

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

Trade Mark No. T1305626H

Hearing Date: 14 February 2017, 11 July 2017

**IN THE MATTER OF A TRADE MARK REGISTRATION IN THE NAME OF**

**KWEK SOO CHUAN**

**AND**

**APPLICATION FOR DECLARATION OF INVALIDITY THEREOF BY**

**ELEY TRADING SDN BHD**

Hearing Officer: Ms Tan Mei Lin  
Principal Assistant Registrar of Trade Marks

Representation:

Mr Paul Teo (Ravindran Associates) for the Applicant

Mr Mark Teng and Ms Gillian Tan (Infinitus Law Corporation) for the Registered Proprietor

**GROUND OF DECISION**

1 Kwek Soo Chuan (“the Proprietor”) is the registered proprietor of the trade mark “菩提” in respect of incense sticks and various similar products. “菩提” (pronounced “Pu Ti”) is a Chinese word meaning “Bodhi” or “Enlightenment”. It is not disputed that the incense products are used by practising Buddhists, or that enlightenment is the ultimate goal of Buddhism.

2 Eley Trading Sdn Bhd (“the Applicant”) applied to have the registration of the “菩提” trade mark declared invalid. Among other things, the Applicant claims that the mark is



similar to its prior registration for  in respect of the same products. The Applicant further argues that the mark is devoid of distinctive character.

3 I therefore have to decide whether the Proprietor or the Applicant has a better claim to the words “菩提” for incense products. Alternatively, I can decide that neither party should be conferred exclusive rights to these words; instead, these words should be free for all traders of incense products to use.

4 Details of the “菩提” trade mark are as follows:

Trade Mark	Trade Mark No.	Class No.	Goods	Date of Application
<p style="text-align: center;"><b>菩提</b></p> <p>Mark Clause on the Register: The transliteration of the Chinese characters of which the mark consists is "Pu Ti" meaning "Bodhi" or "Enlightenment".</p> <p>("the Subject Mark")</p>	T1305626H	3	<p>Incense; incense sticks; incense coils; incense cones; incense sprays; joss sticks; scented oils; scented preparations.</p> <p>("the Subject Goods")</p>	<p>9 April 2013</p> <p>("the Application Date")</p>

5 The Applicant applied on 24 April 2015 for the registration of the Subject Mark to be declared invalid. The Proprietor filed his Counter-Statement in defence of the registration on 23 June 2015.

6 The Applicant filed evidence in support of its application on 13 January 2016. The Proprietor filed evidence in support of the Subject Mark on 13 May 2016. Although the Proprietor did not plead a case of acquired distinctiveness, the Proprietor’s evidence included evidence of use of the Subject Mark prior to the date of application for invalidation. The Applicant filed evidence in reply on 15 July 2016.

7 Following the close of evidence, a Pre-Hearing Review (“PHR”) was held on 5 August 2016. At the PHR:

- (a) Parties were directed to lodge English translations of any exhibits in their evidence which are not in the English language;
- (b) The Applicant applied for, and was granted, leave to cross-examine the Proprietor on his state of knowledge and intention at the time when he filed the Subject Mark.

8 On 31 August 2016, the Applicant filed supplementary evidence attaching translations of various Chinese labels on the packaging of incense products, and on 16 September 2016,

the Proprietor filed supplementary evidence attaching a certified translation of his Chinese business name.

9 On 31 August 2016, the Applicant applied for leave to file further supplementary evidence to exhibit an examination report issued by IPOS dated 29 July 2016. Leave was granted to the Applicant after an interlocutory hearing and the further supplementary evidence was filed on 5 December 2016.

10 On 7 September 2016, the Proprietor applied for leave to cross-examine the Applicant's key witness, Wong Kooi Seng ("Wong"), Managing Director of the Applicant. Leave to cross-examine was granted on 21 September 2016 limited to two issues, namely:

- (a) The meaning of "菩提" and its relation to incense;
- (b) The general use of "菩提" in Singapore.

11 The matter proceeded to a full, substantive hearing over two days on 14 February and 11 July 2017. On 14 February 2017, Wong and the Proprietor attended the hearing for cross-examination. The parties agreed on the appointment of Opus 2 International – Official Court Reporters to prepare the transcripts of the cross-examinations.

12 On 17 February 2017, the Proprietor applied for leave to amend the Counter-Statement to formally plead the case of acquired distinctiveness. Leave was granted to the Proprietor to do so since this did not involve the admission of new evidence and at the same time, leave was also granted to the Applicant to file evidence in reply to the amended Counter-Statement. The amended Counter-Statement was filed on 7 April 2017 and the Applicant's evidence in reply to the amended Counter-Statement was filed on 23 May 2017.

13 The parties filed written submissions ("the Opponent's Written Submissions" and "the Applicant's Written Submissions" as the case may be) on 13 June 2017. The hearing resumed on 11 July 2017 and at the hearing the Applicant submitted its Written Reply Submissions ("the Applicant's Written Reply Submissions").

### **Grounds of Invalidation**

14 The Applicant relies on a number of grounds in the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in support of this application for a declaration of invalidity. They are Sections 7(1)(b), 7(1)(c) and 7(6) read with Section 23(1) and Section 8(2)(b) read with Section 23(3) of the Act. The ground under Section 7(1)(d) was pleaded but at the hearing on 14 February 2017, the Applicant confirmed that it was not proceeding with it.

### **Applicant's Evidence**

15 The Applicant's evidence comprises the following:

- (a) Statutory Declaration ("SD") by Wong dated 11 January 2016 ("Wong's 1<sup>st</sup> SD") which included three further SDs as follows:
  - (i) SD by Chay Chong San ("Chay"), sole proprietor of Shan Wei Hiong Hiong Chung Trading, dated 5 January 2016 ("Chay's 1<sup>st</sup> SD");

- (ii) SD by Ang Lay Ting (“Ang”), sole proprietor of Keng Leong Joss Paper Co, dated 5 January 2016 (“Ang’s SD”);
- (iii) SD by Wang Poo Cheng (“Wang”), sole proprietor of Kiu Leng Heong Chng Trading Enterprise, dated 5 January 2016 (“Wang’s SD”);
- (b) SD in Reply by Wong dated 5 July 2016 (“Wong’s 2<sup>nd</sup> SD”);
- (c) Supplemental SD by Wong dated 26 August 2016 (“Wong’s 3<sup>rd</sup> SD”);
- (d) Further SD by Wong dated 30 November 2016 (“Wong’s 4<sup>th</sup> SD”);
- (e) Further SD by Chay dated 23 May 2017 (“Chay’s 2<sup>nd</sup> SD”).

### Proprietor’s Evidence

16 The Proprietor’s evidence comprises the following:

- (a) SD by the Proprietor dated 12 May 2016 (“Proprietor’s 1<sup>st</sup> SD”);
- (b) SD by Chang Wen Yee (“Chang”), Manager and sister-in-law of Ng Yap Ming trading as Nan Fatt Joss Paper & Joss Stick, dated 13 April 2016 (“Chang’s SD”);
- (c) SD by Koh Cheng Joo (“Koh”), Partner of Aik Che Hiong, dated 13 April 2016 (“Koh’s SD”);
- (d) SD by Tay Pit Loe @ Tay Ah Huat (“Tay”), sole proprietor of Ching Heng Joss-Paper, dated 13 April 2016 (“Tay’s SD”);
- (e) Supplemental SD by the Proprietor dated 16 September 2016 (“Proprietor’s 2<sup>nd</sup> SD”).

### Applicable Law and Burden of Proof

17 The applicable law is the Act. Under Section 101(c)(i) of the Act, “the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of the validity of the original registration”. The burden of proof in the present case falls on the Applicant to prove the ground of invalidity on the balance of probabilities.

### Background

18 The Applicant, established in 1984 in Malaysia, is a manufacturer and distributor of religious products which are sold in, *inter alia*, Malaysia, Thailand, Indonesia, Hong Kong and Singapore through its various local retailers. The Applicant has been promoting and selling incense and incense coils in Singapore under its various brands for almost the past 20 years<sup>1</sup>.

19 The Applicant owns and uses the following registered trade mark in Singapore:

Trade Mark	Trade Mark No.	Class No.	Goods	Date of Registration
 <p>Mark Clause on the Register: The</p>	T0010570B	3	Detergents other than for use in manufacturing operation and for medical purposes; incense; incense sticks,	19 June 2000

<sup>1</sup> Wong’s 1<sup>st</sup> SD at [5]

transliteration of the Chinese characters appearing in the mark is "Pu Ti" meaning "Bodhi".  ("the Applicant's earlier mark")			incense coils, incense cones, incense sprays, joss sticks; scented oils and scented preparations; soaps in liquid form, soaps for use on a person; all included in Class 3.	
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20 According to the Applicant, sometime on or around March 2015, it was informed by its distributor in Singapore, Chay, that several retailers had withdrawn from selling the Applicant's "菩提" branded incense products after having received the Proprietor's notice to the trade about its trade mark registrations<sup>2</sup> ("the Notice"). The bottom half of the English translation of the Notice in Chinese reads as follows<sup>3</sup>:

Widespread advertising of the registered trademark of our company Bodhi ® Incense, Oil, Candles have started since 1998 in various media – "Lianhe Zaobao", "Xinming", "Lianhe Wanbao" and various weekly publications like "Friends of Buddha", "Golden Lotus" etc.

For any party that violate and imitate the company's trademark, please stop selling the products after 15/4/2015 which is the grace period given.

(If parties that violate the company's trademark by selling or distributing the products are found guilty, they will be fined \$10,000 per piece of product. The highest penalty is \$100,000 fine or jail of up to 5 years or both penalties may be imposed.)

Thank you for your cooperation. Counterfeiting is not allowed.

From Bodhi Buddhist Products

21 On 24 April 2015, the Applicant took out this application to invalidate the Subject Mark.

22 The Proprietor is the sole proprietor of a business in Singapore called Bodhi Buddhist Products registered on 9 November 1998. He is in the business of distributing, *inter alia*, Buddhist products such as incense, joss sticks, and scented oils and uses the following signage in the course of his trade:



23 The Proprietor owns the following registered trade marks in Singapore containing the Chinese characters "菩提" or "Bodhi"<sup>4</sup>:

<sup>2</sup> A copy of the Notice is found at page 32 of Wong's 1<sup>st</sup> SD.

<sup>3</sup> The Notice gives the impression that it is a criminal offence to "violate the company's trademark" when trade mark infringement is actually a civil remedy.

<sup>4</sup> There is no application to invalidate any mark apart from the Subject Mark.

Trade Mark	Trade Mark No.	Class No.	Goods	Date of Registration
 <p>Mark Clause on the Register: The Chinese words "tian ran" in the mark means "natural" while the word "BODHI" is the name of the large Indian fig-tree known as "pipal".</p>	T0000781F	4	Candles and lamp oils; all included in Class 4.	20 January 2000
 <p>Mark Clause on the Register: The transliteration of the Chinese characters appearing in the mark is "pu ti" meaning "supreme, wisdom or enlightenment, necessary to the attainment of Buddhahood".</p>	T0207026D	4	Candles and lamp oils; all included in Class 4.	24 May 2002
 <p>Mark Clause on the Register: The transliteration of the Chinese characters appearing in the mark is "Tian Ran" meaning "Natural".</p>	T0419102F	3	Detergents other than for use in manufacturing operation and for medical purposes; incense; incense sticks; incense coils, incense cones, incense sprays, joss sticks, scented oils and scented preparation; soaps in liquid form, soaps for use on a person; all included in Class 3.	6 November 2004
<p><b>菩提</b></p> <p>Mark Clause on the Register: The transliteration of the Chinese characters of which the mark consists is "pu ti" meaning "supreme wisdom of enlightenment, necessary</p>	T0708673H	4	Lamp oils, candles and wicks	20 April 2007

to the attainment of Buddhahood".				
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Trade Mark	Trade Mark No.	Class No.	Goods	Date of Registration
<b>BODHI</b>	T1305623C	3	Incense; incense sticks; incense coils; incense cones; incense sprays; joss sticks; scented oils; scented preparations	9 April 2013
		4	Candles; tea lights [candles]; wicks for lamps; wicks for candles; lighting fuel; paraffin oil; lamp oil.	
<b>菩提</b> (the Subject Mark)	T1305626H	3	Incense; incense sticks; incense coils; incense cones; incense sprays; joss sticks; scented oils; scented preparations	9 April 2013

24 The Proprietor contends, *inter alia*, that he has been using and promoting the Subject Mark in relation to the Subject Goods since late 1998 / early 1999. As a result of his extensive and legitimate use of the Subject Mark, the Proprietor says customers in Singapore have come to associate “菩提” with him and no other.

### MAIN DECISION

#### Ground of Invalidation under Section 23(1) read with Section 7(1)(b) and (c)

25 Section 23(1) of the Act reads:

**23.**—(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.

26 Section 7(1)(b) and (c) of the Act reads:

**7.**—(1) The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in

trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

### ***Relevant date***

27 The language used in Section 23(1), namely, “a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7”, makes it clear that the relevant date for assessing if the provisions of Section 7(1) apply to a registered mark must be assessed as of the same relevant date that applied when it was originally assessed for registration. That relevant date was the Application Date of the mark, in this case 9 April 2013.

### ***The Law***

28 The applicable law in relation to Section 7, in particular, Section 7(1)(b) – (d) read with Section 23, is set out in *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2008] SGHC 158 (“*Love Case*”) at [53] as follows:

The object of the assessment for “inherent distinctiveness” in relation to ss 7(1)(b), 7(1)(c) and 7(1)(d) is to determine whether the trade mark has ***intrinsic or inherent features or characteristics*** that are sufficiently unique to enable the intended mark to ***immediately function*** (and not potentially function in the future through subsequent use by the promoter of the mark) as a readily obvious and reliable badge of origin in the eyes of the average discerning consumer when it is used in relation to the particular trader’s goods or services to differentiate that trader’s goods or services from those originating from other traders, who are operating in the same market place and environment in which that trade mark is supposed to function. If such intrinsic or inherent features or characteristics exist, then the trade mark escapes the objection to registration in ss 7(1)(b), 7(1)(c) and 7(1)(d) because it will then have an “inherent distinctive character”. I re-emphasise that the assessment is made by examining the trade mark and its meaning (if any), ***absent any consideration of its use, promotion or marketing by the promoter of the trade mark***, as will be reasonably perceived and understood at the relevant date by the average discerning consumer of that category of goods or services in the market place and environment that exists again as at the relevant date.

[Emphasis in original]

### ***Decision on Section 7(1)(b)***

29 The test for whether a trade mark is devoid of distinctive character was considered in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) and cited with approval in the *Love Case* at [58]:

“What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. **Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?** A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word

such as “Treat” is, absent use and recognition as a trade mark, in itself ... devoid of any distinctive inherently character.”

[Emphasis in original omitted and emphasis added in bold]

30 This assessment is made by examining the trade mark and its meaning (if any), as will be reasonably perceived and understood at the relevant date by the average discerning consumer of that category of goods or services in the market place and environment that exists again as at the relevant date (*Love Case* at [53]).

31 Bearing the above in mind, I shall now proceed to examine whether “菩提” possesses “distinctive character” as a mark of origin of the Proprietor for the Subject Goods.

32 It is not disputed by the Proprietor that the Subject Goods are intended for use by Buddhists and the relevant public in this instance would primarily include practising Buddhists in Singapore who burn incense and joss sticks in the course of their practice of the faith<sup>5</sup>.

33 As mentioned at [1], the words “菩提” translate to mean “Enlightenment” in Buddhism and that enlightenment is the ultimate goal of Buddhism. Given the importance of “菩提” to practising Buddhists, it is therefore not surprising that the words “菩提” often appear on the cover of a local Buddhist publication exhibited in the Proprietor’s own SD<sup>6</sup>. However, the Subject Mark is not registered in respect of religious publications (in Class 16), religious education services (in Class 41) or religious counselling services (in Class 45) and the fact that “菩提” is commonly used on Buddhist publications does not necessarily mean that “菩提” cannot function as a badge of origin in relation to the Subject Goods. Nevertheless, I bear in mind the meaning of “菩提” which I accept practising Buddhists in Singapore will be aware of and also that “菩提” is the ultimate goal of Buddhism<sup>7</sup>.

34 With regard to the significance of “菩提” in relation to the Subject Goods, it is not disputed by the parties that the burning of incense is an integral part of Buddhism and Buddhists use incense as offerings.

35 The Applicant submits that it is foreseeable for devotees to want to light “Enlightenment” incense or “菩提” incense as an offering to enlightened ones or to Buddha (aka The Enlightened One). In fact, it is the Applicant’s case that traders, both locally and

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<sup>5</sup> Proprietor’s Written Submissions at [57].

<sup>6</sup> Kwek’s 1<sup>st</sup> SD at pages 281, 335, 402, 435, 490, 505 and 509.

<sup>7</sup> For the avoidance of doubt, this is not to be taken to mean that the approach for assessing distinctiveness of non-English word marks is to translate the non-English word into English and assess its distinctiveness based on its meaning in English. Even where Chinese word marks are concerned, and recognising (from judicial notice) the fact that Chinese is one of our national languages and more than 70% of our population is Chinese, it is not to be assumed that the average consumer in Singapore would necessarily know what a more difficult word in Chinese means. The approach should be to look at whether, and, if so, how, the word would be understood by the target audience in Singapore. In the present case, given the significance of “菩提” to Buddhists and in Buddhism, and also the fact that the term frequently features in Buddhist publications, I find that the average consumer of the Subject Goods is likely to know its meaning.

overseas, have been calling their incense “菩提香”<sup>8</sup> and such products have been available in Singapore long before 9 April 2013<sup>9</sup>. Some of the examples of use found in the Applicant’s evidence include:

- a) 菩提香 (Enlightenment incense)<sup>10</sup>
- b) 菩提塔香 (Enlightenment incense coils)<sup>11</sup>
- c) 菩提檀香 (Enlightenment sandalwood incense)<sup>12</sup>
- d) 觀音菩提香 (Goddess of Mercy Enlightenment Incense)<sup>13</sup>

36 Three other traders in Singapore also gave evidence in support of the Applicant’s case that “菩提” is commonly used on incense products in Singapore.

37 Chay has been distributing and retailing religious products (including joss paper and incense for burning) in Singapore for more than 30 years. He has been distributing the Applicant’s goods for over 20 years. He confirms that his business has been selling various “菩提” incense in Singapore for the past 15 years. He did not provide samples of the “菩提” incense sold by him but gave samples of incense products sold by other businesses in Singapore:

Packaging of incense product sold by other traders	English Translation
	<p>[not provided]</p>

<sup>8</sup> Wong’s 1<sup>st</sup> SD at [15]. “香” (pronounced “xiang”) is a Chinese word meaning “incense”.

<sup>9</sup> Wong’s 1<sup>st</sup> SD at [17]

<sup>10</sup> Wong’s 1<sup>st</sup> SD at pages 46, 96, 97, 98, 134

<sup>11</sup> Wong’s 1<sup>st</sup> SD at page 99

<sup>12</sup> Wong’s 1<sup>st</sup> SD at pages 47, 103, 110

<sup>13</sup> Wong’s 1<sup>st</sup> SD at pages 98, 115

	<table border="1"> <tr> <td data-bbox="874 224 1321 322">Tan(Sandalwood)</td> </tr> <tr> <td data-bbox="874 322 1321 595">Bodhi (Enlightenment) Sandalwood</td> </tr> <tr> <td data-bbox="874 595 1321 689">Fu Xiang Cheng</td> </tr> </table>	Tan(Sandalwood)	Bodhi (Enlightenment) Sandalwood	Fu Xiang Cheng
Tan(Sandalwood)				
Bodhi (Enlightenment) Sandalwood				
Fu Xiang Cheng				

38 Chay further declares in his SD at [7] that “[b]eing in this industry for over 30 years, I can confirm that 菩提 is commonly used in relation to incense.”

39 Ang has been in the industry for over 35 years. Ang states that “菩提” is commonly used in relation to incense and confirms that her business has been selling “菩提” incense in Singapore for at least the past 10 years. The “菩提” incense sold by her business in Singapore over the years is shown below.

Packaging of incense product sold by Keng Leong Joss Paper Co	English Translation
	<p data-bbox="1018 1218 1150 1240">Guo Tian Incense</p> <p data-bbox="967 1267 1198 1290">(Picture of Guan Yin Goddess)</p> <p data-bbox="948 1375 1214 1397">Bodhi Tribute Sandalwood Incense</p> <p data-bbox="983 1532 1177 1554">Guo Tian Incense Factory</p>

40 Wang has been selling religious items including incense in Singapore for almost 30 years. Wang says that “菩提” is commonly used in relation to incense and his business has been selling “菩提” incense in Singapore for at least the past 5 years. The various “菩提” incense which his business has been selling over the years are shown below.

Packaging of incense product sold by Kiu Leng Heong Chng Trading Enterprise	English Translation

	<p>Yi Ping Shuang Tiao Commercial Trademark</p> <p>-----</p> <p>Specially produced</p> <table border="1" data-bbox="826 338 1374 483"> <tr> <td data-bbox="826 338 1011 483"> <p>With sincerity when praying to the Gods, enjoy good fortune for hundred thousand years</p> </td> <td data-bbox="1011 338 1192 483"> <p>Lao Shan Bodhi Incense</p> </td> <td data-bbox="1192 338 1374 483"> <p>1 incense a day keeps you safe everyday</p> </td> </tr> </table> <p>(Logo)</p> <p>Sales office</p> <p>Jiu Long Incense Trading Company</p> <p>KIU LENG HEONG CHNG TRADING ENTERPRISE</p> <p>Blk 30 Bendemeer Road #01- (illegible) Singapore 1233 Tel: (illegible) Fax: 2811837</p>	<p>With sincerity when praying to the Gods, enjoy good fortune for hundred thousand years</p>	<p>Lao Shan Bodhi Incense</p>	<p>1 incense a day keeps you safe everyday</p>
<p>With sincerity when praying to the Gods, enjoy good fortune for hundred thousand years</p>	<p>Lao Shan Bodhi Incense</p>	<p>1 incense a day keeps you safe everyday</p>		

Packaging of incense product sold by Kiu Leng Heong Chng Trading Enterprise	English Translation
	<p>[not provided]</p>

41 Wang further says that he has also registered a trade mark incorporating the words “菩提” for “joss sticks” in Class 3 on 19 March 2010. The trade mark is:

Trade Mark	Mark Clause on the Register	Trade Mark No.
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	<p>The transliteration of the Chinese characters appearing in the mark is “Jiu Long Xiang” meaning “Kowloon joss sticks”, “Jiu Long” meaning “Kowloon” and “Ji Pin Zheng Tan Pu Ti Xiang Huang” which has no meaning.</p>	<p>T1003423I</p>
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42 It is not clear from Wang’s evidence whether this incense is sold in Singapore. However, it nevertheless illustrates that “菩提” is a term which other traders in Singapore may wish to use in respect of their goods.

43 The Proprietor submits that a sampling from a pool of only three traders is not representative of the use of “菩提” in relation to the Subject Goods in Singapore. I agree that if only three traders are using “菩提” in relation to the goods in Singapore, it is unlikely to be representative unless evidence of their market share in Singapore is provided. However, the Applicant’s evidence, corroborated by the evidence of the three traders, is that “菩提” is commonly used in the incense industry. The exhibits lodged by the three traders are merely a sampling of some of the uses made by the trade in Singapore.

44 Although the Proprietor contends that he was the first to use “菩提” on the Subject Goods, he does not deny that “菩提” and “菩提香” were in use in the incense industry before the Application Date. Neither did the Proprietor seek to cross-examine any of the three traders on this point. In fact, it is the Proprietor’s evidence during cross-examination that the reason he applied to register the Subject Mark was precisely because many traders were bringing in “菩提香” and he felt he needed to protect himself<sup>14</sup>.

Q: So to clarify, every one of these products on page 98 you would take objection, including let’s say “Guan Yin Pu Ti Xiang”?

A: My thoughts are that, if I don’t object to all these being sold in the market, my ten

<sup>14</sup> The Proprietor seems to hold the view that “菩提” is exclusively associated with him and any use of “菩提香” would be detrimental to his business.

over years of advertisements were being – were flushed in the drain. And I think all these actually are – these products they are actually a free ride on the advertisements that I have made for years.

Just plainly a “Pu Ti”, for example, these two words already can sell so well, you know, because the consumers will say, “We are buying “Pu Ti” brands or “Pu Ti Xiang”, you know? Then, you know, any shop or any retailer can easily get any “Pu Ti” sale from China or from somewhere and then sell it to consumers.

...

Q: So are you saying that, if it is sold before your trademark registration, then you will allow it?

A: After being – after many advertisements being spent, I find that in recent years there are many, many of these “Pu Ti Xiang” being brought in. So I will suffer in business for this reason, so I need to protect my trade. That is why I trademarked these – I do trademark on – I trademark all these so in order to protect myself from these people to avoid them bringing so many in.

...

Q: If you turn over to page 137, it is small but the words say, “Jiu Long Xiang Jiu Long Ji Pin Zheng Tan Pu Ti Xiang Huang”. Would you object to this?

A: I don’t understand why this “Jiu Long”? This company is called Jiu Long, right? They can label as “Jiu Long Xiang” on mine. They put “Jiu Long Pu Ti Xiang”. This is registered in year 2010. This is many years after my advertisements. And, okay, with this additional word of “Pu Ti”, you know, it can easily sell better. And why did they want to put this additional? Because they can ride on the many years of advertisements that have been – many years of advertisement that have been done. All these that have been registered, I cannot object any more.

45 I have some difficulty appreciating the Proprietor’s view that use by other traders of “菩提香” free-rides on his goodwill when it is clear that there are multiple users of that term in Singapore as well as overseas.<sup>15</sup> But in any event, the issue here is not whether other traders are free-riding on his goodwill or not, but whether in light of the “*many, many of these “Pu Ti Xiang”*” incense products being sold in Singapore before the Application Date, “菩提” can function as a trade mark.

46 I find that by virtue of the common use of “菩提香”, the sign “菩提”, without any form of stylisation or embellishment, would be incapable of doing the job of distinguishing without first educating the public that it is a trade mark. To illustrate what I mean, imagine a customer going into an incense shop and asking to buy “菩提” incense. Would it be certain that he wants to buy the “菩提” brand of incense rather than any brand of “菩提” incense? Due to the common use of “菩提香”, I do not think so. This would clearly not be the case if one were to walk into a shop and ask for a bar of “Cadbury” chocolate. This to me is a clear indication that the Subject Mark is not distinctive. To borrow the words of Lord Russell in *The Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada Ltd* (1938) 55 R.P.C. 125:

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<sup>15</sup> Wong’s 1<sup>st</sup> SD at [23].

“A word or words to be really distinctive of a person’s goods must generally speaking be incapable of application to the goods of anyone else.”

47 Even if the words “菩提” are not commonly used in the industry, bearing in mind that “菩提” is the ultimate goal of Buddhism and the burning of incense is an integral part of Buddhism, I would nevertheless hold that the term “菩提”, is one which other traders of the Subject Goods may wish to use for legitimate reasons. The High Court explained the rationale why terms which other traders may desire to use for legitimate reasons should not be monopolised by a single party in *Han’s (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SGHC 39 at [65] - [66]:

65 Allowing a trader to register and obtain a monopoly on words and phrases which other traders may wish to use in respect of their goods and services for entirely legitimate purposes (including competition) is clearly not in the public interest. For example, under the Trade Marks Act 1938 (c 22) (UK) (“UK TMA 1938”), Gibson J held in *Smith Kline & French Laboratories Ltd’s Cimetidine Trade Mark* [1991] RPC 17 at 34 that in deciding whether a claimed trade mark was inherently adapted to distinguish:

[T]he court takes account of the likelihood that other traders may, without improper motive, desire to use the trade mark in relation to their own goods. On grounds of public policy a trader will not be allowed to obtain by a trade mark registration, a monopoly in what other traders may legitimately wish to use ...

While these observations were in relation to the now repealed UK TMA 1938, the general sentiments expressed by Gibson J remain relevant.

66 This is why the law shies away from granting rights over descriptive phrases and words of praise. This is also why the law is careful about granting rights too readily over common words, geographical expressions and place names...

#### *Conclusion on Section 7(1)(b)*

48 The ground of invalidation under Section 23(1) read with Section 7(1)(b) is made out in respect of all the Subject Goods.

49 Having found the above, it does not necessarily follow that the Subject Mark must be invalidated. If the Proprietor can show, on the balance of probabilities, that the Subject Mark has in fact acquired distinctiveness as a result of use by the Proprietor, the mark may nevertheless still be registered. I will discuss this below after looking at the ground of objection under Section 7(1)(c).

#### *Decision on Section 7(1)(c)*

50 The rationale behind Section 7(1)(c) is explained in Mellor, Llewelyn, et. al., *Kerly’s Law of Trade Marks and Trade Names* (15<sup>th</sup> Edition), Sweet & Maxwell (2011) (“*Kerly*”) at [8-087] as follows:

The purpose of this ground of objection is to prevent the registration of signs which are descriptive of the goods or some characteristic of them. These descriptive marks are excluded from registration because they consist of signs or indications which honest traders either use or may wish to use without any improper motive.

51 Further guidance was given by the High Court in the *Love Case*, where it was said at [70]:

A mark must be refused registration under s 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: (DOUBLEMINT Case R216/1998-1, OHIM (Bd App) at [32] ). It does not matter that there are other synonyms, other more usual signs or indications which can also serve to designate the same characteristic or other characteristics of the goods or services as s 7(1)(c) does not prescribe that the mark under examination should be the only way of designating the particular characteristic in question: (Kerly at para 8-082).

52 The Applicant's case under this ground is very specific. The case as stated in the Applicant's Written Reply Submissions at [21] is:

The Applicant is not submitting that the Chinese characters “菩提” are descriptive of incense. Rather, the Applicant is submitting under Section 7(1)(c) that the Chinese characters “菩提” may serve in trade to designate the intended purpose of incense...

53 It is therefore this specific claim that I would consider to see if it has been made out by the Applicant.

54 The Applicant submits:

... the burning of incense may serve various purposes depending on which type of Buddhist tradition one follows. That said, when Mahayana Buddhists<sup>16</sup> light incense, they are affirming to those who are already enlightened that their purpose is to help others reach enlightenment too<sup>17</sup>.

55 In support of this contention, the Applicant relies on an online article entitled “*Buddhist Beliefs & Incense*” published on <http://people.opposingviews.com> and in particular, a sentence in the article which states “*In essence, when Mahayana Buddhists light incense, they are affirming to those who are already enlightened that their purpose is to help others reach enlightenment, too*”.

56 I am not persuaded by the Applicant's submission and evidence.

57 Firstly, if indeed Mahayana Buddhists light incense for the purpose stated, I find it surprising that the Applicant is only able to furnish a single Internet article to support its point. Clearly there are plenty of books and articles on Buddhist practices and enlightenment or even the significance of burning incense in Buddhism but the Applicant only submitted a single Internet article to prove this link. In fact, a Google search of “significance of burning incense in Buddhism” yields many results which could potentially be useful to the Applicant

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<sup>16</sup> Mahayana Buddhism is the most popular form of Buddhism practiced in Singapore.

<sup>17</sup> Wong's 1<sup>st</sup> SD at [14]

if indeed there is such a link or purpose behind the burning of incense. On a topic which is as well documented as this, I do not think that a single article from the Internet is sufficiently persuasive to prove this point.

58 Secondly, this article is a mere printout of a page from the Internet. Apart from what is stated in the article itself about the author, little else is known about the author's credentials and the source of the author's knowledge on this subject matter. I am therefore not persuaded to accept this article for the truth of the statement made therein although I will bear in mind that such a statement has been made. This is in line with the Registry's practice as stated in HMD Circular No. 3/2015 which reads as follows:

“...the Registrar draws a distinction between: (i) copies of published documents and printouts from official websites; and (ii) printouts from other pages on the internet. For the former, the Registrar may, depending on the circumstances of the case, accept the contents of the copies or printouts for the truth of the statements made. However, any printouts from other pages on the internet will not be accepted for the truth of the statements made but only for the fact that such statements have been made.”

59 Thirdly, this article is published on a website called “opposingviews.com”. The name of the website seems to suggest that the views expressed therein could be divergent or controversial in nature.

60 Fourthly, even if I accept that the statement made in the article is true, I am unable to agree that it supports the Applicant's claim that “菩提” designates the intended purpose of incense. The article merely indicates that the intended purpose of burning incense is to affirm one's purpose of helping others reach enlightenment, rather than as an act directly linked to the attainment of enlightenment. “菩提” at best is only the subject matter of what the incense is used to affirm but it is not the purpose of the incense itself, unless the Proprietor is saying that the purpose of burning of incense is enlightenment. However, the Applicant acknowledges that the article does not support a claim that the burning of incense leads to enlightenment<sup>18</sup>.

#### *Conclusion on Section 7(1)(c)*

61 The ground of invalidation under Section 23(1) read with Section 7(1)(c) therefore fails.

#### **Whether the Subject Mark has Acquired Distinctiveness**

62 Section 7(2) reads:

A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

63 Given that this is an invalidation case, Section 23(2) is also relevant. It reads:

Where the registered trade mark was registered in breach of section 7 in that it is a trade mark referred to in subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration

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<sup>18</sup> Wong's 2<sup>nd</sup> SD at [22]

acquired a distinctive character in relation to the goods or services for which it is registered.

64 The impact of the above is that if at the date of filing the Subject Mark had already acquired a distinctive character through use then Section 7(2) is applicable. However, even if this were not the case, and the Subject Mark acquired a distinctive character since it was registered, Section 23(2) is applicable. The question whether a sign has acquired a distinctive character in respect of the goods must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect.

65 To support a finding of acquired distinctiveness, the Proprietor has to show that a significant proportion of the relevant class of persons *relied* upon the sign as indicating that the goods or services in question originated from a particular trader and from no other. It is insufficient to show that the average consumer merely *associated* the sign with a particular trader. The Court of Appeal in **Société Des Produits Nestlé SA and another v Petra Foods Limited and another** [2016] SGCA 64 (“*Nestlé*”) explained the rationale for this at [38]:

...Accepting evidence of “mere association” as sufficient would, in our judgment, detract from and undermine the essential function of trade marks, which is to *guarantee* the origin of goods and services. Further, bearing in mind that trade mark law (as with most intellectual property regimes) is ultimately about negotiating a fair balance among the various stakeholders in the market concerned, we consider that adopting the “mere association” test would strike the balance too far in favour of would-be trade mark proprietors. The danger of accepting evidence of “mere association” as sufficient is succinctly captured in the following remarks of the English High Court in *Unilever* ([32] *supra*) at [32]:

There is a bit of sleight of hand going on here and in other cases of this sort. The trick works like this. The manufacturer sells and advertises his product widely and under a well-known trade mark. After some while the product appearance becomes well-known. He then says the appearance alone will serve as a trade mark, even though he himself never relied on the appearance alone to designate origin and would not dare to do so. He then gets registration of the shape alone. Now he is in a position to stop other parties, using their own word trade marks, from selling the product, even though no one is deceived or misled.

66 The Court of Appeal in *Nestlé* went on further to say at [51]:

...For clarity, we reiterate that the question of reliance is directed at whether consumers perceive the sign in question as an indicator of the origin of the goods or services to which the sign is applied. The key question, in broad terms, is whether consumers treat that sign as a trade mark, that is to say, as a guarantee of origin. This inquiry will entail an *overall assessment* of the evidence.

67 In this overall assessment, the following factors may be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the applicant in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify the goods and services as originating from a particular trader; and statements from chambers of commerce and industry or other trade and professional associations. If on the basis of these factors, a

significant proportion of the average consumers of the goods and services identify the goods and services as originating from a particular undertaking because of the Subject Mark, the mark would have acquired distinctiveness.

68 Against the backdrop of the foregoing analysis of the applicable principles, I turn to consider the evidence that was submitted.

69 The Proprietor’s evidence showing that the Subject Mark has acquired distinctiveness may be summarised as follows:

- (a) He contends that he has used “菩提” on the Subject Goods since 1998.
- (b) He says he is the first person to use “菩提” in relation to the Subject Goods. When he first started his business in Singapore, no other trader was using “菩提” in relation to the Subject Goods.
- (c) The evidence submitted to support his contention that he has been using “菩提” on the Subject Goods since 1998 is:

1. His business name represented in Chinese characters is “菩提佛教文物批发中心” (“Chinese Business Name”) which translates into English as “Bodhi Buddhism Cultural Relic Wholesale Centre”.



2. He has used the signage  on his shop signboard, company vehicles, office stationery (such as name cards, letterheads and invoices), calendars and product packaging. The signage contains the words

“菩提” as shown in the badge  on the left of the signage as well as in the Chinese Business Name.

3. He has been marking the product packaging of his incense with various signs that contain “菩提”. Some examples of how these signs are used on his product packaging appear below:

Example 1	Example 2	Example 3
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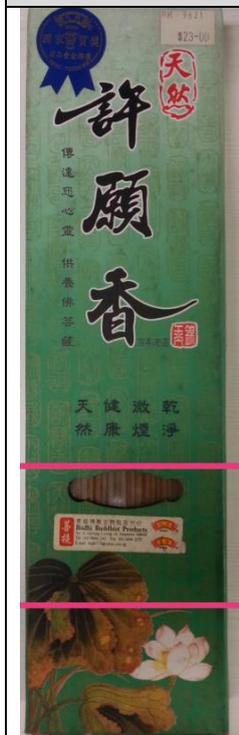
Example 4



Example 5



Example 6



(d) The Proprietor also relies on the following advertisements to show that he has promoted the Subject Mark extensively and as a result of which the Subject Mark has acquired distinctiveness:

Source of advertisement	Nature of advertisement
<p>For You Information Magazine (FYI), a magazine for the Buddhist community in Singapore</p>	<p>Since 1999</p>  <p>Since 2008</p>  <p>Since 2013</p> 
<p>Chinese Yellow Pages</p>	 <p>         源福公司... 6753 5533          源顺兴香庄... 6251 3330          祥丰珍记... 6282 6659  <b>菩提佛教文物批发中心</b>          新加坡武吉2路2#01-05B... <b>6844 2262</b>          萧霖云... 6457 8798          黄亚弟... 6468 9520          鸿合行... 6456 4771          隆发公司...       </p>

Source of advertisement	Nature of advertisement
Lian He Wan Bao and Shin Min Daily News	 <p>The advertisement is for Bodhi Buddhist Products, featuring incense and oil products. It includes a list of benefits such as safety, cleanliness, and fragrance. A warning section identifies counterfeit products and provides registration numbers. The bottom section, highlighted with a red box, lists the company name 'BODHI BUDDHIST PRODUCTS' and its address: 'No. 6, Geylang Lorong 19, Singapore 388480'. Other products mentioned include 'Natural Scented Oil', 'Natural Pure Oil', and 'Natural High-grade Buddhist Oil'.</p>

(e) Three traders of incense products in Singapore, namely Chang, Koh and Tay, also gave evidence on the Proprietor's behalf. These three witnesses essentially say:

1. The Proprietor has consistently advertised the Subject Mark for the Subject Goods in the following publications since 1998:

- (i) Chinese Yellow Pages
- (ii) Lian He Zao Bao
- (iii) Lian He Wan Bao
- (iv) Shin Min Daily News
- (v) For You Information Magazine (FYI)

2. Not only has the Proprietor advertised under and marked his goods with the Subject Mark consistently since 1998, he has also been using the Subject Mark in his business name, his physical shop sign board, his office stationery, such as name cards, invoices, etc., on his company vehicles that drive around Singapore, calendars that are given as gifts to distributors and end consumers, at charity events, on flyers, and on paper bags since around 1998.

3. As a result of the Proprietor's consistent advertising and promotion of the Subject Mark under the Subject Goods, the vast majority of the Buddhist community in Singapore come to identify goods marked with the Subject Mark as originating from the Proprietor.

### *Decision on acquired distinctiveness*

70 Much of the evidence that is tendered by the Proprietor to show that the Subject Mark has acquired distinctiveness pertains to the use of his Chinese Business Name, namely “菩提



佛教文物批发中心” and the usage of the signage since 1998.

I accept the Proprietor’s evidence that he has advertised his business “菩提佛教文物批发中心” and “Bodhi Buddhist Products” extensively. I also do not doubt his oral testimony that he has been linked with the words “菩提” and he is referred to as such by his customers.

Q: So why do your customers refer to you as “Puti”?

A: Because all my products – okay, right. All my products and advertisements are bearing the name “Puti”. “Puti” in English is also called “Bodhi”, okay? Then that’s why they all call me “Puti”. Even my stamp for orders also bearing “Puti”.

71 In my view, it is only natural that the Proprietor is referred to as “菩提” as his Chinese Business Name starts with “菩提”. However, the fact that the Proprietor is referred to as “菩提” does not necessarily mean that his goods are also distinguished by the sign “菩提”. This is because the purpose of a trade or shop name is not, of itself, to distinguish goods or services. The purpose of a trade name or a shop name is to designate a business which is being carried on. I am not suggesting that a company’s trade or shop name can never be used to designate goods or services but merely that if a Proprietor wants to rely on the use of his trade or shop name as having resulted in the acquired distinctiveness of that name for the purposes of distinguishing goods, this has to be borne out by the evidence and it is not a natural consequence. Whether acquired distinctiveness has been shown depends on the nature of the use and the effect that use is likely to have on the consumer. In the instant case, the



signs “菩提佛教文物批发中心” and , in the context in which they are used (such as Examples 4 and 5 at [69(c)] above), merely designate the distributor or retailer of the goods. It has never been used to designate the Subject Goods themselves, which bore their own trade marks. The signs may perhaps have been used as a trade mark for wholesale or retail services of incense products, but it was certainly not used as a trade mark for the Subject Goods.

72 Further, the signs, namely, “菩提佛教文物批发中心” and



include elements which are not present in the Subject Mark and do not go towards showing that “菩提” per se, has acquired distinctiveness. This does not mean that distinctiveness may never be acquired in consequence of the use of a sign as part of or in conjunction with other elements. However, whether it does or not will depend on the circumstances of the use, the nature of the sign and the products in relation to which it is used. With regard to the present use, taking into account that “菩提” is the ultimate goal of

Buddhism, the Proprietor’s use of “菩提” on goods for Buddhists and the nature of the Proprietor’s use of “菩提” (within a sign which clearly designates a name of a business), I am unable to find that “菩提” per se has acquired distinctiveness as a result of the use made of it. As was said by the Court of Appeal in *Nestlé* at [59]:

... where a mark has never been used as a sole badge of origin, ... this might lend weight to the inference that the trader does not depend on the mark standing alone to serve as a trade mark. This is a factor that the trader would have to overcome in proving that the mark has indeed acquired distinctiveness.

73 I now turn to consider the evidence of the three traders who say that the Buddhist community has come to identify goods marked with “菩提” as originating from the Proprietor “as a result of the Proprietor’s consistent advertising and promotion of the Subject Mark”. First, marking goods with “菩提佛教文物批发中心” and



is not the same as marking goods with “菩提”. Second, in relation to the Proprietor’s advertisements, these have been summarised by me at [69(d)]. They do not refer to the Subject Mark per se. They are advertisements for his business “菩提

佛教文物批发中心” which sells goods branded with trade marks such as



. The advertisements and promotion of his business “菩提佛教文物批发中心” at best shows use of “菩提佛教文物批发中心” as a trade mark for wholesale or retail services of incense products, but not for the Subject Goods. The evidence of these three traders therefore does not help advance the Proprietor’s case.

74 Finally, the Proprietor’s evidence also shows use of the words “菩提” in three other ways.



(a) Firstly, he has used the sign  on the product packaging of his incense products since 1999 as illustrated in Examples 1- 3 at [69(c)] above. The Proprietor says that this is clearly use “as a badge of origin”. However, the size of



the  sign is significantly smaller than the other elements found on the packaging and the sign is placed at the bottom corner of the packaging. Even if the sign is noticed by consumers, the nature of the use of the sign is equivocal. In the face of other trademarks appearing on the packaging of the goods themselves

(such as ) , there is no evidence to suggest that customers would rely on the  sign as a secondary trade mark for the goods.

- (b) Secondly, “菩提” has been used on his “*Bodhi Tibetan Incense*” product line (see Example 6 at [69(c)]). The Proprietor says that the Chinese characters “菩提” are in enlarged font and prominently placed so that customers would recognise it as a badge of origin. While I do not disagree that the font is enlarged and the sign is prominently placed, I cannot see how this on its own educates or demonstrates that consumers view the sign, which is not distinctive in the first place, as a trade mark. Much more evidence would be necessary to show that this has happened if this is indeed the case. Furthermore, the trade mark for this line of product is

clearly  and consumers would naturally regard that as the trade mark regardless whether “菩提” was intended to be a secondary trade mark.

- (c) Thirdly, he has used a yellow sticker for the words “菩提” on top and the word “Bodhi” at the bottom (see Examples 1 and 5 at [69(c)] above). These stickers were printed by the Proprietor after the successful registration of the Subject Mark, sometime in 2013. However, no further evidence was submitted by the Proprietor on the extent of use by him of these yellow stickers or how intensive the use was. There is also no evidence as to what is the effect of the use of these yellow stickers on consumers.

75 Overall, my assessment of the evidence is that while it appears that there were some attempts by the Proprietor to try to use “菩提” per se, he was not entirely clear or consistent in how he wanted to use “菩提”. As a result, no clear message could be derived by consumers as to the nature of the use of those words, whether the words were intended, for example, to be descriptive, decorative, inspirational or to indicate origin. The use therefore remains as mere use which does result in acquired distinctiveness of the sign. It is worth quoting Jacob J in *British Sugar* at [302]:

I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark.

...It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote

the mark of a particular trader. This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark.

### *Conclusion on acquired distinctiveness*

76 For the above reasons, I do not consider that the evidence establishes that the Subject Mark has become distinctive because of the use made of it, or that the average consumer has been educated into seeing the Subject Mark as indicating trade origin, whether before the date of application for registration or after registration.

### **Ground of Invalidation under Section 23(1) read with Section 7(6)**

77 Section 7(6) of the Act provides:

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

### *Decision on Section 23(1) read with Section 7(6)*

78 The leading case in this area is the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). Some of the applicable principles laid down in that case which are particularly pertinent here are:

- (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 (*Valentino* at [28]).
- (b) The test for determining bad faith is the combined test of bad faith which contains both a subjective element (*viz*, what the particular proprietor 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 (*Valentino* at [29]).
- (c) Once a *prima facie* case of bad faith is made out by the Applicant, the burden of disproving any element of bad faith on the part of the Proprietor would arise (*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: *Valentino* at [30]. (As observed by Professor Ng-Loy Wee Loon in *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2<sup>nd</sup> Edition, 2014) at [21.4.1], footnote 109, this is not 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 (“*Festina*”) at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)

79 The relevant time for determining whether there was bad faith is the time of filing the application for registration: *Festina* at [100]). The relevant date in this case is 9 April 2013.

80 The Applicant's case on bad faith is essentially as follows:

(a) The Proprietor admitted that at the time of applying for the Subject Mark, he knew there were many other traders who were already selling incense labelled with the words “菩提”.

(b) The Proprietor testified that he applied to register the Subject Mark in order to stop other traders from selling incense bearing the words “菩提”.

(c) The Proprietor further admitted to taking objection to any incense containing the words “菩提” being sold in Singapore.

(d) Further, just prior to the Application Date of the Subject Mark, namely on 30 April 2013, the Proprietor had issued a trade mark infringement demand letter (on 1 Feb 2013) pursuant to his Class 4 registration for the “菩提” mark and settled the matter on terms including a newspaper apology and a sum which was paid to the Proprietor.

(e) Shortly after the Subject Mark was registered, the Proprietor sent out a notice to his customers and the Singapore Religious Goods Merchant Association informing them of his trade mark registration and advising them to stop selling products which infringe his trade mark.

81 The Applicant submits that by filing and securing a trade mark registration for the words “菩提” for incense which he knows is being used by third parties in Singapore, in order to prevent them from trading in the same would be considered unacceptable commercial behaviour by reasonable and experienced persons in the industry. Further, “[t]he fact that the application was made on the back of a successful enforcement action of the Proprietor's “菩提” mark in Class 4 provides further insight into the motivations of the Proprietor at the time of filing of the disputed mark”<sup>19</sup>.

82 I accept that an application may be made in bad faith if an applicant makes the application without intending to use the trade mark, and the application was made for the sole objective to prevent other traders from entering the market. However, given that the Proprietor has been trading under the name “菩提佛教文物批发中心”, it appears to me that the Proprietor was of the view (whether rightly or wrongly) that he had an interest in protecting “菩提”. The following passage in the transcripts illustrate this:

Re-examination of Kwek Soo Chuan Pg 42 Ln 5

Q. So why did you register the application mark in this case, "Pu Ti", in class 3 only in 2013?

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<sup>19</sup> Applicant's Written Submissions at [51].

A. That is when in 2013 I realised that there are many "Pu Ti" -- many incense sticks being brought in bearing "Pu Ti" logo. After many years of advertisement that I have spent, I really worry about -- I worry a lot about copycats, because for a day of charitable sales, those sales that I have made it's all donated out. The money I have made is all donated out to charity causes. So -- and the time and effort and sweat to prepare all this, and if I don't stop all this my 18 years of effort and sweat and lifetime of work will go -- will be wasted.

Usually in my thoughts, in my view, usually any company will not use another company's name for trademark, that's in my view, meaning nobody would use my company name to sell their joss stick, right? And then -- but in actual fact because I would think that many people would sell products of other companies, but not company's name of another company, name of another company, but this is not the case.

83 I accept the Proprietor's evidence that the Subject Mark was filed to help him protect his perceived interest. The fact that this may have been triggered by other traders' use of "菩提" makes no difference to this although it entirely explains the timing of the application.

84 I therefore reject the Applicant's claim that the Subject Mark was filed in bad faith.

*Conclusion on Section 7(6)*

85 The ground of invalidation under Section 23(1) read with Section 7(6) therefore fails.

**Ground of Invalidation under Section 23(3) read with Section 8(2)(b)**

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

8.—(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 exists a likelihood of confusion on the part of the public.

*Decision on Section 23(3) read with Section 8(2)(b)*

87 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 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.

88 The thrust of the Applicant's submission under this ground is as follows:

- (a) The Applicant is the proprietor of the following earlier trade mark in Class 3 with a date of registration on 19 June 2000:

Mark	Trade Mark No.	Class	Goods
	T0010570B	3	Detergents other than for use in manufacturing operation and for medical purposes; incense; incense sticks, incense coils, incense cones, incense sprays, joss sticks; scented oils and scented preparations; soaps in liquid form, soaps for use on a person; all included in Class 3

- (b) Despite the Applicant's earlier trade mark, the Subject Mark was registered on 9 April 2013 also in Class 3:

Mark	Trade Mark No.	Class	Goods
	T1305626H	3	Incense; incense sticks; incense coils; incense cones; incense sprays; joss sticks; scented oils; scented preparations.

- (c) In April 2014, the Applicant applied to register the following mark in Class 4:

Mark	Trade Mark No.	Class	Goods
	40201517739R	4	Candles; Illuminating oil; Lamp oils; Wicks; Lamp wicks; Wicks for candles; Nightlights (candles); Perfumed candles; Scented candles; Lighting fuel; Paraffin wax

- (d) However, the examiner cited the following earlier trade marks belonging to the Proprietor as being confusingly similar:

Mark	Trade Mark No.	Class	Goods
	T0207026D	4	Candles and lamp oils; all included in Class 4.

Mark	Trade Mark No.	Class	Goods
菩提	T0708673H	4	Lamp oils, candles and wicks

(e) Despite filing a round of arguments to the examiner citing the co-existence of the marks in Class 3, the examiner maintained her objections to the citation and held that:

“the two Chinese characters, in which the cited mark consists are incorporated in the subject mark as a prominent element. The presence of a leaf device and the additional textual element "PUIDI" in the subject mark are insufficient in diverting the consumer's attention away from the confusingly [sic] similarity between the two marks concerned.”

89 In essence, the Applicant’s submission is that if the two marks in Class 4 are held by the examiner to be confusingly similar, by the same token, the marks in Class 3, which are identical to the Class 4 marks should also be held to be confusingly similar by me.

90 I reject this submission. In inter partes proceedings, the Registrar must act as an independent tribunal and judge the matter on the basis of the arguments and evidence presented to him by the parties in those proceedings. If the opinion of the examiner in this instant case on the similarity (or more accurately, the lack of similarity) of the marks under comparison is not something to which I can, or should, attach any weight, there is even less reason why the views of an examiner in a different application (and furthermore, where the application is in a different class) should be given any more weight.

91 At best, the Applicant’s case is that there is one examiner who was of the view that the marks are not confusingly similar, and one other examiner of the view that the marks are confusingly similar. But as to why I should agree with the examiner who held the view that the marks are confusingly similar and invalidate the decision of the examiner who found otherwise, the Applicant did not give me any reasons.

92 There being no other submission from the Applicant as to why I should find marks-similarity, I find that the Applicant has not sufficiently made out its case on the first element of the “step-by-step” approach. In any event, I am of the view that overall the marks are more dissimilar than similar and I set out briefly my reasons below:

(a) The marks share one common denominator: the words “菩提”. I have found at [48] that “菩提” simpliciter, is devoid of distinctive character and at [76] that the Subject Mark has not acquired distinctiveness. In this regard, I should be careful before finding similarity merely because of the coincidence of the use of these words. As stated by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] SGCA 26 at [30]:

... the more fancy or inventive or arbitrary a mark, then in general, the greater the protection it will receive, in the sense that the defendant would have to demonstrate to a more compelling degree that his mark or sign is indeed dissimilar from the registered mark (see *Sarika* ([16] *supra*) at [20], *Polo* (CA)

([16] *supra*) at [10] and *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 (“*Ozone Community*”) at [44]). On the other hand, the more descriptive a mark, the greater the latitude afforded to the defendant in using words or ideas of a generic nature, even if these have some similarity to what is found in the registered mark. This follows as a matter of common sense from the fact that in order to balance the interests of honest traders who enter the market later, the rule that proscribes impermissible similarity cannot be applied in precisely the same manner to a mark that uses common descriptive words or devices as to one that does not. Otherwise, the law would prevent the legitimate use of an unacceptably large spectrum of common words and ideas.



- (b) Visually, the marks are dissimilar. The Applicant’s earlier mark  is a composite mark containing several components (such as the Chinese characters “菩提” in a rectangular border, the word “PUIDI” and leaf device). The leaf device is unlikely to be overlooked by the average consumer in his imperfect recollection of the mark as the device is outstanding, memorable and bigger in size than any of the other components in the Applicant’s earlier mark. On the other hand, the Subject Mark consists only of the Chinese characters “菩提” in plain font.
- (c) Aurally, the marks are similar to a low degree. This is because while Chinese-speaking consumers in Singapore are likely to refer to both marks as “Pú tí” given the overlap in the Chinese characters “菩提”, English-speaking consumers are likely to pronounce the Applicant’s earlier mark with reference to the Romanised word “PUIDI”.
- (d) Conceptually, the marks are dissimilar. The concept behind the Subject Mark is enlightenment. However, the concept behind the Applicant’s earlier mark must be assessed as a whole, bearing in mind that the idea connoted by each component may be very different from the sum of its parts. While “菩提” on its own may mean enlightenment, “菩提” seen together with a leaf device, connotes the idea of a leaf from a Bodhi tree. The word “PUIDI” has no meaning and will convey no idea. For consumers who do not understand the meaning of “菩提”, the Subject Mark will convey no meaning and the Applicant’s earlier mark will convey the simple idea of a leaf.

93 Even if I am with the Applicant that there is marks-similarity and I take into account the view of the examiner in the Class 4 application, the Applicant made no submissions under the second and third elements of the “*step-by-step*” approach and the invalidation also fails for that reason.

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

94 The ground of invalidation under Section 23(3) read with Section 8(2)(b) therefore fails.

## **Conclusion**

95 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the invalidation succeeds under Section 23(1) read with Section 7(1)(b) but fails in respect of the other grounds. The Applicant has succeeded in invalidating the Proprietor's mark and is entitled to an award of costs in its favour. However, having regard to the fact that the Applicant only succeeded on one out of five pleaded grounds, I am not inclined to award the Applicant full costs. I will hear parties further on costs.

Date of Issue: 9 October 2017

[The appeal from this decision to the High Court was dismissed.]