

**Intellectual Property Office of Singapore
Hearings & Mediation Department**

**IPOS DISPUTE RESOLUTION:
TRADE MARKS CASE GUIDE**
(1st Ed: 2017, Last Revised 22 January 2019)

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FOREWORD

Introduction

This document is targeted at practitioners who act for clients in proceedings before the Registrar at the Intellectual Property Office of Singapore (IPOS).

It aims to serve as a quick (albeit non-exhaustive) guide to some key aspects of IPOS practice and procedure.

The focus of this document is on selected decisions of the Registrar (from 2013 onwards), and where relevant, their treatment by the courts.

Structure

This document is split into the following parts.

Part I: contains a brief glossary of terms which frequently arise in IPOS disputes.

Part II: deals with matters of practice and procedure.

Part III: discusses legal and evidential points which may be of interest to practitioners. An in-depth treatment of the law is beyond the scope of this document. Instead, the focus is on: (a) significant or frequently encountered issues in IPOS proceedings; and/or (b) issues which the Singapore courts have yet to consider.

Annex A: is a change log which records the changes to the Case Guide (including any new cases).

Important Disclaimer

This document is provided solely for the reader's convenience, and should not be taken as a substitute for the Registrar's full grounds of decision as stated in each case, or the various IPOS Hearings & Mediation Circulars presently in effect.

For the avoidance of doubt, this document is not a Circular and does not have any legal effect or authority.

Abbreviations Used

- Trade Marks Act (Cap. 332) ("**TMA**")
- Trade Marks Rules (Cap. 332, R 1) ("**TMR**")

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PART I

Glossary of commonly used identifiers

- **Applicant:** broadly refers to any party making an application to the Registrar. In practice, the meaning of “Applicant” is context dependent:
 - In trade mark opposition proceedings, “Applicant” refers to the party seeking to obtain registration of its trade mark.
 - In invalidation or revocation cases, “Applicant” is synonymous with “Initiator” (see below).
 - In interlocutory proceedings, “Applicant” refers to the party seeking relief and/or the exercise of the Registrar’s discretion in its favour.
- **Hearing Officer:** refers to the PAR or AR presiding over an interlocutory or final hearing.
- **Initiator:** refers to any party which has commenced legal proceedings at IPOS.
- **IP Adjudicator:** refers to an individual who is appointed to hear IP disputes at IPOS on an *ad hoc* basis. IP Adjudicators are appointed to give parties to disputes the opportunity to have their cases heard by some of the best legal minds in the local IP field. A list of IP Adjudicators is available at the following [link](#).
- **Opponent:** broadly refers to any party resisting an application to the Registrar. In trade mark opposition proceedings, “Opponent” refers to the party seeking to oppose another party’s application to register a trade mark.
- **Proprietor:** The term ‘proprietor’, or ‘registered proprietor’, or ‘registrant’, may refer to any party which owns any intellectual property right that is relevant to the dispute.
- **Registrar:** refers to the Registrar of Trade Marks. In practice, the Registrar’s authority in contentious proceedings is delegated to Principal Assistant Registrars (PAR) and Assistant Registrars (AR) in the Hearings and Mediation Department (HMD), as well as IP Adjudicators in selected cases (see above).
- **Respondent:** refers to any party which defends or resists an application. For example, Respondent may refer to: (1) the Proprietor of a trade mark that is being attacked for non-use may be referred to as the Respondent; or (2) a party resisting an application to adduce further evidence.

PART II

Practice and Procedure

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(1) Starting an action

1.1 The importance of keeping proper records and managing IP

Proprietors should exercise basic intellectual property management such as tracking renewal deadlines and as documenting evidence of use. The records kept may be useful, or even critical, as evidence, in the event a trade mark is challenged post registration.

In this regard, being a small scale business is no excuse for poor record keeping.

- [Cheaney Shoes Limited v Widdy Trading Pte Ltd](#) [2015] SGIPOS 12 at [43]

1.2 Is there a requirement of *locus standi*, or sufficient standing, in order to commence a trade mark opposition?

No, there is no such requirement. “Any person”¹ may give notice of a trade mark opposition under Section 13(2) TMA.

- [Converse Inc v Southern Rubber Works Sdn Bhd](#) [2015] SGIPOS 11 at [18]

1.3 Does the initiator have to adduce evidence of non-use in order to commence an action for trade mark revocation on that ground?

No. A bare allegation of non-use is sufficient.

- [Secondment Pty Ltd v MCI Group Holding SA](#) [2014] SGIPOS 15 at [22] to [30]²

1.4 Is there a requirement that the opponent must be the proprietor of the earlier trade mark(s) relied on?

No. Under Section 8(2)(b), the opponent may rely on earlier trade marks owned by a third party.

- [Application for Amendment of Notice of Opposition by MHCS and Objection Thereto by J.-E. Borie SA](#) [2013] SGIPOS 4 at [23]

1.5 The importance of preparing evidence by reference to the grounds in dispute

In the following cases, a portion of the parties’ evidence pertained to matters outside of the grounds of opposition and it was not necessary for the tribunal to review and make determinations on that evidence. It would have been more straightforward and efficient if the evidence had been more streamlined and curated according to what needed to be established or defended against, by reference to the grounds of opposition. Indeed, parties should take heed of the fact that the tendering of evidence that is irrelevant or excessive may, in certain cases, have cost consequences.

¹ A “person” includes a company.

² However, the Registrar remains open to reconsidering the point in a future case.

- [U-Manga International Business Co., Ltd. v Nunufish.com](#) [2017] SGIPOS 11 at [64]
- [Guccio Gucci S.p.A v Guccitech Industries \(Private Ltd\)](#) [2018] SGIPOS 1 at [15], [73] and [96]

(2) Pleadings

2.1 Pleading the correct grounds and related issues

For guidance on the Registrar's practice in relation to pleadings issues at Case Management Conferences, please see HMD Circular No. 1/2013.

In the following case, decided before HMD Circular No. 1/2013 was issued, the applicant for revocation and invalidation of certain registered marks incorrectly (and thus unsuccessfully) alleged passing off and deception under Sections 7(4) and 7(5) TMA:

- [Autozone Automotive Enterprise v Autozone Parts, Inc.](#) [2013] SGIPOS 1 at [65] – [66]

There are several possible heads of bad faith under Section 7(6) TMA. It is important to particularise these in the pleadings and not leave it only to the later stages of evidence or submissions to think about or articulate what these heads of alleged bad faith are. In the following cases, the Registrar disregarded lines of argument falling outside the scope of the pleadings of bad faith.

- [Adidas International Marketing BV v Lutong Enterprise Corp.](#) [2018] SGIPOS 12 at [80] – [82]
- [Apple Inc. v Swatch AG \(Swatch SA\) \(Swatch Ltd.\)](#) [2018] SGIPOS 15 at [97] – [99]

2.2 Amendments to pleadings

For guidance on amendments to pleadings (e.g. Notice of Opposition, Counter Statement), please see HMD Circular No. 2/2010 dated 20 August 2010.

In the following case which considered HMD Circular No. 2/2010, an amendment to the Notice of Opposition was sought, objected to by the counter party, and allowed by the Hearing Officer on the specific facts:

- [Application for Amendment of Notice of Opposition by MHCS and Objection Thereto by J.-E. Borie SA](#) [2013] SGIPOS 4

However, in the following case, an application by an applicant for leave to amend the Statement of Grounds with a view to adding a new ground for revocation after the registered proprietor had already filed its evidence was refused by the Hearing Officer.

- [Application for Amendment of Pleadings by Axis Law Corporation and Objection Thereto by Axis Intellectual Capital Pte Ltd.](#) [2015] SGIPOS 15³

³ Dissatisfied, the applicant filed for judicial review but the High Court dismissed the judicial review application in [2016] SGHC 127. The applicant subsequently appealed to the Court of Appeal (in Civil Appeal No. CA 79 of 2016) which dismissed the appeal without issuing written grounds of decision.

2.3 Striking Out

The Registrar has no power to strike out a notice of opposition.

- [Application by OOO “TVM Trade” to strike out notice of opposition and objection thereto by Societe De Produits Nestle](#) [2014] SGIPOS 12 at [1] and [37]

2.4 Effective date of revocation for non-use

An order for non-use revocation may, in certain circumstances, take effect from an earlier date than the date of the application for revocation. (See HMD Circular No. 1/2012.) However, the Registrar has *no* power to order the effective date of revocation to a day within the first 5 years from the date of the completion of the registration procedure:

- [New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited](#) [2017] SGIPOS 16 at [7] and [73] – [97].

(3) Exercise of Registrar’s discretion

3.1 Preliminary Views of the Registrar

The term Preliminary View (“PV”) refers to the Registrar’s provisional (as opposed to final) decision or direction.

A PV may be issued in the context of any interlocutory dispute *other than* an application for extension of time made within the relevant prescribed period.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9 at [26]

A brief sketch of the salient points relating to PVs is set out below.

- When interlocutory disputes arise, the Registrar typically does not issue any PV at the outset.
- Instead, the first step is to allow parties to explore the possibility of resolution via consent.
- However, if parties are unable to resolve their differences by a certain time, or at any appropriate juncture, the Registrar will put forth a PV and parties will be given an opportunity to respond by way of letter.
- If no objections are received to the Preliminary View by the stipulated date, the tentative decision or directions set out in the Preliminary View become final and parties are to abide by them.
- In the event objections are received to the Preliminary View, the Registrar may adopt one of the following approaches:

- Issue a fresh PV and give parties a further opportunity to respond. The Registrar may adopt this approach in cases where there is new information that was not previously considered and/or after due consideration of the parties' submissions.
- Indicate that notwithstanding the objections the Registrar is not inclined to deviate from the earlier Preliminary View and at the request of a party or on his own initiative, allow the parties to be heard either (at their election) by way of a formal oral interlocutory hearing or only by further written submissions (if any) in lieu of an in-person interlocutory hearing.
- The Registrar will either issue a final decision at the conclusion of, or after, the interlocutory hearing or after receiving the parties' written submissions in lieu of an in-person interlocutory hearing (as the case may be).

3.2 Extensions of Time (where the application is made out of time)

Rule 83 TMR provides that:

“Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct”.

Pleadings

The Registrar has the power to hear an application for an extension of time (including one made out of time) to file a Counter Statement under Rule 83 TMR.

- [Application for Acceptance of Late Counter-Statement in a Trade Mark Application by MGG Software Pte Ltd and Objection Thereto by Aptitude Pte Ltd](#) [2015] SGIPOS 8 at [1]⁴

However, the mere fact that the Registrar has such discretion does not justify its exercise in every case or where no good reasons are shown.

- [Application for Acceptance of Late Counter-Statement in a Trade Mark Application by MGG Software Pte Ltd and Objection Thereto by Aptitude Pte Ltd](#) [2015] SGIPOS 8 at [2]

Evidence

The Registrar has the power to hear an application for an extension of time to file evidence under Rule 83 TMR. The aforementioned power may be exercised by the Registrar notwithstanding that a request for an extension of time may have been made:-

- (a) after the prescribed period to apply for an extension of time (see Rule 33(4) TMR); and/or
- (b) after the maximum possible time extension that the Registrar would have been able to award if the extension of time had been applied for within the relevant prescribed period for applying for such extension (see Rule 33(5) TMR).

⁴ Citing *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7 for the proposition that “irregularity” in Rule 83 refers to failures to comply with the procedural requirements of the TMA and the TMR.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likburstokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [1] – [3]⁵

Some relevant considerations

In the Registrar's exercise of discretion, a balance must be struck between ensuring that parties have the benefit of certainty and finality that the Trade Marks Rules provide, and that cases are dealt with on the basis of their merits in the interest of justice between parties.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likburstokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [6]⁶

A solicitor's bona fide mistake is but one factor in the Registrar's overall consideration in deciding whether to exercise discretion to allow an extension of time. Such a mistake per se may not be sufficient to enable the Registrar to exercise discretion in favour of an extension.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likburstokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [7]⁷

A key factor that the Registrar will consider is whether the grant of an extension of time is whether the grant of an extension of time would cause prejudice to the innocent party. Although an applicant for extension of time cannot rely on the consequences of his own default as a type of "prejudice" done to him, this does not mean that the Registrar cannot consider other types of prejudice when deciding whether to exercise discretion. Ultimately, in approaching the question of prejudice the Registrar will seek to balance both parties' competing interests and decide based on the justice of the case.

- [Application for Restoration of TM Applications and Request for Extension of Time to File Evidence by Tilaknagar Industries Ltd and Objection Thereto by Distileerderij en Likburstokerij Herman Jansen B.V.](#) [2013] SGIPOS 3 at [10]⁸

3.3 Filing of Further Evidence

For guidance on applications to file further evidence, please see HMD Circular No. 1/2011 dated 8 April 2011.

In the following case, wherein HMD Circular No. 1/2011 was considered, the Hearing Officer refused an application to file further evidence after the close of evidence:

⁵ Citing *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7, *Sao Paulo Alpargatas S.A. v But Fashion Solutions Comercio E Industria De Artigos Em Pele, LDA* [2011] SGIPOS 16

⁶ Citing *Neutrogena Corporation v Neutrigen Pte Ltd* [2005] SGIPOS 7 and *Martin Joseph Peter Myers v GSM (Operations)* [2009] SGIPOS 8

⁷ Citing *Nomura Regionalisation Venture Fund Ltd v Ethical Investments Ltd* [2000] 2 SLR(R) 926 at [28] and *Denko-HLB Sdn Bhd v Fagerdala Singapore Pte Ltd* [2002] 3 SLR 357 at [13]

⁸ Citing the Court of Appeal's dicta in *Sun Jin Engineering Pte Ltd v Hwang Jae Woo* [2011] 2 SLR 196

- [Application for Leave to File Further Evidence in a TM Opposition by Autozone Automotive Enterprise and Objection Thereto by Autozone Parts, Inc.](#) [2013] SGIPOS 7⁹

(4) Matters relating to oral hearings

4.1 Instructed Counsel

Instructed counsel may be engaged to argue cases at IPOS.

- [Secondment Pty Ltd v MCI Group Holding SA](#) [2014] SGIPOS 15 at [6] – [10]

4.2 Applications for cross-examination

For guidance on applications for leave to cross-examine witnesses, please see HMD Circular No. 4/2015 dated 30 June 2015 (Amended 22 July 2016).

In the following case, the first dealing with the interpretation of HMD Circular No. 4/2015, the Hearing Officer allowed the applicant's request for cross-examination on certain specific issues only, and limited the time allotted for cross-examination to 60 minutes per witness.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9

4.3 Cases where there is no cross-examination

The Registrar is not obliged to accept a witness' evidence in the absence of cross-examination if it is obviously incredible. However, where the evidence in a statutory declaration is not obviously incredible, and no opportunity has been given to the deponent (whether in cross-examination or otherwise) to clarify, substantiate the evidence in the statutory declaration, or respond to objections, it may be inappropriate to make adverse factual findings against the deponent.

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [46] – [49]

4.4 Absence of material witness from cross-examination

It may be possible to draw an adverse inference against a party whose material witness is required to attend cross-examination but fails to do so without proper justification.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Limited](#) [2016] SGIPOS 1 at [180] – [183]
- [Bitwave Pte Ltd v Fung Shing Company Limited](#) [2018] SGIPOS 21 at [2] – [3]

⁹ The Registrar made it clear that the factors listed in HMD Circular No. 1/2011 are not exhaustive and considered the principles in following UK cases as being of guidance: *Ladd v Marshall* [1954] 1 WLR 1489, *Hunt Wesson Inc's Trade Mark Application (SWISS MISS)* [1996] RPC 233, and *Yves Saint Laurent v The Zoological Society of London* (Case No. O-245-07, 23 August 2007) (UK IPO) at [29] – [30].

4.5 Whether the Evidence Act and/or Rules of Court apply to IPOS proceedings?

To date, the question of whether proceedings before the Registrar at IPOS are subject to the Evidence Act (Cap. 97) and/or Rules of Court (Cap. 322, R 5) has not been fully and finally settled.

In the following case, the Hearing Officer did not decide the issue, but indicated his inclination to the view that the Rules of Court do not apply to IPOS proceedings generally although parties may mutually agree to their application.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9 at [31] – [56]

The Hearing Officer also considered that Parts I, II and III of the Evidence Act did not apply to statutory declarations filed for the purposes of IPOS proceedings. However, where oral evidence is: (a) given in lieu of or in addition to a statutory declaration, or (b) elicited during cross-examination, the Evidence Act should apply.

4.6 Can supplementary or further written submissions be tendered at the hearing itself? Can additional authorities be cited and relied on?

It depends on the circumstances. HMD Circular No. 4/2015 states that additional or supplementary written submissions (and accompanying bundle of authorities) should be filed and served on the counter-party at least 2 weeks before the hearing. Failure to comply may result in the Registrar disregarding the submissions. If the Registrar exercises his discretion to accept the submissions, the counter-party will be given time to file reply submissions. Although the 2-week requirement does not apply to basic rebuttal submissions, the Registrar retains the discretion to give the other party time beyond the hearing to file reply submissions if the situation calls for it.

In the following case, the opponent furnished supplementary written submissions at the hearing itself (that is to say, it did not comply with the 2-week timeline), together with seven additional case authorities from the UK Patent Office, IP Australia, and the EU Intellectual Property Office. The opponent was given the opportunity to explain its reliance on these additional authorities. After hearing counsel, the Hearing Officer concluded that the persuasive value of these additional authorities was “very limited, at best”. She declined to take them into account. In so doing, she stressed that parties in proceedings before the Registrar are expected to comply with the Circular, which serves to ensure fair and transparent play between parties and the integrity of the rules (which gives parties fair opportunity to concretise their submissions 1 month in advance).

- [Adidas International Marketing BV v Lutong Enterprise Corp.](#) [2018] SGIPOS 12 at [50] – [53]

4.7 Documents in the nature of evidence tendered at the hearing

Parties should not tender documents at the hearing which are in the nature of (further) evidence. Evidence should be tendered by way of statutory declaration (and leave should be obtained for the late filing).

In the following case, the opponent tendered a 13 pages of printouts from various web pages which it described as “observations” in the nature of “general knowledge on the wine industry”. The Hearing Officer did not take these documents into account.

- [Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd](#) [2014] SGIPOS 11 at [15] – [25]

For other cases wherein the Hearing Officer considered that improperly introduced documents should be disregarded, please see:

- [Stora Enso Oyj v PT Purinusa Ekapersada and PT Pabrik Kertas Tjiwi Kimia TBK Ltd](#) [2016] SGIPOS 12 at [119] – [122]
- [Adidas International Marketing BV v Lutong Enterprise Corp.](#) [2018] SGIPOS 12 at [65] – [66]

However, judicial notice can be taken of certain facts even if they are not set out in (or annexed to) a statutory declaration. In the following case, the IP Adjudicator took judicial notice of the fact that certain trade marks were registered in Singapore.

- [The Polo/Lauren Company, L.P. v United States Polo Association](#) [2015] SGIPOS 10 at [76]

4.8 Documents used to challenge witness testimony during cross-examination

By way of contrast, documents produced during cross-examination for the purposes of challenging witness testimony may, in certain circumstances, be admissible.

- [FMTM Distribution Ltd v. Tan Jee Liang Trading as Yong Yew Trading Company](#) [2017] SGIPOS 9 at [18] – [32]

(5) Decisions of the Registrar

5.1 Whether previous IPOS decisions are binding

A holding in an earlier IPOS decision is persuasive, but not binding, on a later IPOS tribunal.

- [Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company](#) [2016] SGIPOS 9 at [40]

5.2 The Registrar’s approach to judgments of a Court or Tribunal in separate proceedings

Observation

At times, parties to IPOS disputes may be embroiled in disputes over the same or related mark(s) before courts or tribunals abroad. Not infrequently, after having obtained a decision of a foreign court or tribunal in their favour, one or both parties may seek to rely on certain findings or holdings in that decision (e.g. on similarity of marks, distinctiveness, or likelihood of confusion) before the Registrar at IPOS as well.

General principles

As a general rule, a previous judgment of a court or tribunal in separate proceedings is a determination based on separate and independent facts and is not relevant to subsequent judicial proceedings (or IPOS proceedings). Even if the parties and issues are substantially the same, a previous judgment may only be admissible in subsequent proceedings in limited circumstances.

- [Star Industrial Company Limited v Sin Fatt Industrial Co., Sdn Bhd](#) [2013] SGIPOS 5 at [20] – [23]¹⁰

That said, if the Singapore High Court makes findings in separate proceedings, and there is evidence of the correlation of the facts and issues before the Court and the existing proceedings before the Registrar, the Registrar may be bound by the substantive decision of the High Court.

- [Tsong-Tse Hsieh v Redsun Singapore Pte. Ltd.](#) [2015] SGIPOS 1 at [16]

Related proceedings between parties in other jurisdictions serve at best as guides to opposition proceedings here. The relevance of these decisions will hinge upon the similarity of the laws of the particular jurisdiction with those of Singapore and also upon the individual facts of the case. For example, it does not follow that a mark which is well known in country X is necessarily also well known in country Y.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [27]¹¹

On the other hand, if a party makes certain factual assertions in one jurisdiction, he should not be permitted to take a completely different position in another jurisdiction.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [27]¹²

Reliance on EU cases

Parties should be mindful of the need to exercise caution in the use of authorities from the EU given the significant differences in the law in certain respects, as well as the different circumstances. (For instance, a sign may have no meaning in respect of the relevant goods and/or services to non-English speakers, but such a finding would be irrelevant to the Singapore context.)

- [Beats Electronics, LLC v LG Electronics Inc.](#) [2016] SGIPOS 8 at pp 12 to 13, footnote 1

Reliance on UDRP cases

Cases decided under the Uniform Domain Name Dispute Resolution Policy (UDRP) are premised on very different considerations from those in trade mark oppositions in Singapore.

¹⁰ Citing Jeffrey Pinsler, S.C., *Evidence, Advocacy and the Litigation Process* (3rd edition) at pp 208 – 209, 253, and 377.

¹¹ Citing *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [118].

¹² Citing *Guy Neale and ors v Ku De Ta SG Pte Ltd* [2015] 4 SLR 283 at [90] and [115].

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [30]
- [Formula One Licensing B.V. v Idea Marketing SA](#) [2015] SGIPOS 7 at [87]¹³

5.3 Partial revocations, invalidations and oppositions

Partial revocation and/or invalidation of goods or services is possible under Sections 22(6) TMA and/or 23(9) TMA respectively. The following are examples of cases where partial invalidation of goods was ordered.

- [Sports Connection Pte Ltd v PT Eigerindo Multi Produk Industri](#) [2015] SGIPOS 5
- [G3 Enterprises, Inc v Bacardi & Company Limited](#) [2014] SGIPOS 6

However, the TMA does not expressly confer upon the Registrar the power to order that an opposition partially succeeds in respect of some, but not all of the goods or services.

In the following case, the Hearing Officer examined some of the arguments for and against allowing partial oppositions, but did not decide on the issue as he was not required to do so.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [102] – [114]

Partial oppositions once again came to the forefront in the case of Monster Energy Company v Tencent Holdings (full citation below).

- [Monster Energy Company v Tencent Holdings Limited](#) [2018] SGIPOS 9

Although it was not necessary to decide the issue in light of his conclusion that the marks were dissimilar, the Hearing Officer considered that the Registrar cannot, in the context of a trade mark opposition under Sections 8(2)(b) and/or 8(4) of the Trade Marks Act refuse the registration of certain goods or services in a certain class, but allow it to be registered for other goods or services in the same class. Instead, the Registrar had to either refuse or allow registration of the mark in its entirety (i.e. in respect of all the goods or services for which registration is sought).

5.4 Costs in partial revocation cases

In the case of a partially successful revocation action, costs would generally be awarded to the applicant for revocation. This flows from the general principle that, in the absence of other intervening factors, costs should follow the event.

However, it does not follow that a partially successful applicant (for revocation) would be awarded full costs. It may be less, depending on the specific facts of the case. This is not a strict numbers game and there is no rigid mathematical formula that can be derived based on the number of items revoked out of the total number of goods/services in the original specification.

¹³ Upheld on appeal (see [2015] SGHC 263) and the Hearing Officer's holding on UDRP cases was expressly affirmed at [73] of the High Court's decision.

➤ [Bigfoot Internet Ventures Pte. Ltd. v Athleta \(ITM\) Inc.](#) [2018] SGIPOS 10

PART III

Legal and Evidential Points of Interest

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(6) Bad faith

6.1 Overly wide specifications

Merely drafting a specification broadly does not necessarily mean that the application is made in bad faith. A line should be drawn between excessively wide specifications and ones which merely provide some room for possible brand extension:

- [Kenzo v Tsujimoto Kenzo](#) [2013] SGIPOS 2 at [125]

It is legitimate for businesses to seek registration of a mark, not only for the categories of goods and services which it markets at the time of filing the application, but also for other categories of goods and services which it intends to market in the future. There is no bad faith in applying for a broader specification than one which a trader currently trades in. A possible or contingent intention to use the mark at some future date may suffice.

However, there may be bad faith if there is something more to suggest that there has been some unconscionable business conduct and/or moral impropriety on the applicant's part. For example, if at the time of the application the applicant had no *bona fide* intention to use the mark in relation to (all of) the goods/services applied for, this would support a finding of bad faith.

- [Audi AG v Lim Ching Kwang](#) [2017] SGIPOS 2 at [59] – [60]

In a case where the trade mark proprietor discloses in evidence that it had never used, nor ever had any intention to use, its trade mark in relation to the entire (broad) specification claimed and where the applicant for invalidation had not pleaded the ground of bad faith, the Registrar nonetheless has no power to decide, of his own volition, in the public interest, that the trade mark registration was obtained in bad faith.

- [Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.](#) [2018] SGIPOS 20 at [30]

6.2 Bad faith and cross-examination

For oppositions based on bad faith where there is no cross-examination, see point 4.3 above and:

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [47]

For oppositions based on bad faith where the trade mark applicant's witness fails to attend the cross-examination without proper justification, see point 4.4 above and:

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Limited](#) [2016] SGIPOS 1 at [181] – [182]
- [Bitwave Pte Ltd v Fung Shing Company Limited](#) [2018] SGIPOS 21

6.3 Time of assessment; matters to be taken into account

In determining whether there was bad faith, the relevant time is the time of filing the application for registration.

- [Leonid Kovalkov v Tan Siew Keng, Angeline](#) [2016] SGIPOS 10 at [29]¹⁴

In this regard, it may be relevant to take into account events that occurred before the date of the application of the mark, as these will give insights into the context in which the impugned marks were registered.

- [Leonid Kovalkov v Tan Siew Keng, Angeline](#) [2016] SGIPOS 10 at [30]

In [Louis Dreyfus Commodities MEA Trading DMCC v Orco International \(S\) Pte Ltd](#) [2017] SGIPOS 8 at [113], the Hearing Officer applied the principle that bad faith must be assessed by reference to the time of filing of the trade mark application. Consequently, he declined to take into account the way the trade mark applicant conducted itself in opposition proceedings when assessing bad faith.

6.4 Cases where bad faith succeeded

In the following cases, the Hearing Officer made a finding of bad faith. These cases illustrate the type of factual matrix and/or evidence required to support a finding on this ground.

- [Sports Connection Pte Ltd v PT Eigerindo Multi Produk Industri](#) [2015] SGIPOS 5
- [Christie Manson & Woods Limited v Chritrs Auction Pte. Limited](#) [2016] SGIPOS 1
- [Leonid Kovalkov v Tan Siew Keng, Angeline](#) [2016] SGIPOS 10
- [Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd](#) [2016] SGIPOS 6
- [USA Pro IP Limited v Montfort Services Sdn. Bhd.](#) [2018] SGIPOS 3
- [Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd.](#) [2018] SGIPOS 6
- [United U-Li Projects Pte Ltd v Tan Buck Hai](#) [2018] SGIPOS 19
- [Bitwave Pte Ltd v Fung Shing Company Limited](#) [2018] SGIPOS 21

¹⁴ Citing *Kerly's Law of Trade Marks and Trade Names* (15th Ed) (Sweet & Maxwell, 2011), at [8-263] and the European Court of Justice's decision in *Chocoladefabriken Lindt & Sprungli AG v Franx Hauswirth GmbH* (C-529/07).

(7) Deceptive trade marks

Observation

Cases wherein deception (Section 7(4)(b) TMA) was pleaded as a ground of opposition are few.

In the following case, the deception ground was argued, albeit unsuccessfully. In arriving at her conclusion, the IP Adjudicator held, among other things, that the applicable threshold for deception is that of a “real tangible danger” that the public be deceived (as distinguished from a mere “cause to wonder”).

- [Starbucks Corporation d/b/a Starbucks Coffee Company v Morinaga Nyugyo Kabushiki Kaisha \(Morinaga Milk Industry Co., Ltd\)](#) [2017] SGIPOS 18

(8) Conflict with an earlier right

8.1 No ‘mosaicking’ of marks

It is trite law that under Section 8(2)(b) TMA, the analysis is mark-for-mark and in this regard two earlier trade marks cannot be mosaicked together into a composite whole for the purposes of the comparison. This principle applies not only to the first step (similarity of marks) but to also the third step (likelihood of confusion).

- [Time Inc. v Li San Zhong](#) [2014] SGIPOS 14 at [69]

The above decision was considered by the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216.

In the result, George Wei J held that two earlier separately registered trade marks cannot be combined so as to form a single composite mark (at [70]).



8.2 Relevance of inherent distinctiveness of the mark in relation to the goods/service in the marks-similarity inquiry

In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65, the Court of Appeal held at [20] that at the marks-similarity stage, the comparison is solely between the mark applied for and the earlier mark, without reference to any other matter (such as the relative weight and importance of each aspect of similarity having regard to the goods). On the other hand, technical distinctiveness is an integral factor in the marks-similarity inquiry (*Staywell* at [25]).

At first blush, the above principles appear to be difficult to reconcile with each other.

In the following case, the IP Adjudicator held that the application of these principles meant that the extent to which the earlier mark is inherently distinctive in relation to the goods for which it is registered is not a factor which may be taken into account in the marks-similarity stage. Instead, the technical distinctiveness of the competing marks must be considered in the abstract at the first stage, without reference to the actual goods/services in issue.

- [Beats Electronics, LLC v LG Electronics Inc.](#) [2016] SGIPOS 8 at [21] – [22]

However, contrast the above with *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30, a decision of the Court of Appeal.¹⁵ The earlier mark was  and the mark applied for was . The latter was sought to be registered in Class 19.¹⁶ The Court of Appeal held that the word “stone” in the application mark is “*merely descriptive of the goods in Class 19*” and that “*the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark*”. Consequently, the presence of such a descriptive element was considered to be not “*effective to displace similarity*”.¹⁷ Furthermore, because “stone” was considered to be merely descriptive of the Class 19 goods, it did not serve to “*sufficiently and substantially distinguish*” the application mark from the earlier mark.¹⁸ In effect therefore, the Court of Appeal took into account the inherent distinctiveness (or rather, the lack thereof) of a component of the later mark in the marks-similarity stage.

In *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12, the Hearing Officer interpreted *Staywell* and *Caesarstone* as standing for the following proposition: While the similarity of marks comparison is to be undertaken mark-for-mark, without consideration of any external matter, to the extent that the respective goods/services are relevant to the issue of distinctiveness (in both its technical and non-technical senses) of the competing marks, they may be taken into account (see [35] – [37]).

A closely-related issue is whether it is permissible for parties to adduce evidence of public activities which may have shaped consumer knowledge of, and familiarity with, a word mark. In the case below, the IP Adjudicator considered that how the average consumer *understands* what he sees (which is the essence of the marks-similarity analysis) must necessarily depend on *what he knows*. As such, the knowledge of the average consumer, and *how* he is likely to *understand* or *interpret* the word device element of a composite mark, must be relevant to mark-similarity assessment. And, what words (or images) *mean* must also be evaluated contextually. It would follow—in the IP Adjudicator’s view—that parties should be permitted to adduce evidence of those surrounding circumstances that are relevant towards establishing the general knowledge possessed by the average consumer.

➤ [Monster Energy Company v NBA Properties, Inc.](#) [2018] SGIPOS 16 at [46]

8.3 Pronouncing invented or unfamiliar words

It is not permissible to take one of several hypothetically plausible pronunciations of a mark, then assert that that specific pronunciation is similar to another mark.

➤ [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [75]

¹⁵ This was a trade mark opposition case where the opposition succeeded under Sections 8(2)(b) and 8(4)(b)(i) TMA but failed on the other pleaded grounds. The Hearing Officer’s decision was reported as [2015] SGIPOS 9. The trade mark applicant appealed to the High Court, and was successful: see [2016] 2 SLR 1229. The opponent appealed to the Court of Appeal, which reversed the High Court’s decision and allowed the opposition.

¹⁶ In respect of the following goods: *Non-metallic tiles, panels for floors, floor coverings, wall cladding, flooring, and ceilings; non-metallic covers for use with floors and parts thereof; non-metallic profiles and floor skirting boards; slabs and tiles formed of composite stone for building panels, counter tops, vanity tops, floors, stairs, and walls.*

¹⁷ See [2017] SGCA 30 at [41]

¹⁸ *Ibid* at [42]

In this case, the Hearing Officer found that there is no aural similarity between the marks “CHRITRS” (held to be unpronounceable) and “CHRISTIE’S”.

When pronouncing invented or unfamiliar words, there is a tendency of persons to reach within his own vocabulary and mentally look for similar words with the same structure. Having done so, he would apply the way in which those words are pronounced to the invented or unfamiliar word.

➤ [Apptitude Pte Ltd v MGG Software Pte Ltd](#) [2016] SGIPOS 15 at [41]¹⁹

Example (1): ROOX would be pronounced as “rooks”

Example (2): SNAC would be pronounced as “snack”

8.4 Aural similarity analysis where one (or both) marks contain word elements which are not (part of) the distinctive / dominant element(s)

The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65²⁰ alluded to two approaches for assessing aural similarity:

- The first approach is for the court or tribunal to have special regard to the distinctive or dominant components of the competing marks.
- The second approach is to undertake a “*quantitative assessment as to whether the competing marks have more syllables in common than not.*”

The elements in the competing marks were “ST REGIS” and “PARK REGIS” and so it mattered not which approach was taken, since both approaches would have yielded the same result.

However, in some cases, a mark may contain word elements which are not (part of) the distinctive / dominant element(s). In such cases, the two approaches may lead to different results.

Consider the following:

➤ [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [67] – [70]

In this case, the competing marks both had a similar fox head device within the word “FOX”. However, the application mark had the additional elements: (a) “Fox Street Wear”; and (b) the slogan “What’s stopping you?” The Hearing Officer applied the first approach and held that consumers would pronounce the application mark as “FOX”, disregarding the other elements.

➤ [Apptitude Pte Ltd v MGG Software Pte Ltd](#) [2016] SGIPOS 15 at [37] – [38]

In this case, the application mark was comprised of the large word element “snaapp” and the following words in much smaller font below: “SCHOOL NOTIFICATION & ATTENDANCE APP”. The Hearing Officer considered “SCHOOL NOTIFICATION &

¹⁹ Citing *Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A.* [2004] SGIPOS 8

²⁰ At [31] – [32]

ATTENDANCE APP” to be subsidiary and that it was likely that average consumers would not use those words when referring to the mark.²¹

8.5 Can goods / services in different classes be similar? Is it necessary to tender evidence to prove this?

In the following case, the respective goods were in different classes (Class 25 as compared to Class 18) and the parties did not put forward any evidence as to the uses, users or trade channels for the goods. Nevertheless, they were nevertheless held to be similar.

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [74] - [85]

Consider also the following where the opposition was under Sections 8(4)(i), 8(4)(ii), 8(7)(a) and 7(6) of the TMA (but Section 8(2)(b) was not pleaded).

- [Kenzo v Tsujimoto Kenzo](#) [2013] SGIPOS 2


The subject mark in this case was: KENZO ESTATE in class 33²². This was an opposition filed by KENZO (which was primarily in high-end fashion). The applicant was a wine producer in Napa Valley.

One of the deponents who gave evidence for the opponent stated that it was common for fashion labels or designers to lend their names or otherwise endorse products beyond clothing and accessories, including alcoholic beverages. There were also internet printouts showing that some fashion designers teamed up with producers of alcoholic beverages to produce limited edition bottles. The opponent relied on *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 2 SLR(R) 541 where the court held that luxury brands have been known to license their trade marks for use on cigarettes even though they themselves do not produce such articles.

However, the Hearing Officer found that there was no evidence on the prevalence of such licensing arrangements between luxury brands and alcoholic beverages. And, although there was some evidence that Hennessy and the opponent had collaborated in respect of the product “HENNESSY BY KENZO”, this was found to be a co-branding exercise rather than a business extension by KENZO into the liquor making business. Unlike *Tiffany* (where cigarette manufacturers bought the right to use the luxury brand’s goodwill to sell their product), it was primarily the alcoholic beverage manufacturer’s goodwill that sold their goods.

More recently, in the “GUCCITECH” case (full citation below), Gucci successfully



opposed Guccitech’s application to register “” in Class 11 in respect of various kitchen and cooking appliances. As Gucci did not have any registered trade marks in Class 11, it relied on, *inter alia*, its “GUCCI” registration in Class 21 (for porcelain and ceramic articles; drinking glasses and glass flasks). The learned IP Adjudicator found the goods to be similar. In so doing, he stressed that the word “similar” is not a synonym for “competing” or “substitutable”. It was, in his view, broader than that: see analysis at [41] – [44] of the decision.

²¹ Following the High Court’s approach in *Han’s (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 at [137].

²² In respect of “Wine; alcoholic beverages of fruit; western liquors (in general)”.

- [Guccio Gucci S.p.A v Guccitech Industries \(Private Ltd\)](#) [2018] SGIPOS 1

Consider also the “NEWYORKER” case (full citation below) where the Hearing Officer found that the goods covered under the earlier trade mark (*inter alia*, “clothing”) to be similar to the services for which the application mark was sought to be registered (*inter alia*, “retail services with regard to clothing”).

- [Daidoh Limited v New Yorker S.H.K. Jeans GmbH & Co. KG](#) [2018] SGIPOS 18

8.6 Relevance of the price of the goods

General principles

In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; [2013] SGCA 65, the Court of Appeal ruled that under Section 8(2)(b), factors which are external to the marks and to the goods in question, and which are susceptible to changes that can be made by a trader from time to time, such as price differentials between the parties’ goods, cannot be taken into account.

However, the *normal price* of the goods can be taken into account in the assessment of the impact of goods-similarity on consumer perception (which impacts on the third step: the likelihood of confusion). Where the goods in question are normally expensive, the average consumer is likely to pay greater attention and care when purchasing them and this affects his ability to detect subtle differences. (See *Staywell* at [96(b)].)

Application

In the following case, the IP Adjudicator held that it would be inappropriate to consider whether the parties’ goods (here: eyewear) were in fact expensive or inexpensive items. Instead, the reference point should be the normal or average price of eyewear as a type or category of goods.

- [The Polo/Lauren Company, L.P. v United States Polo Association](#) [2015] SGIPOS 10²³ at [107] - [108]

The IP Adjudicator also considered that it would not be necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise is to determine the degree of care that the average consumer is likely to pay when purchasing that type of goods. In this exercise, there may be factors other than price which are more useful.

8.7 Family of marks

In the ‘[Relative Grounds for Refusal of Registration](#)’ component of the IPOS Trade Marks Registry’s Trade Mark Work Manual (Version 6 of February 2018), it is stated at p 39 that:

“Where a number of similar marks in the same ownership incorporate an identical element as a family of marks and another party also applies for registration of a mark incorporating that element, the public may assume that the new mark originates from

²³ Upheld on appeal by the High Court in *Polo/Lauren Co LP v United States Polo Association* [2016] SGHC 32

the same undertaking as an addition to the family of marks and be confused or deceived if that is not the case”

Principles

Registration of a number of marks each bearing the same element in common, does not automatically give rise to the presumption that the consumer would perceive them as being a family or series of marks, such that the registered proprietor of the marks is entitled to protection of that common element.

The registered proprietor who claims additional protection of that common element will have to adduce sufficient evidence to show use of a sufficient number of these marks as to be capable of constituting a family or series of trade marks, for the purposes of the assessment of the likelihood of confusion.

The relevant audience to consider when deciding whether a family or series of marks is in existence in the marketplace is the consumer or the public. This follows from the principle that at the end of the day, the query goes towards establishing whether there is a likelihood of confusion as a result of the applicant’s use of a common element in the registered proprietor’s trade marks.

Please see:

- [Beats Electronics, LLC v LG Electronics Inc.](#) [2016] SGIPOS 8 at [32] – [34]
- [Lacoste v Carolina Herrera, Ltd](#) [2014] SGIPOS 3 at [32] – [38]

It is not necessary for trade marks to be owned by the same legal entity in order to be protected as a family of marks. It is possible for corporate family members to be regarded as a single source.

- [Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited](#) [2018] SGIPOS 5 at [33]

Can the family of marks doctrine be taken into account at the marks-similarity stage? Or, is this a consideration that should be left for the likelihood of confusion stage? It appears that the position is not settled.

- [Monster Energy Company v Glamco Co., Ltd](#) [2018] SGIPOS 7

A line of argument was canvassed that the use of a proprietor’s “family of marks” gives rise to an enhanced distinctiveness of its marks. On the facts, the “family of marks” argument used this way did not help the proprietor establish acquired distinctiveness for its descriptive mark. It cannot be the case that adding distinctive matter to a descriptive or generic word and thereby forming a composite mark that may be registered as a trade mark (as the combination is not devoid of distinctive character, exclusively descriptive and/or generic) can support an argument that the descriptive word is registrable on its own.

- [Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.](#) [2018] SGIPOS 20 at [51] – [53]

8.8 Relevance of colour to the assessment for marks similarity

Where the competing marks are both in colour, colour is a relevant consideration in assessing visual similarity. Indeed, the differences in colour may lead to a finding of dissimilarity.

- [Apptitude Pte Ltd v MGG Software Pte Ltd](#) [2016] SGIPOS 15 at [27]

However, where the application mark is depicted in black and white, colour is a neutral factor. It does not influence the marks similarity assessment either way.

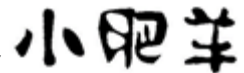
- [Starbucks Corporation d/b/a Starbucks Coffee Company v Morinaga Nyugyo Kabushiki Kaisha \(Morinaga Milk Industry Co., Ltd\)](#) [2017] SGIPOS 18 at [37].

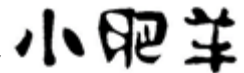
Similarly, where the application mark is in colour and the earlier mark is in black and white, the colour of the application mark is also irrelevant.

- [Fox Head, Inc. v Fox Street Wear Pte Ltd](#) [2018] SGIPOS 8 at [56]

8.9 Whether a mark registered in Chinese characters is similar to its transliteration

In the highly unusual case of “XIAO FEI YANG” (full citation below), Inner Mongolia Little Sheep Catering Chain Co succeeded in invalidating the Grassland Xiao Fei Yang Pte Ltd’s trade mark “XIAO FEI YANG” in Class 43 (for restaurant services) on grounds of bad faith. Although the decision on bad faith made it unnecessary to deal with the other issues in dispute, the Hearing Officer made a number of observations on the issue of



whether an earlier trade mark registered in Chinese characters () is similar to a later trade mark that is essentially its transliteration (XIAO FEI YANG). It appears that this tribunal has not previously considered this issue. An outline of the Hearing Officer’s observations is set out below.

- On visual similarity: Chinese characters are by nature different from letters in the English alphabet. Naturally it follows that in almost all cases the competing marks would be found to be visually dissimilar. So too in this case. If it had been necessary to decide the issue, the marks would have been found to be visually dissimilar. However, the mere fact that Chinese characters are different from their transliteration does not, without more, bar a finding of similarity of marks. This is because one must also take into account the aural and conceptual similarities.
- On aural similarity: The whole purpose of transliteration is to enable, with some degree of aural precision, words in one language to be represented in another. In this case the marks could be considered aurally similar to a significant degree.
- On conceptual similarity: In this case, there would be a slight degree of conceptual similarity in that both of them point to the same meaning, which is little fat sheep. However, everything turns on the specific context and in particular the words and characters at issue (and so it follows that the position may be different where there are other characters involved).

- [Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd.](#) [2018] SGIPOS 6

(9) Evidence relating to copyright

Subsistence of copyright: evidence

An opponent seeking to rely on copyright as a ground of opposition (under Section 8(7)(b) TMA) must show that copyright subsists in the claimed work.

A copyright certificate from another jurisdiction, without more, is insufficient to establish subsistence of copyright.

- [Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd](#) [2014] SGIPOS 10 at [238] – [243]²⁴
- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [110] – [123]

Note: The High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 has held that the presumptions relating to subsistence and ownership of copyright in Section 130 of the Copyright Act (Cap. 63) are a relevant factor to be taken into account in considering an opposition under Section 8(7)(b) TMA.²⁵

(10) Evidence relating to trade mark use

Observation

The concept of ‘trade mark use’ arises not infrequently in trade mark disputes before IPOS.

The issue of whether a trade mark has been used, and if so, the nature and extent of its use, may be relevant to one or more of the following. (The list is non-exhaustive.)

- Non-use revocation (under Section 22(1)(a) and/or (b) TMA) and in particular the issue of whether there has been genuine use of a trade mark, in the course of trade, in respect of the goods or services for which it is registered.
- Whether a trade mark has, in consequence of the use which has been made of it, acquired a distinctive character in relation to the goods or services for which it is registered (which may be relevant to cases involving Section 7(2) and/or 23(2) TMA).
- Whether a trade mark is well known in Singapore (see: Section 2(7)(b) TMA²⁶).

²⁴ On appeal, George Wei J agreed with this specific point, stating that “*the mere fact that copyright has been claimed and registered for [the works in question] in the USA and China does not mean that copyright does in fact and law subsist [in the said works] in Singapore*”. However, His Honour went to add that: “*While copyright registration certificates from other jurisdictions may have persuasive value if evidence is adduced on the process undertaking to obtain such registration, the issue at hand is ultimately whether [the opponent] will be able to establish that it owns copyright [in the works] in Singapore in notional copyright infringement proceedings*”: see [2015] SGHC 216 at [235].

²⁵ See in particular [223]. This was an appeal from the decision of the Hearing Officer in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2014] SGIPOS 10.

²⁶ Section 2(7)(b) provides that in deciding whether a trade mark is well known in Singapore, one relevant factor that may be taken into account is: “*the duration, extent and geographical area of – (i) any use of the trade mark; or*

In certain cases, a trader may enjoy commercial success under a trade mark to such a degree that others may use the trade mark to refer to a characteristic of the goods (or in some other descriptive sense). Whether this has an impact on the issue of trade mark use will depend on the evidence.²⁷

In the following case, an issue arose as to the requisite nexus between Singapore and the evidence of use required to defeat a non-use revocation action. Specifically, must the evidence show that the mark was applied to goods that were advertised and sold to consumers in Singapore? Or is it sufficient to show evidence of *entrepôt* trade conducted under the mark in question, never mind the issue of whether the goods were exposed to consumers in Singapore? Although the Hearing Officer was not required to decide an issue, he set out the arguments on both sides and proffered some observations.

- [FMTM Distribution Ltd v. Tan Jee Liang Trading as Yong Yew Trading Company](#) [2017] SGIPOS 9 at [137] – [151]

10.1 Distinction drawn between use in relation to goods as opposed to services

In the following non-use revocation case, the subject trade marks were registered for “Retail services, including retail of automotive parts”. The proprietor of the impugned marks argued that the actual supply of goods, listed on its website, to a Singapore delivery address, meant that retail services had been provided. The Hearing Officer did not accept this argument, and held that the fact that goods were ordered and delivered in Singapore did not equate to retail services being provided in Singapore. (On the facts, the action for non-use revocation succeeded.)

- [Autozone Automotive Enterprise v Autozone Parts, Inc.](#) [2013] SGIPOS 1 at [37] – [49]

10.2 Trade marks on the internet

As a general rule, the mere existence of a domain name (e.g. where the trade mark in question is a word mark used as part of a domain name) or a website featuring a trade mark does not, without more, translate into worldwide recognition.²⁸

A website, in and of itself, is irrelevant to the consideration of whether the mark is well known in Singapore as websites, unless blocked by governments, are inevitably accessible by Internet users.

- [Alphasonics \(Pte\) Ltd v Alphasonics \(Ultra Cleaning Systems\) Ltd](#) [2013] SGIPOS 6 at [35(h)]

Equally, it is not enough to simply place a mark on the internet and then argue that the requirement of use is satisfied when someone within Singapore downloads it.

(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”.

²⁷ See *FMTM Distribution v Van Cleef & Arpels* [2017] SGIPOS 6, where the applicant for non-use revocation argued that “MYSTERY SET” was descriptive of a certain technique of gem setting in the context of jewellery rather than an indicator of origin.

²⁸ *Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 at [52] – [54].

To satisfy the requirement of proving trade mark use, it must be shown that there was an 'active step' (e.g. through direct encouragement or advertisement) by the proprietor in Singapore which led the consumers to the website featuring the trade mark in question.²⁹

The above principles have been applied in cases such as the following.

- [Autozone Automotive Enterprise v Autozone Parts, Inc.](#) [2013] SGIPOS 1 at [47] – [53]
- [Romanson Co. Ltd. v Festina Lotus, S.A.](#) [2015] SGIPOS 3³⁰ at [81] – [93] and [107]

In a non-use revocation action under Section 22(1)(a) and/or (b) TMA, the Registrar may recognise online, post-sale support in the form of upgrades and updates of computer software as evidence of use in relation to computer software, independently of any new sales of the computer software. However, the application of this would turn on the unique facts of each case.

- [Bigfoot Internet Ventures Pte. Ltd. v Apple Inc.](#) [2017] SGIPOS 4 at [37]

In defending non-use revocation actions, proprietors should ensure that their evidence of use adduced falls within the relevant 5-year period. In the case of internet printouts, the date of the document usually reflected is the date of printing, which post-dates the relevant 5-year period. One useful tool is the Wayback Machine (wayback.com), a digital archive which enables users to see archived versions of webpages over time.

- [Bigfoot Internet Ventures Pte. Ltd. v Athleta \(ITM\) Inc.](#) [2018] SGIPOS 10 at [30]

It is not tenable to claim that, just because a website's url, e.g. <http://athleta.gap.com>, has been stated in evidence, and specific printouts from the same website have been adduced in evidence, the website *as a whole* had therefore been adduced in evidence. If a party desires to rely on specific content on a webpage from a website, it has to adduce that very webpage in evidence. In this case, the proprietors sought to address a gap in evidence in response to the applicants' argument that there was no evidence of use relating to "footwear", not by seeking leave to file further evidence, but by appending website printouts to their reply submissions and claiming that this was acceptable as their website as a whole had already been adduced in evidence.

- [Bigfoot Internet Ventures Pte. Ltd. v Athleta \(ITM\) Inc.](#) [2018] SGIPOS 10 at [32]

10.3 Arriving at a fair specification

In a non-use revocation action under Section 22(1)(a) and/or (b) TMA, the Registrar will first decide whether the subject mark has been put to genuine use in relation to the goods/services for which it is registered. After reaching a conclusion on that point, if the finding is that there has been use in respect of some but not all of the goods/services, the Registrar will then go on to decide what constitutes a fair specification for the use made. In so doing, the Registrar must consider how the average consumer would likely describe the goods. This also means that the specification does not need to be limited

²⁹ *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [106] – [108].

³⁰ The unsuccessful party appealed to the High Court, but the appeal was not contested. In the result, the Registrar's decision was reversed. The High Court's written grounds of decision are not available.

to the precise goods that the mark has been used for, but should also extend to those which the average consumer considers as belonging to the same subcategory.

- [Audi AG v Lim Ching Kwang](#) [2017] SGIPOS 2 at [17], [44] and [45]

For a case involving the application of the above principles and where partial revocation was ordered after an assessment of what constitutes a fair specification, please see:

- [New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited](#) [2017] SGIPOS 16 at [53] – [71]

(11) Evidence required to prove that a mark is well known to the public at large

Observation

A claim that a mark is well known to the public at large must be supported by the evidence. To date, very few marks have crossed this threshold.

In the two cases below, the Hearing Officer found that the subject mark in question was well known to the public at large. These cases are illustrative of the type, nature, and extent of the evidence required to support such a claim.

- SEIKO (see [Seiko Holdings Kabushiki Kaisha \(trading as Seiko Holdings Corporation\) v Choice Fortune Holdings Limited](#) [2014] SGIPOS 8)

It is interesting to note that in an earlier decision (see [2011] SGIPOS 3), it was found, on the basis of the evidence in that case, that SEIKO was not well known to the public at large. However, in this case, the Hearing Officer was prepared, on the evidence, to make such a finding (see [107]).

- INTEL (see [Intel Corporation v Intelsteer Pte Ltd](#) [2015] SGIPOS 2)

In this case, the Hearing Officer found that the INTEL mark was well known to the public at large. In arriving at that conclusion, the Hearing Officer was mindful that a mark must be recognised by most sectors of the public (i.e. it is not enough to show that a mark is well known to a certain sector of the public). However, given that in this day and age a computer is an indispensable tool in both the business world as well as the normal household, it would be hard to miss INTEL, which is one of the largest makers of computer microprocessors (see [147]).

For a more recent example of a case where the earlier trade mark was found to be well known to the public at large, see:

- GUCCI ([Guccio Gucci S.p.A v Guccitech Industries \(Private Ltd\)](#) [2018] SGIPOS 1)

(12) Evidence concerning the state of the Register

Observation

At times, a party entreats the Registrar to take the state of the Trade Marks Register into consideration in the assessment of whether a certain mark is registrable. Usually the argument goes like this: if XX trade mark has been registered for certain goods or services; YY trade mark (bearing similar characteristics) for identical or similar goods or services should likewise be registrable.

In the following *ex parte* application, the Hearing Officer declined to take into account the state of the Register and considered the “*registrations of various vintage*” cited to her as being not of assistance. In so doing, the Hearing Officer restated the long-standing principle that “*although conformity of the register is desirable, registry decisions in the past can do no more than give an indication of what has or has not been acceptable, and the registrability of a mark has to be considered on the facts of each case and in particular the goods or services in respect of which registration is sought*”.

- [In the matter of a trade mark application by Marvelous AQL Inc.](#) [2017] SGIPOS 3³¹ at [44] – [46]³²

(13) Honest concurrent use

Can an opponent rely on an earlier trade mark secured on the basis of honest concurrent use with the applicant’s other trade marks?

Yes. See:

- [Fox Racing, Inc. v Fox Street Wear Pte Ltd](#) [2014] SGIPOS 13 at [55] – [59]

See also:

- [Fox Head, Inc. v Fox Street Wear Pte Ltd](#) [2018] SGIPOS 8

(14) Effect of disclaimers

Do disclaimers apply to registration / opposition proceedings?

Yes, disclaimers apply not only to infringement proceedings but also to opposition proceedings.

- [Christie Manson & Woods Limited v Chritrs Auction Pte. Ltd](#) [2016] SGIPOS 1 at [62]

In the following case, a disclaimer was entered shortly after the pre-hearing review. The Hearing Officer noted, among other things, that Section 30 TMA suggests that it is possible to request for a disclaimer at any stage of the registration process.

³¹ Note: the decision was affirmed on appeal by the High Court.

³² Citing *Kudos Trade Mark* [1995] RPC 242 at 245 and *British Sugar PLC v James Robertson & Sons Ltd.* [1996] RPC 281 at 305.

- [Consolidated Artists B.V. v THEFACESHOP Co. Ltd.](#) [2017] SGIPOS 7

(15) Survey evidence

Observation

Market survey evidence can be of assistance to the Court or Tribunal in a trade mark dispute. However, it is important that the survey is structured carefully. For guidance on structuring surveys, see, for example, *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 and *Société des Produits Nestlé SA and anor v Petra Foods Ltd and anor* [2014] SGHC 252.

In the following case heard at IPOS, market survey evidence was tendered by the trade mark proprietor defending a trade mark invalidation action with a view to: (1) showing that the registered mark, BIG BOX, was not generic (in the sense of being customary in the current language in Singapore to designate a large retail establishment); and (2) establishing that *even if* BIG BOX was generic at the relevant date it had acquired distinctiveness through use.

- [Courts \(Singapore\) Pte Ltd v Big Box Corporation Pte Ltd](#) [2017] SGIPOS 5³³


Given the IP Adjudicator's conclusion in BIG BOX (i.e. that the invalidation attack based on Sections 7(1)(b), (c) and (d) TMA failed), nothing ultimately turned on the market survey evidence.

Nevertheless, the IP Adjudicator expressed the concern that parties to such proceedings at IPOS may spend large sums on adducing evidence that is of little or no probative value. He cautioned that while there remains a role for market survey evidence if that is the only sufficient evidence that can be obtained, very careful consideration needs to be given to the form of the questions and the process for administering them, and recording accurately and fully the responses, so as to ensure that the evidence goes to the factual questions in support of which it is intended it be adduced.

(16) Marks in a language other than English

Observation

Given Singapore's multi-racial and multi-lingual population, it is not uncommon for traders to file for trade marks that are (or contain elements) in a language other than English.

One such example (a case in which  was invalidated on the basis that it had been registered in bad faith) is discussed at point 8.9 above under the heading "Whether a mark registered in Chinese characters is similar to its transliteration".

³³ Note: the decision was upheld by the High Court.

For another case involving a trade mark with elements in Chinese characters, see the decision below, which involved the  **PARK REGIS** 柏·伟诗酒店 mark (the Chinese characters read: “柏·伟诗酒店”, which may be transliterated as “*Bai Wei Shi Jiu Dian*”).

- [*Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Ltd*](#) [2018] SGIPOS 11³⁴

[End of Document]

³⁴ Note: the decision has been appealed to the High Court.

ANNEX A: CHANGE LOG

Note: Where available, clicking a link below should redirect you to the relevant portion of the Case Guide that was added during the update.

- 17 January 2017: Publication of 1st Edition of Case Guide.
- 26 January 2017: Fixed some typographical errors and incorrect references.
- 28 June 2017: Added new cases, commentary, and a new category: 'Survey evidence'
 - *In the matter of a trade mark application by Marvelous AQL Inc.* [2017] SGIPOS 3
 - *Bigfoot Internet Ventures Pte. Ltd. v Apple Inc.* [2017] SGIPOS 4
 - *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2017] SGIPOS 5
 - *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30
- January 2018: Added the following new categories, with commentary: 'The importance of preparing evidence by reference to the grounds in dispute'; 'Effective date of revocation for non-use'; 'Documents used to challenge witness testimony during cross-examination'; 'Deceptive trade marks'; and 'Relevance of colour to the assessment for marks similarity'. Also added the following new cases.
 - *FMTM Distribution v Van Cleef & Arpels* [2017] SGIPOS 6
 - *Consolidated Artists B.V. v THEFACESHOP Co. Ltd.* [2017] SGIPOS 7
 - *Louis Dreyfus Commodities MEA Trading DMCC v Orco International (S) Pte Ltd* [2017] SGIPOS 8
 - *FMTM Distribution Ltd v. Tan Jee Liang Trading as Yong Yew Trading Company* [2017] SGIPOS 9
 - *U-Manga International Business Co., Ltd. v Nunufish.com* [2017] SGIPOS 11
 - *Monster Energy Company v Mixi, Inc.* [2017] SGIPOS 12
 - *New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited* [2017] SGIPOS 16
 - *Starbucks Corporation d/b/a Starbucks Coffee Company v Morinaga Nyugyo Kabushiki Kaisha (Morinaga Milk Industry Co., Ltd)* [2017] SGIPOS 18
- 26 April 2018: Deleted category 'Whether certain goods can be similar to certain services?'
- 9 July 2018: Added new commentary as well as the following new categories: 'Costs in partial revocation cases'; 'Whether a mark registered in Chinese characters is similar to its transliteration'. Also added the following new cases.
 - *Guccio Gucci S.p.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1
 - *USA Pro IP Limited v Montfort Services Sdn. Bhd.* [2018] SGIPOS 3
 - *Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd.* [2018] SGIPOS 6
 - *Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5 at [33]
 - *Monster Energy Company v Glamco Co., Ltd* [2018] SGIPOS 7
 - *Fox Head, Inc. v Fox Street Wear Pte Ltd* [2018] SGIPOS 8
 - *Monster Energy Company v Tencent Holdings Limited* [2018] SGIPOS 9
 - *Bigfoot Internet Ventures Pte. Ltd. v Athleta (ITM) Inc.* [2018] SGIPOS 10
- 22 January 2019: Added new commentary, categories, and references to the following cases.
 - *Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Ltd* [2018] SGIPOS 11
 - *Adidas International Marketing BV v Lutong Enterprise Corp.* [2018] SGIPOS 12
 - *Apple Inc. v Swatch AG (Swatch SA) (Swatch Ltd.)* [2018] SGIPOS 15
 - *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16
 - *Daidoh Limited v New Yorker S.H.K. Jeans GmbH & Co. KG* [2018] SGIPOS 18
 - *United U-Li Projects Pte Ltd v Tan Buck Hai* [2018] SGIPOS 19
 - *Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.* [2018] SGIPOS 20
 - *Bitwave Pte Ltd v Fung Shing Company Limited* [2018] SGIPOS 21