

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

Trade Mark No. T0615045I  
Hearing Date: 7 July 2017

**IN THE MATTER OF A TRADE MARK REGISTRATION BY  
  
GUANGZHOU PHARMACEUTICAL HOLDING LIMITED**

**AND**

**APPLICATION FOR DECLARATION OF INVALIDITY THEREOF BY  
  
MULTI ACCESS LIMITED**

Hearing Officer:     Lee Li Choon  
                              IP Adjudicator

Representation:

Mr Freddy Lim (Lee & Lee) for the Applicants

Ms Anna Toh (Amica Law LLC) for the Registered Proprietors

**GROUND OF DECISION**

**Introduction**

1       Guangzhou Pharmaceutical Holding Limited is the present Registered Proprietor (“the Proprietor”) of the following trade mark in Singapore:

<b>TM No.</b>	<b>Mark</b>	<b>Class</b>	<b>Goods</b>	<b>Date of Application/Registration</b>
T0615045I	王老吉 WONG LO KAT	32	Beverages (non-alcoholic)	25 July 2006

(“the Proprietor’s Mark”)

2 The Applicant, Multi Access Limited is the owner of, *inter alia*, the following trade marks (hereafter referred to as the “Applicant’s Marks”) in Singapore:

TM No.	Mark	Class	Specification of Goods/Services	Date of Application/Registration
T9100470Z		05	Herbal preparations for medical use.	28 January 1991
T9201709J		30	Beverage (non-dairy based).	10 March 1992

3 The Applicant’s Marks have been registered since 28 January 1991 and 10 March 1992 in Classes 05 and 30 respectively. These were not the only marks registered by the Applicant in Singapore. As early as 27 September 1951, the Applicant registered the mark comprising a bottle gourd device with the Chinese characters “王老吉” displayed vertically within the bottle



gourd device in Singapore: (Reg. No. 14271). In 1961 (12 December 1961), the



Applicant registered the mark in respect of “Chinese medicine and herbs prepared as medicines” in Class 5 (Reg. No. 29811). It is to be noted that the Applicant is not relying on its earlier registration in Reg. No. 14271 for the purpose of its application for invalidation.

4 The Applicant applied for a declaration of invalidity on 3 October 2013. A Counter-Statement was filed by the Proprietor on 29 January 2014 in defence of the registration of the Proprietor’s Mark. The Applicant filed evidence in support of the invalidation on 3 June 2015. The Proprietor filed evidence in support of the registration on 16 January 2017. The Applicant filed evidence in reply on 13 April 2017. Following the close of evidence, a Pre-Hearing Review was held on 9 May 2017, leading to the hearing before me on 7 July 2017.

### Grounds of Invalidation

5 The Applicant relies on the following grounds for its application to invalidate the Proprietor’s Mark:

- (i) That the registration was made in bad faith and should therefore be invalidated under section 23(1) read with section 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”);
- (ii) That the Proprietor’s Mark is similar to the Applicant’s Marks and in respect of similar goods and should therefore be invalidated under section 23(3)(a)(i) read with section 8(2)(b) of the Act;
- (iii) That the Proprietor’s Mark is similar to the Applicant’s Marks which are well known in Singapore and should therefore be invalidated under section 23(3)(a)(iii) read with section 8(4) of the Act; and
- (iv) That the registration of the Proprietor’s Mark amounts to passing off the Applicant’s Marks contrary to law and should therefore be invalidated under section 23(3)(b) read with section 8(7)(a) of the Act.

### **Applicant’s Evidence**

6 The Applicant’s evidence comprises the following:

- (i) A Statutory Declaration made by Chan Hung To, Director of the Applicant, on 1 June 2015 in Hong Kong;
- (ii) a Statutory Declaration in Reply made by the same Chan Hung To on 30 March 2017 in Hong Kong; and
- (iii) a Statutory Declaration in Reply made by Wong Kin Yee, Agnes, Director of Wong Lo Kat (Enterprises) Limited, on 7 April 2017 in Hong Kong.

### **Proprietor’s Evidence**

7 The Proprietor’s evidence comprises a Statutory Declaration made by Chen Zhizhao, Head of Marketing Strategy Department of the Proprietor, on 9 January 2017 in Hong Kong.

### **Applicable Law and Burden of Proof**

8 As the applicable law is the Act, there is no overall onus on the Proprietor either before the Registrar during examination or in invalidation proceedings. The undisputed burden of proof in the present case falls on the Applicant.

### **Background**

9 The actual fact is that the mark in contention between both parties is essentially the mark with the Chinese characters “王老吉” (read in Cantonese as Wong Lo Kat and in Mandarin as Wang Lao Ji). The Applicant’s Marks as registered in Singapore have the Chinese characters written from right to left and the Proprietor’s Mark has the Chinese characters written from left to right.

10 The mark, “王老吉”, has a long history tracing all the way back to the creator, a Mr Wong Chak Bong (“the founder Wong”) who, as early as 1853, created a secret formula herbal tea which is known to have the effect of bringing down body heat. The founder Wong started his business selling tea in a herbal tea shop in Guangzhou in 1853. The founder Wong had 3 sons. After the founder Wong passed away, one of the descendants of the youngest son of the founder Wong, a Wong Heng Yu went to Hong Kong and continued the business there (“the Hong Kong branch”).

11 It would appear that some of the descendants of the founder Wong who remained in China later founded the business which, through a series of transformations as a result of the economic system in China, later became state-owned (“the China branch”). The brand “王老吉” went through a long series of transfers over 5 generations in both the China branch and the Hong Kong branch. Suffice to say that the name or trade mark, “王老吉”, ended up being claimed by both the China branch and the Hong Kong branch. For the China branch, the name “王老吉” is now being claimed by the entity, Guanzhou Pharmaceutical Holding Limited, the Proprietor. According to the Proprietor, the trademark “王老吉” was acquired by Guangzhou Pharmaceutical Holding Limited from Guangzhou Yangcheng Pharmaceutical Co. Ltd on 28 August 1997. For the Hong Kong branch, the name or trademark “王老吉” is now being claimed by Multi Access Limited.

12 It would appear that both branches have registrations all over the world. A quick observation of both branches’ registrations for the name or trade mark “王老吉” shows that registrations by the Hong Kong branch date back earlier, with the earliest registrations in 1991. The China branch, however, only started laying claims to the name or trademark “王老吉” through trademark registrations in 2011. The registrations belonging to the Hong Kong branch have a mixture of some being registered with the Chinese characters read from right to left and some being registered with the Chinese characters read from left to right. The China branch, however, have all their registrations with the Chinese characters read from left to right.

#### **Ground of Invalidation under Section 7(6)**

13 Section 23(1) of the Act reads:

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

14 And Section 7(6) of the Act reads:

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

#### ***Decision on Section 7(6)***

*Was the Proprietor’s registration in Singapore obtained in bad faith?*

15 In *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”), the Court of Appeal observed at [105] that “[t]he test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal” [emphasis in original]. It is to be noted that the provision in the English Trade Marks Act referred to by the Court of Appeal is *in pari materia* with our section 7(6). As it would be useful, I will set out in full the observations of the Court of Appeal at [104]–[106] which are as follows:

104 The concept of bad faith under s7(6) of the current TMA was first reviewed by the Singapore courts in *Rothmans of Pall Mall Ltd v Maycolson International Ltd* [2006] 2 SLR(R) 551 (“*Rothmans*”) (that case actually

concerned s7(6) of the Trade Marks Act (Cap 332, 1999 Rev Ed) (“the 1999 TMA”), which is identical to s7(6) of the current Act). In *Rothmans*, Lai Siu Chiu J endorsed (at [32]) Lindsay’s J’s formulation of the concept of bad faith in *Gromax Plasticulture*. This approach was also accepted by Rajah JA in *Warman* ([37] *supra*), where he stated (at [48]):

It would be fair to say *that the term ‘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 *Demon Ale Trade Mark* [2000] RPC 345 at 356; and [Tan’s *Law of Trade Marks* ([54] *supra*)] at p.129. [emphasis mine]

105 The test for determining the presence of bad faith, in the context of the English Trade Marks Act, was settled by the English Court of Appeal in *Harrison v Teton Valley Trading Co Ltd* [2004] 1WLR 2577, where Sir William Aldous, with whom Arden and Pill LJ agreed, expressed the test as follows (at [26]):

The words ‘bad faith’ suggest a mental state. *Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as [being] in bad faith by persons adopting proper standards.*

This test, which was referred to by Sir Aldous (*id* at [25]) as the “combined” test of bad faith, contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think).

106 Recently, this combined test of bad faith was succinctly explained in *Ajit Weekly Trade Mark* [2006] RPC 25 as follows (at [35] and [41]):

35 ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability [for] breach of trust set out by the majority of the House of Lords in *Twinsectra Ltd v Yardley* [2002] 2 A.C. 164, with *Gromax Plasticulture* [(103] *supra*)] ... providing the appropriate standard namely, acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.

...

41 ... [T]he upshot of the Privy [Council’s] decision in [*Barlow Clowes International Ltd v Eurotrust International Ltd* [2006] 1 WLR 1476] is: (a) to confirm the House of Lords’ test for dishonesty applied in *Twinsectra*, i.e. the combined test; and (b) to resolve any ambiguity in the majority of their Lordships’ statement of that test by making it

clear that an enquiry into a defendant's views as regards normal standards of honesty is not part of the test. ***The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant's conduct is dishonest judged by ordinary standards of honest people, the defendant's own standards of honesty being irrelevant to the objective element ...***

16 The Court of Appeal in ***Wing Joo Loong*** then applied, at [107]–[117], the combined test of bad faith which, to reiterate, contains both a subjective element (*viz.*, what the particular person (in this case, the Proprietor) knows) and an objective element (*viz.*, what ordinary persons adopting proper standards would think).

17 Hence, for the Applicant to succeed in invalidating the registration of the Proprietor's Mark on the basis that the application for registration was made in bad faith, the Applicant must show not only that the conduct of the Proprietor in applying for the registration of the Proprietor's Mark in Singapore fell short of the normally accepted standards of commercial behaviour, but also that the Proprietor knew of facts which, to an ordinary honest person, would have made the latter realize that what the Proprietor was doing would be regarded as breaching those standards.

18 It is trite that for the ground for invalidation under bad faith, the issue whether there was bad faith on the part of the Proprietor in registering the mark is to be assessed as at the date of the Proprietor's application, which in this case, is 25 July 2006 (see ***Law of Intellectual Property of Singapore (2<sup>nd</sup> Edition)*** (***Sweet & Maxwell***) by Ng-Loy Wee Loon which, at [21.4.2] cites ***Festina Lotus SA v Romanson Co Ltd*** [2010] 4 SLR 552, [98] for the proposition that "Bad faith is to be determined as at the date of the application to register the trade mark").

19 Now, the Applicant says that the Proprietor, as assignee, steps into the shoes of the original trade mark applicant, Dove Industries Pte Ltd ("Dove"), and that I will have to assess the facts and circumstances based on the perspective that the registration was obtained in the name of Dove as at the date of the application.

20 The Applicant's case on bad faith is premised on the fact that the Proprietor's Mark was originally registered in Singapore in 2006 by Dove. Dove subsequently assigned the mark to 6nergy Pte Ltd on or about 1 November 2011, which in turn later assigned the mark to the Proprietor on or about 22 March 2016.

21 The Applicant's evidence that the application of the Proprietor's Mark was made in bad faith is based on Dove's so-called "*modus operandi*" which the Applicant says, shows that it has registered multiple famous marks (for example, the F1 marks) belonging to other traders. Through the existence of these registrations for "famous marks" allegedly belonging to others by Dove, the Applicant sought to show that Dove was "*hijacking the marks owned by other traders by pre-emptively registering such marks*" and had thereby acted in bad faith.

22 The Applicant quoted from the case of ***Weir Warman Ltd v Research & Development Pty Ltd*** [2007] 2 SLR(R) 1073 ("***Weir Warman***"), in which the Court made the following observations in relation to "trade mark squatting" at [42]:

As such, it is also important that these registered marks be in actual use or be bona fide intended to be used by the registered proprietors; any contrary approach would result in unjust monopolies where devious registered proprietors could prevent the use of a mark by others despite not having any intention to use it, simply by reason of prior registration. Indeed, such "squatting" situations are addressed by most modern trade mark registration statutes, which require that the registrant has at least a bona fide intention to use a mark before registering it (see, ie, s 5(2) of the TMA; s 32(3) of the English Trade Marks Act 1994). Kitchin et al, Kerly's Law of Trade Marks and Trade Names (Sweet & Maxwell, 14th Ed, 2005) at p 237 helpfully illustrates this by reference to three instances of hijacking a mark or spoiling a competitor's plans that suggest bad faith:

- (1) The applicant has no bona fide intention to use the trade mark at all, but wishes to prevent a competitor from using the, or a similar, mark;
- (2) The applicant has no present or fixed intention to use the mark, but wishes to stockpile the mark for use at some indeterminate time in the future; and
- (3) The applicant becomes aware that someone else plans to use the mark, and files a pre-emptive application with a view to selling it.

23 The Applicant pointed to the alleged "multitude of marks" applied for by Dove - some of these were set out in the first statutory declaration of Chan Hung To, Director of the Applicant company at [63] to [68], and some of which were set out in the Applicant's written submissions - as evidence of bad faith on the part of Dove, into whose shoes, according to the Applicant, the Proprietor steps. Briefly, there were the Coconut Palm Yeshu mark, the F1 mark, the "Type R" mark, the AITELI mark, the Gap mark, the Vcom mark and the Kogado mark. The Applicant sought to rely on common knowledge that marks like the F1 mark belongs to Formula One and not an entity known as "Dove" from which the Proprietor acquired the 王老吉 Proprietor's Mark, WONG LO KAT. The Applicant further asserts that their ACRA search shows that Dove's business was described as "manufacturing of car accessories and car products including import/export" and that by virtue of this description, Dove had no business registering some of these marks such as the Coconut Palm Yeshu mark which are for beverages.

24 In response, the Proprietor chose to be silent on the circumstances under which it 王老吉 acquired the registration of the Proprietor's Mark, WONG LO KAT, in Singapore from Dove. The Proprietor's assertion with regard to ownership is that on 28 August 1997, the Proprietor obtained the trade mark rights from Guanzhou Yangcheng Pharmaceutical Co., Ltd in China and the Proprietor asserts that their rights can be traced back to the founder Wong. This fact *per se* (i.e., that the Proprietor came from the China branch of the founder Wong) is not disputed by the Applicant.

25 From the evidence filed through the statutory declarations, it would appear that there was an agreement in 1995 and the Applicant has used that agreement to assert that by virtue of that, the Applicant has ownership rights of the marks outside of China. Now, the Applicant is not relying on breach of this agreement as evidence of bad faith on the part of the Proprietor.

Thus, the contents of the agreement and terms contained therein are not directly relevant. Suffice for me to note that the Applicant does not dispute the existence of the China branch that also traces the origin of their mark back to the founder Wong.

26 I note that other than multiple registrations by the Proprietor's predecessor-in-title, Dove, the Applicant is not relying on any other basis to invalidate the Proprietor's Mark. Since the Applicant's case of bad faith rests mainly on Dove's "multitude of registrations", I shall now look at Dove's registrations.

27 I note that presently, there are no registrations belonging to Dove in respect of the Coconut Palm Yeshu mark (I note that the application was withdrawn three months after the date of application); the F1 mark (I note that the mark was sought to be registered in respect of Class 3 products and the application was abandoned about a year later); the "Type R" mark (the mark was abandoned less than a year after the date of application). On the Gap mark, it is noted that the mark was sought to be registered in respect of "windscreen wiper, wiper blade refill" and the goods are completely different from that of the well known American apparel company. On the Aiteli mark and the Kogado mark, the Applicant has merely alleged that these marks belong to some other entity and not Dove.

28 However, it is to be noted that none of these abovementioned "multitudes of applications or registrations" relate to the Subject Mark or to the parties concerned. In any event, I find that the evidence of the registrations of these marks alone does not assist the

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Applicant as it is Dove's knowledge of the relevant mark ( WONG LO KAT ) ("the subjective element") that needs to be looked at in assessing whether Dove's act of applying for registration for the said mark falls short of the standards of ordinary persons adopting proper standards in the particular trade ("the objective element"). The mere fact that the first owner of the relevant

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mark WONG LO KAT , i.e., Dove, had tried to register other marks, without more, does not show

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any evidence of dishonesty on the part of Dove in relation to WONG LO KAT .

29 I will also point out that every case has to be assessed on its own specific facts as it is the subjective knowledge of the relevant person that has to be judged against the objective standards of ordinary persons adopting proper standards in the relevant commercial setting. Thus, it would not be correct to jump to the conclusion that the mere registrations of well known marks by themselves are enough to show bad faith. For example, it can be envisaged that in certain scenarios, for example, in the registrations of well known marks for totally different goods/services where there would be no likelihood of confusion among the public whatsoever, the mere act of registration does not necessarily fall short of the reasonable standards of ordinary persons. Besides, some of these registrations which the Applicant sought to rely on were subsequently not pursued by Dove. More importantly, these marks have no

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relation whatsoever to the Proprietor's Mark in question, WONG LO KAT .

30 In any event, for our particular case, the Proprietor's current claim to ownership can be traced back to the founder Wong and this part of the evidence of the Proprietor is not disputed by the Applicant. This itself shows that the present Proprietor has some legitimate basis to lay claims to the ownership of the mark.

31 The case of *Weir Warman* which is relied on by the Applicant can also be distinguished. In that case, the “squatter” tried to block the “rightful owner” from registering their mark. In our case, that is not the case of the Applicant. The Applicant’s case is merely that the registrations of other marks on the register by Dove by themselves make Dove dishonest. The Applicant has no evidence to show the subjective frame of mind of Dove in obtaining those registrations vis-à-vis the Applicant. The mere fact of obtaining registration for other marks alone without more simply cannot be extrapolated to amount to dishonesty, especially since there is no evidence to show how Dove has used these prior registrations against the Applicant in relation to the Proprietor’s Mark **王老吉** **WONG LO KAT** in contention. Most importantly, the Proprietor’s Mark is presently owned by an entity that has legitimate claims as regards ownership and the Applicant is not disputing that.

*Conclusion on Section 7(6)*

32 On the whole, as the burden is on the Applicant, and I am not satisfied that the Applicant has proved, on a balance of probabilities that, as at the date of the application, i.e 25 July 2006, the application for registration of the Proprietor’s Mark was made in bad faith, the ground of invalidation under Section 7(6) fails.

**Ground of Invalidation under Section 8(2)(b)**

33 Section 23(3)(a)(i) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground—

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in section 8(1) or (2) apply;

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

34 Section 8(2)(b) of the Act reads:

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

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exist a likelihood of confusion on the part of the public.

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

*Is the Proprietor’s Mark similar to the Applicant’s Marks such that there exists a real likelihood of confusion on the part of the public?*

35 The test for similarity requires that we assess the two marks for their visual, aural and conceptual similarities. In addition, the similarities are to be judged from the perspective of the notional average consumer. As trade mark protection is territorial, the question of whether the similarities lead to a likelihood of confusion on the part of the public is to be answered from the perspective of a notional average consumer in Singapore.

36 Consequently, the question to ask ourselves is, how would the average consumer in Singapore see the two marks? The Applicant's Marks, T9100470Z and T9201709J comprise



solely of Chinese characters and they look like this : . Based on the visual presentation of the Applicant's Marks, I am of the view that the average Singapore consumer will see the Applicant's registrations T9100470Z and T9201709J as “吉老王” (“JI LAO WANG”), based on how the Chinese characters are arranged in the mark. This is because the convention for reading the Chinese language in Singapore is from the left to the right. Thus, the consumers who can read Chinese will see the mark as “吉老王” (“JI LAO WANG”) which can roughly be translated as “Peaceful Old King” or “Peaceful Old Wang”. I acknowledge that the Applicant's intention is to register the mark “王老吉” (“WANG LAO JI”) and the mark is registered in this way because, *“in the olden days, Chinese characters are read from right to left”*.

37 However, the question of similarity of marks and the likelihood of confusion is to be assessed as at the date of the Proprietor's later application for registration of the Proprietor's mark, that is, in 2006. In 2006, in so far as the average Chinese reader in Singapore is concerned, he or she would not likely read a Chinese phrase from right to left anymore. Conversely, the average Chinese reader in Singapore would see and read the Proprietor's mark as “王老吉” (“WANG LAO JI”). The combined Chinese characters in the Proprietor's mark can be translated to roughly mean, “King Old Peace” or “Wang Old Peace”. As for the average consumer in Singapore who does not read Chinese, he or she may not even associate the two marks at all. The Proprietor's Mark will be remembered for the words, “Wong Lo Kat” which appear in the Proprietor's Mark. For the Applicant's Mark, it is likely to be remembered in its visual form. Consequently, visually, except for the middle Chinese character which is “老” (“LAO”) in both marks, the two marks would not look similar to the average consumer in Singapore.

38 Aurally, the Applicant's mark would be read as “Ji Lao Wang” whereas the Proprietor's Mark would be read as “Wong Lo Kat”, because of the plain Romanised (English) characters appearing in the latter mark. Conceptually, the marks are different as well due to the different meanings that can be ascribed to the Chinese characters in its combined form (one being seen as “Peaceful Old King” or “Peaceful Old Wang” on the one hand and, on the other hand, the other being seen as “Wang Old Peace” or “King Old Peace” or simply, “Wong Lo Kat” for those who recognise that the Chinese characters are to be read in Cantonese).

39 For the above reasons, the two marks are not similar visually, aurally and conceptually.

40 In fact, IPOS' Trade Marks Work Manual also lends weight to the above assessment as to how the average consumer in Singapore would see and remember the two marks. To quote from the section on the registration of marks as a series of marks in IPOS' Trade Marks Work Manual:

**Chinese characters are usually read from left to right or from top to bottom.** This principle is applicable for assessing Chinese characters as a series of marks.



*Example 4.10.3.1*

The two marks in Example 4.10.3.1 above are not acceptable as a series, because **the difference in the positioning of the Chinese characters alters the identity of the marks**. As Chinese characters would generally be read from left to right, the first mark would be read as “草莓 微笑” and the second mark would be read as “微笑 草莓”. This results in the two marks being substantially different in their visual, aural and conceptual identities. Hence, the two marks do not qualify as a series.

41 Now, while it is to be appreciated that the above merely shows IPOS' guidelines on similarity of marks containing Chinese characters for the purpose of registering similar marks as a series (it is common ground that two or more marks may only be accepted for registration as a series of marks if they are substantially similar), the above is nonetheless instructive as to how IPOS would assess and apply the test of similarity as regards marks that contain Chinese characters. I conclude in our case here that the difference in the positioning of the Chinese characters alters the identity of the marks and therefore the Proprietor's Mark and the Applicant's Marks are different.

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

42 Having found the two marks in contention to be dissimilar visually, aurally and conceptually, the conclusion is therefore that there is no real likelihood of confusion on the part of the public. Hence, the ground for invalidation under section 23(3)(a)(i) read with section 8(2)(b) of the Act fails.

#### **Ground of Invalidation under Section 8(4)**

43 Section 23(3)(a)(iii) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground—

(b) that there is an earlier trade mark in relation to which —

...

- (iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1<sup>st</sup> July 2004, the conditions set out in section 8(4) apply;

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

44 Section 8(4) of the Act reads:

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1<sup>st</sup> 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;
  - (ii) if the earlier trade mark is well known to the public at large in Singapore —
    - (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
    - (B) would take unfair advantage of the distinctive character of the earlier trade mark.

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

*Is the Proprietor's Mark similar to the Applicant's Marks (which have to be proven to be well known in Singapore in order for the Applicant to succeed on this ground)?*

45 In order for the invalidation under section 23(3)(a)(iii) read with section 8(4) of the Act to succeed, it is crucial that I must find the two marks in contention to be similar. If they are not similar and fail the similarity test, it is not necessary for me to proceed to make a finding as to whether the Applicant's Marks are well known in Singapore. Since I have found the Proprietor's Mark and the Applicant's Marks to be dissimilar, I need not go further. Be that as it may, however, I will also say that the evidence lodged by the Applicant in support of its claim that the Applicant's Marks are well known in Singapore is insufficient and does not support the claim. I note that there is in fact no evidence of use of the Applicant's Marks in Singapore as at the date of the registration of the Proprietor's Mark at all. The evidence shows the earliest use of the Applicant's Marks in Singapore to be in 2014. There is therefore no basis to substantiate the claim by the Applicant that the Applicant's Marks are well known in Singapore as at the date of the registration of the Proprietor's Mark (i.e., in July 2006).

#### ***Conclusion on Section 8(4)***

46 Consequently, the grounds of invalidation under section 23(3)(a)(iii) read with section 8(4)(b)(i), (b)(ii)(A) or (b)(ii)(B) of the Act necessarily fail.

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

47 Section 23(3)(b) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground

...

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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

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

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

...

### ***Decision on Section 8(7)(a)***

*Whether use of the Proprietor's Mark amounts to passing off the Applicant's Marks contrary to law*

49 To establish a claim for passing off, the Applicant must establish that these three elements exist: namely (i) that the Applicant has goodwill that attaches to its business in Singapore and is manifested in the custom that the business enjoys; (ii) that there is misrepresentation on the part of the Proprietor in using a similar mark and (iii) there is damage arising from the above (see Court of Appeal decision *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as LS Electrical Trading* [2016] SGCA 33).

### ***Conclusion on Section 8(7)(a)***

50 On element (ii), in order to find that there is misrepresentation, it is essential that I find the marks to be similar. As I have found that the marks are not so similar as to give rise to a likelihood of confusion, this element is therefore not made out. The ground for invalidation under passing off therefore necessarily fails.

### **Overall Conclusion**

51 Having considered all the pleadings and evidence filed and submissions made in writing and orally, I find that the application for a declaration of invalidity fails on all grounds. The Proprietor is therefore entitled to costs to be taxed, if not agreed.

Date of Issue: 12 September 2017