

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

Trade Mark No. T1316540G
Hearing Date: 23 June 2017

IN THE MATTER OF A TRADE MARK APPLICATION BY

NUNUFISH.COM

AND

OPPOSITION THERETO BY

U-MANGA INTERNATIONAL BUSINESS CO., LTD

Hearing Officer: Ms See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

Representation:

Ms Devi Haridas (Belinda Ang Tang & Partners) for the Opponents

Mr Premsai Chandrasekaran (Mirandah Asia (Singapore) Pte Ltd) for the Applicant

GROUND OF DECISION

1 Trade marks are valuable intellectual property rights. They can be exploited in a myriad of ways. They can cross borders with the goods to which they are applied, and reach new markets. They link manufacturers and distributors in the ecosystem, who together make inroads into the hearts and hands of consumers. But what happens when things go sour? This case involves two parties who had very different ideas about the trade mark in issue.

2 The dispute at hand is an opposition to the registration of a trade mark (“Application Mark”), with details as follows:

TM No.	T1316540G
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Application Date	16 October 2013 (“the Relevant Date”)
Mark	footpure
Class	3
Specification of Goods	Non-medicated foot powders

3 The applicant seeking to register the Application Mark is Nunufish.com, a sole proprietorship in the name of Yee Won Lee (“the Applicant”), who is also known as Yvonne Yee. Unless the context otherwise suggests, references to “the Applicant” in this decision are references to the natural person (Yee Won Lee), being the sole proprietor of Nunufish.com. The opponents to the registration of the Application Mark are U-Manga International Business Co., Ltd (“the Opponents”).

Background

4 The Opponents own the registered trade mark “footpure” in Taiwan and have applied to register the same mark in Singapore on 15 April 2014 under TM No. T1405707A in Class 3 in respect of “Non-medicated foot powders; body talcum powder; cosmetic powder; non-medicated powders”. They claim to have used the mark “footpure” in Singapore since around January 2013.

5 The Opponents appointed Unikoko International Enterprise Co. Ltd as their sole distributor of “footpure” products for overseas markets. Chan Yi-Yao, also known as Lantis Zhan, is a director of Unikoko International Enterprise Co. Ltd. She appears to be the key woman dealing with overseas distributors of “footpure” products. Her evidence is addressed below, in my consideration of the element of “goodwill” under the tort of passing off. We will also encounter another entity, Simply Beauty House, who was a Singapore distributor of “footpure” products.

6 The Applicant is an online seller of various personal care products (such as skin care products and hair care products) and baby care products at her website, www.nunufish.com. Products under a number of brands are sold on this website. Such brands include Pigeon, Crabtree & Evelyn, Clarins, Bioré, Kosé and Hada Lobo.

7 The Application Mark was accepted and published on 28 February 2014 for opposition purposes. The Opponents opposed this application on 25 June 2014 and re-filed their opposition form on 26 August 2014 to rectify a deficiency. The Applicant’s Counter-Statement was filed on 14 October 2014. A case management conference was convened on 19 January 2015. Further to this case management conference, the Opponents filed evidence in support of the opposition on 17 April 2015. The Applicant filed evidence in support of the application on 20 July 2015. The Opponents filed evidence in reply on 23 November 2015. The pre-hearing review was conducted on 15 December 2015, further to which parties attempted to settle their dispute without prejudice. Negotiations having stalled, a further pre-hearing review was convened on 4 August 2016. The Opponents re-executed their deficient statutory declarations and filed these on 21 October 2016.

8 On 4 October 2016, the Opponents also sought to amend their purported ground of opposition from Section 8(5) to Section 7(6)¹ of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). It is understandable why the Opponents sought to do so, as Section 8(5) is not a substantive ground of opposition on its own, but qualifies Section 8(4) in a scenario of bad faith, Section 8(4) being the substantive ground of opposition. In contrast, Section 7(6) is the standalone, substantive ground to plead if bad faith in an application is the basis for the opposition; and much of the Opponents’ evidence steers in this direction. The parties were directed to engage each other and eventually agreed, on 16 December 2016, that the Opponents would “retain the ground of opposition under Section 8(5) of the Trade Marks Act”, with the implication that the latter would no longer pursue their request to substitute Section 7(6) for Section 8(5) as a ground of opposition. The Registrar, by letter dated 19 December 2016, clarified, with reference to HMD Circular 1/2013, that “Section 8(5) is not a ground of opposition as such, but a qualification of the ground of opposition under Section 8(4). Therefore, even though the parties have agreed to the position... the effective outcome is that there is no substantive ground of “bad faith” recognised (as a ground) at the substantive hearing of this opposition.”

9 A third pre-hearing review was conducted on 11 January 2017, further to which the Opponents sought leave to cross-examine the Applicant’s witness, Anton Widjaja. After hearing the parties’ representations, the Registrar gave leave to the Opponents to cross-examine Anton Widjaja on the issues set out in the Opponents’ representations.

Grounds of Opposition

10 The grounds of opposition on which the Opponents rely in this opposition are three, namely Sections 8(2)(a), 8(4)(a)-(b)(i) and 8(7)(a) of the Act.

Opponents’ Evidence

11 The Opponents’ evidence comprises the following:

- (i) a Statutory Declaration made by Chu Yuan-Kuei, Director of the Opponents, on 4 January 2016 in Tainan, Taiwan R.O.C. (“the Opponents’ 1st SD”);
- (ii) a Statutory Declaration in Reply made by the same Chu Yuan-Kuei on 4 January 2016 in Tainan, Taiwan R.O.C. (“the Opponents’ 2nd SD”);
- (iii) a Statutory Declaration in Reply made by Chan Yi-Yao, Director of Unikoko International Enterprise Co. Ltd, on 4 January 2016 in Tainan, Taiwan R.O.C. (“the Opponents’ 3rd SD”); and
- (iv) a Statutory Declaration in Reply made by Gan Wee Chee, Manager of Simply Beauty House and Morenmore Marketing Pte Ltd (the latter of which took over the business of the former), on 18 December 2015 in Singapore (“the Opponents’ 4th SD”).

Applicant’s Evidence

12 The Applicant’s evidence comprises a Statutory Declaration made by Anton Widjaja, Manager of Nunufish.com, on 20 July 2015 in Singapore (“the Applicant’s SD”).

¹ Section 7(6) reads “A trade mark shall not be registered if or to the extent that the application is made in bad faith.” For comparison with Section 8(5), see [43] of these grounds of decision which sets out the provision.

13 At the hearing, the same Anton Widjaja also gave oral testimony as a result of the Opponents being granted leave to cross-examine this witness. We note from his oral testimony that he only joined Nunufish.com as manager around mid-2013.

Applicable Law and Burden of Proof

14 The applicable law is the Act. Hence, there is no overall onus on the Applicant either before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case rests on the Opponents.

MAIN DECISION

15 It is the Opponents' case that the Applicant was aware of the Opponents' rights to the Application Mark, "footpure", but being keen to cash in on the demand for the Opponents' "footpure" goods in Singapore, the Applicant sought to register the mark in her sole proprietorship's name (on 16 October 2013) after her licence was terminated by the Opponents (on 14 October 2013). The Opponents therefore oppose the registration of the Application Mark in the name of Nunufish.com. In this context, the Opponents have chosen to first deal with the ground of opposition under Section 8(7)(a), which has to do with the common law tort of passing off. My decision likewise deals first with Section 8(7)(a), which is the strongest ground of opposition.

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

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

A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

...

Decision on Section 8(7)(a)

17 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] SGCA 33 ("*Singsung*") set out the legal framework for the tort of passing off at [26]-[28] as follows:

26 The basic principle undergirding the law of passing off is that a trader should not sell his or her goods on the pretext that they are the goods of another trader. There are two oft-quoted formulations of the tort of passing off. The first is found in Lord Diplock's speech in *Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Ltd and another* [1979] 1 AC 731 ("*Advocaat*") at 742 where Lord Diplock stated five characteristics of a cause of action in passing off, namely: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

27 The second formulation is the “classical trinity” stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] WLR 491 (“*JIF Lemon*”) at 499:

... The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether this consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. ... Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

28 Both Lord Diplock’s five characteristics in *Advocaat* and Lord Oliver’s reformulation in *JIF Lemon* have found expression in the judgments of our courts (see, for example, *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Novelty*”) at [36]). It has been suggested in a number of cases that there is no difference between these formulations, and that the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty* at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 (“*Nation Fittings*”) at [148]). We accept this, by and large, as the correct position. However, we also agree with Prof Wadlow’s view that Lord Diplock’s five characteristics, focussing as they do on the issue of misrepresentation and damage, “probes more deeply into the inwardness of the tort” (Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011) (“*Wadlow on Passing Off*”) at para 1–027). The essence of passing off – that no person is permitted to steal another’s trade *by deceit* – must not be forgotten. What the tort seeks to protect is not the plaintiff’s use of a mark, name or get-up *per se*; rather, the tort seeks to prevent the defendant from causing damage to the plaintiff by committing an actionable misrepresentation.

18 With the above in mind, I examine the elements of passing off in turn.

Goodwill

19 The Court of Appeal in *Singsung* clarified the nature of goodwill at [33]-[34] as follows:

33 The goodwill relevant to a passing off action is not goodwill in the mark, logo or get-up (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“*CDL Hotels*”) at [45]). Instead, the tort of passing off protects a trader’s *relationship* with his customers. As was stated by Lord Parker of Waddington in *AG Spalding & Bros v A W Gamage Ld* (1915) 32 RPC 273 at 284:

There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question – property in what? Some authorities say property in the mark, name, or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v Banham* (LR (1906) AC 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think strong reasons for preferring the latter view. ...

34 In our judgment, goodwill, in the context of passing off, is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses (see *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 (“*Lifestyle 1.99*”) at [20]–[24]; *Wadlow on Passing Off* at paras 3–003 and 3–004; James Mellor QC *et al*, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) (“*Kerly’s Law of Trade Marks and Trade Names*”) at para 18–100). Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys: *CDL Hotels* at [46]. Goodwill may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear (see *SPGA* at [22]).

20 I consider the following items of the Opponents’ evidence in relation to their claim to goodwill:

- (i) Printouts from online marketplace Qoo10 under the seller Simply Beauty House (Exhibit C of the Opponents’ 1st SD; pages 7 to 25 of Exhibit GWC-1 of the Opponents’ 4th SD)
- (ii) Printouts from online marketplace Qoo10 under the seller Morenmore (pages 26 to 59 of Exhibit GWC-1 of the Opponents’ 4th SD)
- (iii) Advertising and exhibition activities (Exhibit K of the Opponents’ 1st SD)
- (iv) Email correspondence (Exhibit J of the Opponents’ 3rd SD)
- (v) Documents pertaining to two shipments of “footpure” goods from Taiwan to Singapore ([4], [22] to [24] and Exhibits B, K and L of the Opponents’ 3rd SD).

Qoo10 website printouts under the seller Simply Beauty House

21 Item (i) above shows “footpure” foot powder on sale. There are pictures and descriptions of the products. The usual details found on an online marketplace can be seen e.g. price, shipping options, payment options and manufacturer / place of origin. The goods are offered for sale by the seller Simply Beauty House. The Applicant submits that there is no link between the Opponents and the products on sale. The Opponents were not able to rebut this from the exhibit itself, but referred to the Opponents’ 4th SD (made by the manager of Simply Beauty

House) to submit that Simply Beauty House sold the Opponents' "footpure" goods in Singapore.

22 Although this was not pointed out by the Opponents' agents at the hearing, I also note that item (i) above (at page 32 of Exhibit C of the Opponents' 1st SD; mirrored at page 20 of Exhibit GWC-1 of the Opponents' 4th SD) clearly reflects the Opponents' name, "U-manga Int'l business CO., LTD". Within the listing of "footpure" foot powder by Simply Beauty House on the online marketplace Qoo10, the Opponents' name appears in even larger font than Simply Beauty House's. Their name appears in the context of a warning to customers against buying "counterfeit" products and strongly suggests that "U-manga Int'l business CO., LTD" is the source of the "original" "footpure" foot powder. To make things even clearer, the same Qoo10 listing states that "Simply Beauty House and Morenmore.com.sg are the company's authorised merchants in Singapore" (at pages 20-21 of Exhibit C of the Opponents' 1st SD; mirrored at pages 8-9 of Exhibit GWC-1 of the Opponents' 4th SD).

23 The Opponents also rely on item (i) above to demonstrate, not only that they have traded in "footpure" products through their distributors in Singapore, but that such business activity took place before the Relevant Date. For this, I was referred to the customer review and Q&A sections of Simply Beauty House's online listing. The earliest customer review is dated 18 January 2013, which is earlier than 16 October 2013, the Relevant Date. The review says "Fast delivery. Item smaller than expected and I fe.." [truncated on website]. The Applicant objected to the relevance of item (i) because the printout of it is dated 23 May 2014; and because of hearsay. However, I accept the Opponents' point that the earliest customer feedback points to an earlier point in time, prior to the Relevant Date; and that the Opponents are not relying on the truth of what was said in the various customer reviews, but on the fact that they were made (on dates before the Relevant Date) in relation to the sale of "footpure" foot powder. I also accept Gan Wen Chee's evidence at [6] of the Opponents' 4th SD that "Sometime in January 2013, my company started selling online the "footpure" products on the Qoo10 platform." As such, item (i) is relevant to demonstrating the Opponents' business activity before the Relevant Date.

Qoo10 website printouts under the seller Morenmore

24 Item (ii) above is similar to item (i), except that it shows "footpure" products sold under a different seller Morenmore, and the earliest date of customer review reflected is 28 August 2013. The latter is prior to the Relevant Date. Item (ii) was printed on 18 November 2015, after the Relevant Date, but, as with item (i), I accept that the earliest customer feedback points to an earlier point in time, before the Relevant Date. I also note the prominent notice on the site declaring, "Please buy with confidence! Our products are AUTHENTIC and DIRECTLY IMPORTED from the manufacturer" (page 28 of Exhibit GWC-1 of the Opponents' 4th SD). This presupposes that the source of "footpure" products is other than the seller Morenmore itself. The Opponents' 4th SD also suggests, at [6], that "Morenmore" as appears in the online listing that is item (ii) above, is the same entity as Morenmore Marketing Pte Ltd referred to in the main body of that statutory declaration. As for the relationship between Simply Beauty House and Morenmore, I note Gan Wen Chee's evidence at [1] of the Opponents' 4th SD that "The business of Simply Beauty House has been taken over by Morenmore Marketing Pte Ltd. I am also the manager of this company." It is a missed opportunity that Gan Wen Chee, as manager of Morenmore Marketing Pte Ltd, did not take the opportunity to state the latter's source of "footpure" products (which had been clearer in the case of Simply Beauty House). Overall, item (ii) goes towards demonstrating the sale of "footpure" products in Singapore

before the Relevant Date, though the connection with the Opponents is rather more tenuous as compared to item (i).

Advertising and exhibition activities

25 Item (iii) of the above purports to demonstrate advertising and exhibition activities of the Opponents. Pages 73 to 81 of Exhibit K of the Opponents' 1st SD are undated printouts from the online marketplace, Qoo10. While they show the mark "footpure" in use, they do not reflect a link to the Opponents, or at least to a source other than the Applicant. They are therefore of very limited relevance to the goodwill inquiry at hand.

26 Pages 82 to 89 of item (iii) above pertain to an exhibition in Malaysia, at Putra World Trade Centre, from 14 to 17 July 2014. However, again, these pages do not show a link to the Opponents, or at least to a source other than the Applicant. The closest connection observed is the attendance of a Lantis Zhan, also known as Chan Yi-Yao as inferred from [12] of the Opponents' 2nd SD, and the deponent of the Opponents' 3rd SD. However, the exhibitor tag of Lantis Zhan states her organisation as "MZ Eyelash Co Ltd", rather than U-Manga International Business Co., Ltd (the Opponents) or Unikoko International Enterprise Co. Ltd (her company as stated in the Opponents' 3rd SD). There is therefore no clear link between the "footpure" products claimed to be displayed at the exhibition and the Opponents.

27 Pages 90 to 173 of item (iii) above have been labelled "Exhibition in China & Advertising Documents" by the Opponents. There are photographs of what appear to be exhibition halls and displays of "footpure" products. Regrettably, the events' details are skimpy. A sign stating "Shanghai New International Expo Centre" (at pages 105, 107) suggests that at least one exhibition took place in Shanghai – but, no indication of the date can be discerned. Another photograph (at page 134) shows a lady dressed in ethnic costume in an exhibition setting, holding a brochure for what appears to be "footpure" products, with a speech bubble that says "footpure awaits you in Inner Mongolia Autonomous Region" (translated from Chinese). Yet another photograph (at page 137) shows a different lady, this time holding the actual "footpure" products, and the superimposed words "We await you at the Taichung Beauty Fair" (translated from Chinese). Apart from photographs relating to exhibitions, there are advertisements on "footpure" products in Chinese language magazines such as "BEAUTY" (at page 139) and "NEW EASTERN", the inflight magazine of Far Eastern Air Transport, dated Nov-Dec 2014 (at pages 171 to 172). The former shows the retail price of "footpure" powder in Taiwan dollars, suggesting that the magazine's circulation is in Taiwan. The latter shows the retail price in three currencies: Taiwan dollars, US dollars and Chinese yuan. This multi-currency pricing is consistent with the advertisement being placed in an inflight magazine. Finally, pages 90 to 173 of item (iii) also comprise unlabelled, undated photographs of "footpure" products on display in shelves or held by what appears to be models or spokespersons. Some printouts are of online sites, blogs and microblogs (jumei.com, 9night.kimiss.com, weibo) where "footpure" products are sold or featured.

28 In the present consideration of whether the Opponents (or someone other than the Applicant) have relevant goodwill (as demonstrated by business activity in Singapore), pages 82 to 173 of item (iii) above are not helpful. The Opponents have not pointed out how the exhibition, promotion and sale of "footpure" products outside Singapore or to audiences that do not appear to be sited in Singapore (and at mostly unknown dates) assist in establishing the Opponents' goodwill within Singapore.

Email correspondence

29 Moving on to item (iv) of the above, I observe that this comprises email correspondence between the Applicant (the sole proprietor, Yee Won Lee also known as Yvonne Yee) and the deponent of the Opponents' 3rd SD, Chan Yi-Yao (also known as Lantis Zhan). The emails are dated between 3 and 6 August 2013 inclusive, before the Relevant Date. The context of the conversation was the Applicant trying to get Lantis Zhan (whose email signature contained the Opponents' corporate name and whose email address, umanga.lantis@gmail.com, incorporated part of the Opponents' name) to take action so that the parallel importer in Singapore would pull its "footpure" products off the shelves temporarily in order for the Applicant to expand her sales channel to BHG department stores in Singapore. In her email to Lantis Zhan dated 3 August 2013, Yvonne Yee writes, "... I hope you can contact them on Monday and let me know the progress. I have already typed the reply in English, I only need your side to prove that the company is the owner of the brand registration." When Lantis Zhan replied to Yvonne Yee on 6 August 2013, suggesting that the latter contact the parallel importer directly, Yvonne Yee responded with her reason why it would be more effective for Lantis Zhan's office to do so instead, saying, "I know very well that *as a distributor*, the communication is not as good compared to direct contact between manufacturers. Actually, I just hope that they can pull the products off the shelves temporarily..." (italics mine). This email exchange suggests to me that, in August 2013, before the Relevant Date, Yvonne Yee saw the Opponents as the owner of the "footpure" brand and herself and her sole proprietorship (the Applicant) as the distributor in Singapore.

Documents pertaining to shipments

30 Item (v) of the above list of evidence purports to demonstrate that there were business dealings between the Applicant and the Opponents' distributor for overseas markets, Unikoko International Enterprise Co. Ltd., which materialised in two shipments of "footpure" goods from Taiwan to Singapore before the Relevant Date. Exhibit B of the Opponents' 3rd SD is an export declaration dated 1 August 2013. It reflects the exporter/seller as "Unikoko International Enterprise Corp", the buyer as the Applicant (with a Singapore address) and the goods being exported as "footpure" shoe powder of 45g units and 10g units, in two cartons. Exhibit K of the Opponents' 3rd SD comprises an invoice, a packing list and an export declaration, all dated 15 August 2013. Again, the latter reflects the exporter/seller as "Unikoko International Enterprise Corp", the buyer as the Applicant and the goods as "footpure" shoe powder (in 10g units), in two cartons. The invoice and packing list corroborate these details. Exhibit L of the Opponents' 3rd SD is an email chain showing a discussion between the Applicant and Lantis Zhan (of email address umanga.lantis@gmail.com – this suggests that Lantis Zhan acts for the Opponents) on the second shipment of 15 August 2013. The Applicant (Yvonne Yee) raised the issue that the original parcel was too light and needed to weigh more than 30kg, or else the freight would double. As such, she proposed two solutions and ended her email with "Please let me know, I need the goods urgently. Thank you." Lantis Zhan then replied on the same night, on 14 August 2013, "This is the new invoice and packing. Please check. Ask DHL to come collect the parcel in the afternoon. And please transfer the additional amount. Thank you." The latter email exchange would be consistent with the export of the second batch of "footpure" products to the Applicant in Singapore on the following day, on 15 August 2013. Overall, I gather from these exhibits that there was a seller and buyer relationship between the Opponents' authorised distributors and the Applicant.

31 I have reviewed the Opponents' evidence and found some areas lacking, irrelevant or ambiguous. Notwithstanding, following my positive assessment of item (i) above, and applying [34] of *Singsung*, I find that goodwill is established. This view is corroborated by the inference drawn from items (iv) and (v) in the preceding paragraphs.

Misrepresentation

32 With regard to this stage of the inquiry into passing off, the Court of Appeal in *Singsung* at [38] to [40] elucidated the principles as follows:

38 In our judgment, the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation. Simply put, if a mark or get-up is not distinctive of the plaintiff's products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or are economically linked to the plaintiff. Indeed, it has been said (in the context of an alleged representation consisting of the use of a name in connection with goods) that proof that the name has become distinctive of the plaintiff's goods is a "condition precedent" to the success of a passing off action: per Viscount Simmonds in *T Oertli AG v E J Bowman (London) Ld* (1959) RPC 1 at 4. Similarly, where the alleged representation consists of the use of the get-up, the plaintiff is required to prove that the get-up in question has become distinctive in the sense that the relevant segment of the public recognises goods with that get-up as originating from the plaintiff. If it is found that the mark or get-up *is* distinctive of the plaintiff, then the next question is whether the use of similar indicia by the defendant amounts to a misrepresentation.

39 The foregoing analysis is also consistent with our remarks in other cases (see, most recently, *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] SGCA 25 ("AMC") at [82] as well as *SPGA* at [20] and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("Hai Tong") at [115]) where we analysed the issue of distinctiveness in the context of the inquiry into misrepresentation. In this connection, the steps to be taken in the inquiry as to misrepresentation were summarised in *SPGA* (at [20]) as follows:

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

40 Whether misrepresentation has occurred is a question to be determined by the court in the light of the surrounding circumstances. The misrepresentation in question must give rise to confusion (or the likelihood thereof) in order to be actionable under the law of passing off. This is ultimately a matter for the court's judgment and it is not to be determined on a visual side-by-side comparison. Rather it is to be assessed from the vantage point of a notional customer with imperfect recollection...

33 In the present case, the distinctiveness of the mark "footpure" in relation to the Opponents' goods is not in serious issue, given the nature of the mark itself, the Opponents' evidence of the prior use of this mark in Singapore and the fact of the existence of customer feedback before the Relevant Date (which has, incidentally, continued after the Relevant Date, to number 1224 feedback entries as on 23 May 2014, under Simply Beauty House).

34 In coming to the above finding on the threshold inquiry, I am cognisant of the Applicant's claims (which I do not accept) that she conceived the mark "footpure" independently and has rights to the mark. The items of evidence in support of this claim are:

- (i) A quotation of RM1000 provided by Gold Win Design Sdn Bhd to Nunufish.com on 10 December 2008 for an office signboard as follows (Exhibit AW-07 of the Applicant's SD):



- (ii) Anton Widjaja's claim at [16] of the Applicant's SD that "As early as 2009, several entities expressed interest to buy the Applicant's products bearing the mark "FOOTPURE" and/or **footpure**". Annexed herewith and marked as EXHIBIT 'AW-08' is a certified true copy of one such request from an entity names YBH Heng Enterprise." This exhibit, a letter from YBH Heng Enterprise in Kuantan, Pahang, Malaysia is dated 30 March 2009. It is a request for a "price quotation for 1000 units of the FOOTPURE foot deodorant" purportedly to be used as annual gifts.

35 Suffice it to say that neither of the above two items of evidence, whether individually or collectively, establish that "footpure" is distinctive of the Applicant's goods in Singapore. Apart from the doubts cast by the Opponents over these exhibits in the Opponents' 2nd SD and in submissions, even if I were to take the evidence at face value, a quotation for a signboard and a request for quotation from a company in Malaysia do not adequately demonstrate that the Singapore public recognises that foot powder with the mark "footpure" originate from the Applicant. It would be within the Applicant's ability to produce evidence of sales of "footpure"-branded foot powder in Singapore by the Applicant before January 2013 (the earliest time the Opponents could establish the sale of their "footpure" foot powder in Singapore), if such sales existed, but the Applicant did not. In the absence of better evidence,

it would be too much of a stretch for me to find that distinctiveness of the mark “footpure” is in relation to the Applicant’s goods rather than to the Opponents’ goods.

36 Thus, having considered both parties’ evidence, I find that the Opponents have crossed the “*threshold inquiry*”. I am persuaded that the Opponents’ goodwill is in fact associated with the “footpure” mark.

37 Turning to the crux of the second element, namely whether the alleged misrepresentation creates a likelihood of confusion, it bears saying that the Application Mark is practically identical to the “footpure” mark as used by the Opponents, being in plain font and in the lower case: **footpure**. Since the Opponents enjoy goodwill before the Relevant Date and the “footpure” mark is distinctive of the Opponents’ goods, the reasonable conclusion is that the public is likely to be deceived or confused into thinking that the Applicant’s goods are the Opponents’, or emanate from a source that is linked to the Opponents.

Damage

38 As regards damage, the Court of Appeal in *Singsung* states at [87]:

The element of damage may be dealt with briefly. In our judgment, in view of the respondent’s misrepresentation, it is indisputable that the appellant’s goodwill would be adversely affected through a diversion of custom, given that the appellant and respondent were competing in exactly the same line of products and in the same export jurisdictions.

39 As I found actionable misrepresentation above, I am also persuaded that the Opponents’ goodwill “*would be adversely affected through a diversion of custom*”, given that the Opponents and Applicant compete in the same lines of products and even operate in the same online retail environment, targeting customers in Singapore.

Conclusion on Section 8(7)(a)

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

Grounds of Opposition under Sections 8(2)(a) and 8(4)(a)-(b)(i)

41 Section 8(2)(a) of the Act reads:

(2) A trade mark shall not be registered if because —
(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected,
...
there exists a likelihood of confusion on the part of the public.

42 Section 8(4)(a)-(b)(i) of the Act reads:

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

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

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

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

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

Is There An Earlier Trade Mark?

44 Both grounds of opposition under Sections 8(2) and 8(4)(a)-(b)(i) are premised on the existence of an “earlier trade mark”. The definition of this term is set out in Section 2(1) of the Act as follows:

“earlier trade mark” means –

- (a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered.

45 The primary question here is: Is there an “earlier trade mark”? More specifically, since there is no relevant registration or pending application that pre-dates the relevant date, is there a *well known* earlier trade mark? If so, this can be taken into account as an “earlier trade mark” – as envisaged in (b) of the term’s definition at Section 2(1). Section 8(4) also mandates that such “earlier trade mark” be well known in Singapore.

46 As to what constitutes a “well known trade mark”, Section 2(1) states:

“well known trade mark” means —

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —
 - (i) is a national of a Convention country; or
 - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore.

Well Known in Singapore: Principles

47 In assessing whether a trade mark is well known in Singapore, the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and Another* [2009] 3 SLR(R) 216 ("*Amanusa*") held that regard must be had to Section 2(7) of the Act which states:

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

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

48 In interpreting how these factors should assist the court, the Court of Appeal in *Amanusa* held at [137] that "*it appears that the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires (subject to [Section 2(7)(a) of the Act]), and to take additional factors into consideration.*"

49 Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore due to Section 2(8) of the Act, which states that "[w]here it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore", see [139] of *Amanusa*.

50 Consequently, for "footprint" to be deemed to be well known in Singapore, it needs only to be well known to any relevant sector of the public in Singapore.

Relevant Sector of the Public

51 Section 2(9) defines the "relevant sector of the public in Singapore" in Section 2(7) and 2(8) as including any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods to which the trade mark is applied;

- (c) all businesses and companies in Singapore dealing in the goods to which the trade mark is applied.

52 The court in *Amanusa* discussed the ambit of the phrase "*all actual consumers and potential consumers in Singapore of the goods*" at [152] and concluded that "*the inquiry is much more focused and manageable if one looks only at the specific goods or services to which the [Opponents'] trade mark has been applied (i.e., if one considers only the [Opponents'] goods or services).*"

53 Both parties did not articulate what the relevant sector of the public was in the present case, beyond referring to the relevant legislative provisions. Is the phrase in Section 2(9), "the goods to which the trade mark is applied", to be narrowly scoped as "foot powders", or more broadly categorised as "footcare products", or even more widely couched as "personal care products"? There is usually a practical import as the wider the parameter, the more difficult it could be to establish the quality of being well known to a larger relevant sector of the public; and vice versa. However, as concluded at [61] below, this is inconsequential here.

Well Known in Singapore: Analysis

54 The evidence before me includes, in the main, the evidence set out above and considered in respect of the element of "goodwill" under Section 8(7)(a) above (at [20]-[31]). In addition, the Opponents also rely on the following points:

- (i) The fact that "footpure" is registered in the "home" territories of Taiwan and China (Exhibit A of the Opponents' 1st SD)
- (ii) The assertion that "it is common knowledge that Taiwan and China are popular tourist destinations for Singaporeans" ([34(3)] of the Opponents' written submissions)
- (iii) The Applicant's own acknowledgement that there was a sizable market for the Opponents' goods, which she was keen to capture ([34(6)] of the Opponents' written submissions interpreting Exhibit J of the Opponents' 3rd SD)
- (iv) Accolades and comments registered online since January 2013, and complaints and alerts registered as early as January 2014 against the Applicant's foot powders bearing the mark "footpure" ([34(7)] of the Opponents' written submissions interpreting pages 23, 61-62 of Exhibit GWC-1 of the Opponents' 4th SD).

55 Item (i) above is a factor recognised by Section 2(7)(c) of the Act. However, the issue is how "*it may be inferred that the trade mark is well known*" in Singapore (using the language of Section 2(7)(c)) based on this item of evidence. In the same vein, the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 ("*Caesarstone*") made clear at [113] that the crucial point is that the party relying on this "*has to show how the overseas registrations ... led to its mark being well known in Singapore.*" The Opponents offer some explanation at item (ii) above. Yet, the assertion that "it is common knowledge that Taiwan and China are popular tourist destinations for Singaporeans" is a bare one from the bar, and is not borne out by any evidence put before me. Further and in any case, even if the latter point is established, the Opponents have not shown how the Taiwan and China registrations, or even the use of the mark in Taiwan and China, would enter the consciousness of Singaporean tourists in those countries and to such an extent as to lead to the "footpure" mark being well known in Singapore.

56 Item (iii) was first described and considered at [29] above, in the context of goodwill. In the present context, the relevant parts of Yvonne Yee’s emails to Lantis Zhan say, “There will be a lot of expenses to establish the brand in the market, especially in terms of marketing and advertising. After successfully establishing a presence in major chain stores and marking the brand popular, the party that stands to gain from it is not me, but the parallel importers” and “...But if the current parallel import problem can be resolved, I will be able to seize the market. I keep telling you this because I’m confident of it.” Section 2(9)(b) of the Act recognises that distributors of the goods to which the trade mark is applied are part of the “relevant sector of the public in Singapore”, and Yvonne Yee is one of such. Her emails reflect her view that there is a market worth her efforts capturing. Nevertheless, this does not go so far as to show that “footpure” is well known in Singapore. Business ambitions and the potential of a brand are prospective and tangential to the real issue here.

57 Moving on, there are two parts to item (iv). First, so-called “accolades” and comments left by customers online on the Qoo10 portal. Examples include the following:

Item Review	Date	Rating
Fast delivery. Item smaller than expected and I fe... [truncated]	2013-01-18	Recommend
Item received in good condition. Yet to try hopefu... [truncated]	2013-01-19	Highly Recommend
Received yet to try hope it works	2013-01-20	Recommend
Although delivery was fast, item was small and not... [truncated]	2013-01-21	Neutral

58 The second part of item (iv) comprises “complaints and alerts” against the Applicant’s goods to which the mark “footpure” is attached, exhibited as printouts from the Qoo10 portal. The earliest complaint was dated 25 January 2014, and set out below with some of the later complaints:

Item Review	Date
Suspect counterfeit product I received one footpure which is not the one that the picture showing (<i>sic</i>). Seem (<i>sic</i>) like counterfeit product. not (<i>sic</i>) the original one	2014-01-25
Can not (<i>sic</i>) buy anything from this shop. Fake produ... [truncated]	2014-03-04
This shop is flooded with fake goods	2014-03-04
(this is a translation from feedback given in Chinese) Singaporeans can tell what is real. When you look at footpure’s [truncated], you can see that it is written very clearly. Thankfully, I did not place an order! Otherwise I would have been scammed. [truncated] received a bottle of the real thing and a bottle in the packaging shown in the picture. The seller even replied to say that it is a new packaging [truncated]	2014-03-04

59 The above merely demonstrates that the “footpure” mark and products were *known*, but not necessarily *well known*. In fact, on the totality of the evidence, it would be a fantastic stretch to find the mark “footpure” well known.

60 The Court of Appeal in *Caesarstone* elucidated at [101] on the threshold of being “well known” as follows:

... in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size. *Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.*

(italics mine)

61 Therefore, in the absence of better evidence from the Opponents, I am not able to conclude that the mark “footpure” is well known to the public in Singapore. This is the case no matter how the relevant sector of the public is scoped (see [53] above).

62 Since no earlier well known mark has been found at all (whether before or after the Relevant Date), Section 8(5), as set out at [43] above, on which the Opponents rely, does not come into play. I do not have to consider the Opponents’ allegations of bad faith on the part of the Applicant.

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

63 There being no earlier (well known) trade mark, the grounds of opposition under Sections 8(2)(a) and 8(4)(a)-(b)(i) accordingly fail.

Other Observations

64 The parties have filed other evidence pertaining to their prior interactions and relationship. Allegations have been made, but these were not relevant in the present case as the ground of opposition under Section 7(6) – that of bad faith – was not pleaded. Neither is this a rectification proceeding in which an initiator seeks to replace the proprietor on record with the alleged “rightful” proprietor. Therefore, it had not been necessary for me to review and make determinations based on those other evidence. One remark in hindsight is that the parties and the Registrar would have found it more straightforward and efficient if both parties’ evidence had been more streamlined and curated according to what needed to be established or defended against, with reference to the grounds of opposition.

Conclusion

65 Having considered all the pleadings, evidence and submissions made in writing and orally, I find that the opposition succeeds on the sole ground of Section 8(7)(a) and fails on the remaining two grounds (which hinged on the issue whether there was an earlier well known mark).

66 Accordingly, the Application Mark is refused registration. The Opponents are entitled to a third of their costs, to be taxed if not agreed.

Date of Issue: 12 September 2017

