

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

Trade Mark No. T1403091B
Hearing Date: 11 October 2016

**IN THE MATTER OF TRADE MARK APPLICATION BY
MGG SOFTWARE PTE LTD**

AND

**OPPOSITION THERETO BY
APPTITUDE PTE LTD**

Hearing Officer: Mark Lim Fung Chian
Principal Assistant Registrar of Trade Marks

Mr Michael Loh and Ms Estelle Moh (Clifford Law LLP) for the Applicant
Ms Vicki Heng (Vicki Heng Law Corporation) for the Opponent

Cur Adv Vult

GROUND OF DECISION

1 This is an opposition to the registration of the following trade mark:

Trade Mark Applied For	Class / Goods or Services
 <p>App. No. T1403091B (the “Application Mark”)</p> <p>Application Date: 3 March 2014</p>	<p><u>Class 09</u> Communication software; communications processing computer software; communications systems; computer software; computer software (programs); computer software for communicating purposes between microcomputers; data communications software; programs for use in communications.</p> <p><u>Class 38</u> Cellular communications services; computer communications for the transmission of information; mobile telephone communication services.</p>

2 On 3 March 2014, the Applicant applied to protect the Application Mark in Classes 9 and 38. On 10 October 2014, the Opponent opposed the registration of the Application Mark by filing its Notice and Grounds of Opposition. Subsequently, the Opponent amended its Grounds of Opposition to correct a typographical error with the leave of the Registrar, and filed its amended Grounds of Opposition on 5 December 2014.¹ On 7 January 2015, the Applicant filed its Counter-Statement. Although the Counter-Statement was filed out of time, the Applicant sought and was granted leave for the late filing (see: *Application for Acceptance of Late Counter-Statement in a Trade Mark Application by MGG Software Pte Ltd and Objection Thereto by Apptitude Pte Ltd* [2015] SGIPOS 8).

3 Both parties filed evidence by way of Statutory Declarations (“SD(s)”).

(a) On 21 October 2015, the Opponent filed the SD of Mr Allen Poon Hoe Yien (dated 20 October 2015) (“**Poon’s First SD**”). Mr Poon is a director of the Opponent, and has held that position since the Opponent’s incorporation in Singapore on 16 July 2012.

(b) On 5 February 2016, the Applicant filed 3 SDs.

i. First, the SD of Mr Tan Wee Chong dated 5 February 2016 (“**Tan’s SD**”). Mr Tan is a director of the Applicant, and has held that position since the Applicant’s incorporation in Singapore on 14 June 2005.

ii. Second, the SD of Ms Wang Lingqin dated 5 February 2016 (“**Wang’s SD**”). Ms Wang is (and has been since August 2014) an employee of MGG Mobileapps Pte Ltd, a sister company to the Applicant. Prior to that, Ms Wang was employed by the Applicant and worked as an employee from March 2013.

iii. Third, the SD of Ms Lee Xiang Ling, Abigail dated 5 February 2016 (“**Lee’s SD**”). Ms Lee was involved in the development of the Applicant’s “snaapp” software application, and was tasked to register “snaapp” as a trade mark.²

(c) On 5 May 2016, the Opponent filed its evidence in reply: the second SD of Mr Poon dated 5 May 2016 (“**Poon’s Second SD**”).

4 A pre-hearing review was held on 26 May 2016 and the matter was set down for a full hearing on 11 October 2016. The parties were directed to file their written submissions by 22 August 2016. As directed, the Applicant filed its written submissions by the stipulated date. However, the Opponent was unable to meet the deadline and requested for a 3 week extension of the deadline. The Applicant consented to a 2 week extension. As such, the Opponent was directed to file its written submissions within 2 weeks *i.e.* by 6 September 2016. It did so.

5 On 4 October 2016, I directed parties to address certain specific issues at the hearing and they did so orally and by way of brief supplementary written submissions. Both parties were represented by counsel during the oral hearing.

¹ In this decision all references to the Grounds of Opposition are to the amended version.

² Lee’s SD at [4].

Grounds of Opposition

6 The Opponent relies on Sections 8(2)(b), 8(7)(a), and 7(6) of the Trade Marks Act (Cap. 332, Rev. Ed. 2005) (“**the Act**”). For convenience I refer to these grounds as ‘conflict with an earlier trade mark’ (Section 8(2)(b)), ‘passing off’ (Section 8(7)(a)), and ‘bad faith’ (Section 7(6)).

Relevant Date

7 The date on which the parties’ rights are to be assessed in these proceedings (*i.e.* the relevant date) is the application date: 3 March 2014.

Background

8 I briefly summarise the parties’ evidence to the extent necessary to flesh out the background to this dispute.

The Opponent

9 The Opponent was incorporated in Singapore on 16 July 2012. Mr Poon described the Opponent as a “*solutions provider focused on providing its customers with technology-driven means for effective communication*”.³ In essence, the Opponent is a company which markets and sells mobile applications (or “**app(s)**” for short) with a focus on communications solutions.

10 The Opponent is the proprietor of the following trade mark, which is registered in Classes 9, 38, 41 and 42.⁴

Registered Trade Mark	Class / Goods or Services
 TM No. T1315042F (the “ SNAC Mark ”) Registration Date: 30 September 2013	<u>Class 09</u> Communication software; communications processing computer software; communications systems; computer software; computer software (programs); computer software for communicating purposes between microcomputers; data communications software; programs for use in communications. <u>Class 38</u> Cellular communications services; computer communications for the transmission of information; mobile telephone communication services.

11 There is evidence that “SNAC” in plain block letters was first used in marketing by the Opponent in or around July 2012,⁵ although the app itself was officially launched on 5

³ Poon’s First SD at [2].

⁴ The services in classes 41 and 42 have been omitted from the table because they are not material to this dispute, given the identity between the respective parties’ goods and services in classes 9 and 38.

⁵ Poon’s Second SD at pp 20 and 21.

December 2012 “in all major mobile stores”.⁶ The SNAC Mark was and is used in relation to the Opponent’s software product, or app, known as SNAC. SNAC is short for the “School Notification Acknowledgement Console”, later renamed in April 2013 to “Smart Notification Acknowledgement Console”. SNAC is a mobile app that notifies parents of “*ongoings in their children’s schools*” and also serves as “*a communication tool between schools and parents*”.⁷ SNAC is available on iOS (Apple Store) and Android (Google Play).⁸ When a school signs up with the Opponent, parents of the children attending the school are notified of the arrangement, and are given directions to download the Opponent’s SNAC app either via the Apple Store or the Google Play store.⁹

12 As regards marketing and promotion, Mr Poon’s evidence is that the SNAC app was primarily advertised and promoted through the internet and print media,¹⁰ and that EDM (which I understand to mean email or electronic direct marketing) was sent via email on various dates to, *inter alia*, all schools in Singapore registered with the Ministry of Education.¹¹ The Opponent’s representatives visited “*over 260 schools in Singapore*” to market the SNAC app,¹² and approximately S\$10,000 per fiscal year (FY) was spent on advertising and promotion in FY 2012/2013 and in FY 2013/2014.¹³

13 A total of 45 schools (from the first contract in January 2013 to last count in June 2015) signed up with the Opponent for the use of the SNAC app.¹⁴ If I exclude those schools which signed up *on or after* March 2014,¹⁵ as at the relevant date, the Opponent secured a total of 21 contracts for the SNAC app. The annual sales volume of the SNAC app in FY 2012/2013 was S\$12,000 and in FY 2013/2014 the number grew to S\$57,000.¹⁶

The Applicant

14 The Applicant was incorporated in Singapore on 14 June 2005 and is in the business of, among other things, coding and developing software apps for use on mobile devices. The Applicant’s apps are managed, marketed and sold by a separate ‘sister’ company, MGG Mobileapps Pte Ltd.¹⁷

15 Mr Tan took pains to emphasise that the Applicant is “*not a company which just sprung out of nowhere*”,¹⁸ and I find this to be borne out by the documentary evidence. The clients for whom the Applicant has developed apps include: EZ-Link (app: My EZ-Link Mobile, which allows users to ‘top-up’ their EZ-Link cards using an NFC-enabled Android phone) and Lee Kong Chian Natural History Museum (app: App-ollonia, which allows visitors of the museum to hunt for virtual dinosaur bones to unlock an augmented reality dinosaur animation).¹⁹

⁶ Poon’s First SD at p 21.

⁷ Poon’s First SD at [14].

⁸ Poon’s First SD at [17] and at Tab 2, pp 21 to 28.

⁹ Poon’s First SD at [17].

¹⁰ Poon’s First SD at [36].

¹¹ Poon’s First SD at [15] and at Tab 4.

¹² Poon’s First SD at [16].

¹³ Poon’s First SD at [35].

¹⁴ Poon’s First SD at [18].

¹⁵ That is, before the relevant date of 3 March 2014.

¹⁶ Poon’s First SD at [33].

¹⁷ Tan’s SD at [11].

¹⁸ Tan’s SD at [9].

¹⁹ Tan’s SD at [12(c)].

16 The Applicant also developed “snaapp”, which according to Mr Tan is an acronym for “school notification & attendance app”²⁰; this name is also included in the Application Mark. Snaapp has several functions. I will briefly mention the two main features of snaapp. First, teachers can use snaapp to take the attendance of students, and this information is sent directly to an electronic database.²¹ Second, snaapp can be used by teachers to communicate directly with parents without revealing their mobile numbers.²²

17 As regards the date of first use of snaapp, I was referred to an email dated 30 April 2012 for the “School Attendance System”. However, the acronym snaapp was not used in that email. The first recorded use of snaapp was in an email dated 24 July 2012 in which it was stated that one could do a search “*for snaapp*” on the Google Play Store and download it.²³ (For completeness, snaapp is also available on Apple iTunes.)

18 According to Mr Tan, due to the nature of its clientele (primarily schools and educational institutions), the Applicant does not engage in newspaper or public advertising.²⁴ One way that the Applicant goes about promoting its snaapp app is through cold calls, and this is a task which Ms Wang undertook.²⁵ In any case, by November 2015, 101 out of 363 schools in Singapore had signed up with snaapp.²⁶ If I exclude those schools which signed up *on or after* March 2014, that leaves a total of 10 schools which signed up with the Applicant’s snaapp prior to the relevant date.

MAIN DECISION

Opposition under Section 8(2)(b): conflict with an earlier trade mark

19 Section 8(2)(b) provides that:

8.

(2) A trade mark shall not be registered ***if because*** —

(a) ...

(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.

(emphasis added)

20 The term “*earlier trade mark*” is defined in Section 2(1) and includes “*a registered trade mark... the application date of which was made earlier than the trade mark in question*”. For the purposes of the opposition under Section 8(2)(b), the Opponent is relying on the SNAC Mark (see [10] above) as its “*earlier trade mark*”.

21 The law in relation to Section 8(2)(b) is well-established: the leading case is the Court of Appeal’s decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”). In *Staywell* the court reaffirmed the “*step-by-step*” approach which may be summarised as follows. The first element is to assess whether the respective

²⁰ Tan’s SD at [3(b)].

²¹ Tan’s SD at [69].

²² Tan’s SD at [70].

²³ Tan’s SD at MGG-9, p 93.

²⁴ Tan’s SD at [59] and [60].

²⁵ Wang’s SD at [3].

²⁶ Tan’s SD at [85].

marks are similar. The second element is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected. The third element is to consider whether there exists a likelihood of confusion arising from (or to use the words of the section: *because of*) the two similarities. The court made it clear that “*the first two elements are assessed individually before the final element which is assessed in the round*” (*Staywell* at [15]). If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

Whether the marks are similar

22 In assessing the marks for similarity I have taken the following principles into account:

- (a) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. (*Staywell* at [20].)
- (b) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression. (*Staywell* at [17] – [18].)
- (c) At the marks-similarity stage, I do not consider the relative weight and importance of each aspect of similarity having regard to the goods or services, because that is a matter for the confusion stage of the inquiry. (*Staywell* at [20].)
- (d) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side and examined in detail because the person who is confused often makes comparison from memory removed in time and space from the marks. (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [62(a)]). That said, the court or tribunal is entitled to have special regard to the distinctive or dominant components of a mark, even while it assesses the similarity of the two marks as composite wholes, since those (distinctive or dominant components) tend to stand out in the consumer’s imperfect recollection. (*Staywell* at [23].)

The visual aspect

Colour

23 An important feature of this case is that both parties’ respective marks are in colour. Prior to the hearing, I directed parties to address me on the extent to which colour should be taken into account in the assessment.

24 The Opponent pointed out that the respective marks are not subject to a colour limitation,²⁷ and therefore the colours of the marks should be treated merely as a feature of the marks (along with font and typeface).²⁸ The Opponent also submitted that the colours of the marks would be pertinent in the determination of visual similarity.²⁹ The Applicant’s starting point is no different in essence: it contended that colour (including the number of colours, their brightness and hue, tone, and the overall impression given) should be given its due and proper consideration in the assessment.³⁰

25 I agree that colour is a relevant consideration which I should take into account in considering visual similarity. In *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at [84], the Court of Appeal took colour into account when comparing the competing marks:

“... Although there was some similarity between the two marks, there were significant differences between them in terms of font, capitalisation and **colour**. In particular, even the strongest similarity – the **red** letter “O” – was capitalised and designed in an artistic manner by the respondent, which was plainly different from the regular font used by MOBIL...”

(emphasis added)

26 The extent to which colours play a role would vary depending on each case and their impact on the eye of the average consumer. In *Hedgefund Intelligence Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-67/08)

(“*Hedgefund Intelligence*”), the mark applied for was: , for which the colour violet (Pantone 527) was claimed. The opponent relied on the following mark:



. In arriving at the conclusion that the marks were visually similar, the Court of First Instance found, *inter alia*, that the colour was “*insignificant inasmuch as the attention of the public is attracted to the verbal elements*” (at [36]). (*Hedgefund Intelligence* is also discussed in some detail in *Hai Tong* at [63(a)].)

27 In this case, however, colours play a much larger role. The Applicant argued that when the marks are compared, the colours serve to distinguish the respective marks from each other. I agree. Each of the letters in the SNAC Mark are in very different colours (to my eye: “S” is bright red, “N” is in orange, “A” in light green and “C” in turquoise). On the other hand, the first three letters in Application Mark appear to be in different shades of blue (from dark to light to lighter still) and the last three letters are in maroon. For convenience, I again reproduce the respective marks below.

²⁷ A mark that is subject to a colour limitation on the form of the application or registration is one in which rights are claimed to the specific colour(s) only. The proprietor or applicant is essentially accepting that it has no rights in respect of the use of the same (or similar) sign in other colours.

²⁸ Opponent’s Supplementary Written Submissions at [2] – [3].

²⁹ Opponent’s Supplementary Written Submissions at [5].

³⁰ Applicant’s Answers to Questions by IPOS at [1].

**Earlier Trade Mark
(SNAC Mark)**



Application Mark



Based on visual impression alone, the colours in the respective marks are very different. This points towards the conclusion that, viewed through the lens of imperfect recollection, consumers would consider the marks to be different.

The words “SCHOOL NOTIFICATION & ATTENDANCE APP”

28 The Application Mark contains a phrase located below the “snaapp” component. It reads: “SCHOOL NOTIFICATION & ATTENDANCE APP”. This phrase appears in a smaller font as compared to the “snaapp” component which is much bigger in font size.

29 The Opponent submits that the words “SCHOOL NOTIFICATION & ATTENDANCE APP” would have “*limited visual impact*”. I was referred by the Opponent to the High Court’s decision in *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 (“*Audience Motivation*”). In that case, the defendant’s trade mark had the slogan “*to create, entertain and inspire*”. The High Court found that the words of the slogan were “*in very small font and would not be as prominent*”, and would thus have had “*limited visual impact on the consumers*” (at [36]).³¹ A representation of the mark in question is as follows:



30 I agree with the Opponent’s submission that the words “SCHOOL NOTIFICATION & ATTENDANCE APP” in the Application Mark, just like the words “*to create, entertain and inspire*” in the *Audience Motivation* case, are small in size, not very eye catching, and would have limited visual impact. Therefore, “SCHOOL NOTIFICATION & ATTENDANCE APP” should play at most a minor role in the visual comparison (although I cannot disregard it completely because I have to consider the marks as wholes). I return to this point later at [34(d)] below.

Comparing the marks visually

31 It was argued by the Opponent that the word app refers to “*an application, typically a small, specialised program downloaded onto mobile devices*” and that I should discount the app component of the Applicant’s Mark because of the descriptive and non-distinctive nature of the word app.³² (Although it is not entirely clear, I assume that by this the Opponent is arguing that I should disregard the last three letters in the word “snaapp” and not merely the word app in the phrase “SCHOOL NOTIFICATION & ATTENDANCE APP”.)

³¹ Although the decision was reversed by the Court of Appeal on different grounds, the High Court’s conclusion that there was *prima facie* trade mark infringement was upheld, and the findings of fact relating to the limited visual impact of the slogan were not disturbed.

³² Opponent’s Written Submissions at [20].

32 However, I cannot simply dissect snaapp (which appears as one word in the Application Mark) into two arbitrary parts (“sna” and “app”) and then proceed to discard the latter. The marks have to be assessed as wholes. The 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 my analysis. Visually, one would still see “snaapp” and not “sna app”.

33 The Opponent submitted that first three letters of the SNAC Mark and the first three letters of the dominant component of the Application Mark are identical inasmuch as they both contain “S-N-A”. The Opponent also argued that both marks are similar in that they are each represented in 4 colours each.³³ The Applicant, on the other hand, argued that the marks are very different visually, and proceeded to point me towards each of the differences between the marks.

34 I find that the marks are visually substantially dissimilar as a whole, notwithstanding that both marks share the letter string “SNA” / “sna”. My reasons are as follows.

- (a) The letters “S-N-A-C” in the Opponent’s SNAC Mark are each of equal size and are each represented by a different colour. Visually, each and every letter in the mark is equal importance. “SNAC” is an invented word, and the distinctive character of the Opponent’s SNAC Mark resides in “SNAC” as a whole. I cannot simply ignore the “C” in “SNAC” and undertake the comparison on the basis of “SNA”. The overall visual impression, having regard also to the doctrine of imperfect recollection, is that the marks are substantially dissimilar.
- (b) The dominant component in the Application Mark is “snaapp”. The term “snaapp” is also not a word in the English language and, being an invented word, is inherently distinctive. As touched on briefly at [32] above, “snaapp” simply cannot be arbitrarily dissected into “sna” and “app” for the purposes of the comparison. The fact that each of the letters “s”, “n” and “a” appear in shades of blue and the subsequently letters “a”, “p” and “p” appear in the same maroon colour does not change the foregoing analysis.
- (c) Although it would be wrong (for the reasons stated above) for me to pay special attention to the letters “SNA” / “sna”, even if I were to proceed on that erroneous basis, the fact remains that “sna” is but three letters out of six in the “snaapp” component of the Application Mark. While the analysis is ultimately qualitative rather than quantitative, I note that the dominant component of the Application Mark (*i.e.* “snaapp”) contains six letters whereas “SNAC” consists of four letters. These differences point towards the conclusion that the marks are dissimilar.
- (d) As regards the words “SCHOOL NOTIFICATION & ATTENDANCE APP”, the Opponent rightly pointed out that they would have limited visual impact. However, this does not mean that their presence is to be disregarded altogether. These words contribute to the overall visual impression that the Application Mark *“has more components and is visibly more complex and longer than”* the Opponent’s SNAC Mark.³⁴

³³ Opponent’s Written Submissions at [21]. During the hearing, the Opponent explained that they viewed the different shades of blue in the letters “s”, “n” and “a” in the Application Mark as three separate colours.

³⁴ Applicant’s Written Submissions at [10].

- (e) It is true that four colours are used in the SNAC Mark and that the Application Mark also has four colours. But it is not the number of colours that is determinative. I must also consider what colours have been used and how the use of colour feeds into the overall impression on the eye of the consumer. In this case, the colours reinforce my conclusion that the marks are, as a whole, visually substantially dissimilar.

The aural aspect

35 Next, aural similarity.

36 It is clear from *Staywell* (at [23] – [33]) that in undertaking the comparison for aural similarity, there are two possible approaches that can be taken. The first approach is for the court or tribunal to have special regard to the distinctive or dominant components of the marks. The second approach which does not involve considering the dominant components is to undertake a qualitative assessment as to whether the competing marks have more syllables in common than not. (On the facts of that case the competing marks would have been pronounced as ST. REGIS and PARK REGIS and so it mattered not which approach was taken.)

37 In *Han's (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 (“*Han's*”), the plaintiff was the proprietor of two word and two composite marks depicting the word “HAN’S”. The defendant’s sign contained the word “HAN” which occupied a “*prominent position in the centre of the sign*” with the words “Cuisine of Naniwa” “*in a smaller font a subsidiary position to “HAN”*” (see *Han's* at [9]). In arriving at his conclusion that the marks were phonetically similar, George Wei JC (as he then was) found that the main phonetic component of the defendant’s sign was “HAN” and that “Cuisine of Naniwa” was subsidiary. His Honour considered it “*doubtful that the average consumer would make constant reference to the seven-syllable “HAN Cuisine of Naniwa” phrase every time he refers to it*” (see *Han's* at [137]).

38 In this case, “snaapp” is depicted in large font and occupies a prominent position in the Application Mark. The words “SCHOOL NOTIFICATION & ATTENDANCE APP” are subsidiary and it is unlikely that average consumers would use those words when referring to the Application Mark. It was undisputed (and I find) that the Application Mark should be pronounced as “snap” for the purposes of the aural comparison.

39 However, parties were strongly divided over whether the Opponent’s SNAC Mark should be pronounced as “snack” or “S-N-A-C”.

Pronouncing invented words

40 The Opponent’s case is that “SNAC” should be pronounced as “snack”. Mr Poon’s opinion is that where a word is pronounceable, it will be pronounced as it is spelt, rather than by the component letters, regardless of whether the letters are in upper or lower case. He gave the example of IPOS (Intellectual Property Office of Singapore), being commonly pronounced as “eye-pos” rather than “eye-pee-oh-ess”. Mr Poon contrasted this with SMRT (Singapore

Mass Rapid Transit), which he said would be pronounced “ess-em-ar-tee” as SMRT is not a pronounceable word.³⁵

41 During the hearing, I was referred by the Opponent to a decision of this tribunal, *Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A.* [2004] SGIPOS 8 (“**ROOX**”), wherein the competing marks were ROOX and ROLEX. On how ROOX should be pronounced, the Hearing Officer stated (at [30]):

“When a person is faced with an unfamiliar word, there is a tendency for that person to reach within his own vocabulary of words and mentally look for words that have the same structure in the sense that the chronology of the alphabets [*sic*] is the same as the unfamiliar word. Having identified the similar word or words; he would apply the way in which those words are pronounced to the unfamiliar word. In this case, that person would apply the pronunciation of very normal English words like “roof”, “room” and “root” which look the most identical to the word “ROOX”. The mark “ROOX” would be pronounced phonetically as “rooks”, the letter “X” at the end of a word as most of us have been taught, being enunciated with a “-ks” or “-cs” sound. It would be quite a stretch to consider the word “ROOX” as a dual-syllable word; it is clearly a single-syllable word.”

In the Opponent’s submission, if the above principle is applied to this case, “SNAC” should be pronounced as “snack”.

42 In response, the Applicant countered that “SNAC” should be pronounced as “S-N-A-C”, *i.e.* with each letter pronounced separately. The Applicant’s Mr Tan’s evidence was that when he spoke to school teachers and principals, they always referred to the Opponent’s product as “S-N-A-C” in full.³⁶ Mr Tan gave the example of the World Health Organization which is widely known as “W-H-O” and not “who”.³⁷ Another example given by the Applicant during the hearing was Singapore’s Pan Island Expressway, commonly pronounced as “P-I-E” instead of “pie”.

43 During the hearing, the Applicant confirmed that it had no objections to the Hearing Officer’s analysis in the **ROOX** case. But, it sought to distinguish **ROOX** from the present case on grounds that the “snaapp” portion of the Application Mark is in all lowercase whereas the SNAC Mark is registered in all uppercase.

44 Inherent difficulties abound when considering well-known examples such as the World Health Organisation (WHO) and the Pan Island Expressway (PIE). It is hard to say whether one’s perception may be skewed by having been educated that the acronym for World Health Organisation should be pronounced as “W-H-O” instead of “who”. Similarly for the PIE: the public in Singapore may pronounce it as “P-I-E” simply because they have been taught to refer to it as such, or perhaps by comparison with the abbreviations for other expressways in Singapore most of which are unpronounceable (e.g. “ECP” for the East Coast Parkway expressway and “CTE” for the Central Expressway). Therefore, such examples are not necessarily helpful.

³⁵ Poon’s Second SD at [10].

³⁶ Tan’s SD at [78].

³⁷ Tan’s SD at [83].

45 As for the school principals and teachers who spoke to Mr Tan and referred to “S-N-A-C” in full, none of them have come forward to give evidence. However, they would be familiar with both marks and it would only stand to reason that they spelt out each letter separately in order to distinguish the two apps aurally in the course of speech. This would not be surprising given their aural similarity, a conclusion I reach at [56] below. It does not necessarily follow, however, that persons outside of that niche group would ordinarily pronounce the SNAC Mark as “S-N-A-C”.

46 There is much to commend about the approach taken by the Hearing Officer in **ROOX**. It is one which accords with plain common sense. I fail to see how the present case can be distinguished from **ROOX** on the basis that “SNAC” is in uppercase whereas “snaapp” is in lowercase. The approach in **ROOX** is one of general application. When one seeks to pronounce “SNAC”, one would naturally reach for the closest familiar word, which is “snack”. After all, in the English language, the letters “c” and “k”, especially at the end of words, often have the same sound. (Some words, such as “trafficking” and “mimicking” have both the letters “c” and “k”.)

47 I recognise that there may also be some who would pronounce “SNAC” as “S-N-A-C” given that all of the letters in the SNAC Mark are in uppercase and are each represented in a different colour. But, all things considered, I find that “SNAC” is more likely than not to be pronounced either simply as is, *i.e.* “snac” (without the plosive ‘k’ sound), or in the alternative, as “snack” (with the ‘k’, although it is likely to be slurred such that the ‘k’ sound is not as prominent).

Proprietor’s intentions

48 The Opponent’s Mr Poon produced evidence of a transcript of an extract taken from a video demonstration dated 14 February 2013 wherein “SNAC” was pronounced as “snack”.

49 In reply, the Applicant countered that the video/transcript evidence was self-serving in that the presentation was conducted for marketing purposes, and should consequently be accorded less weight. The Applicant drew my attention to Mr Poon’s First SD,³⁸ wherein the



Opponent had set out its other registered mark (No. 40201402323Q) (the “**PNAC Mark**”). Mr Tan pointed out that the PNAC Mark was registered later than the SNAC Mark, and “*is clearly designed to be like “SNAC”*”. According to Mr Tan, this similarity between the PNAC Mark and the SNAC Mark shows that the Opponent “*had never intended*” for “SNAC” to be read or pronounced as “snack”, because “PNAC” is itself unpronounceable. In this connection, it was argued during the hearing that the idea that “SNAC” should be pronounced as “snack” was an afterthought, to win “*half the battle*” on (dis)similarity.³⁹

50 In my judgment, the PNAC Mark is completely irrelevant to the issue of whether the SNAC Mark and the Application Mark are aurally similar. The comparison is mark-for-mark,

³⁸ At [7].

³⁹ During the hearing, the Applicant went so far as to suggest that Mr Poon’s evidence on SNAC being pronounced as “snack” should be disbelieved because SNAC has nothing to do with food. A similar point was made by the Applicant’s Mr Tan (see his SD at [82]). However, this argument is misguided. A mark that says nothing about the goods or services to which it is applied is inherently distinctive and thus fulfils the fundamental function of a trade mark: to designate origin. Conversely, signs which are descriptive may not be registered as trade marks: see Section 7(1) of the Act.

and I have not allowed myself to be side-tracked by a different mark. Traders may have any number of trade marks, and the fact that one of the marks in their stable may be pronounced a certain way has no bearing whatsoever on how a different mark is to be pronounced.

51 Significantly, the Opponent’s demonstration wherein “SNAC” was pronounced as “snack” took place prior to the application date of 3 March 2014. Therefore, it could not have been an afterthought on the part of the Opponent. The Opponent was clearly marketing its app (aurally) as “snack”.

52 But, it does not follow that I must therefore find that the SNAC Mark should therefore be pronounced as “snack”. The proprietor’s intentions as to how its mark should be pronounced may be relevant but are not determinative. Even if the Opponent was marketing its app as “S-N-A-C”, I am still entitled to arrive at the conclusion that average consumers would aurally regard the mark as “snac” or “snack”.

Comparing the marks aurally

53 The fundamental principles which are to be applied in the comparison for aural similarity are well established.

54 In *Johnson & Johnson v. Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR 1082 (“*CAREREE*”), the competing marks were ‘CAREFREE’ and ‘CAREREE’. In arriving at the conclusion that the marks were aurally similar, the Singapore High Court (at [10]) had regard to the following proposition in *Aristoc, Ld v Rysta, Ld (1945)* 62 RPC 65 at 72:

“The answer as to the question whether the sound of one word resembles too nearly the sound of another ... must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused.”

The court in *CAREREE* also took into account the general principle that in many cases, the first syllable of a mark is most important as there is a “*tendency of persons using the English language to slur the termination of words*” (citing *In the Matter of London Lubricants (1920) Limited’s Application to Register a Trade Mark* (1925) 42 RPC 264 at 279 (“*London Lubricants*”)).

55 In *Doctor’s Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193, the High Court emphasised that the *London Lubricants* first syllable principle should not be applied in a blanket fashion (citing *Valentino Globe BV v Pacific Rim Industries Inc* [2009] 4 SLR(R) 577 at [34], in which *London Lubricants* was also considered), and declined to apply it in that case (where the competing marks were SUBWAY and SUBWAY NICHE) because the first syllable principle “*seems reserved for cases where the marks comprise only one word*” (at [35]).

56 Returning to the present case, I have found the earlier trade mark would be pronounced as “snac” or “snack” (see [47] above). As for the Application Mark, the parties appear to be in agreement that it should be pronounced as “snap”. Because “SNAC” and “snaapp” are each one word, the *London Lubricant* principle should apply. Having regard to the tendency of

speakers (especially in Singapore) to slur the endings of words in the English language, the respective marks would be pronounced in a monosyllabic manner (“snap” versus “snac” or “snack”) with the same identical sibilant starting sound (“SNA-”). To that extent, there would be some aural similarity between the marks.

The conceptual aspect

57 The Opponent’s case is that the marks are conceptually similar. It submitted that the conceptual similarity between both marks lies in them being acronyms and having no meaning in any known language.⁴⁰ During the hearing, the Opponent further relied on both marks being monosyllabic and having similar beginnings.

58 The Applicant’s case is that the marks are conceptually different. It argued that “snaapp” was conceived from “SCHOOL NOTIFICATION & ATTENDANCE APP” (which is also part of the Application Mark), whereas “SNAC” stands for “school notification and acknowledgement console” (which is not in the SNAC Mark). The Applicant also contended that although “snaapp” does not have any meaning in the English language, it is allusive of notifications being exchanged immediately (*i.e.* in a snap). According to the Applicant, if “SNAC” is pronounced as “snack” (which it does not accept), then the mental image would be a food reference which is completely unrelated to mobile apps and/or the concept of “snap”.⁴¹

59 I find the competing marks to be conceptually different, but not for the reasons given by the Applicant. It is important to bear in mind that the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole (*Staywell* at [35]; *Hai Tong* at [70]). It must be an idea that manifests in the look and feel of the mark, and not something that is known only to its creator (*Audience Motivation* at [43]).

60 The Opponent may have initially intended for “SNAC” to be an acronym for “school notification and acknowledgement console”⁴², but those words (*i.e.* “school notification and acknowledgement console”) do not appear in the SNAC Mark. And, even though I have found that “SNAC” would be pronounced as “snac” or “snack”, it does not follow that conceptually one would think of food snacks when looking at the mark. Ultimately, the word “SNAC” is an invented word and therefore has no conceptual meaning. The words “SCHOOL NOTIFICATION & ATTENDANCE APP” in the Application Mark inform that “snaapp” is an app for use in schools, and which provides notification and attendance functions. Thus, the comparison is between “snaapp SCHOOL NOTIFICATION & ATTENDANCE APP” (conceptually: an app for use in schools that provides notification and attendance functions) as compared with “SNAC” (a meaningless term). It is obvious that there is no conceptual similarity between the two.

61 Even if I am wrong in taking into account the meaning accorded to the Application Mark by the words “SCHOOL NOTIFICATION & ATTENDANCE APP” for the purposes of assessing conceptual similarity, the result would still be the same. Under this alternative analysis, the comparison would be between two meaningless invented words which are unaccompanied by any other device marks. In *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”), the Court of Appeal found that “NUTELLO” and “NUTELLA” (both textual marks with no accompanying device) to be not conceptually similar because the marks were invented and meaningless terms with no particular idea underlying each of them. According to this line

⁴⁰ Opponent’s Written Submissions at [24].

⁴¹ Applicant’s Written Submissions at [13].

⁴² Later, Smart Notification Acknowledgement Console: see [11] above.

of reasoning, since “SNAC” and “snaapp” are both inherently meaningless, the marks would have no conceptual similarity.

62 And, even if one considers “snaapp” to be conceptually evocative or representative of speed (*i.e.* in a snap), the concept of speed is still conceptually dissimilar to SNAC which has no meaning.

Conclusion: the marks are highly dissimilar

63 I have found that: (a) visually, the marks are dissimilar to a substantial degree; (b) there is some aural similarity between the marks; and (c) there is no conceptual similarity between the marks. When I weigh all three aspects of marks-similarity (*viz.* the visual, aural and conceptual), I find that the Application Mark, as a whole, to be highly dissimilar to the SNAC Mark.

64 In arriving at my conclusion, I am aware that in *Staywell*, the competing marks had no visual similarity (a point which was not appealed and therefore not before the Court of Appeal), and the Court of Appeal considered the marks to have “*a fair degree of conceptual similarity*” and a “*substantial degree of aural similarity*”. In that case, the Court of Appeal had “*no difficulty finding that the marks were similar*”. This shows, of course, that marks which are visually dissimilar may yet be similar overall. However, each case must necessarily turn on its own facts and I cannot see how the aural similarity between the competing marks in this case is sufficient to render the marks similar as a whole, given my findings on the visual and conceptual aspects of the inquiry.

65 For the reasons above, the ground of opposition under Section 8(2)(b) therefore fails at this first step. However, for completeness, and in case I am wrong, I will go on to deal with the arguments and evidence in relation to the second and third elements of the step-by-step approach.

Comparing the goods and services

66 The second step is to compare the goods and services for which registration is sought as against the goods and services for which the earlier trade mark is protected. It is undisputed that the parties’ goods in class 9 and the services in class 38 are identical. The second element in Section 8(2)(b) is therefore satisfied.

Likelihood of confusion

67 Two types of confusion are well recognised under Section 8(2)(b). The first is where the consumer mistakes one mark for another. The second is where consumers may perceive that both marks are different, but may yet remain confused as to the origin which each mark signifies, and may perceive that goods or services of both marks emanate from the same source that has chosen to diversify its range of marks for any of a multitude of marketing or promotional reasons, or that the two sets of goods emanate from sources that are economically linked or associated (see *Hai Tong* at [74]; *Staywell* at [99]).

68 Regardless of whether the likelihood of confusion is of the first or second type, it must have been *brought about* by the similarity between the competing marks and the similarity between the goods and services in relation to which the marks are used (see *Staywell* at [15]).

This is why, if the competing marks are found to be dissimilar, the Section 8(2)(b) inquiry ends and the opposition fails. But, the fact that the competing marks are similar and the goods/services are similar or identical does not mean that the element of likelihood of confusion is automatically established (see *Staywell* at [64]).

69 Admittedly, the fact that I have found the marks to be dissimilar renders any analysis under this third step artificial. Therefore, I will only deal with the evidence and the points raised in argument to the extent that is necessary and appropriate for me to do so.

70 One important feature of this present case is the fact that both parties have put their respective marks into use, prior to the relevant date, in what appears to be a niche market. It is not surprising therefore, that the Opponent has evidence of what it alleges to be actual confusion in the market place. There are two operative questions that fall to be considered. First, to what extent is the actual use of the parties' respective marks relevant? Second, what is the significance of the alleged instances of confusion relied on by the Opponent?

71 As regards the extent to which the use of the parties' respective marks is relevant, the Court of Appeal in *Staywell* has ruled that:

- (a) The likelihood of confusion inquiry in Section 8(2)(b) must take into account the actual and notional fair uses to which the registered proprietor of the earlier trade mark has or might fairly put his registered trade mark and compare this against any actual and notional fair use to which the trade mark applicant may put his mark should registration be granted (see *Staywell* at [60]).
- (b) In the case where an applicant has been using his mark prior to the filing of his registration application, the allegation by the opponent must be that this actual use is to be treated as a putative infringement, so it can be assessed from that perspective. But even if there is no putative infringement based on the actual use, the inquiry does not stop there: it would still be necessary to consider the wider question of whether the notional fair uses that the applicant might put the mark to could conflict with the notional fair uses to which the proprietor of the registered mark could put his mark to. In essence therefore, the applicant will be required to establish that the notional fair use of his mark would not infringe the notional fair use rights of the proprietor (see *Staywell* at [62]).

72 As regards the relevance of the alleged instances of confusion relied on by the Opponent, I have taken note of the following principles.

- (a) The starting point is that the question of whether there is likely to be confusion is ultimately one for the court (or in this case, this tribunal), rather than for witnesses (see *Hai Tong* at [99]). It is settled law that the test to be adopted is whether a *substantial portion* of the relevant public is likely to be confused. The term substantial portion, or substantial number, does not refer to a majority, but to a *not insubstantial number*. Another way of putting it is that the level of confusion must be above or beyond a *de minimis* level. (See *Hai Tong* at [78(e)].) Inherent in this test is the recognition that there will always be some people who are confused, and it cannot be that the requirements of the section would be fulfilled because a small unobservant segment of the public would be confused (see *Sarika* at [57]).

- (b) The relevant public is the segment of the public comprising the actual or potential purchasers of the goods or services in question and those who deal with these goods (e.g. those involved in the distribution of the goods or services). (See Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 (“*Ng-Loy*”) at p 362, [21.5.27].)
- (c) The time of purchase is the material time at which confusion must exist in the mind of the relevant public (see *Ng-Loy* at p 362, [21.5.26] and *Staywell* at [105] – [116]).

73 I am mindful of the Court of Appeal’s guidance in *Staywell* that certain ‘extraneous factors’ may be taken into account in the likelihood of confusion assessment, whereas others cannot (see *Staywell* at [63] – [93]).

- (a) Permissible factors include: (i) those relating to the impact of marks-similarity on consumer perception (e.g. the degree of similarity between the marks; and the importance of any given aspect of similarity having regard to the way the goods or services are sold: see *Staywell* at [20]); (ii) the degree of attention and care that the average consumer is likely to pay when making purchases of the goods or services (and this may be affected in part by the normal price of the goods/services); (iii) the nature of the goods/services (e.g. whether specialist knowledge is required in making the purchase); and (iv) the frequency and mode of purchase of the goods.
- (b) Impermissible factors include those which are external to the marks and goods/services in question, and which are susceptible to changes that can be made by a trader from time to time (e.g. steps taken by a trader to differentiate his goods/services or marks from that of the owner of the incumbent mark).

Importantly, in opposition proceedings, it is not relevant to have regard to extraneous factors concerning the actual and particular circumstances and way in which the mark has been used on the goods and services in question (see *Staywell* at [163(g)]).

The relevant public

74 It is common ground that the parties are competitors in the same niche target market. The question is how this impacts on the analysis of likelihood of confusion under Section 8(2)(b). The short answer is: very little. I elaborate.

75 In its written submissions, the Applicant argued that I should pay heed to the fact that the relevant public in this case were schools, institutions and similar organisations (*i.e.* the actual or potential purchasers of the parties’ respective goods and services).⁴³ It submitted that I should take the unique attributes of the specific trade into account. According to the Applicant, there is evidence that there are schools which have switched over from one app to another (e.g. SNAC to snaapp) and would thus know the difference.⁴⁴ The Applicant also stressed that the majority of schools in Singapore are in receipt of government funding, and are thus accountable to the Ministry of Education for their use of government funds. Surely, goes the rhetorical argument, these schools would pay more attention to their purchases? My attention was also

⁴³ Applicant’s Written Submissions at [15].

⁴⁴ Applicant’s Written Submissions at [16].

drawn to the fact that the respective parties' apps are not cheap (S\$2,998) and thus schools would make their purchases carefully and not on impulse.

76 Now, some of the above considerations may be relevant to the passing off ground. However, on the facts of this case, they play but a minor role under Section 8(2)(b). Why? Because the relevant public is not limited to the specific niche market that the parties are in. It is to be assessed by reference to the goods and services in question, which are:

Class 09

Communication software; communications processing computer software; communications systems; computer software; computer software (programs); computer software for communicating purposes between microcomputers; data communications software; programs for use in communications.

Class 38

Cellular communications services; computer communications for the transmission of information; mobile telephone communication services.

77 The actual and potential purchasers of the goods and services in this case would be the general public (of which the various schools, institutions and similar organisations would only be a small part). Practically anyone and everyone can (and does) purchase and use communication software (e.g. mobile apps) and cellular communications services or mobile telephone communication services.

78 Viewed in their proper context, the goods and services in question do not by nature demand a higher degree of attention and care on the part of the relevant consumer. They are not specialist goods or services. No particular or additional knowledge is required prior to making a purchase. The goods and services in question are certainly not one-off purchases. And, it may be that on the specific facts of this case, both parties were marketing and selling their apps at the price at S\$2,998. But, outside of the parties' very niche market, communication software and services may be priced differently. There is no one fixed price.

79 Having regard to all the circumstances, I find that the general public would pay an ordinary amount of attention to the respective marks in the context of their actual or intended purchases, but no more.

Impermissible extraneous factors

80 Extraneous factors which are susceptible to changes that can be made by a trader from time to time cannot be taken into account. Therefore, the fact that both parties were marketing and selling their "snaapp" and "SNAC" mobile apps at the same price (S\$2,998) is not a factor that can be taken into account in the assessment for likelihood of confusion.

The alleged evidence of actual confusion

81 I now address the Opponent's evidence of alleged actual confusion in the marketplace.

(1) The parent's email of 23 May 2015

82 The first is an email from one Mr X [name anonymised] dated 23 May 2015, apparently sent to snac.support@apptitude.sg. The material part of it reads:

*“Hi, I am unable to add another child to the system, please assist.
Child NRIC: [redacted] (Methodist Girls' School)
The message prompt says NRIC not in system, school said it has been updated.”*

83 According to the Opponent's Mr Poon, this email was sent by a parent of the child in Methodist Girls' School, which was not one of the Opponent's customers. Mr Poon contended that this was a clear case of confusion.⁴⁵ In response, the Applicant's Mr Tan said that the purchasers of the app are the schools and not the parents. Mr Tan pointed out that out of the “*thousands of parents*” the Opponent was only able to cite one instance of alleged confusion. Mr Tan noted further that the parent had not come forward to give evidence to explain why he emailed the wrong company.⁴⁶

84 To my mind, although this email may evince an instance of confusion, it is not the sort of confusion which is relevant under the third step of Section 8(2)(b). My reasons are as follows.

- (a) The comparison in this email is not between the competing marks (i.e. the Application Mark and the SNAC Mark).
- (b) I agree with the Applicant that what is lacking is some sort of statement from Mr X to explain why he emailed the wrong company, because that would have shed light on the reasons why the parent was confused. Was it because he thought that the marks were similar? Or was it some other reason? I cannot tell from this email alone whether the confusion was *brought about* by the similarity between the competing marks and the similarity (or identity) between the goods and services in relation to which the marks were used.
- (c) Likelihood of confusion is to be assessed at the time of purchase. The fact that Mr X received a message prompt that his child's NRIC was not in the system must necessarily mean that the situation relates to post-purchase service support.
- (d) At best, all that can be said about this email is that an unthinking person in a hurry was confused. It appears that the email was sent to snac.support@apptitude.sg. It should have been clear to an average member of the public who exercised ordinary care that the addressee was “snac” and not “snaapp”.
- (e) The email was sent on 23 May 2015, more than a year after the relevant date of 3 March 2014. Moreover, the fact that the Opponent was only able to produce a single email from a confused parent notwithstanding that both parties had put their respective marks into use since July 2012 strongly suggests that the claimed likelihood of confusion is more illusory than real.

⁴⁵ Poon's First SD at [48] and Tab 9.

⁴⁶ Tan's SD at [107(a)].

(2) The email from Siglap Secondary School dated 22 September 2014

85 The second is an email dated 22 September 2014, sent to enquiries@apptitude.sg by an Administrative Executive from Siglap Secondary School. The material part of the email stated:

“We understand that you have made a presentation on your services to our E3 cluster some time back. We are interested to know if any of these services are readily available or can be developed:

- 1. Daily attendance taking (sync with SC)*
- 2. Electronic Notification with responses (for obtaining consent or replies)*
- 3. Sending of mass SMS (e.g. for late comers or absentees)*
- 4. Overseas travel declaration (for staff and/or students)*

...”

86 According to the Opponent’s Mr Poon, the email in question was sent “*out of confusion*” as the Opponent had never made any presentations to Siglap Secondary School.⁴⁷ But the more fundamental question, however, is: what confusion is this evidence of? My difficulty with this email is that nothing in it shows that the writer’s confusion was *brought about by* the similarity between the competing marks and the similarity (or identity) between the goods and services in relation to which the marks were used.

87 Although nothing turns on it, I should add two brief points. One, the email was sent after the relevant date. Two, as the Applicant rightly points out, the email was only sent by the representative of one school out of many. (By the relevant date, 10 schools had signed up with the Applicant and 21 schools had signed up with the Opponent. There were more sign-ups on both sides in the intervening period between March 2014 and September 2014.) If there was truly confusion in the marketplace, why was the Opponent unable to produce evidence of more emails which were wrongly addressed to the Opponent?

(3) The Punggol Green Primary School episode on 24 August 2015

88 The third instance of alleged confusion relates to an episode at Punggol Green Primary School. Both parties’ representatives were present on the same day to make separate sales pitches to the school.

89 In Mr Poon’s SD he stated that he went to Punggol Green Primary School to make a presentation, and a representative from the Applicant was also there at the same time. According to Mr Poon, the person from the school who had fixed the appointment had thought that “*we were the same entity, and had not expected two parties to show up*”.⁴⁸

90 Ms Wang, who represented the Applicant on 24 August 2015 at Punggol Green Primary School, had a different account. She said that while she was waiting to make her sales pitch for the snaapp app, the Opponent’s representative was also present and waiting to make a pitch for the SNAC app. She said that the school clearly knew that snaapp and SNAC were “*2 different apps from 2 different companies*”.⁴⁹ Importantly, she provided documentary evidence of the chain of email correspondence between herself and the Punggol Green Primary School representative, one Mr Y (name anonymised). The subject matter of the emails stated: “*Inquiry*

⁴⁷ Poon’s First SD at [48].

⁴⁸ Poon’s First SD at [48].

⁴⁹ Wang’s SD at [9(b)].

on *Snaapp App*". On 12 August 2015, Mr Y asked several questions about the *snaapp* app, which Ms Wang answered on 14 August 2015 at 7.50 am. Mr Y then replied later that morning at 11.52 am, requesting a meeting on 24 August 2015 and copied a number of other teachers from the school on that email, saying "*Dear teachers, Pls see the reply from snaapp below*".⁵⁰ Quite obviously, Mr Y (and the other teachers) knew who he was corresponding with. And, the fact that the Opponent's representative was also there at that time must mean that Mr Y (or someone else in a similar capacity from the school) had separately reached out to the Opponent to fix a meeting on that same day as well.

91 All things considered, I am unable to accept that there was any confusion on the part of Mr Y (or any other teacher or representative of the school). Even if there was, there is no indication that such confusion was *brought about by* the similarity between the competing marks and the similarity (or identity) between the goods and services in relation to which the marks were used.

(4) Undocumented telephone calls and verbal communications?

92 The Opponent asserted that the three instances of alleged confusion discussed above were but "*a few of the many that have occurred since 2012, the majority of the instances being via undocumented phonecalls [sic] and verbal communications*".⁵¹ However, even if these instances were not documented in writing, the Opponent could have, at the very least, tendered an SD from one or more of its representatives (who received the phone calls and/or verbal communications) explaining what took place during those undocumented telephone calls and verbal communications. It did not do so, and I cannot make an assessment in the complete absence of evidence.

93 Having regard to all of the circumstances, I find that the Opponent's evidence of alleged actual confusion does not establish that there was likelihood of confusion within the meaning of Section 8(2)(b). The very most that can be said is that, in the parties' very niche market of mobile apps for use in relation to facilitating communication between schools and parents, there were isolated instances of confusion. But, even then, it is not clear that such confusion was *brought about by* the similarity between the competing marks and the similarity between the goods and services. In any event, these instances do not show that a substantial portion of the average consumers in that specific market would likely be confused beyond a *de minimis* level. (It should not be forgotten that the relevant public is the general public of which the niche market would be a small sub-set.) The evidence clearly falls far short of showing that the general public would likely be confused.

Notional fair use in relation to the full range of goods and services

94 It is undisputed that, insofar as notional fair use is concerned, it falls to be considered whether the notional fair uses that the Applicant might put the Application Mark to could conflict with the notional fair uses to which the Opponent could put the SNAC Mark to.

95 As the Opponent rightly pointed out during the hearing, considering notional fair use meant that the assessment for likelihood of confusion cannot be confined to the parties' respective *snaapp* and SNAC notification apps, because both parties could potentially use their marks in relation to the full range of goods and services, which would include other types of

⁵⁰ Wang's SD at exhibit JW-3, pp 10 – 13.

⁵¹ Opponent's Supplementary Written Submissions at [15]; Poon's Second SD at [33].

mobile apps as well. (This is consonant with the application of the principle in *Staywell* where hotel services were considered to be hotel services regardless of whether they were applied in fact to a 4-star or a 6-star hotel.)

96 The Opponent went on to argue that in such a case (i.e. where parties use their respective marks in relation to mobile apps in general, as opposed to the specific niche market of school notification apps), the likelihood of confusion would be amplified. I disagree. There is no reason why there would necessarily be a greater likelihood of confusion flowing from the use of the Application Mark in relation to other goods or services outside of a niche market. All other things being equal, the extent of likelihood of confusion does not increase simply by virtue of the fact that one is looking at a larger market.

Notional fair use in relation to differing forms of the marks?

97 The Opponent submitted that notional fair use extended to use of the mark in different forms e.g. in other fonts, typefaces and case.⁵² In support of this proposition, the Opponent relied on a decision of the UK Intellectual Property Office, *In the matter of Application No. 2423905 by Glyn Berrington to register a trade mark in classes 18, 25 and 35 and In the matter of opposition thereto under No. 94929 by Richard Charles Archer-Perkins* (O-152-08) dated 4 June 2007 (“*Glyn Berrington*”).

98 My attention was drawn to the fact that the Applicant has used different permutations of the Application Mark. For instance, the Applicant has used it in uppercase without the tagline “SCHOOL NOTIFICATION & ATTENDANCE APP” (i.e. SNAAPP), and in lowercase without tagline (i.e. snaapp). What this meant, in the Applicant’s submission, was that if the Applicant should “*one day use its mark in the same colours as the Opponent, the Opponent would be prevented from commencing infringement proceedings due to Section 28(3) of the Act*”⁵³.

99 In *Glyn Berrington*, the competing marks were as follows.

Earlier TM

URBAN SHOCK

Application Mark



The opponent sought to rely on the concept of notional and fair use of the marks. In this regard, it referred to two Practice Amendment Notices Nos. 9/06 (also located at p 163 of the UK Trade Marks Manual) and 8/07 (also located at p 155 of the UK Trade Marks Manual). For present purposes I need only mention the former (No. 9/06), which reads as follows:

⁵² Opponent’s Supplementary Written Submissions at [18(iii)].

⁵³ The effect of Section 28(3) is essentially that the proprietor of a later registered trade mark does not infringe an earlier registered trade mark, so long as the later trade mark is used in relation to the goods or services for which it is registered.

“7.7 Notional and Fair Use” and Section 3(1)

The concept “Notional and fair use” refers to how a trade mark may be used in the marketplace and, consequently, will have a bearing on how distinctive the mark will be in its various modes of use. This will include use on business papers, on packaging and in advertising, ie. not just on more conventional means for carrying brands, such as swing tags and sew-in labels etc. A mark may lose trade mark significance when encountered in a promotional context rather than physically used on the goods. Care must be taken when examining a mark which “reads” into the goods or services. “Notional and fair use” of a mark registered in block capitals will also include use in differing typefaces and in upper and lower case letters.”

The opponent contended that the Practice Amendment Notices made it clear that “*notional and fair use of a mark registered in block capitals includes use in a differing type face or upper and lower case letters...*” and further submitted that “*the doctrine of notional and fair use extends to use of a mark registered in block letters in any combination of colours, with one word at a 90 degree angle to the other or even in the form of a cube*”. In essence, the opponent was trying to argue that notional and fair use meant that it, too, could use its mark URBAN SHOCK in a manner which resembled that of the Application Mark. The hearing officer was not persuaded. He agreed with the parts of the opponent’s submissions relating to the upper and lower case, but considered “*the contention that notional and fair use of the opponent’s mark could include a get up similar to that of the applicant*” to be “*totally spurious*”. (*Glyn Berrington* at pp 7 – 8.) In the result, the hearing officer found that the differences between the marks far outweighed any slight similarity (at [33]).

100 I hold that *Glyn Berrington* does not assist the Opponent’s case for two main reasons.

- (a) First, I cannot ignore the context of UK Practice Amendment Notice No. 9/06. It relates to Section 3(1) of the UK Trade Marks Act, which is *in pari materia* to Sections 7(1) and 7(2) of our Act, and which concerns the issue of acquired distinctiveness through use. The issue of whether a mark has acquired distinctiveness through actual use, notwithstanding that it has been used in different forms and typefaces (e.g. in lower case), is a very different issue from whether the notional fair use of a later trade mark is likely to cause confusion within the meaning of Section 8(2)(b) of our Act.
- (b) Second, I note that the earlier trade mark in *Glyn Berrington* is in plain block letters, whereas the SNAC Mark is registered in a particular font and in colour. Further, even if I accept that notional fair use of the SNAC Mark and/or the Application Mark encapsulates the possibility that the respective marks may be used in upper and lower case, the doctrine of notional fair use goes no further than that. It may be that the Applicant is in fact using the Application Mark without the tagline “SCHOOL NOTIFICATION & ATTENDANCE APP”, but that is not what it is seeking to register. This point is therefore irrelevant for the purposes of the comparison (whether in similarity of marks or likelihood of confusion).

101 As regards whether, if the Application Mark is allowed to proceed to registration, the Opponent would be precluded from suing for infringement by reason of Section 28(3) in the event the Applicant adopts a similar colour get-up for its mark, the question is not before me in these proceedings. It is a matter for the High Court to decide in an infringement suit.

Opposition under Section 8(7)(a): passing off

102 Section 8(7)(a) provides that a trade mark shall not be registered if, or to the extent that, “*its use in Singapore is liable to be prevented 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*”. It is trite law that there are three elements in the tort of passing off: goodwill, misrepresentation, and damage (see *Staywell* at [130]).

103 In *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 (“*Rovio*”), a decision of the High Court, George Wei J held that Section 8(7)(a) effectively requires the court to consider the position of the opponent in a notional passing off action (at [159] – [160]). To this end, an opponent relying on this ground must adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation and damage. *Prima facie* in the sense that a court (or tribunal) “*is inevitably hampered by the lack of a full trial and detailed facts and evidence (especially if the mark has not been used yet)*” and yet must decide whether a passing off claim would actually succeed should one be brought (*Rovio* at [164]).

104 In this case, the Applicant has put the Application Mark into use prior to the relevant date, and so I have the benefit, at least, of evidence relating to the competing marks in actual use in the specific marketplace.

Goodwill

105 Goodwill has been famously described as the attractive force that brings in custom (see *Hai Tong* at [111], citing *The Commissioners of Inland Revenue v Muller & Co’s Margarine, Limited* [1901] AC 217 at 224). As the Opponent rightly submits, goodwill is usually established by way of sales figures in Singapore, and evidence relating to marketing and advertising efforts in Singapore (see *Rovio* at [180]).

106 The Opponent accepts that while its sales figures are not substantial, they are not insubstantial when viewed against the target niche market of over 300 schools in Singapore.⁵⁴ The Applicant’s counter is that the Opponent has not engaged in advertising or mass marketing, and at the relevant date, the Opponent had signed on 22 out of 369 schools,⁵⁵ which by its calculations was “*a mere 5.96% of the schools in Singapore*”, “*hardly*” what one would consider as “*enormous goodwill*” or “*excellent reputation*”.⁵⁶

107 It is clear from the authorities that one does not need an excellent reputation or enormous goodwill in order to sustain a passing off action. For instance, in *Hai Tong*, the High Court judge had considered the plaintiff’s sales figures as being “*not particularly impressive*” and held that the element of goodwill was not established. However, on appeal, the Court of Appeal overturned the High Court’s finding on goodwill and held that there was sufficient evidence to establish the element of goodwill. On the other hand, it has been recognised that proof of a few occasional sales to a very limited group of people is unlikely to prove goodwill (see *Rovio* at [179]). Everything turns on the facts of each case.

⁵⁴ Opponent’s Written Submissions at [36].

⁵⁵ The Applicant accepts that the Opponent secured 22 schools as at the relevant date. In so doing, the former has included the 1 contract which the Opponent has secured in March 2014 itself. However, I have found that there are 21 schools at the relevant date because it is not clear when exactly the 1 school signed on with the Opponent. In any event nothing turns on the difference.

⁵⁶ Applicant’s Written Submissions at [36] and [37].

108 The authorities do not require that there must be evidence of widespread advertising and promotion. And, given the nature of the niche market, I fail to see how the lack of mass market advertising is detrimental to the Opponent's case on goodwill. What is the use of advertising to the general public when one is targeting schools and educational institutions? Even the Applicant itself does not engage in newspaper or public advertising, preferring instead to make cold calls to reach out to schools (see [18] above).

109 In this case, bearing in mind the small size and nature of the target market, given that the Opponent was able to secure 21 contracts for the SNAC app from January 2013 to February 2014, I have no difficulty finding that, at the relevant date, the Opponent had the requisite goodwill to sustain an action in passing off.

Misrepresentation

110 Under this element, the Opponent must show that the Applicant's actions (here: both actual use and notional use of the Applicant Mark in a normal and fair manner in respect of the goods and services for which registration is sought) amount to a misrepresentation (whether intentional or not) leading or likely to lead the public into believing that the goods or services (in respect of which registration is sought) are the goods or services of the Opponent or from a commercially related trade source. In this respect, I must consider not only the earlier SNAC Mark, but also the full extent of the Opponent's use of its SNAC Mark "*in all its manifestations*" (see ***Beats Electronics, LLC v LG Electronics Inc.*** [2016] SGIPOS 8 ("***Beats***") at [47]). From the evidence I can see that the Opponent has used "SNAC" without the colours, and so I will take that into account.

111 In ***Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)*** [2016] SGCA 33 ("***Singsung***"), the Court of Appeal emphasised the relevance of distinctiveness to the element of misrepresentation. It held (at [38]) that distinctiveness in the context of passing off "*is best understood as a threshold inquiry*" in the assessment for misrepresentation. If a mark is "*not distinctive of the plaintiff's [here: Opponent's] goods or services, the mere fact that the defendant [here: Applicant] has used something similar or even identical in marketing and selling its products would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or economically linked to the plaintiff*". The Opponent's case in this regard is that "SNAC" has no meaning in relation to the goods and services claimed, and has through sales and advertisement, become distinctive of the Opponent.

112 I have no problems finding that the SNAC Mark and/or the element "SNAC" is distinctive of the Opponent. However, the Applicant is not using or seeking to register something similar to the SNAC Mark and/or the element "SNAC". I have found, in the context of Section 8(2)(b), that the Application Mark and the SNAC Mark are highly dissimilar, and am of the view that the Application Mark and "SNAC" are dissimilar as well. It thus follows that there cannot be any misrepresentation to the public as to trade origin. Such a finding is sufficient to dispose of the misrepresentation element (see ***Rovio*** at [195]). Consequently, the opposition under Section 8(7)(a) fails.

113 For completeness, I will touch on some brief points.

- (a) I note that parties are in the same or common field of activity. At least insofar as school notification apps are concerned, the parties are in direct competition. It is

well established that a relevant factor in deciding whether there is any actionable misrepresentation is how close or far apart the fields of activity are (see *Rovio* at [199]). But, the point remains that there cannot be any deception or likelihood of deception where the competing marks in question are dissimilar.

- (b) There is a key difference between misrepresentation under the second element of passing off as compared with likelihood of confusion under the third step of Section 8(2)(b). It is this: the likelihood of deception in misrepresentation is to be assessed having regard to “*all of the circumstances*”, whereas under the Act, likelihood of confusion must stem from the similarities between the contesting marks and the respective goods and services (see *Hai Tong* at [110]). Accordingly, certain extraneous matters such as the price of the goods/services *can* be taken into account. However, the fact that both parties’ apps were priced at the same price (S\$2,998 for a one-year subscription) does not assist the Opponent. In fact, it suggests that a decision to purchase would be made very carefully.
- (c) I have taken note of the fact that the majority of schools are in receipt of government funds and are accountable for their spending. They would therefore pay more attention to their purchases. Careful enquiries would be made and it is highly unlikely that in these circumstances any school would be so easily deceived.
- (d) The Opponent places heavy reliance on the instances of alleged actual confusion in support of its case on misrepresentation under Section 8(7)(a). However, for the reasons stated at [81] – [93] above, I do not consider that these instances assist the Opponent.

Damage

114 I have found that there was no misrepresentation and therefore the issue of damage (or likelihood thereof) to the Opponent’s goodwill does not arise.

Opposition under Section 7(6): Bad faith

115 The third and final ground of opposition is Section 7(6), which provides that a trade mark “*shall not be registered if or to the extent that the application is made in bad faith*”.

116 The leading case on this provision is the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). A summary of the applicable principles is as follows:

- (a) Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve ‘no breach of any duty, obligation, prohibition or requirement that is legally binding’ upon the registrant of the trade mark’ (see *Valentino* at [28]).
- (b) The test contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Thus, “bad faith” as a concept is context-dependent. In the

final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case (see *Valentino* at [29]).

- (c) Once a *prima facie* case of bad faith is made out by the Opponent, the burden of disproving any element of bad faith on the part of the Applicant would arise (see *Valentino* at [36]).
- (d) An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference (see *Valentino* at [30]). However, as observed in *Ng-Loy* at [21.4.1], footnote 109, this does not mean that there is an absolute prohibition against drawing inferences. In support of this observation, Professor Ng-Loy cited the decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.
- (e) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion (*Valentino* at [20]).

117 The Opponent has advanced three lines of argument in relation to its allegation of bad faith. I will deal with each in turn.

A similar mark for an identical product?

118 In essence, the Opponent's first argument is premised on the allegation that the Applicant acted in bad faith by adopting a similar mark for an identical product.

119 The Opponent's case is that it had commenced the marketing of its SNAC app "*as early as July 2012 shortly before the Applicant allegedly coined the mark "snaapp"*". It argued that given the "*extremely contained*" nature of the target audience of both parties' apps, the Applicant's actions in "*using such a similar mark for an identical product must only point towards an intent to ride upon the Opponent's goodwill and/or to profit from the confusion with the Opponent's product*".⁵⁷

120 The Applicant's case is that it had "*already been working on their mobile application "snaapp" from as early as April 2012*", which was "*much earlier than the Opponent's registration on 30 September 2013*". It pointed to the fact that by 24 July 2012, snaapp had already been uploaded as a mobile application on Google Play. According to the Applicant, for this to have taken place, it would have had to put in a least 1 year's work into developing and improving snaapp (*i.e.* well before July 2012). The Applicant also contends that from both its (*i.e.* subjective) and an objective point of view, the competing marks "*are not similar*" and are "*distinguishable*".⁵⁸

121 I have found the competing marks to be substantially dissimilar. Moreover, the evidence before me shows that by 24 July 2012, the Applicant's snaapp app was already available for download from Google Play, whereas the Opponent's SNAC app was "*officially launched*" on 5 December 2012. And, the evidence of first use in relation to marketing shows that both parties

⁵⁷ Opponent's Written Submissions at [44.1]

⁵⁸ Applicant's Written Submissions at [28] – [30]

started using their respective marks in July 2012. This is arguably a case of legitimate competition, not bad faith.

Application to register in respect of identical goods and services

122 The Opponent's second line of argument is premised on the fact that the Applicant was aware of the SNAC Mark, and applied to register the Application Mark for the same goods and services in the same classes. In its submission, "*the fact that they copied the Opponent's descriptions wholesale, goes to show their intentions of imitating the Opponent*".⁵⁹

123 The Applicant does not dispute that it was aware of the SNAC Mark and that it copied the specifications of goods and services, but contends that it "*honestly believed that the description was a template description and that there was nothing wrong with following it*". It argued that there is nothing proprietary about the description of the specifications, and that all of them can be found on the IPOS' website. It submitted that there is no other way to describe its trade mark other than by using those words, and that it should not be faulted for wanting to save time, effort and costs by using what it thought to be a template accessible in the public domain.⁶⁰

124 In my judgment, the mere fact that one trader has applied to register its trade mark for the same goods or services as another trader cannot, without more, amount to bad faith. I agree with the Applicant that there is nothing proprietary about the specification of goods or services in the classes applied for. At a very fundamental level, the specification indicates to the Registrar and the public that the claimed goods and/or services are those which the applicant/proprietor intends to apply its trade mark to. The fact that a certain description has previously been accepted by the Registrar for registration means no more than that it is an appropriate claim for goods or services falling within that relevant class. There is nothing wrong with conducting a search to see what a competitor has registered its marks for and then applying to register a dissimilar mark for the same goods and/or services.

125 That said, I am prepared to accept that in very limited circumstances such as trade mark squatting, the wholesale copying of the specification of goods and/or services may be relevant towards a finding of bad faith. However, this is not such a case.

Price matching

126 The Opponent's third line of argument is based on price matching. It argued that the Applicant first priced its product at S\$9,000 but then later lowered it to match that of the Opponent (at S\$2,998).⁶¹ However, I fail to see how selling one's goods/services at the same price as that of a competitor can amount to bad faith. Moreover, it is clear to me from the evidence that there was a good reason for both parties to fix the price of a one year subscription at S\$2,998: it made things convenient for their clients (here: mainly the schools) because they did not have to go through the GeBiz system.⁶²

⁵⁹ Opponent's Written Submissions at [44.2].

⁶⁰ Applicant's Written Submissions at [31] – [33]

⁶¹ Opponent's Written Submissions at [44.3].

⁶² At the material time, for procurements below S\$3,000, the procurement procedure adopted by a government entity (including government schools) could be by way of a small value purchase. Under this procedure, a government entity could make a purchase directly from suitable suppliers or off-the-shelf (provided the prices assessed reflect fair market value), without having to go through the GeBiz system.

Consequence of there being no cross-examination

127 I should add that neither party sought to cross-examine the counter party's deponent(s). As the Opponent rightly submitted, the consequence of there being no cross-examination is that I am left to decide the issue of bad faith based on the documents before me. I should be very careful to draw any adverse inferences against either party unless it is very clear that I should do so on the face of the documents before me (*Arjo Wiggins Fine Papers Limited v Transasia Fine Papers Pvt Ltd* [2016] SGIPOS 2 at [19]), and I have borne this in mind.

128 In this case I cannot see how, on the face of the evidence and documents before me, I can draw an inference of bad faith. Consequently the opposition on Section 7(6) fails.

Conclusion

129 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. The Applicant is entitled to costs to be taxed, if not agreed.

Dated this 12th day of December 2016

Mark Lim Fung Chian
Principal Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore