

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

[2024] SGIPOS 9

Trade Mark Nos. 40201816175S-02 and 40201816175S-01

IN THE MATTER OF TRADE MARK APPLICATIONS

IN THE NAME OF

SUNRISE PLUS (PTE) LTD

... Applicant

AND OPPOSITIONS BY

**SUNRIDER CORPORATION DBA SUNRIDER
INTERNATIONAL**

... Opponent

GROUND OF DECISION

TABLE OF CONTENTS

INTRODUCTION.....	1
BACKGROUND FACTS	5
 GROUNDS OF OPPOSITION.....	7
OPPONENT’S EVIDENCE.....	7
APPLICANT’S EVIDENCE.....	8
APPLICABLE LAW AND BURDEN OF PROOF	8
GROUND OF OPPOSITION UNDER S 8(2)(B).....	8
APPLICABLE LEGAL PRINCIPLES: MARKS-SIMILARITY ASSESSMENT	10
<i>Visual similarity.....</i>	<i>11</i>
<i>Aural similarity.....</i>	<i>16</i>
<i>Conceptual similarity.....</i>	<i>17</i>
<i>Conclusion on mark-similarity assessment.....</i>	<i>18</i>
GOODS / SERVICES SIMILARITY ASSESSMENT	18
40201816175S – 02 (Class 5).....	23
40201816175S – 01 (Classes 29 and 30).....	29
40201816175S – 01 (Class 35).....	31
LIKELIHOOD OF CONFUSION	33
<i>Factors relating to the impact of mark-similarity</i>	<i>35</i>
<i>Factors relating to the impact of good / service similarity.....</i>	<i>48</i>
CONCLUSION ON SECTION 8(2)(B).....	50
GROUND OF OPPOSITION UNDER SECTION 8(4)(B)(I).....	50

SIMILARITY OF MARKS	54
WELL-KNOWN IN SINGAPORE	54
CONCLUSION ON SECTION 8(4)(B)(I)	55
GROUND OF OPPOSITION UNDER SECTION 8(7)(A).....	55
GOODWILL	57
MISREPRESENTATION.....	58
DAMAGE	58
CONCLUSION ON SECTION 8(7)(A).....	58
OVERALL CONCLUSION.....	58
COSTS	59

Sunrider Corporation dba Sunrider International

v

Sunrise Plus (Pte) Ltd

[2024] SGIPOS 9

Trade Mark Nos. 40201816175S-02 and 40201816175S-01


Principal Assistant Registrar Sandy Widjaja
17 September 2024

13 December 2024

Principal Assistant Registrar Sandy Widjaja:


Introduction

1 This is a consolidated action for oppositions against the following marks:¹

S/N	Application Marks	Goods
1	 40201816175S-02 Relevant date: 16 August 2018 (Relevant Date) ²	Class 05: Nutritional supplements for humans; Nutritional supplement energy bars; Dietary and nutritional supplements; Powdered nutritional supplement drink mixes; Powdered nutritional supplement energy drink mixes; Dietetic substances adapted for

¹ The marks were originally filed as a single multi-class application under 40201816175S on 16 August 2018. This application was divided into the two applications which are the subject of these opposition proceedings. The amendment to the original application for division was published on 7 July 2023 (see AWS at [2], defined at footnote 20 below).

² This is the date of application of the Application Mark(s). It is important as only evidence which is dated *before* the Relevant Date can be taken into account when assessing whether the relevant ground of opposition has been established.

		<p>medical use, dietetic foods and beverages; dietary supplements; functional foods and supplemental foods in this class; nutritional supplements; nutritional additives and supplements; vitamins and vitamin formulations for human consumption; minerals and mineral formulations for human consumption; casein dietary supplements; milk protein; casein; proteins; protein bars.</p>
<p>2</p>	 <p>40201816175S-01 Relevant date: 16 August 2018</p>	<p>Class 29: Dairy products; protein products for human consumption, namely, protein milk; protein soybased bars; yoghurt, drinking yoghurt and yoghurt preparations; preserved food products of vegetables; preserved food products of fruits; preserved, dried or cooked fruits and vegetables; whey</p> <p>Class 30: Chocolate; Chocolate products and chocolate-based products; Dairy chocolates; Chocolate coated nuts or fruits; Chocolate coated fruits; Chocolate coated nuts; Dark chocolate; White chocolate; Milk chocolate; Filled chocolate; Filled chocolates; Chocolate confections; Chocolate candies;</p>

		Chocolate powder; Chocolate sauce; Chocolate-based spreads with or without nuts; Chocolate confectionery containing pralines; Pralines made of chocolate; Chocolates with mint flavoured centres; Chocolate confectionery having a praline flavour; Chocolates in the form of pralines; Cocoa; Cocoa products; Cocoa mixes; Cocoa spreads; Cocoa powder; Instant cocoa powder; Coffee; coffee flavorings; Flavouring syrups for use in coffee espresso and/or cappuccino; Chocolate-covered coffee beans; Chocolate bark containing ground coffee beans; Chocolate bars; Chocolate-based bars; Chocolate coated nougat bars; Chocolate-based meal replacement Bars; Foodstuffs containing principally of chocolate; Chocolate-based ready to-eat food bars; high-protein cereal bars; high-energy cereal bars; coffee or cocoa-based beverages with or without milk; tea; coffee-based beverages; chocolate based beverages; beverages made from chocolate; chocolate drink preparations;
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	<p>chocolate beverages with milk; Spices; Powdered spices; Mixed spices; Marinades containing spices.</p>
	<p>Class 35: Promotional Services; Online market place services; Retail services; Distribution services, namely, wholesale services; Distribution services, namely, wholesale services featuring a wide variety of consumer goods including sports related goods, sporting equipments, sporting articles, footwears, foodstuffs, clothing, bags, exercise equipments, health supplements and health foods, including through means of the Internet and the world wide web; Promotion of goods and services through sponsorship of events and competitions; Promotion of sports competitions and events; Promotions of sports personalities, sports goods and other consumer goods; Advertising and marketing including promotion of products and services of third parties through sponsorship arrangements and license agreements relating to a wide variety of consumer goods, sports events and sports goods;</p>

		Retail and wholesale services in respect of dietetic foods, health food products, nutritional additives and supplements, vitamins and vitamin formulations for human consumption, minerals and mineral formulations for human consumption, herbal supplements and formulations for human consumption, spreads, proteins and protein products for human consumption, probiotic products, casein, including the retailing and wholesaling of such goods via the Internet and the world wide web; information, consultancy and advice in relation to the aforesaid services.
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Background facts

2 Sunrider Corporation, doing business as Sunrider International (“Opponent”),³ deposed that it is a privately held multi-level marketing company based in Torrance, California, and was incorporated in 1982.⁴ The Opponent was founded in the United States by Taiwanese herbalist, Mr Chen Tei Fu (“Mr Chen TF”) with a view to starting a business marketing health products based on traditional Chinese herbal medicines.⁵ By 1990, the

³ Thereafter the term will include the Opponent’s related entities.

⁴ Opponent’s 1st and 2nd SD (defined in [6(a) & (b)] below), both at [4].

⁵ Opponent’s 1st and 2nd SD, both at [4].

Opponent had expanded into the Asia-Pacific market and expansion into Europe followed in 1992.⁶

3 The Opponent deposed that it chose Singapore as one of its key manufacturing bases and opened a manufacturing plant here in 1997.⁷ As of 2023, the Opponent operates in nearly 40 countries and has regional offices in 20 of them, including Singapore.⁸

4 Sunrise (Plus) Pte Ltd (“Applicant”) deposed that together with its related entities⁹ (hereafter, all references to “Applicant” shall include its related entities), the Applicant has been leading wholesalers and distributors of sports apparatus and equipment, sports accessories, apparel, sports footwear and health and wellness-related goods since the late 1950s.¹⁰ The Applicant deposed that in or around the early 1960s, the Applicant began to exclusively distribute products, including Yonex and Mikasa.¹¹ To-date, the Applicant continues to be the exclusive distributor of Yonex and Mikasa products across 15 Asian countries.¹² The Applicant also deposed that, in addition to the above, the Applicant offers a range of sports and health products under its own “Sunrise” brand.¹³

⁶ Opponent’s 1st and 2nd SD, both at [4].

⁷ Opponent’s 1st and 2nd SD, both at [4].

⁸ Opponent’s 1st and 2nd SD, both at [4].

⁹ See Applicant’s SD (defined at [7] below) at [4].

¹⁰ Applicant’s SD at [4].

¹¹ Applicant’s SD at [5].

¹² Applicant’s SD at [5].

¹³ Applicant’s SD at [6].

Grounds of Opposition

5 The Opponent relies on Sections 8(2)(b), 8(4)(b)(i) and 8(7)(a) of the Trade Marks Act 1998 (“Act”) in these proceedings. The Opponent confirmed at the hearing that it *no* longer wishes to pursue the ground of opposition under Section 8(4)(b)(ii) of the Act.¹⁴

Opponent’s evidence

6 The Opponent’s evidence comprises the following:

(a) statutory declaration of Mr Kevin Chang, Associate Corporate Counsel of the Opponent (“Mr Chang”), in relation to 40201816175S-01,¹⁵ dated 12 April 2023 (“Opponent’s 1st SD”);

(b) statutory declaration of the same Mr Chang, in relation to 40201816175S-02,¹⁶ dated 12 April 2023 (“Opponent’s 2nd SD”);¹⁷ and

(c) statutory declaration of Ms Sunny Beautler, Chief Executive Officer of the Opponent, in relation to both 40201816175S-01 *and* 40201816175S-02, dated 12 June 2024 (“Opponent’s 3rd SD”).

¹⁴ See below, the Opponent dropped the ground of objection under section 8(4)(b)(ii) at the point of submission of its written submissions dated 19 August 2024.

¹⁵ In relation to classes 29, 30 and 35.

¹⁶ In relation to class 5.

¹⁷ It would appear that the Opponent’s 1st SD is *almost identical* to the Opponent’s 2nd SD *except for* Exhibit 12 of the Opponent’s 1st SD which is replicated only at Exhibit 13 of the Opponent’s 2nd SD.

Applicant’s evidence

7 The Applicant’s evidence comprises the following:

- (a) statutory declaration of Shaan Seth (“Mr Seth”), Legal Manager of the Applicant, in relation to both 40201816175S-01 and 40201816175S-02, dated 1 January 2024 (“Applicant’s SD”).

Applicable law and burden of proof

8 The applicable law is the Act. The undisputed burden of proof for the oppositions fall on the Opponent.

Ground of Opposition under s 8(2)(b)

9 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.

10 The Opponent relies, in the main,¹⁸ on its earlier registered mark as follows:

Opponent’s Earlier Mark	Goods
S U N R I S E	Class 5 Herbal drinks included in Class 5

¹⁸ As the Opponent indicated at the Pre-Hearing Review dated 15 July 2024.

11 The Opponent also submitted that it has several unregistered marks (Opponent’s Unregistered Marks). They do not add anything to these opposition proceedings but are listed below for completeness:¹⁹

S/N	Opponent’s Unregistered Marks	Product
1		Liquid Herb Food Concentrate, Box of 42 0.5 fl oz./15ml bottles.
2		Dietary Supplement Herbal Liquid Concentrate, Box of 10 0.5 fl oz./15ml bottles.
3		Dietary Supplement Herbal Liquid Concentrate, Box of 10 0.5 fl oz./15ml bottles.

12 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under section 8(2)(b) (at [15] and [55]):

[15]...The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are *assessed individually before* the final element which is assessed in the round.

...

[55] 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*.

[Emphasis in italics mine]

¹⁹ Opponent’s written submissions (OWS) at [1.5] – [1.6].

13 It is only if the first two threshold requirements have been met that the issue of likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

Applicable legal principles: Marks-similarity assessment

14 The law in relation to this issue is not in dispute and is as follows (*Staywell* at [15] to [30]):

- (i) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court’s inquiry. Trade-offs can occur among the three aspects of similarity.
- (ii) Technical distinctiveness (discussed further below) is an *integral*²⁰ factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.
- (iii) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.

²⁰ This has been confirmed in the case of *V V Technology Pte Ltd v Twitter, Inc.* [2023] 5 SLR 513 where Goh Yihan JC (as he then was) emphasized at [79] that it is important to “not treat distinctiveness as a separate, threshold enquiry”.

- (iv) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- (v) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- (vi) The assessment of marks similarity is mark-for-mark without consideration of any external matter.

[Emphasis in italics mine]

15 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("*Hai Tong*") at [40(c)] and [40(d)]:


[40(c)] The *relevant viewpoint* is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, *not* that of an unthinking person in a hurry.

[40(d)] It is assumed that the average consumer has "*imperfect recollection*" such that the two contesting marks are *not* to be compared or assessed side by side (and examined in detail). Instead, the court will consider the *general impression* that will likely be left by the essential or dominant features of the marks on the average consumer.

[Emphasis in italics mine]

Visual similarity

16 For ease of comparison, the relevant marks are as follows:

Opponent's Earlier Mark	Application Mark(s) ²¹
S U N R I S E	

17 The Applicant relied on the test in *Hai Tong* (at [62]) for the purposes of assessing the visual similarity of composite marks:²²

[62(e)] The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:

(i) the device is significant and large (see, eg, the decision of the European General Court in *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Case T-415/09) (29 September 2011)*);

(ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component (see *Quelle AG* at [60]; see also *Sime Darby* at [18] and [20]–[21]) or of similar goods of a superior quality (see the decision of the CFI in *Saiwa SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Case T-344/03) [2006] ECR II-1097* at [41] and [45]); or

(iii) the device component is of a complicated nature (see, eg, *Waseem Ghias t/as Griller v Mohammed Ikram t/as The Griller Original, Esmail Adia t/as Griller King, Shahzad Ahmad t/as Griller Hut, Griller Original Limited, Griller Hut Limited [2012] EWPC 3*).

But usually not where:

²¹ I am of the view that the rectangle frame in the Application Mark does not help in the analysis at all (see Applicant's written submissions (AWS) at [38]).

²² AWS at [23].

(iv) the device is simple and will not evoke any particular concept for the average consumer (see, eg, the decision of the European General Court in *Kavaklidere-Europe v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and Yakult Honsha Kabushiki Kaisha* (Case T-276/09) [2012] ETMR 45);

(v) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods (see *Shaker (CFI)* at [42]); or

(vi) the device component is more likely to be perceived as a *decorative* element rather than as an element indicating commercial origin (see *Trubion* at [45] and *Oberhauser* at [47]; see also *Wassen*).

[Emphasis in italics mine]

18 Applying the above principles, I am of the view that:

- (a) the device in the Application Mark is *not* large; and
- (b) it is most likely to be perceived as a “decorative element”.²³

19 I accept the Applicant’s submission that the “anthropomorphic element”²⁴ of the device “sets [the device] apart from more conventional depictions of the sun”²⁵ and that the device is at the left of the mark and appears *before* the word “Sunrise”. However, the device, *in essence*, depicts the sun and in terms of size, the device at most occupies about *a third* of the Application Mark. Thus, while I agree that the device is “not merely a reinforcement of the

²³ I disagree with the Applicant in this regard (see *AWS* at [29]).

²⁴ *AWS* at [25].

²⁵ *AWS* at [25].

word “Sunrise”²⁶ and “should not be ignored”,²⁷ the overall dominant component of the mark is still the word “Sunrise”.

20 In relation to the word “Sunrise”, the Opponent argued that it is inherently distinctive because it does not describe the goods of the Opponent (i.e. “Herbal drinks included in Class 5”) at all.²⁸

21 Conversely, the Applicant argued that “the lack of inherent technical distinctiveness...extends to...*allusions* to desirable attributes of such goods and services” (emphasis in the original).²⁹

22 The Applicant relied on, amongst others,³⁰ *Monster Energy v Glamco Co, Ltd* [2021] 3 SLR 319,³¹ where the court observed that:³²

[49] 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.” (emphasis by the Applicant)

²⁶ AWS at [36].

²⁷ AWS at [39].

²⁸ OWS at [4.8].

²⁹ AWS at [18].

³⁰ The Opponent also relied on *Fair Isaac Corporation v LAC Co., Ltd.* [2022] SGIPOS 19, where the learned Principal Assistant Registrar found that “the word “FALCON” which describes a bird which is very fast, has sharp eyesight and is highly intelligent (among numerous positive attributes) clearly has allusive and laudatory connotations for goods and services relating to the prevention of fraud” (see AWS at [18]).

³¹ AWS at [19].

³² *Monster Energy v Glamco Co, Ltd* [2021] 3 SLR 319 at [49].

23 In the same vein, the Applicant argued that:³³

[17] The word “SUNRISE” is not an invented word. It is an ordinary English word...The word “SUNRISE” is widely recognised and used in various contexts...to convey ideas of new beginnings, hope, and renewal...Health products...align with this concept...Both the word “SUNRISE” and the design drawings of sunrises are common fodder to the consumer.

24 Specifically, the Applicant argued that the word “Sunrise”, belongs to a family of words commonly linked with “renewal, rejuvenation and vitality”³⁴ and “does not have a high level of technical distinctiveness, especially when used in relation to health and wellness products”.³⁵ However, I am of the view that the word “Sunrise” in relation to health-related goods in Class 5 can be distinguished from “Monster” for energy drinks.

25 The Applicant submitted that the “low distinctiveness”³⁶ of the word, “Sunrise”, is “supported by the state of the register”³⁷ whereby “the word “Sunrise” and similar marks thereof are being utilised by third party proprietors”.^{38 39}

Marks	Class 5	Class 29	Class 30	Class 35
<i>Sunrise</i>	1	8	9	5
Sunshine	6	16	24	14

³³ AWS at [17].

³⁴ AWS at [21].

³⁵ AWS at [21].

³⁶ Applicant’s rebuttal written submissions (ARW) at [9].

³⁷ ARW at [9].

³⁸ ARW at [9].

³⁹ Excluding the Applicant and Opponent (ARW at [9]).

Sunny	8	31	18	7
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26 First, the above should have been submitted via evidence rather than submissions. Secondly and more importantly, I observe from the above that the word “Sunrise” only appeared *once* in Class 5.

27 Having regard to all of the above, I am of the view that the Opponent’s Earlier Mark is distinctive to an *average* degree and that the marks are visually similar to a high degree.

28 In coming to this decision, I am mindful of the Applicant’s submission that “[a] greater latitude of permissible use should be granted [here] as the [tribunal] should be wary of granting a monopoly over the use of common words”⁴⁰ and that “Sunrise” being a common English word, should be “left open for other honest traders to choose...based on the concept or idea of a “sunrise” for different goods and services”.⁴¹ However, this concern has *not* been borne out in relation to Class 5 goods based on the Applicant’s submission above.

Aural similarity

29 The test for aural similarity is also not in dispute. The Court of Appeal in *Staywell* at [23] - [33] provided two main approaches, namely:

- (a) "Dominant Component Approach", having special regard to the distinctive or dominant components of the marks; and

⁴⁰ AWS at [14].

⁴¹ AWS at [21].

(b) Quantitative Assessment Approach”, where the competing marks are assessed to see if they have more syllables in common than not.

30 In this case, regardless of the approach taken, it is clear that the marks are aurally identical (since the device will not be taken into account).

Conceptual similarity

31 Similarly, the test for conceptual similarity is trite. The Court of Appeal in *Staywell* expounded at [35] as follows:

[35] ...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole... *Greater care* is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts...

[Emphasis in bold and italics mine]

32 I am mindful that I have accepted that⁴² the “anthropomorphic element” of the device “sets [the device] apart from more conventional depictions of the sun”. However, given the dominance of the word “Sunrise”, and since the device *fundamentally*⁴³ portrays the sun and is *consistent* with the idea of a “sunrise”, I am of the view that the marks are conceptually similar to a large extent.

⁴² See above at [19].

⁴³ Despite any possible nuanced ideas such as grandeur, authority and prominence (see AWS at [36]).

Conclusion on mark-similarity assessment

33 In light of all the above, I am of the view that the marks are visually and conceptually similar to a large extent and aurally identical, such that the marks are overall more similar than dissimilar.

Goods / Services similarity assessment

34 For ease of reference, the goods are as follows:

Opponent’s Earlier Mark	Application Mark
Class 5	40201816175S-02
Herbal drinks included in Class 5	<p>Class 05: <i>Nutritional supplements for humans; Nutritional supplement energy bars; Dietary and nutritional supplements; Powdered nutritional supplement drink mixes; Powdered nutritional supplement energy drink mixes; Dietetic substances adapted for medical use, dietetic foods and beverages; dietary supplements; functional foods and supplemental foods in this class; nutritional supplements; nutritional additives and supplements; vitamins and vitamin formulations for human consumption; minerals and mineral formulations for human consumption; casein dietary supplements; milk protein; casein; proteins; protein bars.</i></p>
	40201816175S-01

	<p>Class 29: Dairy products; protein products for human consumption, namely, protein milk; protein soybased bars; yoghurt, drinking yoghurt and yoghurt preparations; preserved food products of vegetables; preserved food products of fruits; preserved, dried or cooked fruits and vegetables; whey</p>
	<p>Class 30: Chocolate; Chocolate products and chocolate-based products; Dairy chocolates; Chocolate coated nuts or fruits; Chocolate coated fruits; Chocolate coated nuts; Dark chocolate; White chocolate; Milk chocolate; Filled chocolate; Filled chocolates; Chocolate confections; Chocolate candies; Chocolate powder; Chocolate sauce; Chocolate-based spreads with or without nuts; Chocolate confectionery containing pralines; Pralines made of chocolate; Chocolates with mint flavoured centres; Chocolate confectionery having a praline flavour; Chocolates in the form of pralines; Cocoa; Cocoa products; Cocoa mixes; Cocoa spreads; Cocoa powder; Instant cocoa powder; Coffee; coffee flavorings; Flavouring syrups for use in coffee espresso and/or cappuccino; Chocolate-covered coffee beans; Chocolate bark containing ground coffee beans; Chocolate bars; Chocolate-based bars; Chocolate coated nougat bars; Chocolate-based meal</p>

	<p>replacement Bars; Foodstuffs containing principally of chocolate; Chocolate-based ready to-eat food bars; high-protein cereal bars; high-energy cereal bars; coffee or cocoa-based beverages with or without milk; tea; coffee-based beverages; chocolate based beverages; beverages made from chocolate; chocolate drink preparations; chocolate beverages with milk; Spices; Powdered spices; Mixed spices; Marinades containing spices.</p>
	<p>Class 35: Promotional Services; Online market place services; Retail services; Distribution services, namely, wholesale services; Distribution services, namely, wholesale services featuring a wide variety of consumer goods including sports related goods, sporting equipments, sporting articles, footwears, foodstuffs, clothing, bags, exercise equipments, health supplements and health foods, including through means of the Internet and the world wide web; Promotion of goods and services through sponsorship of events and competitions; Promotion of sports competitions and events; Promotions of sports personalities, sports goods and other consumer goods; Advertising and marketing including promotion of products and services of third parties through sponsorship arrangements and license</p>

	agreements relating to a wide variety of consumer goods, sports events and sports goods; <i>Retail and wholesale services in respect of dietetic foods, health food products, nutritional additives and supplements, vitamins and vitamin formulations for human consumption, minerals and mineral formulations for human consumption, herbal supplements and formulations for human consumption, spreads, proteins and protein products for human consumption, probiotic products, casein, including the retailing and wholesaling of such goods via the Internet and the world wide web; information, consultancy and advice in relation to the aforesaid services.</i>
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The items which are italicised are goods and services which are arguably similar to the goods for which the Opponent’s Earlier Mark is registered. I analyse this in detail below.

35 I would first like to deal with some preliminary issues:

- (a) The Applicant made a voluntary *limitation* to limit its specification in Class 5 by “excluding liquid herb concentrates and none of the foregoing being in the nature of herbal drinks included in Class 5” on 9 June 2023.⁴⁴ While I disagree with the Opponent that the limitation is a “tacit admission...of confusion or likelihood of

⁴⁴ AWS at [64].

confusion”,⁴⁵ I do agree with the Opponent that “the limitation...does *not* detract from the fact that confusion can still occur” (emphasis mine).⁴⁶

(b) I agree with the Applicant that,⁴⁷ for the purposes of comparison at this stage two of the analysis, only the *registered specification*, that is, “[h]erbal drinks included in Class 5” can be considered. In particular, the fact that the Opponent is “considering to market”⁴⁸ its “Sunrise” drink in both powdered and liquid form cannot be taken into consideration.

(c) While marketing materials may assist in the assessment of the nature, function and purpose of a good, they are *not* conclusive. At the end of the day, it is the specification which has been registered or applied for (as the case may be), and nothing more, which is subject to scrutiny.⁴⁹

(d) Last but not least, the *whole* class will “fail” as long as *one* of the goods/services is similar.⁵⁰ In a multi-class application, this means that the *whole* application will “fail” as long as *one* of the goods/services in *one* of the classes is similar.⁵¹

⁴⁵ OWS at [4.24].

⁴⁶ OWS at [4.24].

⁴⁷ AWS at [58].

⁴⁸ OWS at [4.25].

⁴⁹ For example, the Opponent submitted that the registered specification is intended to “enhance energy levels” (see Opponent’s 1st SD at Exhibit 11 at page 219). In any event, the evidence can only be accorded little weight as it is unclear if the marketing materials were circulated in Singapore.

⁵⁰ Assuming likelihood of confusion is established, of course.

⁵¹ See [106] below.

36 It is trite that the relevant factors are those set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”), which have been endorsed in *Staywell* at [43]:

- (i) the respective uses of the respective goods or services;
- (ii) the respective users of the respective goods or services;
- (iii) the physical nature of the goods or acts of service;
- (iv) the respective trade channels through which the goods or services reach the market;
- (v) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be found on the same or different shelves;
- (vi) the extent to which the respective goods or services are competitive.

I will address the above factors, but not necessarily in the order as listed above.

40201816175S – 02 (Class 5)

37 For ease of reference, the Applicant’s goods of interest which are arguably similar to the goods for which the Opponent’s Earlier Mark is registered are extracted below:

<i>Opponent’s Earlier Mark</i>	<i>Application Mark</i>
Class 5 Herbal drinks included in Class 5	40201816175S-02 Class 05: <i>Nutritional supplements for humans; Dietary and nutritional supplements; dietary supplements; nutritional supplements; nutritional additives and supplements; vitamins and vitamin formulations for human</i>

	<i>consumption; minerals and mineral formulations for human consumption...</i>
--	--

38 It is obvious that both marks are in the *same* class. I am mindful that the Nice Classification is only an administrative tool which aids registration. Nonetheless, I am of the view that it would be helpful to have regard to the same:

The Class heading for Class 5 reads:

Pharmaceuticals, medical...preparations...dietetic food and substances adapted for medical...use...dietary supplements for human beings...

The Explanatory notes are as follows:

Class 5 includes mainly *pharmaceuticals* and other preparations for *medical...purposes*.

This Class includes, in particular:

- ...
- dietary supplements intended to *supplement* a normal diet or to have *health benefits...*
- meal replacements and *dietetic food and beverages* adapted for *medical...use*.

[Emphasis in italics mine]

Uses and Physical nature of the goods

39 The Applicant submitted that:⁵²

[34] According to the literal meaning of “dietary supplements”, their purpose is to *supplement* the nutritional intake of the normal human diet, ensuring that individuals receive the necessary vitamins, minerals, and nutrients that they might not otherwise obtain from food. The main objective of dietary supplements is to *fill gaps in an individual's nutritional intake*. These products are often formulated with vitamins, minerals, and other nutrients that are either *synthetically*

⁵² ARW at [34].

produced or derived from conventional chemical or pharmaceutical sources.

[Emphasis in italics mine]

40 In the same vein, the Applicant argued that the Opponent’s goods, namely, “[h]erbal drinks included in class 5” are not dietary supplements as they “do not have the primary objective of supplementing the diet with essential nutrients”.⁵³ Instead, “[t]hese herbal-based beverages, while having *medicinal or therapeutic* benefits, tend to focus on offering specific *herbal or botanical ingredients* that may support particular wellness goals...but are *not intended to replace or augment* the daily intake of vitamins and minerals...herbal drinks are more associated with *offering therapeutic or medicinal benefits* rather than addressing deficiencies in a person’s diet” (emphasis in italics mine).⁵⁴

41 However, the meaning of “dietary supplement” is *not* as narrow as the Applicant submitted it to be. The dictionary ⁵⁵ meaning of “dietary supplements” is “a *product* containing one or more vitamins, minerals or *other substances* that the body *needs* to be healthy” (emphasis mine). Britannica⁵⁶ defines “dietary supplement” as “any vitamin, mineral, *herbal product*, or other ingestible *preparation* that is added to the diet to *benefit* health” (emphasis mine).

⁵³ ARW at [35].

⁵⁴ ARW at [35].

⁵⁵ <https://dictionary.cambridge.org/us/dictionary/english/dietary-supplement> (accessed on 11 November 2024).

⁵⁶ <https://www.britannica.com/science/dietary-supplement> (accessed on 11 Nov 2024)

42 Last but not least, the Health Sciences Authority defines “health supplement” as follows:⁵⁷

A health supplement is a product that is used to *supplement a diet* and to *support or maintain, enhance, and improve* the *healthy functions* of the human body...

A health supplement must also contain *one or more, or a combination* of the following ingredients:

- (a) *Vitamins, minerals...*
- (b) *Substances derived from natural sources*, including animal, mineral, and *botanical materials...*
- (c) *Synthetic sources* of ingredients mentioned in (a) and (b).

A health supplement must be administered in small unit doses in *dosage form* such as the following:

- Capsules
- Softgels
- *Tablets*
- *Liquids*
- Syrups

[Emphasis in italics mine]

I note that the above relates to “health supplement” rather than “dietary supplement” but I am of the view that they are in principle similar.

43 In light of all of the above, it is *artificial* to attempt to draw a distinction between:

- (a) “[supplementing]...nutritional intake”⁵⁸ versus “offering... medical benefits”;⁵⁹
- (b) having natural versus synthetic sources; and

⁵⁷ <https://www.hsa.gov.sg/health-supplements/overview> (accessed on 11 November 2024)

⁵⁸ Above at [39].

⁵⁹ Above at [39].

(c) the various physical forms, including tablets and liquids.^{60 61}

44 In conclusion, there is an overlap in relation to *uses* and *physical nature* of the goods.

Users and whether the goods are competitive

45 The Applicant submitted:⁶²

[36] ...Consumers who seek out herbal products are typically more inclined toward *natural, plant-based remedies* and are often concerned with *avoiding synthetic chemicals or pharmaceutical ingredients*. They may have preferences rooted in traditional medicine or wellness practices and prioritising natural ingredients that are believed to offer specific health benefits in a more organic and holistic way.

[Emphasis in italics mine]

46 I am of the view that this is only *one segment* of the consumers of the Opponent's products. There will be others who will *not* be concerned about this distinction and are simply looking for products, natural or otherwise, to supplement, maintain or improve their health, regardless of its source or nature. Following the above, this *British Sugar* factor is neutral here.

47 Similarly, depending on the type of consumer (whether they are sensitive as to the sources of the products, natural or otherwise), the goods can be competitive or complementary.

48 In conclusion, I am of the view that the *British Sugar* factors of users and the nature of the goods are neutral.

⁶⁰ See AWS at [51].

⁶¹ See also AWS at [69] and [70].

⁶² ARW at [36].

Trade channels and whether they are found on the same shelves in the supermarket

49 One of the peculiarities of this case is that the Opponent is a “privately held multi-level marketing company”.⁶³ At the hearing, the Opponent submitted that it falls under an exception under the Multi-Level Marketing and Pyramid Selling (Prohibition) Act 1973 (“MLM Act”).⁶⁴ However, it did not provide further details.

50 Regardless of the scheme or exception under which the Opponent operates pursuant to the MLM Act, for the purposes of Section 8(2)(b), it is the *notional* trade channels which is relevant here.

51 In this regard, I am of the view that the “trade channel” is a neutral factor here as there will be entities which focus only on natural-based health products⁶⁵

⁶³ For context, it is helpful to have reference to the MLM Act to have a sense of what a “multi-level marketing company” entails. Section 2 of the MLM Act reads:

“pyramid selling scheme or arrangement” means any scheme or arrangement for the distribution or the purported distribution of a commodity by which —

- (a) a person may in any manner **acquire a commodity** or a right or a licence to acquire the commodity for sale, lease, licence or other distribution;
- (b) that person **receives any benefit**, directly or indirectly, as a result of —

- (i) the **recruitment**, acquisition, action or performance of one or more additional participants in the scheme or arrangement; or
 - (ii) the **sale**, lease, licence or other distribution of the **commodity by one or more additional participants** in the scheme or arrangement;
- and

- (c) **any benefit is or may be received by any other person** who promotes, or participates in, the scheme or arrangement (other than a person referred to in paragraph (a) or an additional participant referred to in paragraph (b)).

[Emphasis in italics mine]

⁶⁴ See section 2(2) of the MLM Act.

⁶⁵ In this regard “traditional Chinese medicine stockists or specialist stores” (see AWS at [71]) is merely one of the many possible trade channels.

while there will be others which produce health preparations *both* from natural as well as synthetic sources.

52 Apart from the specialist stores as well as pharmacies, the goods can also be found the supermarkets. While they may not be found on the same shelves, they are likely to be found in the same aisle.⁶⁶ Thus in relation to this last factor (as to the shelves on which the goods can be found in the supermarket), I am of the view that it is also neutral.⁶⁷

Conclusion

53 In summary, applying the *British Sugar* factors,

- (a) The uses and physical nature of the goods are similar; while
- (b) The users and nature of the goods (whether they are complimentary or competitive) as well as the trade channels, including the shelves on which the goods are displayed in the supermarket, are neutral factors.

54 In light of all of the above, in relation to 40201816175S – 02 (Class 5), I am of the view that the goods are similar.

40201816175S – 01 (Classes 29 and 30)

55 I will deal with Classes 29 and 30 together.

⁶⁶ The Applicant submitted that the Opponent’s goods “may” require refrigeration (ARW at [42]). However, there is nothing in the evidence to suggest that this is the case.

⁶⁷ In any event, even if I am wrong in relation to this, it does not affect my conclusion below.

56 As the Applicant submitted, the relevant goods under Classes 29 and 30 can be broadly categorised as follows:⁶⁸

(a) *Class 29*: Dairy products, protein products, yoghurt, preserved foods, whey.

(b) *Class 30*: Chocolate products, cocoa products, coffee, flavourings, chocolate and cereal bars, coffee and cocoa-based beverages, spices, tea.

57 At the outset, I agree with the Applicant that the Explanatory Note for Class 5 clarifies that Class 5 “includes pharmaceuticals and other preparations for medical use but *excludes* meal replacements and dietetic food and beverages *not* specified for such uses”⁶⁹ (emphasis mine). This exclusion specifically provided in the Explanatory Note for Class 5 sets the context for the comparison process.

*Uses, users and trade channels of the goods etc*⁷⁰

58 The uses are clearly different. As alluded above, Class 5 mainly deals with pharmaceuticals and medical preparations. This is certainly *not* the case for *Class 29* and *Class 30*. This also means that the respective users as well as trade channels are different.

⁶⁸ AWS at [45]

⁶⁹ AWS at [49].

⁷⁰ It is not meaningful to discuss whether the goods are substitutes or complimentary or the physical nature of the goods etc since the goods are for a completely different purpose.

Conclusion

59 In conclusion, the goods in relation to 40201816175S – 01 (Classes 29 and 30) are *dissimilar*.

40201816175S – 01 (Class 35)

60 Again, for ease of reference, the Applicant’s services of interest which are arguably similar to the goods for which the Opponent’s Earlier Mark is registered are as follows:

<i>Opponent’s Earlier Mark</i>	<i>Application Mark</i>
	40201816175S-01 (Class 35)
Class 5 Herbal drinks included in Class 5	Class 35: <i>Retail...services in respect of dietetic foods, health food products, nutritional additives and supplements, vitamins and vitamin formulations for human consumption, minerals and mineral formulations for human consumption, herbal supplements and formulations for human consumption...including the retailing...of such goods via the Internet and the world wide web...</i>

61 As the Applicant submitted, “[t]he goods covered by the [Opponent’s Earlier Mark] may be found in a store selling medicinal or *health products*” (emphasis mine).⁷¹

62 I am mindful that the case of *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“*Guccitech*”) supports the argument that it is possible for goods and the services in Class 35 to be similar, but only to the following *narrow extent*.⁷²

[35] As far as the specification of services in T1319783Z is concerned, the Opponent cites Tan, *Law of Trade Marks and Passing Off in Singapore* (3rd ed, 2014) at [8.115] that:

“goods and services can also be regarded as similar to each other. This will, for instance, be the case where *the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such, and vice versa*”.

I would respectfully agree with the general view expressed by the learned author Mr Tan Tee Jim SC, although I consider that the example given is the *only circumstance* where goods could be found to be similar to the retail services in a specification...

[Emphasis in italics mine]

63 It is to be recalled that for the purposes of stage two of the analysis, it is the *notional* specifications which must be taken into account. Applying *Guccitech*, the Applicant’s services of interest (reproduced at [60] above) are similar to the goods for which the Opponent’s Earlier Mark is registered.

⁷¹ AWS at [59]. There is “retail services in respect of...nutritional additives and supplements”, amongst others in Class 35 above.

⁷² *Guccitech* at [35].

Conclusion

64 In light of my conclusions as to goods/services similarity, I will proceed to stage three of the analysis for the Application Mark 40201816175S-02 (Class 5) as well as Application Mark 40201816175S-01 (Class 35 only).

Likelihood of Confusion

65 The law pertaining to the issue of likelihood of confusion is not in dispute. The relevant principles for assessing likelihood of confusion have been expounded by the Court of Appeal in *Staywell* at [60], [64], [83] and [96]:

- (i) In opposition proceedings, the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the *actual and notional fair uses* to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the *full range of such rights* sought by the applicant *by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses* to which the applicant may put his mark should registration be granted.
- (ii) Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers' ability to understand where those goods and services originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. However, the plain words of section 8(2) do *not* have

the effect of making a finding of confusion automatic upon the establishment of similarity of marks and goods or services.

- (iii) On the effect of the foregoing (i.e. similarity of marks and goods or services) on the relevant segment of the public – *extraneous* factors may be considered to the extent that they inform the court as to how the *similarity of marks and goods* will likely *affect* the consumer’s perception as to the source of the goods.
- (iv) The following represents a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry:
 - (a) Factors relating to the impact of *marks-similarity* on consumer perception:
 - (1) the *degree of similarity* of the marks themselves;
 - (2) the *reputation* of the marks (a strong reputation does *not* necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect);
 - (3) the *impression* given by the marks; and
 - (4) the *possibility of imperfect recollection* of the marks.
 - (b) Factors relating to the impact of *goods-similarity* on consumer perception (factors concerning the *very nature* of the goods without implicating any steps that are taken by the trader to differentiate the goods):

- (1) The *normal way* in, or the *circumstances* under which, consumers would *purchase goods* of that type;
- (2) Whether the products are *expensive or inexpensive* items;
- (3) Whether they would tend to *command a greater or lesser degree of fastidiousness and attention* on the part of prospective purchasers; and
- (4) The *likely characteristics of the relevant consumers* and whether the relevant consumers would or would not tend to *apply care* or have *specialist knowledge* in making the purchase.

[Emphasis in italics mine]

Factors relating to the impact of mark-similarity

66 I have already concluded above that the marks are visually and conceptually similar to a large extent and aurally identical, such that the marks are overall more similar than dissimilar. As the marks pertain to goods which are sold via retail, online or otherwise, I am of the view that it is the *visual* and *conceptual* aspects which take precedence.

67 I also note that, as the Principal Assistant Registrar commented in *Twitter, Inc. v VV Technology Pte Ltd* [2022] SGIPOS 4 (“*Twitter*”):⁷³

[112] The likelihood of confusion is not confined to consumers mistaking the Application Mark for the [Opponent’s Earlier Mark]. It can also be established by showing that consumers may perceive an *economic link* between the two marks. The Opponent’s submit that this could arise in two ways: (1) that the Application Mark is a *new iteration* of the [Opponent’s Earlier Mark]; and/or (2) that the Application Mark is a *modified mark* that the Opponent is using for *new closely-related*

⁷³ *Twitter* at [112].

[goods]...which are extensions of the Opponent's existing range of *[goods]*.

[Emphasis in italics mine]

68 I am of the view that the same two types of confusion can occur here, given the extent of similarities between the marks (and the goods and services).⁷⁴

69 In terms of reputation, the Opponent did not specifically address this factor. However, I will refer to the Opponent's submissions in relation to the Opponent's Earlier Mark being a well-known mark. The Opponent relied on the following evidence to show that the Opponent's Earlier Mark is well known in Singapore:⁷⁵

S/N	Description	Comments
1	The detailed history of the Opponent showing the global expansion of its business. It shows the market penetration of the Opponent's products globally. ⁷⁶	Does <i>not</i> show the extent to which Opponent's Earlier Mark is well known to a specific sector in Singapore.
	In particular, in 1997, the Opponent's manufacturing	As submitted by the Applicant, it is unclear if the products manufactured at the

⁷⁴ See AWS at [85] where the Applicant argued that there is no evidence that the Opponent uses the Opponent's Earlier Mark for *other products*.

⁷⁵ OWS at [5.5].

⁷⁶ Opponent's 1st SD at Exhibit 1 at pages 13 – 21.

	plant opened in Singapore to “support its worldwide growing business”. ^{77 78}	plant are intended for export. ⁷⁹ I agree with the Applicant that the reference to “[f]inished goods” being analysed to ensure that they meet the required quality control standards “before shipment” ⁸⁰ supports the proposition that products manufactured in Singapore are intended for export. ⁸¹
2	List of the Opponent’s Worldwide Offices (including the Singapore office) showing global reach of the Opponent’s products. ⁸²	Does <i>not</i> assist with regard to the issue as to whether the Opponent’s Earlier Mark is well known to a specific sector in Singapore.
3	Award of Grade A License status granted to the Opponent’s manufacturing plant for 18 consecutive years by Singapore’s Agri-Food and Veterinary	<i>Per</i> the Opponent’s own description, the award is in relation to “factory cleanliness, factory housekeeping, food hygiene, employee personal hygiene, staff training, and the performance record of the

⁷⁷ OWS at [5.5].

⁷⁸ Opponent’s 1st SD at Exhibit 1 at pages 13 – 21, in particular at page 16

⁷⁹ AWS at [100].

⁸⁰ Opponent’s 1st SD at Exhibit 2 at page 25 which is an excerpt of the Straits Times dated 7 July 2017 (see below).

⁸¹ AWS at [135].

⁸² Opponent’s 1st SD at Exhibit 6 at pages 35 – 44, in particular at page 43.

	Authority (“AVA”); ⁸³ it was also featured in the local newspapers, including The Straits Times ⁸⁴	factory”; ⁸⁵ ⁸⁶ it is <i>not</i> relevant to the issue of whether the Opponent’s Earlier Mark is well known to a relevant sector in Singapore.
4	Opening of the Singapore showroom ⁸⁷	This evidence is dated <i>after</i> the Relevant Date and cannot be taken into account. ⁸⁸
5	Small and Medium Enterprises (SME) award ⁸⁹	This award is due to the Opponent “contributing positively to [the] local economy”. ⁹⁰ However, as alluded to above, it is unclear if the products manufactured at the Opponent’s plant were slated for export. Even if the products were sold locally, the sales figures provided (see below at item 9) do

⁸³ Opponent’s 1st SD at Exhibit 2 at pages 23 – 24, dated 24 July 2018.

⁸⁴ Opponent’s 1st SD at Exhibit 2 at page 25, dated 7 July 2017.

⁸⁵ OWS at [5.5] at item 4.

⁸⁶ See also Opponent’s 1st SD at Exhibit 2 at page 24.

⁸⁷ Opponent’s 1st SD at Exhibit 3, pages 28 -29, dated 16 July 2022.

⁸⁸ The Registrar enquired at the hearing if there was any retail activity in the showroom. In response, the Opponent pointed to the term “customer” in the article (see Opponent’s 1st SD at Exhibit 3 at page 29). This is hardly evidence of retail activity in the Singapore showroom, much less evidence of the Opponent’s Earlier Mark being well known to a relevant sector in Singapore.

⁸⁹ Opponent’s 1st SD at Exhibit 4 at page 31, dated 12 March 2014.

⁹⁰ Opponent’s 1st SD at Exhibit 4 at page 31.

		not have any breakdown as to the sales pertaining to the Opponent's Earlier Mark.
6	Digital Momentum Index ranking. ^{91 92}	The articles were dated <i>after</i> the Relevant Date ^{93 94} and cannot be taken into account.
7	Founder of the Opponent featured in Direct Selling News, as one of the most influential women in the direct selling industry. ^{95 96}	This is <i>not</i> relevant to the issue of whether the Opponent's Earlier Mark is well known to a relevant sector in Singapore.
8	The Opponent's mark is registered extensively all over the world. ⁹⁷	<i>Per Novelty Pte Ltd v Amanresorts Ltd and another</i> [2009] 3 SLR(R) 216 ("Amanresorts"), see below at [85(b)], this is not relevant and is not taken into account.

⁹¹ Opponent's 1st SD at Exhibit 7, pages 46 – 69.

⁹² In addition, it would appear to relate to the USA; see AWS at [77(b)(2)].

⁹³ Dated 15 July 2021 at page 46.

⁹⁴ Dated 2 December 2020 at page 64.

⁹⁵ The Opponent also submitted (OWS at [5.5] item 8) that the article highlights the Opponent's success as a US\$100 million Club direct selling company. This represents the value of the Opponent's business (inclusive of its marks). But there is no breakdown in relation to the use of Opponent's Earlier Mark in Singapore.

⁹⁶ Opponent's 1st SD at Exhibit 8, pages 71 – 132, especially at pages 76 – 78.

⁹⁷ Opponent's 1st SD at Exhibit 9, pages 134 – 202.

9	Opponent's sales figures from 2005 to 2021. ⁹⁸	First, only the sales <i>in Singapore</i> for the period 2005 – 2018 can be taken into account. Secondly, there were no supporting documents such as invoices or purchase orders <i>at all</i> . ⁹⁹ Thirdly, there is no breakdown of sales figures in relation to the Opponent's Earlier Mark. ¹⁰⁰ Fourthly, the products (on which the marks are appended) were likely slated for export. ^{101 102}
10	Promotional materials ¹⁰³	Most of the evidence here cannot be taken into account for the following reasons: a) Pages 206 – 207 are screen shots of a website; they are dated <i>after</i> the Relevant Date. b) Pages 208 - 210 appear to be brochures; they are all dated <i>after</i> the Relevant Date.

⁹⁸ Opponent's 1st SD at Exhibit 10, pages 204.

⁹⁹ AWS at [100].

¹⁰⁰ AWS at [100].

¹⁰¹ AWS at [100].

¹⁰² See also AWS at [77(c)].

¹⁰³ Opponent's 1st SD at Exhibit 11, pages 206 – 246.

		<p>c) Pages 211 - 219 appear to be brochures / leaflets. All the materials are <i>undated</i>.¹⁰⁴</p> <p>d) Pages 220 – 246 are excerpts of magazines and calendars; it is <i>unclear</i> if the materials were circulated in Singapore.¹⁰⁵</p> <p>e) Pages 243 - 244 are <i>undated</i> while pages 245 – 246 are dated <i>after</i> the Relevant Date.</p>
11	List of awards and accolades the Opponent received ¹⁰⁶	<p>Page 260:</p> <p>a) Year 2014 – Sunrider won the SME Asia and Luminary Award; as alluded above at item 5, it is unclear if the products manufactured at the Opponent’s plant were exported. Even if the products were sold locally, the sales figures (see below at [70]) do</p>

¹⁰⁴ The only reference to the Opponent’s Earlier Mark is at page 219 for material which appears to be distributed in the US (see Reference to “Food and Drug Administration” which is a US based entity).

¹⁰⁵ There are images of the Opponent’s Earlier Mark at pages 230, 232, 234, 236, 238, 240 and 242.

¹⁰⁶ Opponent’s 1st SD at Exhibit 13 at pages 260 – 262.

		<p>not have any breakdown as to the sales pertaining to the Opponent’s Earlier Mark.</p> <p>b) Year 2013 – Sunrider China (Huang Pu) was recognised for manufacturing excellence; this is <i>not</i> relevant.</p> <p>c) Year 2011 – Sunrider won the Branding Laureate Award for branding excellence. However, there are no further details as to the “brand” involved while the “brand” on the certificate does not appear to be the Opponent’s Earlier Mark.</p> <p>d) Year 2010 - Mr Chen TF was selected by Forbes Asia as one of the 25 most notable Chinese Americans; this is <i>not</i> relevant.</p> <p>e) Year 2004 – Mr Chen TF was featured on Elite Overseas Chinese Commemorative stamps collection; this is <i>not</i> relevant.</p>
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		<p>Page 261:¹⁰⁷</p> <p>a) Year 2017 – Mr Reuben Chen¹⁰⁸ and Sunrider were honoured by the UC Irvine Pediatric Exercise and Geonomics Research Center; this is <i>not</i> relevant.</p> <p>b) Year 2017 – Mdm Oi Leen Chen¹⁰⁹ was named as one of the 25 most influential woman in Direct Selling by Direct Selling News. Similar to item 7 above, which relates to the same award in the year 2012; this is <i>not</i> relevant.</p> <p>c) Year 2017 – Mr Chen TF was awarded an Honorary Doctorate Degree by Kaohsiung Medical University; this is <i>not</i> relevant.</p> <p>d) Year 2015 – Sunrider Singapore Manufacturing (Pte) Ltd was awarded Gold Award and certificate of commendation by the</p>
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¹⁰⁷ Opponent's 1st SD at Exhibit 13.

¹⁰⁸ Mr Chen TF's son.

¹⁰⁹ Mr Chen TF's wife.

		<p>AVA. There are no further details in relation to this. However, it would appear to be similar to item 3 above (which relates to an award in 2018); if so, the award would only relate to the operation of the factory and is <i>not</i> relevant.</p> <p>e) Year 2014 – Sunrider won the Outstanding Entrepreneur Certificate and Award from Kuala Lumpur & Selangor Chinese Chamber of Commerce and Industry; this is <i>not</i> relevant.</p>
		<p>Page 262:</p> <p>a) Year 2020 – Sunrider achieved one of the top 50 spots under Direct Selling News. This is dated <i>after</i> the Relevant Date and cannot be taken into account.</p> <p>b) Year 2020 – Sunrider Hong Kong earned the Asia Pacific Sustainable Enterprise Award; this is <i>after</i> the Relevant Date and cannot be taken into account.</p>

		<p>c) Year 2019 – Sunrider Manufacturing L.P earned a certification from NSF International, a food safety certification organisation; it is dated <i>after</i> the Relevant Date and cannot be taken into account.</p> <p>d) Year 2018 – Sunrider Singapore Manufacturing Pte Ltd was recognised for food safety and excellence by AVA; this is again <i>not</i> relevant (see also above at item 3).</p> <p>e) Year 2017 – Mr Reuben Chen was appointed to the Kingston University Programme Advisory committee; this is <i>not</i> relevant.</p>
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70 In addition, the Opponent relies on the following sales figures for the period 2005 – 2018:¹¹⁰

S/N	Year	Amount (US\$)
1	2005	328,358.00
2	2006	309,230.00
3	2007	316,934.00
4	2008	315,468.00
5	2009	325,366.00
6	2010	164,781.00
7	2011	162,104.00
8	2012	164,125.00
9	2013	198,949.00
10	2014	183,953.00
11	2015	152,635.00
12	2016	147,436.00

¹¹⁰ Opponent's 1st SD at Exhibit 10.

13	2017	143,920.00
14	2018	143,726.00

71 I agree with the Applicant that the above evidence is “problematic” to the extent that:

- (a) there were *no* supporting documents such as invoices *at all*,¹¹¹
- (b) there is *no* breakdown of sales in relation to the Opponent’s Earlier Mark;¹¹² and
- (c) there is a high probability that these goods may be slated for export.¹¹³

72 It is to be recalled that the *burden* is on the Opponent to prove that the Opponent’s Earlier Mark enjoys reputation in the local market. In light of the above, I am of view that the Opponent has *not* discharged its burden of proof.

73 In any event, I note that any reputation by the Opponent does not necessarily mean that there is a likelihood of confusion. In fact, as alluded to above, a strong reputation does *not* necessarily equate to a higher likelihood of confusion and could in fact have the contrary effect. At the end of the day, “the exact effect which the reputation of a mark has as regards the likelihood of confusion inquiry is a fact specific inquiry”.¹¹⁴

¹¹¹ AWS at [100].

¹¹² AWS at [100].

¹¹³ AWS at [100].

¹¹⁴ See *Twitter* at [124].

74 On the other hand, most of the evidence filed by the Applicant pertain to sporting products.¹¹⁵ Accordingly, the Applicant has *not* shown reputation in relation to the relevant goods / services.

75 Taking into account the overall impression as well as the possibility of imperfect collection, the respective marks are similar to a large extent. This would lean towards a finding that there is a likelihood of confusion.

Factors relating to the impact of good / service similarity

76 As indicated above, the goods / services in relation to 40201816175S-02 and 40201816175S-01 (Class 35) overlap.

77 The Applicant submitted that “consumers are likely to *exercise a higher level of attention* when purchasing these products, given their medicinal claims...[c]onsequently, the risk of *confusion...is significantly reduced*, as consumers seeking medicinal [products]...are *more discerning and informed...*”.^{116 117}

78 I agree that consumers are likely to be more cautious when purchasing goods from Class 5. However, I am of the view that in this case, the high degree of similarity of the marks and the goods / services are such that it is not sufficient to dispel confusion.

¹¹⁵ See also AWS [79] – [82].

¹¹⁶ AWS at [83].

¹¹⁷ Also see ARW at [49(g)].

79 For the avoidance of doubt, the above analysis will also apply to the comparison between the goods registered under the Opponent’s Earlier Mark and the services under 40201816175S – 01 (Class 35).

80 Last but not least, the Applicant submitted that “[i]n the health products industry, it is common practice to develop and use a distinct trade mark or product name for each individual product rather than using an overarching brand name.... health products often have specialised and individualised names to highlight their specific benefits and uses”.^{118 119} The Applicant added that the Opponent “has not given evidence showing that it uses the sign “Sunrise” for other health products”.¹²⁰

81 The above appears to be related to the argument that “Sunrise” is merely a subsidiary trade mark, while “Sunrider” is the house mark.¹²¹ In relation to this, putting the issue of the date of the evidence aside, I observe that in some instances, the Opponent’s Earlier Mark appeared *together* with the Opponent’s house mark¹²² while in some instances it appeared on its *own*¹²³ so this issue is inconclusive and does not assist the analysis.

¹¹⁸ AWS at [85].

¹¹⁹ In the event the Applicant is referring to the International Non-proprietary Names (INN), it does not assist as an INN is intended to “facilitate the identification of pharmaceutical substances or active pharmaceutical ingredients. Each INN is a unique name that is globally recognised and is public property. A nonproprietary name is also known as a *generic* name” (emphasis mine).

¹²⁰ ARW at [49(c)].

¹²¹ AWS at [85].

¹²² See Opponent’s 1st SD at Exhibit 11 at page 206.

¹²³ See Opponent’s 1st SD at Exhibit 11 at page 219.

Conclusion

82 Taking all of the above into account, I am of the view that there is a *likelihood of confusion*.

Conclusion on section 8(2)(b)

83 The ground of opposition under Section 8(2)(b) therefore succeeds.

Ground of Opposition under Section 8(4)(b)(i)

84 Section 8(4) of the Act reads:

8(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and
(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

Section 2 of the Act reads:

2.—(1) In this Act, unless the context otherwise requires —

“earlier trade mark” means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a *well known trade mark*,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any *unregistered trade mark that is well known in Singapore* and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore.

Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) 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;

(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;

(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;

(e) any value associated with the trade mark.

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to *any relevant sector of the public in Singapore*, the trade mark shall be *deemed* to be well known in Singapore

Section 2(9) of the Act states:

In subsections (7) and (8), “relevant sector of the public in Singapore” includes *any* of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the *distribution* of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore *dealing* in the goods or services to which the trade mark is applied.

[All emphasis in italics mine]

85 The provisions have been the subject of further exposition by the Courts:

(a) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because Section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] *Amanresorts*).

(b) Aside from Section 2(7)(a) of the Act, the court is ordinarily free to *disregard* any or all of the factors listed in Section 2(7) as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).

(c) In relation to Section 2(8) of the Act, the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore¹²⁴...

[102] We do *not* think that this comment in *Amanresorts* was made to lay down a general principle...the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size. Beyond this, it should *not* be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is *a low one*.

(d) Last but not least, with regard to the ambit of Section 2(9)(a), the inquiry is into the specific goods or services to which the Opponent’s trade mark has been applied (*Amanresorts* at [152]).

[All emphasis in italics mine]

86 In summary, to succeed in an opposition under s 8(4)(b)(i), the Opponent must establish that:

- (a) The whole or essential part of the mark is similar to an earlier trade mark;
- (b) The earlier mark is well-known in Singapore;
- (c) Use of the mark in relation to the goods / services for which the mark is sought to be registered would indicate a confusing connection between those goods / services and the earlier mark; and
- (d) Such use is likely to cause damage to the earlier mark.

¹²⁴ See *Amanresorts* at [229].

Similarity of marks

87 In relation to this ground, as alluded above, the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark". This element is essentially the same as the similar element under Section 8(2)(b) (see *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [70] and [71]).

88 Hence, with regard to this factor, my conclusion is the same as that for the objection under section 8(2)(b), that is, I find that the marks are similar.

Well-known in Singapore

89 The critical question is whether the Opponent's Earlier Mark was well known in Singapore as at the Relevant Date. The Court of Appeal in *Caesarstone* (above) has made clear that there is *no* general rule that "the threshold for a trade mark to be regarded as well-known in Singapore is *a low one*".¹²⁵

90 Specifically, the Court of Appeal in *Amanresorts* had earlier commented that it is *not too difficult* for a trade mark to be regarded as "well known in Singapore" since the trade mark in question need only be recognised or known by "*any relevant sector of the public in Singapore*" (emphasis in the original), which could in certain cases be miniscule (*Amanresorts* at [229]). This statement has been interpreted by some to mean that the bar to find that a mark is well-known in Singapore under section 8(4)(b)(i) is a low one.

¹²⁵ See above at [85(c)].

91 The Court of Appeal has since clarified in *Caesarstone* that the statement is simply to make clear that “in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size” (emphasis in the original)¹²⁶ and that “[b]eyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.”¹²⁷

92 I have already concluded above that I am of the view that the Opponent’s Earlier Mark does not enjoy a reputation in the local market. For the same reasons, I am of the view that the Opponent’s Earlier Mark is *not* well-known to any relevant sector of the public in Singapore.

93 Following the above, there is *no* need for me to consider the other elements for this ground.

Conclusion on section 8(4)(b)(i)

94 The ground of opposition under Section 8(4)(b)(i) fails.

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

95 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

¹²⁶ *Caesarstone* at [102].

¹²⁷ *Caesarstone* at [102].

96 In relation to this ground, there are three elements to be established:

- (i) Goodwill;
- (ii) Misrepresentation; and
- (iii) Damage.

97 Some further elaboration as to the law in relation to passing off:

(a) The Opponent must establish that they have acquired goodwill as at the *Relevant Date*, that is, the date on which the defendant's conduct complained of started. (*Law of Intellectual Property of Singapore (Sweet & Maxwell, Third Edition, 2021)* by Professor Ng-Loy Wee Loon (“*Law of Intellectual Property of Singapore*”) at [17.1.6])

(b) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue of *whether a mark or get-up is distinctive* of a plaintiff's products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“*Singsung*”) at [34] and [37] respectively). Evidence of sales and income of the business are a “proxy for the attractive force of the business” (*Singsung* at [58]). The “get up” can include various aspects of the business and is not pegged to any particular mark (*Law of Intellectual Property of Singapore* at [17.2.10] – [17.2.20]).

(c) Section 8(7)(a) of the Act at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill,

misrepresentation and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]).

Goodwill

98 The Applicant’s arguments in relation to the issue of goodwill is similar to its arguments for the issue of reputation of the Opponent’s Earlier Mark. In short, the Applicant argued that the evidence of the Opponent’s sales figures¹²⁸ is “problematic” as:

- (a) there were *no* supporting documents such as invoices *at all*;¹²⁹
- (b) there is *no* breakdown of sales¹³⁰ in relation to the Opponent’s Earlier Mark; and
- (c) there is a high probability that these goods may be slated for export.¹³¹

99 However, while I have held above that the Opponent’s Earlier Mark does not enjoy any reputation in Singapore and is not well-known to any relevant sector of the public, I am prepared to accept that there is goodwill for the purposes of this ground. This is because goodwill is concerned with the “business *as a whole*”. Here, based on the evidence tendered, it is not in dispute

¹²⁸ Opponent’s 1st SD at Exhibit 10.

¹²⁹ AWS at [100].

¹³⁰ AWS at [100].

¹³¹ AWS at [100].

that the Opponent has manufacturing operations in Singapore;¹³² the Opponent is not a “foreign trader who does not conduct any business in Singapore”.¹³³

100 I am of the view that the above is sufficient to constitute goodwill.

Misrepresentation

101 In addition to the Opponent’s Earlier Mark, the Opponent’s Unregistered Marks can also be taken into account (see above at [11]).

102 I have concluded that there is a likelihood of confusion under section 8(2)(b) of the Act. For the same reasons, I am of the view that there is a likelihood of misrepresentation.

Damage

103 As misrepresentation has been made out and given the extent of similarity of marks and goods / services, there is also a likelihood of damage via blurring or diversion of sales.¹³⁴

Conclusion on section 8(7)(a)

104 The ground of opposition under Section 8(7)(a) therefore succeeds.

Overall conclusion

105 While it is clear that there is no similarity in relation to the goods for 40201816175S-01 (Classes 29 and 30), as there is similarity in relation to the

¹³² See for example Opponent’s 1st SD at Exhibit 2 at pages 23 – 24.

¹³³ ARW at [59].

¹³⁴ OWS at [6.9].

services for 40201816175S-01 (Class 35), the Application Mark 40201816175S-01 as a whole *cannot* proceed to registration. As the IP Adjudicator opined in *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [75], there is *no* “partial opposition” whether within the same class or in multi-class applications.

106 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the oppositions *succeed* under Section 8(2)(b) and Section 8(7)(a) but *fail* under Section 8(4)(b)(i) such that *both*:

- (a) 40201816175S-02; and
- (b) 40201816175S-01

shall *not* proceed to registration.

Costs

107 Both parties have provided written submissions on costs.¹³⁵

108 The Opposition only succeeded on two out of three grounds. In addition, most of the evidence were dated *after* the Relevant Date or *undated*.¹³⁶

109 In light of the above, I find that the Opponent is only entitled to part of its costs as follows:

¹³⁵ OWS at [7.1] and AWS at [157] – [159].

¹³⁶ See also AWS at [77(d)].

S/N	Description	Amount / fee (\$)	Award (\$)	Reasons ¹³⁷
Institution of Proceedings				
1	Prepare Notice of Opposition ¹³⁸	390	390	Standard item
2	Review Counter-Statement x 2 (this included amended counter-statement x 2)	195 – 1,040 per document	500 x 2	Four grounds were raised but one ground was dropped at a late stage ¹³⁹
3	Review Applicant's SD	195 – 1,040 per document	500	Four grounds raised ¹⁴⁰ but consolidated case
3a	Prepare Opponent's 1 st SD	390 – 2,080 per statutory declaration	700	The two SDs were almost identical. There were four grounds raised.
3b	Review Opponent's 2 nd SD		400	

¹³⁷ Having regard to HMD Circular 6.1 in relation to *Award and assessment of costs* at Part F which pertains to *Drafting a Bill of Costs* where appropriate.

¹³⁸ There is only ONE Notice of Opposition (the division was made later at 9 June 2023).

¹³⁹ The Opponent dropped one ground when filing the OWS dated 19 August 2024.

¹⁴⁰ The last ground was only dropped at a late stage (see above).

3c	Review Opponent's 3 rd SD		500	Limited evidence
Interlocutory Hearings				
4a	Preparing the Pre-Hearing Review on 15 July 2024	65 – 650 per proceeding / review / conference	200	No written submissions / authorities
4b	Attending the Pre-Hearing Review on 3 August 2022		100	1 hour or less
Full Hearing				
8	Preparing for full hearing	650 – 2,600	1,000	3 grounds raised
9	Attending for full hearing	260 – 1,040	700	Hearing lasted for half a day
<i>Total for work done</i>			<i>S\$5,490</i>	
Grand Total¹⁴¹			<i>S\$5,490</i>	

¹⁴¹ The Opponent did not claim for disbursements (see OWS at [7.1]).

Sandy Widjaja
Principal Assistant Registrar

Mr Suhaimi Bin Lazim (Mirandah Law LLP)
for the Opponent;

Ms Millicent Lui and Ms Ruth Teh (Ghows LLC)
for the Applicant

[An appeal from this decision to the General Division of the High Court is
pending.]