

Intellectual Property Office of Singapore Case Summary: NCL Corporation v Norwegian Brand Ltd. [2023] SGIPOS 5

Source: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>

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This case involves two parties with established businesses in the global travel industry. One provides air travel services and the other operates cruises. They share a common word in their respective trade marks, namely, the word “Norwegian”. There is some overlap between the cruise company’s services and the services claimed by the airline company in its international registrations designating Singapore. The Principal Assistant Registrar decided that there was no likelihood of deception or confusion under the law of passing off as long as the airline company’s specifications of services were appropriately qualified. The main features of this decision are summarised below.

Norwegian Brand Ltd. (“the Applicant”), is an airline and sought to protect Trade Mark No. 40201709794W



The logo for Norwegian, featuring the word “norwegian” in white lowercase letters on a red rectangular background, with a stylized white and blue bird-like graphic to the right.

in Singapore on 20 January 2017, which is the relevant date here. NCL Corporation (“the Opponent”) is a cruise line and opposed the protection of these international registrations designating Singapore.

The Opponent relied on two main grounds in this opposition. First, it relied on the “well known mark” provision under Section 8(4) of the Trade Marks Act 1998 (“the Act”). Second, it relied on the “passing off” provision under Section 8(7)(a) of the Act.

In relation to the “well known mark” provision, the Opponent adduced evidence of the use and promotion of its marks overseas and in Singapore to show that they were well known in Singapore. However, most of this evidence post-dated the relevant date in 2017, and very little of it pertained to the Singapore context. Further, it could not be ascertained what impact such use and promotion had in the minds of the relevant public in Singapore. As the Opponent’s evidence could not substantiate a finding that the Opponent’s most relevant mark, “NORWEGIAN CRUISE LINE”, was well known in Singapore, it did not succeed under the “well known mark” provision of the Act¹.

As for the ground of opposition under “passing off”, it was undisputed that the Opponent had goodwill in its business in Singapore. The decision therefore focused on whether there was misrepresentation. The memorable and dominant



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elements of both “NORWEGIAN CRUISE LINE” and “norwegian” were the word “Norwegian”, and there were overlapping services such as “travel services” and “travel booking, reservation or information services relating to travel”. The Principal Assistant Registrar also considered market realities in the travel industry, such as the availability of “fly-cruise” packages. The average consumer may be confused into thinking that the Applicant’s services came from a source that is linked to the Opponent.

Section 8(7)(a) of the Act prohibits the registration of a trade mark only to the extent that its use in Singapore is liable to be prevented by the law of passing off. With the qualifying phrase “none of the aforesaid related to cruise services”



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applied to the opposed specifications, the use of “norwegian” only in relation to the qualified services would address the concern of confusion to the public.

The opposition was also directed at another of the Applicant’s international registrations, namely Trade Mark No.

40201709795R



. However, “NORWEGIAN CRUISE LINE” and



were found to be distinguishable from each other as their memorable and dominant elements differed. There was therefore no need to qualify the specifications in respect of Trade Mark No. 40201709795R and this international registration can be protected in Singapore as filed.

Disclaimer: The above is provided to assist in the understanding of the Registrar’s grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2023/ncl-v-norwegian-brand-2023-sgipos-5.pdf>.

¹ For those interested in legal issues, the decision also discusses the requirement of a “real and effective commercial establishment” in the context of a “well known mark”.