

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

Trade Mark Nos. 40201810931X-01 and 40201810931X-02  
13 November 2020

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

**MICHAT PTE LTD**

**AND**

**OPPOSITION THERETO BY**

**XIAOMI INC.**

Hearing Officer: Ms Sandy Widjaja  
Principal Assistant Registrar of Trade Marks

Representation:

Ms Amira Nabila Budiitano and Ms Tran Le Luu Phuong (Gateway Law Corporation) for  
the Opponent

Ms Teresa O'Connor and Ms Millicent Lui Qiao Xin (Infinitus Law Corporation) for the  
Applicant

**GROUND OF DECISION**

- 1 Shall we chat? Or talk?
- 2 In this dispute, MiChat Pte Ltd (the "*Applicant*") sought to register:

| S/N | <i>Application Mark</i>  | <b>Goods / Services</b>   |
|-----|--|---|
| 1   | <p><b>MiChat</b><br/>40201810931X-01<br/><i>“Application Mark-1”</i></p> | <p><b><u>Class 09</u></b><br/>Computer programs, recorded; computer peripheral devices; computer software, recorded; electronic publications, downloadable; computer programs [downloadable software]; computer game software; computer software applications, downloadable; computer screen saver software, recorded or downloadable; downloadable graphics for mobile phones; counters; intercommunication apparatus; Global Positioning System [GPS] apparatus; theft prevention installations, electric; Internet messaging software; Electronic message handling apparatus; Electronic panels for displaying messages; Carriers for message transmission.</p> <p><b><u>Class 42</u></b><br/>Technical research; computer programming; computer software design; installation of computer software; conversion of computer programs and data, other than physical conversion; providing search engines for the internet; software as a service [SaaS]; information technology [IT] consultancy; electronic data storage; cloud computing; creating and designing website-based indexes of information for others [information technology services]; data security consultancy; data encryption services; monitoring of computer systems for detecting unauthorized access or data breach; Design and development of software for instant messaging.</p> |
| 2   | <p><b>MiChat</b><br/>40201810931X-02<br/><i>“Application Mark-2”</i></p> | <p><b><u>Class 38</u></b><br/>News agency services; wireless broadcasting; message sending; communications by computer terminals; computer aided transmission of messages and images; information about telecommunication; electronic bulletin board services [telecommunications services]; providing user access to global computer networks; providing internet chatrooms; providing online forums; Electronic exchange of messages via chat lines, chatrooms and Internet forums; Electronic mail and messaging services; Video messaging services; transmission of digital files.</p> <p><b><u>Class 45</u></b></p>  |

|  |  |  |
|--|--|--|
|  |  | Physical security consultancy; escorting in society [chaperoning]; dating services; marriage agency services; on-line social networking services; lost property return; monitoring intellectual property rights for legal advisory purposes; licensing of computer software [legal services]; registration of domain names [legal services]; legal administration of licences; On-line social introduction services; Online social networking services accessible by means of downloadable mobile applications; Personal introduction agency services. |
|--|--|--|

(Collectively, the “*Application Mark*”.) The *Application Mark* was applied for on 6 June 2018 (“*Relevant Date*”).

3 The *Application Mark*<sup>1</sup> was accepted and published on 12 October 2018 for opposition purposes. Xiaomi Inc., (the “*Opponent*”) filed its Notice of Opposition to oppose the registration of the *Application Mark* on 12 November 2018. On 28 March 2019, the *Applicant* requested for a division of the *Application Mark* into the *Application Mark-1* and the *Application Mark-2*. Thereafter, the *Applicant* filed *two* sets of counter-statements in support of the registration of each of these marks on 3 April 2019. The matters were consolidated at the Case Management Conference on 9 July 2019. The *Opponent* thereafter filed its evidence on 20 December 2019 while the *Applicant* filed its evidence on 2 April 2020. The *Opponent* did not file any evidence in reply. The matter was then set down for a hearing on 13 November 2020.

### Grounds of Opposition

4 The *Opponent* relies on sections 8(2)(b), 8(4), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“*Act*”) in this opposition.

### Evidence and written submissions

5 The evidence comprises the statutory declarations of:

- (i) Mr Sun Bin, Chief Legal Officer of the *Opponent*, dated 9 December 2019 (“*Opponent’s SD*”); and
- (ii) Mr Wiyatno Gerald Mursjid, Regional Legal Counsel of the *Applicant*, dated 25 March 2020 (“*Applicant’s SD*”).

6 Parties submitted the following written submissions:

- (i) *Opponent’s* written submissions dated 13 October 2020 (“*OWS*”); and

<sup>1</sup> At the point of publication, the application was for a single mark. The division was made subsequent to the filing of the notice of opposition into *Application Mark-1* (Classes 9 and 42) and *Application Mark-2* (Classes 38 and 45).

(ii) *Applicant's* written submissions dated 22 October 2020<sup>2</sup> (“*AWS*”).

### Applicable Law and Burden of Proof

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


### Background

8 The *Opponent* deposed that it is part of the Xiaomi Corporation which was established in April 2010 and listed on the Main Board of the Hong Kong Stock Exchange since July 2018.<sup>3</sup> The *Opponent* and various other entities within the Xiaomi Corporation umbrella are globally recognised as an internet conglomerate with smartphones and smart hardware connected by an Internet of Things (IoT) platform at its core.<sup>4</sup>

9 The *Applicant* deposed that it was founded in Singapore in 2018.<sup>5</sup> The *Applicant's* business plan was to launch a new messaging application (“*App*”) for download onto mobile phones.<sup>6</sup> The *Applicant's* MiChat App has been available for download in Singapore and the region since April 2018<sup>7</sup> through the App Store by Apple or Google Play.<sup>8</sup> It can be used on Android as well as iOS phones.<sup>9</sup>

### Preliminary Issues

10 A preliminary issue arose as to the earlier marks which the *Opponent* seeks to rely on. In the Notice of Opposition,<sup>10 11</sup> only the following earlier marks are referred to:

| S/N | <i>Opponent's Earlier Marks</i>  | Goods / Services  |
|-----|--|---|
| 1   | <br>T1219547G | <b>Class 9:</b><br>Computer memories; computers; recorded computer programs; computer keyboards; recorded computer operating programs; computer peripheral devices; recorded computer software; monitors; data processing equipment, namely |

<sup>2</sup> The Applicant missed the original deadline of 13 October 2020 to file its written submissions and bundle of authorities (see Applicant's letter of 13 October 2020). The Registrar eventually allowed for the late filing of the same (see IPOS letter of 15 October 2020).

<sup>3</sup> *Opponent's SD* at [4].

<sup>4</sup> *Opponent's SD* at [5].

<sup>5</sup> *Applicant's SD* at [3].

<sup>6</sup> *Applicant's SD* at [3].


<sup>7</sup> *Applicant's SD* at [4].

<sup>8</sup> *Applicant's SD* at [4].

<sup>9</sup> *Applicant's SD* at [4].

<sup>10</sup> Notice of Opposition at [5].

<sup>11</sup> In the event of any consistencies as to what these marks are, the list at [5] of the Notice of Opposition *shall* be conclusive. For example, item 3 at Table A in [17] *OWS* which corresponds to the mark at page 160 of the *Opponent's* bundle of authorities is to be *excluded*.

|   |  |   |
|---|--|---|
|   |  | <p>mouse, readers, scanners; compact discs; printers for use with computers; central processing units; notebook computers; calculators; electronic publications (downloadable); downloadable software, namely computer programs; mouse pads; wrist rests for use with computers; computer game programs; downloadable mobile phone ringtones; downloadable music files; downloadable image files; universal serial bus hardware; portable computers.</p> <p><b>Class 35:</b><br/>Advertising; on-line advertising on a computer network; commercial administration of the licensing of the goods and services of others; sales promotion for others; marketing.</p> <p><b>Class 42:</b><br/>Technical research; industrial design; packaging design services; styling (industrial design); computer rental; computer programming; computer software design; updating of computer software; consultancy in the design and development of computer hardware; rental of computer software; recovery of computer data; maintenance of computer software; computer systems analysis; computer system design; duplication of computer programs; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; hosting computer sites (web sites); installation of computer software; data conversion of computer programs and data (not physical conversion); computer software consultancy; rental of web servers; computer virus protection services; providing search engines for the Internet; digitization of files by scanning; remote monitoring of computers.</p> |
| 2 | <br>T1310968Z <sup>12</sup> | <b>Classes 3, 5, 8, 9, 11, 12, 14, 16, 17, 18, 20, 21, 22, 24, 25, 26, 27, 28, 30, 34, 35, 36, 38, 41, 42, 43, 45<sup>13</sup></b>  |

(collectively, “*Opponent’s Earlier Marks*”).

<sup>12</sup> There are also other *identical* marks, namely, 40201504345V (registered in class 9), 40201511260W (registered in class 9) and 40201606144S (registered in class 12).

<sup>13</sup> For the full specifications, see Annex A of the Notice of Opposition.

11 However, the **Opponent** sought to rely on a whole host of earlier marks (including those above) in the **OWS**.<sup>14</sup> These are:

- (i) The **Opponent's** earlier<sup>15</sup> registrations which incorporate “Mi” whether as a prefix or suffix;<sup>16</sup>
- (ii) The **Opponent's** Singapore subsidiary's (Xiaomi Singapore Pte Ltd) earlier registrations with “Mi” as a prefix.<sup>17</sup>

12 At the hearing, the **Opponent** argued that judicial notice can be taken of the marks which *only* surfaced in the **OWS**. In this regard, the **Opponent** relied on **The Polo/Lauren Company, L.P. v United States Polo Association** [2015] SGIPOS 10 (“**Polo**”) at [75] – [77]:

[75] It should be noted that these Singapore registered trade marks were cited in the Applicants’ Written Submissions or during the hearing. They were not tendered via a statutory declaration.

[76] This issue of tendering of evidence otherwise than by way of a statutory declaration...I am comfortable to take judicial notice of the Singapore registrations which were not tendered via the Applicants’ SD. In this regard, I am guided by the principles provided by the leading authority on the law of evidence in Singapore, Professor Jeffrey Pinsler in his book *Evidence, Advocacy and the Litigation Process* (4<sup>th</sup> Edition) (Lexis Nexis: 2013) at [11.002]:

*A fact may be so well established that the court may assume its existence without proof. In such circumstances, proof is unnecessary because the fact has an objective existence which constitutes proof beyond and unaffected by, the specific circumstances of the case. ... [The court] may exercise its own initiative in taking judicial notice of a fact after making the necessary enquiry into the circumstances. For example, judicial notice has been taken of the state of the economy (and, more specifically, the existence of a recession and economic recovery)...*

[Emphasis by the **Opponent**]

[77] In this case, the facts relate to the existence of the Singapore registered trade marks cited by the Applicants. Do these facts have “an objective existence” which is “unaffected by the specific circumstances of the [present] case”? The answer must be a “yes”. The existence of these two trade marks can be objectively verified via a search of the register of trade marks of Singapore, and their existence is entirely independent of the specific circumstances of the present case...

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<sup>14</sup> See Tables A, B and C at [17]- [20] **OWS**.

<sup>15</sup> Those marks which have a later registration date than the **Relevant Date** will not be taken into consideration.

<sup>16</sup> [18] **OWS**.

<sup>17</sup> [19] **OWS**.

13 In response, the *Applicant* submitted that the above does not apply to the case at hand. In the *Polo* case, the IP Adjudicator was relying on the marks (which were not submitted via evidence) to provide *context* in relation to the issue of distinctiveness for the purposes of mark comparison for the objection under section 8(2)(b).<sup>18</sup> However, in this instance, the *Opponent* is seeking to rely on the marks as a *basis* for its *relative* ground of objection under section 8(2)(b). In such a case, the *Applicant* must be given notice of such a reliance so as to be able to respond to the objection.

14 The *Applicant* argued that this can be clearly seen from the requirements for the contents of the Notice of Opposition set out in Rule 30 of the Trade Marks Rules (2005 Ed):

*Contents of notice of opposition*

30.—(1) The notice of opposition shall contain a statement of the grounds upon which the opponent opposes the registration.

(2) If registration is opposed on the ground that the *mark is identical or similar to an earlier trade mark*, the following information *must* be included in the statement, for the purpose of determining whether the mark is identical or similar to the earlier trade mark:

- (a) a representation of the earlier trade mark; and
- (b) such of the following as may be applicable:

(i) *if the earlier trade mark is registered* —

- (A) its registration number; and
- (B) the class number and specification of the goods or services in respect of which the earlier trade mark is registered;

(ii) *if the application to register the earlier trade mark is pending* —

- (A) the number accorded by the Registrar to the application; and
- (B) the class number and specification of the goods or services in respect of which the earlier trade mark is sought to be registered; or

(iii) *if the earlier trade mark is not registered*, and no application has been made to register it, the specification of the goods or services in respect of which the earlier trade mark is used.

(3) If registration is opposed on the ground that the mark is identical or similar to an earlier trade mark which is well known in Singapore, the following additional information must be included in the statement for the purpose of determining whether the trade mark is well known in Singapore:

- (a) information on the use of the earlier trade mark; and

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<sup>18</sup> See [8] – [10] and [74] of *Polo*.

(b) information on any promotion undertaken for the earlier trade mark.

[Emphasis by the *Applicant*]

15 I agree with the *Applicant*. As submitted by the *Applicant*.<sup>19</sup>

[5]...it is a very basic principle for pleadings in a case that the case which is made against a party must be clear in its parameters...

[6] If the Opponent wishes to rely on additional marks the proper procedure would have been to apply to amend the Grounds of Opposition, but this has not done. Therefore...[t]he Opponent must be confined to the earlier marks which it had originally set out in paragraph 5 and Schedule A of its Grounds of Opposition...

16 Thus, moving forward, *only* those marks as listed at [5] of the *Notice of Opposition*, that is the *Opponent's Earlier Marks* (at [10] above) can be *relied on* as earlier marks for the purposes of its *relative* ground objections.<sup>20</sup>

17 Another related issue is that the *Opponent* submitted several documents, which included the *Opponent's* other earlier marks discussed above, as attachments to its bundle of authorities ("*Opponent's BoA*"). At the hearing, the *Opponent* submitted that judicial notice can be taken of these documents.

18 To the extent that these documents should have rightfully been submitted as evidence, they will also not be taken into account. The *Opponent* had the opportunity to provide evidence at two junctures in the Opposition process – when filing evidence in support of the Opposition and when filing evidence in reply. The *Opponent's SD* was filed in support of the Opposition, but did not contain these documents. The *Opponent* did not file any evidence in reply.

19 Applying the above, the *only* documents in the *Opponent's BoA*<sup>21</sup> which can be taken into consideration are:

| S/N | Item <sup>22</sup> | Description  | Comments           |
|-----|--------------------|--|--------------------|
| 1   | 2                  | <i>Opponent's Earlier Marks</i> (depicted at [10] above) – Tab B <sup>23</sup> | As concluded above |
| 2   | 5                  | Dictionary definition of "chat" – Tab E.                                       | Judicial Notice    |

Accordingly, I will disregard any documents which cannot be taken into consideration that are referred to in any of the *Opponent's* submissions.

<sup>19</sup> At [5] – [6] *AWS*.

<sup>20</sup> Accordingly, anything in the *OWS*, *Opponent's SD* and *Opponent's BoA* pertaining to these marks in relation to any section 8 *relative* objections must be *disregarded* as well.

<sup>21</sup> Aside from the authorities; these documents are labelled Tabs A- I.

<sup>22</sup> As per the *Opponent's BoA* under the title "Documents".

<sup>23</sup> See above footnote.



## MAIN DECISION

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

20 Section 8(2)(b) provides:

8(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.

### *Decision on Section 8(2)(b)*

#### *Step-by-step approach*

21 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal re-affirmed the 3-step test approach in relation to an objection under section 8(2)(b).<sup>24</sup>

- (i) Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements - namely similarity or identity of the marks and similarity or identity of the goods / services - are assessed individually before the final element which is assessed in the round.
- (ii) Once the two threshold requirements have been met, the issue of the likelihood of confusion arises and the tribunal / court is directed to look at (a) *how* similar the marks are, (b) *how* similar the goods / services are, and (c) given this, how likely the relevant segment of the public will be confused.

#### *Similarity of Marks*

22 The law in relation to this issue is as follows:<sup>25</sup>

- (i) The three aspects of similarity (i.e. visual, aural and conceptual similarities) are meant to guide the court’s inquiry. Trade-offs can occur among the three aspects of similarity.
- (ii) Technical distinctiveness (discussed further below) is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.

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<sup>24</sup> At [15] and [55] of *Staywell*.

<sup>25</sup> *Staywell* at [15] to [30].

- (iii) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.
- (iv) When speaking of the assessment of a mark as a whole, the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- (v) The similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise. The court must ultimately conclude whether the marks, when observed in their totality, are similar or dissimilar.
- (vi) The assessment of marks similarity is mark-for-mark without consideration of any external matter.



23 Further, the Court of Appeal provided in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("**Hai Tong**"):<sup>26</sup>

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


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

#### *Opponent's Earlier Marks*

24 As alluded to above, the earlier marks which can be taken into account are **only** those listed at [5] of the *Notice of Opposition*. For ease of reference only, the marks are:

| S/N | <i>Opponent's Earlier Marks</i>   | <i>Application Mark</i>  |
|-----|---|--|
|     | <i>Opponent's Earlier Mitalk Mark</i>   |  |
| 1   |  |  |
|     | T1219547G   |  |

<sup>26</sup> At [40(c)] and [40(d)] *Hai Tong*.

| S/N | <i>Opponent's Earlier Marks</i>   | <i>Application Mark</i> |  |
|-----|---|-------------------------|--|
|     | <i>Opponent's Earlier Mitalk Mark</i>   |                         |  |
| 2   | <i>Opponent's Earlier Mi Mark</i>   |                         |  |
|     |  |                         |  |

T1310968Z<sup>27</sup>*Opponent's Earlier Mi Mark*

25 I shall deal with *Opponent's Earlier Mi Mark* first, as the objections based on this mark can be dealt with briefly. In my view, it is evident that the *Opponent's Earlier Mi Mark* is more dissimilar than similar to the *Application Mark* in *totality*. It is so stylistic that it may *not* even be perceived as the (sole) word “Mi” by the average consumer.

26 As argued by the *Applicant*:

- (i) Visually, “[t]he stark and glaring absence of the “Chat” component...will clearly not be overlooked by the average consumer”.<sup>28</sup> In that regard, the *Application Mark* is “clearly much longer”<sup>29</sup> than the *Opponent's Earlier Mi Mark*. Last but not least, the marks are “undeniably visually different”<sup>30</sup> since *Opponent's Earlier Mi Mark* contains a “graphical design”.<sup>31</sup>
- (ii) Aurally, the marks are dissimilar as the *Application Mark* will be pronounced as ““mai-chat” or “mee-chat””<sup>32</sup> while the *Opponent's Earlier Mi Mark* will be pronounced ““mai” or “mee””.<sup>33</sup> In the event the *Opponent's Earlier Mi Mark* is construed as a graphical device, “there can be no aural similarity”<sup>34</sup> since “the graphical device cannot be enunciated or pronounced”.<sup>35</sup>
- (iii) Conceptually, even if the *Opponent's Earlier Mi Mark* is perceived as the word “Mi”, there would be no conceptual similarity as “the word “Mi” is meaningless”.<sup>36 37</sup>

<sup>27</sup> Other marks are identical to this mark (see above).

<sup>28</sup> [36] AWS.

<sup>29</sup> [37] AWS.

<sup>30</sup> [33] AWS.

<sup>31</sup> [33] AWS.

<sup>32</sup> [39] AWS.

<sup>33</sup> [45] AWS. For clarity, I do not agree with the *Applicant's* submission that the *Opponent's Earlier Mi Mark* may be construed as “N” (at [35] AWS) and thus the possibility of it being pronounced as “Nee” or “Nai”.

<sup>34</sup> [44] AWS.

<sup>35</sup> [44] AWS.

<sup>36</sup> [51] AWS.

<sup>37</sup> The *Applicant* also submitted that both marks are conceptually dissimilar because the *Opponent's Earlier Mi Mark* is a graphical design and has no meaning. However, the Court of Appeal in *Ceramiche Caesar*

27 I am broadly in agreement with the *Applicant*. In my view, the *Application Mark* is, in comparison to the *Opponent's Earlier Mi Mark*:

- (i) Visually *highly* dissimilar;
- (ii) Aurally similar to some extent;<sup>38</sup> and
- (iii) Conceptually similar to a low extent<sup>39</sup>

such that the marks are *more dissimilar than similar in totality*.

28 Having regard to the step-by-step approach, the opposition based on the *Opponent's Earlier Mi Mark* fails at the threshold. There is therefore *no* need to analyse this mark any further in relation to the objection under section 8(2)(b).

29 *Henceforth* only the *Opponent's Earlier Mitalk Mark* will be considered for the purposes of section 8(2)(b).

#### *Distinctiveness*

30 I am mindful of the Court of Appeal's guidance in *Staywell* that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry. However, for ease of analysis, I will summarise my findings on distinctiveness first, before applying them within the context of the mark-similarity analysis (this was also the approach taken by the Court of Appeal in *Hai Tong*).<sup>40</sup>

#### *Opponent's Earlier Mitalk Mark*

31 The crux of the issue is whether the *Opponent's Earlier Mitalk Mark* has any dominant and distinctive components and if so, what they are. This is because "the more distinctive the registered trade mark, the more it is necessary to show sufficient alterations to, or difference in, the sign in order that it may not be held to be similar to the trade mark".<sup>41</sup>

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*SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 ("*Caesarstone CA*") has indicated that the *design of a mark* is best taken into account at the *visual* rather than at the conceptual stage (see [50] and [54]).

<sup>38</sup> For clarity, I am of the view that the *Opponent's Earlier Mi Mark* is likely to be construed as a graphical device such that there is no aural similarity (since the graphical device cannot be enunciated). Nonetheless, I am prepared to accept that there is a possibility that the *Opponent's Earlier Mi Mark* will be pronounced "mai" or "mee".

<sup>39</sup> In this regard, I disagree with the *Applicant* to the extent that "Mi" is replicated in the *Application Mark* as well.

<sup>40</sup> See *Hai Tong* at [26].

<sup>41</sup> *OWS* at [29] quoting the Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [20].

32 In this regard, the *Opponent* submitted that “Mi” is the distinctive component (acquired<sup>42</sup> or otherwise)<sup>43</sup> of the *Opponent’s Earlier Mitalk Mark*.<sup>44</sup> This is because (i) all of the *Opponent’s* marks comprise the word “Mi”;<sup>45</sup> and (ii) it is a coined term and does not have any specific meaning in the English language.<sup>46</sup>

33 I agree that “Mi” is a coined term and does not have any specific meaning in the English language. I also accept that “Mi” may possibly be construed as an acronym<sup>47</sup> although I do not think it is as common as what the *Applicant* makes it out to be.<sup>48</sup>

34 I also do not think there is a need to look into the number of “Chinese characters which are pronounced as “Mi” and/or written in Hanyu Pinyin as “Mi”.”<sup>49</sup> This is because there is no indication in the Form TM4<sup>50</sup> that the “Mi” component is a transliteration of a Chinese character.

35 In light of the above, I agree with the *Opponent* that “Mi” in all likelihood is the *more distinctive component* of the *Opponent’s Earlier Mitalk Mark* (compared to the “talk” component of the mark), although the design of the mark as a whole is such that this is not very obvious (more below).

36 Having regard to all of the above, I agree that “Mi” is distinctive to *some* extent. Nonetheless, there is also a need to look into the *Opponent’s* assertion that “Mi” has *acquired* distinctiveness as *all* of the *Opponent’s* marks comprise of the word “Mi”.

37 Here we are faced with an unsettled area of the law. The issue is whether evidence from the surrounding circumstances can be taken into account in determining the issue of distinctiveness. At the hearing, the *Opponent* submitted that it cannot be taken into account while the *Applicant* submitted otherwise.<sup>51</sup> My view is that such circumstances can be taken into account at this stage as they provide a context which indirectly affects a consumer’s perception and understanding of the marks in comparison here.<sup>52</sup>

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<sup>42</sup> [31] *OWS*; more below.

<sup>43</sup> [31] *OWS*.

<sup>44</sup> [31] *OWS*.

<sup>45</sup> [30] *OWS*.

<sup>46</sup> [30] *OWS*.

<sup>47</sup> Although I am of the view that it is more likely to be an acronym when it is in capital letters only, for example, MI.

<sup>48</sup> [17(a)] *AWS*.





<sup>49</sup> [17(b)] *AWS*.

<sup>50</sup> Filed on 6 June 2018. TM4 is the form used to apply to register a trade mark under the Act.




<sup>51</sup> The *Applicant’s* case is that, if it is taken into account, it will show that the “Mi” component is common in the field. The *Opponent’s* position is a little dicey as on the one hand, it is trying to include evidence of use to show that “Mi” is distinctive; while on the other hand, it is not in the *Opponent’s* interest if the evidence shows that the “Mi” component is common.

<sup>52</sup> In this regard, I find support in the IP Adjudicator’s comments in *Monster Energy Company v NBA Properties, Inc* [2018] SGIPOS 16 (“*Monster Energy*”) at [41] and [46], albeit *obiter*. I am aware that a different IP Adjudicator in *Valentino S.P.A v Matsuda & Co* [2020] SGIPOS 8 (“*Matsuda*”) does not agree with this approach. Nonetheless, with the greatest respect to the IP Adjudicator in *Matsuda*, I am of the opinion that “a *common-sense* overall comparison of mark-for-mark” *necessarily encompasses* the context within which the marks reside for reasons described in *Monster Energy* at [46].

38 The *Applicant* provided evidence of various “Mi” / “Mi” prefixed marks in the Register at [16] and Exhibit 8 of the *Applicant’s SD*. In this regard, only marks which were registered before the *Relevant Date* are included below. Some examples are as follows:

| S/N | Mark <sup>53</sup>  | Relevant Class | Owner                                       |
|-----|---|----------------|---|
| 1   | <br>T1016521Z    | 42             | ETABLISSEMENTS SOGAL<br>DIRECTIONS SUPPORTS |
|     |   |                |   |
| 2   | <br>40201507536R | 9              | MICROMAX INFORMATICS<br>LIMITED             |
|     |   |                |   |
| 4   | <br>T9402590B    | 9              | NXP B.V.                                    |
|     |   |                |   |
| 5   | <br>T1002831Z  | 9, 38, 42      | Novatel Wireless, Inc.                      |
|     |   |                |   |

39 In addition, the *Applicant* also tendered evidence of the *Opponent’s* multitude of “Mi” / “Mi” prefixed marks in Singapore as well:<sup>54</sup>

| S/N | Mark <sup>55</sup>  | Class     | Owner                            |
|-----|---|-----------|----------------------------------|
| 1   | <br>40201802865W | 9, 38, 42 | XIAOMI<br>SINGAPORE PTE.<br>LTD. |
|     |   |           |                                  |
| 2   | <br>T1413302I    | 9, 38     | XIAOMI INC.                      |
|     |   |           |                                  |
| 3   | <br>T1300049A    | 9, 42     |                                  |
|     |   |           |                                  |

<sup>53</sup> Only those registered before the *Relevant Date* will be considered.

<sup>54</sup> [18] and exhibit 10 of the *Applicant’s SD*.

<sup>55</sup> Only those which are registered before the *Relevant Date* can be taken into account.

|   |               |           |                                  |
|---|---------------|-----------|----------------------------------|
| 4 | <b>MIHOME</b> | 9, 38, 42 | XIAOMI<br>SINGAPORE PTE.<br>LTD. |
|   | 40201608005S  |           |                                  |
| 5 | <b>MI TV</b>  | 9, 38     |                                  |
|   | T1405410B     |           |                                  |

40 I note that there is an argument that the marks on the Register cannot be taken as indicative of market conditions as the trade mark registration system under the *Act* is on the basis of use / intention to use<sup>56</sup> such that there may well be marks on the Register which are not yet in use.

41 I do not dispute the above. Nonetheless, I do not think it is right to wholly disregard the above evidence either. In this regard, I note that the IP Adjudicator took judicial notice of the marks on the Register to determine the issue of distinctiveness in the *Polo* case at [74] – [80]. I am of the view that a better approach is for the weight to be accorded to the above evidence to be adjusted to reflect this concern.

42 It is opportune at this point to deal with the evidence sought to be submitted by the *Opponent* as to its “consistent and regular use of [the] “Mi” term in all of its branding and marketing, as well as in the course of business for all of its products and services”.<sup>57</sup>

43 In this regard, the *Opponent* tendered the following:

- (i) Extracts of its Facebook and Instagram pages;<sup>58</sup>
- (ii) Extract of the *Opponent* and its group company’s 2018 Annual Report (*2018 AR*);<sup>59</sup>
- (iii) The *Opponent’s* market share in Singapore in relation to Mobile, Tablet and Console.<sup>60</sup>

44 My comments in relation to the above items are as follows:

<sup>56</sup> Section 5 of the Act.

<sup>57</sup> Since the *Opponent’s* submission above is that the “Mi” component has become distinctive, “acquired” or otherwise ([31] *OWS*).

<sup>58</sup> [15] and Exhibit 4 of the *Opponent’s SD*.

<sup>59</sup> [17] and Exhibit 5 of the *Opponent’s SD*.

<sup>60</sup> [19] and Exhibit 6 of the *Opponent’s SD*.

- (i) The extracts of the Facebook and Instagram pages are undated.<sup>61</sup> In addition, the **Opponent's Earlier Mitalk Mark** is *nowhere* to be seen.<sup>62</sup>
- (ii) In relation to the **Opponent's 2018 AR**, the **Opponent** pointed to page 236 of the same and deposed:

[18] As of financial years ending 2018 and 2017, the **Opponent** and its Group Company's subsidiary in Singapore has a respectable paid-in capital of SG\$ 1 and US\$ 149,000,000"...

Unfortunately, the above says nothing about the extent of use of the **Opponent's Earlier Mitalk Mark** in the local market.

- (iii) Last but not least, the statistics pertaining to market share in Singapore cannot be taken into account as it is for a period after the **Relevant Date**.<sup>63</sup>

45 Returning to the issue of the distinctiveness of the "Mi" component, having regard to **all** of the above, that is:

- (i) the fact that "Mi" is a coined term in the English language; and
- (ii) the multitude of "Mi"/ "Mi" prefixed marks in the relevant class,<sup>64</sup> on the Register;

the "Mi" component appears to be *not uncommon* (although I would stop short of saying that it is "common"). If so, there is no reason that it should be granted any additional protection that is usually reserved for marks which are technically distinctive. I would not, however, say that the "Mi" component is *so common* that the **Applicant** is entitled to cross a *lower* threshold of alteration to show that it is dissimilar to the **Opponent's Earlier Mitalk Mark**.

46 In short, the "Mi" component has a level of technical distinctiveness which is **not high** such that *some* differences in the **Application Mark** may be sufficient to render the marks dissimilar.<sup>65</sup> <sup>66</sup> For the avoidance of doubt, the "Mi" component is **still relatively** more distinctive than "talk" (or "chat") since "talk" (or "chat") is a common English word,

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<sup>61</sup> To be precise, most of the webpages in Exhibit 4 of the **Opponent's SD** were created on 13 May 2013 (see for example, page 300). The date the webpages were printed was 12 June 2019 (see again at page 300). However, this does not assist the assessment of the situation **as at the Relevant Date**.

<sup>62</sup> On the other hand, the **Opponent's Earlier Mi Mark** is represented *differently* as

<sup>63</sup> Exhibit 6 at page 641 of the **Opponent's SD**.

<sup>64</sup> The focus is on Class 9 as mobile applications are in this class.

<sup>65</sup> [20] **AWS**, although the conclusion here is somewhat different.

<sup>66</sup> The **Applicant** also sought to tender evidence as to the well-known "Mi" marks; however it is unclear if these are well-known marks in Singapore (see [17] of the **Applicant's SD**).





which additionally is descriptive of some of the goods and services of interest in the present case.

47 I note that the *Applicant* argued that (i) the *Application Mark* cannot be dissected into two words and must be viewed as whole;<sup>67</sup> (ii) there is no dominant component (and in that regard, “Mi” is of a low distinctive value and is not the dominant component of the *Application Mark*).<sup>68</sup>

48 In relation to the *Applicant’s* submissions with respect to the issue of distinctiveness of the *Application Mark*, I am of the view that the *Applicant’s* reliance on the following cases is misplaced for the marks in those cases are quite different to the present case.

49 In *Apple Inc. v Xiaomi Singapore Pte Ltd* [2017] SGIPOS 10 (“*Apple Inc*”), the Principal Assistant Registrar (“*PAR*”) was referring to the specific facts of that case:

[50(iii)]...In assessing marks for similarity it must be borne in mind that the average consumer perceives marks as wholes and does not ordinarily analyse or dissect their various details. *The average consumer will not take a portion of a word in a mark (in this case the “I” in the word “MI”), join it to another word in the mark (in this case “PAD”) and conclude that it resembles another mark [IPAD]...*

[Emphasis in bold and italics mine]


The marks in contention were *MI PAD* versus the earlier *IPAD* marks.

50 Similarly, in *Appitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15 (“*MGG*”), the specific issue was the colour of the letters which constitute the mark



. It was in this context that the *PAR* held that he “cannot simply dissect snaapp...into two arbitrary parts (“sna” and “app”) and then proceed to discard the latter... [t]he marks have to be assessed as wholes” and that “[t]he fact that the first three letters in the dominant portion of the Application Mark (i.e. “sna”) are *in different shades of blue*, whereas the last three letters (i.e. “app”) are *in maroon*”, does not change his analysis.

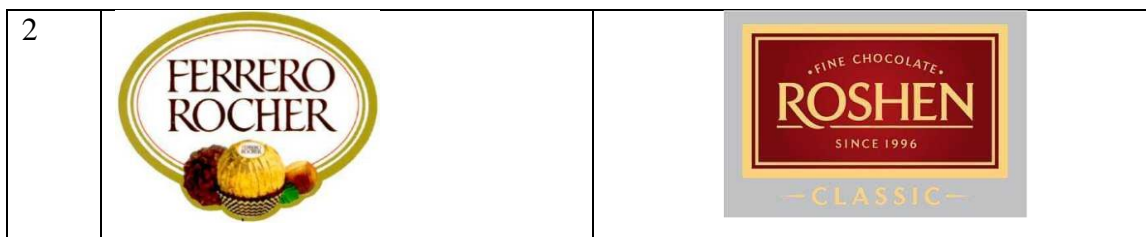
51 In *Ferrero SpA v Dochirnie Pidpriemstvo "Kondyterska Korporatsiia "Roshen"* [2015] SGIPOS 14 (“*Roshen*”), the marks in contention were, amongst others:

| S/N | Opponent’s earlier marks     | Applicant’s Marks  |
|-----|------------------------------|--|
| 1   | FERRERO ROCHER <sup>69</sup> |  |

<sup>67</sup> [11] – [16] *AWS*.



<sup>68</sup> [17] – [19] *AWS*.

<sup>69</sup> This was defined as the *Opponent’s Word Mark* at [33] *Roshen* [2015] SGIPOS 14, see below.



Looking at the marks, it is not at all surprising that the Assistant Registrar held that “there is no dominant component in the Opponents' Word Mark”.<sup>70 71</sup>

52 For ease of reference only, the marks to be compared in the present case are as follows:

| S/N | <i>Opponent's Earlier Mitalk Mark</i>   | <i>Application Mark</i>  |
|-----|---|--|
| 1   |  |  |

#### *Visual Similarity*

53 I have earlier concluded that the “Mi” component is of a level of technical distinctiveness which is not high and therefore does not enjoy any greater protection in the sense that *some* differences in the *Application Mark* may be sufficient to render the marks dissimilar, although the “Mi” component is *still relatively* more distinctive than “talk” since “talk” is a common English word.

54 As submitted by the *Opponent*:<sup>72</sup>

[38]...where there is a common component. This approach was set out and applied in *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] SGHC 175 (“*Polo/Lauren HC*”) at [26]–[29] (and which was upheld by the Court of Appeal on appeal in *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690...(“*Polo/Lauren CA*”) as follows:-

“... *In cases where there is a **common denominator**, it is important to look at the **differences** between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially*

...

[Emphasis in bold mine]

<sup>70</sup> [41] at *Roshen*; also at [19] *AWS*.

<sup>71</sup> See above definition.

<sup>72</sup> [38] *OWS*.

55 Further, following *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] SGHC 16 at [49], there is a need to look into:

- (a) the length of the marks;
- (b) the structure of the marks (whether there are the same number of words);  
and
- (c) whether the same letters are used in the marks.

56 Applying the above, the marks are of similar length. Each mark is six letters.

57 In terms of the structure of the marks, I am of the view that the presence of the capital letters for “m” and “c” is such that the *Application Mark* would be viewed as *two words* although the *Applicant* argued otherwise.<sup>73</sup> In this regard, as alluded to above, I am of the view that the *Applicant’s* reliance on *Apple Inc* and *MGG* (above) is misplaced as the marks in those cases are different to those here.

58 Further, the font of the marks also affects the *overall optical impact* of the respective marks on the naked eye. The net result is that the component “Mi” is more *accentuated* for the *Application Mark*<sup>74</sup> in comparison to the *Opponent’s Earlier Mitalk Mark* and *stands out* as the distinctive element of the *Application Mark*. This is especially so having regard to the fact that “Mi” is an invented word in comparison to “Chat” which is a common English word (above).

59 On the other hand, structure wise, the *Opponent’s Earlier Mitalk Mark* is represented as one word. While the “mi” component is not as obvious, it is still readily apparent that the mark is made up of “mi” and “talk”. As alluded to above, the “Mi” component is of a *lower* level of technical distinctiveness and therefore does not enjoy any greater protection although it is *still relatively* more distinctive than “talk” since “talk” is a common English word.

60 Last but not least, it is obvious that the first two letters of the marks are *identical*.

61 Taking into account all of the above, I am of the view that overall, the marks are visually more similar than dissimilar to a low extent.<sup>75</sup>

#### *Aural Similarity*

62 With regard to aural similarity, the Court of Appeal in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the marks (“Dominant Component Approach”) and the other is to undertake a

<sup>73</sup> [15] *AWS*; in this regard, I am of the view that the fact that there is no space between “Mi” and “Chat” is not conclusive.

<sup>74</sup> Even though there is no space between “Mi” and “Chat” ([15] *AWS*), above.

<sup>75</sup> For the avoidance of doubt, I am of the view that the *Applicant’s* reliance on *Monster Energy Company vs Mixi, Inc.* [2017] SGIPOS 12 (“*Mixi*”) at [30] *AWS* is misplaced as the marks there were “Monster Energy” versus “Monster Strike”; each mark consists of two common English words.

quantitative assessment as to whether the competing marks have more syllables in common than not (“Quantitative Assessment Approach”).

63 Applying the Dominant Component Approach, while the level of distinctiveness of the “Mi” component is not high, it is still relatively more distinctive than “talk” and “chat” (above) such that the marks are similar to a low extent. In the same vein, applying the Quantitative Assessment Approach, since the first syllable for both marks, “Mi”, is *identical*, the marks are aurally similar to a low extent.<sup>76</sup>

64 The *Applicant* deposed that “[the *Application Mark*] was originally derived from the words “My Chat”...[such that the *Application Mark*] is meant to be pronounced as “mai-chat”.<sup>77</sup> I do not dispute that. Nonetheless, it is equally possible that the *Application Mark* would be pronounced as “Mee-Chat”.<sup>78</sup> In any event, the *Applicant’s* intention as to how the *Application Mark* is to be pronounced cannot be conclusive.<sup>79</sup> Crucially, the *Opponent’s Earlier Mitalk Mark* can similarly be pronounced as “mai-talk” as well. A consumer who pronounces the *Application Mark* as “mai-chat” is likely to pronounce the *Opponent’s Earlier Mitalk Mark* as “mai-talk”.

65 In light of the above, whether the marks are pronounced as “Mai-talk” versus “Mai-Chat” or “Mi-talk” versus “Mi-Chat”, both marks are aurally similar to a low extent.

#### *Conceptual Similarity*

66 The Court of Appeal in *Staywell* expounded at [35] as follows:

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

[Emphasis in italics mine]

67 The *Applicant* submitted that:<sup>80</sup>

[50]...Although the elements “chat” and “talk” are seemingly related in that they both relate to a form of *communication*, there are definite differences in their nuanced meanings...the word “chat” brings to mind short, *casual* bits of conversation regarding topics of relatively non-serious concerns...“Talk” is also more *formal and serious* and carries with it less frivolity than a “chat”.

<sup>76</sup> As alluded above, the case of *Mixi* can be distinguished since in that case the marks consist of two common words respectively, namely, “Monster Energy” versus “Monster Strike” ([41] *AWS*).

<sup>77</sup> [3] of the *Applicant’s SD*.

<sup>78</sup> I note the *Applicant* recognised this at [39] *AWS*.

<sup>79</sup> This is similar to the understanding for conceptual similarity.

<sup>80</sup> [50] *AWS*.

[Emphasis in bold and italics mine].

68 I am unable to agree. Essentially, each mark encompasses the coined word “Mi” and the words “talk” versus “chat” which points to the idea of communication, regardless of whether the communication is formal or informal. Due to the *identity* in the “Mi” component and the *substantial overlap* between the meanings of “talk” and “chat”, there is considerable conceptual similarity. In this regard, I disagree with the *Applicant* that this is too simplistic a conclusion.<sup>81</sup>

69 I am of the view that the *Applicant’s* reliance on *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika CA*”)<sup>82</sup> is misplaced. The marks there, being NUTELLO versus NUTELLA, are different from the current case. It is no surprise then that there was no discussion of “[dissection of] the respective marks to impose a concept of “nuts” or being “related to nuts””.<sup>83 84</sup>

*Conclusion on the similarity of marks*

70 It is to be recalled that:

- (i) The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. In this regard, trade-offs can occur among the three aspects of similarity.
- (ii) The average consumer:
  - (a) has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the dominant features of the marks.
  - (b) is one 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.

71 In light of all the above, the *Application Mark* is, in comparison to the *Opponent’s Earlier Mitalk Mark*:

- (i) Visually more similar than dissimilar to a low extent;
- (ii) Aurally more similar than dissimilar to a low extent; and
- (iii) Conceptually considerably more similar than dissimilar;

such that it is *overall more similar than dissimilar* in comparison to the *Opponent’s Earlier Mitalk Mark*.

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<sup>81</sup> [50] *AWS*.

<sup>82</sup> [49] *AWS*.

<sup>83</sup> [49] *AWS*.

<sup>84</sup> Further, it is noted that *Caesarstone CA*, which was decided after *Sarika CA*, provided that “[t]o the extent that both marks do not offer a clear concept, it cannot be said that the marks are conceptually *dissimilar*; the most that can be said is that this is a neutral consideration”.

*Similarity of Goods / Services*

72 For ease of reference, the relevant goods and services are as follows:

| <i><b>Opponent's Earlier Mitalk Mark</b></i>   | <i><b>Application Mark</b></i>   |
|--|--|
| <p><u><b>Class 9</b></u><br/>           Computer memories; computers; recorded computer programs; computer keyboards; recorded computer operating programs; computer peripheral devices; <u><b>recorded computer software</b></u>; monitors; data processing equipment, namely mouse, readers, scanners; compact discs; printers for use with computers; central processing units; notebook computers; calculators; electronic publications (downloadable); <u><b>downloadable software, namely computer programs</b></u>; mouse pads; wrist rests for use with computers; computer game programs; downloadable mobile phone ringtones; downloadable music files; downloadable image files; universal serial bus hardware; portable computers.</p> | <p><u><b>Class 9</b></u><br/>           Computer programs, recorded; computer peripheral devices; computer software, recorded; electronic publications, downloadable; computer programs [downloadable software]; computer game software; <u><b>computer software applications, downloadable</b></u>; computer screen saver software, recorded or downloadable; downloadable graphics for mobile phones; counters; intercommunication apparatus; Global Positioning System [GPS] apparatus; theft prevention installations, electric; Internet messaging software; Electronic message handling apparatus; Electronic panels for displaying messages; Carriers for message transmission.</p> |
| <p><u><b>Class 35</b></u><br/>           Advertising; on-line advertising on a computer network; commercial administration of the licensing of the goods and services of others; sales promotion for others; marketing.</p>  |  |
|  | <p><u><b>Class 38</b></u><br/>           News agency services; wireless broadcasting; <i>message sending</i>; <i>communications by computer terminals</i>; <i>computer aided transmission of messages and images</i>; information about telecommunication; electronic bulletin board services [telecommunications services]; providing user access to global computer networks; providing internet chatrooms; providing online forums; Electronic exchange of messages via chat lines, chatrooms and Internet forums; Electronic mail and messaging services;</p>  |

|  |   |
|--|---|
|  | Video messaging services; transmission of digital files.  |
| <p><b><u>Class 42</u></b><br/> Technical research; industrial design; packaging design services; styling (industrial design); computer rental; computer programming; computer software design; updating of computer software; consultancy in the design and development of computer hardware; rental of computer software; recovery of computer data; maintenance of computer software; computer systems analysis; computer system design; duplication of computer programs; conversion of data or documents from physical to electronic media; creating and maintaining web sites for others; hosting computer sites (web sites); installation of computer software; data conversion of computer programs and data (not physical conversion); computer software consultancy; rental of web servers; computer virus protection services; providing search engines for the Internet; digitization of files by scanning; remote monitoring of computers.</p> | <p><b><u>Class 42</u></b><br/> Technical research; computer programming; computer software design; installation of computer software; conversion of computer programs and data, other than physical conversion; providing search engines for the internet; software as a service [SaaS]; information technology [IT] consultancy; electronic data storage; cloud computing; creating and designing website-based indexes of information for others [information technology services]; data security consultancy; data encryption services; monitoring of computer systems for detecting unauthorized access or data breach; Design and development of software for instant messaging.</p> |
|  | <p><b><u>Class 45</u></b><br/> Physical security consultancy; <i>escorting in society [chaperoning]</i>; <i>dating services</i>; marriage agency services; on-line social networking services; lost property return; monitoring intellectual property rights for legal advisory purposes; licensing of computer software [legal services]; registration of domain names [legal services]; legal administration of licences; On-line social introduction services; Online social networking services accessible by means of downloadable mobile applications; Personal introduction agency services.</p>   |

73 It is clear that this element is *not* satisfied for *Application Mark-2* (Classes 38 and 45), and the *Opponent* did not seriously try to persuade me otherwise.<sup>85</sup> While the services in Classes 38 and 45 are related to the goods in Class 9, they are clearly not substitutes.

74 For example, the services in Class 38, such as “message sending; communications by computer terminals; computer aided transmission of messages and images” *enable* access to the item “*downloadable software, namely computer programs*” as registered in Class 9 for *Opponent’s Earlier Mitalk Mark*, while the services in Class 45 such as “escorting in society [chaperoning]; dating services” *describe the content* in relation to the same.

75 Thus, there is *no* need to proceed further in relation to *Application Mark-2* for the ground of objection under section 8(2)(b).

76 On the other hand, it is obvious that this element has been satisfied for the purposes of *Application Mark-1* (Classes 9 and 42) since this element is satisfied as long as there is *some* overlap in the respective goods/services. Some examples of the identical / similar items are highlighted at [72] above in bold and underlined. For instance, *computer software applications, downloadable* sought to be registered for the *Application Mark* is identical or similar to “recorded computer software” and “downloadable software, namely computer programs” registered for the *Opponent’s Earlier Mitalk Mark*.

#### *Likelihood of Confusion*

77 The relevant principles for assessing likelihood of confusion have been expounded by the Court of Appeal in *Staywell*:

- (i) In opposition proceedings, the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the *actual and notional fair uses* to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the *full range of such rights* sought by the applicant *by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses* to which the applicant may put his mark should registration be granted (*Staywell* at [60]).
- (ii) Once similarity between the competing marks and goods or services has been established, the *impact* of these similarities on the relevant consumers’ ability to understand where those goods and services originate from falls to be considered. The only relevant confusion is that which results from the similarity between marks and goods or services. However, the plain words of section 8(2) do *not* have the effect of making a finding of confusion automatic

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<sup>85</sup> See [60] and Annex B *OWS*. The submissions in relation to Classes 38 and 45 relate to *Opponent’s Earlier Mitalk Mark* (see page 123 *OWS*).



upon the establishment of similarity of marks and goods or services (*Staywell* at [64]).

- (iii) On the effect of the foregoing (i.e. similarity of marks and goods or services) on the relevant segment of the public – *extraneous* factors may be considered to the extent that they inform the court as to how the *similarity of marks and goods* will likely *affect* the consumer’s perception as to the source of the goods (*Staywell* at [83]).
- (iv) The following represents a non-exhaustive list of factors which are regarded as admissible in the confusion inquiry (*Staywell* at [96]):
  - (a) Factors relating to the impact of *marks-similarity* on consumer perception:
    - (1) the *degree of similarity* of the marks themselves;
    - (2) the *reputation* of the marks (a strong reputation does *not* necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect);
    - (3) the *impression* given by the marks; and
    - (4) the *possibility of imperfect recollection* of the marks.
  - (b) Factors relating to the impact of *goods-similarity* on consumer perception (factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods).
    - (1) The *normal way in, or the circumstances under, which consumers would purchase goods of that type*;
    - (2) Whether the products are *expensive or inexpensive items*;
    - (3) Whether they would tend to *command a greater or lesser degree of fastidiousness and attention* on the part of prospective purchasers; and
    - (4) The *likely characteristics of the relevant consumers* and whether the relevant consumers would or would not tend to apply care or have *specialist knowledge* in making the purchase.

[Emphasis in italics mine]

#### *Factors relating to the impact of marks-similarity*

78 I have concluded above that *Application Mark-1* is overall more similar than dissimilar in comparison to the *Opponent’s Earlier Mitalk Mark*. Typically, the *visual aspect* is an important facet for the purposes of “purchasing” these products, which in essence, are computer related products (that is, online purchases). Nonetheless, I am also of the view that the *conceptual aspect (meaning / ideas behind the marks)* also has an impact on the perception of the marks.

79 I clarify that the importance of the visual aspect pertaining to online purchases varies depending on the type of marks involved. In cases of composite marks where there is a mix of words and devices, the visual aspect plays a highly important role. However, in cases where the marks are *short word marks* like this one, with the same number of letters (six respectively), *two of which are identical*, I am of the view that the visual aspect of the marks is not as decisive. Specifically, in this case, the conceptual component *colours* the *overall perception* of the marks such that consumers are likely to find that the marks are *more similar than dissimilar*.

80 In relation to the reputation of the *Opponent's Earlier Mitalk Mark*, I have already indicated above that most of the evidence cannot be taken into account such that it is not possible for me to conclude if there is any reputation to speak of. Ultimately, it is a business decision whether or not to record the sales revenue for a particular jurisdiction.

81 On the other hand, the *Applicant* deposed as follows with regard to its reputation:

[7]...In Singapore, in the Google Play store, it is the 5<sup>th</sup> most downloaded communication application and in the iOS app store, it is the 25<sup>th</sup> most popular social networking application in Singapore. By virtue of being a top application in the Google Play Store, "MiChat" is accorded a "trending" status and would be recommended on the front page of the Google Play Store. This means that "MiChat" will be listed near the top of the mobile phone screen. Without having to scroll downwards, users will see the application immediately, understand that it is popular in their country and will be more likely to download it...

[8] The Applicant relies on two major digital paid advertising platforms, Google and Facebook, as the main source of in-application advertising...This means that the MiChat app would be made visible to a large and interested audience in Singapore. MiChat enjoys a high engagement rate with the consumers who see the advertisement, many of whom proceeded to download the app after seeing the advertisements.

[9] Apart from collaborations with Google and Facebook, MiChat has also partnered with the immensely popular mobile game application, Mobile Legends: Bang bang ("Mobile Legends")...The popularity of Mobile Legends can be gauged by the fact that an Instagram account dedicated to this game @mobilelegendsgame has 6.5 million followers...

[10] The Applicant is also one of the sponsors of e-sports tournaments hosted by Mobile Legends. Given that each Mobile Legends e-tournament has an average viewership of 1.5 million, a MiChat advertisement in-game would be broadcasted to a very large audience...

82 Unfortunately, most of the above are bare assertions<sup>86</sup> and are not supported (the supporting exhibits cannot be taken into account as they are dated after the ***Relevant Date***).<sup>87</sup> Thus little weight can be accorded.

83 In relation to the ***Opponent's*** argument that it has a family of “Mi” marks, I am of the view that there is insufficient evidence to support this argument. As alluded to above, most of the evidence tendered by the ***Opponent*** to show reputation / use cannot be taken into account.<sup>88</sup>

84 Having regard to all of the above, the general impression of the marks and possibility of imperfect recollection, I am of the view that the impact of marks similarity in this case points towards a likelihood of confusion.

*Factors relating to the impact of goods-similarity*

85 The ***Applicant*** submitted that:

[71] ...the nature of the goods and services, being apps, tend to ***command a higher level of attention*** from the relevant consumer...Apps are largely for ***functional purposes*** and the user chooses to download based on specific needs and requirements...<sup>89</sup>

[Emphasis in bold and italics mine]

86 On the other hand, the ***Opponent*** argued:<sup>90</sup>

[73]...both apps by the Opponent and the Applicant are ***free***. As it does not cost a single cent to download and use these apps, the average consumer would simply ***download*** them in a hurry ***without putting in much care and attention*** into the download, installation and creation of account.

[Emphasis in bold and italics mine]

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<sup>86</sup> Evidence pertaining to the ***Applicant's*** award at [11] similarly cannot be taken into account as it is dated after the ***Relevant Date***.

<sup>87</sup> Exhibits 3, 4 (except at page 86) and 5 (except for the last 4 rows at page 91 which relate to tournament statistics, although they do not reflect how the ***Application Mark*** was used for such events) of the ***Applicant's SD***.

<sup>88</sup> What more of evidence to show that consumers associate the marks which bear a common element. For the avoidance of doubt, even if the evidence of the ***Opponent's*** marks in the Register can be taken into account, the ***Opponent*** has not used “Mi” in a consistent manner to allow for any association between the marks to be made (and so be considered as a family of marks).

<sup>89</sup> I am of the view that malware / advertisement are irrelevant for this purpose (see [71] ***AWS***).

<sup>90</sup> [73] ***OWS***.

I would add that even if a mobile application<sup>91</sup> is chargeable, the typical price range for the same is at the low end such that the downloading (and purchasing process, where appropriate) is **not** likely to entail much care and attention.

87 Further, the relevant consumers in this instance would be the general public and clearly no specialist knowledge is required for downloading (and purchasing) a mobile application.

88 Balancing all of the above factors, I am of the view that the effect of the low price will take **precedence** over the fact that a mobile application has a specific function such that the general public will **not** pay much attention when downloading / purchasing the same.

#### *Likelihood of Confusion*

89 Thus, having regard to the usual factors relating to the impact of marks-similarity and goods-similarity, **there is a likelihood of confusion** that the marks are one and the same or are at least economically linked.

#### *Conclusion on Section 8(2)(b)*

90 The ground of opposition under Section 8(2)(b) therefore **succeeds** in relation to **Application Mark-1** (Classes 9 and 42), but **fails** in relation to **Application Mark-2** (Classes 38 and 45).

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

91 Section 8(4) of the Act reads:

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

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
  - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

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<sup>91</sup> There is a need to take into account the notional specification for the purposes of opposition such that it is the typical mobile application which must be taken into account.

***Decision on Section 8(4)(b)(i)***

*Similarity of marks*

92 In relation to this ground, the first element that must be satisfied is that "the whole or an essential part of the trade mark" must be "identical with or similar to an earlier trade mark". This element is essentially the same as the element of mark similarity under section 8(2)(b).<sup>92</sup> Thus, my conclusion in relation to this is the same as that for the objection under section 8(2)(b) above. The *Application Mark* is ***overall more dissimilar than similar*** in comparison to the ***Opponent's Earlier Mi Mark***, but ***overall more similar than dissimilar*** in comparison to the ***Opponent's Earlier Mitalk Mark***.

*Well-known in Singapore*

93 The critical question is whether the ***Opponent's Earlier Mitalk Mark***:



is well known in Singapore at the ***Relevant Date***.

94 The definition of a well known trade mark is provided in section 2 of the Act:

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

“well known trade mark” means —

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

- (i) is a national of a Convention country; or
- (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore;

95 Section 2(7), (8) and (9) of the Act elaborate on the matters to consider in determining if a mark is “well known in Singapore”. Section 2(7) of the Act states:

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

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<sup>92</sup> See *Sarika CA* at [70] and [71].

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of –
  - (i) any use of the trade mark; or
  - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

Section 2(8) of the Act reads:

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

Section 2(9) of the Act states:

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

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

96 These provisions have been the subject of further exposition by the Courts:

- (i) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore.<sup>93</sup>

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<sup>93</sup> See [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 ("*Amanresorts*").

- (ii) Aside from section 2(7)(a) of the Act, the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires and to take additional factors into consideration.<sup>94</sup>
- (iii) In relation to section 2(8) of the Act, the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore<sup>95</sup> ...

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

[Emphasis in italics mine]

- (iv) Last but not least, with regard to the ambit of section 2(9)(a), the inquiry is into the specific goods or services to which the opponent’s trade mark has been applied.<sup>96</sup>

97 I have dealt with the **Opponent’s** evidence of use above and I will not repeat my analysis here. In short, most of the evidence cannot be taken into account because they do not relate to the **Opponent’s Earlier Mitalk Mark** and are either undated<sup>97</sup> or dated after the **Relevant Date**.

98 Before I conclude, the **Opponent** submitted:<sup>98</sup>

[89(a)] the “**Mi**” marks and the “**Mitalk**” mark are known to or recognised by anyone owning a Xiaomi-branded smartphone in Singapore at least, and arguably would have been known to anyone making a decision as to which smartphone to buy. It is said to be fourth in place in terms of market share in Singapore.

99 Firstly, as alluded to above, the evidence pertaining to the **Opponent’s** market share in Singapore cannot be taken into account.<sup>99</sup> Secondly, even if the evidence pertaining to

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<sup>94</sup> See *Amanresorts* at [137].

<sup>95</sup> The Court of Appeal in *Amanresorts* 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* ([229] *Amanresorts*).

<sup>96</sup> See [152] *Amanresorts*.

<sup>97</sup> See above.

<sup>98</sup> [89(a)] **OWS**.

<sup>99</sup> As it is dated after the **Relevant Date**.

the *Opponent's* market share can be taken into account, it is a leap of logic to conclude that the *Opponent's Earlier Mitalk Mark* in relation to *computer software applications, downloadable* is well-known simply from the sales of hardware.<sup>100</sup> Evidence must be tendered to show that the *Opponent's* hardware has a mobile application with the *Opponent's Earlier Mitalk Mark* built in; a bare assertion is insufficient.

100 Accordingly, this element has *not* been made out.

*Confusing connection / Likelihood of Damage*

101 Having regard to the above, there is no need for me to deal with the two elements of “confusing connection” and “likelihood of damage”.

*Conclusion on Section 8(4)(b)(i)*

102 The ground of opposition under section 8(4)(b)(i) fails.<sup>101</sup>

**Ground of Opposition under Section 8(4)(b)(ii)**

103 The relevant provisions of the Act read:

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

(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.

104 It is clear that the relevant provisions and case law which relate to the limb “well known in Singapore” (above) apply. Further, the following are pertinent:

(i) The test “well known to the public at large in Singapore” has to mean *more* than just “well known in Singapore”. The mark has to necessarily enjoy a much

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<sup>100</sup> See [70] *OWS*.

<sup>101</sup> For the avoidance of doubt, this applies to both *Application Mark-1* (Class 9 and 42) and *Application Mark-2* (Class 38 and 45).



*higher* degree of recognition. It has to be recognised by *most* sectors of the public though not so far as to all sectors of the public.<sup>102</sup>

- (ii) A much more *extensive* level of protection is granted to trade marks which have attained the *coveted* status of being “well known to the public at large in Singapore”. These form a *rare and exclusive class*, and are entitled to protection from use of a trade mark<sup>103</sup> on dissimilar goods or services even in the absence of a likelihood of confusion.<sup>104</sup>

#### ***Decision on Section 8(4)(b)(ii)***

105 I have found that the ***Opponent’s Earlier Mitalk Mark*** is not well known in Singapore. It must follow that it is *not* “well known to the public at large in Singapore” either.

106 The ground of objection under section 8(4)(b)(ii) therefore fails.<sup>105</sup>

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

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

8(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)***

108 In relation to this ground, it is trite that there are three elements to be established (i) goodwill; (ii) misrepresentation; and (iii) damage.

109 I further elaborate on the law of passing off as follows:

- (i) The opponent must establish that it has acquired goodwill as at the *relevant date*, that is, the date on which the defendant's conduct complained of started. Applying this principle, it is the ***Relevant Date*** in this instance (*Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2<sup>nd</sup> Edition, 2014) (“***Law of Intellectual Property of Singapore***”) at [17.2.5]).
- (ii) Goodwill, in the context of passing off, is concerned with goodwill in the *business as a whole*, and not specifically in its constituent elements. The issue

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<sup>102</sup> See *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [13].

<sup>103</sup> Similar.

<sup>104</sup> See *Amanresorts* at [233].

<sup>105</sup> For the avoidance of doubt, this applies to both ***Application Mark-1*** (Classes 9 and 42) and ***Application Mark-2*** (Classes 38 and 45).

of whether a mark or get-up is distinctive of a plaintiff's products or services is a question best dealt with in the context of the inquiry as to whether the defendant has made a misrepresentation (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading* [2016] 4 SLR 86 (“*Singsung*”). Evidence of sales and income of the business are a “proxy for the attractive force of the business” (*Singsung* at [58]). The “get up” can include various aspects of the business, including a mark (*Law of Intellectual Property of Singapore* at [17.2.10] – [17.2.11]).


- (iii) Section 8(7)(a) of the Act at the very least requires an opponent to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation and damage (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 at [164]).

110 The *Applicant* has not sought to challenge that the *Opponent* enjoys goodwill in its business as a whole,<sup>106</sup> and I am prepared to accept that the *Opponent* has the relevant goodwill.

#### *Misrepresentation*

111 As alluded to above, in an action in passing off, it is permissible for the *Opponent* to rely on its *get-up* (which includes the *Opponent's Earlier Mitalk Mark*).<sup>107</sup>

112 Accordingly, the comparison of get-ups / marks is as follows:

| S/N | <i>Opponent's Earlier Mitalk Mark</i>   | <i>Application Mark</i>  |
|-----|---|--|
| 1   |  |  |

113 For the same reasons as the objection under section 8(2)(b), I am of the view that, on a balance of probabilities, there is ***a likelihood of misrepresentation*** that the *Applicant* and the *Opponent* are one and the same or that they are economically linked for the purposes of *Application Mark-1* (Classes 9 and 42) ***only***.

<sup>106</sup> In this regard, the *Applicant* argued that “the *Opponent* has made ***no attempt to attribute separate facts and figures to the sales and promotion of [the] individual marks***” (see [126] *AWS*), emphasis in italics and bold mine.

<sup>107</sup> As alluded to above, the *Application Mark* is more dissimilar than similar to the *Opponent's Earlier Mi Mark*.

*Damage*

114 I agree with the **Opponent** that there will be damage via blurring or the diversion of sales (e.g. the relevant public downloading the **Applicant's** services thinking they belong to the **Opponent**).<sup>108</sup>

*Conclusion*

115 The ground of opposition under section 8(7)(a) therefore **succeeds** in relation to **Application Mark-1** (Classes 9 and 42) **only**.

**Decision on Section 7(6)**<sup>109 110</sup>

116 Section 7(6) reads:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

117 The law in relation to bad faith is not in contention. I do not propose to set it out as this ground of opposition can be dealt with briefly. Suffice to say, I accept the **Opponent's** submissions as to the legal position.<sup>111</sup>

118 The **Opponent's** main argument in relation to this ground is as follows:

[168] It is disconcerting to the Opponent that the Applicant had boldly claimed that it had done due diligence prior to filing the Application Mark and had not made reference to any third party....it is submitted that the Applicant **ought to have known** of the Opponent's "**Mitalk**" mark and its instant messaging app by the time it chose to enter the Singapore market and filed the Application Mark in 2018.

[Emphasis in italics and in bold mine]

119 The **Applicant** responded, in the main, that "[e]ven if the Applicant was aware of "mitalk" at the time when it derived its mark, its choice to coin the mark as "MiChat" cannot be said to be in bad faith when the element "Mi" has so extensively been used by others and is common in the social landscape as well".<sup>112</sup>

120 It is important to recall that an allegation of bad faith is a serious claim to make. I am of the view that "[e]ven if the Applicant was aware of "mitalk" at the time when it derived its mark", that *per se*, without more,<sup>113</sup> cannot be considered to be bad faith.

<sup>108</sup> [157] **OWS** referring to [95(b)] **OWS**.

<sup>109</sup> No cross-examination was requested in this action.

<sup>110</sup> For clarity, the **Application Mark** (pertaining to all 4 classes) can be taken into account for the purposes of this objection.

<sup>111</sup> [162] – [166] **OWS**.

<sup>112</sup> [139] – [145] **AWS**.

<sup>113</sup> This is especially so when the evidence of use / reputation of the **Opponent** has not been made out here.

*Conclusion*

121 The ground of opposition under section 7(6) therefore fails.

**Conclusion**

122 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition *succeeds* under section 8(2)(b) and section 8(7)(a) in relation to ***Application Mark-1*** (Classes 9 and 42) ***only***. Accordingly, ***Application Mark-2*** (relating to Classes 38 and 45) shall ***proceed to registration***.

123 As the Opposition succeeds against ***Application Mark-1*** (Classes 9 and 42) but not ***Application Mark-2*** (relating to Classes 38 and 45), each party is to bear its own costs.

Date of Issue: 15 February 2021

[The appeal from this decision on ***Application Mark-1*** to the General Division of the High Court was successful.]