

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

Trade Mark No. 40201707514X
29 August 2019

IN THE MATTER OF A TRADE MARK APPLICATION BY

MINTEREST PRIVATE LIMITED

AND

OPPOSITION THERETO BY

INTUIT INC.

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

Mr Marcus Liu and Ms Megan Pang (Amica Law LLC) for the Applicant
Ms Teresa O'Connor and Ms Zinia Ang (Infinitus Law Corporation) for the Opponent

GROUND OF DECISION

1 Minterest Private Limited (“the Applicant”) is a digital peer-to-business marketplace funding platform headquartered in Singapore. Founded in 2016 as MRSMINT PRIVATE LIMITED, the Applicant changed its name to what it is currently known on 9 March 2017. The Applicant’s MINTEREST platform connects corporate borrowers with investors and allows investors to participate in business loans or invoices offered by small and medium business enterprise borrowers.

2 Intuit Inc. (“the Opponent”) is a business and financial software company. It was founded in 1983 in the United States of America. In September 2009, the Opponent acquired Mint.com, a financial services platform which was launched in 2007. Among other services, this platform provides individuals and small businesses with the ability to (1) shop for and compare loans, (2) shop for and compare credit cards, and (3) track their loan, bank, credit card and investment balances and transactions through a single interface. This platform is available via the Opponent’s website, www.mint.com and MINT mobile app. Over 20 million registered user accounts have been created worldwide since its launch. Out of this number, over 200¹ registered users are from Singapore.

3 On 27 April 2017, the Applicant applied to register the trade mark:

The image shows the word "mint" in a teal color and "erest" in an orange color, both in a lowercase, sans-serif font.

(“the Application Mark”), in Singapore in respect of “Financial services” in Class 36.

4 The Application Mark was accepted and published on 14 July 2017 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 14 November 2017. The Applicant filed its Counter-Statement on 15 January 2018. The Opponent filed evidence in support of the opposition on 27 August 2018. The Applicant filed evidence in support of the application on 21 December 2018. The Opponent filed its evidence in reply on 29 April 2019. A Pre-Hearing Review was conducted on 29 May 2019 and the matter was set down for hearing on 29 August 2019.

Grounds of Opposition

5 The Opponent relies on Sections 8(2)(b) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this opposition.

Opponent’s Evidence

6 The Opponent’s evidence comprises a statutory declaration (“OSD1”) and a statutory declaration in reply (“OSD2”), both made in California, United States of America by Todd Santos, Senior Manager – IP Programs of the Opponent. They are dated 23 August 2018 and 26 April 2019 respectively.

Applicant’s Evidence

7 The Applicant’s evidence comprises a statutory declaration made by Ronnie Chia Siang Hee, Chief Operating Officer of the Applicant on 20 December 2018 (“ASD”) in Singapore.

¹ As at August 2018.

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 during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

MAIN DECISION

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

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

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

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public.

Decision on Section 8(2)(b)

10 The law in Singapore on the approach to be taken in applying Section 8(2)(b) of the Act is now well-settled. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) reaffirmed the “step-by-step” approach which may be summarised as follows. The first step is to assess whether the respective marks are similar. The second step 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. If the first and second steps are answered in the affirmative, the third step is to consider whether there exists a likelihood of confusion as a result of the similarities and/or identities. 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]).

Marks-Similarity: Principles

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

- (a) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. (*Staywell* at [20].)
- (b) The marks are to be compared “as a whole” (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(b)]). When speaking of the assessment of a mark as a whole, the similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. (*Staywell* at [23], [26].)
- (c) 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].)

- (d) 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 or examined in detail for the sake of isolating particular points of difference because the person who is confused often makes a comparison from memory removed in time and space from the marks. (*Hai Tong* at [40(d)], [62(a)]).
- (e) The 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. (*Hai Tong* at [40(c)].)

Marks-Similarity: Analysis

12 The Opponent owns and relies upon the following trade mark registrations (collectively known as “the Opponent’s Mark”) in Singapore in these proceedings:

Trade Mark No.	Filing Date	Mark	Specification
40201401135Y	2 February 2014	MINT	<p>Class 9 Computer software for use in processing electronic payments and transferring funds to and from others; computer software for use in transferring funds between financial accounts; computer software for bill presentment and payment; magnetically encoded debit cards, payment cards and stored-value cards.</p> <p>Class 36 Electronic bill presentation and electronic payment services, namely, receipt, processing and payment of bills, issuance of personal payments and the electronic transmission of payment data for others; providing bill payment and tax payment processing services via computer and communication networks; money transfer services.</p>

Trade Mark No.	Filing Date	Mark	Specification
			<p>Class 42 Providing temporary use of on-line non-downloadable computer software for performing financial transactions and transmitting and receiving information in the fields of electronic payments and electronic bill payments and bill presentment; providing temporary use of non-downloadable computer software for use in sending and receiving payments, transferring funds, bill payment and bill presentment; providing temporary use of non-downloadable computer software for generating bill reminders and bill payment status alerts.</p>
40201621394X	13 February 2016	MINT	<p>Class 36 Loan comparison and referral services, namely providing information, qualification, rate comparison and referral services related to obtaining loan financing, personal loans, peer-to-peer loans, lending products that match investors with borrowers, and student loans.</p>

Distinctiveness of the Opponent's Mark

13 I am mindful of the Court's guidance in *Staywell* at [30] that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, following the approach of the Court of Appeal in *Hai Tong* at [26], for the purpose of elucidating the analytical process, I will highlight it here as a separate step first before applying my findings within the context of the marks-similarity analysis.

14 Assessment of the degree of distinctiveness of the earlier trade mark is important "in order to determine the extent of the latitude that will be allowed to a user of features that appear in that mark" (*Hai Tong* at [27]). Further, the Court of Appeal said in *Staywell* at [25]:

... a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (*Sarika* at [36]).

15 The Opponent submits that "MINT" possesses a high level of distinctiveness and should enjoy a high threshold before the Application Mark would be considered dissimilar to it.

16 On the other hand, the Applicant submits that “MINT” is not technically distinctive (or at the very best, of an extremely low level of inherent distinctiveness)². According to dictionary websites, the word “MINT” has several meanings as follows:

- (a) An aromatic herb plant.
- (b) A sweet flavoured with mint.
- (c) In new condition.
- (d) A place where the official coins of a country are made.
- (e) A large sum of money.

17 The Opponent does not deny that due to meanings (d) and (e), the word “MINT” has some linkage to money and finances³. However, it argues that those meanings are uncommonly used in Singapore and further, the reference to money or finance based on the definitions is indirect. That being the case, “MINT” would still possess a high level of distinctiveness.

18 I do not agree that the Opponent’s Mark has a high level of inherent distinctiveness. The Opponent’s Mark is an ordinary English word in plain font with no emphasis, colour, stylisation or device. Even if I accept that meanings (d) and (e) are not commonly used in Singapore, it does not mean, and there is no evidence before me to suggest, that the average consumer is unable to appreciate those two meanings of “MINT”. In my view, “MINT”, while not directly descriptive of a characteristic of the Opponent’s goods and services, is allusive of them due to the linkage the word “MINT” has to money and finance.

19 I therefore find the Opponent’s Mark to possess a medium degree of distinctiveness, no higher or lower than the norm. While it does not describe the goods and services for which it is registered, it certainly does not qualify as a mark that has greater technical distinctiveness. Consequently, it does not enjoy a high threshold before a competing sign will be considered dissimilar to it.


Visual Similarity

20 The visual similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components and it is only when other components of a mark are of negligible significance, that it is permissible to make the comparison solely on the basis of any dominant element(s) (*Hai Tong* at [62(b)]).

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

² ASWS at [10].

³ OWS at [20].

<i>Opponent's Mark</i>	<i>Application Mark</i>
MINT	

Dominant and Distinctive Components of the Contesting Marks

22 The Opponent's Mark has only one component: the word "MINT". Consequently, that is the only thing that contributes to its overall impression.

23 As for the Application Mark, the Opponent submits that the dominant and distinctive component is the textual component "MINT" and the overall impression left by the Application Mark on an average consumer with imperfect recollection will be dominated by the component "MINT". This is because it is the "first component that the average consumer will notice when viewing the mark, hence leaving a stronger impression on the mind of the consumer. Further, the textual component "MINT" appears in bold and in larger font than the rest of the Application Mark, which is not in bold font. The component "MINT" is also highlighted in a minty green, causing it to stand out from the duller colour of the rest of the Application Mark."

24 I am unable to agree with the Opponent. In my view, there is no component of the Application Mark which dominates its overall impression visually. The High Court in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 ("*Caesarstone (HC)*") at [30], clearly cautioned that "it cannot and must not be assumed that there will always be a feature of the mark which dominates the mark's landscape. In many cases, no particular feature will stand out. Microanalysing a mark for particular distinctive features in such cases is unhelpful."⁴

25 The Application Mark is a single word "MINTEREST". Due to the different colours used, the average consumer may discern the components, "MINT" and "EREST". However, the colour differentiation does not prevent the Application Mark from being seen as a single word. This is because the components are conjoined and the entire mark is in lower case lettering, in the same font and with letters of roughly equal size and prominence.

26 I appreciate that the "MINT" component is in bold and appears in a different colour from the "EREST" component which is not in bold and which is in red/orange. These stylistic features are, however, unlikely to stand out in the consumers' imperfect recollection⁵. As for the Opponent's point that the "EREST" portion is in a "duller colour" than the "MINT" portion, in my view, the colours are quite evenly balanced.

27 Overall, I do not see how it may be said that the "MINT" component dominates over the "EREST" component. The two components form a single word and it is unlikely that the average consumer would dissect the word.

⁴ Although this decision of the High Court was reversed on appeal, the Court of Appeal did not comment on this particular passage and I see no reason, in principle, to doubt its correctness.

⁵ The fact that the average consumer is treated as having "imperfect recollection" means that the two contesting marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference (*Hai Tong* at [40(d)]).

28 I therefore find that the distinctiveness of the Application Mark rests in the combination of “MINT” and “EREST”, and in the manner in which these components are conjoined to form a single invented word. In any event, the “EREST” component certainly cannot be said to be of negligible significance. I must therefore compare the Opponent’s Mark against the Application Mark as a whole.

Analysis of Visual Similarity

29 Visually the competing marks are of different lengths—the Application Mark has nine letters as opposed to four in the Opponent’s Mark. Whilst there may be some similarity because the word “MINT” is present in both marks, the Application Mark has an additional suffix “EREST” which makes the Application Mark considerably longer and more complicated than the Opponent’s Mark. Even taking into account imperfect recollection, there is very little likelihood of the additional five letters of the suffix of the Application Mark being missed. I thus find that the marks when observed in their totality are more dissimilar than similar.

30 In arriving at this conclusion, I have noted that in Singapore the test for marks-similarity is not a low one such that any modicum of similarity would compel this tribunal to make a finding of marks-similarity (*Staywell* at [17]).

31 There is another approach to the assessment of marks-similarity in cases such as this, where there is a common component. This approach was set out in *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] SGHC 175 at [26]–[27] as follows:

... 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 ...

32 I will consider this approach to see if it results in a different finding.

33 The Application Mark clearly has an additional component “EREST” which is not found in the Opponent’s Mark. This component is distinctive and not descriptive. When added as a suffix to the word “MINT”, the distinctiveness of “MINT” is blended into the new word it forms and as such it is sufficient to displace the similarity that the average consumer will observe and is enough so as not to capture the distinctiveness of the Opponent’s Mark.

34 In this regard, I have found above that the Opponent’s Mark has a medium degree of distinctiveness, no higher or lower than the norm and consequently, it does not enjoy a high threshold before a competing sign will be considered dissimilar to it.

35 Finally, for the avoidance of doubt, while I note that the Application Mark uses a particular font and colour, I do not accord much weight to this as the Opponent’s Mark is in block capital letters. It is clear that registration of a mark in block capital letters (or standard font), covers use of the mark in every font or style (*Allergan, Inc and another v Ferlandz Nutra Pte Ltd* [2016] 4 SLR 919 at [44]).

36 For the reasons mentioned above, I find that the Application Mark is visually more dissimilar than similar to the Opponent's Mark.

Aural Similarity

37 The Court of Appeal in *Staywell* (at [31] to [32]) established two approaches to assessing aural similarity. The first is to consider the dominant component of the marks and the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not.

38 The Opponent submits, under the dominant component approach, that there is a high degree of aural similarity between the marks for the following reasons:

- (a) "MINT" is the first syllable of the Application Mark and generally, the beginnings of marks would have more emphasis when pronounced aurally;
- (b) "MINT" is the dominant and distinctive component of the Application Mark;
- (c) "MINT" is the syllable that would be emphasised when the Application Mark is pronounced aurally, while the suffix portion "EREST" would be more subdued.

39 I do not agree with the Opponent. Firstly, there is no rigid principle that the first syllable of a word would always have more emphasis when pronounced aurally. Sometimes the emphasis in a word may fall at the end of the word. Secondly, I have held above that "MINT" is not the dominant and distinctive component of the Application Mark. This holds true for the aural analysis as well. The Application Mark is a single word mark and will not be dissected when spoken. In this regard, the Opponent submits and I agree, the Application Mark would be pronounced as "MINT-TREST". Finally, while I agree with the Opponent that the suffix is likely to be more subdued when pronounced relative to the prefix, the fact remains that the suffix would still be pronounced and would be audible. The difference between "MINTEREST" and "MINT" is obvious and not hard to hear.

40 Considering the above, I find that the marks are aurally more dissimilar than similar under the dominant component approach.

41 As for the quantitative approach, I would also reach a similar conclusion. The Opponent's Mark has one syllable "MINT"; whereas the Application Mark has two⁶. The marks cannot be said to have more syllables in common than not as there is one syllable in common and one syllable different. In any event, the Opponent's Mark has fewer syllables than the Application Mark and this difference would be obvious aurally.

42 In conclusion, I find that when the marks are spoken aurally, their overall phonetic impressions are more dissimilar than similar.

⁶ Neither of the parties raised the possibility that the Application Mark would be pronounced as "MINT-EE-REST" and as such I do not consider it.

Conceptual Similarity

43 Conceptual similarity is directed at the ideas that lie behind and inform the understanding of the marks as a whole (*Staywell* at [35]).

44 Here as before, the Opponent’s argument is that “MINT” is the dominant and distinctive component of the Application Mark. It also argued that if the word “MINT” is interpreted as “a large sum of money”, it is conceivable that the component “EREST” in the Application Mark would also be understood as a reference to the word “interest” due to the close proximity between the concept of “a large sum of money” and the meaning of the word “interest”. The idea conveyed by the word “interest” being in line with the idea conveyed by the component “MINT” does not distinguish the marks conceptually. The Opponent thus, submits that there is a high degree of conceptual similarity between the marks.

45 In my view, it is not helpful to microanalyse and break down the Application Mark into its constituent components because the Application Mark is after all a single word mark with no component more dominant than the other. In this regard, the Court of Appeal in *Staywell* at [35] clearly cautioned that greater care is needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts. “MINTEREST” as a whole, is a coined word with no meaning and is likely to be perceived by the average consumer as such.

46 Consequently, I consider that the marks are dissimilar conceptually: one is an invented word and the other is a commonly used word that could have a number of meanings.

Conclusion on Marks-Similarity

47 I have concluded that the Opponent’s Mark in comparison to the Application Mark is visually and aurally more dissimilar than similar and conceptually dissimilar. Overall, I am of the view that the marks are more dissimilar than similar.

48 Having regard to the 3-step test, my conclusion above ends the inquiry with regard to the objection under Section 8(2)(b). The ground of opposition under Section 8(2)(b) therefore fails.

A “MINT” family of marks?

49 Before leaving this ground, I should touch briefly on the Opponent’s claim that it has a family of “MINT” marks. The existence of a family of marks and the degree of recognition evoked therefrom is one factor, which along with others, this tribunal would have to take into account in the overall assessment of the likelihood of confusion for the average consumer of the services in question⁷. Given my finding above, the following comments are obiter as it is not necessary for me to deal with this issue.

50 The Opponent submits that it uses multiple “MINT” formative marks, such as “MINTER”, “MINTSTYLE”, “MINT CREDIT SCORE”, “MINTFAMILY” and

⁷ See *Monster Energy Co v Glamco Co, Ltd* [2018] SGHC 238 at [76].

“MINTLIFE” in relation to its products. Consequently, the Opponent submits, a consumer who comes across the Application Mark is likely to assume erroneously that it is part of the Opponent’s family of “MINT” marks.

51 I have a few difficulties with the Opponent’s claim in this case:

(a) Firstly, I do not think that the Opponent should be permitted to argue that it has a family of “MINT” marks. This is because it had omitted to plead such a claim in its Statement of Grounds. If the Opponent seriously intended to pursue this claim, it should have indicated so at the first opportunity or applied to amend its pleadings to state so.

(b) Secondly, none of the “MINT” formative marks mentioned in [50] above are registered in Singapore. The Opponent submits that whether the marks in the family are registered or unregistered is not important. This is because the average consumer is unlikely to know if the marks are registered or not and consequently such information would not have a bearing on the state of consumer confusion. In the Opponent’s view, what must be considered is whether the marks have been used “such that it may be said that consumers are aware that the common element constitutes a family of marks” (*Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5 (“*Bridgestone*”) at [36]). I do not agree with the Opponent. Registration is a necessary requirement before this tribunal may consider a family of marks claim as unregistered marks are irrelevant for purposes of Section 8(2)(b) of the Act⁸. In any event, *Bridgestone* does not stand for the proposition that registration is not necessary. The marks relied on as a family in that case were in fact registered. This is clear from the decision at [34]:

The next question relates to what needs to be proven in order to establish a family of marks. Would registration of a number of marks bearing a common element give rise to a presumption that the common element constitutes a family of marks? In my view, the answer to this question is obviously a “no”. The mere fact that a mark is registered does not mean that it is used in the marketplace. Without use it cannot be established that consumers are aware that there is a common element within the marks owned by a single source which constitutes a family.

(c) Thirdly, the only evidence produced by the Opponent to support its claim to have a family of “MINT” marks is screenshots from its websites—mint.com and blog.mint.com showing that these marks are used by it. This alone, is insufficient to prove that consumers in Singapore are aware of the existence of a family of “MINT” marks. To affect the relevant consumer’s reaction to the Application Mark, the marks in that family must be proven to be evident to Singapore consumers. The Opponent’s evidence falls short of proving this.

52 As such, I would reject the Opponent’s family of marks claim if I am required to decide on this issue.

⁸ Unless the unregistered marks are well known in Singapore.

Conclusion on Section 8(2)(b)

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

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

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

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

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

Decision on Section 8(7)(a)

55 The necessary requirements to establish a passing off right are well established. They are, essentially, (1) goodwill, (2) misrepresentation, and (3) damage.

56 The Opponent's case on this ground is that use of the Application Mark would misrepresent that the Applicant's services originate from the Opponent or are economically connected to the Opponent.

57 I have found above that the Application Mark is more dissimilar than similar to the Opponent's Mark. As such, it cannot be said that the Applicant is making a misrepresentation that is sufficiently likely to deceive the relevant segment of the public into thinking that the Applicant's services are, or emanate from a source that is linked to, the Opponent's. It is thus not necessary for me to deal with whether the Opponent has the requisite goodwill in Singapore. Given that there is no misrepresentation, it also follows that there is no damage, or likelihood thereof, to the Opponent's goodwill.

Conclusion on Section 8(7)(a)

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

Overall Conclusion

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

Date of Issue: 1 November 2019