

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

Trade Mark No. T1405403Z  
Hearing Date: 8 May 2017

**IN THE MATTER OF TRADE MARK APPLICATION BY**

**XIAOMI SINGAPORE PTE LTD**

**AND**

**OPPOSITION THERETO BY**

**APPLE INC.**

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

Representation:

Ms Regina Quek and Mr Shawn Poon (One Legal LLC) for the Applicant  
Mr Lim Ren Jun and Mr Nigel Bay (Wong & Leow LLC) for the Opponent

**GROUND OF DECISION**

1 The range of products offered by Apple Inc. (“the Opponent”) includes the iPhone, iMac, iPod and iTunes to name a few. In particular, for the purposes of the current proceedings, their tablet computers are sold under the iPad mark, which is registered as a trade mark in Singapore for relevant goods and services of interest to the Opponent.

2 The range of products offered by Xiaomi Singapore Pte Ltd (“the Applicant”) and its parent company, Xiaomi Inc., include Mi 1, Mi 2, Mi Note, Mi Bank, Mi Air Purifier and the Mi Power Bank. The Applicant applied to register “MI PAD” as a trade mark in Singapore

for tablet computers, among other goods and services. The details of its application are as follows:

| Trade Mark  | Class / Goods or Services  |
|---|--|
| <p><b>MI PAD</b></p> <p>T1405403Z<br/>(the “Application Mark”)</p> <p>Date of Application:<br/>9 April 2014<br/><br/>(the “Application Date”)</p> | <p><u>Class 09</u><br/>Portable and handheld electronic devices for transmitting, storing, manipulating, recording, and reviewing text, images, audio, video and data, including via global computer networks, wireless networks, and electronic communications networks; tablet computers, electronic book readers, periodical readers, digital audio and video players, digital camera, electronic personal organizers, personal digital assistants, electronic calendars, mapping and global positioning system (GPS) devices; computer peripheral devices; computer and portable and handheld electronic device accessories, namely, monitors, displays, keyboards, mouse, wires, cables, modems, disk drives, adapters, adapter cards, cable connectors, plug-in connectors, electrical power connectors, docking stations, charging stations, drivers, battery chargers, battery packs, memory cards and memory card readers, headphones and earphones, speakers, microphones, and headsets, cases, covers, and stands for portable and handheld electronic devices and computers; computer software for the development of content and service delivery across global computer networks, wireless networks, and electronic communications networks; downloadable audio works, visual works, audiovisual works and electronic publications featuring books, magazines, newspapers, periodicals, newsletters, journals and manuals on a variety of topics; computer software for transmitting, sharing, receiving, downloading, displaying, transferring, formatting, and converting content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works via portable electronic devices and computers; computer game programs; downloadable music files; downloadable image files; video telephones; navigational instruments; screens [photoengraving].</p> <p><u>Class 38</u><br/>Telecommunication access services; communication by computer; transmission of data and of information by electronic means, broadcasting or transmission of radio and television programs; provision of telecommunications connections to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; streaming of video content, streaming and subscription audio broadcasting of spoken word, music, concerts, and radio programs, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events,</p> |

|  |  |
|--|--|
|  | and entertainment-related programs of all kinds, via computer and other communications networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment in the nature of music, concerts, videos, radio, television, film, news, sports, games and cultural events; communication services, namely, providing users access to communication networks for the transfer of music, video and audio recordings; teleconferencing services; providing internet chatrooms; voice mail services; transmission of digital files. |
|--|--|

3 The application was accepted and published on 16 July 2014 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 11 November 2014. This Notice of Opposition was revised by the Opponent on 13 November 2014. On 11 March 2015, the Applicant filed its Counter-Statement.

4 The Opponent filed evidence in support of the opposition on 28 September 2015. The Applicant filed evidence in support of the application on 30 March 2016. The Opponent filed evidence in reply on 30 September 2016. The Pre-Hearing Review (“PHR”) was held on 26 October 2016. Following the PHR, both parties filed supplementary evidence on 19 January 2017. The opposition was first fixed for hearing on 18 April 2017 but re-fixed to 8 May 2017 due to the unavailability of the Opponent's lawyers on the original date.

### **Grounds of Opposition**

5 The Opponent relies on the following grounds in this opposition:

- (i) Section 8(2)(b);
- (ii) Section 8(4)(a) read with 8(4)(b)(i);
- (iii) Section 8(4)(b)(ii);
- (iv) Section 8(7)(a); and
- (v) Section 7(6)

of the Trade Marks Act (Cap. 332, Rev. Ed. 2005) (“the Act”).

### **Opponent’s Evidence**

6 The Opponent’s evidence comprises the following:

- (i) Statutory Declaration by Mr Thomas R. La Perle, Director of Legal Department of the Opponent, dated 23 September 2015 (“the Opponent’s 1<sup>st</sup> SD”);
- (ii) Statutory Declaration in reply by Mr La Perle dated 29 September 2016 (“the Opponent’s 2<sup>nd</sup> SD”); and
- (iii) Supplementary Statutory Declaration by Mr La Perle dated 17 January 2017 (“the Opponent’s 3<sup>rd</sup> SD”).

### **Applicant’s Evidence**

7 The Applicant’s evidence comprises the following:

- (i) Statutory Declaration made by Mr Hugo Barra, Vice President of Xiaomi Global Division of the Applicant, dated 29 March 2016 (“the Applicant’s 1<sup>st</sup> SD”); and
- (ii) Supplementary Statutory Declaration made by Mr Barra dated 16 January 2017 (“the Applicant’s 2<sup>nd</sup> SD”).

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

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

### **Background**

9 The Applicant was incorporated in Singapore on 21 February 2014. It is a wholly owned subsidiary of Xiaomi Inc., a Chinese electronics company founded on 6 April 2010. From this point onwards, all references to “Applicant” will include not just the Applicant but Xiaomi Inc. as well.

10 The Applicant’s name, Xiaomi, comes from the *hanyu pinyin* (a widely used transliteration system) of the Chinese characters for small, uncooked rice, or “millet” (“小米”). It also references a revolutionary idiom from the early days of the Chinese Communist Party which calls on fighters to have millet and a rifle on hand to be ready to fight<sup>1</sup>. The Applicant is one of the world’s fastest-growing smartphone companies and most valuable startups, with a valuation of approximately US\$45 billion as at December 2014. In 2015, it was ranked as the world’s fourth largest smartphone vendor, with a share of 5.6% of the worldwide smartphone market.

11 The Applicant has two main product ranges, namely the flagship “Mi” range and the “Redmi” range. The products in the “Mi” range include the Mi 1, Mi 2, Mi 3, Mi 4, Mi 5, Mi Pad, Mi Pad 2, Mi Note, Mi Note Pro, Mi Band, Mi Air Purifier and the Mi Power Bank. The products in the “Redmi” range include the Redmi, Redmi IS, Redmi 2, Redmi Note, Redmi Note 2 and the Redmi 3. The “MI PAD” tablet is the Applicant’s first tablet. Its release was announced by the Applicant on 15 May 2014 and it was sold in China in June 2014.

12 The Applicant entered the Singapore market in early 2014. The first product sold in Singapore was the Redmi phone, which was released on 21 February 2014. This was subsequently followed by other products such as the Mi 3 (on 7 March 2014) and the Redmi Note (July 2014). The Applicant’s “MI PAD” tablet was introduced in Singapore on 10 February 2015<sup>2</sup>.

13 The Applicant’s products are officially distributed to customers in Singapore via its website, [www.mi.com/sg](http://www.mi.com/sg) and through the websites and physical outlets of third parties such as Starhub, Singtel, M1, Challenger Singapore and [www.lazada.sg](http://www.lazada.sg). The Applicant’s first brick-and-mortar shop in Singapore, located at Suntec City Mall, was set up in or around October 2016. It also operates a service centre at The Central.

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<sup>1</sup> Applicant’s 1<sup>st</sup> SD at [13].

<sup>2</sup> Applicant’s 1<sup>st</sup> SD at [74].

14 The Opponent needs little introduction. Incorporated on 3 January 1977 in California, it is a world leading manufacturer of mobile communication and media devices. In 2015, the Opponent was named the most profitable company in the world, and the Apple brand was named the number one brand in terms of brand value.

15 The Opponent’s evidence goes into much detail about its I-family of marks which it began using since 1988 when the iMac PC was introduced, and the sales figures in relation to the I-family of marks. To give an illustration, in 2014, the Opponent’s net sales figures amounted to over USD182 billion and out of this, some USD134 million is attributed to the sales of goods bearing the I-prefix marks, namely, iPod, iPhone and iPad<sup>3</sup>. It says in its evidence<sup>4</sup>:

Overall, the Apple products and services within the family of “I” marks became a veritable phenomenon and the object of recognition and desire among consumers throughout the world. The use of the I-prefix family of marks is a famous naming convention of the Opponent. The addition of the element “I” brings with it a significant amount of consumer recognition and goodwill associated with the Opponent – it is not merely an addition of a single vowel. The Opponent’s famous I-prefix family of marks includes the iPad mark.

16 The first generation “IPAD” tablet was launched in Singapore on 23 July 2010. The launch of this device, as well as subsequent generations of the “IPAD” device, was met with great enthusiasm by Singapore consumers who queued up many hours in advance to purchase the devices.

17 The worldwide sales for the “IPAD” tablet averaged about USD30 billion per annum from 2012 to 2014. By 2014, 237 million “IPAD” devices had been sold by the Opponent worldwide<sup>5</sup>.

18 In Asia Pacific (including Singapore), the Opponent’s total net sales for devices (including the “IPAD” tablet), amounted to over USD42 billion from 2010 to 2014<sup>6</sup>.

19 The annual advertising expenditure incurred by the Opponent to promote its products worldwide from 2010 to 2014 is as follows:

| <b>Fiscal Year</b>             | <b>Advertising Expenditures</b> |
|--------------------------------|---------------------------------|
| 2010 (ended 25 September 2010) | USD 691,000,000.00              |
| 2011 (ended 24 September 2011) | USD 933,000,000.00              |
| 2012 (ended 29 September 2012) | USD 1,000,000,000.00            |
| 2013 (ended 28 September 2013) | USD 1,100,000,000.00            |
| 2014 (ended 27 September 2014) | USD 1,200,000,000.00            |

<sup>3</sup> Opponent’s 1<sup>st</sup> SD at [15] and [16].

<sup>4</sup> Opponent’s 1<sup>st</sup> SD at [14].

<sup>5</sup> Opponent’s 1<sup>st</sup> SD at [53].

<sup>6</sup> Opponent’s 1<sup>st</sup> SD at [55].

20 The Opponent did not break down the quantum spent on advertising, promoting and marketing the “IPAD” products in Singapore. However, it lodged some 115 pages of exhibits and five MP4 videos to show that the “IPAD” device has been advertised in Singapore in major print publications such as newspapers and magazines, as well as through broadcast media such as television and radio<sup>7</sup>. It also contends that telecommunications service providers in Singapore, such as Singtel, M1 and Starhub, have also extensively promoted and advertised the “IPAD” range of products<sup>8</sup>.

21 The Opponent has sought and obtained numerous registrations of the “IPAD” and “IPAD”-formative marks in Singapore, with the earliest filing date dating as far back as 7 November 2000, including:

| <b>Apple i-formative mark</b>  | <b>Trade Mark No.</b> | <b>Filing Date</b> | <b>Class</b> | <b>Status</b> |
|--|-----------------------|--------------------|--------------|---------------|
| <br> | T0019534E             | 7 November 2000    | 9            | Registered    |
| <b>IPAD</b>  | T1000463A             | 16 July 2009       | 9            | Registered    |
| <b>IPAD</b>  | T1000464Z             | 15 January 2010    | 38           | Registered    |
| <b>IPAD</b>  | T1000464Z             | 15 January 2010    | 16           | Registered    |
| <b>IPAD</b>  | T1000464Z             | 15 January 2010    | 28           | Registered    |
| <b>IPAD</b>  | T1000464Z             | 15 January 2010    | 41           | Registered    |
| <b>IPAD</b>  | T1000464Z             | 15 January 2010    | 42           | Registered    |
| <b>IPAD</b>  | T1004429C             | 13 April 2010      | 18           | Registered    |
| <b>IPAD</b>  | T1004429C             | 13 April 2010      | 35           | Registered    |
| <b>IPAD</b>  | T1004429C             | 13 April 2010      | 37           | Registered    |
|   | T1007921F             | 4 May 2010         | 9            | Registered    |
| <b>IPAD SMART COVER</b>  | T1115984A             | 14 November 2011   | 9            | Registered    |
| <b>IPAD SMART COVER</b>  | T1115984A             | 14 November 2011   | 18           | Registered    |
|   | T1218360F             | 4 December 2012    | 10           | Registered    |

<sup>7</sup> Opponent’s 1<sup>st</sup> SD, Exhibit TLP-46.


<sup>8</sup> Opponent’s 1<sup>st</sup> SD, Exhibit TLP-5.

| <u>Apple i-formative mark</u> | <u>Trade Mark No.</u> | <u>Filing Date</u> | <u>Class</u> | <u>Status</u> |
|-------------------------------|-----------------------|--------------------|--------------|---------------|
| <b>IPAD SMART CASE</b>        | T1218848I             | 12 December 2012   | 9            | Pending       |
| <b>IPAD MINI</b>              | T1305097I             | 4 February 2013    | 9            | Registered    |
| <b>IPAD AIR</b>               | T1320637E             | 20 November 2013   | 9            | Registered    |

22 Further, the Opponent has applied for and obtained registration of the “IPAD” trade mark in numerous countries and regions around the world, including Argentina, Armenia, Australia, Bahrain, The Republic of Celarus, Belize, Benelux, Bosnia and Herzegovina, China, Columbia, Congo, Costa Rica, Croatia, Denmark, Dorminica, Ecuador, Ethiopia, France, Honduras, Hong Kong, Iceland, India, Indonesia, Israel, Jamaica, Japan, Kyrgyzstan, Jordan, Kuwait, Lebanon, Macau, Madagascar, Mauritius, Mexico, Moldova, Myanmar, New Zealand, Nigeria, Norway, OAPI, Panama, Paraguay, Peru, South Korea, Russian Federation, Switzerland, Thailand, Tunisia, Turkey, Turkmenistan, Uganda, Ukraine, the United Arab Emirates, the United Kingdom, the United States, Vietnam, WIPO, Yemen, Zanzibar and Zimbabwe<sup>9</sup>.

23 The Opponent has also successfully opposed the Application Mark in several jurisdictions, such as, China, EU, Australia, New Zealand, Israel, Norway, Colombia, Japan, Mexico, Taiwan and Turkey<sup>10</sup>.

24 The Opponent relies on the following earlier trade marks in these proceedings:

| <b>Registered Trade Mark</b>   | <b>Class / Goods or Services</b>  |
|--|---|
|  <p>TM No. T1000463A</p> <p>Registration Date: 15 January 2010</p> <p>Priority Date: 16 July 2009</p> | <p><b>Class 9</b></p> <p>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computers, computer peripheral devices, computer terminals; computer hardware; computer gaming machines, microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, disk drives, adapters, adapter cards, connectors and drivers; blank computer storage media; magnetic data carriers;</p> |

<sup>9</sup> Opponent’s 1<sup>st</sup> SD at [95].

<sup>10</sup> Opponent’s 2<sup>nd</sup> SD at [25] and Opponent’s 3<sup>rd</sup> SD at [6] - [9].

| Registered Trade Mark | Class / Goods or Services  |
|-----------------------|--|
|                       | <p>computer software and firmware, namely, operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer hardware and software for providing integrated telephone communication with computerized global information networks; handheld digital electronic devices and software related thereto; MP3 and other digital format audio players; hand held computers, tablet computers, personal digital assistants, electronic organizers, electronic notepads; mobile digital electronic devices, global positioning system (GPS) devices, telephones; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, and other digital data; cordless telephones; mobile telephones; parts and accessories for mobile telephones; facsimile machines, answering machines, cameras, videophones, telephone-based information retrieval software and hardware; electronic handheld units for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; electronic communication equipment and instruments; telecommunications apparatus and instruments; computer software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; fonts, typefaces, type designs and symbols in the form of recorded data; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; computer and electronic games; computer equipment for use with any of the aforesaid goods; electronic apparatus with multimedia functions for use with any of the aforesaid goods; electronic apparatus with interactive functions for use with any of the aforesaid goods; accessories, parts, fittings, and testing apparatus for all the aforementioned goods; user manuals in electronically readable, machine readable or computer readable form for use with, and sold</p> |




| Registered Trade Mark   | Class / Goods or Services   |
|---|---|
|   | <p>as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); CD-ROMs; digital versatile discs; mouse pads; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones; digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; digital music and/or video players; radios; video cameras; audio, video, and digital mixers; radio transmitters; car audio apparatus; parts and fittings for all the aforesaid goods; bags and cases adapted or shaped to contain cameras and/or video cameras; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitations of leather; mobile telephone covers made of cloth or textile materials; bags and cases adapted or shaped to contain MP3 players, hand held computers, tablet computers, personal digital assistants, global positioning system (GPS) devices, electronic organizers and electronic notepads.</p> |
| <p><b>IPAD</b></p> <p>Trade Mark No. T1000464Z</p> <p>Registration Date: 15 January 2010</p> <p>Priority Date: 16 July 2009</p> | <p><b>Class 38</b></p> <p>Telecommunications; communication and telecommunication services; telecommunication access services; communications by computer; communication between computers; electronic sending of data and documentation via the Internet or other databases; electronic transmission of data; communications services for the exchange of data in electronic form; sending (transmission) of news; providing telecommunication access to websites; providing telecommunication access to websites online allowing the download of information and data providing telecommunication access to web sites on the Internet; delivery of digital music by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and / or receive messages through a wireless</p>   |

| Registered Trade Mark | Class / Goods or Services   |
|-----------------------|---|
|                       | <p>data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; broadcasting or transmission of radio and television programmes; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; webcasting services (transmission); delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; provision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing telecommunication access to digital music web sites on the Internet; providing telecommunication access to MP3 web sites on the Internet; delivery of digital music by telecommunications; provision of telecommunications connections to the Internet or computer databases; electronic mail services; telecommunication of information (including web pages); video broadcasting, broadcasting pre-recorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network; streaming of video content via a global computer network; subscription audio broadcasting via a global computer network; audio broadcasting; audio broadcasting of spoken word, music, concerts, and radio programmes, broadcasting pre-recorded videos featuring music and entertainment, television programmes, motion pictures, news, sports, games, cultural events, and entertainment-related programmes of all kinds, via computer and other communications networks; streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; communication services, namely, matching users for the transfer of music, video and audio recordings via communication networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio, television, film, news, sports, games and cultural events; rental and hire of communication apparatus and electronic mail-boxes; electronic news services; electronic communications consultancy; facsimile, message collection and transmission services; transmission of data and of information by electronic means, computer, cable, radio,</p> |

| Registered Trade Mark | Class / Goods or Services   |
|-----------------------|---|
|                       | teleprinter, teletype, electronic mail, telecopier, television, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; information, advisory and consultancy services relating to all the aforesaid; provision of telecommunication access time to web-sites featuring multimedia materials; providing telecommunication access to databases and directories via communications networks for obtaining data in the fields of music, video, film, books, television, games and sports; providing users with telecommunication access time to electronic communications networks with means of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing user access to the Internet (service providers). |



(Collectively, the ““IPAD” Mark”.) Reliance on TM No. T0019534E “  ” as an earlier trade mark was dropped at the hearing.

## MAIN DECISION

### Ground of Opposition under Section 8(2)(b)

25 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 8(2)(b)*

26 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.

*Comparison of Goods and Services*

27 It is useful to begin with the second element in order to set the context. The respective goods and services are as follows:

Class 9

| Applicant’s Goods  | Opponent’s Goods  |
|--|---|
| Portable and handheld electronic devices for transmitting, storing, manipulating, recording, and reviewing text, images, audio, video and data, including via global computer networks, wireless networks, and electronic communications networks; <b>tablet computers</b> , electronic book readers, periodical readers, digital audio and video players, digital camera, electronic personal organizers, <b>personal digital assistants</b> , electronic calendars, mapping and global positioning system (GPS) devices; computer peripheral devices; computer and portable and handheld electronic device accessories, namely, monitors, displays, keyboards, mouse, wires, cables, modems, disk drives, adapters, adapter cards, cable connectors, plug-in connectors, electrical power connectors, docking stations, charging stations, drivers, battery chargers, battery packs, memory cards and memory card readers, headphones and earphones, speakers, microphones, and headsets, cases, covers, and stands for portable and handheld electronic devices and computers; computer software for the development of content and service delivery across global computer networks, wireless networks, and electronic communications networks; downloadable audio works, visual works, audiovisual works and electronic publications featuring books, magazines, newspapers, periodicals, newsletters, journals and manuals on a variety of topics; computer software for | Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computers, computer peripheral devices, computer terminals; computer hardware; computer gaming machines, microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, disk drives, adapters, adapter cards, connectors and drivers; blank computer storage media; magnetic data carriers; computer software and firmware, namely, operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and |

| Applicant's Goods  | Opponent's Goods  |
|--|---|
| <p>transmitting, sharing, receiving, downloading, displaying, transferring, formatting, and converting content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works via portable electronic devices and computers; computer game programs; downloadable music files; downloadable image files; video telephones; navigational instruments; screens [photoengraving].</p> | <p>searching online databases, computer hardware and software for providing integrated telephone communication with computerized global information networks; handheld digital electronic devices and software related thereto; MP3 and other digital format audio players; hand held computers, <b>tablet computers, personal digital assistants</b>, electronic organizers, electronic notepads; mobile digital electronic devices, global positioning system (GPS) devices, telephones; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, and other digital data; cordless telephones; mobile telephones; parts and accessories for mobile telephones; facsimile machines, answering machines, cameras, videophones, telephone-based information retrieval software and hardware; electronic handheld units for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; electronic communication equipment and instruments; telecommunications apparatus and instruments; computer software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; fonts, typefaces, type designs and symbols in the form of recorded data; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; computer and electronic games; computer equipment for use with any of the aforesaid goods; electronic apparatus with multimedia functions for use with any of the aforesaid goods; electronic apparatus with interactive functions for use with any of the aforesaid goods; accessories, parts, fittings, and testing apparatus for all the aforementioned goods;</p> |

| <b>Applicant's Goods</b> | <b>Opponent's Goods</b>  |
|--------------------------|--|
|                          | <p>user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); CD-ROMs; digital versatile discs; mouse pads; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones; digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; digital music and/or video players; radios; video cameras; audio, video, and digital mixers; radio transmitters; car audio apparatus; parts and fittings for all the aforesaid goods; bags and cases adapted or shaped to contain cameras and/or video cameras; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitations of leather; mobile telephone covers made of cloth or textile materials; bags and cases adapted or shaped to contain MP3 players, hand held computers, tablet computers, personal digital assistants, global positioning system (GPS) devices, electronic organizers and electronic notepads.</p> |

Class 38

| <b>Applicant's Services</b>               | <b>Opponent's Services</b>            |
|---|---------------------------------------|
| <b>Telecommunication access services;</b> | Telecommunications; communication and |

| Applicant's Services  | Opponent's Services   |
|---|---|
| <p><b>communication by computer; transmission of data and of information by electronic means</b>, broadcasting or transmission of radio and television programs; provision of telecommunications connections to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; streaming of video content, streaming and subscription audio broadcasting of spoken word, music, concerts, and radio programs, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via computer and other communications networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment in the nature of music, concerts, videos, radio, television, film, news, sports, games and cultural events; communication services, namely, providing users access to communication networks for the transfer of music, video and audio recordings; teleconferencing services; providing internet chatrooms; voice mail services; transmission of digital files.</p> | <p>telecommunication services; <b>telecommunication access services; communications by computer;</b> communication between computers; electronic sending of data and documentation via the Internet or other databases; electronic transmission of data; communications services for the exchange of data in electronic form; sending (transmission) of news; providing telecommunication access to websites; providing telecommunication access to websites online allowing the download of information and data providing telecommunication access to web sites on the Internet; delivery of digital music by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; broadcasting or transmission of radio and television programmes; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; webcasting services (transmission); delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; provision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing telecommunication access to digital music web sites on the Internet; providing telecommunication access to MP3 web sites on the Internet; delivery of digital music by telecommunications; provision of telecommunications connections to the</p> |

| Applicant's Services | Opponent's Services   |
|----------------------|---|
|                      | <p>Internet or computer databases; electronic mail services; telecommunication of information (including web pages); video broadcasting, broadcasting pre-recorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network; streaming of video content via a global computer network; subscription audio broadcasting via a global computer network; audio broadcasting; audio broadcasting of spoken word, music, concerts, and radio programmes, broadcasting pre-recorded videos featuring music and entertainment, television programmes, motion pictures, news, sports, games, cultural events, and entertainment-related programmes of all kinds, via computer and other communications networks; streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; communication services, namely, matching users for the transfer of music, video and audio recordings via communication networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio, television, film, news, sports, games and cultural events; rental and hire of communication apparatus and electronic mail-boxes; electronic news services; electronic communications consultancy; facsimile, message collection and transmission services; <b>transmission of data and of information by electronic means</b>, computer, cable, radio, teleprinter, teleletter, electronic mail, telecopier, television, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; information, advisory and consultancy services relating to all the aforesaid; provision of</p> |



| Applicant's Services | Opponent's Services  |
|----------------------|--|
|                      | telecommunication access time to web-sites featuring multimedia materials; providing telecommunication access to databases and directories via communications networks for obtaining data in the fields of music, video, film, books, television, games and sports; providing users with telecommunication access time to electronic communications networks with means of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing user access to the Internet (service providers). |

28 There are clear overlaps between the Applicant's goods and services and the Opponent's goods and services. Items such as "*tablet computers*", "*personal digital assistants*", "*telecommunication access services*" and "*transmission of data and of information by electronic means*", to name a few, appear in both parties' specifications.

29 The Applicant makes no submissions as regards the issue of whether the Applicant's goods and services are identical with or similar to those for which the "IPAD" Mark is protected.

30 For reasons of procedural economy, I will not undertake a full comparison of the goods and services. Instead I will first assess the opposition in relation to the above items where the contested goods and services are obviously identical to those covered by the earlier trade marks. (For the avoidance of doubt, this does not mean that the identical goods and services are limited to the above list nor that the remaining goods and services in the Application Mark are not similar to the earlier marks.) If the opposition fails where the respective goods and services are identical, it follows that it will also fail where the respective goods and services are only similar.

#### *Comparison of Marks*

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

- (i) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. (*Staywell* at [20].)
- (ii) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects

of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression. (*Staywell* at [17] – [18].)

- (iii) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side and examined in detail because the person who is confused often makes a comparison from memory removed in time and space from the marks. (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [62(a)]). That said, the court or tribunal is entitled to have special regard to the distinctive or dominant components of a mark, even while it assesses the similarity of the two marks as composite wholes, since those (distinctive or dominant components) tend to stand out in the consumer’s imperfect recollection. (*Staywell* at [23].)
- (iv) The signs/marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some care and good sense in making his purchases. (*The Polo/Lauren Co, LP Shop In Department Store Pte Ltd* [2006] SGCA 14 (“*Polo (CA)*”) at [34].)
- (v) Distinctiveness (in both its technical and non-technical senses) is a factor *integrated into* the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry. (*Staywell* at [30].) The more distinctive the registered trade mark, the more it is necessary to show sufficient alterations to, or difference in, the sign in order that it may not be held to be similar to the trade mark. (*Hai Tong* at [25].) Conversely, 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. 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. (*Hai Tong* at [30].)

### *Distinctiveness*

32 I appreciate that distinctiveness of a mark is to be integrated within the assessment of mark similarity. However, before I delve into the assessment of mark similarity in more detail, I should mention that it is not in dispute in these proceedings that the word “Pad” is a synonym for “*tablet computers*” and has a descriptive meaning in relation to goods and services which are linked to tablet computers. It is also not in dispute that the public in Singapore will recognise the descriptive connotation in the element “Pad”. The Opponent concedes that “[u]pon hearing the word “Pad” one would think that the good to which the mark is applied is a tablet device”<sup>11</sup> and “[t]his component [“Pad”] will cause consumers to associate both competing marks with tablet devices”<sup>12</sup>.

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<sup>11</sup> Opponent’s Written Submissions at [90].

<sup>12</sup> Opponent’s Written Submissions at [97(ii)].

33 Further, it is also not in dispute that even before the Application Date, many third parties were already using the word “PAD” as part of the name of their tablet computer<sup>13</sup>. The following “Pad”-formative trade marks were listed in the Applicant’s 1<sup>st</sup> SD at [116]:

| <b>Release Date (Approximate)</b> | <b>Brand</b>      | <b>Tablet Name</b>                | <b>Release Price</b>                     |
|-----------------------------------|-------------------|-----------------------------------|--|
| April 2010                        | Apple             | iPad1                             | US\$499                                  |
| November-December 2010            | ViewSonic         | ViewPad 7                         | US\$479                                  |
| March 2011                        | ViewSonic         | ViewPad 10                        | US\$599                                  |
| March 2011                        | Apple             | iPad2                             | US\$499-US\$829                          |
| April 2011 (for pre-order)        | ASUS              | Eee Pad Transformer               | S\$699                                   |
| August 2011                       | Lenovo            | IdeaPadK1                         | S\$699                                   |
| August 2011                       | ASUS              | Eee Pad Slider                    | S\$799                                   |
| September 2011                    | Lenovo            | ThinkPad Tablet                   | S\$699 (without 3G) to S\$799            |
| January 2012                      | ASUS              | Eee Pad Transformer Prime         | S\$899                                   |
| January 2012                      | RedPad Number One | RedPad Number One                 | ¥9,999 – S\$2096                         |
| March 2012                        | Apple             | The new iPad (iPad 3)             | S\$658 – S\$1088                         |
| May 2012                          | Huawei            | MediaPad                          | S\$498 without subscription plan         |
| June 2012                         | ASUS              | Padphone                          | S\$800 (without contract)                |
| September 2012                    | Huawei            | MediaPad 10 FHD                   | US\$249 – S\$337                         |
| September 2012                    | Huawei            | MediaPad 7.0 Lite                 | S\$328                                   |
| September 2012                    | Panasonic         | ToughPad A1                       | US\$1499 – S\$2032                       |
| November 2012                     | Apple             | iPad with Retina display (iPad 4) | S\$658 – S\$1088                         |
| November 2012                     | Apple             | iPad mini                         | S\$448 – S\$878                          |
| November 2012                     | ASUS              | PadFone 2                         | From S\$1,099                            |
| December 2012                     | Archos            | GamePad                           | US\$169                                  |
| February 2013                     | ASUS              | MeMO Pad                          | S\$249                                   |
| March 2012                        | Archos            | Child Pad                         | US\$129                                  |
| April 2013                        | ASUS              | Fonepad                           | S\$369                                   |
| June 2013                         | ASUS              | Fonepad Note FHD 6                | €349                                     |
| June 2013                         | ASUS              | MeMo Pad HD 7                     | US\$129 (for 8GB) or US\$149 (for 16 GB) |
| September 2013                    | WikiPad           | WikiPad                           | £249.99                                  |
| September 2013                    | LG                | G Pad 8.3                         | US\$349.99                               |
| October 2013                      | Archos            | GamePad 2                         | €180                                     |
| November 2013                     | Apple             | iPad Air                          | S\$688 – S\$1288                         |
| November 2013                     | ASUS              | MeMo Pad 10                       | US\$275 – S\$373                         |
| November 2013                     | ASUS              | PadFone Infinity                  | S\$898 or S\$998                         |
| November 2013                     | Apple             | iPad mini 2                       | S\$548 – S\$1148                         |

<sup>13</sup> Applicant’s 1<sup>st</sup> SD at [116] – [122] and Opponent’s Written Submissions at [115] and [205].

| Release Date (Approximate) | Brand         | Tablet Name          | Release Price                          |
|----------------------------|---------------|----------------------|--|
| May 2014                   | Huawei        | MediaPad X1          | S\$498 (3G model)<br>S\$598 (4G model) |
| June 2014                  | Huawei        | MediaPad M1 8.0      | S\$469                                 |
| <b>July 2014</b>           | <b>Xiaomi</b> | <b>Mi Pad</b>        | <b>S\$300 – S\$340</b>                 |
| July 2014                  | LG            | G Pad 7.0            | US\$115 – S\$155                       |
| July 2014                  | LG            | G Pad 8.0            | US\$166 – S\$225                       |
| October 2014               | LG            | G Pad 10.1           | US\$199 – S\$270                       |
| October 2014               | Apple         | iPad Air 2           | S\$688 – S\$1148                       |
| October 2014               | Apple         | iPad mini 3          | S\$548 – S\$1008                       |
| October 2014               | ASUS          | Memo Pad 8 (ME581CL) | S\$499                                 |
| October 2014               | ASUS          | Fonepad 8            | S\$299                                 |
| June 2015                  | ASUS          | ZenPad C 7.0         | S\$199                                 |
| September 2015             | Apple         | iPad mini 4          | S\$548 – S\$1008                       |
| September 2015             | LG            | G Pad X 10.1         | US\$350 – S\$475                       |
| October 2015               | LG            | G Pad II 8.0         | US\$190 – S\$257                       |
| November 2015              | Apple         | iPad Pro             | S\$1188 – S\$1648                      |
| November 2015              | Xiaomi        | Mi Pad 2             | S\$221 – S\$282                        |

34 As a result, by reason of its descriptive connotation and its common usage, I find that the element “Pad” is less likely to be regarded as the dominant or distinctive element of the marks in question. In *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”), the Court of Appeal said at [41]:

... the public will not generally consider a descriptive element ... as the distinctive and dominant element of the overall impression conveyed by that mark (*Honda Motor Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-363/06) [2009] ETMR 34 at [39])...

35 A further issue which ought to be mentioned before I assess the marks for similarity relates to the distinctiveness of the earlier trade marks. The Opponent relies on the fact that the “IPAD” Mark has acquired distinctiveness in Singapore by virtue of its use. This is not disputed by the Applicant and I have no hesitation concluding that as a consequence of the use made of it since 2010, it was, by the date of the application for registration in 2014, possessed of a reasonably high degree of acquired distinctive character due to its reputation and success in Singapore.

36 I am aware that the Court of Appeal in *Staywell* (at [25]) said that a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it. However, this statement should not be taken too literally and without regard to the context. It is always important to bear in mind what it is about the earlier mark which gives it its distinctive character. If for example, the distinctiveness is provided by an aspect of the mark which has no counterpart in the Application Mark, then there is no reason why the distinctiveness should be of any assistance to the Opponent. In fact, it may possibly have an opposite effect for the Opponent as the differences would be made more apparent.

37 There is another reason why distinctiveness is only part of the inquiry and it is nevertheless important to look at where the distinctiveness of the earlier mark lies. This applies where the coinciding element of the marks under comparison is a descriptive word as care should be exercised so that a monopoly in its use is not granted. See Professor Ng-Loy Wee Loon in *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2<sup>nd</sup> Edition, 2014) (“*Ng-Loy Wee Loon*”) at [21.5.18]:

“If there is a common component in the two marks, and this component is inherently non-distinctive (because, for example, it describes the quality of the goods or services in question) there would be some reluctance to find similarity between the marks. This is because the tribunal would be wary of granting a monopoly over components which other traders may legitimately wish to use as part of their own trade marks.”

38 It is clear that there is a common component between the marks in the present case. The parties however disagree on what this common component is. The Opponent contends that it is the entire mark “IPAD” whereas the Applicant submits that it is only the element “Pad”, which is descriptive and cannot be monopolised by the Opponent. I will deal with this in more detail at [50(v)] but for present purposes, I note that a well-established approach for the assessment of marks-similarity, in cases where there is a common component, is to consider whether the differences between the marks are sufficient such that the latter mark does not capture the distinctiveness of the earlier mark. In *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] SGHC 175, the High Court said at [26]–[27]:

... In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially ...

In the present case, the differences are obvious: the addition of the word “PACIFIC” together with the sign’s different font and design. The question, then, is whether these differences are enough so as not to capture the distinctiveness of the registered mark...

39 It is therefore necessary to examine what constitutes the distinctiveness of the “IPAD” Mark. In approaching this issue, I remind myself of the Opponent’s 1<sup>st</sup> SD at [11] – [14] where it said:

#### The Opponent's I-Family of Marks

11. In 1998, the Opponent began using the I-prefix mark worldwide with the introduction of the extremely successful iMac personal computer, followed by the iBook laptop computer (1999), the iPod line of portable digital music and video players (2001), iTunes (2001), the iTunes Music Store (now, simply, the iTunes Store) (2003), and the iPhone mobile telecommunications devices (2007). In 2010, the Opponent further solidified the iconic character of the "I" family of marks when it introduced the iPad mobile media computing device, which is addressed in more detail below. Further examples of the Opponent's I-prefix brands include IMAC, ILIFE, IWORK, ISIGHT, ICAL, ICHAT, IMOVIE, IPHOTO, IDVD, IAD, IBOOKS, and IBOOKSTORE to name but a few.

12. The launch dates for a number of I-prefix marks are as follows:

| I-Prefix Marks           | Worldwide Launch Date |
|--------------------------|-----------------------|
| I MAC (first generation) | August 1998           |
| IBOOK                    | 21 July 1999          |
| IMOVIE                   | October 1999          |
| IREVIEW                  | 5 January 2000        |
| ICARDS                   | 5 January 2000        |
| IDISK                    | 5 January 2000        |
| ITOOLS                   | 5 January 2000        |
| IDVD                     | 9 January 2001        |
| ITUNES                   | 9 January 2001        |
| IPOD                     | 23 October 2001       |
| IMAC (second generation) | 7 January 2002        |
| IPHOTO                   | 7 January 2002        |
| ICAL                     | 17 July 2002          |
| ISYNC                    | 17 July 2002          |
| ILIFE                    | 7 January 2003        |
| ICHAT                    | 23 June 2003          |
| ISIGHT                   | 23 June 2003          |
| IPHONE                   | 29 January 2007       |
| IPAD                     | 27 January 2010       |
| IBOOKS                   | 27 January 2010       |
| IBOOKSTORE               | 27 January 2010       |
| IAD                      | 8 April 2010          |
| ICLOUD                   | 6 June 2010           |
| IMESSAGE                 | 2 October 2011        |

13. Press releases announcing the launches of products and services bearing the I-prefix marks above were featured on the Opponent's website at [www.apple.com](http://www.apple.com). Attached at "Exhibit TLP-3" are samples of the press releases for various I-prefix product launches on the Opponent's website.

14. Overall, the Apple products and services within the family of "I" marks became a veritable phenomenon and the object of recognition and desire among consumers throughout the world. The use of the I-prefix family of marks is a famous naming convention of the Opponent. The addition of the element "I" brings with it a significant amount of consumer recognition and goodwill associated with the Opponent - it is not merely an addition of a single vowel. The Opponent's famous I-prefix family of marks includes the iPad mark.

40 Given the Opponent's evidence that "*the I-prefix family of marks is a famous naming convention of the Opponent*", coupled with the fact that the element "Pad" is descriptive, it must surely follow that the I-prefix plays an important, if not critical, role in the distinctiveness of the "IPAD" Mark ("**distinctive feature 1**").

41 Further, I find that distinctiveness of the "IPAD" Mark also lies in the fact that the elements "I" and "Pad" are conjoined to form a single invented word ("**distinctive feature 2**").

42 Against this backdrop I will proceed to examine if the Application Mark captures the distinctiveness of the “IPAD” Mark.

*Visual Similarity*

43 The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

44 For ease of reference, the marks to be compared are:

| <i>Opponent’s Mark</i> | <i>Application Mark</i> |
|------------------------|-------------------------|
| <b>IPAD</b>            | <b>MI PAD</b>           |

45 The Opponent submits that the marks have strong visual similarity because all the letters of the “IPAD” Mark are found in the Application Mark in exactly the same sequence. In this regard, the Opponent submits the common component between the marks is “iPad” or in other words, the “IPAD” Mark is incorporated in the Application Mark.

46 The Applicant however, submits that the mere fact that all the letters of the “IPAD” Mark are found in the Application Mark should not automatically lead to a finding that the marks are visually similar. It contends that the common element between the marks is the word “Pad” which is descriptive and non-distinctive. It would therefore be conferred very little weight by consumers who will look to other parts of the marks which are distinctive to distinguish the marks.

47 I agree with the Applicant that the fact the Application Mark contains all the letters of the “IPAD” Mark in the same sequence is not conclusive. At the end of the day, the exercise here is to determine the overall impression given by the mark on the consumer who does not spend too much time analyzing the marks. In *Polo (CA)*, the Court of Appeal said at [23] that it “does [not] follow that the incorporation of an entire registered word mark would automatically lead to infringement” and quoted the Appointed Person (Geoffrey Hobbs QC) in the case of *10 Royal Berkshire Polo Club Trade Mark* [2001] RPC 32 (“*Royal Berkshire*”) at [16]:

... Hobbs QC also went on to find that even though the word “polo” was incorporated into the applicant’s mark, the two were nevertheless not similar (see [30]–[31]):

[T]he real task is to determine what impression the use of that mark would make upon people in the ordinary course of trade in goods of the kind specified in the application for registration: see *Marengo v Daily Sketch and Sunday Graphic Ltd* (1948) 65 R.P.C. 242, HL, at page 250 *per* Lord Simonds. Approaching the matter in that way, I am satisfied that the use of the word POLO as part of the

applicant's mark does not capture the distinctiveness of the opponent's earlier trade marks. I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.

48 In *Hai Tong*, the Court of Appeal said at [62(b)] that visual similarity is to be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components.

49 I have held at [40] and [41] above that the distinctiveness of the "IPAD" Mark lies partly in the I-prefix (distinctive feature 1) and partly in the fact that as a whole, it is an invented word (distinctive feature 2). In the circumstances, I find that this is also where the overall impression of the "IPAD" Mark lies.

50 Bearing in mind the above considerations, my analysis of the visual similarity of the marks is as follows:

- (i) The marks are similar in that they incorporate all the letters of the "IPAD" Mark in the same sequence. However, letters per se, even though presented in the same sequence do not necessarily equate to visual similarity as other elements such as structure play an equally important role in the visual impression of word marks. In this case, the Application Mark consisting of two words, breaks up the letters of the "IPAD" Mark and reduces its visual similarity. As a result, the Application Mark does not capture the distinctiveness of the "IPAD" Mark, which is the single invented word.
- (ii) While the Opponent's say that the Application Mark differs from the "IPAD" Mark only by an "M" consonant and a space, ultimately the ordinary average consumer does not break down word marks in such a manner. It is the effect of these differences on the consumer's overall impression that is more important.
- (iii) In assessing marks for similarity it must be borne in mind that the average consumer perceives marks as wholes and does not ordinarily analyse or dissect their various details. The average consumer will not take a portion of a word in a mark (in this case the "I" in the word "MI"), join it to another word in the mark (in this case "PAD") and conclude that it resembles another mark.
- (iv) The visual impact of the similarity of the letters of the "IPAD" Mark is significantly diminished by the fact that: (a) "I" is separated from "PAD" and (b) the alphabet "I" is conjoined with "M" to form another distinct word "MI". In this regard, the Application Mark captures neither distinctive feature I (the I-prefix) nor distinctive feature 2 (the single invented word) of the "IPAD" Mark.
- (v) I am unable to agree with the Opponent that the common component between the marks under comparison is the word "IPAD". The components in the Application Mark are "MI" and "PAD". "IPAD" is not a component in the Application Mark for three reasons: (a) there is no "I" component in the Application Mark, merely the alphabet "I"; (b) the alphabet "I" is preceded by the alphabet "M" to form



another visually distinctive word; (c) there is an obvious space between the alphabet “I” and the word “PAD”. The common component between the marks is thus the word “PAD” which is descriptive and unlikely to dominate the consumer’s overall perception of the marks.

- (vi) The dominant and distinctive component of the Application Mark is recognisably “MI”, not “I”. In this regard, it does not capture distinctive feature 1 (the I-prefix) of the “IPAD” Mark.
- (vii) The prefix of the Application Mark is recognisably “MI”, not “I”. Given the fact that the visual difference appears at the beginning of the marks and coupled with the fact that the marks are short, I am of the view that this difference is not negligible or likely to be overlooked or overshadowed. I am aware that it is not an immutable rule that the beginnings of words will tend to have the greatest impact on the consumer’s perception. However, I consider the rule is applicable here, bearing in mind that the only other element of the marks under comparison is descriptive and will not dominate the consumer’s overall perception.
- (viii) In the imperfect recollection of the marks, it would be highly unlikely for the average consumer to notice the coincidence of the letters I-P-A-D without noticing the existence of the word “MI” in the Application Mark.

51 In light of all the above, I am of the view that the Application Mark and the “IPAD” Mark are visually more dissimilar than similar.

#### *Aural Similarity*

52 With regard to aural similarity, it is clear from *Staywell* (at [31] and [32]) that there are two possible approaches. One approach is to consider the dominant and distinctive components of the marks. The other approach which does not involve considering the dominant components is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. In *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [30]-[31], the Court of Appeal also endorsed the consideration of “*how an average Singaporean consumer would pronounce the respective words*” and the making of “*allowances for imperfect recollection and careless pronunciation and speech*”.

53 Parties in this case were divided over whether the word “MI” in the Application Mark would be pronounced by the average Singaporean consumer as “Mee” or “My”. The Applicant submits that it would be pronounced as “Mee” given that “MI” is a known English word in the dictionary meaning “the third degree of any major scale” (as in DO-RE-MI) and is pronounced as “Mee”. The Opponent on the other hand, contends that “Mi” would be pronounced as “My” as common words such as “mice”, “microphone”, “mime”, “mind”, “mine”, and “minor” all begin with “mi” and are pronounced as “my” and other electronic products such as Mi-Si products are pronounced as “My-Sigh”.

54 While there are common English words which begin with “mi” and are pronounced as “my”, equally, there are also many common English words beginning with “mi” that are pronounced as “mee”, such as “mid”, “mix”, “mini”, “miss” and “mirror”. I do not think such an approach is helpful for the case at hand. “MI” in the Application Mark is a word on its

own. As a word by itself and being a word found in the English dictionary, I find that the average consumer in Singapore would pronounce “MI” as “Mee”, the same way that one would pronounce the word “MI” in “Do-Re-Mi”.

55 As such, the aural comparison of the “IPAD” Mark and the Application Mark comes down to a comparison of the pronunciations “*eye pad*” and “*mee pad*”. “Mee” and “eye” are aurally dissimilar. The marks therefore differ in their first syllables but are identical in their second syllables.

56 While both marks are identical in their second syllables, the word “PAD” is descriptive and non-distinctive. It is an established principle that, where a word is found to be descriptive of the goods and services claimed, that portion would have less significance in terms of aural similarity. This principle was applied by the High Court in the case of *Formula One Licensing BV v Idea Marketing SA* [2015] 5 SLR 1349 (“*Formula One*”). In that case, the High Court considered that as “F1” is descriptive, its significance is lessened (at [119]), despite being the first portion of the trade mark, and found “F1” aurally dissimilar to “F1H20” (at [109])<sup>14</sup>.

57 Accordingly, since “Pad” is descriptive and non-distinctive (and further, it does not form the first portion of the mark which was the case in *Formula One*), its aural significance is lessened in the comparison of aural similarity between the marks. Greater significance should be given to the aural comparison between the first syllables of the marks and I have found that they are aurally dissimilar.

58 In light of all of the above, I am of the view that the Application Mark is aurally more dissimilar to the “IPAD” Mark than similar.

#### *Conceptual Similarity*

59 With regard to conceptual similarity, the inquiry is to “*uncover the ideas that lie behind and inform the understanding of the mark as a whole*” (*Staywell* at [35]).

60 The Opponent contends that the marks are conceptually similar for the following reasons:

- (i) The marks share the same component “IPAD” and consumers will associate “IPAD” with the Opponent and tablet devices. This association arises because the Opponent has acquired distinctiveness in the mark;
- (ii) Alternatively, the marks share the same dominant component of “PAD” which will cause consumers to associate both competing marks with tablet devices; and
- (iii) Consumers will associate the “MI” (whether pronounced as “My” or “Mee”) component in the Application Mark and the “I” component in the “IPAD” Mark with the notion of personal possession.

61 With regard to the Opponent’s first point, I do not agree that “IPAD” is an idea behind the mark. “IPAD” is the Opponent’s mark itself. It conveys no idea as a whole as it is an

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<sup>14</sup> The decision of the High Court was affirmed on appeal by the Court of Appeal, although no written grounds of decision was issued.

invented word. As for consumers associating “IPAD” with the Opponent and tablet devices, this is not to be taken into account at this stage as the comparison is “mark for mark” without taking into account any external added matter or circumstances (*Hai Tong* at [40(b)]). Furthermore, in *Sarika* at [34], the Court of Appeal found that the Judge had erred when he decided (at [69]) that because “Nutello” was derived from “Nutella” with only a change to the last letter (as the Appellant’s witness admitted), it suggested that there was conceptual similarity. In the Court of Appeal’s view, while those circumstances justified a finding that there is similarity in the visual and aural sense, they do not necessarily suggest a conceptual similarity. They are just meaningless words and do not evoke any ideas.

62 In respect of the Opponent’s second point that the marks share the common use of the descriptive word ‘Pad’ causing consumers to associate both competing marks with tablet devices, this can hardly be said to be a distinctive conceptual similarity where the goods are tablet devices themselves. I do not see how the concept of tablet devices will dominate the consumers’ overall impression of the marks when it refers to the goods themselves. The significance of this common element is thus lessened.

63 The Opponent’s third point is that “MI” will be perceived as “My” or “Me” and therefore share the notion of personal possession with the “I” component of the “IPAD” Mark. I accept that it is not necessary for a word to be written properly for its semantic content to be perceived by the relevant public. However, I have not been provided sufficient evidence to persuade me that the average Singaporean will perceive “MI” in this way given the obvious difference in spelling. On the other hand, the Applicant’s argument that “Mi” connotes the idea of music appears to have more basis. The fact is that “MI” is an English word; one which is associated with music and the song “Do-Re-Mi”. In this regard, it is conceptually different from the idea of personal possession which the “IPAD” Mark evokes. Alternatively there may also be consumers who do not appreciate that “MI” is associated with music. In this case, they are likely to consider “MI” as an invented word with no meaning and if this is the case, the marks are still conceptually different.

64 Accordingly in my view “IPAD” and “MI PAD” are not conceptually similar.

#### *Conclusion on Similarity of Marks*

65 I now consider whether the respective marks, "*when observed in their totality, are similar rather than dissimilar*", noting the Court of Appeal's rejection of the suggestion that "*any modicum of similarity would compel the court to make a finding of marks-similarity*" at [19] of *Staywell*.

66 Earlier on, I have found that the respective marks are (a) visually more dissimilar than similar; (b) aurally more dissimilar than similar and (c) conceptually not similar. While bearing in mind that "*trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry*" ([18] of *Staywell*), I find that the Application Mark and the “IPAD” Mark are dissimilar rather than similar in their totality.

67 The similarity of the competing marks is a "*threshold requirement that had to be satisfied before the confusion inquiry is undertaken*" (*Staywell* at [15]). Given that the threshold requirement has not been met, this is enough to dispose of the matter in favour of the Applicant.

68 Nevertheless, I will go on to consider the likelihood of confusion under Section 8(2)(b) in the event I am wrong in finding no marks-similarity.

69 Before I proceed, I would mention that the Opponent pointed me to a number of foreign decisions which found that the competing marks were visually and aurally similar, such as the European Union Intellectual Property Office (EUIPO) (formerly known as Office for Harmonization in the Internal Market (OHIM)), the Mexican Institute of Industrial Property (IMPI) and the Norwegian Industrial Property Office (NIPO). I did not find it useful to refer to these foreign decisions. These decisions are not binding on this tribunal and it appears that the approach taken in assessing marks-similarity in these jurisdictions could be different from Singapore. In particular, I note:

- (i) In the OHIM decision, comparison of the signs was made by reference to the Portuguese-speaking part of the public in the European Union;
- (ii) In the IMPI decision, there was no discussion on the issue of descriptiveness of the element “Pad” at all;
- (iii) In respect of the NIPO decision, in considering the visual and aural similarity of the marks, there was no discussion on the issue of descriptiveness of the element “Pad”.

#### *Likelihood of Confusion*

70 In the event I am wrong on the lack of marks-similarity, I continue with a consideration of the likelihood of confusion at the third stage of the enquiry. The following assessment is based on the premise that the Application Mark is *marginally* more similar to the “IPAD” Mark than not.

71 There are at least two types of confusion under Section 8(2)(b). The first is where the consumer mistakes one mark for another. The second is where consumers may perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies, and may perceive that goods or services of both marks emanate from the same source or from sources that are economically linked or associated (see *Hai Tong* at [74]). The Court of Appeal, nonetheless, recognised at [75] that confusion in the sense of “*mere association*” is not enough. This means that “*it is not sufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing*”. Similar views were also expressed by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) at [58].

72 Further, in *Sarika*, the Court of Appeal said that the test to be adopted in determining likelihood of confusion is whether a substantial portion of the relevant public will be confused. In this regard, the Court of Appeal also said in *Sarika* (at [57]) that:

... the essence of this requirement is that there must not be an insubstantial number of the relevant public being confused. This standard is above *de minimis* and must be appreciable, though it is not necessary to show that a majority of the public is confused. It is insufficient, however, if only a “single member” of the relevant public is confused or if only a “very small and unobservant section” is confused ...

73 The question whether there is likely to be confusion is ultimately one for the court (or in this case, this tribunal), rather than for witnesses. While evidence of actual confusion can be very helpful, its absence should not be accorded undue significance (*Hai Tong* at [100]).

74 The Opponent submits that actual confusion has taken place as shown by the following excerpts found on technology review websites commenting on the Applicant's "MI PAD" Mark:

- (i) "...a product name that simply adds one letter and a space to Apples [sic] trademarked name"<sup>15</sup>;
- (ii) "They just added one letter, and it's easily confused with iPad"<sup>16</sup>;
- (iii) "It looks like iPad knockoff...even the name also"<sup>17</sup> and
- (iv) "The name is, regardless of what the company says, an attempt to sound just like Ipad...might as well call it iPad"<sup>18</sup>.

75 I am unable to agree with the Opponent that the above shows actual confusion has taken place. In my view, the authors of the excerpts above were fully aware that the goods under the competing trade marks originate from unrelated undertakings and were not in the least confused. In fact, the comments were made precisely because the authors were aware of the origin of the respective marks and were not confused. At best, the excerpts only show that the authors recognised the similarities between the contesting marks but it is clear that under the law this is not sufficient if there is no likelihood of confusion as to origin ensuing.

76 The absence of evidence of actual confusion is nevertheless not detrimental and I go on to consider whether there is a likelihood of confusion. The Court of Appeal in *Caesarstone* summarised at [56] the extraneous factors that may be taken into account in the likelihood of confusion assessment:

The likelihood of confusion inquiry directs the court to look at: (a) how similar the marks are; (b) how similar the goods or services are; and (c) given this, how likely it is that the relevant segment of the public will be confused (*Staywell* at [55]). In opposition proceedings, the inquiry takes into account the actual and notional fair uses of both the existing and the application mark (*Staywell* at [60]). The factors which are admissible in the confusion inquiry include:

(a) Factors relating to the impact of marks-similarity on consumer perception: (i) the degree of similarity of the marks themselves; (ii) the reputation of the marks; (iii) the impression given by the marks; and (iv) the possibility of imperfect recollection of the marks (*Staywell* at [96(a)]).

(b) Factors relating to the impact of goods-similarity on consumer perception: (i) the normal way in or the circumstances under which consumers would purchase goods of that type; (ii) whether the products are expensive or inexpensive items;

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<sup>15</sup> Opponent's 2<sup>nd</sup> SD at p. 1330.

<sup>16</sup> Opponent's 2<sup>nd</sup> SD at p. 1346.

<sup>17</sup> Opponent's 2<sup>nd</sup> SD) at p. 1315.

<sup>18</sup> Opponent's 2<sup>nd</sup> SD at p. 1339.

(iii) the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase (Staywell at [96(b)]).

(i) *Factors Relating to the Impact of Marks-Similarity on Consumer Perception*

The degree of similarity of the marks

77 I have held at [66] that the marks are not similar on the whole. However, if I were wrong on this and were to accept that there is marks-similarity, I would be inclined to say that the Application Mark is only marginally more similar to the “IPAD” Mark than not. Hence, this factor in the consideration of likelihood of confusion lies in the Applicant's favour – “Clearly, the greater the similarity between the marks, the greater the likelihood of confusion” ([96] of *Staywell*) and conversely, the lesser the similarity between the marks, the lower the likelihood of confusion.

The reputation of the marks

78 The Opponent submits that the reputation of the “IPAD” Mark is well known and cites this as a factor that points towards a likelihood of confusion. However, the Court of Appeal in *Staywell* (at [96(a)]) cited with approval *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 at [74], where it was made clear that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect as in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 (“*McDonald's*”) (at [64]). The exact effect the reputation of a mark has on the likelihood of confusion depends on the specific facts of a case. In the current case, I am of the view that the reputation of the “IPAD” Mark is likely to have an effect contrary to a likelihood of confusion. This is because the reputation of the “IPAD” Mark is inextricably linked to the well known fact that the Opponent uses an I-prefix family of marks and the fact that the Application Mark does not have an I-prefix reduces the likelihood of confusion.

The impression given by the marks and the possibility of imperfect recollection of the marks

79 The impression given by the “IPAD” Mark would be that it is a member within the Opponent’s well known I-prefix family of marks. The Application Mark, on the other hand, does not have an I-prefix and the general impression conveyed by it is that it has a “MI”-prefix, which falls outside the Opponent’s well known naming convention and its I-family of marks. It is unlikely that average consumers who are sufficiently familiar with the Opponent’s marks so as to recognise them as a family of I-prefix marks, will imperfectly recall the “IPAD” Mark and fail to recognise the difference between “MI PAD” and “IPAD”.

(ii) *Factors Relating to the Impact of Goods-Similarity on Consumer Perception*

80 The goods and services under consideration here are tablet computers and related goods and services. However for clarity, I will focus my analysis below on tablet computers, being the goods most key to the parties.

The normal way in or the circumstances under which consumers would purchase goods of that type

81 The Applicant submits that the normal way tablet devices would be purchased would be either online or through brick-and-mortar stores such as specialised computing shops or telecommunications services providers. In this regard, the visual similarities or differences between the marks assume greater importance as compared to the aural similarities or differences.

82 When such goods are purchased online, consumers would only perceive the trade marks visually. Under such circumstances, the textual content is also important as one would have to enter the text of the mark into the address bar or search engine in order to get the desired website (*Hai Tong* at [53]). As such, the element “MI” would have a significant impact on the consumer and this reduces the likelihood of confusion. When such goods are purchased in a brick-and-mortar shop, a consumer would usually go through the process of perusal, deliberation and sometimes engagement with a sales staff before coming to a purchase decision. It would also not be uncommon for a purchaser to check out the display of the screen as well as other features and functions of the device and if so, the consumer would perceive the marks visually.

83 The Opponent argues that given consumers will pay more attention to the visual representation of the marks, they would surely notice the obvious and striking similarities between the marks and therefore be confused as to the commercial origin of the “MI PAD” mark. I am unable to agree with the Opponent. Firstly, as mentioned at [71], it is not sufficient for the relevant segment of the public to recognise or recollect similarities between the contesting marks (if they do at all) if there is no likelihood of confusion as to origin ensuing. Secondly, the Opponent has not explained why the similarity would give rise to confusion or which type of confusion would this be.

Whether the products are expensive or inexpensive items

84 The Applicant’s evidence (see [33] above) shows that the price of tablet devices range from around S\$180, for a low-end tablet computer, to more than S\$1,000. The goods are relatively expensive products and not something that an average consumer would simply purchase in a hurry without putting in some care and attention into the purchase process. This factor is also in the Applicant’s favour.

The nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers

85 On this aspect, tablet computers are inherently relatively complex articles which contain many technical features and specifications. Consequently, consumers will generally pay greater care and attention in purchasing such goods to ensure that the item they buy will have the technical features they need.

86 In fact, consumers are also likely to carry out their “research” and “homework” before purchasing a tablet computer and this is supported by parties’ evidence which shows a proliferation of numerous articles, reviews and comparisons related to the technical specifications and other details of tablet computers. This clearly points to the fact that there is

an interest and demand from consumers for such information.

87 The high degree of care and attention paid by prospective purchasers to the purchase of such goods mean that they are less likely to be confused as to the source and origin of the goods and this factor lies in the Applicant's favour.

The likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase

88 The average consumer in Singapore has been described as literate, educated, exposed to the world and unlikely to be easily hoodwinked. In *McDonald's*, the Court of Appeal said at [64]:

With widespread education and a public which is constantly exposed to the world, either through travel or the media, one should be slow to think that the average individual is easily deceived or hoodwinked.

89 Such a consumer, when selecting goods like tablet computers would be reasonably brand aware and reasonably careful in making the purchase.

Whether the transactions are routine or infrequent

90 Another factor that can be taken into account is whether the purchasing transactions are routine or infrequent (*Staywell* at [94]). Where the transactions are infrequent, consumers typically pay more attention and care to the purchase.

91 Tablet computers are likely to be purchased infrequently rather than routinely, unlike the purchase of everyday consumable items. Firstly, the product in question is not cheap and secondly, purchasing a new tablet computer means the inconvenience of migration of data and both these characteristics point to an infrequent purchase pattern.

*Conclusion on Likelihood of Confusion*

92 Having considered the case as a whole, on the evidence submitted and taking into account the permissible extraneous factors, I do not consider that this element has been made out, whether it be confusion as to origin or confusion as to being economically linked.

93 The ground of opposition under Section 8(2)(b) therefore fails.

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

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

**8.—(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)*

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

The basic principle undergirding the law of passing off is that a trader should not sell his or her goods on the pretext that they are the goods of another trader. There are two oft-quoted formulations of the tort of passing off. The first is found in Lord Diplock’s speech in *Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Ltd and another* [1979] 1 AC 731 (“*Advocaat*”) at 742 where Lord Diplock stated five characteristics of a cause of action in passing off, namely:

(1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so.

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

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

Both Lord Diplock’s five characteristics in *Advocaat* and Lord Oliver’s reformulation in *JIF Lemon* have found expression in the judgments of our courts (see, for example, *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Novelty*”) at [36]). It has been suggested in a number of cases that there is no difference between these

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

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

### *Goodwill*

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

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

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

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

98 The High Court in *Allergan, Inc and another v Ferlandz Nutra Pte Ltd* [2016] SGHC 131 (“*Allergan*”), referring to *Singsung*, summarized at [170] – [171] as follows:

Goodwill is the legal property protected by the law of passing off. Goodwill in the context of passing off is not goodwill in the mark, logo or get-up as such. Instead, goodwill is the trading relationship with his customers. Viewed from this perspective, passing off is concerned with goodwill in the business as a whole and not its constituent elements such as the mark, logo or get-up that it uses.

The Court of Appeal in *Singsung* held (at [37]) that for conceptual clarity, the issue as to whether a mark or get up is distinctive of the plaintiff's product or services is best dealt with in the context of whether the defendant had made a misrepresentation. Further, at [55], the Court of Appeal emphasised that the goal of the tort is to prevent unfair competition brought about by deception or misrepresentation by the defendant as to, amongst other things, the origin of goods...

99 The fact that the Opponent has goodwill in Singapore is not in dispute.

#### *Misrepresentation*

100 Under this element, the Opponent must show that the use of the Applicant Mark, in a normal and fair manner in respect of the goods and services for which registration is sought, amounts to a misrepresentation. The misrepresentation (whether intentional or not) must be such that would lead or be likely to lead the public into believing that the goods or services (in respect of which registration is sought) are the goods or services of the Opponent or from a commercially related trade source.

101 The Court of Appeal in *The Singapore Professional Golfers' Association v Chen Eng Waye and others* [2013] SGCA 18 provided a helpful summary of misrepresentation at [20] as follows:

... It will then be necessary to consider, amongst other factors, whether there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant's goods or services are, or emanate from a source that is linked to, the claimant's...

102 I have earlier found, in the context of the claim under Section 8(2)(b) of the Act, that the marks are dissimilar rather than similar in their totality and also that there is no reasonable likelihood of confusion arising in the circumstances. It thus follows that there cannot be any misrepresentation to the public as to trade origin. In particular, I find that use of the Application Mark is unlikely to deceive a substantial number of the Opponent's customers or potential customers into believing that the Applicant's goods and services are those of the Opponent, or that the Opponent is otherwise responsible for the quality of the goods and services offered under the Application Mark.

103 I am mindful of the words of the Court of Appeal in *Hai Tong* at [115] that:

... the relevant tests for the tort of passing off and a claim for trade mark infringement are not identical, ... in an action for passing off, the court is not constrained in the same way that it would be in a trade mark infringement action in identifying the factors it

may take into account...

104 However, despite being able to consider all circumstances and not only factors relating to the impact of marks-similarity and goods-similarity on consumer perception, I am still unable to conclude that there would be misrepresentation in the present case.

105 For completeness, I would like to make a few comments on some points brought up in the present case.

106 Firstly, this concerns the relevant date for the assessment of evidence for the purposes of Section 8(7)(a). An earlier right based on the law of passing off has to be ascertained as of the date of the application for registration of the competing mark, or, if there is a priority date, that date (Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore Volume 1 (Sweet & Maxwell, 3rd Ed, 2014)* (“*Tan Tee Jim*”) at para 8-159). The Opponent submits that while this proposition applies to goodwill-based evidence, the Opponent’s evidence showing misrepresentation and confusion which is not goodwill-based should be assessed as of the date of hearing<sup>19</sup>.

107 The Opponent explains that perverse outcomes could likely arise if an opponent was restricted to adducing evidence only as of the Application Date. It cites the following example:

A mischievous applicant could exploit the lacuna in the law by first applying to register his borderline-similar mark before entering the market. Subsequently, he could even flagrantly copy an identical get-up of the goods of another established trade mark proprietor for his own goods. Thereafter, he could release these goods bearing his mark into the market to deceive consumers into thinking that his goods originated from, or were connected to that of, the established trade mark proprietor. Despite such reprehensible conduct, the application mark may not be defeated under section 8(7)(a) of the TMA because it may be challenging for an opponent to show that there was misrepresentation by the applicant as of the application date without being allowed to rely on the flagrantly identical get-up.

108 I am not persuaded by the Opponent’s submissions. If it is the identical get-up (and not the trade mark applied for) which causes the deception in the marketplace, the proper recourse for the Opponent would be under the common law for the tort of passing off (and not under the Act to prevent the registration of the trade mark). In this regard, I note that the Opponent’s right to commence an action for passing off is expressly preserved: see Section 4(2) of the Act. However, in any case, I will proceed to look at the post-application evidence to see if anything turns upon it.

109 The Opponent’s post-application evidence relates to the way the Applicant’s product looks. It submits that the Applicant’s tablet device is highly similar to the Opponent’s in terms of size, product design and user interface (as illustrated in the comparison table below) and that this points towards a likelihood of deception.

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<sup>19</sup> On the issue of the relevant date for determining the likelihood of confusion or deception under Section 8(2)(b) see the discussion by the High Court in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] SGHC 45 at [85] – [105] as well as the discussion by the Court of Appeal in *Caesarstone* at [59].

| The Opponent   | The Applicant   |
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110 I am unable to agree that matters extraneous to the Application Mark are relevant. In opposition proceedings, essentially proceedings concerning the registration of a trade mark, misrepresentation leading to deception and confusion must stem from the use of the trade mark – in this case, the Applicant’s use of “MI PAD”. This is explicit in the wording of Section 8(7)(a) itself, which states that a mark shall not be registered if “*its use in Singapore is liable to be prevented by virtue of any rule of law (in particular, the law of passing off)*”. The misrepresentation leading to deception and confusion must thus stem from the use of the Application Mark and not matters which are extraneous to the mark itself, such as the way the goods look or the way the goods are marketed. The correct comparison is “mark v earlier sign”. The Application Mark does not include anything other than the words “MI PAD”. Although extraneous factors may be relevant in an actual passing off action, in opposition proceedings brought under Section 8(7)(a), the effect of the use of the word “MI PAD” in combination with extraneous matter is irrelevant to the enquiry.

111 Further, it is clear that the enquiry under Section 8(7)(a) requires me to take into account all the normal and fair uses of the Application Mark and any misrepresentation, deception and confusion must stem from or originate from the normal and fair use of the Application Mark. This was explained by the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 (“*Rovio*”) at [160] as follows:

It is fairly well established that in evaluating opposition to trade mark registration under s 8(7)(a) of the TMA, the court considers whether the normal and fair use of the applicant mark in respect of the goods or services for which the mark is sought to be registered would result in passing off: Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* vol 1 (Sweet & Maxwell, 3rd Ed, 2014) (“*Tan Tee Jim*”) at para 8.159

and James Mellor *et al*, *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) ("*Kerly's on Trade Marks*") at para 9-147. Thus, s 8(7)(a) effectively requires the court to consider the position of the opponent in a notional passing off action.

112 Finally, even if I do take into account the fact that the Application Mark is used on tablet computers that are of the same size and having a similar product design and user interface as that of the Opponent, I find that use of the Application Mark in relation to tablet computers would not deceive a substantial number of persons. The evidence submitted by the Opponent with a view to showing that consumers are alive to the striking similarity in get-up and marketing between the Applicant's "MI PAD" products and the Opponent's "IPAD" products clearly show that the consumers are not confused as to the origin or source of the respective products.

113 As misrepresentation has not been established, and misrepresentation is an essential component of the tort of passing off, it follows that the Opponent's claim that the Applicant is passing off fails.

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

114 The ground of opposition under Section 8(7)(a) therefore fails.

**Ground of Opposition under Section 8(4)(a) read with 8(4)(b)(i)**

115 Section 8(4)(a) read with 8(4)(b)(i) of the Act reads:

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

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

***Decision on Section 8(4)(a) read with 8(4)(b)(i)***

116 Under this ground, the Opponent has the burden of establishing the following:

- (i) The whole or essential part of the Application Mark is identical with or similar to the Opponent's mark;
- (ii) The Opponent's mark is well known in Singapore;
- (iii) Use of the Application Mark in relation to the goods claimed would indicate a connection with the Opponent; and
- (iv) Use of the Application Mark is likely to damage the Opponent's interests.

### *Similarity of Marks*

117 The High Court in **Rovio** (at [146]) held that there was no difference between the similarity of marks comparison in Section 8(2)(b) and Section 8(4) of the Act. I have dealt with the issue of marks-similarity earlier under Section 8(2)(b) and found that the marks are dissimilar rather than similar in their totality ([66] above). The inquiry effectively ends here, but in case I am wrong on the lack of marks-similarity, I will proceed to analyse the other elements under this ground of opposition.

### *Whether the Opponent's Mark is Well Known in Singapore?*

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

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

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

119 It is clear that the factors listed in Section 2(7) above are not an exhaustive list as Section 2(7) makes it explicit that it shall be relevant to “take into account any matter from which it may be inferred that the trade mark is well known”. The Court of Appeal in **Amanresorts** at [137] said that the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires (subject to one particular factor which will be elaborated on later), and to take additional factors into consideration. Thus, it is clear that the factors in Section 2(7) (with the exception of the factor in Section 2(7)(a) which has a deeming effect in Section 2(8)) are merely a set of guidelines to assist the Registrar in determining whether the mark is a well known trade mark. Section 2(7)(a), however, has a special effect. This is because of Section 2(8) which states that, “Where it is determined that a

trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.” As stated in *Amanresorts* ([140]), once it is determined that the trade mark in question is well known to “any relevant sector of the public”, it is deemed to be well known in Singapore. The High Court in *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 ("*Ferrero*") at [158] quoting the Court of Appeal in *Amanresorts* at [139], also held that in determining whether a trade mark is well known in Singapore, the most crucial factor is that set out in Section 2(7)(a) of the Act, viz, "*the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore*". Thus, it is very clear that, if the Opponent's "IPAD" Mark is well known to the relevant sector of the public in Singapore, the Opponent's "IPAD" Mark shall then be deemed to be well known in Singapore.

120 I first consider the “*degree to which [the Opponent’s mark] is known to or recognised by any relevant sector of the public in Singapore*”. In Section 2(9), “*relevant sector of the public in Singapore*” in Section 2(7) and 2(8) includes any of the following:

- (i) all actual consumers and potential consumers in Singapore of the goods to which the trade mark is applied;
- (ii) all persons in Singapore involved in the distribution of the goods to which the trade mark is applied;
- (iii) all businesses and companies in Singapore dealing in the goods to which the trade mark is applied.

As for the ambit of “all actual consumers and potential consumers in Singapore of the goods”, *Amanresorts* has settled this issue as “*the actual consumers and potential consumers of, specifically, the [Opponent’s] goods only*” ([142] to [154]), specifically, [154]). Applying the law to the facts of this case, the relevant sector of the public would be the general public as well as retailers and distributors of these goods and services. Given the nature of the products, the general public would include not just individuals who buy tablet devices for their own use but also businesses in unrelated fields who may buy tablet computers for a variety of reasons such as for their employees, for their customers’ use or to promote their products and services. The evidence before me does not provide any indication as to the size and the views of the relevant sector of the public in Singapore, but I note the Opponent enjoys a market-leading 28.1% share of tablets worldwide.

121 In addition to what I have already set out at [14]-[24] above, the Opponent’s evidence that the “IPAD” Mark is well known in Singapore includes the following:

- (i) The Opponent’s products (including the “IPAD”) are readily available in Singapore. The “IPAD” tablet may be purchased through the Opponent’s official website at [www.apple.com/sg](http://www.apple.com/sg), which ranks as the 17<sup>th</sup> most visited website in Singapore;
- (ii) In terms of brick-and-mortar stores, the “IPAD” tablet may be purchased through Apple shops, which are Apple-designed outlets located within selected Apple resellers and other retail shops, Apple Premium Resellers, and other authorised resellers. There are about 100 sales locations of authorised resellers of Apple products in Singapore. Moreover, the “IPAD” may also be purchased at the 3



- (iii) major telecommunication service providers' shops in Singapore (*i.e.*, SingTel, Starhub and M1). Many of these stores and shops are situated in shopping centres located throughout Singapore's heartlands and business districts with high consumer traffic;
- (iv) The "IPAD" tablet is also sold to Singapore consumers through various unauthorised resellers which operate through physical shops or online platforms such as Lazada and Groupon;
- (v) In addition, the "IPAD" tablet is promoted and sold at the numerous electronics and IT fairs held across Singapore throughout the year;
- (vi) According to an online article titled "iPad rules in tablet traffic, Singapore among top 3 places" published in 2011, the "IPAD" is the most dominant tablet device across all geographical regions, contributing to more than 89% of tablet traffic across all markets, with a particularly high usage rate in Singapore;
- (vii) A report published by Pingdom Royal on 16 May 2012 ranks Singapore as the world's most "iPad-friendly" country. The report, formulated using web-browsing data from StatCounter, which is based on visitor statistics from more than 3 million websites, measures the use of the iPad to browse the web in a country. It was reported that iPad users in Singapore garnered just over 7% of desktop web browsing traffic, coming in ahead of Australia at 5.14%, the UK at 4.69% and Hong Kong at 4.07%;
- (viii) AsiaOne's article titled "S'poreans among top iPad buyers" published in 2010. In the article, AsiaOne reported that data collected by the auction website eBay showed that Singapore is "one of the most iPad-crazy countries in the world". It further reported that in per-capita terms, Singapore is the fifth-largest buyer of "IPAD" tablets via eBay;
- (ix) An SG50 commemorative article, entitled, "SG50: Five Technologies That Changed Our Lives", the "IPAD" was touted as *the* device that popularised tablet computing in Singapore.

122 Having considered all the evidence, I accept that to the relevant sector of the public who are actual and potential consumers of tablet computers in Singapore, the Opponent's "IPAD" Mark is well known to them.

#### *Confusing Connection*

123 In relation to this element, it has been settled by the Court of Appeal in *Sarika*, at [76]-[77], that implicit in this requirement is that a likelihood of confusion must be shown in relation to the connection between the parties' products.

124 I have concluded at [92], that there is no reasonable likelihood of confusion arising in this case. For the same reasons that led me to arrive at that conclusion, I am of the view that a confusing connection has not been established by the Opponent.

*Damage to the Opponent's Interests*

125 As the Opponent has failed to establish the following elements under Section 8(4)(a) read with 8(4)(b)(i):

- (i) The whole or essential part of the Application Mark is identical with or similar to the Opponent's mark; and
- (ii) Use of the Application Mark in relation to the goods claimed would indicate a connection with the Opponent,

it follows that it must also fail to establish that the use of the Application Mark is likely to damage its interests.

*Conclusion on Section 8(4)(a) read with Section 8(4)(b)(i)*

126 The ground of opposition under Section 8(4)(a) read with 8(4)(b)(i) therefore fails.

**Ground of Opposition under Section 8(4)(b)(ii)**

127 The relevant provisions of the Act read:

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

(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 —

(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)(b)(ii)*

128 To succeed under this ground, the Opponent has to show that:

- (i) The whole or essential part of the Application Mark is identical with or similar to the Opponent's mark;
- (ii) The Opponent's mark is well known to the public at large in Singapore; and
- (iii) Either

- a. The use of the Application Mark in relation to the goods and services applied for would cause dilution in an unfair manner of the distinctive character of the Opponent's mark; or
- b. The use of the Application Mark in relation to the goods and services applied for would take unfair advantage of the distinctive character of the Opponent's mark.

*Similarity of Marks*

129 I have found at [66] that the Application Mark and the Opponent's mark are dissimilar rather than similar in their totality. Although under Section 8(4)(b)(ii), it is sufficient for an “*essential part*” of the Application Mark to be similar to the Opponent's mark, it was decided in **Rovio** (at [146]) that little turns on the reference to “*essential part*” in Section 8(4); the similarity of marks comparison is the same as under Section 8(2)(b). The inquiry effectively ends here, but in case I am wrong on the lack of marks-similarity, the analysis under this ground of opposition continues below.

*Whether the Opponent's Mark is Well Known to the Public at Large in Singapore?*

130 The critical question is whether the “IPAD” Mark is well known to the public at large in Singapore as at the relevant date of 9 April 2014, which is the date of application of the Application Mark.

131 The meaning of “*well known to the public at large*” is not defined in the Act. Nonetheless, the Court of Appeal in **City Chain** said at [92] and [94] as follows:

In determining whether a trade mark is “well known to the public at large in Singapore” under s 55(3)(b)(i) and s 55(4)(b)(i) of the Act, one must certainly have regard to s 2(7) of the Act which provides that in deciding whether a trade mark is well known in Singapore...

...

...the test “well known to the public at large in Singapore” must mean more than just “well known in Singapore”. To come within the former test, the mark must necessarily enjoy a much higher degree of recognition. It must be recognised by most sectors of the public though we would not go so far as to say all sectors of the public...

132 I have already looked at the factors in Section 2(7) and concluded that the Opponent's "IPAD" Mark is well known in Singapore. The question is, is the “IPAD” Mark recognised by most sectors of the Singapore public?

133 So far only four trade marks have been held to be well known to the public at large in Singapore. These are:

- (i) "CLINIQUE" – in *Clinique Laboratories, LLC v Clinique Suisse Pte Ltd and another* [2010] 4 SLR 510 (“*Clinique*”);
- (ii) "NUTELLA" in *Ferrero*;

- (iii) "SEIKO" in *Choice Fortune Holdings Limited v Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation)* [2014] SGIPOS 8 ("*Seiko*"); and
- (iv) "INTEL" in *Intel Corporation v Intelsteer Pte Ltd* [2015] SGIPOS 2.

134 The Opponent submits that comparing the evidence in the above cases with their own evidence, the "IPAD" Mark should similarly be considered well known to the public at large for the following reasons:

- (i) In *Clinique*, the plaintiff's worldwide advertising, promotional and marketing expenditure for the 5-year period preceding the defendant's infringement was in excess of USD400 million per year (at [39]). In the present case, the Opponent's worldwide advertising expenditure (in the five year period preceding the Application Date of the "MI PAD" Mark) is about USD984 million per year, amounting to more than twofold of the proprietor's expenditure in *Clinique*;
- (ii) In *Clinique* (at [41]), the Court considered the brand's "extensive advertising efforts in various media"; in *Seiko* (at [96(v)] to [97(i)]), the opponent exposed the SEIKO mark in worldwide media and through local public advertising campaigns; in *Intel* (at [135] to [137]), the Principal Assistant Registrar took into account the applicant's extensive advertisements in the local media. In the present case, the Opponent submits that it has likewise carried out large-scale promotional efforts across various media (see [20] above).
- (iii) The products under the "CLINIQUE" mark were offered in 13 stores / counters in Singapore (at [41]); in *Seiko*, the opponent's SEIKO watch products as well as SEIKO optical lenses and frames were offered by more than 70 watch dealers and 100 optical shops in Singapore respectively (at [96(iii)]); in *Ferrero*, it was relevant that the Plaintiff's bread spread could be found throughout Singapore at various trade outlets such as hypermarkets and petrol kiosks (at [155(a)]). In the present case, the Opponent's products are sold at about 100 sales locations throughout Singapore;
- (iv) In *Clinique*, the plaintiff's products could be purchased through its official website. However, online purchasing was not available to Singapore consumers (at [41]); in *Seiko*, there was no evidence adduced on the online sales of the opponent's products. In the present case, Singapore consumers are able to purchase the Opponent's products through its official Singapore website (<https://www.apple.com/sg>) and frequently visit the website;
- (v) The "IPAD" tablet is also sold online by unofficial resellers and further promoted and sold at multiple electronics and IT fairs held in Singapore throughout the year.

135 I do not see how it is helpful to compare the evidence in this manner and I am unable to agree that the evidence is comparable. In relation to the Opponent's worldwide advertising, promotional and marketing expenditure which the Opponent submits is more than twofold of the proprietor's expenditure in *Clinique*, I note that the figures provided by the Opponent relate to its total expenditure across all of the Opponent's products. It therefore includes

expenditure spent on promoting other marks and not just the “IPAD” Mark. At least for this reason, the Opponent’s advertising figures cannot be compared with that in the *Clinique* case. I further note that there is **no evidence of the Opponent’s advertising figures for the “IPAD” Mark in Singapore**. In the cases in which a mark has been held to be well known to the public at large in Singapore, the advertising expenditure in Singapore were as follows:

- (i) In *Clinique*, the advertising, promotional and marketing expenditure for the plaintiff’s products sold under the Clinique Mark in Singapore in the years 2004–2008 (inclusive) was in the region of \$3m each year (at [39]);
- (ii) In *Seiko*, the total advertising expenditure in Singapore from 2005 to 2010 amounted to more than S\$4 million (at [96(v)]);
- (iii) In *Intel*, the expenditure on marketing and advertising in Singapore averaged S\$454 million per year over the years 2005 – 2011 (at [129(ii)]).

136 In addition, **no sales figures relating to the “IPAD” Mark in Singapore** has been submitted before me. The sales figures provided either relate to the sales of all the Opponent’s products in the Asia Pacific or the sales for the “IPAD” Mark globally. In the cases where a mark was held to be well-known to the public at large, evidence of very large sales figures in Singapore relating to the marks in question were provided.

- (i) In *Clinique* at [39], the sales figures in Singapore for products sold under the Clinique Mark were in the region of \$10m each year in the years 2004–2008 (inclusive);
- (ii) In *Ferrero* at [155(a)], about 2 million units of “Nutella” bread spread are sold every year in Singapore (where there are only 1.1 million households);
- (iii) In *Seiko* at [96(ii)], the sales figures for products sold under the SEIKO Mark from 2005 to 2010 were about S\$14 million per annum;
- (iv) In *Intel* at [129(iii)], the annual net revenue was USD 1.277 billion a year for Singapore alone.

137 Further, it appears to me, even if it is proven that there is extensive use and extensive promotion of the “IPAD” Mark in Singapore, this per se does not in my view necessarily mean that the mark will be well known to the public at large. What must be shown is the effect of the use and promotion of the mark in the minds of the public at large. Without evidence that ultimately there is actual recognition of the mark by most sectors of the public, mere use and promotion is of little assistance to an opponent under this ground. In fact, there must be evidence that there is a high degree of recognition of the mark by the public at large such that it can be said that the mark is not just known to them but well known to them.

138 Regrettably, in the present case, **no evidence of the degree of recognition of the “IPAD” Mark in Singapore** has been furnished. In all the cases where the marks have been found to be well known to the public at large, relevant evidence in the form of a survey, was submitted to show the level of recognition of the mark in Singapore<sup>20</sup>.

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<sup>20</sup> For the avoidance of doubt, I am not suggesting that a survey is necessary in all cases.

- (i) In *Clinique*, 46% of the non-Clinique consumers interviewed had used Clinique's products at least once and only 5% of the non-Clinique consumers interviewed were unaware of the Clinique brand;
- (ii) In *Ferrero*, a 71.2% recognition rate among the survey respondents persuaded the High Court that "NUTELLA" was well known to the public at large;
- (iii) In *Seiko*, the mark had a 72% recognition rate among the survey respondents;
- (iv) In *Intel*, the marks were recognised by 85% of the respondents.

139 Moreover, in the present case, the **"IPAD" Mark was only first used in Singapore in April 2010**; as at the Application Date (9 April 2014), it would only have been used for a period of 4 years. However, in the cases where the marks have been found to be well known to the public at large, the marks in question had a much longer history in Singapore.

- (i) In *Clinique*, the mark was first used in Singapore in 1976 (*Clinique* at [39]);
- (ii) In *Seiko*, the mark was first used in Singapore in 1963 (*Seiko* at [96(i)]);
- (iii) In *Intel*, the marks appeared in local newspapers since 1975 (*Intel* at [27]).

140 As for the Opponent's point that the products under the "IPAD" Mark are sold at about 100 sales locations throughout Singapore, I am unable to conclude from this fact per se that the public at large will recognise the mark, much less regard it as well known. The shop front of these shops do not bear the "IPAD" Mark and it could be that the general public may not even be exposed to the "IPAD" Mark if they do not enter the shop to browse.

141 The Opponent further argues that even if one does not personally own an "IPAD" in Singapore, one would still be exposed to the "IPAD" due to the *"widespread usage of the iPad by many shops, restaurants, hair salons, businesses offering the iPad as promotional gifts/lucky draw prizes, and even the Singapore military"*. The following examples were cited in the Opponent's 1<sup>st</sup> SD at [68]:

- (i) According to an online article dated 13 July 2015 (<http://www.honeykidsasia.com/singapore/mums-cat/best-childrens-hair-salons-in-singapore-where-to-go-to-for-kids-haircuts-grooming-and-styling/>) a kid-centric salon in Singapore uses the iPad to register its customers and also offers use of the iPad to the child receiving the hair cut to help abate restlessness with a wide range of games and cartoons available on the iPads.
- (ii) The iPad is used in restaurants across Singapore including JPot. In 2012, an online article (<http://www.soshiok.com/content/Popular-ipot-opens-tampines-1-outlet-ipad-ordering>) reported that the local steamboat restaurant JPot provided diners with a pull out iPad from the dining table allowing diners to choose the items and place orders. A local blogger Miss Tam Chiak (<http://www.misstamchiak.com/jpot-innovation-helps-to-deliver-god-service/>) also made a blog entry and showed pictures of how JPot used iPads to aid in their business operations, such as to seat customers and confirm orders.

- (iii) An article in Today dated 26 August 26 2013 (<http://www.todayonline.com/singapore/picking-tab-may-soon-only-require-few-taps>), reported how restaurant owners such as the Timbre Group of restaurants in Singapore, which already used iPads as ordering systems at its outlets, were interested in automating payments using e-solutions offered by various service providers in the market.
- (iv) Where tablets are used in restaurants in Singapore, they are almost exclusively iPads. A sampling of the e-solutions projects showcased or offered by various Singapore e-solution service providers (e.g., OrderPoint, Aptsys Technology Solutions and Techmetics Solutions Pte. Ltd.) on their websites shows that all service providers offer their solutions as applications for use on the iPad and that they make no mention of any other tablet computers.
- (v) It is common for many businesses in Singapore to offer the iPad as a free gift as part of their business promotions, these include The Straits Times Newspaper and Maybank Singapore amongst others.
- (vi) The iPad is used in the Singapore tourism industry. In 2012, the Straits Times reported that start-up companies in Singapore such as tourism company TouristPads had been integrating the use of the iPad their business operations, such as to offer "tour guides" in the form of an iPad preloaded with apps offering to maximise the holiday experience in Singapore.
- (vii) The widespread usage of the iPad in Singapore even extended to the Singapore Armed Forces. In 2011, AFP reported that the Singapore Armed Forces were issuing about 8000 iPads to recruits in November that year. The rationale behind this issuance was to exploit the use of "popular and current information and communications technology" and to "harness the advantage of today's technologically-savvy servicemen".

142 While I accept that the Opponent's tablet device was used and exposed to the public to some extent, I find the Opponent's evidence too vague to justify a finding that the "IPAD" Mark was well known to the public at large as at the relevant date. Firstly, it is not clear to what extent the exposure referred to reaches out to the public at large. Secondly, no evidence has been put before me to show that as a result of such exposure the "IPAD" Mark is recognised by the public at large and has become well known to them. In particular, I note from the image of the Opponent's product (see [109] above) that the "IPAD" Mark does not appear on the front of the device but only at the back. This means that the "IPAD" Mark would only be visible if the device is flipped over by the user and provided the back of the device is not covered or mounted onto another object.

143 The burden lies on the Opponent to show that its "IPAD" Mark is well known to the public at large in Singapore. Based on what I have found at [135]–[142] above, it is evident that the evidence adduced by the Opponent is, on the whole, weak. I am not willing to regard assertions without any real substantiation as sufficient to support a finding that the mark has attained the "*coveted status*" which form "*a rare and exclusive class*" (*Amanusa* at [233]). Accordingly, while I am satisfied that the "IPAD" Mark is well known to the segment of the public who are actual and potential consumers of tablet computers, I am not convinced that

the “IPAD” Mark is well known to the general public, let alone most sectors of the public, bearing in mind that the assessment is to be made as at the Application Date i.e. on 9 April 2014. **I emphasise that this finding is based purely on the evidence that has been adduced in this case.**

144 My conclusion at [129] and [143] above makes it unnecessary for me to consider the third limb under Section 8(4)(b)(ii) of the Act (which is dilution in an unfair manner and unfair advantage).

145 The ground of opposition under Section 8(4)(b)(ii) therefore fails.

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

146 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 7(6)***

147 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:

- (i) “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]).
- (ii) The test for determining bad faith is the combined test of bad faith which contains both a subjective element (*viz.*, what the particular applicant knows) and an objective element (*viz.*, what ordinary persons adopting proper standards would think). Thus, “bad faith” as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case (***Valentino*** at [29]).
- (iii) Once a *prima facie* case of bad faith is made out by the Opponent, the burden of disproving any element of bad faith on the part of the Applicant would arise (***Valentino*** at [36]).
- (iv) 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 in ***Ng-Loy Wee Loon*** 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*** at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)



- (v) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion (*Valentino* at [20]).

148 The Opponent's case on bad faith revolves around three main contentions: first, the Applicant was aware of the Opponent's rights in the "IPAD" Mark when it made its application to register the "MI PAD" Mark; second, the "*substantial identity*" between the "MI PAD" Mark and the "IPAD" Mark; and third, while there have been other companies that have used "Pad"-formative marks, "*no other company, other than the Applicant, has used an "iPad"-formative mark that shares the same number of syllables as the iPad Mark*"<sup>21</sup>. The Opponent submits that this "*departure from industry norm sheds light on the bad faith exhibited by the Applicant*" and "*it is obvious that the Applicant intends to misappropriate Apple's iPad Mark*"<sup>22</sup>.

149 On the first contention, the Applicant does not deny that it had knowledge of the Opponent's "IPAD" Mark at the time of registration of the Application Mark. However, it is well established that knowledge of the trade mark belonging to an opposing party per se is not sufficient in and of itself to constitute bad faith. In *Ng-Loy Wee Loon* at [21.4.5], the learned author noted that:

One of the facts often relied upon to make out a case of bad faith is the knowledge of the trade mark applicant that there existed another trade mark belonging to the party opposing the application or to a third party. This knowledge is certainly a relevant fact in the bad faith inquiry...It should be noted, however, that this knowledge per se does not amount to bad faith. Whether there is bad faith in a case where the trade mark applicant possesses this knowledge depends on the broader question of whether, in the light of all the other circumstances in the case, an ordinary, honest person possessing this knowledge would have considered it appropriate to apply to register the trade mark.

150 As for the second contention that the marks are substantially identical, I have found at [66] that the marks are more dissimilar than similar.

151 The Opponent's third point is that the Application Mark is an "IPAD"-formative mark. I dealt with this earlier at [50(v)] where I found that "IPAD" is not a component in the Application Mark. It can only be said that the Applicant has used a "Pad"-formative mark but where a trader adopts words in common use for his trade mark, surely he must take the risk that other traders may similarly be minded to, and permitted to, use those words. That risk must run unless he is allowed to unfairly monopolise the words. It thus cannot be said that there is bad faith.

152 I also bear in mind the Applicant's explanation how the name "Xiaomi" came about and how the "MI" element in "MI PAD" is derived from the Applicant's house brand "Xiaomi". It appears to me that the Applicant's creation of the "MI PAD" Mark is independently derived and follows its own protocol of branding, i.e. using its house mark "MI" as the prefix in combination with a descriptive suffix that describes the product, i.e. "PAD" in this case. This "MI" branding has been used by the Applicant since 2010 with products such as MIUI, MiTalk, Mi 1, Mi 2, Mi 3, Mi 4, Mi 5, Mi Note, Mi Bank, Mi Air Purifier and the Mi Power Bank.

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<sup>21</sup> Opponent's Written Submissions at [202] – [205].

<sup>22</sup> Grounds of Opposition at [43].

153 I therefore find that the Opponent has not discharged its burden of showing that there is bad faith on the part of the Applicant.

154 The ground of opposition under Section 7(6) therefore fails.

### **Conclusion**

155 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the Application Mark shall proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 7 August 2017