

**Intellectual Property Office of Singapore  
Hearings & Mediation Department**

**IPOS DISPUTE RESOLUTION:  
TRADE MARKS CASE GUIDE**  
(1<sup>st</sup> Ed: 2017, Last Revised 6 January 2023)

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## FOREWORD

### Introduction

This document is targeted at practitioners who act for clients in proceedings before the Registrar at the Intellectual Property Office of Singapore (IPOS).

It aims to serve as a quick (albeit non-exhaustive) guide to some key aspects of IPOS practice and procedure.

The focus of this document is on selected decisions of the Registrar (from 2013 onwards), and where relevant, their treatment by the courts.

### Structure

This document is split into the following parts.

Part I: contains a brief glossary of terms which frequently arise in IPOS disputes.

Part II: deals with matters of practice and procedure.

Part III: discusses legal and evidential points which may be of interest to practitioners. An in-depth treatment of the law is beyond the scope of this document. Instead, the focus is on: (a) significant or frequently encountered issues in IPOS proceedings; and/or (b) issues which the Singapore courts have yet to consider.

Annex A: is a change log which records the changes to the Case Guide (including any new cases).

### Important Disclaimer

This document is provided solely for the reader's convenience, and should not be taken as a substitute for the Registrar's full grounds of decision as stated in each case, or the various IPOS Hearings & Mediation Circulars presently in effect.

For the avoidance of doubt, this document is not a Circular and does not have any legal effect or authority.

### Abbreviations Used

- Trade Marks Act 1998 ("**TMA**")
- Trade Marks Rules (Cap. 332, R 1) ("**TMR**")
- Compendium of Hearings & Mediation Department Circulars (Last updated: 25 May 2022) ("**Compendium**")

## TABLE OF CONTENTS

<b>PART I Glossary of commonly used identifiers.....</b>	<b>5</b>
<b>PART II Practice and Procedure .....</b>	<b>6</b>
(1) Starting an action.....	7
(2) Pleadings.....	8
(3) Exercise of Registrar’s discretion .....	9
(4) Matters relating to oral hearings.....	12
(5) Decisions of the Registrar.....	15
(6) Dealing with Confidentiality Issues .....	18
<b>PART III Legal and Evidential Points of Interest.....</b>	<b>20</b>
(7) Bad faith .....	21
(8) Deceptive trade marks.....	23
(9) Conflict with an earlier right.....	24
(10) Use of sign prohibited by law .....	34
(11) Evidence relating to copyright.....	35
(12) Evidence relating to trade mark use.....	35
(13) Evidence required to prove that a mark is well known to the public at large .	38
(14) Evidence concerning the state of the Register.....	39
(15) Honest concurrent use .....	40
(16) Effect of disclaimers .....	40
(17) Survey evidence .....	40
(18) Marks in a language other than English.....	41
(19) Geographical Indications .....	42
<b>ANNEX A: CHANGE LOG .....</b>	<b>43</b>

## PART I

### Glossary of commonly used identifiers

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- **Applicant:** broadly refers to any party making an application to the Registrar. In practice, the meaning of “Applicant” is context dependent:
  - In trade mark opposition proceedings, “Applicant” refers to the party seeking to obtain registration of its trade mark.
  - In invalidation or revocation cases, “Applicant” is synonymous with “Initiator” (see below).
  - In interlocutory proceedings, “Applicant” refers to the party seeking relief and/or the exercise of the Registrar’s discretion in its favour.
- **Hearing Officer:** refers to the PAR or AR presiding over an interlocutory or final hearing.
- **Initiator:** refers to any party which has commenced legal proceedings at IPOS.
- **IP Adjudicator:** refers to an individual who is appointed to hear IP disputes at IPOS on an *ad hoc* basis. IP Adjudicators are appointed to give parties to disputes the opportunity to have their cases heard by some of the best legal minds in the local IP field. A list of IP Adjudicators is available at the following [link](#).
- **Opponent:** broadly refers to any party resisting an application to the Registrar. In trade mark opposition proceedings, “Opponent” refers to the party seeking to oppose another party’s application to register a trade mark.
- **Proprietor:** The term ‘proprietor’, or ‘registered proprietor’, or ‘registrant’, may refer to any party which owns any intellectual property right that is relevant to the dispute.
- **Registrar:** refers to the Registrar of Trade Marks. In practice, the Registrar’s authority in contentious proceedings is delegated to Principal Assistant Registrars (PAR) and Assistant Registrars (AR) in the Hearings and Mediation Department (HMD), as well as IP Adjudicators in selected cases (see above).
- **Respondent:** refers to any party which defends or resists an application. For example, Respondent may refer to: (1) the Proprietor of a trade mark that is being attacked for non-use may be referred to as the Respondent; or (2) a party resisting an application to adduce further evidence.

## **PART II**

### **Practice and Procedure**

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<b>(1)</b>	<b>Starting an action.....</b>	<b>7</b>
<b>(2)</b>	<b>Pleadings.....</b>	<b>8</b>
<b>(3)</b>	<b>Exercise of Registrar’s discretion .....</b>	<b>9</b>
<b>(4)</b>	<b>Matters relating to oral hearings.....</b>	<b>12</b>
<b>(5)</b>	<b>Decisions of the Registrar.....</b>	<b>15</b>
<b>(6)</b>	<b>Dealing with Confidentiality Issues .....</b>	<b>18</b>

## (1) Starting an action

### 1.1 The importance of keeping proper records and managing IP

Proprietors should exercise basic intellectual property management such as tracking renewal deadlines and as documenting evidence of use. The records kept may be useful, or even critical, as evidence, in the event a trade mark is challenged post registration.

In this regard, being a small scale business is no excuse for poor record keeping.

- [Cheaney Shoes Limited v Widdy Trading Pte Ltd](#) [2015] SGIPOS 12 at [43]

### 1.2 Is there a requirement of *locus standi*, or sufficient standing, in order to commence a trade mark opposition?

No, there is no such requirement. “*Any person*”<sup>1</sup> may give notice of a trade mark opposition under Section 13(2) TMA.

- [Converse Inc v Southern Rubber Works Sdn Bhd](#) [2015] SGIPOS 11 at [18]

### 1.3 Does the initiator have to adduce evidence of non-use in order to commence an action for trade mark revocation on that ground?

No. A bare allegation of non-use is sufficient.

- [Secondment Pty Ltd v MCI Group Holding SA](#) [2014] SGIPOS 15 at [22] to [30]<sup>2</sup>

### 1.4 Is there a requirement that the opponent must be the proprietor of the earlier trade mark(s) relied on?

No. Under Section 8(2)(b), the opponent may rely on earlier trade marks owned by a third party.

- [Application for Amendment of Notice of Opposition by MHCS and Objection Thereto by J.-E. Borie SA](#) [2013] SGIPOS 4 at [23]

### 1.5 The importance of preparing evidence by reference to the grounds in dispute

In the following cases, a portion of the parties’ evidence pertained to matters outside of the grounds of opposition and it was not necessary for the tribunal to review and make determinations on that evidence. It would have been more straightforward and efficient if the evidence had been more streamlined and curated according to what needed to be established or defended against, by reference to the grounds of opposition. Indeed, parties should take heed of the fact that the tendering of evidence that is irrelevant or excessive may, in certain cases, have cost consequences.

<sup>1</sup> A “person” includes a company.

<sup>2</sup> However, the Registrar remains open to reconsidering the point in a future case.

- [U-Manga International Business Co., Ltd. v Nunufish.com](#) [2017] SGIPOS 11 at [64]
- [Guccio Gucci S.p.A v Guccitech Industries \(Private Ltd\)](#) [2018] SGIPOS 1 at [15], [73] and [96]

## (2) Pleadings

### 2.1 Pleading the correct grounds and related issues

For guidance on the Registrar's practice in relation to pleadings issues at Case Management Conferences, please see HMD Circular 1.6 (Compendium at p 17).

In the following case, the applicant for revocation and invalidation of certain registered marks incorrectly (and thus unsuccessfully) alleged passing off and deception under Sections 7(4) and 7(5) TMA:

- [Autozone Automotive Enterprise v Autozone Parts, Inc.](#) [2013] SGIPOS 1 at [65] – [66]

There are several possible heads of bad faith under Section 7(6) TMA. It is important to particularise these in the pleadings and not leave it only to the later stages of evidence or submissions to think about or articulate what these heads of alleged bad faith are. In the following cases, the Registrar disregarded lines of argument falling outside the scope of the pleadings of bad faith.

- [Adidas International Marketing BV v Lutong Enterprise Corp.](#) [2018] SGIPOS 12 at [80] – [82]
- [Apple Inc. v Swatch AG \(Swatch SA\) \(Swatch Ltd.\)](#) [2018] SGIPOS 15 at [97] – [99]

### 2.2 Amendments to pleadings

For guidance on amendments to pleadings (e.g. Notice of Opposition, Counter Statement), please see HMD Circular 1.2 (Compendium at p 8).

In the following case, an amendment to the Notice of Opposition was sought, objected to by the counter party, and allowed by the Hearing Officer on the specific facts:

- [Application for Amendment of Notice of Opposition by MHCS and Objection Thereto by J.-E. Borie SA](#) [2013] SGIPOS 4

However, in the following case, an application by an applicant for leave to amend the Statement of Grounds with a view to adding a new ground for revocation after the registered proprietor had already filed its evidence was refused by the Hearing Officer.

- [Application for Amendment of Pleadings by Axis Law Corporation and Objection Thereto by Axis Intellectual Capital Pte Ltd.](#) [2015] SGIPOS 15<sup>3</sup>

<sup>3</sup> Dissatisfied, the applicant filed for judicial review but the High Court dismissed the judicial review application in [2016] SGHC 127. The applicant subsequently appealed to the Court of Appeal (in Civil Appeal No. CA 79 of 2016) which dismissed the appeal without issuing written grounds of decision.



### 2.3 Striking Out

The Registrar has no power to strike out a notice of opposition.

- [Application by OOO “TVM Trade” to strike out notice of opposition and objection thereto by Societe De Produits Nestle](#) [2014] SGIPOS 12 at [1] and [37]

### 2.4 Effective date of revocation for non-use

An order for non-use revocation may, in certain circumstances, take effect from an earlier date than the date of the application for revocation. (See HMD Circular 1.5; Compendium at p 14) However, the Registrar has *no power* to order the effective date of revocation to a day within the first 5 years from the date of the completion of the registration procedure:

- [New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited](#) [2017] SGIPOS 16 at [7] and [73] – [97].

### 2.5 Relevant date for assessing descriptiveness/distinctiveness in cases involving subsequent designation (of an international registration) in Singapore

Where a request for extension of an international registration's protection to Singapore is made via a *subsequent designation*, the mark would be assessed for descriptiveness/distinctiveness in Singapore by reference to the “Date of Subsequent Designation” recorded on the Singapore trade marks register.

- [Abbott Laboratories v Société des Produits Nestlé S.A.](#) [2019] SGIPOS 11 at [15] – [19].<sup>4</sup>

## (3) Exercise of Registrar’s discretion

### 3.1 Preliminary Views of the Registrar

The term Preliminary View (“PV”) refers to the Registrar’s provisional (as opposed to final) decision or direction.

A PV may be issued in the context of any interlocutory dispute *other than* an application for extension of time made within the relevant prescribed period.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9 at [26]

A brief sketch of the salient points relating to PVs is set out below.

- When interlocutory disputes arise, the Registrar typically does not issue any PV at the outset.

<sup>4</sup> Upheld on appeal by the High Court with no written grounds of decision.

- Instead, the first step is to allow parties to explore the possibility of resolution via consent.
- However, if parties are unable to resolve their differences by a certain time, or at any appropriate juncture, the Registrar will put forth a PV and parties will be given an opportunity to respond by way of letter.
- If no objections are received to the Preliminary View by the stipulated date, the tentative decision or directions set out in the Preliminary View become final and parties are to abide by them.
- In the event objections are received to the Preliminary View, the Registrar may adopt one of the following approaches:
  - Issue a fresh PV and give parties a further opportunity to respond. The Registrar may adopt this approach in cases where there is new information that was not previously considered and/or after due consideration of the parties' submissions.
  - Indicate that notwithstanding the objections the Registrar is not inclined to deviate from the earlier Preliminary View and at the request of a party or on his own initiative, allow the parties to be heard either (at their election) by way of a formal oral interlocutory hearing or only by further written submissions (if any) in lieu of an in-person interlocutory hearing.
- The Registrar will either issue a final decision at the conclusion of, or after, the interlocutory hearing or after receiving the parties' written submissions in lieu of an in-person interlocutory hearing (as the case may be).

The Registrar generally does not make any final orders without first hearing from all parties to the dispute.

- [Application for confidentiality safeguards by TWG Tea Company and objection thereto by T2 Singapore & Tea Too](#) [2019] SGIPOS 9 at [51]

### 3.2 Extensions of Time (where the application is made out of time)

Rule 83 TMR provides that:

*“Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct”.*

#### Pleadings

The Registrar has the power to hear an application for an extension of time (including one made out of time) to file a Counter Statement under Rule 83 TMR.

- [Application for Acceptance of Late Counter-Statement in a Trade Mark Application by MGG Software Pte Ltd and Objection Thereto by Apptitude Pte Ltd](#) [2015] SGIPOS 8 at [1]<sup>5</sup>

<sup>5</sup> Citing *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7 for the proposition that “irregularity” in Rule 83 refers to failures to comply with the procedural requirements of the TMA and the TMR.

However, the mere fact that the Registrar has such discretion does not justify its exercise in every case or where no good reasons are shown.

- [Application for Acceptance of Late Counter-Statement in a Trade Mark Application by MGG Software Pte Ltd and Objection Thereto by Apptitude Pte Ltd](#) [2015] SGIPOS 8 at [2]

### Evidence

The Registrar has the power to hear an application for an extension of time to file evidence under Rule 83 TMR. The aforementioned power may be exercised by the Registrar notwithstanding that a request for an extension of time may have been made:-

- (a) after the prescribed period to apply for an extension of time (see Rule 33(4) TMR); and/or
- (b) after the maximum possible time extension that the Registrar would have been able to award if the extension of time had been applied for within the relevant prescribed period for applying for such extension (see Rule 33(5) TMR).

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likbustokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [1] – [3]<sup>6</sup>

### Some relevant considerations

In the Registrar's exercise of discretion, a balance must be struck between ensuring that parties have the benefit of certainty and finality that the Trade Marks Rules provide, and that cases are dealt with on the basis of their merits in the interest of justice between parties.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likbustokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [6]<sup>7</sup>

A solicitor's bona fide mistake is but one factor in the Registrar's overall consideration in deciding whether to exercise discretion to allow an extension of time. Such a mistake per se may not be sufficient to enable the Registrar to exercise discretion in favour of an extension.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likbustokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [7]<sup>8</sup>

A key factor that the Registrar will consider is whether the grant of an extension of time is whether the grant of an extension of time would cause prejudice to the innocent party. Although an applicant for extension of time cannot rely on the consequences of his own default as a type of "prejudice" done to him, this does not mean that the Registrar cannot

<sup>6</sup> Citing *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7, *Sao Paulo Alpargatas S.A. v But Fashion Solutions Comercio E Industria De Artigos Em Pele, LDA* [2011] SGIPOS 16

<sup>7</sup> Citing *Neutrogena Corporation v Neutrogen Pte Ltd* [2005] SGIPOS 7 and *Martin Joseph Peter Myers v GSM (Operations)* [2009] SGIPOS 8

<sup>8</sup> Citing *Nomura Regionalisation Venture Fund Ltd v Ethical Investments Ltd* [2000] 2 SLR(R) 926 at [28] and *Denko-HLB Sdn Bhd v Fagerdala Singapore Pte Ltd* [2002] 3 SLR 357 at [13]

consider other types of prejudice when deciding whether to exercise discretion. Ultimately, in approaching the question of prejudice the Registrar will seek to balance both parties' competing interests and decide based on the justice of the case.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likburstokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [10]<sup>9</sup>

For a decision where the Hearing Officer declined to exercise the Registrar's power under Rule 83 TMR in the context of trade mark invalidation proceedings, which resulted in the registered proprietor being treated, under Rule 59(2)(d) read with Rule 31A(9) TMA, as having admitted to the facts alleged by the applicant for invalidity, see:

- [Mahendra Naidu A/L R. Manogaran trading as Sri Sai Traders v Navin Trading Pte Ltd](#) [2019] SGIPOS 2 at [9] – [19]

For examples of cases where a request for extension of time to file evidence (made out of time) was allowed, see:

- [Application for Extension of Time to File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba \(Zhejiang\) Nursing Products Co., Ltd](#) [2021] SGIPOS 1
- [Application for Extension of Time to File Evidence in a Trade Mark Revocation by Symphony Holdings Limited and Objection Thereto by Skins IP Limited](#) [2021] SGIPOS 5

### 3.3 Filing of Further Evidence

For guidance on applications to file further evidence, please see HMD Circular 4.1 (Compendium at p 42).

In the following case, the Hearing Officer refused an application to file further evidence after the close of evidence:

- [Application for Leave to File Further Evidence in a TM Opposition by Autozone Automotive Enterprise and Objection Thereto by Autozone Parts, Inc.](#) [2013] SGIPOS 7<sup>10</sup>

## (4) Matters relating to oral hearings

### 4.1 Instructed Counsel

Instructed counsel may be engaged to argue cases at IPOS.

- [Secondment Pty Ltd v MCI Group Holding SA](#) [2014] SGIPOS 15 at [6] – [10]

<sup>9</sup> Citing the Court of Appeal's dicta in *Sun Jin Engineering Pte Ltd v Hwang Jae Woo* [2011] 2 SLR 196

<sup>10</sup> The Registrar made it clear that the factors are not exhaustive and considered the principles in following UK cases as being of guidance: *Ladd v Marshall* [1954] 1 WLR 1489, *Hunt Wesson Inc's Trade Mark Application (SWISS MISS)* [1996] RPC 233, and *Yves Saint Laurent v The Zoological Society of London* (Case No. O-245-07, 23 August 2007) (UK IPO) at [29] – [30].

#### 4.2 Applications for cross-examination

For guidance on applications for leave to cross-examine witnesses, please see HMD Circular 5.2 (Compendium at p 53).

In the following case, the Hearing Officer allowed the applicant's request for cross-examination on certain specific issues only, and limited the time allotted for cross-examination to 60 minutes per witness.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9

#### 4.3 Cases where there is no cross-examination

The Registrar is not obliged to accept a witness' evidence in the absence of cross-examination if it is obviously incredible. However, where the evidence in a statutory declaration is not obviously incredible, and no opportunity has been given to the deponent (whether in cross-examination or otherwise) to clarify, substantiate the evidence in the statutory declaration, or respond to objections, it may be inappropriate to make adverse factual findings against the deponent.

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [46] – [49]

#### 4.4 Absence of material witness from cross-examination

It may be possible to draw an adverse inference against a party whose material witness is required to attend cross-examination but fails to do so without proper justification.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Limited](#) [2016] SGIPOS 1 at [180] – [183]
- [Bitwave Pte Ltd v Fung Shing Company Limited](#) [2018] SGIPOS 21 at [2] – [3]

#### 4.5 Whether the Evidence Act and/or Rules of Court apply to IPOS proceedings?

To date, the question of whether proceedings before the Registrar at IPOS are subject to the Evidence Act (Cap. 97) and/or Rules of Court (Cap. 322, R 5) has not been fully and finally settled.

In the following case, the Hearing Officer did not decide the issue, but indicated his inclination to the view that the Rules of Court do not apply to IPOS proceedings generally although parties may mutually agree to their application.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9 at [31] – [56]

The Hearing Officer also considered that Parts I, II and III of the Evidence Act did not apply to statutory declarations filed for the purposes of IPOS proceedings. However, where oral evidence is: (a) given in lieu of or in addition to a statutory declaration, or (b) elicited during cross-examination, the Evidence Act should apply.

#### 4.6 Can supplementary or further written submissions be tendered at the hearing itself? Can additional authorities be cited and relied on?

It depends on the circumstances. HMD Circular 5.2 at paragraph H (Compendium at p 59) states that additional or supplementary written submissions (and accompanying bundle of authorities) should be filed and served on the counter-party at least 2 weeks before the hearing. Failure to comply may result in the Registrar disregarding the submissions. If the Registrar exercises his discretion to accept the submissions, the counter-party will be given time to file reply submissions. Although the 2-week requirement does not apply to basic rebuttal submissions, the Registrar retains the discretion to give the other party time beyond the hearing to file reply submissions if the situation calls for it.

In the following case, the opponent furnished supplementary written submissions at the hearing itself (that is to say, it did not comply with the 2-week deadline), together with seven additional case authorities from the UK Patent Office, IP Australia, and the EU Intellectual Property Office. The opponent was given the opportunity to explain its reliance on these additional authorities. After hearing counsel, the Hearing Officer concluded that the persuasive value of these additional authorities was “very limited, at best”. She declined to take them into account. In so doing, she stressed that parties in proceedings before the Registrar are expected to comply with the Circular, which serves to ensure fair and transparent play between parties and the integrity of the rules (which gives parties fair opportunity to concretise their submissions 1 month in advance).

- [Adidas International Marketing BV v Lutong Enterprise Corp.](#) [2018] SGIPOS 12 at [50] – [53]

In the following case, opponent’s counsel sought permission to tender rebuttal submissions at the beginning of the oral hearing. There were no objections by applicant’s counsel and directions were given to file the soft copy via IP<sup>2</sup>SG after the hearing. However, the version of the document that was filed via IP<sup>2</sup>SG turned out to be different from the hardcopy tendered at the hearing. Opponent’s counsel explained that they had included the written version of the verbal arguments made at the hearing. In response, applicant’s counsel objected and argued that this was unfair and prejudicial and resulted in unnecessary wasted time and costs.

The Hearing Officer noted that while the opponent might have been well-intentioned, it should not have taken the liberty of doing what it did. However, the opponent’s conduct was not egregious. Given the circumstances, no costs penalty was awarded. Nevertheless, such leniency might not be awarded in future cases.

- [B.R. v Elements Cosmeceuticals Pte. Ltd.](#) [2021] SGIPOS 3 at [13]

#### 4.7 Documents in the nature of evidence tendered at the hearing

Parties should not tender documents at the hearing which are in the nature of (further) evidence. Evidence should be tendered by way of statutory declaration (and leave should be obtained for the late filing).

In the following case, the opponent tendered a 13 pages of printouts from various web pages which it described as “observations” in the nature of “general knowledge on the wine industry”. The Hearing Officer did not take these documents into account.

- [Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd](#) [2014] SGIPOS 11 at [15] – [25]

For other cases wherein the Hearing Officer considered that improperly introduced documents should be disregarded, please see:

- [Stora Enso Oyj v PT Purinusa Ekapersada and PT Pabrik Kertas Tjiwi Kimia TBK Ltd](#) [2016] SGIPOS 12 at [119] – [122]
- [Adidas International Marketing BV v Lutong Enterprise Corp.](#) [2018] SGIPOS 12 at [65] – [66]

However, judicial notice can be taken of certain facts even if they are not set out in (or annexed to) a statutory declaration. In the following case, the IP Adjudicator took judicial notice of the fact that certain trade marks were registered in Singapore.

- [The Polo/Lauren Company, L.P. v United States Polo Association](#) [2015] SGIPOS 10 at [76]

#### **4.8 Documents used to challenge witness testimony during cross-examination**

By way of contrast, documents produced during cross-examination for the purposes of challenging witness testimony may, in certain circumstances, be admissible.

- [FMTM Distribution Ltd v. Tan Jee Liang Trading as Yong Yew Trading Company](#) [2017] SGIPOS 9 at [18] – [32]

#### **4.9 Possible consequences of not filing Form HC1**

Rule 37(4) of the Trade Marks Rules (Cap. 332, 2008 Rev Ed) provides that “*Any party who does not file with the Registrar Form HC1 before the hearing may be treated as not desiring to be heard, and the Registrar may proceed with the hearing in the absence of that party or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit*”.

In the following case, the Registrar exercised his discretion under the above mentioned rule under to allow a trade mark opposition without proceeding with a full substantive hearing. The Applicant was unresponsive in the advanced stages of the opposition and did not file Form HC1.

- [Seek Limited v Seek Asia Pte Ltd](#) [2020] SGIPOS 2

## **(5) Decisions of the Registrar**

### **5.1 Whether previous IPOS decisions are binding**

A holding in an earlier IPOS decision is persuasive, but not binding, on a later IPOS tribunal.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9 at [40]

## 5.2 The Registrar's approach to judgments of a Court or Tribunal in separate proceedings

### Observation

At times, parties to IPOS disputes may be embroiled in disputes over the same or related mark(s) before courts or tribunals abroad. Not infrequently, after having obtained a decision of a foreign court or tribunal in their favour, one or both parties may seek to rely on certain findings or holdings in that decision (e.g. on similarity of marks, distinctiveness, or likelihood of confusion) before the Registrar at IPOS as well.

### General principles

As a general rule, a previous judgment of a court or tribunal in separate proceedings is a determination based on separate and independent facts and is not relevant to subsequent judicial proceedings (or IPOS proceedings). Even if the parties and issues are substantially the same, a previous judgment may only be admissible in subsequent proceedings in limited circumstances.

- [Star Industrial Company Limited v Sin Fatt Industrial Co., Sdn Bhd](#) [2013] SGIPOS 5 at [20] – [23]<sup>11</sup>

That said, if the Singapore High Court makes findings in separate proceedings, and there is evidence of the correlation of the facts and issues before the Court and the existing proceedings before the Registrar, the Registrar may be bound by the substantive decision of the High Court.

- [Tsung-Tse Hsieh v Redsun Singapore Pte. Ltd.](#) [2015] SGIPOS 1 at [16]

Related proceedings between parties in other jurisdictions serve at best as guides to opposition proceedings here. The relevance of these decisions will hinge upon the similarity of the laws of the particular jurisdiction with those of Singapore and also upon the individual facts of the case. For example, it does not follow that a mark which is well known in country X is necessarily also well known in country Y.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [27]<sup>12</sup>

On the other hand, if a party makes certain factual assertions in one jurisdiction, he should not be permitted to take a completely different position in another jurisdiction.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [27]<sup>13</sup>

<sup>11</sup> Citing Jeffrey Pinsler, S.C., *Evidence, Advocacy and the Litigation Process* (3rd edition) at pp 208 – 209, 253, and 377.

<sup>12</sup> Citing *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [118].

<sup>13</sup> Citing *Guy Neale and ors v Ku De Ta SG Pte Ltd* [2015] 4 SLR 283 at [90] and [115].



For an interesting case where one party attempted to rely on an English decision to support its submission that the other party should be estopped from raising a contrary argument or different position in Singapore, please see:

- [Hotel Cipriani S.P.A. v Altunis - Trading, Gestão E Serviços, Sociedade Unipessoal, LDA](#) [2022] SGIPOS 3 at [59]-[69]

#### Reliance on EU cases

Parties should be mindful of the need to exercise caution in the use of authorities from the EU given the significant differences in the law in certain respects, as well as the different circumstances. (For instance, a sign may have no meaning in respect of the relevant goods and/or services to non-English speakers, but such a finding would be irrelevant to the Singapore context.)

- [Beats Electronics, LLC v LG Electronics Inc.](#) [2016] SGIPOS 8 at pp 12 to 13, footnote 1

#### Reliance on UDRP cases

Cases decided under the Uniform Domain Name Dispute Resolution Policy (UDRP) are premised on very different considerations from those in trade mark oppositions in Singapore.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [30]
- [Formula One Licensing B.V. v Idea Marketing SA](#) [2015] SGIPOS 7 at [87]<sup>14</sup>

### **5.3 Partial revocations, invalidations and oppositions**

Partial revocation and/or invalidation of goods or services is possible under Sections 22(6) TMA and/or 23(9) TMA respectively. The following are examples of cases where partial invalidation of goods was ordered.

- [Sports Connection Pte Ltd v PT Eigerindo Multi Produk Industri](#) [2015] SGIPOS 5
- [G3 Enterprises, Inc v Bacardi & Company Limited](#) [2014] SGIPOS 6

However, the TMA does not expressly confer upon the Registrar the power to order that an opposition partially succeeds in respect of some, but not all of the goods or services.

In the following case, the Hearing Officer examined some of the arguments for and against allowing partial oppositions, but did not decide on the issue as he was not required to do so.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [102] – [114]

Partial oppositions once again came to the forefront in the following cases.

<sup>14</sup> Upheld on appeal (see [2015] SGHC 263) and the Hearing Officer's holding on UDRP cases was expressly affirmed at [73] of the High Court's decision.

- [Monster Energy Company v Tencent Holdings Limited](#) [2018] SGIPOS 9

Although it was not necessary to decide the issue in light of his conclusion that the marks were dissimilar, the Hearing Officer considered that the Registrar cannot, in the context of a trade mark opposition under Sections 8(2)(b) and/or 8(4) of the Trade Marks Act refuse the registration of certain goods or services in a certain class, but allow it to be registered for other goods or services in the same class. Instead, the Registrar had to either refuse or allow registration of the mark in its entirety (i.e. in respect of all the goods or services for which registration is sought).

- [Abbott Laboratories v Société des Produits Nestlé S.A.](#) [2019] SGIPOS 11<sup>15</sup>

In this case, the Hearing Officer expressed the view that the Registrar cannot make an order for partial opposition under Section 7(1)(b) or (c) of the Trade Marks Act. Nevertheless, the position remains unclear as to whether the non-availability of partial oppositions extends to multi-class applications. (See decision at [71] – [75].)

- [Damiani International BV v Dhamani Jewels DMCC](#) [2020] SGIPOS 11

Here, the IP Adjudicator considered the issue of partial oppositions and came to the conclusion that the tribunal is not required, and does not have the authority, to grant partial oppositions whether or not they arise within the context of a single class or in multi-class applications. (See decision at [66].)

#### 5.4 Costs in partial revocation cases

In the case of a partially successful revocation action, costs would generally be awarded to the applicant for revocation. This flows from the general principle that, in the absence of other intervening factors, costs should follow the event.

However, it does not follow that a partially successful applicant (for revocation) would be awarded full costs. It may be less, depending on the specific facts of the case. This is not a strict numbers game and there is no rigid mathematical formula that can be derived based on the number of items revoked out of the total number of goods/services in the original specification.

- [Bigfoot Internet Ventures Pte. Ltd. v Athleta \(ITM\) Inc.](#) [2018] SGIPOS 10

## (6) Dealing with Confidentiality Issues

### 6.1 Is it possible to obtain confidentiality safeguards in relation to trade marks proceedings before the Registrar?

Yes, although the case for imposing such safeguards would need to be compelling.

- [Application for confidentiality safeguards by TWG Tea Company Pte. Ltd. and objection thereto by T2 Singapore Pte. Ltd. & Tea Too Pty Ltd](#) [2019] SGIPOS 9 at [33]

<sup>15</sup> Upheld on appeal by the High Court. No written grounds of decision were issued.

In assessing whether confidentiality safeguards would be imposed, some factors to consider would include:

- The importance of the information to the issues in dispute – the more critical the information, the less likely it should be kept private; in accordance with the principle of open justice, it is important to be able to ascertain the basis of a court or tribunal’s decision;
- The degree to which the information is confidential – if the same type of information is available through publicly available sources (e.g. if the party providing the confidential information is publicly-listed, some of the information may be publicly available; some of the information may be available through industry or trade publications);
- How current the information is – in most trade mark disputes before IPOS, the tribunal is concerned with the status of matters at the date of application for registration of the mark in dispute; this could be a few years before the date when the information is provided; the more “historic” the information, the less likely that it will still be commercially valuable;
- Whether the parties are competitors – if so, it would be more important to have confidentiality safeguards; but this cannot be decisive since the parties in such proceedings will in many cases be competitors;
- The extent of prejudice to a party should the confidential information be disclosed to its competitor – this will depend very much on the facts of each individual case; and
- The stage of the proceedings – as the matter advances towards a hearing, it will become progressively more important for a party to be fully apprised of the case it has to answer, and it is plausible that more individuals within that party might need access to the confidential information to enable meaningful discussions as to the conduct of the case, including whether the possibility of a settlement should be explored.

## 6.2 Does the *Riddick* principle apply to proceedings before IPOS?

Although the position is not entirely clear, the Hearing Officer in [Application for confidentiality safeguards by TWG Tea Company Pte. Ltd. and objection thereto by T2 Singapore Pte. Ltd. & Tea Too Pty Ltd](#) [2019] SGIPOS 9 expressed his view at [56] that “it would be surprising” if it did not. On the facts of that case, he made an order to essentially the same effect, saying this:

*“In the present case, I have ordered that the Respondents shall not use the Applicant’s confidential information for any purposes other than the conduct of the IPOS proceedings in respect of the Subject Marks. This essentially reinforces the Riddick principle as an explicit term of an order of this Tribunal, and is one of the suggested methods for safeguarding confidentiality set out in the **Supreme Court Intellectual Property Court Guide (supplement to Orders 87 and 87A of the Rules of Court (Cap 322, R5, 2006 Rev Ed))**...”*

## PART III

### Legal and Evidential Points of Interest

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(7)	Bad faith .....	21
(8)	Deceptive trade marks.....	23
(9)	Conflict with an earlier right.....	24
(10)	Use of sign prohibited by law .....	34
(11)	Evidence relating to copyright.....	35
(12)	Evidence relating to trade mark use.....	35
(13)	Evidence required to prove that a mark is well known to the public at large.	38
(14)	Evidence concerning the state of the Register.....	39
(15)	Honest concurrent use .....	40
(16)	Effect of disclaimers .....	40
(17)	Survey evidence .....	40
(18)	Marks in a language other than English.....	41
(19)	Geographical Indications .....	42

## (7) Bad faith

### 7.1 Overly wide specifications

Merely drafting a specification broadly does not necessarily mean that the application is made in bad faith. A line should be drawn between excessively wide specifications and ones which merely provide some room for possible brand extension:

- [Kenzo v Tsujimoto Kenzo](#) [2013] SGIPOS 2 at [125]

It is legitimate for businesses to seek registration of a mark, not only for the categories of goods and services which it markets at the time of filing the application, but also for other categories of goods and services which it intends to market in the future. There is no bad faith in applying for a broader specification than one which a trader currently trades in. A possible or contingent intention to use the mark at some future date may suffice.

However, there may be bad faith if there is something more to suggest that there has been some unconscionable business conduct and/or moral impropriety on the applicant's part. For example, if at the time of the application the applicant had no *bona fide* intention to use the mark in relation to (all of) the goods/services applied for, this would support a finding of bad faith.

- [Audi AG v Lim Ching Kwang](#) [2017] SGIPOS 2 at [59] – [60]

In a case where the trade mark proprietor discloses in evidence that it had never used, nor ever had any intention to use, its trade mark in relation to the entire (broad) specification claimed and where the applicant for invalidation had not pleaded the ground of bad faith, the Registrar nonetheless has no power to decide, of his own volition, in the public interest, that the trade mark registration was obtained in bad faith.

- [Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.](#) [2018] SGIPOS 20 at [30]

### 7.2 Bad faith and cross-examination

For oppositions based on bad faith where there is no cross-examination, see point 4.3 above and:

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [47]
- [GCIH Trademarks Limited v Hardwood Private Limited](#) [2022] SGIPOS 14

For oppositions based on bad faith where the trade mark applicant's witness fails to attend the cross-examination without proper justification, see point 4.4 above and:

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Limited](#) [2016] SGIPOS 1 at [181] – [182]
- [Bitwave Pte Ltd v Fung Shing Company Limited](#) [2018] SGIPOS 21

### 7.3 Time of assessment; matters to be taken into account

In determining whether there was bad faith, the relevant time is the time of filing the application for registration.

- [Leonid Kovalkov v Tan Siew Keng, Angeline](#) [2016] SGIPOS 10 at [29]<sup>16</sup>

In this regard, it may be relevant to take into account events that occurred before and shortly after the date of the application of the mark, as these will give insights into the context in which the impugned marks were registered.

- [Leonid Kovalkov v Tan Siew Keng, Angeline](#) [2016] SGIPOS 10 at [30]

Matters which occurred after the date of application which may assist in determining the applicant's state of mind as at the date of application can be taken into consideration.

- [Pauline New Ping Ping v Eng's Char Siew Wantan Mee Pte. Ltd.](#) [2022] SGIPOS 10<sup>17</sup> at [85] citing *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [100]

In [Louis Dreyfus Commodities MEA Trading DMCC v Orco International \(S\) Pte Ltd](#) [2017] SGIPOS 8 at [113], the Hearing Officer applied the principle that bad faith must be assessed by reference to the time of filing of the trade mark application. Consequently, he declined to take into account the way the trade mark applicant conducted itself in opposition proceedings when assessing bad faith.

### 7.4 Cases where bad faith succeeded

In the following cases, the Hearing Officer made a finding of bad faith. These cases illustrate the type of factual matrix and/or evidence required to support a finding on this ground.

- [Sports Connection Pte Ltd v PT Eigerindo Multi Produk Industri](#) [2015] SGIPOS 5
- [Christie Manson & Woods Limited v Chritrs Auction Pte. Limited](#) [2016] SGIPOS 1
- [Leonid Kovalkov v Tan Siew Keng, Angeline](#) [2016] SGIPOS 10
- [Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd](#) [2016] SGIPOS 6
- [USA Pro IP Limited v Montfort Services Sdn. Bhd.](#) [2018] SGIPOS 3
- [Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd.](#) [2018] SGIPOS 6
- [United U-Li Projects Pte Ltd v Tan Buck Hai](#) [2018] SGIPOS 19

<sup>16</sup> Citing *Kerly's Law of Trade Marks and Trade Names* (15th Ed) (Sweet & Maxwell, 2011), at [8-263] and the European Court of Justice's decision in *Chocoladefabriken Lindt & Sprungli AG v Franx Hauswirth GmbH* (C-529/07).

<sup>17</sup> Appeal to General Division of the High Court currently pending (as of time of publication)

- [Bitwave Pte Ltd v Fung Shing Company Limited](#) [2018] SGIPOS 21
- [Shenzhen Meixixi Catering Management Co., Ltd. v Heetea Pte. Ltd.](#) [2021] SGIPOS 12

### 7.5 Failure to disclose meaning of word in foreign language to the Registrar

In the following case, it was argued that the trade mark applicant's failure to notify the Registrar that the application mark "Recherché" is a French word which means "research" or "exquisite" or "rare" amounted to bad faith on grounds that: (a) the application mark was not in compliance with Rule 20(1) of the TMR which provides that trade marks in a language other than English shall, unless the Registrar otherwise directs, be endorsed with a translation in English; and (b) if the Registrar had known that the application mark had those meanings it may have encountered a descriptiveness/non-distinctiveness objection by an Examiner.

- [B.R. v Elements Cosmeceuticals Pte. Ltd.](#) [2021] SGIPOS 3 at [97]-[98]

On the facts, however, the arguments were rejected because "Recherché" is also an English word (albeit one that originated from French). Accordingly, the applicant had no obligation to inform the Registrar of the French meaning of the word and thus did not act in bad faith in applying for the mark.

Rule 20(1) of the TMR has since been deleted by Rule 5 of the Trade Marks (Amendment) Rules 2021. The ground of opposition based on the scenario described here would therefore not apply to trade mark applications filed from 1 October 2021.

## (8) Deceptive trade marks

### Observation

Cases where deception (Section 7(4)(b) TMA) was pleaded as a ground of opposition are relatively uncommon. Here are some examples.

In the following case, the deception ground was argued, albeit unsuccessfully. In arriving at her conclusion, the IP Adjudicator held, among other things, that the applicable threshold for deception is that of a "real tangible danger" that the public be deceived (as distinguished from a mere "cause to wonder").

- [Starbucks Corporation d/b/a Starbucks Coffee Company v Morinaga Nyugyo Kabushiki Kaisha \(Morinaga Milk Industry Co., Ltd\)](#) [2017] SGIPOS 18

In this next case, which involved the application mark "ISETAN TARTAN", the deception ground was unsuccessful at first instance. The Hearing Officer took the view that "ISETAN TARTAN" was not of such a nature as to deceive the public as to the origin of the goods.

However, the High Court reversed the Hearing Officer's decision on appeal. In brief, the judge found that there was a strong association between tartan and Scotland and that the public in Singapore are familiar with Scotland and tartan. Accordingly, the judge

concluded that the use of the mark on non-Scotch whisky products is sufficiently deceptive as to the product's geographical origin.

- *Scotch Whisky Association v Isetan Mitsukoshi Ltd* [2019] SGHC 200

For a case where the deception ground of opposition was raised and discussed in some detail, please see [18] – [32] of the following decision.

- [Comité Interprofessionnel du Vin de Champagne and Institut National de l'Origine et de la Qualité v Keep Waddling International Pte. Ltd](#) [2020] SGIPOS 10

In the abovementioned case, a French trade association representing the Champagne geographical indication and a French public administrative institution filed collectively to

**CHAMPENGWINE**  
UNIQUE. BOUTIQUE. SPARKLING WINES OF CHILE

oppose an application to register in respect of “*Sparkling wines, all originating from Chile*” in Class 33. Although the opposition succeeded on a different ground (viz. bad faith), the Hearing Officer was not persuaded that the s 7(4)(b) TMA ground was sufficiently established.

## (9) Conflict with an earlier right

### 9.1 No ‘mosaicking’ of marks

It is trite law that under Section 8(2)(b) TMA, the analysis is mark-for-mark and in this regard two earlier trade marks cannot be mosaicked together into a composite whole for the purposes of the comparison. This principle applies not only to the first step (similarity of marks) but to also the third step (likelihood of confusion).

- [Time Inc. v Li San Zhong](#) [2014] SGIPOS 14 at [69]

The above decision was considered by the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216.

In the result, George Wei J held that two earlier separately registered trade marks cannot be combined so as to form a single composite mark (at [70]).

### 9.2 Relevance of inherent and/or acquired distinctiveness of the mark in the marks-similarity inquiry

#### Background

In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65, the Court of Appeal held at [20] that at the marks-similarity stage, the comparison is solely between the mark applied for and the earlier mark, without reference to any other matter (such as the relative weight and importance of each aspect of similarity having regard to the goods). On the other hand, technical distinctiveness is an integral factor in the marks-similarity inquiry (*Staywell* at [25]).

The above principles appear to be difficult to reconcile with each other, and differing views have been put forward by different Hearing Officers and IP Adjudicators. For a



detailed treatment on the issue, please refer to the following case and the case law discussed within.

- [GCIH Trademarks Limited v Hardwood Private Limited](#) [2021] SGIPOS 6 (“GCIH”) at [34]-[40] and [103]-[112]

The *GCIH* decision was considered in the following subsequent decisions of this tribunal by different IP Adjudicators.

- [Combe International Ltd. v Dr. August Wolff GmbH & Co. KG Arzneimittel](#) [2021] SGIPOS 10 at [26]-[30] (note: the IP Adjudicator disagreed with the approach in *GCIH*)<sup>18</sup>
- [Louis Vuitton Malletier v Human Horizons Holding \(Shanghai\) Co., Ltd.](#) [2021] SGIPOS 13 at [22]-[32] (note: the IP Adjudicator agreed with the approach in *GCIH*)

#### Critical development and binding precedent

The General Division of the High Court has, in [V V Technology Pte Ltd v Twitter, Inc](#) [2022] SGHC 293, now directly addressed the issues discussed above (see [80]-[118] of the decision). For convenience, the learned JC Goh Yi-han’s conclusions (at [119], largely endorsing the approach in *GCIH*) are reproduced below.

(a) First, I would suggest the consistent use of the following expressions when discussing the concept of distinctiveness at the marks-similarity inquiry: (a) inherent technical distinctiveness; (b) acquired technical distinctiveness; and (c) non-technical distinctiveness. The consistent use of these expressions would aid in the formulation of coherent arguments before decision-makers, as well as enhance the comprehensibility of our intellectual property law jurisprudence.

(b) Second, I would suggest a faithful return to *Staywell* and not consider “distinctiveness” as a “threshold” enquiry (even for reasons of convenience or ease of analysis), as this is in reality a separate step to the analysis that is not permitted by *Staywell*. Treating distinctiveness as integrated within the step-by-step approach would ensure that it is properly applied in the right context.

(c) Third, I hold that acquired technical distinctiveness should not be considered at the marks-similarity inquiry based on reasons of precedent, principle, and policy. The issue of acquired technical distinctiveness should be considered at the likelihood of confusion stage of the inquiry to preserve conceptual clarity.

#### **9.2A Marks-similarity analysis when later mark wholly incorporates earlier mark**

When a later trade mark (“CloudFalcon”) wholly incorporates an earlier trade mark (“FALCON”), the inherent technical distinctiveness (or otherwise) of the earlier mark is critical in determining whether the later mark is similar to the earlier mark.

- [Fair Isaac Corporation v LAC Co., Ltd.](#) [2022] SGIPOS 19 at [34]-[43]

<sup>18</sup> Appeal to the General Division of the High Court pending.

### 9.3 Pronouncing invented or unfamiliar words

It is not permissible to take one of several hypothetically plausible pronunciations of a mark, then assert that that specific pronunciation is similar to another mark.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [75]

In this case, the Hearing Officer found that there is no aural similarity between the marks “CHRITRS” (held to be unpronounceable) and “CHRISTIE’S”.

When pronouncing invented or unfamiliar words, there is a tendency of persons to reach within his own vocabulary and mentally look for similar words with the same structure. Having done so, he would apply the way in which those words are pronounced to the invented or unfamiliar word.

- [Apptitude Pte Ltd v MGG Software Pte Ltd](#) [2016] SGIPOS 15 at [41]<sup>19</sup>

Example (1): ROOX would be pronounced as “rooks”

Example (2): SNAC would be pronounced as “snack”

### 9.4 Aural similarity analysis where one (or both) marks contain word elements which are not (part of) the distinctive / dominant element(s)

The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65<sup>20</sup> alluded to two approaches for assessing aural similarity:

- The first approach is for the court or tribunal to have special regard to the distinctive or dominant components of the competing marks.
- The second approach is to undertake a *“quantitative assessment as to whether the competing marks have more syllables in common than not.”*

The elements in the competing marks were “ST REGIS” and “PARK REGIS” and so it mattered not which approach was taken, since both approaches would have yielded the same result.

However, in some cases, a mark may contain word elements which are not (part of) the distinctive / dominant element(s). In such cases, the two approaches may lead to different results.

Consider the following:

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [67] – [70]

In this case, the competing marks both had a similar fox head device within the word “FOX”. However, the application mark had the additional elements: (a) “Fox Street Wear”; and (b) the slogan “What’s stopping you?” The Hearing Officer applied the first

<sup>19</sup> Citing *Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A.* [2004] SGIPOS 8

<sup>20</sup> At [31] – [32]

approach and held that consumers would pronounce the application mark as “FOX”, disregarding the other elements.

- [Apptitude Pte Ltd v MGG Software Pte Ltd](#) [2016] SGIPOS 15 at [37] – [38]

In this case, the application mark was comprised of the large word element “snaapp” and the following words in much smaller font below: “SCHOOL NOTIFICATION & ATTENDANCE APP”. The Hearing Officer considered “SCHOOL NOTIFICATION & ATTENDANCE APP” to be subsidiary and that it was likely that average consumers would not use those words when referring to the mark.<sup>21</sup>

### 9.5 Can goods / services in different classes be similar? Is it necessary to tender evidence to prove this?

In the following case, the respective goods were in different classes (Class 25 as compared to Class 18) and the parties did not put forward any evidence as to the uses, users or trade channels for the goods. Nevertheless, they were nevertheless held to be similar.

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [74] - [85]

Consider also the following where the opposition was under Sections 8(4)(i), 8(4)(ii), 8(7)(a) and 7(6) of the TMA (but Section 8(2)(b) was not pleaded).

- [Kenzo v Tsujimoto Kenzo](#) [2013] SGIPOS 2

The subject mark in this case was: KENZO ESTATE in class 33<sup>22</sup>. This was an opposition filed by KENZO (which was primarily in high-end fashion). The applicant was a wine producer in Napa Valley.

One of the deponents who gave evidence for the opponent stated that it was common for fashion labels or designers to lend their names or otherwise endorse products beyond clothing and accessories, including alcoholic beverages. There were also internet printouts showing that some fashion designers teamed up with producers of alcoholic beverages to produce limited edition bottles. The opponent relied on *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 2 SLR(R) 541 where the court held that luxury brands have been known to license their trade marks for use on cigarettes even though they themselves do not produce such articles.

However, the Hearing Officer found that there was no evidence on the prevalence of such licensing arrangements between luxury brands and alcoholic beverages. And, although there was some evidence that Hennessy and the opponent had collaborated in respect of the product “HENNESSY BY KENZO”, this was found to be a co-branding exercise rather than a business extension by KENZO into the liquor making business. Unlike *Tiffany* (where cigarette manufacturers bought the right to use the luxury brand’s goodwill to sell their product), it was primarily the alcoholic beverage manufacturer’s goodwill that sold their goods.

<sup>21</sup> Following the High Court’s approach in *Han’s (F&B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 at [137].

<sup>22</sup> In respect of “Wine; alcoholic beverages of fruit; western liquors (in general)”.

In the “GUCCITECH” case (full citation below), Gucci successfully opposed Guccitech’s



application to register “GUCCITECH” in Class 11 in respect of various kitchen and cooking appliances. As Gucci did not have any registered trade marks in Class 11, it relied on, *inter alia*, its “GUCCI” registration in Class 21 (for porcelain and ceramic articles; drinking glasses and glass flasks). The learned IP Adjudicator found the goods to be similar. In so doing, he stressed that the word “similar” is not a synonym for “competing” or “substitutable”. It was, in his view, broader than that: see analysis at [41] – [44] of the decision.

- [Guccio Gucci S.p.A v Guccitech Industries \(Private Ltd\)](#) [2018] SGIPOS 1

Consider also the “NEWYORKER” case (full citation below) where the Hearing Officer found that the goods covered under the earlier trade mark (*inter alia*, “clothing”) to be similar to the services for which the application mark was sought to be registered (*inter alia*, “retail services with regard to clothing”).

- [Daidoh Limited v New Yorker S.H.K. Jeans GmbH & Co. KG](#) [2018] SGIPOS 18

In the following case, the Hearing Officer rejected the opponent’s argument that services in Class 35: “*Sales promotion for others; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising; Marketing*” were similar to goods such as nutritional supplements in Class 5, coffee/tea/sugar in Class 30 and beverages in Class 32. It was found that the respective goods and services are wholly dissimilar.

- [Monster Energy Company v Health and Happiness \(H&H\) Hong Kong Limited](#) [2021] SGIPOS 14

## 9.6 Relevance of the price of the goods

### General principles

In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65, the Court of Appeal ruled that under Section 8(2)(b), factors which are external to the marks and to the goods in question, and which are susceptible to changes that can be made by a trader from time to time, such as price differentials between the parties’ goods, cannot be taken into account.

However, the *normal price* of the goods can be taken into account in the assessment of the impact of goods-similarity on consumer perception (which impacts on the third step: the likelihood of confusion). Where the goods in question are normally expensive, the average consumer is likely to pay greater attention and care when purchasing them and this affects his ability to detect subtle differences. (See *Staywell* at [96(b)].)

### Application

In the following case, the IP Adjudicator held that it would be inappropriate to consider whether the parties’ goods (here: eyewear) were in fact expensive or inexpensive items. Instead, the reference point should be the normal or average price of eyewear as a type or category of goods.

- [The Polo/Lauren Company, L.P. v United States Polo Association](#) [2015] SGIPOS 10<sup>23</sup> at [107] - [108]

The IP Adjudicator also considered that it would not be necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise is to determine the degree of care that the average consumer is likely to pay when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.

## 9.7 Family of marks

In the '[Relative Grounds for Refusal of Registration](#)' component of the IPOS Trade Marks Registry's Trade Mark Work Manual (Version 9.1 of November 2022), it is stated at pp 44 to 45 that:

*"Where a number of similar marks in the same ownership incorporate an identical element as a family of marks and another party also applies for registration of a mark incorporating that element, the public may assume that the new mark originates from the same undertaking as an addition to the family of marks and be confused or deceived if that is not the case.*

*... the registration of a number of marks sharing a common element by a single trader is not sufficient to establish that the average consumer would perceive this group of marks as being a family of marks. The proprietor has to provide evidence to prove that the average consumer readily associates marks sharing the common element as originating from the proprietor in order to establish that the marks are indeed perceived as a family of marks..."*

### Principles

Registration of a number of marks each bearing the same element in common, does not automatically give rise to the presumption that the consumer would perceive them as being a family or series of marks, such that the registered proprietor of the marks is entitled to protection of that common element.

The registered proprietor who claims additional protection of that common element will have to adduce sufficient evidence to show use of a sufficient number of these marks as to be capable of constituting a family or series of trade marks, for the purposes of the assessment of the likelihood of confusion.

The relevant audience to consider when deciding whether a family or series of marks is in existence in the marketplace is the consumer or the public. This follows from the principle that at the end of the day, the query goes towards establishing whether there is a likelihood of confusion as a result of the applicant's use of a common element in the registered proprietor's trade marks.

Please see:

- [Beats Electronics, LLC v LG Electronics Inc.](#) [2016] SGIPOS 8 at [32] – [34]
- [Lacoste v Carolina Herrera, Ltd](#) [2014] SGIPOS 3 at [32] – [38]

<sup>23</sup> Upheld on appeal by the High Court in *Polo/Lauren Co LP v United States Polo Association* [2016] SGHC 32

It is not necessary for trade marks to be owned by the same legal entity in order to be protected as a family of marks. It is possible for corporate family members to be regarded as a single source.

- [Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited](#) [2018] SGIPOS 5 at [33]

Can the family of marks doctrine be taken into account at the marks-similarity stage? Or, is this a consideration that should be left for the likelihood of confusion stage? Previously, the position appeared to be not settled. However, please see JC Goh Yihan's decision in [V V Technology Pte Ltd v Twitter, Inc](#) [2022] SGHC 293.

- [Monster Energy Company v Glamco Co., Ltd](#) [2018] SGIPOS 7

A line of argument was canvassed that the use of a proprietor's "family of marks" gives rise to an enhanced distinctiveness of its marks. On the facts, the "family of marks" argument used this way did not help the proprietor establish acquired distinctiveness for its descriptive mark. It cannot be the case that adding distinctive matter to a descriptive or generic word and thereby forming a composite mark that may be registered as a trade mark (as the combination is not devoid of distinctive character, exclusively descriptive and/or generic) can support an argument that the descriptive word is registrable on its own.

- [Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.](#) [2018] SGIPOS 20 at [51] – [53]

Although *obiter*, the Hearing Officer in the following case made two observations in relation to claims involving a family of marks. The first is that such a claim must be expressly pleaded in the pleadings. The second is that the marks in the alleged family of marks must be registered (unless they are shown to be well known trade marks in Singapore) before the tribunal may consider the family of marks claim.

- [Intuit Inc. v Minterest Private Limited](#) [2019] SGIPOS 16 at [49] – [52]

## 9.8 Relevance of colour to the assessment for marks similarity

Where the competing marks are both in colour, colour is a relevant consideration in assessing visual similarity. Indeed, the differences in colour may lead to a finding of dissimilarity.

- [Apptitude Pte Ltd v MGG Software Pte Ltd](#) [2016] SGIPOS 15 at [27]

However, where the application mark is depicted in black and white, colour is a neutral factor. It does not influence the marks similarity assessment either way.


- [Starbucks Corporation d/b/a Starbucks Coffee Company v Morinaga Nyugyo Kabushiki Kaisha \(Morinaga Milk Industry Co., Ltd\)](#) [2017] SGIPOS 18 at [37].

Similarly, where the application mark is in colour and the earlier mark is in black and white, the colour of the application mark is also irrelevant.

- [Fox Head, Inc. v Fox Street Wear Pte Ltd](#) [2018] SGIPOS 8 at [56]

### 9.9 Whether a mark registered in Chinese characters is similar to its transliteration

In the highly unusual case of “XIAO FEI YANG” (full citation below), Inner Mongolia Little Sheep Catering Chain Co succeeded in invalidating the Grassland Xiao Fei Yang Pte Ltd’s trade mark “XIAO FEI YANG” in Class 43 (for restaurant services) on grounds of bad faith. Although the decision on bad faith made it unnecessary to deal with the other issues in dispute, the Hearing Officer made a number of observations on the issue of







whether an earlier trade mark registered in Chinese characters (  ) is similar to a later trade mark that is essentially its transliteration (XIAO FEI YANG). It appears that this tribunal has not previously considered this issue. An outline of the Hearing Officer’s observations is set out below.

- On visual similarity: Chinese characters are by nature different from letters in the English alphabet. Naturally it follows that in almost all cases the competing marks would be found to be visually dissimilar. So too in this case. If it had been necessary to decide the issue, the marks would have been found to be visually dissimilar. However, the mere fact that Chinese characters are different from their transliteration does not, without more, bar a finding of similarity of marks. This is because one must also take into account the aural and conceptual similarities.
- On aural similarity: The whole purpose of transliteration is to enable, with some degree of aural precision, words in one language to be represented in another. In this case the marks could be considered aurally similar to a significant degree.
- On conceptual similarity: In this case, there would be a slight degree of conceptual similarity in that both of them point to the same meaning, which is little fat sheep. However, everything turns on the specific context and in particular the words and characters at issue (and so it follows that the position may be different where there are other characters involved).

➤ [Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd.](#) [2018] SGIPOS 6

### 9.10 Word mark X vs device containing or comprising representation of X

To what extent does a trade mark registration for a word protect a device representation thereof? How would one compare the similarity of marks in such cases? In the following case, the competing marks were:

Application Marks	Earlier Marks
<p>1.  LNK Brand</p> <p>2.  LNK Brand</p> <p>1.  LNK Coatings</p> <p>2.  LNK Coatings</p>	<p>1. TIGER</p> <p>2. TIGER DRYLAC</p> <p>3. </p> <p>(collectively the “Non-Pictorial Marks”)</p> <hr/> <p></p> <p>(the “Cartoon Tiger Mark”)</p>

An important issue which the IP Adjudicator had to decide was whether the competing marks were similar notwithstanding that the application marks did not contain the word “TIGER”. Ultimately, the IP Adjudicator found the competing marks to be visually, aurally and conceptually dissimilar. Nevertheless, he discussed and left open the possibility that in some *other case* there could be conceptual similarity between a word mark and device representation thereof.

➤ [Tiger Coatings GmbH & Co. KG v Seng Fong Paints Pte Ltd](#) [2019] SGIPOS 10 at [72] – [81]

### 9.11 Inherent distinctiveness of full (personal) names

In the following case, the competing marks were “WONGLO” (the application mark) and “WONG LO KAT” (the earlier registered mark relied on by the opponent).

The applicant acknowledged that “WONG LO KAT” was a reference to Mr Wong Chak Bong’s “王老吉” (pronounced: “Wang Lao Ji” in Mandarin and “Wong Lo Kat” in Cantonese) herbal tea. However, it contended that personal names are not particularly distinctive and hence would not serve as a strong badge of origin.

The Hearing Officer disagreed and expressed the view that personal full names (i.e. a personal name plus a surname) are better able to distinguish goods and services as compared to a personal name (by itself) or only a surname (by itself). Therefore, personal full names, when used as trade marks, will automatically imbue the mark with the capacity to distinguish, subject to whether the full name is deemed extremely common or whether it is used in a trade where there is a large number of traders.

➤ [Multi Access Limited v Guangzhou Pharmaceutical Holdings Limited](#) [2019] SGIPOS 15<sup>24</sup>

### 9.12 Collective marks

The following case is the first in Singapore involving an opposition to an application for a collective mark. Unlike a trade mark, which serves to identify a specific trader as the source of goods (or services), a collective mark can be used by any member of an

<sup>24</sup> Upheld on appeal by the High Court. No written grounds of decision were issued.



association designated by the collective mark. The opposed collective mark, "BAVARIAN BEER", was sought to be registered for "beers" in Class 32 by the applicant, Bayerischer Brauerbund, an umbrella association for the Bavarian brewing industry in the German Federal State of Bavaria formed in 1880. The opponent, Bavaria N.V., has brewed beer under the name "Bavaria" in Netherlands since 1930. The following trade marks were relied on as earlier marks by the opponent:

- (a) "BAVARIA HOLLAND BEER", registered for beer in Class 32



- (b) \_\_\_\_\_, registered for beer (among other things) in Class 32



- (c) \_\_\_\_\_, registered for beer (among other things) in Class 32.  
(This mark was referred to in the decision as the "Earlier Blue Label Mark")

The opponent raised the following grounds of opposition: (i) confusing similarity under s 8(2)(b); (ii) passing off under s 8(7)(a); well-known trade marks under s 8(4)(b)(i) and 8(4)(b)(ii).

In addition to the above grounds, the opponent raised Paragraph 4 of the First Schedule (of the Trade Marks Act) as a ground of objection to the application. The provisions in the First Schedule set out additional requirements which a collective mark must comply with, beyond the requirements applicable to trade marks. Para 4(1) provides that a collective mark "*shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark*". Para 4(2) states that the Registrar "*may accordingly require that a mark... include some indication that it is a collective mark*". One of the opponent's arguments was that having regard to its earlier registered trade marks (above), the public would be misled into believing that the "BAVARIAN BEER" application was for a trade mark rather than a collective mark.

After hearing arguments, the Hearing Officer decided to exercise the Registrar's discretion under Para 4(2) of the First Schedule to require that the application mark include an indication that it is a collective mark. Consequently, the application was amended to include the words "Collective Mark" below the words "BAVARIAN BEER", which had the effect of addressing the objection.

In the result, the opposition was allowed under ss 8(2)(b) and 8(7)(a) on account of the fact that the application conflicted with the Earlier Blue Label Mark. (The Hearing Officer did not find the application mark to be similar to the other two earlier marks relied upon by the opponent.)

- [Bavaria N.V. v Bayerischer Brauerbund e.V.](#) [2019] SGIPOS 17 <sup>25</sup>

### 9.13 Can strong reputation point away from a likelihood of confusion?

Yes. A strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect: see *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65 at [96(a)], considered and applied in the following case.

- [Warrior Pte Ltd v Nippon Paint \(Singapore\) Co. Pte. Ltd.](#) [2021] SGIPOS 7 at [73]-[74]<sup>26</sup>

However, a strong reputation may increase the likelihood of confusion that consumers may perceive an economic link between the two marks.

- [Twitter, Inc. v V V Technology Pte Ltd](#) [2022] SGIPOS 4 at [129]-[134] (upheld on appeal by the General Division of the High Court: see [2022] SGHC 293 at [192]-[201])

## (10) Use of sign prohibited by law

### Observation

Section 7(5) TMA states that “A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law”. This ground was relied on as a ground of opposition in the following two cases.

- [Scotch Whisky Association v Isetan Mitsukoshi Ltd](#) [2019] SGIPOS 4 where the “written law or rule of law” relied on was ss 3(2)(a), 3(2)(b) and 3(2)(d) of the Geographical Indications Act 1998 (Cap. 117B, 1999 Rev Ed) as well as s 7(7) TMA. This ground of opposition was unsuccessful. On appeal (see: [2019] SGHC 200), although the court overruled the first instance IPOS decision in relation to a different ground of opposition (namely: s 7(4)(b) TMA), it upheld the first instance ruling on s 7(5) TMA.
- [Harvard Club of Singapore v President and Fellows of Harvard College](#) [2019] SGIPOS 14,<sup>27</sup> where the “written law or rule of law” relied on was s 4(3) of the Societies Act (Cap. 311, Rev Ed 2014). In refusing this ground of opposition, the Hearing Officer observed, among other things, that the societies register and the trade mark register are wholly different regimes and that it would be against public policy to permit a registration on the registry of societies (or by extension the companies register) to block a trade mark registration or vice-versa. If it had been Parliament’s intention for that to happen, it would have been made express. In any case, the Registrar of Trade Marks does not conduct prior searches on the societies register.

<sup>25</sup> Appeal to the High Court pending.

<sup>26</sup> Appeal to the General Division of the High Court dismissed without written grounds of decision.

<sup>27</sup> The decision was upheld on appeal: see *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] SGHC 77.

## (11) Evidence relating to copyright

### Subsistence of copyright: evidence

An opponent seeking to rely on copyright as a ground of opposition (under Section 8(7)(b) TMA) must show that copyright subsists in the claimed work.

A copyright certificate from another jurisdiction, without more, is insufficient to establish subsistence of copyright.

➤ [Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd](#) [2014] SGIPOS 10 at [238] – [243]<sup>28</sup>

➤ [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [110] – [123]

Note: The High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 has held that the presumptions relating to subsistence and ownership of copyright in Section 130 of the Copyright Act (Cap. 63) are a relevant factor to be taken into account in considering an opposition under Section 8(7)(b) TMA.<sup>29</sup>

## (12) Evidence relating to trade mark use

### Observation

The concept of ‘trade mark use’ arises not infrequently in trade mark disputes before IPOS.

The issue of whether a trade mark has been used, and if so, the nature and extent of its use, may be relevant to one or more of the following. (The list is non-exhaustive.)

- Non-use revocation (under Section 22(1)(a) and/or (b) TMA) and in particular the issue of whether there has been genuine use of a trade mark, in the course of trade, in respect of the goods or services for which it is registered.
- Whether a trade mark has, in consequence of the use which has been made of it, acquired a distinctive character in relation to the goods or services for which it is registered (which may be relevant to cases involving Section 7(2) and/or 23(2) TMA).
- Whether a trade mark is well known in Singapore (see: Section 2(7)(b) TMA<sup>30</sup>).

<sup>28</sup> On appeal, George Wei J agreed with this specific point, stating that “*the mere fact that copyright has been claimed and registered for [the works in question] in the USA and China does not mean that copyright does in fact and law subsist [in the said works] in Singapore*”. However, His Honour went to add that: “*While copyright registration certificates from other jurisdictions may have persuasive value if evidence is adduced on the process undertaken to obtain such registration, the issue at hand is ultimately whether [the opponent] will be able to establish that it owns copyright [in the works] in Singapore in notional copyright infringement proceedings*”: see [2015] SGHC 216 at [235].

<sup>29</sup> See in particular [223]. This was an appeal from the decision of the Hearing Officer in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10.

<sup>30</sup> Section 2(7)(b) provides that in deciding whether a trade mark is well known in Singapore, one relevant factor that may be taken into account is: “*the duration, extent and geographical area of – (i) any use of the trade mark; or (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied*”.

In certain cases, a trader may enjoy commercial success under a trade mark to such a degree that others may use the trade mark to refer to a characteristic of the goods (or in some other descriptive sense). Whether this has an impact on the issue of trade mark use will depend on the evidence.<sup>31</sup>

In the following case, an issue arose as to the requisite nexus between Singapore and the evidence of use required to defeat a non-use revocation action. Specifically, must the evidence show that the mark was applied to goods that were advertised and sold to consumers in Singapore? Or is it sufficient to show evidence of *entrepôt* trade conducted under the mark in question, never mind the issue of whether the goods were exposed to consumers in Singapore? Although the Hearing Officer was not required to decide an issue, he set out the arguments on both sides and proffered some observations.

- [FMTM Distribution Ltd v. Tan Jee Liang Trading as Yong Yew Trading Company](#) [2017] SGIPOS 9 at [137] – [151]

For another interesting case discussing trade mark use in the context of trade mark revocation, please see: [Technopharma Limited v Unilever PLC](#) [2021] SGIPOS 11

### 12.1 Distinction drawn between use in relation to goods as opposed to services

In the following non-use revocation case, the subject trade marks were registered for “Retail services, including retail of automotive parts”. The proprietor of the impugned marks argued that the actual supply of goods, listed on its website, to a Singapore delivery address, meant that retail services had been provided. The Hearing Officer did not accept this argument, and held that the fact that goods were ordered and delivered in Singapore did not equate to retail services being provided in Singapore. (On the facts, the action for non-use revocation succeeded.)

- [Autozone Automotive Enterprise v Autozone Parts, Inc.](#) [2013] SGIPOS 1 at [37] – [49]

### 12.2 Trade marks on the internet

As a general rule, the mere existence of a domain name (e.g. where the trade mark in question is a word mark used as part of a domain name) or a website featuring a trade mark does not, without more, translate into worldwide recognition.<sup>32</sup>

A website, in and of itself, is irrelevant to the consideration of whether the mark is well known in Singapore as websites, unless blocked by governments, are inevitably accessible by Internet users.

- [Alphasonics \(Pte\) Ltd v Alphasonics \(Ultra Cleaning Systems\) Ltd](#) [2013] SGIPOS 6 at [35(h)]

Equally, it is not enough to simply place a mark on the internet and then argue that the requirement of use is satisfied when someone within Singapore downloads it.

<sup>31</sup> See *FMTM Distribution v Van Cleef & Arpels* [2017] SGIPOS 6, where the applicant for non-use revocation argued that “MYSTERY SET” was descriptive of a certain technique of gem setting in the context of jewellery rather than an indicator of origin.

<sup>32</sup> *Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 at [52] – [54].

To satisfy the requirement of proving trade mark use, it must be shown that there was an 'active step' (e.g. through direct encouragement or advertisement) by the proprietor in Singapore which led the consumers to the website featuring the trade mark in question.<sup>33</sup>

The above principles have been applied in cases such as the following.

- [Autozone Automotive Enterprise v Autozone Parts, Inc.](#) [2013] SGIPOS 1 at [47] – [53]
- [Romanson Co. Ltd. v Festina Lotus, S.A.](#) [2015] SGIPOS 3<sup>34</sup> at [81] – [93] and [107]

In a non-use revocation action under Section 22(1)(a) and/or (b) TMA, the Registrar may recognise online, post-sale support in the form of upgrades and updates of computer software as evidence of use in relation to computer software, independently of any new sales of the computer software. However, the application of this would turn on the unique facts of each case.

- [Bigfoot Internet Ventures Pte. Ltd. v Apple Inc.](#) [2017] SGIPOS 4 at [37]

In defending non-use revocation actions, proprietors should ensure that their evidence of use adduced falls within the relevant 5-year period. In the case of internet printouts, the date of the document usually reflected is the date of printing, which post-dates the relevant 5-year period. One useful tool is the Wayback Machine (wayback.com), a digital archive which enables users to see archived versions of webpages over time.

- [Bigfoot Internet Ventures Pte. Ltd. v Athleta \(ITM\) Inc.](#) [2018] SGIPOS 10 at [30]

It is not tenable to claim that, just because a website's url, e.g. <http://athleta.gap.com>, has been stated in evidence, and specific printouts from the same website have been adduced in evidence, the website *as a whole* had therefore been adduced in evidence. If a party desires to rely on specific content on a webpage from a website, it has to adduce that very webpage in evidence. In this case, the proprietors sought to address a gap in evidence in response to the applicants' argument that there was no evidence of use relating to "footwear", not by seeking leave to file further evidence, but by appending website printouts to their reply submissions and claiming that this was acceptable as their website as a whole had already been adduced in evidence.

- [Bigfoot Internet Ventures Pte. Ltd. v Athleta \(ITM\) Inc.](#) [2018] SGIPOS 10 at [32]

### 12.3 Arriving at a fair specification

In a non-use revocation action under Section 22(1)(a) and/or (b) TMA, the Registrar will first decide whether the subject mark has been put to genuine use in relation to the goods/services for which it is registered. After reaching a conclusion on that point, if the finding is that there has been use in respect of some but not all of the goods/services, the Registrar will then go on to decide what constitutes a fair specification for the use made. In so doing, the Registrar must consider how the average consumer would likely describe the goods. This also means that the specification does not need to be limited

<sup>33</sup> *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [106] – [108].

<sup>34</sup> The unsuccessful party appealed to the High Court, but the appeal was not contested. In the result, the Registrar's decision was reversed. The High Court's written grounds of decision are not available.

to the precise goods that the mark has been used for, but should also extend to those which the average consumer considers as belonging to the same subcategory.

- [Audi AG v Lim Ching Kwang](#) [2017] SGIPOS 2 at [17], [44] and [45]

For a case involving the application of the above principles and where partial revocation was ordered after an assessment of what constitutes a fair specification, please see:

- [New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited](#) [2017] SGIPOS 16 at [53] – [71]

#### **12.4 Use in a form differing in elements which do not alter the distinctive character of the registered mark**

In defending a non-use revocation action under Section 22(1)(a) and/or (b) TMA, it is possible for a proprietor to rely on Section 22(2) in that the use of the mark includes “*use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.*”

For some cases involving the consideration of the above provision, please see:

- [The Patissier LLP v Aalst Chocolate Pte Ltd](#) [2019] SGIPOS 6 at [23] – [59]
- [Aussino International Pte Ltd v Aussino \(USA\) Inc.](#) [2019] SGIPOS 18 at [50] – [66]
- [Technopharma Limited v Unilever PLC](#) [2021] SGIPOS 11 at [27] – [62], [104] – [118]

### **(13) Evidence required to prove that a mark is well known to the public at large**

#### Observation

A claim that a mark is well known to the public at large must be supported by the evidence. To date, very few marks have crossed this threshold.

In the two cases below, the Hearing Officer found that the subject mark in question was well known to the public at large. These cases are illustrative of the type, nature, and extent of the evidence required to support such a claim.

- SEIKO (see [Seiko Holdings Kabushiki Kaisha \(trading as Seiko Holdings Corporation\) v Choice Fortune Holdings Limited](#) [2014] SGIPOS 8)

It is interesting to note that in an earlier decision (see [2011] SGIPOS 3), it was found, on the basis of the evidence in that case, that SEIKO was not well known to the public at large. However, in this case, the Hearing Officer was prepared, on the evidence, to make such a finding (see [107]).

- INTEL (see [Intel Corporation v Intelsteer Pte Ltd](#) [2015] SGIPOS 2)

In this case, the Hearing Officer found that the INTEL mark was well known to the public at large. In arriving at that conclusion, the Hearing Officer was mindful that a mark must be recognised by most sectors of the public (i.e. it is not enough to show that a mark is well known to a certain sector of the public). However, given that in this day and age a computer is an indispensable tool in both the business world as well as the normal household, it would be hard to miss INTEL, which is one of the largest makers of computer microprocessors (see [147]).

For an example of a case where the earlier trade mark was found to be well known to the public at large, see:

- GUCCI ([Guccio Gucci S.p.A v Guccitech Industries \(Private Ltd\)](#) [2018] SGIPOS 1)

## (14) Evidence concerning the state of the Register

### Observation

At times, a party entreats the Registrar to take the state of the Trade Marks Register into consideration in the assessment of whether a certain mark is registrable. Usually the argument goes like this: if XX trade mark has been registered for certain goods or services; YY trade mark (bearing similar characteristics) for identical or similar goods or services should likewise be registrable.

In the following *ex parte* application, the Hearing Officer declined to take into account the state of the Register and considered the “*registrations of various vintage*” cited to her as being not of assistance. In so doing, the Hearing Officer restated the long-standing principle that “*although conformity of the register is desirable, registry decisions in the past can do no more than give an indication of what has or has not been acceptable, and the registrability of a mark has to be considered on the facts of each case and in particular the goods or services in respect of which registration is sought*”.

- [In the matter of a trade mark application by Marvelous AQL Inc.](#) [2017] SGIPOS 3<sup>35</sup> at [44] – [46]<sup>36</sup>

However, the state of the register can be considered when assessing whether a particular mark or word is distinctive. In the following opposition, when assessing whether the word “FALCON” is inherently technically distinctive of certain goods and services, the Hearing Officer took into account the fact that numerous marks consisting of, or containing, the word “FALCON” had been registered or applied for by a large number of unrelated traders in the relevant classes.

- [Fair Isaac Corporation v LAC Co., Ltd.](#) [2022] SGIPOS 19 at [55]–[74]

<sup>35</sup> Note: the decision was affirmed on appeal by the High Court.

<sup>36</sup> Citing *Kudos Trade Mark* [1995] RPC 242 at 245 and *British Sugar PLC v James Robertson & Sons Ltd.* [1996] RPC 281 at 305.

## (15) Honest concurrent use

**Can an opponent rely on an earlier trade mark secured on the basis of honest concurrent use with the applicant's other trade marks?**

Yes. See:

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [55] – [59]

See also:

- [Fox Head, Inc. v Fox Street Wear Pte Ltd](#) [2018] SGIPOS 8

## (16) Effect of disclaimers

**Do disclaimers apply to registration / opposition proceedings?**

Yes, disclaimers apply not only to infringement proceedings but also to opposition proceedings.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [62]

In the following case, a disclaimer was entered shortly after the pre-hearing review. The Hearing Officer noted, among other things, that Section 30 TMA suggests that it is possible to request for a disclaimer at any stage of the registration process.

- [Consolidated Artists B.V. v THEFACESHOP Co. Ltd.](#) [2017] SGIPOS 7

## (17) Survey evidence

### Observation

Market survey evidence can be of assistance to the Court or Tribunal in a trade mark dispute. However, it is important that the survey is structured carefully. For guidance on structuring surveys, see, for example, *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 and *Société des Produits Nestlé SA and anor v Petra Foods Ltd and anor* [2014] SGHC 252.

In the following case heard at IPOS, market survey evidence was tendered by the trade mark proprietor defending a trade mark invalidation action with a view to: (1) showing that the registered mark, BIG BOX, was not generic (in the sense of being customary in the current language in Singapore to designate a large retail establishment); and (2) establishing that *even if* BIG BOX was generic at the relevant date it had acquired distinctiveness through use.

- [Courts \(Singapore\) Pte Ltd v Big Box Corporation Pte Ltd](#) [2017] SGIPOS 5<sup>37</sup>

<sup>37</sup> Note: the decision was upheld by the High Court.



Given the IP Adjudicator's conclusion in BIG BOX (i.e. that the invalidation attack based on Sections 7(1)(b), (c) and (d) TMA failed), nothing ultimately turned on the market survey evidence.

Nevertheless, the IP Adjudicator expressed the concern that parties to such proceedings at IPOS may spend large sums on adducing evidence that is of little or no probative value. He cautioned that while there remains a role for market survey evidence if that is the only sufficient evidence that can be obtained, very careful consideration needs to be given to the form of the questions and the process for administering them, and recording accurately and fully the responses, so as to ensure that the evidence goes to the factual questions in support of which it is intended it be adduced.

In the following case, survey evidence was adduced by the trade mark applicant with a view to proving, among other things, that the application for the 3-dimensional shape




mark had acquired distinctiveness through use. (In the real world, when the application mark is used, it is accompanied by the word mark "FERRERO ROCHER".) After considering the survey evidence, the IP Adjudicator found flaws with the methodology of the survey and went on to say that even if one takes the results at face value, it failed to show that the application mark functions as an indication of trade origin absent the distinctive word mark "FERRERO ROCHER".

- [In the matter of a trade mark application by Ferrero S.p.A.](#) [2019] SGIPOS 19

## (18) Marks in a language other than English

### Observation

Given Singapore's multi-racial and multi-lingual population, it is not uncommon for traders to file for trade marks that are (or contain elements) in a language other than English.

One such example (a case in which ) was invalidated on the basis that it had been registered in bad faith) is discussed at point 8.9 above under the heading "Whether a mark registered in Chinese characters is similar to its transliteration".

For another case involving a trade mark with elements in Chinese characters, see the decision below, which involved the  mark (the Chinese characters read: "柏·伟诗酒店", which may be transliterated as "Bai Wei Shi Jiu Dian").

- [Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Ltd](#) [2018] SGIPOS 11<sup>38</sup>

<sup>38</sup> Note: the decision was upheld by the High Court.

For a case involving a French word, see the decision below, which involved the

*The Pâtissier*

mark and set out the approach to assessing whether marks with non-English word elements were descriptive and/or devoid of any distinctive character.

- [Aalst Chocolate Pte Ltd v The Pâtissier LLP](#) [2019] SGIPOS 7 at [42] – [73]

## (19) Geographical Indications

### Observation

Section 7(7) TMA provides, in material part, that:

*“... a trade mark shall not be registered if it contains or consists of a geographical indication in respect of a wine or spirit and the trade mark is used or intended to be used in relation to a wine or spirit not originating from the place indicated in the geographical indication.”*

In the following case, the above provision was raised as a ground of opposition against

**CHAMPENGWINE**  
UNIQUE, BOUTIQUE, SPARKLING WINES OF CHILE

an application to register for “Sparkling wines, all originating from Chile” in Class 33.

- [Comité Interprofessionnel du Vin de Champagne and Institut National de l’Origine et de la Qualité v Keep Waddling International Pte. Ltd](#) [2020] SGIPOS 10

Among other things, the Hearing Officer in the above case had to consider whether the mark “contains or consists of a geographical indication” within the meaning of s 3(4) of the Geographical Indications Act and s 7(7) of the Trade Marks Act.

In his view, the relevant component of the trade mark must: (a) reproduce, without any modification or addition, all the elements constituting the geographical indication; or (b) viewed as a whole, contain differences so insignificant that they may go unnoticed by an average consumer (see [43] – [63] of the decision).

[End of Document]

## ANNEX A: CHANGE LOG

**Note:** The following is a brief list of the changes made to the Case Guide since its inception.

- 17 January 2017: Publication of 1<sup>st</sup> Edition of Case Guide.
- 26 January 2017: Fixed some typographical errors and incorrect references.
- 28 June 2017: Added new cases, commentary, and a new category: 'Survey evidence'
  - *In the matter of a trade mark application by Marvelous AQL Inc.* [2017] SGIPOS 3
  - *Bigfoot Internet Ventures Pte. Ltd. v Apple Inc.* [2017] SGIPOS 4
  - *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2017] SGIPOS 5
  - *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30
- January 2018: Added the following new categories, with commentary: 'The importance of preparing evidence by reference to the grounds in dispute'; 'Effective date of revocation for non-use'; 'Documents used to challenge witness testimony during cross-examination'; 'Deceptive trade marks'; and 'Relevance of colour to the assessment for marks similarity'. Also added the following new cases.
  - *FMTM Distribution v Van Cleef & Arpels* [2017] SGIPOS 6
  - *Consolidated Artists B.V. v THEFACESHOP Co. Ltd.* [2017] SGIPOS 7
  - *Louis Dreyfus Commodities MEA Trading DMCC v Orco International (S) Pte Ltd* [2017] SGIPOS 8
  - *FMTM Distribution Ltd v. Tan Jee Liang Trading as Yong Yew Trading Company* [2017] SGIPOS 9
  - *U-Manga International Business Co., Ltd. v Nunufish.com* [2017] SGIPOS 11
  - *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12
  - *New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited* [2017] SGIPOS 16
  - *Starbucks Corporation d/b/a Starbucks Coffee Company v Morinaga Nyugyo Kabushiki Kaisha (Morinaga Milk Industry Co., Ltd)* [2017] SGIPOS 18
- 26 April 2018: Deleted category 'Whether certain goods can be similar to certain services?'
- 9 July 2018: Added new commentary as well as the following new categories: 'Costs in partial revocation cases'; 'Whether a mark registered in Chinese characters is similar to its transliteration'. Also added the following new cases.
  - *Guccio Gucci S.p.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1
  - *USA Pro IP Limited v Montfort Services Sdn. Bhd.* [2018] SGIPOS 3
  - *Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd.* [2018] SGIPOS 6
  - *Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5
  - *Monster Energy Company v Glamco Co., Ltd* [2018] SGIPOS 7
  - *Fox Head, Inc. v Fox Street Wear Pte Ltd* [2018] SGIPOS 8
  - *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9
  - *Bigfoot Internet Ventures Pte. Ltd. v Athleta (ITM) Inc.* [2018] SGIPOS 10
- 22 January 2019: Added new commentary, categories, and references to the following cases.
  - *Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Ltd* [2018] SGIPOS 11
  - *Adidas International Marketing BV v Lutong Enterprise Corp.* [2018] SGIPOS 12
  - *Apple Inc. v Swatch AG (Swatch SA) (Swatch Ltd.)* [2018] SGIPOS 15
  - *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16
  - *Daidoh Limited v New Yorker S.H.K. Jeans GmbH & Co. KG* [2018] SGIPOS 18
  - *United U-Li Projects Pte Ltd v Tan Buck Hai* [2018] SGIPOS 19
  - *Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.* [2018] SGIPOS 20
  - *Bitwave Pte Ltd v Fung Shing Company Limited* [2018] SGIPOS 21
- 12 July 2019: Added new commentary and the following new categories: 'Relevant date for assessing descriptiveness/distinctiveness in cases involving subsequent designation of an international registration in Singapore'; 'Is it possible to obtain confidentiality safeguards in relation to trade marks proceedings before the Registrar?'; 'Does the Riddick principle apply to proceedings before IPOS?'; 'Word mark X vs device containing or comprising representation

of X'; and 'Use in a form differing in elements which do not alter the distinctive character of the registered mark'. Also added references to the following cases:

- *Mahendra Naidu A/L R. Manogaran trading as Sri Sai Traders v Navin Trading Pte Ltd* [2019] SGIPOS 2
- *The Patisserie LLP v Aalst Chocolate Pte Ltd* [2019] SGIPOS 6
- *Aalst Chocolate Pte Ltd v The Patisserie LLP* [2019] SGIPOS 7
- *Application for confidentiality safeguards by TWG Tea Company and objection thereto by T2 Singapore & Tea Too* [2019] SGIPOS 9
- *Tiger Coatings GmbH & Co. KG v Seng Fong Paints Pte Ltd* [2019] SGIPOS 10
- *Abbott Laboratories v Société des Produits Nestlé S.A.* [2019] SGIPOS 11
- 29 January 2020: Added new commentary and the following new categories: 'Inherent distinctiveness of full (personal) names'; 'Collective marks' and 'Use of sign prohibited by law'. Also added references to the following cases:
  - *Harvard Club of Singapore v President and Fellows of Harvard College* [2019] SGIPOS 14
  - *Multi Access Limited v Guangzhou Pharmaceutical Holdings Limited* [2019] SGIPOS 15
  - *Intuit Inc. v Minterest Private Limited* [2019] SGIPOS 16
  - *Bavaria N.V. v Bayerischer Brauerbund e.V.* [2019] SGIPOS 17
  - *Aussino International Pte Ltd v Aussino (USA) Inc.* [2019] SGIPOS 18
  - *In the matter of a trade mark application by Ferrero S.p.A.* [2019] SGIPOS 19
- 9 February 2021: Added new categories: "Possible consequences of not filing Form HC1"; and "Geographical Indications". Also added references to the following cases:
  - *Seek Limited v Seek Asia Pte Ltd* [2020] SGIPOS 2
  - *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11
  - *Comité Interprofessionnel du Vin de Champagne and Institut National de l'Origine et de la Qualité v Keep Waddling International Pte. Ltd.* [2020] SGIPOS 10
- 6 January 2022: Added new categories: "Can strong reputation point away from a likelihood of confusion?" and "Failure to disclose meaning of word in foreign language to the Registrar". Also added new commentary and references to the following cases:
  - *Application for Extension of Time to File Evidence in a Trade Mark Opposition by BEABA and Objection Thereto by Biba (Zhejiang) Nursing Products Co., Ltd* [2021] SGIPOS 1
  - *B.R. v Elements Cosmeceuticals Pte. Ltd.* [2021] SGIPOS 3
  - *Application for Extension of Time to File Evidence in a Trade Mark Revocation by Symphony Holdings Limited and Objection Thereto by Skins IP Limited* [2021] SGIPOS 5
  - *GCIH Trademarks Limited v Hardwood Private Limited* [2021] SGIPOS 6
  - *Warrior Pte Ltd v Nippon Paint (Singapore) Co. Pte. Ltd.* [2021] SGIPOS 7
  - *Combe International Ltd. v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2021] SGIPOS 10
  - *Technopharma Limited v Unilever PLC* [2021] SGIPOS 11
  - *Shenzhen Meixixi Catering Management Co., Ltd. v Heetea Pte. Ltd.* [2021] SGIPOS 12
  - *Louis Vuitton Malletier v Human Horizons Holding (Shanghai) Co., Ltd.* [2021] SGIPOS 13
  - *Monster Energy Company v Health and Happiness (H&H) Hong Kong Limited* [2021] SGIPOS 14

Removed references to the following cases:

- *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12
- *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16
- 6 January 2023: Added new category 9.2A "Marks-similarity analysis when later mark wholly incorporates earlier mark", as well as commentary/references to the following cases.
  - *Hotel Cipriani S.P.A. v Altunis - Trading, Gestão E Serviços, Sociedade Unipessoal, LDA* [2022] SGIPOS 3
  - *GCIH Trademarks Limited v Hardwood Private Limited* [2022] SGIPOS 14
  - *Pauline New Ping Ping v Eng's Char Siew Wantan Mee Pte. Ltd.* [2022] SGIPOS 10
  - *Twitter, Inc. v V V Technology Pte Ltd* [2022] SGIPOS 4
  - *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293
  - *Fair Isaac Corporation v LAC Co., Ltd.* [2022] SGIPOS 19