

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

Trade Mark No. 40201605065Y  
27 August 2020

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

**YITAI (SHANGHAI) PLASTIC CO., LTD.**

**AND**

**OPPOSITION THERETO BY**

**CHARLOTTE PIPE AND FOUNDRY COMPANY**

Hearing Officer: Cheng Pei Feng  
IP Adjudicator

Representation:

Mr Samuel Wee and Ms Jessica Cheng (Yusarn Audrey) for the Applicant

Ms Ashley Chew Lixian and Mr Tan Guodong (Ella Cheong LLC) for the Opponent

**GROUND OF DECISION**

1 This was a case involving marks used by an American company set up since the turn of the last century. It had been in the business of manufacturing pipes and fittings and over time established a global presence. A China company set up a hundred years later had ambitions of competing in the same market, using a mark which the American company accuses of being identical or too similar to its own. Would the attempt by the new upstart to register its own mark turn out to be a pipe dream?

2 On 7 October 2015, YITAI (SHANGHAI) PLASTIC CO., LTD. (“the Applicant”) filed its International Registration No. 1292448 for the trade mark **CHARLOTTE** (“the Application Mark”), designating Singapore. On 17 March 2016, the Intellectual Property Office of Singapore (“IPOS”) was notified of the Applicant’s International Registration designating Singapore. The Applicant’s Singapore application under Trade Mark No. 40201605065Y is in Classes 17, 19 and 20 in respect of the following goods:

Class 17

Sealing rings; casings for pipes, not of metal; junctions for pipes, not of metal; plastic pipes; plastic board; plastic poles; plastic strips; flexible tubes, not of metal; clack valves of rubber.

Class 19

Rigid pipes, not of metal; water-pipes, not of metal; rigid pipes for building, not of metal; plastic ducts used in construction; drain traps or valves, not of metal or plastic; water pipes, not of metal; water-pipe valves, not of plastic or metal; building materials, not of metal; reinforcing materials, not of metal, for building.

Class 20

Clips for cables and pipes, not of metal; valves, not of metal, other than parts of machines; water-pipe valves of plastic; drain valves of plastic; fiber reinforced plastic container; plastic trough for cables and wires; valves, not of metal, other than parts of machines.

3 The Singapore application was accepted and published on 6 October 2017 for opposition. Charlotte Pipe and Foundry Company (“the Opponent”), filed its Notice of Opposition to oppose the registration of the Application Mark on 6 February 2018. The Applicant filed its Counter-Statement on 6 August 2018.

4 The Opponent filed its evidence in support of the opposition on 28 March 2019. The Applicant filed its evidence in support of the application on 29 July 2019. The Opponent filed its evidence in reply on 13 May 2020. Following the close of evidence, the Pre-Hearing Review was held on 12 June 2020. The opposition was heard on 27 August 2020.

**Grounds of Opposition**

5 The Opponent relies on Section 8(2)(b), Section 8(4)(b)(i) read with Section 8(4)(a) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

**Opponent’s Evidence**

6 The Opponent’s evidence comprises the following:

- (i) a Statutory Declaration made by Brad Muller, Vice President of the Opponent, on 22 March 2019 in the United States of America.
- (ii) a Statutory Declaration in Reply made by Todd Diggs, Director of International Sales of the Opponent, on 20 March 2020 in the United States of America.

### Applicant's Evidence

7 The Applicant's evidence comprises a Statutory Declaration made by Wang Qiu Bin, director of the Applicant, on 17 July 2019 in the People's Republic of China.

### Applicable Law and Burden of Proof

8 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

### Background

9 The Opponent is a company organised and existing under the laws of the United States of America ("USA"). It was founded in 1901 and the Opponent's company name and related trade marks comprising "Charlotte" are derived from the name of the city, Charlotte, in North Carolina of the USA, where the Opponent was first set up and remains headquartered. The Opponent manufactures pipes and fittings for plumbing and industrial systems. It claims to be one of the world's leading manufacturers of pipes and fittings for plumbing and industrial systems and its products are sold and distributed worldwide to Latin America, the Middle East, Oceania and Asia, including Singapore<sup>1</sup>.

10 In Singapore, the Opponent is the registered proprietor of the following trade mark registration in Class 6 ("**Opponent's Registered Mark**")<sup>2</sup>:


TRADE MARK NO	MARK	CLAUSE	CLASS / GOODS	APPLICATION DATE
40201604945Q (IR No. 1292566)	CHARLOTTE PIPE	Registration of this mark shall give no right to the exclusive use of the word "Pipe".	<b>Class 06</b>  Cast iron pipes and fittings therefor.	09 February 2016

11 The Opponent also asserts to be the owner at common law of various "Charlotte" related trade marks which are not registered, at least not in Singapore, and which

<sup>1</sup> Brad Muller's SD at [3] to [4].

<sup>2</sup> Brad Muller's SD at [6].

include but are not limited to the following marks covering Class 6 (Cast iron pipes and fittings) and Class 17 (Plastic pipes and fittings) (“**Opponent’s Unregistered Marks**”)<sup>3</sup>:

MARK
CHARLOTTE PIPE
CHARLOTTE


12 In this opposition, the Opponent seeks to assert its rights over the Opponent’s Registered Mark and the Opponent’s Unregistered Marks.

13 The Applicant is a company based in Shanghai, in the People’s Republic of China (“China”), and established since 2001. It is in the business of manufacturing and supplying products such as plastic valves, fittings, production, design and development of industrial piping systems for both domestic and international markets. The Applicant asserts that it has been using the **CHARLOTTE** mark and has obtained registrations for the mark in various countries, including China, South Korea and Vietnam<sup>4</sup>. The Applicant also asserts that it has been exporting its products into the Singapore market since around January 2011.

## MAIN DECISION

### Preliminary issues:

#### *Marks which the Opponent can rely on*

14 A preliminary issue which came up for consideration in this case was the issue of the marks which the Opponent could rely on for the purposes of its opposition. During the hearing on the opposition, counsel for the Applicant raised a preliminary objection to the Opponent’s reliance on the Opponent’s Unregistered Marks which it argues was not part of the Opponent’s pleaded case.

15 Applicant’s counsel argued that when the Grounds of Opposition was filed, the Opponent had referred only to the Opponent’s Registered Mark for CHARLOTTE PIPE (as shown above at [10]) and that it was not stated anywhere else that any other marks were being referred to or relied on, and that the reference to the Opponent’s Unregistered Marks surfaced for the first time only in the written submissions tendered by counsel for the Opponent. The Applicant further asserted that the Opponent had framed its ground of Opposition under Section 8(2)(b) as being based only on the Registered Mark and it was only in the submissions that the Opponent is now seeking to rely on the earlier Opponent’s Unregistered Marks. In support of its position, the Applicant referred to various case authorities where the Court had held parties to be

<sup>3</sup> Brad Muller’s SD at [5] and Annex 2, Todd Digg’s SD in Reply at [23] and Opponent’s written submissions at [7].

<sup>4</sup> Wang Qiu Bin’s SD at [6] – [7].

bound by their pleadings and that the court would be precluded from considering matters which parties had not put into issue: see *V Nithia (co-administratrix of the estate of Ponnusamy Sivapakiam, deceased) v Buthmanaban s/o Vaithilingam & another* [2015] SGCA 56, *Adidas International Marketing BV v Lutong Enterprise Corp* [2018] SGIPOS 12, *Apple Inc v Swatch AG (Swatch SA)(Swatch Ltd.)* [2018] SGIPOS 15, and *Inuit Inc v Minterest Private Limited* [2019] SGIPOS 16. Counsel for the Applicant also sought to rely on Rule 30(2) of the Trade Marks Rules which imposes certain requirements on the information which must be included in the notice of opposition where the registration is opposed on the ground that the mark is identical or similar to an earlier trade mark. Based on the foregoing arguments and the preliminary objection, although the Applicant was invited at the hearing to explain the Applicant's position on the Opponent's Unregistered Marks, the Applicant's counsel explained that it would not be responding on these marks as its fundamental position was that the Opponent should not be entitled to rely on them at all as these unregistered marks did not form part of the Opponent's pleaded case.

16 In response to this issue, counsel for the Opponent argued at the hearing that paragraph 2 of the Opponent's Grounds of Opposition had referred to the Opponent being the owner of the common law rights and goodwill in the trade mark CHARLOTTE PIPE without confining it only to the registered trade mark. Counsel further distinguished the case of *V Nithia* where the Plaintiff had sought to rely on an entire cause of action which had not been pleaded at all, which was not the case here. The pleadings here, on the other hand, was wide enough to cover any mark belonging to the Opponent which contained the word "CHARLOTTE PIPE". Furthermore, any defect in the pleadings was rectified through the evidence tendered as it was clear from Brad Muller's Statutory Declaration that the evidence referred to and exhibited showed the unregistered marks of the Opponent. Counsel confirmed that it was not seeking to rely on an argument of "family of marks" but was seeking to rely only on the three marks asserted as the Opponent's Unregistered Marks (as shown at [11] above) or in the alternative, on unregistered marks for CHARLOTTE PIPE and the logo mark "

**CHARLOTTE**  
PIPE AND FOUNDRY COMPANY

" which contained the word "CHARLOTTE PIPE" within it. Counsel for the Opponent also noted that the Applicant chose not to respond on these marks although they had come out in the evidence in Brad Muller's Statutory Declaration and neither did the Applicant ask to file a further reply to Todd Digg's Statutory Declaration in Reply which had specifically, at [23], clarified that other than the Opponent's Registered Mark, the Opponent's trade marks included and is not

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PIPE AND FOUNDRY COMPANY

limited to the trade marks CHARLOTTE and **CHARLOTTE** PIPE AND FOUNDRY COMPANY. Counsel further argued that the standard for pleadings should be lower for proceedings before IPOS, which was a low-cost tribunal compared to the courts and should not require as much particularisation.

17 On this preliminary issue, I noted that the Opponent's Ground of Opposition did refer generally to its common law rights in the trade mark CHARLOTTE PIPE without specifying it as being confined only to the registered mark. The Opponent also stated that the trade mark had been accepted and registered in many jurisdictions around the world and that further details of the pending applications and registrations of the Opponent's Mark may appear in the evidence to be submitted<sup>5</sup>. Having said that, there

<sup>5</sup> Grounds of Opposition at [2].

was much left to be desired in the manner of the Opponent's pleadings as the Opponent did not then set out in full all the marks it clearly intended to rely on for its opposition, preferring to focus mainly on the Opponent's Registered Mark. This may be due to the Opponent thinking initially that the Opponent's Registered Mark was an earlier mark which it could fully rely on, although this was conceded subsequently by the Opponent to be later in time (more on this will be elaborated further below). It was also puzzling why no specific reference was made in the Opponent's pleadings to the unregistered

logo mark **CHARLOTTE**  
PIPE AND FOUNDRY COMPANY when the Opponent had intended to rely on it. Indeed, for the comparison on the similarity between the marks, at [7] to [10] of the Opponent's Grounds of Opposition, the Opponent highlighted its Registered Mark, showing only a table comparing the Application Mark and the Opponent's Registered Mark. This was likewise repeated in the Opponent's first Statutory Declaration by Brad Muller.

18 The Opponent's evidence, however, clearly sought to refer to the use of the Opponent's Unregistered Marks in Singapore, especially for the sample invoices showing sale of the Opponent's products to Singapore, where the logo mark **CHARLOTTE**  
PIPE AND FOUNDRY COMPANY was clearly marked out repeatedly and referred to<sup>6</sup>. As pointed out by counsel for the Opponent, it also sought to clarify its position in the Statutory Declaration by Todd Diggs, stating that it was in fact also relying on the Opponent's

Unregistered Marks **CHARLOTTE**  
PIPE AND FOUNDRY COMPANY and **CHARLOTTE**  
PIPE AND FOUNDRY COMPANY.

19 For proceedings before the IPOS, a low-cost tribunal, it is true that the level of particularisation for pleadings and evidence tendered generally may not be as detailed as those used in courts proceedings. That, of course, does not mean that parties are not bound by their pleadings. At the same time, in applying this rule in the case of *V Nithia*, which was referred to by counsel for both sides, the Court of Appeal had also emphasised, at [39] – [40], that the “court is not required to adopt an overly formalistic and inflexibly rule-bound approach even in those clear cases that to do so might lead to an unjust result” and that “the law permits the departure from the general rule in limited circumstances, where no prejudice is caused to the other party in the trial or where it would be clearly unjust for the court not to do so”.

20 In the present case, whilst the Opponent's case could probably have been better and more clearly pleaded, I am prepared to accept the arguments by the Opponent as there was sufficient reference in its pleadings and the evidence tendered, to the Opponent's common law rights in its Unregistered Marks. This was also not a case where the Opponent had sought to belatedly raise a whole new unrelated ground of opposition which caused irreparable prejudice to the Applicant. Ultimately, the Applicant did have sufficient notice of the Opponent's case and the marks being relied on, and even if there had been doubt or uncertainty earlier, there were ample opportunities by the Applicant to seek clarification and to provide further response in evidence, if it was inclined to. It did appear to me that the Applicant made a deliberate choice not to address, even as an alternative, its position if the Opponent's Unregistered Marks were included and chose only to proceed on the basis that such marks could not be relied on at all by the Opponent.

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<sup>6</sup> Brad Muller's SD at Annex 6.

21 In view of the above finding, the subsequent discussions on the grounds of opposition will cover both the Opponent's Registered Mark and the Opponent's Unregistered Marks, where applicable.

*Whether the Opponent can rely on the ground of opposition under Section 8(2)(b)*

22 When the Grounds of Opposition was filed, the Opponent had specified that registration of the Application Mark would be contrary to Section 8(2)(b) of the Act<sup>7</sup>. Subsequently, in the first Statutory Declaration filed by Brad Muller, the Opponent confusingly stated that the Opponent would no longer be relying on this ground of opposition<sup>8</sup>. The Opponent then did another about turn when it filed its Statutory Declaration in Reply by Todd Diggs where it clarified that the Opponent was still proceeding with the ground of opposition under Section 8(2)(b) of the Act, subject to any formal application for leave to amend its Statement of Grounds<sup>9</sup>. There was eventually no application by the Opponent to amend its Grounds of Opposition.

23 At the hearing of the opposition, counsel for the Applicant sought to raise this as an argument, that the Opponent was no longer relying on this ground of opposition. However, this should not have been an issue at the oral hearing on 27 August 2020 as any earlier confusion over it had been clarified and determined at the Pre-Hearing Review held on 12 June 2020.

24 At this Pre-Hearing Review, the question of the Opponent's wavering position on this ground of opposition was raised by counsel for the Applicant. Counsel for the Opponent argued that it was still allowed to proceed on Section 8(2)(b) as the Statutory Declaration was not a proper place to drop a ground of opposition and it had subsequently rectified its position in its Statutory Declaration in Reply. The IPOS Registrar had criticised the Opponent for its less than ideal treatment of this issue given the length of time between the Opponent's first Statutory Declaration and its Statutory Declaration in Reply. Nonetheless, the Applicant was provided the full opportunity to respond and was asked by the IPOS Registrar if the Applicant needed to supplement its Statutory Declaration to address this point. Although the Applicant's counsel protested that the Opponent's procedure was improper, the invitation to put in a supplemental Statutory Declaration was not taken up and counsel said that the matter could still proceed to hearing. In this context, the IPOS Registrar then concluded that the Opponent could proceed with Section 8(2)(b) as the ground had been pleaded and the pleading was not amended, leaving open the issue of costs, which was not dealt with at that time.

25 As the issue had already been dealt with and determined at the Pre-Hearing Review, I reminded counsel that parties already had the opportunity and had addressed this issue before the hearing and it should not be reopened. In any event, I note that the Applicant was prepared and had responded to this ground of opposition in its submissions, both written and oral, and it did not appear that any further evidence needed to be tendered from the Applicant to address this ground. On this note, I turn now to deal with the grounds of opposition.

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<sup>7</sup> Grounds of Opposition at [10].

<sup>8</sup> Brad Muller's SD at [30].

<sup>9</sup> Todd Digg's SD in Reply at [12(c)].

**Grounds of Opposition under Section 8(2)(b) and Section 8(4)(b)(i) read with Section 8(4)(a)**

26 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.

27 Section 8(4) of the Act reads:

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1<sup>st</sup> 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

28 Section 8(5) of the Act provides as follows:

(5) A trade mark shall not be refused registration by virtue of subsection (4) if the application for the registration of the trade mark was filed before the earlier trade mark became well known in Singapore, unless it is shown that the application was made in bad faith.

***Decision on Sections 8(2)(b) and 8(4)(a)-(b)(i)***

*The Opponent's earlier trade marks*

29 A common feature of the grounds of opposition under both Sections 8(2)(b) and 8(4)(a)-(b)(i) is an “earlier trade mark” upon which the Opponent relies to object to the registration of the Application Mark.

30 The phrase “earlier trade mark” is specifically defined in the Act. Section 2(1) provides as follows:

“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.

31 The Opponent had initially seemed to rely on the Opponent’s Registered Mark as an earlier trade mark. In Brad Muller’s Statutory Declaration, the Opponent’s Registered Trade Mark was referred to as an “earlier” trade mark registration<sup>10</sup>. Todd Digg’s Statutory Declaration in Reply also claimed that the Opponent’s Registered Mark was an earlier trade mark under Section 2(1) of the Act as it was entered on the Singapore’s Trade Mark register on 9 June 2017, earlier than the Application Mark which was pending since its publication date on 6 October 2017<sup>11</sup>. This was refuted by the Applicant on the basis that the date of application for the Opponent’s Registered Mark in Singapore was on 9 February 2016, which was *after* the date of the Applicant’s International Registration on 7 October 2015.

32 On this issue, I fully agree with the Applicant’s position as the relevant date of priority for the Application Mark should be the date of application for the International Registration of the Application Mark where Singapore was designated, which is on 7 October 2015. It is not the date that IPOS was notified of the International Registration designating Singapore (which was on 17 March 2016) and neither is it the date the Singapore application was accepted for publication (which was on 6 October 2017). For completeness, this position appeared to be conceded later by the Opponent as well, as the Opponent’s written and oral submissions subsequently referred to the relevant date, taking into account the priorities claimed, as 7 October 2015. Therefore, it was clear that the Opponent’s Registered Mark could not be an “earlier trade mark” under Section 2(1) of the Act.

33 Apart from the Opponent’s Registered Mark, the Opponent was also relying on its Unregistered Marks as being “well known trade marks” under Section 2(1), read with Sections 2(7) and 2(8) of the Act. To succeed on this basis, the Opponent would need to show that at least one of its Unregistered Marks is a well known trade mark as at 7 October 2015, which is the relevant date (“**relevant date**”).

*Whether the Opponent’s Unregistered Marks are well known trade marks*

34 The term “well known trade mark” is defined in section 2(1) of the Act, which provides as follows:

“well known trade mark” means —

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<sup>10</sup> Brad Muller’s SD at [4].

<sup>11</sup> Todd Digg’s SD in Reply at [12].

- (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.

35 Sections 2(7) to 2(9) of the Act further define the relevant matters to be considered in determining whether a trade mark is well known in Singapore and provide as follows:

(7) 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.
- (8) 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.
- (9) 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.

36 The Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) held (at [137] and [139]-[140]) that the factor in Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is

well known in Singapore, although it also recognised that the factors listed in Section 2(7) were not exhaustive and that the court is ordinarily free to disregard any or all of the factors as the case requires and to take additional factors into consideration. It was also held, at [229], that “it is not too difficult for a trade mark to be regarded as “well known in Singapore” – essentially, the trade mark in question need only be recognised or known by “any relevant sector of the public in Singapore”, which sector could in certain cases be miniscule...”.

37 On the last point, in the subsequent decision of *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“**Caesarstone**”), the Court of Appeal clarified, at [101-102]:

101 Although we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore (see [100] above), the Judge thought that this 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.

102 We do not think that this comment in *Amanresorts* was made to lay down a general principle. In this regard, we agree with the Respondent’s submission that 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.

38 The Opponent argued that the Opponent’s Unregistered Marks, which is referred to here as its “Charlotte Marks”, were well known in Singapore based on the following factors:

- (a) The Opponent’s duration, extent and geographical area of use and promotion of its Charlotte Marks;
- (b) The Opponent’s worldwide registrations and use of its Charlotte Marks;
- (c) The Opponent’s enforcement of its rights in its Charlotte Marks in China; and
- (d) The Opponent’s Charlotte Marks are each well known to the plumbing and industrial systems sector of the public in Singapore, and therefore shall be deemed well known in Singapore

39 I will deal with the second and third factors first as the evidence tendered on these points were more straightforward. Under the second factor, which corresponds to the factor in Section 2(7)(c) of the Act, the Opponent asserted that the Opponent’s Unregistered Marks were first used in Singapore since the 1960s. This, however, appeared to be a bare assertion as there was no clear evidence tendered to support this claim at all. The Opponent then relied on evidence of its worldwide registrations of its trade marks, asserting that such worldwide registrations in combination with its long-standing and extensive use showed the well known status of its marks.

40 As pointed out by the Applicant, an examination of the evidence tendered by the Opponent showed that the worldwide registrations for its CHARLOTTE PIPE mark started only from 9 February 2016 and any earlier registrations referred only to registrations within the USA of the Opponent's marks in various Charlotte variants. On this note, it should be mentioned that initially, the Opponent had sought only to tender its own table listing of the worldwide registrations without reference to proper source materials<sup>12</sup> and that alone would have been insufficient to show that such worldwide registrations existed. The Opponent sought to cure this problem in its subsequent Statutory Declaration in Reply where it put in the source documents evidencing the worldwide registrations<sup>13</sup>. However, none of the evidence showed any *earlier* registrations for the CHARLOTTE PIPE mark in the rest of the world and none of the worldwide registrations appeared to even relate to the other two of the Opponent's

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Unregistered Marks for CHARLOTTE and PIPE AND FOUNDRY COMPANY. In this regard, I noted that there was often a generic reference by the Opponent to its various Charlotte related marks, without clearly distinguishing which specific mark the evidence related to. The Opponent's arguments would probably have benefited from a less haphazard presentation of its evidence and greater clarity on the specific marks it wanted to rely on and the evidence in support of its position.

41 As acknowledged in the Opponent's own submissions, registrations do not automatically equate to trade mark use (see *Formula One Licensing BV v Idea Marketing SA* [2015] SGHC 263, at [66]). There was clearly no proof of use or recognition of the Opponent's Unregistered Marks from this factor alone. Even if I accepted that the Opponent did make a substantial number of international filings, they related only to the CHARLOTTE PIPE mark and they were done only after the relevant date of 7 October 2015. Thus, the conclusion on this factor is that it did not assist the Opponent.

42 I turn to the next factor on the enforcement by the Opponent of its rights in China, which corresponds to the factor in Section 2(7)(d) of the Act. The Opponent has filed for invalidation of the Applicant's registered mark in China (which appears to be the same as the Application Mark here) and it stated that the Opponent is also contemplating filing similar actions in South Korea and Vietnam, where the Applicant had likewise registered its Application mark. At the time of the hearing, the Opponent's invalidation application was still pending in China and there was no indication of when any similar invalidation application would be made in South Korea or Vietnam. The Opponent asserts that the enforcement of its right in China caught the attention of "international media" and "an outpouring of support for the Opponent" but all that was tendered in support of this assertion was an online publication of the American Supply Association's interview with the Opponent's spokesperson, Brad Muller, which interview had then made mention of an earlier Fox News report on the same<sup>14</sup>. The references to these American based media were self-serving at best and hardly seemed relevant especially given that it did not shed light on whether the Opponent's Unregistered Marks were well known in Singapore at the relevant date. The application in China carried little weight, if any at all, for the present opposition as there has been no finding at all on whether the Opponent's Unregistered Marks was well known at the

<sup>12</sup> Brad Muller's SD at Annex 2.


<sup>13</sup> Todd Digg's SD in Reply at Exhibit TD-5.

<sup>14</sup> Todd Digg's SD in Reply at Exhibit TD-4, pages 153-154.

relevant date and whether it was well known in Singapore at that time. This factor is therefore also of no assistance to the Opponent.

43 Finally, I turn to the first and last factors, which correspond to the factors in Section 2(7)(b) and 2(7)(a) respectively. Here, the Opponent asserted that its Unregistered Marks have been used continuously and extensively by it, referring to its worldwide distribution networks of its goods, including in Singapore, and substantial marketing and promotional efforts expended in respect of the same<sup>15</sup>. The Opponent argued that its sales figures and substantial marketing and promotional efforts, including establishing a “Charlotte Pipe University” website, videos, mobile applications, social media pages and online resources regarding its products all generated significant actual and potential consumers in Singapore. These showed that the Opponent’s Unregistered Marks were well known by the plumbing and industrial systems sector of the public in Singapore.

44 On the evidence of the printouts from the Opponent’s website with a listing of its worldwide distributors and agents<sup>16</sup>, it was not clear how this evidence showed that the Opponent had long and substantial use of its Charlotte Marks, at least in Singapore, as at the relevant date of 7 October 2015. The printouts from the Opponent’s website were dated in 2019 and there was no reference to when these online presence were established and how they would show if the Opponent’s Unregistered Marks were already well known in Singapore in 2015.

45 The Opponent also relied on printouts which it claimed showed all the Opponent’s trade marks being used on the Opponent’s goods since the 1960s<sup>17</sup>. However, what was exhibited for this was an undated photo of a building with the Charlotte logo mark with the words “Industrial Piping Systems”, notably not any one of the Opponent’s Unregistered Marks which it was relying on. It was not clear when this photo was taken, where this building was located and how it would be relevant since it did not show any of the Opponent’s Unregistered Marks. Annex 4 also showed another two photos under a heading “Open House September 2014” which showed some displayed products bearing the  mark. Likewise, these two photos were undated, save for the heading which was self-inserted, so it was not clear that these photos were indeed taken in 2014. In any event, it was not clear nor explained where this Open House was, who it was open to and whether it was even held in Singapore. It was certainly not explained how these photos even showed use of the Opponent’s Unregistered Marks since the 1960s, given that nothing in the photos exhibited referred to that period.

46 As for the evidence of its marketing and promotional efforts, including online use of the Opponent’s Unregistered Marks, the evidence tendered showed printouts from the Qoo10 and ebay third-party online retailer websites, the Opponent’s “Charlotte Pipe University”, YouTube channel, mobile application and the website of its Singapore distributor Agru Technology Pte Ltd (“Agru Tech”). Notably, all of these printouts were done in 2019 as well with nothing clearly evidencing the state of use of the Opponent’s marks in Singapore in 2015 or earlier. While there were some references

<sup>15</sup> Brad Muller’s SD at [9]-[17] and Todd Digg’s SD at [22]-[25].

<sup>16</sup> Brad Muller’s SD at Annex 1.

<sup>17</sup> Brad Muller’s SD at [9] and Annex 4.

to earlier dates in the printouts which may suggest that some of the online presence may have existed since 2017, this was quite tenuous and unclear and nothing pointed to dates in 2015 or earlier. There was a reference to a printout titled “Charlotte Pipe – Website (Google Analytics) For 02/01/2015 – 02/27/2019”<sup>18</sup> which purportedly showed “new users” and “sessions” of the listed countries, including Singapore. However, this document was unclear as to how it was derived, whether it was independently generated from a third party source, what or when the “new users” or “sessions” related to, which “Charlotte Pipe website” the data related to. It was again unclear how this evidence assisted the Opponent’s case and showed usage of the Opponent’s Unregistered Marks in Singapore by 2015 or earlier.

47 The Opponent also tendered some promotional materials<sup>19</sup> of its products but it was not clear where these promotional materials were used or if used in Singapore at all. The promotional materials also featured only the **CHARLOTTE** PIPE AND FOUNDRY COMPANY Unregistered Mark and some other Charlotte related marks but not the CHARLOTTE PIPE or CHARLOTTE Unregistered Marks. Although the Opponent claimed to have carried out extensive marketing and promotional efforts, there was no data or figures provided by the Opponent to show its expenditure on such marketing or the promotion of the Opponent’s goods bearing the Unregistered Marks in Singapore or elsewhere.

48 The Opponent also asserted that it had earned very substantial revenue and claimed that its approximate annual sales in Singapore for its products under the Opponent’s trade marks, including the CHARLOTTE PIPE Mark, from 2003 to 2015 were as follows<sup>20</sup>:

<b>YEAR</b>	<b>SALES (USD) Approx.</b>
2003	183,457
2004	201,819
2005	356,343
2006	83,243
2007	N.A
2008	N.A
2009	N.A
2010	N.A
2011	N.A
2012	N.A
2013	44,975
2014	52,829
2015	172,077

49 Such evidence may have been significant except that it was not entirely clear how these figures were derived. The Opponent tendered copies of “sales records for goods sold in Singapore, showing the combined annual sales figures between 2003 to 2015”<sup>21</sup>. A close examination of these purported sales records showed a highlighted figure for each year which appeared to correspond with the respective sum stated in the

<sup>18</sup> Brad Muller’s SD at Annex 5, pages 111-112.

<sup>19</sup> Brad Muller’s SD at Annex 10.

<sup>20</sup> Brad Muller’s SD at [12]. Another set of figures was provided in Todd Digg’s SD in Reply at [22] but appear to be same save that the figures were stated in Singapore Dollars.

<sup>21</sup> Brad Muller’s SD at [12] and Annex 7.

above table. However, there was nothing in each of these documents to show how the figure related to the sales in Singapore. The documents were each titled “SALES DOLLARS AND WEIGHT”, followed by the words “Report reflects current affiliation. Account history moves with affiliate”. The documents appeared to be printouts generated in 2019, there was no mention of or reference to Singapore and no mention even of the Opponent or any of the Charlotte marks anywhere at all in the documents. While there appeared to be a summary document referring to “Sales to Singapore”<sup>22</sup>, this document had no reference to the Opponent or if the sales related to products carrying the Charlotte marks. There were no other public documents or accounts (audited or unaudited) or balance sheets contemporaneous with each period, that were tendered in support of these purported sales figures.

50 Finally, apart from these documents, the Opponent had also tendered sample invoices from 2013 to 2015<sup>23</sup> and 2004 to 2005<sup>24</sup> showing sale of its products by the Opponent to its Singapore distributors and some sample invoices for goods sold by the Singapore distributor, Agru Tech, to various consumers in Singapore from 2014 to 2015<sup>25</sup>. Notably, while the invoices from the Opponent to the Singapore distributors

showed use of the **CHARLOTTE** PIPE AND FOUNDRY COMPANY Unregistered Mark on the face of the invoices, there was no indication of the CHARLOTTE PIPE or CHARLOTTE Unregistered Marks. As for the invoices from Agru Tech to its consumers, while there was no clear use of any of the Opponent’s Unregistered Marks on these invoices, the descriptions of the products (to which the marks were applied), i.e “PVC SCH 80...”, appeared to correspond with the description of products sold from the Opponent to Agru Tech and the description of the Opponent’s products on Agru Tech’s website<sup>26</sup>.

51 At this juncture, it is useful to return to Section 2(9) of the Act and what constitutes “relevant sector of the public in Singapore”. In the present case, the Opponent had identified the relevant sector of the public as the actual or potential traders, distributors and consumers in the plumbing and industrial systems industry in Singapore which have used and/or distributed the Opponent’s products. Read in the context of Section 2(9) and the nature of the Opponent’s products, this appears to be a logical and reasonable definition of the relevant sector of the public in Singapore. The Applicant did not dispute this definition but argued that the evidence was insufficient to establish that the Opponent’s Unregistered Marks were well known in Singapore at the relevant date.

52 Based on the examination of evidence tendered by the Opponent thus far, it would appear that the only evidence it has in support of its argument that its Unregistered Marks are well known are the sample invoices provided. As mentioned in *Caesarstone*, the relevant sector need not be large in size, so the Opponent only needs to show that it was well known to this specific sector. However, as discussed earlier, the threshold for a trade mark to be regarded as well known by the relevant sector, and thus in Singapore, is not necessarily a low or minimal one. As was recognised in the case of *U-Manga International Business Co., Ltd v nunufish.com* [2017] SGIPOS 11 (“*U-Manga*”),

<sup>22</sup> Brad Muller’s SD at Annex 7, pages 92-93.

<sup>23</sup> Brad Muller’s SD at Annex 6.

<sup>24</sup> Todd Digg’s SD in Reply at Exhibit TD-4.

<sup>25</sup> Brad Muller’s SD at Annex 6, pages 69-77.

<sup>26</sup> Brad Muller’s SD at Annex 11, pages 129-130.

there is a difference between the mark and products being “known” in Singapore and being “well known”. Showing that they were “known” did not necessarily mean that they were “well known” (at [59], *U-Manga*).

53 Bearing in mind that this seems to be the only evidence in favour of the Opponent on this issue, I did not find it to be sufficient to merely be able to show some sale in Singapore of the products to which the trade marks in question is applied to establish that the trade marks are therefore *well known* in Singapore. There was simply no other evidence tendered in favour of the Opponent that clearly established that the Opponent’s Unregistered Marks were well known to the relevant sector in Singapore as at 7 October 2015. Indeed, any evidence showed at most some use of the

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mark in Singapore at that time, but there was no other clear evidence relating to the other two of the Opponent’s Unregistered Marks. At the end, it seemed that the Opponent had such a firm belief that its long establishment since 1901 in the USA spoke for itself and that its reputation would surely lend itself the aura of being well known throughout the world, even in Singapore. That, however, still needed to be proved through evidence tendered and the burden lay on the Opponent to show that the marks it was seeking to rely on were well known in Singapore at the relevant date. I was not satisfied that this burden had been discharged in this case and I therefore conclude that the Opponent has not shown that any of its Unregistered Marks was an earlier well known mark.

54 In light of the above finding, as there was no earlier well known mark to be found on the evidence tendered, it was not necessary to consider the other elements in Sections 8(2)(b) and 8(4) (b)(i).

*Conclusion on Section 8(2)(b) and 8(4)(a)-(b)(i)*

55 The grounds of opposition under Section 8(2)(b) and 8(4)(a)-(b)(i) therefore fail.

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

56 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

### *Decision on Section 8(7)(a)*

57 Section 8(7)(a) provides for trade mark protection based on the tort of passing off. In the recent decision in *Tuitiongenius Pte Ltd v Toh Yew Keat & Anor* [2020] SGCA 103 (“*Tuitiongenius*”), at [80], the Court of Appeal reiterated the fundamental principle undergirding the law of passing off, i.e, “a trader should not sell his or her goods or services under the pretence that they are the goods or services of another.”



58 The applicable law on this area is well established and not disputed between the parties. To succeed in a claim in passing off, the three elements of goodwill, misrepresentation and damage will need to be shown. Each element will be examined in turn.

### *Goodwill*

59 In *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) the Court of Appeal acknowledged, at [32], that goodwill is “an amorphous idea that does not sit well with strict definitions”. It sought to clarify the position and explained that “the goodwill relevant to a passing off action is not goodwill in the mark, logo or get-up” and that instead, “the tort of passing off protects a trader’s *relationship* with his customers” (at [33]). It was further elaborated:

[34] In our judgment, goodwill, in the context of passing off, is concerned with goodwill in the business *as a whole*, as not specifically in its constituent elements, such as the mark, logo or get-up that it uses... Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys... Goodwill 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.

60 In the present case, a preliminary question arose as to the relevant date on which the goodwill of the Opponent is to be determined. The Applicant has relied on the holding in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“*CDL Hotels*”), where the Court of Appeal stated, at [34], that “the relevant date, as at which the reputation of the plaintiff in a passing off action should be considered is the date on which the conduct complained of commences.” Referring to earlier English and local decisions, the Court of Appeal affirmed this to be the position for cases where the defendant had already committed the acts complained of by the plaintiff.

61 The Opponent did not cite any contrary case authority on this point but essentially disagreed with the Applicant’s assertion on what should be the date on which the conduct complained of commenced. The Applicant argued that the date should be January 2011, which it asserts is when the Applicant first used the Application Mark in Singapore and would be when the alleged passing off started. On the other hand, the Opponent argued that it should be the date when the application for the Applicant’s International Registration was filed, i.e. 7 October 2015, or the date the Opposition was filed, i.e. 6 February 2018.

62 Applying the law as stated in *CDL Hotel*, it was quite clearly not the date in 2018. The significance of the applicable date lies in the parties’ respective assertions on when they each started selling their products in Singapore. The Applicant’s position is that it started selling its products bearing the Application Mark (“the Application Goods”) in Singapore since January 2011. The Application Goods were brought into Singapore through its import-exporting agents, Shanghai K-Zone Import & Export Co Ltd (“Shanghai K-Zone”) and Shanghai Taly Import & Export Co. Ltd (“Shanghai Taly”). In support of its assertion, the Applicant tendered copies of the agreements appointing Shanghai K-Zone and Shanghai Taly as the Applicant’s import-export agent, as well as

extensive samples of purchase orders, invoices, packing lists, bills of lading, airway bills, certificates of origin of China, custom clearance forms of the People’s Republic of China, a term sheet dated 14 June 2012 signed between Shanghai K-Zone and Hydrochem (S) Pte Ltd and photographs purportedly taken by a Hyflux employee of the shipment of the Applicant’s Goods received in Singapore<sup>27</sup>. Similar to the Opponent, the Applicant also asserted that it had engaged in extensive promotional and marketing efforts through its online website and participating in various international exhibitions and conferences where it showcased its Application Goods<sup>28</sup>. The Applicant further claimed that between 2011 to 2015, the annual sales revenue of the Application Goods in Singapore were as follows<sup>29</sup>:

<b>Year</b>	<b>Estimated Total Sales Revenue (USD)</b>
2011	102,637.98
2012	594,721.52
2013	266,883.96
2014	355,688.60
2015 (from Jan to Oct 2015)	500,394.27

63 Having gone through more than 550 pages of the evidence tendered on this issue, the Applicant’s evidence suffered from the basic defect that it was not clear that the Application Mark was being used on the goods that were being exported by Shanghai K-Zone and Shanghai Taly into Singapore. Although the Applicant exhibited photos which supposedly showed the Application Goods at two desalination plants situated at Tuas, Singapore and a storage facility<sup>30</sup>, these photos were undated and it was not clear that these were even taken at locations in Singapore. This was in fact the defect common to almost all the photographic evidence tendered as the time and place at which they were taken could not be affirmatively ascertained. For the few photos which had a date, for example in one of the photos of the international exhibitions or conferences which the Applicant participated in, it was clear though that the event was not held in Singapore. Likewise, the printouts of the Applicant’s online website were all dated 2019 and could not show how long this platform had been used as a means for promoting and marketing the Application Goods in Singapore. As for the extensive samples of purchase orders, invoices, packing lists, bills of lading, airway bills, certificates of origin of China, custom clearance forms, etc., many of these did not even relate to export of products to Singapore and showed the export of goods to other places such as Oman and Algeria, so it was not clear how such evidence would be relevant here.

64 What was the most telling was that in none of these purchase orders, invoices, packing lists, bills of lading, airway bills, certificates of origin of China, custom clearance forms, etc., was there a reference to the Application Mark. It was hard even finding a mention of the word “Charlotte”. The word “Charlotte”, but not the Application Mark, did appear in around three pages<sup>31</sup> of Chinese documents, out of the

<sup>27</sup> Wang Qiu Bin’s SD at [15]-[16] and Tabs C-D.

<sup>28</sup> Wang Qiu Bin’s SD at [17] and Tab E.

<sup>29</sup> Wang Qiu Bin’s SD at [18] and Tab D.

<sup>30</sup> Wang Qiu Bin’s SD at [14] and Tab B.

<sup>31</sup> Wang Qiu Bin’s SD at pages 226, 227, 644.

more than 500 pages of such documents. Two of these documents were not translated into English at all but appeared to be an agreement between two Chinese companies so the link to Singapore was unclear. As for the third document, the word “Charlotte” appeared in the Chinese document, which did not seem to have an English translation accompanying it but I noted that the word “Charlotte” could not be found in both the English language documents which immediately preceded and came after that Chinese document. These English language documents appeared to refer to the same invoice number and related to the same shipment of goods as those referred to in the Chinese document but had no mention of “Charlotte”. As the estimated figures by the Applicant for the annual sales revenue were drawn from the same source documents of the sample invoices, etc., these figures likewise suffered from the same deficiency.

65 Taking the evidence from the Applicant in totality, it was not possible to safely conclude that the Application Mark had been used in the products shipped by the Applicant to Singapore under the applicable invoices for the period of 2011 to 2015, thereby rendering such evidence of little probative value to this particular issue.

66 Consequently, it appeared that the date by which it could be said that the conduct complained of commenced would be the date of the filing of the international registration of the Application Mark designating Singapore, i.e. 7 October 2015.

67 Having ascertained the date at which goodwill should be determined, we now turn to the evidence put in by the Opponent to prove its goodwill. For this, the Opponent relied on the same evidence it had put in to show that its marks were well known.

68 For the period 2013 to 2015, it may be recalled that the Opponent provided sample invoices from the Opponent to its Singapore distributor, Agru Tech, which showed sale of its PVC products. There were also invoices from Agru Tech to consumers in Singapore for the period 2014 to 2015<sup>32</sup>. As mentioned (at [50] above), the invoices from Agru Tech to its consumers contained descriptions of products which appeared to correspond with the description of products sold from the Opponent to Agru Tech and the description of the Opponent’s products on Agru Tech’s website<sup>33</sup>. It was clear that there were sales conducted by the Opponent of its products during the period from 2013 to 2015.

69 In *Singsung*, it was held, at [67], that goodwill would clearly exist in Singapore if it is shown that a business offers a product or service for sale here and a customer purchases the product or consumes the service here. While the sales revenue may not have been very large, it was not insignificant and definitely not negligible. The same evidence, while insufficient to establish that the Opponent’s Unregistered Marks were well known in Singapore at that time, was more than adequate to demonstrate that the Opponent had goodwill to seek relief in Singapore for the tort of passing off.

70 For completeness, I would add that an issue had been raised by the Applicant in relation to the lack of any sales revenue in Singapore by the Opponent for the period 2007 to 2012. The Applicant had sought to argue that the long period of 7 years during which there were no sales figures provided showed that the Opponent had abandoned any goodwill it had acquired, if at all, for the earlier period from 2003 to 2006. The

<sup>32</sup> Brad Muller’s SD at [12] and Annex 6.

<sup>33</sup> Brad Muller’s SD at Annex 11, pages 129-130.

Opponent countered to say that it was only a temporary break due to the change in its Singapore distributor and that it had carried on sales through its online platforms during that period, although the fact was there was no evidence tendered by the Opponent to support this nor were there any sale figures provided at all on the alleged online sales. In any event, as goodwill could be established by the Opponent for the period 2013 to 2015, it became unnecessary to go into whether there was goodwill for the period prior to that and whether there had been an abandonment of goodwill by the Opponent.

### *Misrepresentation*

71 Moving on to the next element, guidance can again be found in the *Singsung* decision where the Court of Appeal had held, at [70], that it should be determined as a preliminary threshold issue whether the goodwill is distinctive of the Opponent's goods and/or services. If this is shown, then the questions to be considered are first, whether there was a misrepresentation made by the Applicant in using products which are strikingly similar or identical (this may amount to a misrepresentation as to trade source or the trade origin of the goods); followed by the second query, whether actual confusion or likelihood of confusion arose as a result of the misrepresentation.

72 This issue of distinctiveness is important because when a mark is not distinctive of the plaintiff's products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or are economically linked to the plaintiff. On this note, it is useful to refer to the approach set out in Court of Appeal decision in *The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] 2 SLR 495, which was also endorsed in *Singsung*<sup>34</sup>:

[20]...[The second inquiry (*i.e.*, of misrepresentation)] typically begins with a consideration of how the defendant is said to be doing this. In general, it will entail the use of some element that serves as a badge or identifier marking the goods or services in question as emanating from the claimant ... *It will be necessary here to consider whether that element does serve as a badge or identifier, or, in the parlance of the action, whether it is 'distinctive' of the claimant's goods and services, and whether the claimant's goodwill (established under the first stage of the inquiry) is in fact associated with that element.* It will then be necessary to consider, amongst other factors, whether there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant's goods or services are, or emanate from a source that is linked to the claimant's... (*emphasis added*)

73 With the above in mind and applying the law usefully summarised by the Court of Appeal in *Tuitiongenius*, at [88], which essentially reaffirms earlier case authorities, the threshold issue will be met if it is shown that the Opponent's goodwill is sufficiently associated with its Unregistered Marks and sufficient association will be established if

<sup>34</sup> *Singsung* at [57].

the Opponent can show that its Unregistered Marks are *distinctive* of its business, such that the public, being actual and potential consumers, will view the marks as an *indicator of origin*.

74 The Opponent had explained that the reason for using “Charlotte” in its marks was based on the origin of the Opponent company, which was started in 1901 in the city of Charlotte in North Carolina, USA, where the Opponent remains headquartered. It manufactures pipes and fittings, hence the use of the word “pipe” in some of its marks. The marks incorporating the reference to “Charlotte” and “pipe” therefore served as a badge of origin on the source of the Opponent’s products and the products covered by it. In the present case, it was quite clear that the goodwill was distinctive of the Opponent’s goods and the Opponent’s Unregistered Marks served as a badge of origin and identifier of the source of the Opponent’s products.

75 At this juncture, it would be useful to set out a comparison of the Opponent’s Unregistered Marks and the Application Mark.

APPLICATION MARK	OPPONENT’S UNREGISTERED MARKS
<b>CHARLOTTE</b>	CHARLOTTE PIPE
	CHARLOTTE
	<b>CHARLOTTE</b> PIPE AND FOUNDRY COMPANY

76 In *Singsung*, the Court of Appeal had also held, at [48] that, “deliberate copying and evidence of an intention to misrepresent or deceive consumers will together be strong *prima facie* evidence of both the distinctiveness of the indicia that has been copied and also the fact of misrepresentation and the likelihood of confusion” and, at [55], “the stronger the evidence of deliberate copying coupled with an intention to deceive, the greater will be the evidential basis for drawing the inference of distinctiveness and a likelihood of deception. There will correspondingly be a greater burden on the defendant to explain why such inferences should not be drawn.”

77 While there was no direct evidence tendered on whether the Applicant showed an intention to misrepresent or deceive consumers, it was the lack of explanation from the Applicant that was significant. No background or context was proffered by the Applicant to explain how the Application Mark was derived. This was specifically raised at the oral hearing and counsel for the Applicant was invited to explain how the Applicant came to use its mark. Counsel’s response was that this issue was not relevant and that in any event, there was no evidence and counsel could not submit on this from the Bar. So the question was quite deliberately side-stepped by the Applicant. There was no suggestion at all that the Applicant had somehow obtained inspiration or come up with the Application Mark independently. This was curious as the lack of explanation offered no insight as to why a China-based company would use an English word for its products and which word had no similarity with or bearing on the Applicant, or why the design of the Applicant’s mark came to be so similar to part of a trade mark used by the Opponent. The irresistible inference to be drawn was that the Applicant had deliberately copied from the Opponent’s Unregistered Mark

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and nothing was tendered by the Applicant to refute this inference. It will be recalled that the Applicant had specifically chosen not to address arguments regarding the Opponent's Unregistered Marks and thus, chose not to touch on any points regarding similarity of the Application Mark to any of the Unregistered Marks.

78 In October 2015, when the Applicant filed its International Registration for the Application Mark, designating Singapore, the Opponent had already been selling its products to Singapore for at least 2 years. Although the Applicant purported to show that it had already been selling products bearing the Application Mark in Singapore since 2011, the evidence tendered did not clearly establish this. There was also no evidence put forward by the Applicant as to how it had promoted or marketed its products bearing the Application Mark in Singapore, other than an undated catalogue and some printouts from the Applicant's website featuring its products and which printouts were dated in 2019. The lack of evidence showing any efforts to promote or market the defendant's goods was seen by the Court of Appeal in *Singsung* as an indicator of intention on the defendant's part to deceive the consumers into believing that its products were the same as those from the plaintiff.

79 In the circumstances and based on the evidence tendered, I was satisfied that the Applicant had deliberately copied parts of the Opponent's Unregistered Mark **CHARLOTTE** PIPE AND FOUNDRY COMPANY, notably the word "Charlotte" right down to the stylised "O" which was bolded in exactly the same manner. This was done with the intention to deceive customers or to pass off the Applicant's goods as being that of the Opponent's, or that the Applicant was somehow associated with the Opponent. Based on the product listings of the Applicant and the Opponent on their respective websites and just by perusing the sample invoices each have provided, both clearly supplied similar products of pipes and fittings and industrial piping systems. Both parties clearly sold these products to the same sector of the market and consumers which required such products. The likelihood of confusion has been established and the element of misrepresentation has been met.

#### *Damage*

80 On the final element, it is not necessary for the Opponent to show actual damage so long as a real tangible risk of substantial damage is present and this could also occur by way of blurring or tarnishment: see *Singsung* at [41].

81 On the present facts, it was indisputable that with the Applicant's deliberate misrepresentation, the Opponent's goodwill would be adversely affected through a diversion of custom given that the parties were competitors supplying the same line of products. This was sufficient to establish the element of damage.

#### *Conclusion on Section 8(7)(a)*

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

### **Overall Conclusion**

83 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds on the sole ground under Section 8(7)(a) and fails on the other two grounds under Section 8(2)(b) and 8(4)(a)-(b)(i). Accordingly, the application to register the Application Mark is refused. The Opponent, having succeeded on one out of three grounds of opposition, is entitled to one third of its costs, to be taxed, if not agreed.

Date of Issue: 30 December 2020