

IPOS Decisions 2024: Year-in-Review





Selected Issues, Holdings and Comments of Interest

Please note:





- (1) Full Grounds of Decision and case summaries (where available) are accessible at: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>
- (2) We have a mailing list where we provide regular updates on recent developments in the field of IP/Tech dispute resolution in Singapore. To join, please contact ipos_hmd@ipos.gov.sg.

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IPOS CASES IN 2024

Case Reference	Selected Issues, Holdings and Comments of Interest
<p><i>Google LLC v Green Radar (Singapore) Pte Ltd</i> [2024] SGIPOS 1</p>	<p style="text-align: center;">grMail</p> <p style="text-align: center;"></p> <p>Google opposed Green Radar’s trade mark application for “grMail” () in Classes 42 and 45 for “<i>Electronic monitoring services being IT security services in the nature of protection and recovery of computer data</i>” and “<i>Security services for the protection of property and individuals</i>” respectively. The applicant does not provide any email services. Instead, “grMail” is an enterprise email security service. Google relied on its trade mark registration for “GMAIL” in Singapore in Class 38 for “<i>telecommunication services; electronic mail services; all included in Class 38</i>”. Five grounds of opposition were raised under the Trade Marks Act: (a) s 7(6) (bad faith); (b) s 8(2)(b) (confusing similarity); (c) s 8(4)(b)(i) (well known trade mark); (d) s 8(4)(b)(ii) (trade mark well known to the public at large); and (e) s 8(7)(a) (passing off).</p> <p>The IP Adjudicator dismissed the opposition on all grounds. In arriving at her conclusion, the IP Adjudicator found “GMAIL” and “grMail” were slightly more similar than not. She also agreed with Google’s contention that the mark “GMAIL” is well known to the public at large in Singapore. However, she was of the view that there is no similarity in the services and that there would be no likelihood of confusion (which meant that ss 8(2)(b), 8(4)(b)(i) and 8(7)(a) could not succeed). As regards s 8(4)(b)(ii), the IP Adjudicator was not persuaded that there would be any dilution or unfair advantage taken of the distinctive character of the “GMAIL” mark. Finally, there was insufficient evidence to prove bad faith under s 7(6).</p>
<p><i>Henkel Polybit Industries Ltd v Polybit Industries Far East Sdn Bhd</i> [2024] SGIPOS 2</p>	<p>This case involves two formerly-related business entities in the business of developing and producing water-proofing and corrosion-inhibiting sealants and coating for the construction industry. The parties were fighting over the name “Polybit”, the rightful ownership of the copyright in respect of various logos which incorporate that name (Polybit), and the right to register trade marks which include these logos. In the result, Henkel Polybit Industries Ltd succeeded in</p> <p style="text-align: center;"></p> <p>its opposition to Polybit Industries Far East Sdn Bhd’s application for: (a) “  ” (the “Polybit Logo”); and (b) other applications for trade marks containing the Polybit Logo. It also succeeded in invalidating a trade mark registration comprising the Polybit Logo. The hearing officer found for Henkel Polybit on two main grounds. The first was notional copyright infringement under s 8(7)(b) of the Trade Marks Act. Here, the hearing officer found that the Polybit Logo is an artistic work owned by Henkel Polybit. Since Polybit Industries’ trade mark registration and applications were identical to or fully reproduced it, the ground premised on notional copyright infringement succeeded. The second ground was that of bad faith under s 7(6) of the Trade Marks Act. The hearing officer found that Polybit Industries had acted in bad faith and even held itself out on several occasions as a representative of Henkel Polybit.</p>

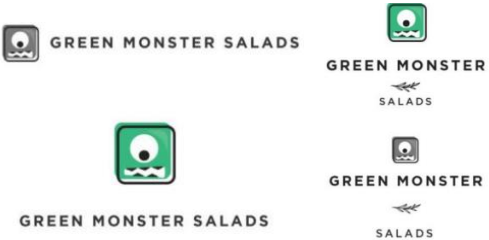

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<p><i>In the matter of a trade mark application by BioMedical Research Group Inc. & Anor.</i> [2024] SGIPOS 3</p>	<p>Two Japanese companies jointly sought to register IP-PA1 in Class 3 for non-medicated toiletry preparations and non-medical bath preparations. The term “IP-PA1” is an abbreviation of and reference to “<i>immunopotentiator from Pantoea agglomerans 1</i>”, an edible lipopolysaccharide with beneficial properties such as promoting hair growth, reducing atopic dermatitis, and suppressing inflammation. The trade mark examiners objected to the application on grounds that it was devoid of distinctive character under ss 7(1)(b) and 7(1)(c) in that it conveys a straightforward message: namely, that the goods claimed contain IP-PA1. As the applicants were unable to persuade the examiners to allow the application to proceed to registration, they opted for an <i>ex parte</i> hearing. The hearing officer maintained the objection, noting that the evidence showed that there were unrelated researchers who have used the term IP-PA1 in a descriptive manner which suggests that it has become an accepted abbreviation in the relevant scientific community.</p>
<p><i>CrossFit LLC v Play Distribution Pte Ltd</i> [2024] SGIPOS 4</p>	<p>CrossFit LLC, owner of the “CROSSFIT” trade mark in various Classes, including in Class 25 for clothing, socks and footwear, was unsuccessful in its application to invalidate Play Distribution’s “CrossFeet” trade mark in Class 25 (registered for a wide range of headwear, clothing and footwear). The hearing officer found the competing marks to be visually similar to an average degree, aurally similar to an above average degree, and conceptually dissimilar. When observed in their totality, she considered the marks to have an average degree of similarity. As regards goods-similarity, the hearing officer found that the goods overlapped. However, she did not think that there would be any likelihood of confusion given that the common element “cross” is a common English word and when combined with “Feet” creates a new unitary meaning that is different from “CROSSFIT”. (Note: the hearing officer also found that “CROSSFIT” was not well known in Singapore at the relevant date of 10 June 2019.)</p>
<p><i>Bytedance Ltd v Dol Technology Pte Ltd</i> [2024] SGIPOS 5</p>	<p>Bytedance, owner of the TikTok and Douyin (抖音) short video sharing platforms and the proprietor of the “TikTok”, “ ” and “ ” and “ ” trade marks, was unsuccessful in its opposition to Dol Technology’s application to register “ Tiki ”. The hearing officer found the competing marks to be dissimilar overall. This finding of dissimilarity effectively meant that the opposition could not succeed on all pleaded grounds.</p> <p>Readers may be interested to note that, on the facts of the case, the hearing officer was prepared to take into account evidence from overseas when finding that the “TikTok” word mark was well known to the public at large in Singapore (see [125]-[129] of the decision for his detailed reasons).</p>

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<p><i>Amazon Technologies Inc v Survivalverse Pte Ltd</i> [2024] SGIPOS 6</p>	<p>Amazon, a leading tech company, was successful in opposing a trade mark application by Survivalverse, a videogame software publisher, to register  in Class 9 for “software” and Class 41 for “providing online computer games”. Amazon’s essential argument was that the application mark should not be registered because it conflicted with its earlier plain word mark “AMAZON” registered in Class 9 for “computer software” and in Class 41 for “providing on-line computer and educational games and on-line interactive children’s stories”. Although the applicant accepted that the goods and services were identical, it contended that the marks were dissimilar and that there was no likelihood of confusion. In allowing the opposition, the hearing officer found that “” is what stands out in the application mark. Due to its dominance, the marks are similar to a high degree. Given this, and the identity between the goods and services, a likelihood of confusion would result.</p>
<p><i>Craft Drinks Pte Ltd v Tapout Pte Ltd</i> [2024] SGIPOS 7</p>	<p>This dispute was between two bars in Singapore in the craft beer industry.</p> <p>Craft Drinks Pte Ltd operates bars in Singapore under the mark “”. The sign is registered in Class 43 for “bar services”. It opposed an application to register “”, filed by Tapout Pte Ltd in Class 43 for essentially the same services. The hearing officer ultimately dismissed the opposition, finding (among other things) that in the context of the services of interest consumers would easily recognise that “TAP” alludes to the kind of drinks (beers on tap) offered. Consequently, although the competing marks were conceptually similar to a medium degree, they were overall more dissimilar than similar.</p>

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<p><i>Monster Energy Company v Artisan Boulangerie Compagnie Pte Ltd</i> [2024] SGIPOS 8</p>	<p>Monster Energy Company (“MEC”) has failed in its opposition to an application for the following “GREEN MONSTER SALAD” marks in Class 43 (for, among other things, services relating to drinks and restaurant services):</p> <div style="text-align: center;">  </div> <p>The opposition was based on s 8(2)(b) of the Trade Marks Act. MEC relied on various earlier trade mark registrations including the plain word mark “MONSTER”. The IP Adjudicator found that the competing marks were visually, conceptually and aurally more dissimilar than similar. This meant that the opposition failed at the first step. However, he went on to observe, <i>obiter</i>, that he regarded the following goods in Classes 30 and 32 to be similar to services relating to drinks and restaurant services in Class 43:</p> <p><i>“beverages”, “coffee”, “tea”, “coffee-based beverages”, “tea-based beverages”, “carbonated drinks and energy drinks”, “soda water”, “fruit juices”, “non-alcoholic beer” and “beer”.</i></p>
<p><i>Sunrider Corporation dba Sunrider International v Sunrise Plus (Pte) Ltd</i> [2024] SGIPOS 9</p>	<p>Sunrider International, an American multi-level marketing company based in California, is the proprietor of “S U N R I S E”, registered in Class 5 for herbal drinks. The applicant, Sunrise (Plus), is in the business of selling sports equipment, accessories, apparel and footwear manufactured by third parties. In addition, it offers a range of sports and health products under its own “SUNRISE” brand. In August 2018, the applicant applied to register “</p> <div style="text-align: center;">  </div> <p>” in Class 5 (under a single application) as well as various goods and services in Classes 29, 30 and 35 (under a separate multi-Class application). The applications were opposed by Sunrider International and the cases were heard together.</p> <p>In allowing the opposition, the hearing officer found the marks to be visually similar to a high degree, aurally identical, and conceptually similar to a large extent. For the goods comparison, the hearing officer found “herbal drinks” (covered under the earlier mark) to be similar to nutritional supplements and dietary supplements under the application mark in Class 5. In her view, the fact that the applicant had voluntarily limited its specification in this Class to exclude liquid herb concentrates and herbal drinks did not detract from the fact that confusion can still occur. As regards Class 35,</p>

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	<p>the hearing officer found that retail services for health food products and supplements to be similar to herbal drinks as a good. And since the application was a multi-Class one, even though there was no similarity between the products applied for in Classes 29 and 30 to the opponent’s herbal drinks in Class 5, the hearing officer took the view that the opposition should succeed in relation to the entire application on the basis that partial oppositions cannot be allowed in Singapore: see [105] of the decision.</p>
<p><i>Apple Inc v Penta Security Inc</i> [2024] SGIPOS 10</p>	<p>Apple Inc was unsuccessful in its bid to oppose an application by Penta Security, a South Korean company in the business of providing IT security services, to register the “WAPPLES” mark in Class 9 for “<i>Recorded computer software; recorded computer operating programs; recorded computer programs; computers; computer memories</i>”. In the opposition, Apple relied on a number of its earlier “APPLE” registrations in Class 9. The hearing officer found that the competing marks were not similar, whether visually, aurally or conceptually. Consequently, the grounds of opposition which required a finding a similarity of marks failed at the first threshold. For completeness, Apple Inc also pleaded that the applicant had applied to register the mark in bad faith but was unable to persuade the hearing officer that the choice of “WAPPLES” — which she found to be an invented word and distinctive and on its own merit dominant as a whole — could be said to be commercially unacceptable by reasonable and experienced persons in the trade.</p>

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