

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF THE  
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE**

**[2022] SGIPOS 19**

Trade Mark No. 40202003885Q

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**LAC CO., LTD.**

*... Applicant*

**AND OPPOSITION THERETO BY**

**FAIR ISAAC CORPORATION**

*... Opponent*

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**GROUNDS OF DECISION**

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**Fair Isaac Corporation**  
**v**  
**LAC Co., Ltd.**

**[2022] SGIPOS 19**

Trade Mark No. 40202003885Q  
Principal Assistant Registrar Mark Lim  
27 October 2022

29 December 2022

**Principal Assistant Registrar Mark Lim:**

**Introduction**

1 Several Singapore cases concern a situation where a later trade mark wholly incorporates an earlier trade mark. What principles apply to determine whether the later trade mark is similar to the earlier trade mark?

2 Where, as here, it is argued that the earlier trade mark is not inherently technically distinctive given that there are many other trade marks on the register which are identical to or incorporate the earlier trade mark, can the state of the register be relied on as evidence? And, if so, to what extent?

**Chronology of Proceedings**

3 On 21 February 2020 (the “**Relevant Date**”), LAC Co., Ltd. (the “**Applicant**”) applied to register “**CloudFalcon**” (the “**Application Mark**”) in respect of the following goods and services:

Class 9	Game programs for arcade video game machines; photographic machines and apparatus; cinematographic machines and apparatus; optical machines and apparatus; measuring or testing machines and instruments; telecommunication machines and apparatus; personal digital assistants in the shape of a watch; smartphones; electronic equipment, apparatus and their parts; electron tubes; semiconductor elements; electronic circuits, not including those recorded with computer programs; computer programs; data carriers recorded with computer programs; computers and their peripherals; computer servers; computer software; game programs for home video game machines; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; phonograph records; downloadable music files; downloadable image files; recorded video discs and video tapes; exposed cinematographic films; exposed slide films; slide film mounts; electronic publications; all the aforesaid goods being used in the field of computer network security.
Class 35	Advertising and publicity services; business management analysis or business consultancy; marketing research or analysis; providing information concerning commercial sales; business management of hotels; collection, management, research, analysis and evaluation of business information; employment agency services; filing of documents or magnetic tapes [office functions]; filing of electronic data [office functions]; compilation of information into computer databases; updating and maintenance of data in computer databases; providing business assistance to others in the operation of data processing apparatus namely, computers, typewriters, telex machines and other similar office machines; business administration for operating computer, computer system and computer controllable apparatus; business administration for operating apparatus for Internet access; business administration for operating security surveillance equipment; business administration for operating server computers; publicity material rental; rental of advertising space on the Internet.
Class 42	Designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; design services; computer software design, computer programming, or maintenance of computer software; monitoring of computer systems for detecting unauthorized access or data breach by computer programs; provision of technical information and support information in relation to computers, computer systems, computer networks and computer software; research, analysis, calibration and evaluation of computers, computer systems, computer networks and computer software; monitoring of computers, computer systems, computer networks and computer software by remote access; detection of abnormality on computer networks; computer security consultancy; information technology [IT] consultancy; research, analysis and evaluation of technical information; technological advice relating to computers,

	automobiles and industrial machines; technological advice relating to computer programs; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing or research on information and communications technology; research or development of data processing technology and information and communications technology; testing, research, or development on computer programs and computer software; testing or research on telecommunication network systems; rental of computers; providing computer programs on data networks; rental of data carriers recorded with computer programs; rental of web servers; software as a service [SaaS]; cloud computing; rental of computer software; providing Internet security programs.
Class 45	Providing information on agencies for procedures relating to industrial property rights; providing information on agencies for legal procedures relating to lawsuits or other legal issues; providing information on agencies for judicial registration or deposits; security guarding for facilities; personal body guarding; investigation or surveillance on background profiles.

4 The Application Mark was published for opposition purposes on 18 September 2020.

5 Fair Isaac Corporation (the “**Opponent**”) filed its Notice of Opposition on 18 January 2021, and subsequently amended it on 8 August 2022 (“**NO**”). It relies on its prior registrations for “**FALCON**” (the “**Opponent’s Mark**”), which is registered for the following goods and services:

Class 9	Software and enterprise software applications for use in monitoring, tracking, detecting, preventing and managing fraud in the fields of credit fraud, credit card fraud, debit card fraud, check fraud, identity theft, mortgage fraud, and banking fraud.
Class 35	Business investigations and business research, namely, data warehousing, data mining and predictive modeling services, all for use in monitoring, tracking, detecting, preventing and managing fraud in the fields of credit fraud, credit card fraud, debit card fraud, check fraud, identity theft, mortgage fraud, and banking fraud.
Class 42	Providing temporary use of online non-downloadable software for use in monitoring, tracking, detecting, preventing and managing fraud in the fields of credit fraud, credit card fraud, debit card fraud, identity theft, mortgage fraud, and banking fraud; and development

	of customized software for others for use in monitoring, tracking, detecting, preventing and managing fraud.
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6 The Opponent also relies on several trade marks and trade names containing or comprising the word “FALCON”, namely: FICO FALCON FRAUD MANAGER, Falcon Platform, Falcon Fraud Manager, Falcon Compromise Manager, Falcon Identity Proofing, Falcon Authentication Suite, Falcon X, Analytics Workbench – Falcon Edition, Falcon Intelligence Network, and Falcon Intelligence Network Insights.<sup>1</sup>

7 In support of the application, the Applicant filed its Counter-Statement on 18 March 2021, and subsequently amended it on 17 August 2022 (“CS”).

8 The Opponent filed evidence in support of the opposition on 17 September 2021. The Applicant filed evidence in support of the application on 28 March 2022. The Opponent filed its reply evidence on 2 June 2022. Pre-Hearing Reviews were held on 4 and 25 July 2022, and the opposition was heard on 27 October 2022.

9 In advance of the hearing, the parties filed their written submissions on 27 September 2022 (Applicant’s Written Submissions (“AWS”) and Opponent’s Written Submissions (“OWS”) respectively). After reviewing the pleadings, evidence and submissions, I requested that the parties address me on the following two (2) issues at the hearing:

- (b) Which Singapore cases concerned a situation where a trade mark wholly incorporated a prior trade mark (e.g. “HYSTERIC GLAMOUR”

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<sup>1</sup> NO at [1].

vs “GLAMOUR”)? What principles can be derived from these cases on the issue of marks-similarity?

(c) What is the relevance (if any) of the state of the register on the issue of whether a particular mark or word is distinctive?

10 Both parties addressed me on these issues orally. The Applicant additionally filed Skeletal Submissions (“ASS”) to assist with its oral submissions.

### **The Evidence**

11 The following Statutory Declarations (“SDs”) were tendered in evidence:

(a) SD of Ted Koshiol, Senior Counsel of the Opponent, dated 27 October 2021 (“OSD”).

(b) SD of Naoki Sato, Head of Legal Section, General Administration & Legal Department of the Applicant, dated 28 March 2022 (“ASD”).

(c) SD in Reply of Ted Koshiol dated 2 June 2022 (“OSDR”).

### **Background**

12 The Applicant is an industry leader in Japan’s IT solutions and cybersecurity sectors, and is listed on the Tokyo Stock Exchange. It employs over 2,000 people in Japan, operates the largest monitoring centre in Japan for information security, and counts over a thousand Japanese companies as its clients. The Applicant’s business is particularly focused on advanced security technologies. Through its predecessor company, the Applicant’s information



security business has been operating since 1995. The Applicant is active in the international cybersecurity scene, and regularly takes part in international events organized outside of Japan that promote international cooperation and information-sharing in the field of cybersecurity. In addition, the Applicant also conducts cybersecurity training workshops in Japan for participants from foreign countries to share its expertise in this field.<sup>2</sup>

13 The Application Mark was adopted by the Applicant as the name of the cybersecurity monitoring system used by the Applicant's clients. Apart from Singapore, the Application Mark is registered (or has been accepted for registration) in classes 9, 35, 42 and 45 in Japan, Indonesia and Malaysia.<sup>3</sup>

14 The Opponent was incorporated in Delaware, USA in 1956. It is an industry leader in providing business analytics solutions, including in the fields of fraud detection, authentication and related areas. It is listed on the New York Stock Exchange. It works with thousands of companies in more than 120 countries, and employs over 4,000 people worldwide. Among numerous other activities, it organises forums which are attended by its customers across South-East Asia.<sup>4</sup>

15 The Opponent's Mark has been applied for or registered in numerous countries around the world, including Singapore, Japan, Indonesia and Malaysia. The Opponent's products and services in the field of fraud detection, authentication and related areas can trace their origin to a fraud detection system named "FALCON" which was developed in 1992, with "FALCON" being an

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<sup>2</sup> ASD at [4]-[6], [8]-[9].

<sup>3</sup> ASD at [7] & [10] and AWS at [11].

<sup>4</sup> See OSD at [3]-[8], [14]-[17] and [19]-[29] for details of the Opponent's business.

acronym for “Fraudulent Activity Loss Containment”. The Opponent subsequently developed several other products and services incorporating the word “FALCON”, such as the Falcon Platform, Falcon Fraud Manager, Falcon Compromise Manager, Falcon Identity Proofing, Falcon Authentication Suite and Falcon X.<sup>5</sup>

### **Grounds of Opposition**

16 The Opponent relies on Section 8(2)(b) and Section 8(7)(a) of the Trade Marks Act 1998 (the “Act”) in this opposition.

### **Applicable Law and Burden of proof**

17 The applicable law is the Act. The Opponent bears the burden of proof to establish the grounds of opposition.

### **Ground of Opposition under Section 8(2)(b)**

18 Section 8(2)(b) of the Act reads:

(2) A trade mark shall not be registered if because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

19 To succeed in an opposition under this ground, the opponent must establish that:

(a) the competing marks are similar;

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<sup>5</sup> OSD at [9]-[12] and [18]-[19].

- (b) the goods and services of the competing marks are identical or similar; and
- (c) there exists a likelihood of confusion arising from the similarities in (a) and (b) above.

20 Each of these conditions must be established, and they are assessed “step-by-step.” As stated by the Court of Appeal in the landmark decision of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“**Staywell**”) at [15]:

“... Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round.”

### ***Similarity of Marks***

21 The key principles relating to the evaluation for marks-similarity have been set out in a number of decisions of the Court of Appeal, including *Staywell* and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“**Hai Tong**”). These can be summarised as follows:

- (a) The assessment of marks-similarity is “*mark-for-mark without consideration of any external matter.*” (*Staywell* at [20])
- (b) The relevant marks must be viewed and compared as a whole, and not dissected into their individual elements.
- (c) There are three aspects of the evaluation of marks-similarity, namely, visual, aural and conceptual similarities. These aid the court’s evaluation by signposting its inquiry. There is no requirement that all

three similarities (visual, aural, and conceptual) need to be made out before the marks or signs being compared may be found to be similar. The relative importance of each aspect of similarity will depend on the circumstances, including the nature of the goods or services and the types of marks involved, and a trade-off can be made between the three aspects of similarity. (*Hai Tong* at [40])


(d) The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar. There is no “*minimal threshold*” whereby it is sufficient for an opponent to establish that “*there was some degree of similarity in any one of these three aspects, no matter how weak.*” (*Staywell* at [17])


(e) Integrated into the analysis of visual, aural and conceptual similarity is a consideration of whether the earlier mark is distinctive. (*Staywell* at [30]). It is “*relevant to examine the distinctiveness of the [opponent’s] registered mark in order to determine the extent of the latitude that will be allowed to a user of features that appear in that mark.*” (*Hai Tong* at [27])

(f) When assessing two contesting marks or signs, the court does so with the “*imperfect recollection*” of the average consumer. The two marks or signs should not be compared side by side or examined in detail because “*the person who is confused often makes comparison from memory removed in time and space from the marks*”. (*Hai Tong* at [40])

22 This case involves the application of these well-known principles to a situation where the later mark (“CloudFalcon”) wholly incorporates the earlier mark (“FALCON”).

23 There have been numerous cases in Singapore where this situation has arisen. Before examining the parties' submissions on this issue and setting out my own views, I briefly set out the conclusions reached in a few of the earlier Singapore cases. I will examine these cases in greater detail in the course of my decision.

S/N	Case	Singapore Court/Tribunal	Mark applied for (and relevant goods/ services)	Prior mark(s) (and relevant goods/ services)	Decision on mark-similarity
01	<i>Ozone Community Corp v Advance Magazine Publishers Inc</i> [2010] 2 SLR 459 (" <b>Ozone Community</b> ")	High Court	<b>HYSTERIC GLAMOUR</b>  for "printed matter"	<b>GLAMOUR</b>  for "magazines, books and publications"	Overall: Dissimilar  Visually dissimilar  Aurally dissimilar  Conceptually "in some way" similar
02	<i>The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd</i> [2005] SGHC 175 (" <b>Polo HC</b> "); [2006] 2 SLR(R) 690 (" <b>Polo CA</b> ")	High Court & Court of Appeal	  for clothing, bags, handbags and shoes	<b>POLO</b>  for clothing, handbags and shoes	Overall: Dissimilar  Visually, aurally and conceptually dissimilar
03	<i>Monster Energy Company v Glamco Co, Ltd</i> [2018] SGHC 238 (" <b>Monster Energy</b> ")	High Court	<b>SWEET MONSTER</b>  for "tea; coffee; cocoa products; non- medicated tea based beverages"	<b>MONSTER</b>  for "energy drinks and caffeinated beverage"	Overall: Dissimilar  Visually dissimilar  Aurally similar  Conceptually dissimilar

04	<i>Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)</i> [2018] SGIPOS 1 (“ <i>Gucci</i> ”)	IPOS	 <p>for various types of cooking apparatus in Class 18.</p>	<p><b>GUCCI</b></p> <p>For “porcelain and ceramic articles; drinking glasses and glass flasks” in Class 21.</p>	<p>Overall: very similar</p> <p>Visually, aurally and conceptually very similar</p>
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### *Opponent’s Suggested Approach*

24 The Opponent relied principally on three (3) cases in support of its submissions on this issue: *Ozone Community*, *Monster Energy*, and *FMTM Distribution Ltd vs Rolex S.A.* [2020] SGIPOS 6 (“*FMTM Distribution*”).

25 The Opponent submitted that the following aspects are relevant in the present case:

- (a) On whether two (2) marks are visually and aurally similar, this is a mechanical exercise and boils down to the overall length (in terms of number of words, syllables and letters) of the respective marks. Essentially, if the additional word is longer than the common word, then the marks will be visually and aurally dissimilar (e.g. *Ozone Community* – marks dissimilar as *Hysteric* is longer than *Glamour*). Conversely, the marks are similar if the additional word is shorter than the common word (e.g. *FMTM Distribution* (where the comparison was between **SUBMARINER** and **MARINER**) at [41]-[44], [47]-[54] – marks visually and aurally similar as the prefix “SUB” is shorter than the

<sup>6</sup> The words in small print below “**GUCCITECH**” read “INNOVATION SAVES SPACE”.

common word “MARINER”). In the current case, “CLOUD” is shorter than “FALCON”.<sup>7</sup>

(b) On conceptual similarity, according to the Opponent, this is key in determining whether two (2) marks are similar or dissimilar overall. As to whether there is conceptual similarity, this depends on the additional word added to a mark. For example, in *Monster Energy* (at [63]-[65]), the marks were not conceptually similar since “*when the word ‘sweet’ is used as an adjective to describe the word ‘monster’, it changes the impression that a consumer would get from an image of a ‘large, ugly and frightening imaginary creature’... to a ‘delightful’ and ‘endearing’ imaginary creature.*” However, in *FMTM Distribution* (at [55]-[60]), despite the addition of the prefix “SUB” to the word “MARINER”, both marks still convey the ideas of the sea and a sailor. In the present case, both marks evoke the concept of a falcon. The addition of the word “CLOUD” in the Application Mark does not change this regardless of whether “CLOUD” is understood by the average consumer as referring to clouds in the sky or (which the Opponent denies) in the context of cloud computing.<sup>8</sup>

26 The Opponent did not address me on the relevance of the distinctiveness of the earlier mark (“FALCON”) in a situation where the later mark wholly incorporates the earlier mark. However, in its submissions on marks-similarity generally, the Opponent did address the issue of distinctiveness. I consider this issue below.

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<sup>7</sup> See also OWS at [26]-[34].

<sup>8</sup> See details in OWS at [35]-[41].

*Applicant's Suggested Approach*

27 The Applicant examined several Singapore cases, including *Ozone Community*, *Polo CA* and *Monster Energy*.

28 On the issue of marks-similarity, it concluded that marks must be assessed in totality. The fact that marks may have similar elements or a common denominator does not automatically mean that the marks are similar. Some factors that are relevant in determining whether two or more marks are similar or dissimilar include the use of different prefixes, the existence of other prior marks with the same elements, the co-existence of marks elsewhere and the differences found in both marks when compared in totality.<sup>9</sup>

*My Views on the Applicable Principles*

29 I have set out the legal principles applicable to the evaluation of marks-similarity at [21] above.

30 In *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 (“*Twitter*”), a judgement issued by Goh Yihan JC (“Goh JC”) after I heard parties, Goh JC gave his views on the correct approach to understanding and applying the concept of “distinctiveness” in the marks-similarity inquiry. He summarised his views at [119] as follows:

- (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

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<sup>9</sup> ASS at [24(a)].



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.

31 Technical distinctiveness refers to the ability of a mark to distinguish the goods or services of one particular trader from those of another. (*Twitter* at [43]) A trade mark can have inherent technical distinctiveness in the sense that it can immediately function as a clear badge of origin of a trader. Technical distinctiveness can also be acquired through subsequent use by the proprietor of the trade mark. (*Twitter* at [42])

32 Non-technical distinctiveness refers to the dominant/outstanding and memorable component of a mark which stands out in the average consumer’s imperfect recollection. (*Twitter* at [43]) The non-technical distinctiveness of an element of a trade mark could depend on factors such as the size of the element, how the element is positioned and whether it was in bold font, *etc.* (*Twitter* at [41]) A mark cannot acquire an outstanding and memorable component through

prolonged use. Therefore, non-technical distinctiveness can only be inherent. (*Twitter* at [63])

33 I gratefully adopt the analytical framework as well as the terminology put forward by Goh JC in his clear and persuasive judgment.

34 In the specific situation where a later mark wholly incorporates an earlier mark, the earlier mark is invariably a mark comprising of a single word (e.g. “GLAMOUR”, “POLO”, “MONSTER” and “GUCCI” in the examples set out in [23] above). This is not surprising. If a later mark wholly incorporates an earlier mark which comprises several elements, it will almost certainly be objectionable on the basis that: it is confusingly similar to the earlier mark (Section 8(2)(b) of the Act); (if the earlier mark includes a device element) it infringes copyright in the device (Section 8(7)(b) of the Act); and/or that it is applied for in bad faith (Section 7(6) of the Act).

35 I am of the view that the inherent technical distinctiveness (or otherwise) of the earlier mark is critical in determining whether the later mark is similar to the earlier mark.

36 If the earlier mark is of a low level of inherent technical distinctiveness, the average consumer viewing the marks with imperfect recollection would focus on the differences between the marks. He (or she) will find the marks to be dissimilar overall, even if certain aspects of the marks (visual, aural or conceptual) may have some degree of similarity.

37 This is consistent with the policy that “*the courts are wary of allowing companies to monopolise words that are either purely descriptive or used in everyday parlance*” (*Polo HC* at [30]; cited with approval in *Polo CA* at [11])

(see also [23] and [24])).<sup>10</sup> In turn, this translates into a reluctance to hold that the later mark is similar overall to the earlier mark (*Ozone Community* at [43]<sup>11</sup>).

38 As distinctiveness is integrated into the marks-similarity analysis (see [30(b)] above), and as the three aspects of the evaluation of marks-similarity (namely, visual, aural and conceptual similarities) focus on different aspects of the competing marks, it may well be that the later mark will be found to be similar to the earlier mark in one or more of these aspects. However, the relative importance of each aspect of similarity will depend on the circumstances, including the types of marks involved (see [21(c)] above). Where the only point of similarity between two competing marks arises from a common element which is of a low level of inherent technical distinctiveness, it is likely that the later mark will be found to be dissimilar overall to the earlier mark. For example, the addition of a shorter word “SWEET” (1 syllable; 5 letters) to a longer word “MONSTER” (2 syllables; 7 letters) resulted in the marks being found to be aurally similar. However, as the court held that “MONSTER” does not have a high level of inherent technical distinctiveness, that was sufficient to render the marks visually and overall dissimilar (*Monster Energy* at [47]-[60], [66]).

39 In contrast, where the earlier mark is of a high level of inherent technical distinctiveness and a later mark wholly incorporates the earlier mark, it would almost inevitably be the case that the marks will be found to be similar. The

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<sup>10</sup> As noted by the Court of Appeal at [24], the word “polo” is an ordinary English word meaning a game played on horseback, or used to describe a type of T-shirt with a collar.

<sup>11</sup> Citing Ng-Loy Wee Loon in *Law of Intellectual Property in Singapore* (Sweet & Maxwell Asia, 2009) at [21.5.12]. It does not seem that this exact paragraph appears in the Third Edition (Sweet & Maxwell, 2021) of this textbook, though the same point is conveyed at [21.5.18(c)] read with [21.3.3]. See also [44]-[48], [65]-[73] of the judgment. Among other things, the court noted that “GLAMOUR” is descriptive of a magazine for young women interested in fashion, beauty and a contemporary lifestyle.

average consumer viewing the marks with imperfect recollection would latch onto the common inherently technically distinctive component of the marks, and find the marks to be visually, aurally and conceptually similar.

40 The later mark cannot escape a finding of marks-similarity by the simple expedient of adding numerous embellishments to the earlier mark. For example, in *Gucci*, the learned IP Adjudicator found



to be visually, aurally and conceptually very similar to “GUCCI” despite the stylisation of the letter “G”, the addition of the -TECH suffix and the presence of the strapline INNOVATION SAVES SPACE (see [25]-[30]).

41 As astutely observed by the IP Adjudicator in the context of aural similarity (at [27]), it is not appropriate to do a simple syllable count in these circumstances since “[t]o do so could have the consequence that a later mark could be differentiated sufficiently from a third party’s distinctive earlier mark incorporated in it merely by adding sufficient matter of a descriptive nature as to overwhelm in purely quantitative terms the distinctive element that comprises the opponent’s earlier mark: for example, a later mark comprising NIKE: MAKES YOU RUN BETTER would then be more dissimilar than similar to NIKE even though the only distinctive part of the later mark is the word NIKE.”

42 I would go further and suggest that even adding another inherently technically distinctive component to an earlier inherently technically distinctive mark should in general not preclude a finding of marks-similarity. For example, a person should not be allowed to register “NIKE ADIDAS”, on the basis that the mark is allegedly not similar to either “NIKE” or “ADIDAS”.

43 Of course, there are gradations of inherent technical distinctiveness, and when the earlier mark falls somewhere between these extremes, whether the marks will be found to be similar would depend on all the circumstances of the case.

*Comparison between Application Mark and Opponent's Mark*

44 I now proceed to compare the Application Mark with the Opponent's Mark.

45 Before examining the three (3) aspects (visual, aural and conceptual) of similarity, I deal first with the Applicant's submission based on the co-existence of the marks on the trade mark register in Indonesia, and the acceptance of the Application Mark for registration in Malaysia despite the registration of the Opponent's Mark there. According to the Applicant, this *"supports the fact that the mere sharing of the common element 'Falcon' alone does not render the marks confusingly similar."*<sup>12</sup>

46 I do not agree. The facts leading to the registration/acceptance of the Application Mark in Indonesia and Malaysia (of which there is no evidence) may be very different from the situation in Singapore. The legal position in these countries may also be different. Further, as observed by the High Court in *Digi International Inc. v Teraoka Seiko Co., Ltd* [2021] SGHC 165 ("**Digi**") at [194], a party *"is entitled to elect which jurisdiction(s) to contest the registration of the Application Mark in. This is a multi-faceted commercial decision which [a judge is] not in a position to question. As such, the co-existence of identical iterations of the Application Mark and Respondent's Mark (Singapore) in other jurisdictions merely shows that the respondent has chosen not to oppose the*

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<sup>12</sup> AWS at [43]-[45].

*Application Mark's registration in those jurisdictions.*” It follows that the mere fact of coexistence of the marks in other jurisdictions without more is not a relevant consideration.

*Visual Similarity*

47 It is evident that the point of similarity between the competing marks is that they both contain the word “FALCON”, while the difference is that the Application Mark contains an additional word “CLOUD”.

48 I disagree with the Opponent’s submission (see [25(a)] above) that the analysis of visual similarity is a mechanical exercise involving a simple comparison of the number of words, syllables and letters in the respective marks. Such a simplistic analysis would result in a finding that the marks are visually similar just because “CLOUD” (1 syllable; 5 letters) is shorter than “FALCON” (2 syllables; 6 letters).

*Distinctiveness of Opponent’s Mark*

49 It is first necessary to assess the distinctiveness of the Opponent’s Mark (FALCON), which is registered for goods and services relating to the prevention of fraud (see [5] above for full details of the registrations).

50 I do not need to concern myself with non-technical distinctiveness as the Opponent’s Mark comprises of a single word and there is no dominant/outstanding and memorable component of the mark which stands out in the average consumer’s imperfect recollection.

51 I also do not need to consider the acquired technical distinctiveness of the Opponent’s Mark as the Opponent does not assert that its mark has acquired distinctiveness. In any event, the court in *Twitter* has held that acquired

technical distinctiveness should not be considered at the marks-similarity inquiry (see [30(c)] above).

52 The Opponent argues that the Opponent’s Mark is inherently technically distinctive as “‘FALCON’ is an English word that refers to a species of bird of prey” and “has no meaning in relation to the goods and services covered”.<sup>13</sup> I am unable to agree. Lack of inherent technical distinctiveness is not confined to a mark being descriptive of the relevant goods and services; it extends to (among other things) allusions to desirable attributes of such goods and services.<sup>14</sup>

53 In *Monster Energy* (at [49]), for example, the court observed that “the word ‘monster’ has an allusive and laudatory meaning in relation to the Appellant’s goods, ie, energy drinks and caffeinated beverages. The word ‘monster’ when used in relation to the Appellant’s energy-boosting beverages suggests that upon consuming these beverages, a consumer would gain a great level of energy and strength, much like a large and ferocious monster. Therefore, it cannot be said that the word ‘monster’ has no bearing on the Appellant’s products, given that it is laudatory as to the effectiveness of the beverage in achieving its intended purpose of providing an energy boost to the consumer.”

54 In the present case, a falcon is very fast, has sharp eyesight and is highly intelligent (among numerous positive attributes), and clearly has allusive and

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<sup>13</sup> OWS at [23].

<sup>14</sup> By way of analogy, Section 7(1)(c) of the Act prohibits registration of “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.”

laudatory connotations for goods and services relating to the prevention of fraud.

*Relevance (or otherwise) of the state of the register*

55 The Applicant also relies on “registrations of marks by third parties, all of which [consist] of the word ‘Falcon’, either as a standalone word or with other combinations” to argue that “the Opponent has no exclusive right over the word ‘Falcon’.”<sup>15</sup>

56 Specifically, a search for the word “FALCON” in classes 9, 35, 42 and 45 of the Singapore trade mark register conducted by the Applicant on 21 March 2022<sup>16</sup> showed that numerous marks consisting of, or containing, the word “FALCON” had been registered or applied for by a large number of unrelated traders. The search results also disclosed numerous applications or registrations for marks consisting of, or containing, the names of other well-known birds of prey such as “eagle” and “hawk”.<sup>17</sup> I tabulate the number of such marks below<sup>18</sup>:

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<sup>15</sup> AWS at [42].

<sup>16</sup> On the day of the hearing, the Applicant also tendered an updated trade mark search to similar effect: see Annexure A to ASS.

<sup>17</sup> See exhibit “NS-4” of OSD.

<sup>18</sup> There is a slight degree of double-counting. For example, some of the marks are registered or applied for by the same proprietor in different classes. But this does not detract from the conclusion that the register indicates that “FALCON” is a word which many traders may wish to use for goods and services in these classes without any dishonest intention. The precise specifications of goods and services is also immaterial to the discussion which follows.



<b>Marks consisting or containing the word:</b>	<b>Class 9</b>	<b>Class 35</b>	<b>Class 42</b>	<b>Class 45</b>
<b>FALCON</b>	17	17	6	1
<b>EAGLE</b>	23	5	6	0
<b>HAWK</b>	14	5	6	1

57 It is first necessary to consider whether the state of the register can be taken into account in assessing the inherent technical distinctiveness of the word “FALCON”. This issue arises not infrequently in trade mark opposition proceedings. The state of the register is also often relied upon by an applicant when an examiner rejects its trade mark application on the basis that it is similar to a prior mark.

58 The Opponent submits that the existence of other trade mark applications/registrations consisting of or containing the word “FALCON” is irrelevant. It relies on *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) (at 305) in support of its submission.<sup>19</sup>

59 The Opponent further highlights that the relevant passage in *British Sugar* has been endorsed by the High Court in *Digi* at [193].<sup>20</sup> In relation to *Digi*, I note that this proposition was considered in a different context. Specifically, the appellant had submitted “*that the long period of co-existence*

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<sup>19</sup> OWS at [52].

<sup>20</sup> OWS at [52].

*of the parties' marks... in Singapore and outside of Singapore... supports the conclusion that there will be no likelihood of confusion among the relevant public.*" (Digi at [192])

60 This proposition in *British Sugar* was also cited in *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S v BenQ Materials Corp.* [2018] SGIPOS 2 at [31] and *Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2020] SGIPOS 3 at [29]. As far as I am aware, however, there is no Singapore case which has specifically considered the issue of whether the state of the register is relevant in the assessment of inherent technical distinctiveness.<sup>21</sup>

61 Given that the local cases all refer to *British Sugar*, it is helpful to examine this case in greater detail. I first set out the relevant quote in context and in full:

"On the question of factual distinctiveness I must also have regard to how the mark is used -- how it appears on the label. I think it is fairly ambiguous. What the customer sees is "Silver Spoon Treat". The suggestion is that the syrup from "Silver Spoon" will be a "treat". Other customers may accept the word as having a trade mark meaning in context. I take the latter possibility into account in my conclusion.

**"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances**

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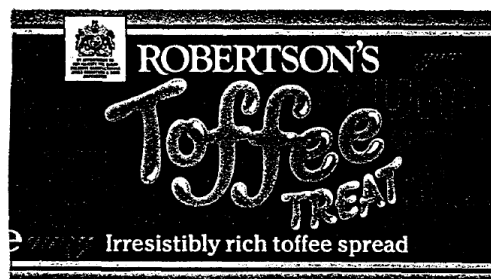
<sup>21</sup> The Applicant did locate a High Court decision (discussed below at [70]) which took into account the state of the register in the assessment of distinctiveness. In my earlier decision in *Twitter, Inc. v V V Technology Pte Ltd* [2022] SGIPOS 4 at [51], I also did suggest that the state of the register could be considered in the assessment of distinctiveness. However, in both these decisions, there was no analysis or detailed discussion of this issue.

**were which led the registrar to put the marks concerned on the register.** It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg MADAME Trade Mark ([1996] RPC 541) and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

(emphasis added)

62 *British Sugar* was an action for trade mark infringement. The plaintiff had registered “TREAT” for ‘dessert sauces and syrups’. It used its trade mark on “Silver Spoon Treat”, a sweet syrup in a range of flavours to pour onto ice cream. The defendant launched a sweet spread labelled “Robertson’s Toffee Treat” which it sold along with its range of jams and preserves. The judge rejected the trade mark infringement claim and also allowed the defendant’s counterclaim that the plaintiff’s trade mark registration was invalid.

63 The following are examples of how the parties used the word “TREAT” on the labels for their respective products:



64 The relevant quote from *British Sugar* is taken from the section of the judgment discussing the validity of the “TREAT” trade mark (see pages 300-306 of the judgment). Specifically, it appears that both parties invited the judge to have regard to the state of the register when he was considering the relevance of a market survey conducted by the plaintiff. The judgment does not indicate

what precisely the parties were relying on the state of the register for, though it appears that this was on the question of whether “TREAT” had acquired technical distinctiveness.



65 I also note that in the very first paragraph of his judgment, the learned judge decried attempts by “[w]ealthy traders... to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure.” He rightly observed that trade mark legislation should not “enable big business to buy ordinary words of the English language as trade marks at comparatively little cost.” (*British Sugar* at pages 284-285; citations omitted) He regarded “TREAT” as “a highly descriptive or laudatory word” (page 286, line 38), and held that the registration was invalid as “TREAT” was not distinctive (see discussion at pages 300-306).

66 I agree with *British Sugar* that the state of the register does not shed light on the realities of the marketplace. This is also the position taken by the local cases endorsing *British Sugar* which I have cited above. To that extent, the state of the register does not assist in the distinctiveness assessment.

67 At the same time, in my view, the state of the register can be considered when assessing whether a particular mark is inherently technically distinctive. If numerous marks registered or applied for by unrelated traders consist of, or contain, a particular word, this suggests that traders might legitimately want to use the word as (or as part of) a trade mark for their own goods or services. No single trader should be granted a monopoly over such a word. I say this for several reasons.

68 First, *British Sugar* itself contemplates the possibility of the state of the register being used “to confirm that this is the sort of word in which traders would like a monopoly” (at page 305, lines 4-5).

69 Secondly, in applying to register a trade mark, an applicant is representing to the Registrar “that the trade mark is being used in the course of trade... or that the applicant has a bona fide intention that the trade mark should be so used” (Section 5(1)(e) of the Act). Securing registration confers on the applicant, among other things, “the exclusive rights to use the trade mark” in relation to the goods or services for which the trade mark is registered (Section 26(1)(a) of the Act).

70 Thirdly, the High Court in *Valentino Globe BV v Pacific Rim Industries Inc* [2009] 4 SLR(R) 577 (“*Valentino*”) did in fact take the state of the register into consideration in circumstances similar to the present case. That case concerned an opposition by the proprietor of the mark  VALENTINO against the registration of  Emilio Valentino. In the discussion of conceptual similarity (at [35]-[36]), the court stated:

[35] As a number of traders in the fashion industry use the word Valentino, the PAR rejected the argument that the Respondent had created a mark that was conceptually similar to the Appellant’s Relevant Marks. In fact, the PAR identified (at [52] of her GD) seven traders which trade marks were registered in class 18 and “constituted wholly or in part of the word ‘Valentino’”. These trade marks included a “Mario Valentino”, an “Orlandi Valentino” and a “Valentino”, the latter belonging to one Mario Valentino SpA, a company unrelated to the Appellant. This was also a relevant consideration on the issue of the likelihood of confusion (at [78] of her GD).

[36] Given the various trade marks on the register under class 18 which comprise of the word “Valentino” (at the time of the opposition hearing there were 14 in total), I find it unconvincing that simply by virtue of the word “Valentino” in the Application

Mark, there is present conceptual similarity and even confusion. The Appellant certainly does not have a monopoly over the word “Valentino”.

71 Fourthly, taking the state of the register into consideration is consistent with the practice at IPOS’ Registry of Trade Marks. When responding to a trade mark examiner’s objection that an applicant’s mark is similar to a prior mark which includes a common element, an applicant often responds by pointing to other marks on the register which also include that same element. The argument, as in the present case, is that the proprietor of the prior mark does not have a monopoly over an element which many other traders may legitimately wish to use on their own goods or services. Such an argument would typically be taken into consideration by a trade mark examiner.

72 Fifthly, if evidence of the state of the register is rejected, a party may then need to carry out costly investigations in the marketplace to demonstrate that a particular word is used by other honest traders as part of their own trade marks. This is at odds with the legislative intention that trade mark oppositions should be low cost proceedings.

73 In the present case, the state of the register shows clearly that “FALCON” is a word which many different traders may wish to use as (or as part of) their trade mark for goods and services in the relevant classes without any dishonest intention. This is not surprising given the laudatory connotations of a falcon (a falcon is fast, sharp and intelligent: see [54] above) to such goods and services.

74 I am therefore of the view that the Opponent’s Mark only has a low level of inherent technical distinctiveness.

*Conclusion on Visual Similarity*

75 As I have found that “FALCON” has a low level of inherent technical distinctiveness, I am of the view that the average consumer would notice that the Application Mark has an additional word (which moreover is the first word in the mark) - “CLOUD” - which is absent in the Opponent’s Mark.

76 This finding is consistent with the various court decisions which I have considered above.

77 In *Monster Energy* (as noted above at [38]) the addition of a shorter word “SWEET” (1 syllable; 5 letters) to a longer word “MONSTER” (2 syllables; 7 letters) was also sufficient to render the marks visually dissimilar.

78 In *Ozone Community*, the court found that “GLAMOUR” and “HYSTERIC GLAMOUR” were visually dissimilar. Among other things, the court noted that “HYSTERIC GLAMOUR” has two words, and “HYSTERIC” appears at the beginning of the mark and would be seen first. (at [49]-[56])

79 In *Valentino*, the court did not accept that the appellant had a monopoly over the word “VALENTINO”, and found that there was little visual similarity between the relevant marks.

80 For all the above reasons, I find that the marks are visually dissimilar.

*Aural Similarity*

81 There are two possible approaches for assessing the aural similarity of two competing marks. The first is by comparing the aural similarity of only the distinctive (in both its technical and non-technical senses) component of the marks. The second is to undertake a quantitative assessment of whether the

competing marks have more syllables in common than not. (*Staywell* at [31]-[33]).

82 The Opponent argues for the adoption of the second approach (see [25(a)] above).

83 In *Monster Energy*, the court found that the application mark in that case (i.e. “SWEET MONSTER”) did not have a distinctive component. On that basis, the court found that it was aurally similar to “MONSTER” on the basis that the marks had more syllables in common than not (*Monster Energy* at [61]-[62]).

84 In contrast, in *Ozone Community* (at [49]-[56]), the court found that “GLAMOUR” and “HYSTERIC GLAMOUR” were aurally dissimilar. Among other things, the court noted that “HYSTERIC GLAMOUR” has two words, and “HYSTERIC” appears at the beginning of the mark and would be read first.

85 Similarly, in *Valentino*, the court observed (at [26]) that the fact that “*the name ‘Emilio’ precedes ‘Valentino’ is a very glaring difference between the marks because in the aural sense especially, they are very distinct from one another. One would hear the name ‘Emilio’ before ‘Valentino’ when pronouncing the Application Mark and reading-wise, one would very likely read the name ‘Emilio’ first too. The Application Mark must be viewed in its entirety. Simply because it incorporates the word ‘Valentino’ does not mean that it is so visually and aurally similar as to be confused with the Appellant’s Relevant Marks.*”

86 I have found that “FALCON” has a low level of inherent technical distinctiveness. I am of the view that the average consumer would notice that



the Application Mark has an additional word - “CLOUD” - which is absent in the Opponent’s Mark. Moreover, this is the first word in the mark and would be read first. The marks are therefore aurally dissimilar.

*Conceptual Similarity*

87 The analysis for conceptual similarity “*seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole... the idea connoted by each component [of a mark] might be very different from the sum of its parts.*” (*Staywell* at [35])

88 The Applicant argues that there is no conceptual similarity as the word “FALCON” in the Opponent’s Mark is an acronym for “Fraudulent Activity Loss Containment”<sup>22</sup>, whereas there is no such connotation for the Application Mark. I am unable to agree with the Applicant. Marks-similarity is viewed from the perspective of the average consumer of the goods or services in question, and not the creator of the mark. The average consumer would not be aware of the derivation of the word “FALCON” in the Opponent’s Mark. This fact should therefore be disregarded. (*Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 at [43])

89 I agree with the Opponent (see [25(b)] above for the Opponent’s submissions on this issue) that the marks are conceptually similar. Regardless whether “CLOUD” is understood by the average consumer as referring to clouds in the sky or in the context of cloud computing, the Application Mark (“CloudFalcon”) would still evoke the concept of a falcon.

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<sup>22</sup> See OSD at [18] and AWS at [39].

90 However, I disagree with the Opponent (see [25(b)] above for the Opponent’s submissions on this issue) that conceptual similarity is key in determining whether two (2) marks are similar overall.

*Overall Similarity*

91 I have found that the marks are visually and aurally dissimilar, and conceptually similar.

92 As noted at [21(b)] and [21(c)] above, the relative importance of each aspect of similarity will depend on the circumstances of each case. It must ultimately be concluded whether the marks, when observed in their totality, are similar or dissimilar.

93 In *Monster Energy*, the court found the competing marks to be aurally similar, but visually and conceptually dissimilar. As the court held that “MONSTER” does not have a high level of inherent technical distinctiveness, this was sufficient to render the marks dissimilar overall. (see discussion at [38] above).

94 In *Ozone Community*, the court “*saw no reason to disturb the Principal Assistant Registrar’s holding that the word marks in this case were ‘in some way’ (as opposed to completely or to a large extent) conceptually similar. As Ozone conceded, the concept of ‘glamour’ was still present in ‘hysterical glamour’. The inquiry however does not stop here. The distinctiveness of AMP’s GLAMOUR mark must also be considered at this stage.*” (at [64]-[65]) After considering the distinctiveness of “GLAMOUR”, the court concluded that given that the marks were “*visually and aurally dissimilar, but conceptually similar, and that ‘glamour’ was merely descriptive and neither inherently distinctive nor distinctive by use... there was no similarity between the marks.*” (at [73])

95 In the present case, the concept of a “FALCON” with its attendant laudatory connotations is precisely what no trader should enjoy a monopoly over. As such, I am of the view that the conceptual similarity between the marks is of marginal relevance.

96 Overall, I find that the marks are dissimilar. Accordingly, the opposition under Section 8(2)(b) of the Act fails.

97 In case I am wrong, I briefly consider the other elements which the Opponent must establish to succeed under this ground of opposition.

***Similarity of Services***

98 For ease of reference, I reproduce the table prepared by the Opponent listing side-by-side the goods and services covered by the respective marks. The goods and services that the Opponent considers to be identical or similar are shown in bold.<sup>23</sup>

Applicant’s Goods and Services	Opponent’s Registered Goods and Services
<p><b><u>Class 09</u></b>                      Game programs for arcade video game machines; photographic machines and apparatus; cinematographic machines and apparatus; optical machines and apparatus; measuring or testing machines and instruments; telecommunication machines and apparatus; personal digital assistants in the shape of a watch;</p>	<p><b><u>Class 09</u></b>                      Software and enterprise software applications for use in monitoring, tracking, detecting, preventing and managing fraud in the fields of credit fraud, credit card fraud, debit card fraud, check fraud, identity theft, mortgage fraud, and banking fraud.</p>

<sup>23</sup> OWS at [45].

<p>smartphones; electronic equipment, apparatus and their parts; electron tubes; semi-conductor elements; electronic circuits, not including those recorded with computer programs; <b>computer programs</b>; data carriers recorded with computer programs; <b>computers and their peripherals</b>; <b>computer servers</b>; <b>computer software</b>; game programs for home video game machines; electronic circuits and CD-ROMs recorded with programs for hand-held games with liquid crystal displays; phonograph records; downloadable music files; downloadable image files; recorded video discs and video tapes; exposed cinematographic films; exposed slide films; slide film mounts; electronic publications; <b>all the aforesaid goods being used in the field of computer network security.</b></p>	
<p><b><u>Class 35</u></b> Advertising and publicity services; business management analysis or business consultancy; marketing research or analysis; providing information concerning commercial sales; business management of hotels; <b>collection, management, research, analysis and evaluation of business information</b>; employment agency services; filing of documents or magnetic tapes [office functions]; filing of electronic data [office functions]; <b>compilation of</b></p>	<p><b><u>Class 35</u></b> <b>Business investigations and business research, namely, data warehousing, data mining and predictive modeling services, all for use in monitoring, tracking, detecting, preventing and managing fraud in the fields of credit fraud, credit card fraud, debit card fraud, check fraud, identity theft, mortgage fraud, and banking fraud.</b></p>

<p><b>information into computer databases; updating and maintenance of data in computer databases;</b> providing business assistance to others in the operation of data processing apparatus namely, computers, typewriters, telex machines and other similar office machines; business administration for operating computer, computer system and computer controllable apparatus; business administration for operating apparatus for Internet access; business administration for operating security surveillance equipment; business administration for operating server computers; publicity material rental; rental of advertising space on the Internet.</p>	
<p><b><u>Class 42</u></b>          Designing of machines, apparatus, instruments (including their parts) or systems composed of such machines, apparatus and instruments; design services; <b>computer software design, computer programming, or maintenance of computer software; monitoring of computer systems for detecting unauthorized access or data breach by computer programs; provision of technical information and support information in relation to computers, computer systems, computer networks and computer software;</b> research, analysis, calibration and</p>	<p><b><u>Class 42</u></b>  <b>Providing temporary use of online non-downloadable software for use in monitoring, tracking, detecting, preventing and managing fraud in the fields of credit fraud, credit card fraud, debit card fraud, identity theft, mortgage fraud, and banking fraud; and development of customized software for others for use in monitoring, tracking, detecting, preventing and managing fraud.</b></p>

<p>evaluation of computers, computer systems, computer networks and computer software; <b>monitoring of computers, computer systems, computer networks and computer software by remote access; detection of abnormality on computer networks; computer security consultancy;</b> information technology [IT] consultancy; research, analysis and evaluation of technical information; technological advice relating to computers, automobiles and industrial machines; <b>technological advice relating to computer programs;</b> research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing or research on information and communications technology; research or development of data processing technology and information and communications technology; <b>testing, research, or development on computer programs and computer software;</b> testing or research on telecommunication network systems; rental of computers; <b>providing computer programs on data networks;</b> rental of data carriers recorded with computer programs; rental of web servers; <b>software as a service [SaaS];</b> cloud computing; <b>rental of</b></p>	
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<b>computer software; providing Internet security programs.</b>	
<b>Class 45</b> Providing information on agencies for procedures relating to industrial property rights; providing information on agencies for legal procedures relating to lawsuits or other legal issues; providing information on agencies for judicial registration or deposits; security guarding for facilities; personal body guarding; <b>investigation or surveillance on background profiles.</b>	

99 The goods and services to be compared are those for which the Application Mark is applied for, and those for which the Opponent's Mark is registered. (*Staywell* at [40])

100 In my view, at least some of the goods/services highlighted in bold by the Opponent are clear examples of identical or similar specifications in the parties' respective goods and services of interest. I note that the Applicant itself concedes that "*there may be slight overlap in the specification of goods / services of the Applicant and Opponent.*"<sup>24</sup>

101 Accordingly, this requirement is met by the Opponent.

### ***Likelihood of confusion***

102 The third element which the Opponent must establish is that there exists a likelihood of confusion arising from the similarities in marks and in

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<sup>24</sup> AWS at [52].

goods/services. This issue therefore does not arise as I have found that the marks are dissimilar.

103 I also note although both parties are multinational companies and there is some overlap in the jurisdictions in which they have each been operating for several years, the Opponent (which bears the burden of proof) has not furnished any evidence of actual confusion on the part of any consumer.

104 Of course, it is not necessary for the Opponent to establish actual confusion; a likelihood of confusion would suffice. In this regard, given my view that the Opponent's Mark has a low level of inherent technical distinctiveness, the average consumer viewing the respective marks would focus on their differences and is unlikely to be confused.

***Conclusion on opposition under Section 8(2)(b)***

105 As the Opponent has not established the threshold requirement of marks-similarity (and is also unable to show a likelihood of confusion on the part of the average consumer), this ground of opposition fails.

**Ground of Opposition under Section 8(7)(a)**

106 Section 8(7)(a) of the Act reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

107 The three elements of passing off are (a) goodwill, (b) misrepresentation, and (c) damage to goodwill: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 at [37]; affirmed in *Singsung Pte Ltd v*



*LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [28]. All three elements must be established to succeed in a claim for passing off.

108 It is not necessary for me to consider the elements of goodwill and damages as the Opponent is not able to establish misrepresentation. The test for misrepresentation under passing off is substantially the same as that for “likelihood of confusion” under Section 8(2)(b) of the Act (*Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [76]-[77]). I have found that the competing marks are dissimilar, and that the average consumer is unlikely to be confused. It follows that there would also not be a misrepresentation under passing off. The opposition under this ground fails.

### **Overall Conclusion**

109 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails under both Sections 8(2)(b) and 8(7)(a) of the Act. The Application Mark may proceed to registration.

### **Costs**

110 As the opposition fails on all grounds, the Applicant is entitled to costs. Rule 75(2) of the Trade Mark Rules (the “**Rules**”) provides that costs awarded in proceedings before IPOS are not intended to compensate the parties for the expense to which they may have been put. Further, the Fourth Schedule in the Rules prescribes a Scale of Costs, which caps the costs claimable. Section F of HMD Circular 6.1 (Costs) provides parties with detailed guidance on the factors which the Registrar takes into account when deciding on the quantum of costs to be awarded for each item in the Scale of Costs.

111 For most trade marks hearings fixed from 2 June 2022, costs are assessed summarily. This approach is intended to be more cost and time effective for parties as compared to taxation proceedings after the substantive decision.

112 In the present case, on the assumption that the opposition succeeds, the Opponent sought the sum of \$7,575 for work done in relation to the Opposition, \$299 for work done for or in the assessment of costs, and \$5,142.30 for disbursements. This amounts to a total of \$13,016.30.<sup>25</sup> On its part, the Applicant sought the sum of \$10,970.00 as costs.<sup>26</sup> This sum, however, did not include disbursements save for \$83.65 for printing, photocopying and courier expenses.

113 At the hearing, the Opponent pointed out that the Applicant had pegged costs at the higher end of scale for each item in the Scale of Costs, which is not appropriate. To give just two (2) examples, the Applicant claimed \$1,040 for reviewing the Notice of Opposition, which is the maximum sum allowable under the Fourth Schedule. For reviewing the evidence, the Applicant claimed \$1,040 each for reviewing the Opponent's SD and the Opponent's SD in reply, which is again the maximum sum allowable under the Fourth Schedule. In each case, Section F of HMD Circular 6.1 (Costs) provides that "*[t]he number and complexity of issues raised in fact and law are relevant factors to be considered.*" Specifically, where (as here) 1 or 2 grounds of opposition are raised, the HMD circular provides that the indicative costs for each item should be between \$195-\$500.

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<sup>25</sup> OWS at [124].

<sup>26</sup> AWS at [81].

114 The Applicant accepted that its costs submissions were on the high side, and left it to the Registrar to decide on the appropriate costs in the event the Applicant was successful.

115 I have considered the parties' submissions on costs and, having regard to all the circumstances, award the Applicant the sum of S\$12,000 (inclusive of disbursements).

Mark Lim  
Principal Assistant Registrar

Mr Gerald Samuel and Mr Kwok Tat Wai (Marks & Clerk  
Singapore LLP) for the Applicant;  
Mr Jeremiah Chew and Mr Teo Jim Yang) (Ascendant Legal  
LLC) for the Opponent.

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