

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

[2025] SGIPOS 1

Trade Mark No. 40202125945T

IN THE MATTER OF A TRADE MARK APPLICATION

IN THE NAME OF

TIANRONG CO., LTD

... Applicant

AND

AN OPPOSITION BY

ESSITY HYGIENE AND HEALTH AKTIEBOLAG

... Opponent

GROUND OF DECISION

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Essity Hygiene and Health Aktiebolag

v

Tianrong Co Ltd


[2025] SGIPOS 1

Trade Mark No. 40202125945T
IP Adjudicator Tan Tee Jim, SC
23 October 2024

13 January 2025

IP Adjudicator Tan Tee Jim, SC:

Introduction

1 This is an opposition by Essity Hygiene and Health Aktiebolag (“Opponent”) against an application by Tianrong Co., Ltd (“Applicant”) to register the trade mark  under TM No. 40202125945T (“Application Mark”) in Classes 3 and 5.


2 Having heard and considered the parties’ submissions and evidence, I dismissed the opposition. These are my reasons.


Brief Procedural Background

3 On 16 September 2021, the Applicant applied to register the Application Mark in Classes 3 and 5.

4 On 18 April 2022, the Opponent filed a Notice of Opposition to oppose

the registration of the Application Mark. It is the registered proprietor of the following marks (“Opponent’s Marks”):

Mark & Mark No.	Class	Specification of Goods (collectively referred to as “Opponent’s Goods”)
<p style="text-align: center;">TENA</p> <p style="text-align: center;">T9906788C</p>	3	Skin care products, namely washcream, perineal washcream and conditioner, cleansing cream, moisturizers, skin lotions, disposable pre-moistened washcloths; all included in Class 3.
<p style="text-align: center;">TENA</p> <p style="text-align: center;">40201718818S</p>	5	Sanitary napkins and towels; sanitary panties; sanitary knickers; panty liners (sanitary); napkins and pads for incontinence; absorbent pants and panties for incontinence; tissues impregnated with pharmaceutical lotions (for medical purposes); diapers for incontinence (for medical purposes); fixation pants for use by persons suffering from incontinence (for medical purposes); disposable diapers and diaper pants made of paper and/or cellulose; wound cleansing set composed of medical cleansers for wounds and wound dressings; all included in Class 5.
	3	Skin care preparations; washing creams; perineal washing creams; skin conditioners; cleansing creams; cleansing mousse; moisturizers; skin lotions; barrier

<p>40201900214P (International Registration No. 1442218)</p>		<p>creams; moisturizing creams with zinc; liquid soaps; skin care oils [non-medicated]; hair shampoos; hair conditioners; tissues impregnated with a skin cleanser; moist wipes for cosmetic purposes.</p>
	<p>5</p>	<p>Sanitary napkins [towels]; absorbent pants [sanitary]; panty liners; pants shields [sanitary]; absorbent pants for incontinence; incontinence pads; incontinence diapers; napkins [towels] with belts for incontinence; underpants for sanitary purposes; underpants for fixation of sanitary napkins [towels]; pharmaceutical preparations for skin care; sanitizing wipes; wipes impregnated with pharmaceutical lotions; ointments for pharmaceutical purposes; wound dressings; antiseptic preparations for wound care.</p>
 <p>40202017877W (International Registration No. 1438093)</p>	<p>3</p>	<p>Skin care preparations; washing creams; perineal washing creams; skin conditioners; cleansing creams; cleansing mousse; moisturizers; skin lotions; barrier creams; moisturizing creams with zinc; liquid soaps; skin care oils [non-medicated]; hair shampoos; hair conditioners; tissues impregnated with a</p>

		skin cleanser; moist wipes for sanitary and cosmetic purposes.
	5	Sanitary napkins [towels]; absorbent pants [sanitary]; panty liners; panty shields [sanitary]; absorbent pants for incontinence; incontinence pads; incontinence diapers; napkins [towels] with belts for incontinence; underpants for sanitary purposes; underpants for fixation of sanitary napkins [towels]; pharmaceutical preparations for skin care; sanitizing wipes; wipes impregnated with pharmaceutical lotions; ointments for pharmaceutical purposes; wound dressings; antiseptic preparations for wound care.
	10	Incontinence bed pads; incontinence sheets; protective underlays for incontinence.
	16	Paper washcloths; paper wipes; towels of paper; paper bibs.

5 The Opponent relies on Section 8(2)(b), Section 8(7)(a), Section 8(4)(b)(i), Section 8(4)(b)(ii) and Section 7(6) of the Trade Marks Act 1998 (“Act”) for the opposition.

Evidence

6 The Opponent’s evidence comprises the following:

- (1) A further re-executed Statutory Declaration made by Jeanette Annergren, Vice President IP of the Opponent, on 16 June 2023 (“Annergren’s SD”); and
- (2) A re-executed Statutory Declaration in Reply made by the same Jeanette Annergren on 26 July 2024 (“Annergren’s Reply SD”).

7 The Opponent deposed at [5] and [6] of Annergren’s SD that it is a hygiene and health company and its products include incontinence care products, baby diapers and wet wipes, consumer tissues and feminine care products which it offered for sale under a number of brands, including “TENA”.

8 The Applicant’s evidence comprises a further re-executed Statutory Declaration made by its President and CEO, Huang Huaixiang, on 25 March 2024 (“Huang’s SD”). At [5] of Huang’s SD, he deposed that the Applicant is involved in the business of manufacturing and selling, amongst others, baby care products and its products have been sold under the Application Mark, “with a focus on baby and children’s care products”. He also said at [7] of Huang’s SD that the Applicant applied to register the Application Mark in Singapore with the intention of expanding the sales of its products in Singapore.

Applicable law and burden of proof

9 There is no overall onus on the Applicant before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

The law under Section 8(2)(b)

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

“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.”

11 There are three elements which the Opponent must establish in order to succeed in its opposition under Section 8(2)(b):

- (1) the competing marks are similar;
- (2) the goods or services of the competing marks are identical or similar; and
- (3) there exists a likelihood of confusion as a result of the similarities in (1) and (2) above.

12 Section 8(2)(b) was subject to close consideration by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc.* [2014] 1 SLR 911 (“*Staywell*”). The court endorsed (at [15]) the “step-by-step” approach for determining an opposition under this provision. Specifically, under this approach, the three elements of similarity of marks, identity or similarity of goods or services, and likelihood of confusion arising

from the two similarities, are to be systematically and individually assessed in turn. Only after the first two elements have been assessed to be present will there be an inquiry on whether there is a likelihood of confusion as a result of the similarities. The court added that this inquiry directs the court to look at (a) how similar the marks are; (b) how similar the goods or services are; and (c) given these similarities, how likely the relevant segment of the public will be confused.

Similarity of Marks

13 The court in *Staywell* provided (at [17]-[30]) the following advice concerning the similarity of marks (emphasis in *italics* added):

- (1) The comparison of the competing marks is one of “*mark for mark*”. Each mark is to be considered as a whole without consideration of any external matter.
- (2) Each of the competing marks is to be viewed and compared as a whole, not dissected into its individual components.
- (3) 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 rather than dissimilar.
- (4) There are three aspects of similarity (i.e. visual, aural and conceptual similarities) and these are meant as signposts to guide the court’s inquiry. There is *no requirement* that these three

aspects of similarity must be made out before the competing marks can be found to be similar. *Trade-offs can occur among the three aspects of similarity.*

- (5) The visual, aural or conceptual similarity of the competing marks must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- (6) Integrated into the analysis of visual, aural and conceptual similarity is a consideration of whether the earlier mark is distinctive (in both its technical and non-technical sense):
 - (a) In the non-technical sense, distinctiveness refers to “what is outstanding and memorable about the mark”. Such components tend to draw the average consumer’s attention and stand out in the average consumer’s imperfect recollection;
 - (b) In the technical sense, distinctiveness ordinarily refers to a mark’s inherent capacity (*ie*, relating to a mark’s fanciful or descriptive nature) or acquired capacity (*ie*, based on the duration and nature of the use of the mark) to operate as a badge of origin:

A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.

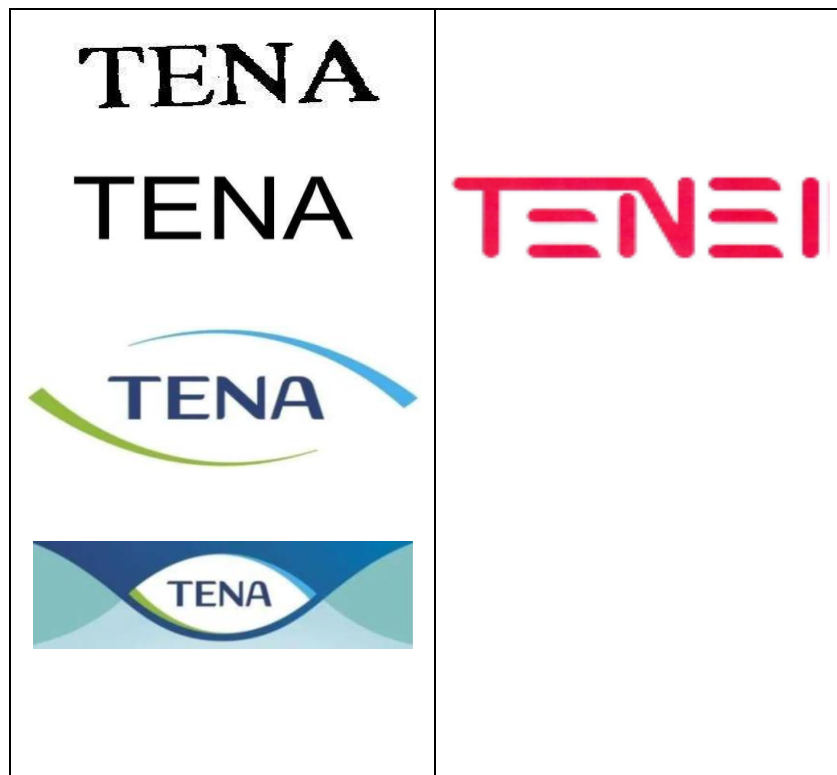
14 The court cautioned (at [29]) that “[t]he finding of distinctiveness of the separate components of the mark must ultimately be related back to the impression given by the mark as a whole” because “it is the entire mark, and not only a component of it, that must function as the badge of origin”.

15 Further, in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("*Hai Tong*"), the Court of Appeal said (at [40(c)] and [40(d)]) that whether there is similarity of marks is to be ascertained from the viewpoint 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. It is assumed that the average consumer has “imperfect recollection” such that the two competing 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.

Application of Section 8(2)(b) to the facts

16 For ease of comparison, the Opponent’s Marks and the Application Mark are reproduced below:

Opponent’s Marks	Application Mark
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17 The Opponent submits that when compared as wholes, the Opponent's Marks and the Application Mark are visually, aurally and conceptually similar thereby causing a likelihood of confusion.¹ It argues that as both marks contain the letters "T", "E" and "N" in an identical sequence with the prefix "TEN" forming an essential and dominant feature of both marks, the marks are similar to each other visually and conceptually, and that the minor differences between the two marks are insufficient to distinguish them as the essential feature (i.e., the prefix "TEN") is identical and present in both marks.²

18 I am unable to accept this argument. It is not permissible to dissect the competing marks and assert that the common components of the mark (*viz*, the

¹ See [30] of the Opponent's Written Submissions ("OWS").

² [31] of OWS.

letters “T”, “E” and “N”) form a word that constitutes the essential and dominant feature of the marks. As the Court of Appeal has advised, a mark must be looked at *as a whole* in order to assess its ability to function as a badge of origin and even if the common components were the essential and dominant features, a finding of distinctiveness of the components must ultimately be related back to the impression given by the mark as a whole because it is the entire mark, and not only a component of it, that must function as the badge of origin. In the present case, it is not the word “TEN” that functions as a badge of origin of the parties’ goods and services in question but, rather, the Opponent’s Marks and the Application Mark looked at as wholes.

19 The overall impression given by these marks when they are compared mark for mark and looked at as wholes is that they are visually dissimilar rather than similar. Two of the Opponent’s Marks comprise the word “TENA” in plain font (registered under TM No. T9906788C and TM No. 40201718818S) while the other two marks consist of the juxtaposition of the word with blue and green graphics (registered under TM No. 40201900214P and TM No. 40202017877W). In contrast, the Application Mark comprises a single, stylised word “TENEI” in red (namely, “**TENEI**”). It is noticeable that the vertical strokes in the letter “E” in the Application Mark are absent, which has the visual effect of substituting the Chinese character “三” (meaning the number “3”) for the letter in the mark. This effect would not be lost on the average consumer even when the possibility of his imperfect recollection is taken into account. This being the case, and coupled with the fact that the other components of the marks are the letter “A” and “三I” respectively which are also different, it would not be difficult to conclude that the parties’ marks are likely to appear to the average consumer to be different. The difference is accentuated in the case of the Opponent’s Marks with the blue and green graphics.

20 The Opponent has not submitted on whether any of the Opponent’s Marks is distinctive in its technical or non-technical sense. Even if it had made the submission, the distinctiveness of each of the marks must be seen to lie in a combination of the prefix and the other component of the mark. The Opponent avers that it is the prefix “TEN” which forms an essential and dominant feature of the competing marks, thus rendering them to be visually and conceptually similar to one another.³ I have alluded above to the absence of the vertical strokes in the Application Mark. I add that the absence would also have the visual effect of rendering the prefix “TEN” non-existent in the Application Mark. Even if I were wrong in this regard, I am of the view that the presence of the other components in the competing marks (namely, the letter “A” and “三 l”), which would not be disregarded by the average consumer with an imperfect recollection, would counteract any dominant visual impact of the prefix. This is because these other components are distinctly and visually different.

21 The Opponent relies on *Sarika Connoisseur Café Pte Ltd. v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) where the Court of Appeal found that the marks “Nutella” and “Nutello” were visually similar as (1) they shared the same length and structure and utilised substantially the same letters; and (2) the difference of a single letter is not sufficient to render them dissimilar, particularly given the imperfect recollection of consumers. However, the case is distinguishable as, in the present case, the parties’ marks (1) are not of the same length; (2) do not use the same letters; (3) have differences that are not confined to a single letter only; and (4) the other components of the marks (namely, the letter “A” and “三 l” respectively) are decidedly different.

³ [31] of OWS.

22 In the premises, I hold that the Opponent’s Marks and the Application Mark have a high level of visual dissimilarity.

23 With regard to aural similarity, there are two approaches. One approach is to consider the dominant component of the mark (“Dominant Component Approach”) while the other approach is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not (“Quantitative Assessment Approach”) (see *Staywell* at [31]-[32]).

24 Without expressly indicating which approach is to be applied, the Opponent submits that the marks are aurally similar because they both have the distinctive and dominant prefix and syllable (*viz*, “TEN”) which the public will emphasize aurally while slurring the second syllable to similarly pronounce them as “TEN-NA”.⁴ It cites in support Sargant LJ’s observation in *London Lubricants (1920) Ltd’s Application to Register a Trade Mark* (1925) 42 RPC 264 at 279:

“But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and, in my judgment, the first syllable of a word is, as a rule, far the most important for the purpose of distinction.”

25 The Applicant submits that the Quantitative Assessment Approach should not be applied, stating that the Opponent’s Marks would likely be pronounced as “TAY-NAH” or “TEN-NAH” whereas the Application Mark

⁴ [36] of OWS.

would be pronounced as “TEN-NAY” and that this aural dissimilarity cannot be ignored.⁵

26 There is no evidence adduced as to as to which of these pronunciations is more likely amongst average consumers in Singapore. Notwithstanding this, I would opine that there is some aural similarity in the pronunciations of the competing marks. They each have two syllables with a similar first syllable. As regards the second syllables “-NAH” and “-NAY”, although I am mindful of the advice of Tay Yong Kwang J (as he then was) in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [47] (“*Festina*”) that Sargant LJ’s observation, useful as it is, should not be taken as a hard and fast rule and that there is no rigid principle that the first syllable of a word mark is more important than other syllables, I must acknowledge the real possibility that average consumers in Singapore may slur the second syllables such that the competing marks as a whole sound somewhat similar.⁶

27 Taking into account the effects of slurring and imperfect recollection, I would hold that the Opponent’s Marks and the Application Mark have a medium level of aural similarity.

28 As for conceptual similarity, the relevant analysis “seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole” (*Staywell* at [35]). This analysis is based on the mark itself, not on any external circumstances. For instance, in *Staywell*, the court considered the word “Regis” in the parties’ marks to reasonably connote royalty but this connotation becomes

⁵ [29] of the Applicant’s Written Submissions (“AWS”).

⁶ The Court of Appeal in *Staywell* indicated (at [37]) that the Singapore context is relevant in considering whether the competing marks are aurally similar,

secondary as a result of the use of the prefixes “Park” and “St” in the applicant’s and opponent’s marks respectively (*Staywell* at [36]).

29 In the present case, the Opponent neither pleaded nor submitted that the Opponent’s Marks and the Application Mark are conceptually similar. However, at [30] of *Annergren’s SD*, it explained that the Opponent’s Marks came about due to the first TENA diapers which have a shape similar to the letter “T” and the diapers are good to use at night. It also said that the Swedish translation of “night” is “natt” and the diapers were initially called “T-Natt” which later became “TENA”. These are external circumstances which I am at liberty to ignore.

30 The Applicant submits that the parties’ marks are not conceptually similar and goes on to explain that the Application Mark, “**TENEI**”, is derived from the Japanese pronunciation of the name of the Applicant (“Tianrong Co. Ltd”) written in Japanese as “天荣株式会社”, with “TEN” being the Japanese pronunciation of the first character, “天”, and “EI” being the Japanese pronunciation of the second character, “荣”.⁷ I am also at liberty to disregard this explanation as it is not evident from the mark itself and, besides, is likely to escape the vast majority of average consumers in Singapore who are not familiar with the Japanese language.

31 Indeed, I find that the parties’ marks are meaningless. They do not convey any meaning and idea to the average consumer in Singapore. This applies also to the Opponent’s Marks with the graphics. The marks do not therefore have any conceptual similarity.

⁷ [32] of *AWS*. The explanation is also provided at [23(c)(ii)] of *Huang’s SD*.

Conclusion on similarity of the competing marks

32 As noted above, the Court of Appeal’s advice is that the similarity of marks is ultimately a matter of impression and based on whether the marks, when observed in their totality, are similar or dissimilar. The three aspects of similarity (i.e., visual, aural and conceptual) are merely signposts to guide in this ultimate inquiry. Trade-offs can occur among these three aspects of similarity.

33 I have concluded earlier that the competing marks have a high level of visual dissimilarity, a medium level of aural similarity and no conceptual similarity. In light of this conclusion and having regard to the court’s advice, it is my finding that, overall, the marks are dissimilar. Consequently, and applying the “step-by-step” approach, the inquiry with regard to the objection under Section 8(2)(b) ends.

34 It is therefore strictly not necessary for me to proceed to consider the issue of similarity of goods and whether there is a likelihood of confusion. Nevertheless, for the sake of completeness, I shall do so.

Similarity of Goods

35 For the purposes of the goods-similarity inquiry, I bear in mind the following factors which were set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 296-297 (“*British Sugar*”) and endorsed by our Court of Appeal in *Hai Tong* and *Staywell*:

- (1) The respective uses of the respective goods or services;

- (2) The respective users of the respective goods or services;
- (3) The physical nature of the goods or acts of service;
- (4) The respective trade channels through which the goods or services reach the market;
- (5) In the case of self-serve consumer items, whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (6) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same and different sectors.

36 The Opponent submits that there are “obvious overlaps” between their goods (“Opponent’s Goods”) and the Applicant’s goods (“Applicant’s Goods”) in Classes 3 and 5, and has helpfully set out the goods in a table as shown below with the overlapping goods highlighted in bold (“Overlapping Goods”):⁸

Opponent’s Goods	Applicant’s Goods
<p>TENA T9906788C</p>	<p><u>Class 3</u></p>

⁸ See [39] of OWS.

<p><u>Class 3</u> Skin care products, namely washcream, perineal washcream and conditioner, cleansing cream, moisturizers, <u>skin lotions</u>, disposable pre-moistened washcloths; all included in Class 3.</p>	<p>Preparations for the elimination of bacteria for laundry use; color\-\brightening chemicals for household purposes [laundry]; fabric softeners for laundry use; cakes of toilet soap; soaps; douching preparations for personal sanitary or deodorant purposes [toiletries]; <u>shampoos</u>; body soaps; cleaning chalk; mouthwashes, not for medical purposes; dentifrices; bath preparations, not for medical purposes; hair lotions; cleansing milk for cosmetic purposes; cosmetics kits; baby powders; baby lotions; lipsticks; cosmetic creams; <u>lotion</u> for cosmetic purposes; oils for cosmetic purposes; essential oils; laundry preparations.</p>
<p style="text-align: center;">TENA 40201718818S</p> <p><u>Class 5</u> Sanitary napkins and towels; sanitary panties; sanitary knickers; panty liners (sanitary); napkins and pads for incontinence; <u>absorbent pants and panties for incontinence</u>; tissues impregnated with pharmaceutical lotions (for medical purposes); <u>diapers for incontinence</u> (for medical purposes); fixation pants for use by persons suffering from incontinence (for medical purposes); <u>disposable diapers and diaper pants made of paper and/or cellulose</u>; wound cleansing set composed of medical cleansers for wounds and wound dressings; all included in Class 5.</p>	<p><u>Class 5</u> <u>Diapers for incontinence; pants, absorbent, for incontinence; babies' diapers; babies' diaper-pants</u>; food for babies.</p>



40201900214P

(International Registration No.
1442218)

Class 3

Skin care preparations; washing creams; perineal washing creams; skin conditioners; cleansing creams; cleansing mousse; moisturizers; **skin lotions**; barrier creams; moisturizing creams with zinc; liquid soaps; skin care oils [non-medicated]; **hair shampoos**; hair conditioners; tissues impregnated with a skin cleanser; moist wipes for cosmetic purposes.

Class 5

Sanitary napkins [towels]; absorbent pants [sanitary]; panty liners; pants shields [sanitary]; **absorbent pants for incontinence; incontinence pads; incontinence diapers**; napkins [towels] with belts for incontinence; underpants for sanitary purposes; underpants for fixation of sanitary napkins [towels]; pharmaceutical preparations for skin care; sanitizing

<p>wipes; wipes impregnated with pharmaceutical lotions; ointments for pharmaceutical purposes; wound dressings; antiseptic preparations for wound care.</p>	
<div data-bbox="411 667 694 741" data-label="Image"> </div> <p>40202017877W (International Registration No. 1438093)</p> <p><u>Class 3</u> Skin care preparations; washing creams; perineal washing creams; skin conditioners; cleansing creams; cleansing mousse; moisturizers; <u>skin lotions</u>; barrier creams; moisturizing creams with zinc; liquid soaps; skin care oils [non-medicated]; <u>hair shampoos</u>; hair conditioners; tissues impregnated with a skin cleanser; moist wipes for sanitary and cosmetic purposes.</p> <p><u>Class 5</u> Sanitary napkins [towels]; absorbent pants [sanitary]; panty liners; panty shields [sanitary]; <u>absorbent pants for</u></p>	

<p><u>incontinence; incontinence pads;</u> <u>incontinence diapers;</u> napkins [towels] with belts for incontinence; underpants for sanitary purposes; underpants for fixation of sanitary napkins [towels]; pharmaceutical preparations for skin care; sanitizing wipes; wipes impregnated with pharmaceutical lotions; ointments for pharmaceutical purposes; wound dressings; antiseptic preparations for wound care.</p>	
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37 The Opponent says that the Overlapping Goods can be broadly classified as personal hygiene products in Class 3 (such as “skin lotions” in the Opponent’s specifications and “shampoos” and “lotion (for cosmetic purposes)” in the Applicant’s specifications) and incontinence products in Class 5 (such as “disposable diapers and diaper pants made of paper and/or cellulose” in the Opponent’s specifications and “diapers for incontinence” in the Applicant’s specifications).⁹ It submits that the Overlapping Goods are similar.

38 The Opponent’s opposition is not confined to the Overlapping Goods only. Despite this, it has made no submission concerning the other Class 3 and Class 5 goods which are not highlighted and which the Applicant also seeks to protect in its application, such as “preparations for the elimination of bacteria for laundry use”, “fabric softeners for laundry use”, “soaps”, “oils for cosmetic

⁹ [40] of OWS.

purposes” and “food for babies”. This is understandable as these other goods are not similar to, and do not overlap, any of the Overlapping Goods.

39 As regards the Overlapping Goods in Class 3, I do not regard the Opponent’s “skin lotion” as similar to “shampoo” in the Applicant’s specifications. Skin lotion is a liquid product that is applied to the skin to protect it, improve it or make it smell better¹⁰ whilst shampoo is a hair care product that is used for cleaning hair. It is however similar to “lotion (for cosmetic purposes)” in the Applicant’s specifications. I also regard the Opponent’s “hair shampoos” as identical with “shampoos” in the Applicant’s specifications.

40 I find that the Overlapping Goods in Class 5 are substantially similar. They include the Applicant’s “babies’ diapers” and “babies’ diaper-pants”. Such goods are a type of diapers and are similar to the Opponent’s “diapers” and “disposable diapers”.

41 Thus, I am of the view that the Applicant’s Goods are not similar to the Opponent’s Goods in Classes 3 and 5 *except* for “lotion (for cosmetic purposes)” and “shampoos” in Class 3 and the Overlapping Goods in Class 5 (“Similar Goods”).

42 I will now proceed to the final step of ascertaining whether there is a likelihood of confusion in relation to the Similar Goods.

¹⁰ See, e.g., Cambridge Dictionary definition of “lotion”.

Likelihood of Confusion

43 The Court of Appeal in *Staywell* set out (at [60], [64], [83] and [96]) the following principles for determining a likelihood of confusion (emphasis *in italics* added):

- (1) 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.
- (2) 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. In other words, even where the marks are similar and the goods or services are similar, this does not mean that there will *ipso facto* be confusion in the mind of the public.
- (3) As regards the effect of the 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.
- (4) 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:
 - (i) the *degree of similarity* of the marks themselves;
 - (ii) 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);
 - (iii) the *impression* given by the marks; and
 - (iv) 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):
 - (i) The *normal way in, or the circumstances under which, consumers would purchase goods of that type*;
 - (ii) Whether the products are *expensive or inexpensive items*;
 - (iii) Whether they would tend to *command a greater or lesser degree of fastidiousness and attention* on the part of prospective purchasers; and
 - (iv) 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.

44 The court also advised (at [60]) that 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.

45 With these principles in mind, I turn to the present case.

46 The Opponent argues that:

- (1) the substantial similarity between the parties' marks elevates the likelihood of confusion, particularly given that the relevant public in Singapore is likely to perceive that the marks are the same, associated and/or extended marks belonging to the same entity by reason of imperfect recollection and/or the proprietors of the marks are economically linked together; and
- (2) the similarities between the parties' goods have also significantly contributed to the likelihood of confusion, given that

- (a) they are inexpensive consumer goods which are readily available for purchase in supermarkets and retail stores;
- (b) the goods are mass-produced and common household goods and the average consumer is unlikely to exercise heightened attention when selecting or purchasing them; and
- (c) they are also offered for sale to the public in Singapore through online websites and e-commerce platforms where consumers may be unable to fully inspect or view the packaging or product descriptions at the time of purchase.¹¹

47 The Opponent further submits that adults and parents in family households are unlikely to possess specialist knowledge when purchasing the parties' goods and may erroneously assume that the Applicant's Goods originate from the Opponent as they are marketed and sold through the same trade channels as the Opponent's Goods.¹²

48 The Applicant asserts that there is no likelihood of confusion because the visual, aural and conceptual differences between the Opponent's Marks and the Application Mark are more than sufficient such that traders and consumers will not be confused as to the trade origin of the parties' goods which has a low level of similarity.¹³

¹¹ [48]-[49] of OWS.


¹² [50] of OWS.

¹³ [48], [53] and [55] of AWS.

49 In my view, there are four factors that militate against a finding of a likelihood of confusion in respect of the Similar Goods (which, I reiterate, are “lotion (for cosmetic purposes)” and “shampoos” in Class 3 and the Overlapping Goods in Class 5 such as “diapers”):

- (1) As I have held above, the Opponents’ Marks and the Application Mark are, overall, not similar and, in particular, have a high level of visual dissimilarity.
- (2) The Similar Goods are hygiene and health products. I agree that they are relatively inexpensive consumer goods which are normally offered for sale and purchased in supermarkets and retail stores and would typically be obtained by self-selection and purchased off the shelf by average consumers. Nevertheless, I am mindful that the nature of the goods would tend to elicit a greater degree of fastidiousness and attention on the part of average consumer (who in my view are likely to be women and the elderly) when selecting and purchasing the goods. They are highly personal self-care products which the average consumers would not simply purchase in a hurry without putting in some care and attention into the purchasing process. In the circumstances, it is the *visual* dissimilarities of the marks that play a significant role. As such, the average consumers are unlikely to be confused because, as I have found, the parties’ marks have a high degree of visual dissimilarity.
- (3) While there may be some consumers who would purchase the Similar Goods online and through e-commerce platforms, it

seems to me that a majority of them still normally purchase these goods in brick-and-mortar shops where they can inspect the goods and obtain assistance before purchase.

- (4) As the court has indicated, it is relevant to consider the actual use to which the proprietor has put his registered trade mark in the market place. It is noticeable that the Opponent’s promotional materials featuring the Opponent’s Marks and exhibited at Exhibits “E” and “F” of Annergren’s SD focus on adult diaper products (such as “diapers for incontinence (for medical purposes)”). These materials also show that the products are intended for use by women and the elderly who have issues concerning incontinence. Such consumers would have specialist knowledge concerning the products and tend to exercise much attention and care when making purchases of the products. In my view, they would have little difficulty discerning that products bearing the mark “TENA” are not from the same trade origin or source as the Applicant’s diapers which are primarily for babies and bear the Application Mark (namely, “”) which is visually not similar.

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

50 As the parties’ marks are not similar and there is no likelihood of confusion in respect of the Similar Goods, the ground of opposition under Section 8(2)(b) fails.

The law under Section 8(7)(a)

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

“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;

....”

Application of Section 8(7)(a) to the facts

52 It is well-established that the three elements of passing off are (1) goodwill; (2) misrepresentation; and (3) damage: see, e.g., *Novelty Pte Ltd. v Amanresorts Ltd* (“*Amanresorts*”) [2009] 3 SLR 216 at [37] and *Staywell* at [130]. All these elements must be established in order to succeed in a claim for passing off. The approach for establishing the three elements parallels the “step-by-step” approach for determining an opposition under Section 8(2)(b) in that the elements are also to be assessed systemically and individually. In particular, if either goodwill or misrepresentation is not established, there is no necessity to consider the next element, namely, misrepresentation or damage respectively.

53 Section 8(7)(a) indicates that the proprietor/opponent must demonstrate that the use of the applicant mark is “liable to be prevented” by the law of passing off in order to prevent the mark from being registered. This requires the opponent to prove, on a balance of probabilities, that he would have a valid passing off claim if the applicant mark was used in relation to any of the goods or services for which the mark is sought to be registered: *Rovio Entertainment*

Ltd v Kimanis Food Industries Sdn Bhd (“Rovio”) [2015] SGHC 216 at [161]. In turn, this at the very least requires the opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation, and damage (*Rovio* at [164]).

Goodwill

54 Goodwill must exist on the date of the commencement of the defendant's conduct complained of: see, e.g., *City Chain Stores (S) Pte Ltd. v Louis Vuitton Malletier (“City Chain”)* [2010] 1 SLR 382 at [63]. In trade mark opposition proceedings, that is the date of the allegedly offending trade mark application (*Staywell* at [130]). In the present case, the relevant date is 16 September 2021 (“Relevant Date”).

55 Goodwill must exist in Singapore. It is concerned with goodwill in the business as a whole, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses. It is manifested in the custom that the business enjoys and may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear: see, e.g., *Singsung Pte Ltd. and anor. v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 at [34].

56 In the present case, the Opponent claims that it has achieved significant sales of the Opponent's Goods bearing the Opponent's Marks in recent years in Singapore and in various markets globally.¹⁴ However, no sales figures were provided, nor was there any evidence adduced, on what proportion of the sales relate to the period before the Relevant Date and to Singapore. There are also no supporting documents to buttress the claim concerning significant sales.

¹⁴ [12] of OWS.

57 The Opponent also claims that it has undertaken significant and extensive efforts to advertise, promote and market the Opponent’s Goods bearing the Opponent’s Marks in Singapore. It says that it expended nearly S\$2.5 million between 2017 and 2022 in relation to the efforts.¹⁵ This figure however does not relate to Singapore only as the Opponent goes on to say that the figure demonstrates its “strong financial commitment to enhancing the Opponent’s reputation in and to the Opponent’s Marks both in Singapore *and worldwide*”.¹⁶ Besides, the sum also encompasses the period *after* the Relevant Date.

58 There are documents provided to show the advertising, promotional and marketing efforts of the Opponent’s Goods in Singapore. Here, I am mindful of the advice that the court will scrutinise the nature, extent and effectiveness of the efforts in determining if the Opponent’s Marks have achieved some degree of notoriety (in the sense of recognition) in the minds of Singaporean consumers (*Rovio* at [180(b)], *per* George Wei JC (as he then was)). The Opponent exhibits at Exhibits “E” and “F” of Annergren’s SD advertising and marketing materials and at Exhibit “G” invoices for print advertisements and marketing materials that, it claims, evidence the expenditure that it incurred in advertising, promoting and marketing the Opponent’s Goods bearing the Opponent’s Marks.¹⁷

59 The evidence provided by the materials at Exhibits “E” and “F” are rather vague as to the scale and extent of advertising, promotional and marketing efforts. The number of occasions when these materials were published and displayed in Singapore is not known. As regards the invoices at Exhibit “G”, a

¹⁵ [10] and [11] of OWS.

¹⁶ [11] of OWS and [11] of Annergren’s SD, emphasis added.

¹⁷ See Exhibit “G” of Annergren’s SD.

close scrutiny reveals that a large majority of them do not bear out the Opponent's claim. For instance, the invoices were addressed to third parties (mainly Vinda Singapore Pte Ltd and Vinda Malaysia Sdn Bhd whose relationship with the Opponent is unknown) and for services other than advertising, promotion and marketing. It is also not evident that the subject matter of these invoices is the Opponent's Marks or the Opponent's Goods. The Applicant rightly points out that the invoices bear no relation to the advertising, promotional and marketing expenses amounting to nearly S\$2.5 million.

60 The Opponent submits that the Opponent's Goods have significant online presence and exhibits at Exhibit "J" screenshots from online marketplaces in Singapore such as Lazada and Shopee.¹⁸ However, it has not disclosed the number of "hits" and downloads by Singaporean consumers.

61 The positive reviews exhibited at Exhibit "H" attest to the quality and reliability of the Opponent's diapers for incontinence but not the level of recognition by the average consumers in Singapore such that the Opponent's Marks are associated exclusively with goods of a particular origin.

62 As for the awards exhibited at Exhibit "I", these are for the quality of the Opponent's Goods, as it has submitted.¹⁹ A number of the awards were given to a third party (namely, Vinda Singapore Pte Ltd) and for reasons that are not relevant for our purposes (such as "in recognition of your enduring partnership and invaluable contribution towards Serving Humanity, Saving Lives").

¹⁸ [14] of OWS.

¹⁹ [13] of OWS.

63 In the result, I find that the Opponent has not adduced sufficient evidence to establish a *prima facie* case on goodwill. I therefore hold that the Opponent has not established the first element (goodwill) of passing off and that its opposition based on Section 8(7)(a) fails.

64 In case I am wrong, I shall now consider the second element (misrepresentation) of passing off.

Misrepresentation

65 The test for establishing misrepresentation is substantially the same as that for “likelihood of confusion” under Section 8(2)(b) of the Act (*Sarika* at [76]-[77]). In *Hai Tong*, the Court of Appeal stated at [115] that, “although in an action for passing off, the court is not constrained in the same way that it would be in a trade mark infringement action in identifying the factors it may take into account”, the court was amply satisfied that the element of misrepresentation had been made out for the same reasons as those relied on to hold that there was a “likelihood of confusion” in an infringement action under Section 27(2)(b) of the Act (which mirrors the language of Section 8(2)(b) of the Act). Thus, if an opponent fails in an opposition under Section 8(2)(b), it would generally also fail under Section 8(7)(a).²⁰

66 In the present case, given my conclusion that the competing marks are not similar and there is, in any event, no likelihood of confusion, I find that the use of the Application Mark would not amount to a misrepresentation.

²⁰ There are of course exceptions, such as in *Staywell* in which the opponent succeeded under Section 8(2)(b) but failed in its passing off case under Section 8(7)(a) because it failed to prove that it had the necessary goodwill in the mark “St Regis” at the relevant date.

67 The Opponent’s case on misrepresentation is hinged solely on the assertion that the parties are in the same or closely related field of business (i.e., skincare, incontinence and diaper products) and this, coupled with “the high degree of similarity” of the parties’ marks and goods, would cause confusing misrepresentation to arise. The case falters because, as I have found, the marks are not similar and there is no likelihood of confusion.

Damage

68 In light of my findings above, there is no necessity to consider this third element of passing off.

Conclusion on opposition under Section 8(7)(a)

69 The ground of opposition under Section 8(7)(a) therefore fails.

The law under Section 8(4)(b)(i)

70 Section 8(4)(b)(i) of the Act reads:

“... 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;

....”

71 There are four elements which must be shown for an opposition under Section 8(4)(b)(i) of the Act (*Staywell* at [119]). They are

- (1) the whole or the essential part of each of the competing marks is identical or similar;
- (2) the earlier mark is well known in Singapore;
- (3) the use of the application mark would indicate a connection between the applicant’s goods or services and the proprietor; and
- (4) the connection is likely to damage the interests of the proprietor.

72 In *Sarika* (at [70-[71]), the Court of Appeal indicated that the difference between the language used in Section 8(4)(b)(i) (“the whole or an essential part of the trade mark is ... similar to an earlier trade mark”) and the language in Section 8(2)(b) (“similar to an earlier trade mark”) is immaterial. This means that the test for determining similarity of marks under Section 8(4)(b)(i) is the same as under Section 8(2)(b).

Application of Section 8(4)(b)(i) to the facts

73 It is undisputed that each of the Opponent’s Marks is an “earlier mark”.

74 With respect to the first element referred to above, I have already found that the parties' marks are not similar in the context of Section 8(2)(b). In particular, the marks are visually not similar to a high degree. Thus, the marks are also not similar for purposes of Section 8(4)(b)(i). In case I am wrong, I proceed to consider the second element.

75 On the second element, Section 2(1) states that "well-known trade mark" means

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

...

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

76 Thus, a trade mark which has not acquired goodwill for purposes of passing off can be a well known mark for purposes of Section 8(4)(b)(i). To determine whether a trade mark is well known in Singapore, Section 2(7) states that:

“... it is 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.”

77 These factors serve as guidelines and the court is free to disregard any or all of the factors as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).

78 Section 2(8) states that “[w]here it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark is deemed to be well known in Singapore”.

79 Section 2(9) defines the “relevant sector of the public in Singapore” as including any of the following:

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

80 It has been authoritatively said that 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) deems a trade mark to be well known in Singapore where it is well known to *any* relevant sector of the public in Singapore (*Amanresorts* at [139]). This led to the view that it is relatively easy for a trade mark to be regarded as well known in Singapore. The Court of Appeal in *Amanresorts* seemed to agree with this view as it 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” which could in certain cases be miniscule (*Amanresorts* at [229]). However, the court subsequently advised in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Ceramiche Caesar*”) that the comment should not be taken to mean that the hurdle that trade mark owners had to cross was minimal. Rather, the comment had to be applied with judicious caution to the actual facts and circumstances of each case. The comment was not made to lay down a general principle. The context of the

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. The court added 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.” (*Ceramiche Caesar* at [102])

81 In my view, whether the threshold has been crossed and a mark has become well known to any sector of the public is a question of fact which is dependent on the actual facts and circumstances of each case. In the present case, the Opponent contends that the Opponent’s Marks were well known at the Relevant Date and relies on the submissions and evidence adduced in support of the element of goodwill for its passing off claim.²¹ I have pointed out a number of deficiencies with respect to those submissions and evidence, including the fact that they do not at all throw any light on the extent and scale of sales and promotional expenditure that relate to Singapore (see [56]-[62] above). As these deficiencies also afflict the Opponent’s position on the issue whether the Opponent’s Marks were well known at the Relevant Date, I am unable to find that the marks were indeed well known to any sector of the public in Singapore at the Relevant Date.

82 The Opponent cites its several applications and registrations of the Opponent’s Marks in various countries and regions globally, including Taiwan and Hong Kong.²² In general, these are not relevant for our consideration: see, e.g., *Digi International Inc. v Teraoka Seiko Co. Ltd* [2021] SGHC 165 at [193]. This is especially so if there is no evidence that *as a result* of the applications,

²¹ [22(a)] read with [10]-[17] of OWS.

²² [22(b) and (c)] read with [7]-[8] of OWS.

registrations and oppositions, the Opponent’s Marks have become recognised or known by any sector of the public in Singapore.

83 I am also unable to give any weight to the decisions of the tribunals in the Opponent’s oppositions in Hong Kong and Taiwan, especially as there is no evidence adduced to show that the legal principles applied by the tribunals are similar to those relating to Section 8(4)(b)(i). Indeed, the principles applied by the tribunal in the Hong Kong proceedings in determining an opposition under Section 12(3) of the Trade Mark Ordinance (similar to Section 8(2)(b) of the Act) are markedly different from those for an opposition under Section 8(2)(b) in that the tribunal adopted the “global assessment” approach of English and EU law, not the “step-by-step” approach that our courts have adopted. The relevance of the Hong Kong’s tribunal’s decision is further attenuated by the fact that the Applicant had chosen not to contest it.

Conclusion under Section 8(4)(b)(i)

84 In the premises, there is no need for me to consider the other elements of Section 8(4)(b)(i) and the ground of opposition under that provision fails.

The law under Section 8(4)(b)(ii)

85 Section 8(4)(b)(ii) relevantly reads:

“... 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

- (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) if the earlier trade mark is well known to the public at large in Singapore;
 - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
 - (B) would take unfair advantage of the distinctive character of the earlier trade mark.”

86 This provision grants a much more extensive level of protection to trade marks which have attained the “coveted” status of being “well known to the public at large in Singapore”. Such marks form “a rare and exclusive class”, and are entitled to protection from use of a trade mark on dissimilar goods or services even in the absence of a likelihood of confusion (*Amanresorts* at [233]). To attain the coveted status, the mark has to be more than just “well known in Singapore”. It has to be recognised by *most* sectors of the public (though not so far as to all sectors of the public), rather than any sector of the public (*City Chain* at [94]). The threshold for attaining the status is understandably higher than that required for a mark which is “well known in Singapore”.

Application of Section 8(4)(b)(ii) to the facts

87 For the reasons set out at [81]-[83] above, I have ruled that the Opponent has not overcome the threshold of establishing that the Opponent’s Marks are well known to any sector of the public in Singapore. This ruling applies with

greater force in relation to the Opponent's opposition under Section 8(4)(b)(ii), especially as it has not adduced any additional evidence in support of the opposition under that provision. I find that none of the Opponent's Marks has in fact achieved the coveted status in Singapore, and there is therefore no necessity to address the Opponent's submissions concerning unfair dilution and unfair advantage.

Conclusion on opposition under Section 8(4)(b)(ii)

88 The ground of opposition under Section 8(4)(b)(ii) therefore fails.

The law under Section 7(6)

89 Section 7(6) of the Act states that a trade mark shall not be registered if or to the extent that the application is made in bad faith.

90 Although "bad faith" is not defined in the Act, there is ample local authority to indicate that it "includes dishonesty and ... includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area of trade being examined": see, e.g., *Valentino Globe BV v Pacific Rim Industries Inc.* ("*Valentino*") [2010] 2 SLR 1203 at [30].

91 An allegation that an applicant had filed a trade mark application in bad faith is a serious allegation against him and is not to be lightly inferred. As such, the allegation must be distinctly proved: see, e.g., *McDonald's Corp. v Future Enterprises Pte Ltd* [2005] 1 SLR 177 at [78]. The evidential burden of proof is on the party who makes the allegation, and the standard of proof is the balance

of probabilities, but cogent evidence is required to establish the allegation due to the seriousness of the allegation: see *Wing Joo Loong Ginseng Hong (Singapore) Co. Pte Ltd. v Qinghai Xinyuan Foreign Trade Co. Ltd* [2009] 2 SLR 814 at [33] and *Valentino* at [30].

92 In *Festina*, Tay Yong Kwang J (as he then was) said (at [115]):

“... despite the broad nature of the notion of bad faith, one must show *some sort of nexus* between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in vacuum. A clear-cut example of such a nexus would be an outright copying of the proprietor’s mark such that the two competing marks are practically identical. However, the nexus may be in the guise of something more subtle. In finding a nexus between the parties, a parallel may be drawn between ss 8(2)(b) and 7(6) TMA. For example, there may be cases where although there is *some* similarity of marks or of the goods or services, it falls short of confusing similarity (*ie*, no likelihood of confusion) within the meaning of s 8(2)(b) TMA. Nevertheless, the evidence of this similarity may be taken into account and considered against the background facts from which bad faith may be inferred. In other words, while the finding of bad faith is largely, if not invariably, based on circumstantial evidence, the party alleging bad faith needs to show some link between the parties, perhaps by way of a preexisting relationship or some acts of association with the proprietor or some nexus between the two competing marks.” (emphasis in original)

Application of Section 7(6) to the facts

93 The Opponent argues that the Applicant had in bad faith proceeded to file its application for trade mark registration of the Application Mark even though it would have “full awareness and knowledge” of the Opponent’s Marks and the Opponent’s Goods, given that the Applicant only filed the application some 20 years later than the Opponent’s applications and the Opponent’s Marks had been in use for 5 years since at least 2015.²³ The difficulty with this argument is that the Applicant’s application was for a mark (namely, the Application Mark) which is neither identical nor similar to any of the Opponent’s Marks and there is no likelihood of confusion. In view of this, and as there was no nexus and pre-existing relationship between the parties, I do not consider the application to register the Application Mark to be dishonest or to fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced business people.

Conclusion on opposition under Section 7(6)

94 As the Opponent has not provided cogent evidence to tilt the balance of probabilities in its favour in relation to a serious allegation, I find that the ground of opposition under Section 7(6) fails.

Overall conclusion

95 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds under Section 8(2)(b), Section 8(7)(a), Section 8(4)(b)(i), Section

²³ [82] and [85] of OWS.

8(4)(b)(ii) and Section 7(6) of the Act. The application will proceed to registration. The Applicant is also entitled to costs as follows:

(a) Party and party costs: \$5,580.00

(b) Disbursements: \$2,160.00

The total assessed costs to be paid by the Opponent to the Applicant are \$7,740.00.

Tan Tee Jim, SC
IP Adjudicator

Suhaimi Bin Lazim (Mirandah Law LLP) for the Applicant;
Amos Khaw and Joyce Goh (ZICO IP Pte Ltd) for the Opponent.
