

# IPOS Cases in 2018 – Selected Issues, Holdings and Comments of Interest

Note:

- (1) Full Grounds of Decision (and Case Notes where available) accessible at: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>
- (2) We have a mailing list where we provide updates on recent IPOS decisions. To join, please contact [gabriel\\_ong@ipos.gov.sg](mailto:gabriel_ong@ipos.gov.sg).

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## IPOS CASES IN 2018

Case Reference	Selected Issues, Holdings and Comments of Interest	Paragraph References
<p><i>Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)</i> [2018] SGIPOS 1</p>	<p><u>Background</u></p> <p>In this case, Gucci successfully opposed Guccitech’s application to register  in Class 11 in respect of various kitchen and cooking appliances.</p> <p><u>Points of interest</u></p> <p>Goods and services can be regarded as similar to each other where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such (or vice-versa). However, it does not follow that a general retail services specification (that does not refer to any particular goods) must be regarded to any goods that may be sold in a retail outlet.</p> <p>A specification of goods or services — detailed as it might be — should not be examined as if it were a testamentary disposition. What is required is to use practical common sense, while bearing in mind that the presence or absence of a particular description of goods in a specification does not have the consequence that it had under the old pre-1999 trade mark law (which protected only against use on or in relation to the same goods as those in the specification); for under the present Trade Marks Act a trade mark owner may be protected against use (or registration) of an identical or similar mark in relation to similar goods or services which may not even fall within the same class.</p> <p>On the facts, Guccitech’s application mark in Class 11 (sought to be registered in respect of various kitchen and cooking appliances) was held to be similar to GUCCI’s earlier registration in Class 21 (registered for porcelain and ceramic articles; drinking glasses and glass flasks).</p>	<p>[35]</p> <p>[41] – [44]</p>

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	<p>The GUCCI mark was also found, on the evidence, to be well known to the public at large in Singapore. Further, it was found that the use of the application mark would cause dilution in an unfair manner and take unfair advantage of the distinctive character of the earlier well known mark. It is rare for cases to succeed on these grounds in Singapore.</p>	[71] – [77]
<p><i>Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S. v BenQ Materials Corp.</i> [2018] SGIPOS 2</p>	<p><u>Background</u></p> <p>This was an unsuccessful opposition by Clarins Fragrance Group (formerly known as Thierry Mugler Parfums) to BenQ Materials Corp’s application to register  in Class 3 for cosmetics and various other goods. Clarins relied on the following registration: “ANGEL” in Class 3 for perfumes and various other goods.</p> <p>The case essentially turned on the finding that “ANGEL” and  are dissimilar.</p> <p><u>Points of interest</u></p> <p>In assessing whether a word mark is distinctive or descriptive for the purposes of the marks-similarity assessment, one may have regard to the relevant goods (or services).</p> <p>In both <i>Staywell</i> and <i>Caesarstone</i>, the Court of Appeal did not consider evidence of alleged acquired distinctiveness at the marks-similarity stage. Instead, the focus in each case was on which, if any, were the distinctive and dominant elements of the competing marks. Whether intentional or not, the advantage of such an approach is that it preserves the conceptual clarity of the step-by-step test. It allows the first stage to be focussed on the crucial question of whether the competing marks are similar, instead of being side tracked by the additional question of whether the earlier mark enjoys sufficient acquired distinctiveness so as to have an impact on the marks-similarity enquiry. This is not to say that evidence of acquired distinctiveness through</p>	<p>[22]</p> <p>[25]</p>

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	use is irrelevant. It is not. Rather, as with reputation, it can be considered at the likelihood of confusion stage.	
<p><i>USA Pro IP Limited v Montfort Services Sdn. Bhd.</i> [2018] SGIPOS 3</p>	<p><u>Background</u></p> <p>This case and the one below (<i>USA Pro IP Limited v Montfort Services Sdn. Bhd.</i> [2018] SGIPOS 4) arose out of a dispute between the parties concerning two related USAPRO trade marks (the first was a registered trade mark and the second was a trade mark application).</p> <p>It was found that Montfort Services had knowledge of USA Pro IP's rights at the relevant time; that Montfort Services had proceeded to apply to register USAPRO despite such knowledge; and that Montfort Services had not used the mark at all.</p> <p>In the result, USA Pro IP Limited succeeded in obtaining a declaration of invalidity in respect of the registered trade mark on grounds that the mark had been applied for in bad faith. USA Pro IP Limited also succeeded in its trade opposition (on grounds of bad faith) for substantially the same reasons.</p> <p><u>Points of interest</u></p> <p>The registered proprietor submitted that the Registrar should be slow in making adverse findings (on the ground of bad faith) against it as their deponents were not cross-examined. The Hearing Officer stressed that the key was whether the case is one in which cross-examination is warranted, and noted that there was in fact no substantial dispute on the evidence. Instead, what was disputed was the conclusions that should be drawn from the evidence filed. There was therefore no need for cross-examination. Consequently, the submission was rejected.</p> <p>The fact that revocations proceedings have been brought against a trade mark does not prevent the proprietor of that mark from using it. It is not a valid reason for non-use.</p>	<p>[21] – [23]</p> <p>[107] – [117]</p>

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<p><i>USA Pro IP Limited v Montfort Services Sdn. Bhd.</i> [2018] SGIPOS 4</p>	<p><u>Points of interest</u></p> <p>A lack of a bona fide intention to use a registered mark is a factor which points towards a finding that the mark was registered in bad faith.</p>	<p>[31] – [37]</p>
<p><i>Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited</i> [2018] SGIPOS 5</p>	<p><u>Background</u></p> <p>This was an unsuccessful opposition to Deestone Limited’s application to register the  trade mark in Class 12 (in respect of “Automobile tires; Motorcycle tires; Bicycle tires” and various other goods). The joint opponents had relied on: (a) the first opponent’s  registered in Class 12 (in respect of “Tires and tubes, vehicle wheels, bicycles and their parts”) and (b) the second opponent’s  registered in Class 12 (in respect of “Tyres included in Class 12”).</p> <p>The outcome essentially turned on the Hearing Officer’s view that the application mark was more dissimilar than similar to each of the two cited trade marks.</p> <p><u>Points of interest</u></p> <p>Among other things, the Hearing Officer found that it is not necessary for trade marks to be owned by the same legal entity in order to be protected as a family of marks. Thus, it is possible for corporate family members to be regarded as a single source (see [33]). As regards the requirements for protection, it was found that use alone is insufficient to prove a family of marks. Ultimately, the issue is whether the consumers regard the marks which bear a common element as originating from the same trade source such that confusion would likely result if there is another mark in the marketplace bearing that common element (see [39] – [40]). The thrust of the joint opponents’ case was that there was a family of “STONE” marks, but this was, in the Hearing Officer’s view, not borne out by the evidence (see [42]).</p>	<p>[34] – [36]</p>

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	<p>Does registration of a number of marks bearing a common element give rise to a presumption that the common element constitutes a family of marks? No. The mere fact that a mark is registered does not mean that it is used in the market place. Without use it cannot be established that consumers are aware that there is a common element within the marks owned by a single course which constitutes a family. Therefore, a proprietor needs to submit proof of use of a number of marks bearing a common element such that it may be said consumers are aware that the common element constitutes a family of marks.</p> <p>Is use alone sufficient to establish a family of marks? Or, does the use have to achieve a certain effect on consumers before protection as a family of marks will be accorded? Ultimately the issue is not just whether the marks have been in use but whether consumers associate the marks which bear a common element as originating from a single source such that if there is another mark in the marketplace bearing that common element, the consumer is likely to be confused. If consumers do not associate the common element as belonging to a family, there would be no reason to extend protection to that common element on the basis that consumers are likely to be mistaken as to the origin of goods or services covered by the mark applied for, or consider erroneously that the mark applied for is part of that family. For the existence of a family of marks to affect the relevant consumer's reaction, that family must have been evident to consumers in Singapore.</p>	[37] – [41]
<p><i>Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd</i> [2018] SGIPOS 6</p>	<p><u>Background</u></p> <p>In this highly unusual case, Inner Mongolia Little Sheep Catering Chain succeeded in invalidating the latter's trade mark "XIAO FEI YANG" in Class 43 (for restaurant services) on grounds of bad faith. (Other grounds of invalidation were pleaded, but the decision on bad faith made it unnecessary to deal with those other grounds.) Although the latter filed its pleadings, it failed to file evidence and later abandoned the proceedings.</p> <p>It is necessary to provide some context. The applicant for invalidity was a successful hotpot restaurant chain known as "Little Sheep" or "小肥羊" (the Chinese characters are pronounced "XIAO FEI YANG", and may be loosely translated as "little fat sheep"). Although there were no</p>	

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	<p>“Little Sheep” / “小肥羊” restaurants in Singapore, the applicant had various earlier trade mark registrations in Singapore, including the stylised mark  in Class 43 for restaurant services. The subject mark in issue was used in relation to a hotpot restaurant known as “草原小肥羊” (pronounced “CAO YUAN XIAO FEI YANG”, loosely translated as Grassland Little Fat Sheep). There was sufficient evidence to support a finding that “XIAO FEI YANG” was applied for in bad faith.</p> <p><u>Points of interest</u></p> <p>This is the first time that this tribunal has had the opportunity to consider the issue of whether an earlier trade mark registered in Chinese characters (here: ) is similar to a later trade mark that is essentially its transliteration (XIAO FEI YANG). Although it was not necessary to decide the marks-similarity point, the following observations were made.</p> <p>The visual aspect: Chinese characters are by nature different from letters in the English alphabet. Naturally it follows that in almost all cases the competing marks would be found to be visually dissimilar. So too in this case. If it had been necessary to decide the issue, the marks would have been found to be visually dissimilar. However, the mere fact that Chinese characters are different from their transliteration does not, without more, bar a finding of similarity of marks. This is because one must also take into account the aural and conceptual similarities.</p> <p>The aural aspect: The whole purpose of transliteration is to enable, with some degree of aural precision, words in one language to be represented in another. In this case the marks could be considered aurally similar to a significant degree.</p> <p>The conceptual aspect: In this case, there would be a slight degree of conceptual similarity in that both of them point to the same meaning, which is little fat sheep. However, everything turns on the specific context and in particular the words and characters at issue (and so it follows that the position may be different where there are other characters involved).</p>	<p>[70]</p>

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<p><i>Monster Energy Company v Glamco Co., Ltd.</i> [2018] SGIPOS 7</p>	<p><u>Background</u></p> <p>This was the third case to be decided by IPOS involving an opposition by Monster Energy Company (“MEC”) to the registration of a trade mark containing the word “MONSTER”.</p> <p>MEC was unsuccessful in all three (unrelated) cases. There was no appeal against the first decision (see [2017] SGIPOS 12). An appeal against the second (see [2017] SGIPOS 17) was dismissed by the High Court; no written grounds of decision were issued. Separately, there have been 9 other separate trade mark opposition cases before IPOS wherein the application was abandoned after MEC filed an opposition.</p> <p>In this case, the competing marks were Glamco’s application mark “SWEET MONSTER” and MEC’s earlier trade mark “MONSTER”. In the Hearing Officer’s view, while there is some aural similarity between the two, the marks are visually and conceptually more dissimilar than similar. Overall, the marks were held to be more dissimilar than similar.</p> <p><u>Points of interest</u></p> <p>The decision was appealed to the High Court, which upheld the decision below. (See <i>Monster Energy v Glamco Co, Ltd.</i> [2018] SGHC 238 (Chan Seng Onn J).)</p> <p>A further appeal to the Court of Appeal is pending.</p>	
<p><i>Fox Head, Inc. v Fox Street Wear Pte Ltd</i> [2018] SGIPOS 8</p>	<p><u>Background</u></p> <div style="text-align: center;">  </div> <p>Fox Street Wear Pte Ltd applied to register “” in Class 25 in respect of footwear and certain articles of clothing. The primary mark relied on to oppose the application was “</p>	

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	<p data-bbox="546 304 1783 424">            ” (in Class 25). This mark was registered on the basis of honest concurrent use with some of the applicant’s earlier trade marks (see below).         </p> <p data-bbox="546 475 1783 619">           The background to the dispute is somewhat complicated. It suffices to say that both parties had applications/registrations for trade marks comprised of or containing the word “FOX” and/or images relating to foxes. One might perhaps get a flavour of the rather odd situation by considering the table below (which sets out some of the marks owned by the respective parties).         </p> <table border="1" data-bbox="842 663 1482 1152"> <thead> <tr> <th data-bbox="842 663 1162 770">Opponent (Fox Head Inc)</th> <th data-bbox="1162 663 1482 770">Applicant (Fox Street Wear)</th> </tr> </thead> <tbody> <tr> <td data-bbox="842 770 1162 1152">  </td> <td data-bbox="1162 770 1482 1152">  </td> </tr> </tbody> </table> <p data-bbox="546 1190 1783 1318">           Given the circumstances, it was unsurprising that the among the issues argued were: (a) whether the fact that the opponent’s earlier mark was registered on the basis of honest concurrent use made any difference to the outcome; and (b) whether the opponent had acquiesced to the applicant’s use of the application mark.         </p>	Opponent (Fox Head Inc)	Applicant (Fox Street Wear)			
Opponent (Fox Head Inc)	Applicant (Fox Street Wear)					
						

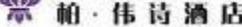
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	<p>The Hearing Officer decided that both of these questions were to be answered in the negative. In the result, she held that the marks are similar, the goods are similar, and the requirement of likelihood of confusion had been made out. The opposition succeeded.</p> <p><u>Points of interest</u></p> <p>In order to obtain registration under honest concurrent use, the party seeking registration must genuinely believe that concurrent use of its mark with the earlier marks do not and would not cause confusion.</p>	[29]
<p><i>Monster Energy Company v Tencent Holdings Limited</i> [2018] SGIPOS 9</p>	<p><u>Background</u></p> <p>This was the fourth case to be decided by IPOS involving an opposition by Monster Energy Company (“MEC”) to the registration of a trade mark containing the word “MONSTER”. The mark</p> <div style="text-align: center;">  </div> <p>sought to be registered was and the primary mark relied on by MEC was “MONSTER ENERGY”. It was held that the marks were dissimilar and thus the opposition was unsuccessful.</p> <p><u>Points of interest</u></p> <p>Parties ran arguments on the issue of partial oppositions. Although the Hearing Officer did not need to decide the issue in light of his conclusion that the marks were dissimilar, he expressed the view that the Registrar cannot, in the context of a trade mark opposition under Sections 8(2)(b) and/or 8(4) of the Trade Marks Act refuse the registration of certain goods or services in a certain class, but allow it to be registered for other goods or services in the same class. Instead, the Registrar had to either refuse or allow registration of the mark in its entirety (i.e. in respect of all the goods or services for which registration is sought). This is the first time that the tribunal has taken a firm view on partial oppositions.</p> <p>An appeal to the High Court is currently pending.</p>	[74] – [92]

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<p><i>Bigfoot Internet Ventures Pte. Ltd. v Athleta (ITM) Inc.</i> [2018] SGIPOS 10</p>	<p><u>Background</u></p> <p>Bigfoot sought to revoke “ATHLETA”, registered in Class 25 in respect of “clothing, footwear, headgear and clothing accessories”, on the basis of non-use. It is not mandatory for a party seeking non-use revocation to file evidence in support, and Bigfoot did not do so. The parties elected to have the matter determined on the papers (i.e. based on the documents, evidence and written submissions, without oral arguments). As with practically all non-use revocation cases, the outcome turned on the evidence before the tribunal. On the documentary evidence, Athelta was able to establish that its registered mark had been used in respect of “clothing, headgear and clothing accessories” but not “footwear”. An order for partial revocation was made.</p> <p><u>Points of interest</u></p> <p>This decision is a useful point of reference on the issue of costs to be awarded in partial revocations. As a starting point, in the absence of other intervening factors, costs should ordinarily follow the event. In the event of a partially successful revocation action, costs should be awarded to the party which brought the action (here: Bigfoot). However, it does not necessarily follow that full costs should be awarded in such cases. The Registrar may award a <i>percentage</i> of costs in cases of partial revocation. In this regard, it is important to note that the percentage of costs is not something that is determined by a rigid mathematical formula based on the number of items revoked out of the total number in the original specification. It is not a strict numbers game. Rather, it is determined by all the circumstances of the case. On the facts of this case, Bigfoot was awarded 20% of their costs.</p>	<p>[44] – [48]</p>
<p><i>Starwood Hotels &amp; Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Limited</i> [2018] SGIPOS 11</p>	<p><u>Background</u></p> <p>It has been almost 5 years since the Court of Appeal handed down its seminal decision in <i>Staywell Hospitality Group Pty Ltd v Starwood Hotels &amp; Resorts Worldwide Inc &amp; anor</i> [2014] 1 SLR 911 (“<i>Staywell (CA)</i>”). One might recall that in that case, Starwood/Sheraton succeeded in</p>	

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	<p>their opposition (based on their earlier registered mark “ST. REGIS”) to Staywell’s application for</p>  <p>“ PARK REGIS ” in Classes 35 and 43.</p> <p>In the present case, Starwood/Sheraton sought to invalidate Staywell’s trade mark</p>   <p>(registered in Classes 35 and 43) on the basis that it conflicted with the same “ST. REGIS” mark that was relied on in <i>Staywell (CA)</i>.</p> <p>The Hearing Officer considered that the only difference between the instant dispute and <i>Staywell (CA)</i> was the Chinese characters “柏·伟诗酒店” (transliteration: <i>Bai Wei Shi Jiu Dian</i>) in the subject mark. In her view, the crucial issue was whether the addition of these characters should result in a different conclusion from that which the Court of Appeal reached in <i>Staywell (CA)</i>. After consideration, she held that they did not. Consequently, the registration was declared invalid.</p> <p><u>Points of interest</u></p> <p>Having regard to the demographics of Singapore, the Hearing Officer was of the view that the Chinese characters 柏·伟诗酒店 would not be viewed simply as a decorative element. Those who are literate in Chinese are not likely to ignore them. However, English is the working language in Singapore, and the English words would take primary significance over the Chinese characters 柏·伟诗酒店.</p> <p>An appeal to the High Court is currently pending.</p>	<p>[69] – [83]</p>

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<p><i>Adidas International Marketing BV v Luton Enterprise Corp.</i> [2018] SGIPOS 12</p>	<p><u>Background</u></p> <div style="text-align: center;">  </div> <p>Are “” and “” similar? That is the central question that lay at the heart of adidas’ opposition to Lutong’s trade mark application. In advancing its case that the competing marks are similar, adidas focused on the sloping stripes and downplayed the role of the circle in Lutong’s trade mark. The Hearing Officer was not persuaded, and considered the presence of the circle to be significant in impact on the overall impression of Lutong’s trade mark. She ultimately took the view that the marks are more dissimilar than similar.</p> <p>Since all of the pleaded grounds (except for bad faith) were contingent on a finding of marks-similarity, the opposition failed. adidas was also not able to establish a case of bad faith.</p> <p><u>Points of interest</u></p> <p>The opponent furnished supplementary written submissions at the hearing itself. These submissions came with 7 additional case authorities from other IP offices. HMG Circular No. 4/2015 states, at Part F, the proper practice relating to additional or supplementary written submissions and authorities. A party who wishes to tender additional or supplementary written submissions and authorities should file and serve the same on the counter-party at least two weeks before the hearing. This circular makes clear that if the above is not complied with, the Registrar will either disregard the submissions; or accept them and give the counter-party time to file reply submissions. The policy behind this is that parties are expected to articulate their best case through the written submissions and authorities due at least one month before the hearing: Rule 37 of the Trade Marks Rules (Cap 332, 2008 Rev Ed). They should not, as a matter of course, have a second bite at the cherry by tendering more submissions and / or authorities of a substantive nature only at the hearing itself when these could have been filed at least one month earlier. A distinction is drawn between such submissions and / or authorities and basic rebuttal submissions which can be made at the hearing itself (HMG Circular No. 4/2015 does not require basic rebuttals to be filed and served two weeks in advance).</p>	<p>[50] – [53]</p>

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	<p>The Hearing Officer declined to accept the additional case authorities.</p> <p>An appeal to the High Court is currently pending.</p>	
<p><i>Singapore Shipping Association and Association of Singapore Marine Industries v Hitachi, Ltd.</i> [2018] SGIPOS 13</p>	<p><u>Background</u></p> <p>This was an application by Singapore Shipping Association and Association of Singapore Marine Industries to revoke Hitachi’s patent relating to ballast water treatment. The pleaded grounds of revocation were: (a) lack of inventive step; and (b) double patenting.</p> <p>Hitachi did not defend the proceedings.</p> <p>As the Applicants filed sworn expert evidence, and Hitachi filed neither counter-statement, evidence nor arguments, the Hearing Officer relied on the Applicants’ expert evidence significantly (without merely taking it at face value), giving much weight to what the expert claims to be the common general knowledge, in the context of what would be obvious to the person skilled in the art.</p> <p>Ultimately, the application succeeded under the first ground but not the second.</p>	
<p><i>Singapore Shipping Association and Association of Singapore Marine Industries v Hitachi, Ltd.</i> [2018] SGIPOS 14</p>	<p><u>Background</u></p> <p>This was another application by Singapore Shipping Association and Association of Singapore Marine Industries to revoke Hitachi’s patent relating to a ballast water management system. Four grounds of revocation were pleaded, namely: (a) lack of inventive step; (b) insufficiency of disclosure; (c) added matter; and (d) double patenting.</p> <p>As with the case above, Hitachi did not defend the proceedings.</p> <p>The application succeeded under the added matter ground. The Hearing Officer did not assess the remaining grounds as it was not necessary to do so, especially in an undefended revocation application.</p>	

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<p><i>Apple Inc. v Swatch AG (Swatch SA) (Swatch Ltd.)</i> [2018] SGIPOS 15</p>	<p><u>Background</u></p> <p>Apple’s “Think Different” advertising campaign, which started in 1997 (not long after Steve Job’s return to the company he co-founded) was — by various accounts — a key contributor to Apple’s success and represented an inflection point in the fortunes of the then-floundering company. In 1999, Apple registered the “THINK DIFFERENT” trade mark in Class 9 in Singapore in respect of, among other things, “<i>computers; computer hardware; computer software</i>”.</p> <p>The “Think Different” campaign lasted until 2002.</p> <p>In November of 2015, Swatch applied to register “Tick different” for a wide variety of goods in Class 9 (including “<i>computers</i>”) and Class 14. The trade mark applications were opposed by Apple, which relied on its registered “THINK DIFFERENT” trade mark in Class 9. According to Swatch, the word “TICK” was a reference to the ticking of clocks or other timepieces, and “Tick different” was coined to reflect Swatch’s long history and association with timepieces. However, no further explanation was given for the choice of the word “different” in conjunction with “Tick”. Ultimately, the oppositions were unsuccessful. The Hearing Officer was persuaded that the two marks were overall more dissimilar than similar. Hence, Apple could not succeed on the grounds of opposition that relied on the marks being found similar.</p> <p>On the ground of bad faith, Apple alleged that Swatch could not validly claim to be the proprietor of “Tick different” because it filed the applications with the intention to ride on Apple’s substantial goodwill and reputation in “THINK DIFFERENT” and to benefit from a favourable association. As “Tick different” and “THINK DIFFERENT” were found dissimilar, (a) it was difficult to see how there is any benefit to be had from riding on Apple’s goodwill and reputation and from any favourable association with Apple or “THINK DIFFERENT”; and (b) that Apple claims rights to “THINK DIFFERENT” is not inconsistent with Swatch laying legitimate claim to “Tick different”. Apple therefore could not establish that Swatch filed its applications in bad faith.</p>	

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	<p><u>Points of interest</u></p> <p>Apple alleged in its statutory declaration and/or its submissions the following: (a) that Swatch had a <i>modus operandi</i> of registering several of Apple’s famous marks and slogans even though it had allegedly no rights nor intention to use these marks; (b) that Swatch was a “troll” that engaged in “trade mark squatting” and that it was seeking to “agitate Apple with trademarks instead of competition”; and (c) that Swatch was trying to register “TICK DIFFERENT” “to prevent any potential use of any variation(s) of the “THINK DIFFERENT” mark to complement any marketing campaign for the Apple Watch”. Nevertheless, the above allegations were not part of Apple’s pleaded case and were not adjudicated upon.</p>	[94] – [99]
<p><i>Monster Energy Company v NBA Properties, Inc.</i> [2018] SGIPOS 16</p>	<p><u>Background</u></p> <p>Although this is the fifth case by MEC to reach a full hearing before this tribunal, the subject matter differs from the earlier cases. The primary objection taken in those first four cases was that the later trade mark application contained the word “MONSTER”. In this case, however,</p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p>MEC relied on its claw device “” and composite mark “”. The opposition was to</p> <div style="display: flex; justify-content: center; align-items: center;">  </div> <p>the following application mark: “”. (As some would be aware, Toronto Raptors is the name of a team in NBA’s professional basketball league.) The IP Adjudicator found the competing marks to be dissimilar. Since all of the grounds of opposition hinged on a finding of similarity between the marks, the action failed in its entirety.</p>	

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	<p><u>Points of interest</u></p> <p>The IP Adjudicator took the view that how the average consumer <i>understands</i> what he sees (which is the essence of the mark-similarity analysis) must necessarily depend on <i>what he knows</i>. In other words: a contextual approach should be adopted in evaluating the average consumer’s perception of the mark(s). Accordingly, in his view, parties should be permitted to adduce evidence of those surrounding circumstances that are relevant towards establishing the general knowledge possessed by the average consumer. It is clear that he considered this approach to be not inconsistent with Court of Appeal’s decision in <i>Staywell</i> and in particular the requirement that the “<i>mark-for-mark</i>” comparison be “<i>without consideration of any external matter</i>”. Following this approach, the IP Adjudicator took into account, among other things, the fact that the average Singaporean consumer would perceive “TORONTO RAPTORS” as a reference to the name of a sports team, as this might have an impact on how the stylised graphic device element is perceived and interpreted (which feeds into the assessment for visual, aural and conceptual similarity).</p> <p>An appeal to the High Court is currently pending.</p>	[41] – [48]
<p><i>Singapore Telecommunications Limited v Megaport (Services) Pty Ltd</i> [2018] SGIPOS 17</p>	<p><u>Background</u></p> <p>Singapore Telecommunications Limited (SingTel), a major service provider of telecommunication services in Singapore, opposed Megaport (Services) Pty Ltd’s application to register “MEGAPORT” in Class 38 for (among other things) telecommunication services. In the proceedings, SingTel placed primary reliance on the following registered mark (registered as a series) in Class 38 for (among other things) telecommunication services:</p> <p style="text-align: center;">MEG@POP meg@pop Meg@POP</p> <p>The Hearing Officer held that the objection under section 8 failed. Key to her decision were her findings that the marks are more dissimilar than similar, in particular having regard to the symbol</p>	

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	<p>“@” in SingTel’s earlier mark (which was not present in the application mark) and that there is no likelihood of confusion in light of the mode of purchase of the service.</p>	
<p><i>Daidoh Limited v New Yorker S.H.K. Jeans GmbH &amp; Co. KG</i> [2018] SGIPOS 18</p>	<p><u>Background</u></p> <p>This decision brings an end to a two-part fight between two traders in the fashion industry over the trade mark “NEWYORKER”. The incumbent, Daidoh, is the registered proprietor of the trade mark  in Class 25 for clothing and a number of other goods.</p> <p>The trade mark applicant, New Yorker Jeans, sought to register  in respect of a wide variety of services in Class 35, including retail services with regard to clothing. The Hearing Officer held: (1) that the marks are identical on account of the fact that the differences between them are insignificant and would go unnoticed by an average consumer with imperfect recollection; (2) the goods and services are similar (here: clothing on the one hand and retail services with regard to clothing on the other); and (3) there is a likelihood of confusion. Consequently, the opposition was allowed and the application mark was refused registration.</p> <p><u>Points of interest</u></p> <p>A finding that two competing marks are identical can be made where the differences are minor and insignificant that they may go unnoticed by an average consumer. Case law does not require that every jot or tittle of the marks be identical in every respect.</p> <p>If “a service of repair might well be similar to the goods repaired” (<i>British Sugar Plc v James Robertson &amp; Sons Ltd.</i> [1996] RPC 281 at 297), surely it must follow that the service of retailing a specific good ought to be similar to the good itself.</p>	<p>[19] – [29]</p> <p>[36]</p>
<p><i>United U-LI Projects Pte Ltd v Tan Buck Hai</i> [2018] SGIPOS 19</p>	<p><u>Background</u></p> <p>This is the second instalment of a dispute between the parties over the trade mark “U-LI”. Last year, Tan Buck Hai was unsuccessful in seeking a declaration of invalidity of United U-LI Projects’</p>	

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	<p>trade mark (see [2017] SGIPOS 14). In this case, the roles were reversed: this time, it was United U-LI Projects that sought—and was ultimately granted—a declaration of invalidity in respect of the trade mark “U-LI” registered in the name of Tan Buck Hai.</p> <p><u>Points of interest</u></p> <p>United U-Li Projects succeeded on the ground of bad faith. The thrust of its case on this ground was that the proprietor had wrongfully claimed ownership of the registration even though he knew that he was not authorised to register it. After evaluating the evidence, the IP Adjudicator found that throughout the relevant time, the registrant was but an employee. He might have promoted the U-LI products in the course of his work, but this did not mean that he had acquired rights to them. Furthermore, the registrant acted in the following ways which pointed towards his intention being not purely bona fide. First, he got a company (United U-LI Impex Pte Ltd) that he had incorporated to register the subject mark instead of registering it in his own name, despite intending to assign it to himself after the registration was completed. This suggested that he wanted to cloak the application with greater legitimacy (through the use of a company bearing the name “U-LI”). Second, despite knowing of the applicant’s earlier “U-LI” mark in Class 6, he registered the subject mark in a different class, Class 9. Third, at no point of time did he ever seek to clarify the position with United U-LI (M) Sdn Bhd as to his entitlement to the U-LI mark in Singapore. Taken in totality, there are sufficient grounds to find that the registrant’s behaviour would not have been commercially acceptable when considered by reasonable and experienced persons in the trade and would amount to bad faith.</p> <p>An attempt was also made to argue that the registration was obtained on grounds of misrepresentation. The registration was originally in the name of “U-LI Impex Pte Ltd” which is an entity that did not exist at the time. It was contended by the applicant that this amounted to a misrepresentation because a trade mark cannot vest in an entity that did not exist. As a consequence of such a fundamental error the registration could not fulfil the fundamental definition of being property at the time it was made; any subsequent amendment as to the identity of the owner could not correct such a fundamental defect. (The proprietor’s information had later been amended for accuracy to: “United U-LI Impex Pte Ltd”.) This creative argument was rejected by the IP Adjudicator on the basis that there was no evidence of any intention to mislead</p>	<p>[60] – [64]</p> <p>[66] – [73]</p>

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	the Registrar. It was, after all, a typographical error. The unsuccessful argument had an adverse impact on the costs ultimately awarded to the otherwise successful applicant for invalidity.	
<p><i>Chicago Mercantile Exchange Inc. v Intercontinental Exchange Holdings, Inc.</i> [2018] SGIPOS 20</p>	<p><u>Background</u></p> <p>Chicago Mercantile Exchange (CME) successfully applied to have two trade marks —“BRENT” and “BRENT INDEX”, both registered in the name of Intercontinental Exchange Holdings (ICE) in Class 36 in respect of a wide range of financial services — declared invalid on grounds that they were: (a) devoid of any distinctive character; (b) exclusively descriptive of the financial services for which they were registered; and (c) customary terms used by those trading (and otherwise dealing) in financial derivatives connected with (or related to) the oil (and oil-products) markets to describe a sweet crude oil with a particular geographical origin. The fact that ICE was and is the sole provider of “BRENT” pricing information (and has been regulated by the UK’s Financial Conduct Authority since April 2015) did not assist its position.</p> <p><u>Points of interest</u></p> <p>A line of argument was canvassed that the use of a proprietor’s “family of marks” gives rise to an enhanced distinctiveness of its marks. On the facts, the “family of marks” argument used this way did not help the proprietor establish acquired distinctiveness for its descriptive mark. It cannot be the case that adding distinctive matter to a descriptive or generic word and thereby forming a composite mark that may be registered as a trade mark (as the combination is not devoid of distinctive character, exclusively descriptive and/or generic) can support an argument that the descriptive word is registrable on its own.</p> <p>The registrations in issue were registered in respect of what the IP Adjudicator considered to be an “<i>extremely broad specification of services</i>”. The IP Adjudicator then turned to the issue of whether he had the power under the Trade Marks Act to decide, of his own volition, in the public interest, that the registrations were obtained in bad faith by reason of the evidence before the tribunal <i>coupled with</i> ICE’s statements (in the relevant application forms) that it did have an intention to use the marks in relation to the broad specification of services claimed. He reluctantly</p>	<p>[30]</p>

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	<p>concluded that he did not have such a power, but opined that if he did, he would have exercised it in favour of CME.</p> <p>An appeal to the High Court is currently pending.</p>	
<p><i>Bitwave Pte Ltd v Fung Shing Company Limited</i> [2018] SGIPOS 21</p>	<p><u>Background</u></p> <p>What is a trader to do when a former business partner registers a trade mark — without consent — that it was using? File for invalidation proceedings, of course. In this rather unfortunate case, Bitwave succeeded in obtaining a declaration of invalidity on grounds that its former business partner had registered “<b>UCLEAR</b>” in bad faith.</p> <p><u>Points of interest</u></p> <p>Fung Shing’s director failed to appear before the tribunal to be cross-examined. This cast serious doubt on the credibility of his evidence, and the Hearing Officer rejected his version of the facts insofar as they conflicted with Bitwave’s account and the documentary record. Fung Shing also did not attend the oral hearing, which went on in its absence.</p>	<p>[51]</p>
<p><i>Cartier International AG v Moneymax Jewellery Pte. Ltd.</i> [2018] SGIPOS 22</p>	<p><u>Background</u></p> <p>Can anyone have a monopoly over love? More precisely, can a trader prevent other traders from registering a trade mark which includes the word “LOVE” for use on jewellery? In <i>Love &amp; Co Pte Ltd v The Carat Club Pte Ltd</i> [2009] 1 SLR(R) 561, Justice Chan Seng Onn was of the view that no trader should be permitted to monopolise the word “LOVE” for jewellery. In these proceedings,</p> <div style="text-align: right;">  </div> <p>Cartier sought to rely on its <b>LOVE</b> trade mark to prevent MoneyMax from registering</p>	

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	<p>in respect of jewellery. The Hearing Officer refused the opposition. In so doing, he stressed that since “LOVE” itself is not distinctive in relation to jewellery, any distinctiveness in the opponent’s mark resided in the so-called screw-head device  and possibly the use of the small letter “e”. Since neither of these elements were present in the application mark, the competing marks were found to be dissimilar.</p> <p>An attempt was also made by Cartier to attack the application mark on grounds of non-distinctiveness. It was argued that (a) the Chinese characters should be disregarded as they are of secondary significance compared to the English words; and (b) the word “LOVE”, the word “GOLD” and the combination of these words were each descriptive and not distinctive. Hence the mark as a whole lacked distinctiveness. The Hearing Officer rejected these submissions, holding that Cartier’s approach was misguided in as much as it had sought to break up the mark into constituent parts (instead of assessing it as a whole).</p>	

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