

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

Trade Mark No. 40201608455Q (International Registration Number: 1297792)  
Hearing Date: 6 August 2019

**IN THE MATTER OF A TRADE MARK APPLICATION BY  
  
GUANGZHOU PHARMACEUTICAL HOLDINGS LIMITED**

**AND**

**OPPOSITION THERETO BY**

**MULTI ACCESS LIMITED**

Hearing Officer: Anne Loo  
Principal Assistant Registrar of Trade Marks

Representation:

Mr Chua Shang Li (Donaldson & Burkinshaw LLP) for the Applicant

Mr Freddy Lim and Mr Chew Zhi Xuan (Lee & Lee) for the Opponent

**GROUND OF DECISION**

1 There is a popular Chinese saying that wealth does not pass three generations, but the progeny of the founder Mr Wong Chak Bong's 王老吉<sup>1</sup> herbal tea business appear to belie this. Mr Wong's herbal tea business began in 1853 during the Qing dynasty in China

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<sup>1</sup> Both the Opponent and the Applicant agree that the Chinese characters “王老吉” are referred to as “Wang Lao Ji” in Mandarin and “Wong Lo Kat” in Cantonese.

and has flourished over almost 5 generations. However, a long passage of time is never without complication and the series of events from within this time – from fissures in familial relationships to migration, to expansion of the business beyond the shores of China, and to changes in ownership – have brought the parties and their dispute before this Tribunal.

2 Guangzhou Pharmaceutical Holdings Limited (“the Applicant”) applied to protect the trade mark “WONGLO” (“the Application Mark”) in Singapore on 15 December 2015 under International Registration No. 1297792 (Singapore Trade Mark No. 40201608455Q) in Classes 5, 30 and 32. The goods of the application are indicated below:

Class 05:

Medicines for human purposes; medicinal drinks; drugs for medical purposes; syrups for pharmaceutical purposes; disinfectants; chemical conductors for electrocardiograph electrodes; cultures of microorganisms for medical and veterinary use; candy, medicated; dietetic foods adapted for medical purposes; candy for medical purposes; food for babies; chewing gum for medical purposes; depuratives; medicines for veterinary purposes; preparations for destroying noxious animals; surgical dressings; teeth filling material; medicinal jelly made from a variety of Chinese medicinal materials, called Gui Ling Gao in Chinese; medicated pollen cream for health.

Class 30:

Chicory [coffee substitute]; candy; chewing gum; longan syrup (Gui Yuan Gao) for food; syrup for food made with pears, tuckahoe, and fritillary (Ling Bei Li Gao); loquat leaf syrup (Pi Pa Gao) for food; honey; almond paste; bread; gruel; cereal preparations; starch for food; ice cream; milky tea, non-milk-based.

Class 32:

Beer; non-alcoholic beverages; soya-based beverages, other than milk substitutes; beverages based on beans; waters [beverages]; soda water; cola; fruit juices; beverages based on plants; syrups for beverages; preparations for making beverages.

3 The application was accepted and published on 26 May 2017 for opposition purposes. Multi Access Limited (“the Opponent”) filed its Notice of Opposition to oppose the registration of the Application Mark on 5 September 2017. The Applicant filed its Counter-Statement on 19 January 2018.

4 The Opponent filed evidence in support of the opposition on 30 July 2018. The Applicant filed evidence in support of the application on 30 November 2018. The Opponent filed evidence in reply on 8 April 2019. Following the close of evidence, the Pre-Hearing Review was held on 8 May 2019. The Opponent filed its written submissions (“Opponent’s WS”) on 5 July 2019 and the Applicant (“Applicant’s WS”) on 9 July 2019. The opposition was heard on 6 August 2019.

## Grounds of Opposition

5 The Opponent relies on Sections 8(2)(b), 8(4)(a) read with 8(4)(b)(i) 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 the following:
- (i) a Statutory Declaration made by Mr Chan Hung To, the Director of the Opponent on 25 July 2018 in Hong Kong (“Opponent’s 1<sup>st</sup> SD”); and
  - (ii) a Statutory Declaration in Reply made by the same Mr Chan Hung To on 4 April 2019 in Hong Kong (“Opponent’s 2<sup>nd</sup> SD”).

## Applicant’s Evidence

7 The Applicant’s evidence comprises a Statutory Declaration made by Mr Chen Zhizhao, Head of the Marketing Strategy Department of the Applicant on 26 November 2018 in China (“Applicant’s 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

### *The Opponent*



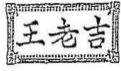
9 The Opponent is Multi Access Limited, a limited liability company incorporated in the British Virgin Islands. The Opponent states that it is the producer and seller of the famous 王老吉 Herbal Tea, also known as Wong Lo Kat Herbal Tea, which traces its lineage back to the Qing Dynasty in China.

10 The Opponent derives its title to the mark from the direct descendants of the originator of the 王老吉 Herbal Tea as declared at [4] to [29] of the Opponent’s 1<sup>st</sup> SD. In a nutshell, the 5<sup>th</sup> generation descendants. The Opponent registered the mark bearing the




Chinese characters 王老吉 on 27 September 1951 and the  mark on 12 December 1961, and say that these marks have been used in Singapore as early as the 1950s.

11 The Opponent has registered the following marks listed in [30] of the Opponent's 1<sup>st</sup> SD (collectively, *Opponent's Earlier Marks*):

TM No.	Mark (and transliteration where applicable)	Class	Specification of Goods/Services	Date of Completion of Registration
T9100470Z	 <p>The transliteration of the Chinese characters appearing in the Mark is "Wang Lao Ji"</p>	05	Herbal preparations for medical use.	31 August 1993
T9201709J	 <p>The transliteration of the Chinese characters appearing in the Mark is "Wang Lao Ji"</p>	30	Beverage (non-dairy based).	(not specified)
T1015997Z	<p>王老吉 </p> <p>The transliteration of the Chinese characters appearing in the mark is "Wang Lao Ji" which has no meaning</p>	05	Chinese medicine and herbs for medicinal use.	10 April 2018
		30	Non-medicated tea or herbal tea products, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt; mustard; vinegar; sauces (condiments); spices; ice.	
		33	Alcoholic beverages (except beers).	

TM No.	Mark (and transliteration where applicable)	Class	Specification of Goods/Services	Date of Completion of Registration
T1015996A	<p>王老吉</p> <p>The transliteration of the Chinese characters of which the mark consists is “Wang Lao Ji” which has no meaning</p>	05	Chinese medicine and herbs for medicinal use.	14 June 2018
		30	Non-medicated tea or herbal tea products, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt; mustard; vinegar; sauces (condiments); spices; ice.	
		33	Alcoholic beverages (except beers).	
T1015995C	WANG LAO JI	05	Chinese medicine and herbs for medicinal use.	5 July 2018
		30	Non-medicated tea or herbal tea products, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt; mustard; vinegar; sauces (condiments); spices; ice.	
		33	Alcoholic beverages (except beers).	
T1015993G	WONG LO KAT	05	Chinese medicine and herbs for medicinal use.	11 February 2018
		30	Non-medicated tea or herbal tea products, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and	

TM No.	Mark (and transliteration where applicable)	Class	Specification of Goods/Services	Date of Completion of Registration
			preparations made from cereals, bread pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt; mustard; vinegar; sauces (condiments); spices; ice.	
		33	Alcoholic beverages (except beers).	
T1118488I	 <p>The transliteration of the Chinese characters appearing in the mark is “Wang Lao Ji” which has no meaning.</p>	05	Chinese medicine and herbs for medicinal use; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.	18 January 2018
		29	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.	
		30	Non-medicated tea and herbal tea products (other than for medicinal use); coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder, salt, mustard; vinegar, sauces (condiments); spices; ice.	
		33	Alcoholic beverages (except beers).	

TM No.	Mark (and transliteration where applicable)	Class	Specification of Goods/Services	Date of Completion of Registration
		35	Advertising; business management; business administration; office functions; retail services in the field of Chinese medicine and herbs, pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, food for babies, plasters, materials for dressings, materials for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides, herbicides, tea or herbal tea related products, coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, beverages, preparations for making beverages, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages, meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, and alcoholic beverages.	

TM No.	Mark (and transliteration where applicable)	Class	Specification of Goods/Services	Date of Completion of Registration
T1208722D	<p>王 老 吉</p> <p>The transliteration of the Chinese characters of which the mark consists is “Wang Lao Ji” which has no meaning.</p>	05	Chinese medicine and herbs; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.	5 July 2018
		30	Non-medicated tea and herbal tea products (other than for medicinal use); coffee, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder, salt, mustard; vinegar, sauces (condiments); spices; ice.	
		33	Alcoholic Beverages (except beers).	

12 The Opponent states that it is the proprietor of the following trade marks which it collectively refers to as the “Opponent’s Family marks<sup>2</sup>” and state that these marks have been registered in numerous jurisdictions (Opponent’s 1<sup>st</sup> SD at [34]):

- a. WANG LAO JI
- b. WONG LO KAT
- c. 王老吉
- d. 王老吉 

<sup>2</sup> So as not to be confused with the concept of a “family of marks”, I shall refer to these as the Opponent’s Earlier Registered Marks.



13 The Opponent's Chinese character mark 王老吉 as well as its other registered marks are applied onto herbal tea and other drink products, which are produced in accordance to the founder Wong Chak Bong's secret formula. The Opponent claims that its products are amongst the more popular soft drinks in China and around the world.

14 The Opponent indicated that the 2014 revenue from the sale of goods bearing the Opponent's marks amounted to \$20,340.00 representing the export sale of approximately 1,130 cartons<sup>3</sup>.

*The Applicant*

15 The Applicant is an Enterprise group in China which is authorised by the Guangzhou municipal government to operate state-owned assets. The Applicant states that it is one of the largest health product companies in China, and is involved in scientific research, manufacture and trade relating to Chinese and western medicines, medicinal products, medical devices, food products and other related products.

16 The Applicant states that in 1997, it acquired ownership of the mark consisting of the Chinese characters “王老吉” and since then has been selling herbal tea products bearing the 王老吉 mark in regions including China and the USA. The Applicant's derivation of title is shown in the Applicant's SD at [6]-[7] and Exhibit A.

17 The Applicant disputes the Opponent's derivation of title set out in the Opponent's 1<sup>st</sup> SD at [4] to [29] save that in 1995, the Applicant granted a licence of use to Hung To (Holdings) Co, the Opponent's predecessor.

18 Revenue for the Wong Lo Kat herbal tea beverages globally and in Singapore are as follows:

<b>Year</b>	<b>Estimated Revenue</b>	<b>Global (including mainland China)</b>	<b>Singapore</b>
2013		8.94 Billion Yuan	30,769.23 Yuan
2014		9.12 Billion Yuan	326,620.51 Yuan
2015		8.45 Billion Yuan	914,220.52 Yuan
2016		7.80 Billion Yuan	294,800.00 Yuan
2017		8.62 Billion Yuan	799,300.00 Yuan

<sup>3</sup> It is not indicated what the cartons refer to. However, the supporting invoices and other documents lodged in the Opponent's 1<sup>st</sup> SD make reference to cartons of “canned herbal tea”.

19 The Applicant’s estimated advertisement expenditure globally and in Singapore are reflected in the table below:

<b>Year Estimated Revenue</b>	<b>Global (including mainland China)</b>
2013	479.86 Million Yuan
2014	467.33 Million Yuan
2015	342.59 Million Yuan
2016	379.29 Million Yuan
2017	602.47 Million Yuan

20 The Applicant has registered its marks, described in the Applicant’s SD at [12] as “WONG LO KAT marks and derivatives, including the WONGLO mark” in many jurisdictions, including Singapore. The Singapore registration is shown below:

<b>TM No.</b>	<b>Trade Mark and its transliteration</b>	<b>Class</b>	<b>Date of Application</b>
T0615045I	<p>王老吉 WONG LO KAT</p> <p>The transliteration of the Chinese characters appearing in the mark is "Wang Lao Ji" which has no meaning</p>	32 Beverages (non-alcoholic)	25 July 2006

21 The Applicant also declares that it has won numerous awards and accolades over the years as shown in the Applicant’s SD at [14].

### ***Preliminary Point***

22 There is concurrence as to the origin of the “王老吉” ( Wang Lao Ji/WONG LO KAT Chinese character) mark, the Opponent and the Applicant both agree that the founder of the brand is one Mr Wong Chak Bong (“Founder Wong”) during the Qing dynasty. Founder Wong’s secret herbal recipe for countering internal heat, influenza and a host of other ills, became widely known and popular and the secret formula was passed down to his descendants from generation to generation.

23 The Opponent and the Applicant are not on the same page beyond the 2<sup>nd</sup> generation ownership of the mark. The Opponent states that one of the 3<sup>rd</sup> generation descendants of

Founder Wong crossed over from mainland China to Hong Kong in order to set up the 王老吉 herbal tea business there.

24 The Opponent submits in its written submissions (“Opponent’s WS”) that the Applicant does not provide a clear chain of title to the marks and as such, the Applicant’s alleged right to the marks is murky and unclear.

25 The Opponent has, in a neatly set out chronology in the Opponent’s 1<sup>st</sup> SD at [26], clearly traced the Opponent’s chain of title from 1821 to date. Save that the Applicant says that it disputes the Opponent’s derivation of title as set out, there is no other reason or evidence tendered by the Applicant to throw doubt on its veracity. The Applicant in the Applicant’s SD at [15] to [58] has set out its chronology of the ownership of the 王老吉 mark from the years post the founding of the People’s Republic of China, that is from 1956 to date.

26 The Applicant’s chain of title from the descendants of Founder Wong to Guangzhou Pharmaceutical Holdings Limited is supported by the various documents and their translations filed in the Applicant’s SD. The relevant documents include:

<b>Date</b>	<b>Document Type</b>	<b>Issued to</b>
26 July 1955	Health business licence issued by Guangzhou Municipal Health Bureau for herbal tea	Trade Name: Wanglaoji, Manager: Wang Baotian
1 June 1956	Notice of Factory Merge	Original factory name: Wanglaoji Factory to Wanglaoji United Pharmaceutical Factory
30 Sept 1959	Provisional licence for the production and sales of patent Medicines of Guangzhou Municipal Health Bureau for Wanglaoji herbal tea	Production Unit: Wanglaoji United Pharmaceutical Factory
30 Sept 1959	Provisional licence for the production and sales of patent Medicines of Guangzhou Municipal Health Bureau for “Colds cough tea”	Production Unit: Wanglaoji United Pharmaceutical Factory
20 August 1966	Reply from Guangzhou Municipal Chemical Industry Bureau on change of factory name	Approval for Wanglaoji to change its name to Guangzhou Traditional Chinese Medicine No. 9 Factory

Date	Document Type	Issued to
29 September 1981	Notice on restoring and changing the names of some pharmaceutical factories by Health Department of Guangdong Province Administration for Industry & Commerce of Guangdong Province, Medical Administrative Bureau of Guangdong Province	Guangzhou Traditional Chinese Medicine No. 9 Factory changed to Guangzhou Yhangcheng Pharmaceutical Factory
4 February 1982	Reply from Guangzhou Municipal Economic Commission on the Establishment of Tonic Factories by Guangzhou Qixing Pharmaceutical Factory and Guangzhou Yangcheng Pharmaceutical Factory	Allowing Guangzhou Qixing Pharmaceutical Factory and Guangzhou Yangcheng Pharmaceutical Factory to establish Guangzhou Qixing Tonic Factory and Guangzhou Yangcheng Tonic Factory
14 September 1992	Reply from Guangzhou Municipal Economic System Reform Committee regarding the approval of the Establishment of Guangzhou Yangcheng Pharmaceutical Limited Company	Guangzhou Yangcheng Pharmaceutical Factory allowed to be reorganised into Guangzhou Yangcheng Pharmaceutical Limited Company
28 August 1997	Assignment of the 王老吉 (Wang Laoji in Chinese characters) mark, registration no. 626155 from Guangzhou Yangcheng Tonic Factory to Guangzhou Pharmaceutical Holdings Limited	Guangzhou Pharmaceutical Holdings Limited

The documents tendered show that the Applicant is the owner of the trade mark 王老吉 (Wang Laoji in Chinese characters) mark as the mark was assigned to them in 1997 by Guangzhou Yangcheng Tonic Factory. Guangzhou Yangcheng Tonic Factory was set up by Qixing Pharmaceutical Factory and Guangzhou Yangcheng Pharmaceutical Factory in 1992.

27 Having examined the documents filed in evidence by both the Opponent and the Applicant and on the face of the documents, I am satisfied that both have legitimately derived title.

## MAIN DECISION

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

28 Section 8(2)(b) provides as follows:

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)*

29 The law in relation to Section 8(2)(b) is well-established. The Court of Appeal's decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 ("*Staywell*") reaffirmed that it is the "*step-by-step*" approach that is to be applied.

30 The three requirements that will have to be assessed systematically under the step-by step approach may be summarised as follows:

- (i) the first element is to assess whether there is identity or similarity of the respective marks;
- (ii) 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; and
- (iii) the third element is to consider whether there exists a likelihood of confusion arising from the two similarities.

31 The Court of Appeal in *Staywell* made it clear, at [15], that "*the first two elements are assessed individually before the final element which is assessed in the round*". If, for any one step, the answer is in the negative, the inquiry will end, and the opposition will fail. However, if the first two threshold elements have been met, the issue of the likelihood of confusion arises and the inquiry must be made into (a) how similar the marks are; (b) how similar the services are; and (c) given this, how likely the relevant segment of the public will be confused (*Staywell* at [55])

### *Assessment of Marks Similarity*

32 In assessing the marks for similarity, the following principles from *Staywell* at [15] to [30] and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [40] ("*Hai Tong*") apply:

- (i) Comparison between two competing marks is mark-for-mark - between the mark applied for and the earlier mark - and as a whole, without consideration of any

external matter. The Court of Appeal in *Staywell*, states at [20] that “*this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods*”.

(ii) The marks are to be compared with regard to three aspects of similarity – visual, aural and conceptual. There is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar. The three aspects of similarity are but signposts meant to guide in the marks-similarity inquiry. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. Ultimately, the conclusion will have to be made as to whether the marks, when observed in their totality, are similar rather than dissimilar. *Staywell* at [17] states that the “*reality [is] that the similarity of marks is ultimately and inevitably a matter of impression than one that can be resolved as a quantitative or mechanistic exercise.*”

(iii) Technical distinctiveness is an integral factor in the marks-similarity inquiry. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.

(iv) While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness.

(v) The comparison is made from the perspective of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

(vi) The average consumer, however, is assumed to possess “imperfect recollection” and cannot be expected to compare the contesting marks side by side and examine them in detail for the sake of isolating particular points of difference. Instead, it is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

### ***Distinctiveness***

33 I am mindful of the Court of Appeal’s reiteration 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 is not a separate step within the marks-similarity inquiry. However, I will consider distinctiveness of the Opponent’s mark as a separate step and then apply these considerations within the context of the mark-similarity analysis, following the approach of the Court of Appeal in *Hai Tong* at [26].

34 The Opponent has a number of earlier trade marks but for the purpose of these proceedings (see [11] above), relies on its mark T1015993G for WONG LO KAT (I will

refer to this as the “Opponent’s Mark”) as its primary earlier trade mark for the purpose of this proceeding. The Opponent’s Mark is registered for goods in classes 5, 30 and 33. At the oral hearing, counsel for the Opponent indicated that the rest of the Opponent’s Earlier Registered Marks would be referred to in order to show how these marks are used on the goods in the market and would be relevant insofar as the marks are used in this context.

35 On the issue of distinctiveness, the Opponent argues that the Application Mark **WONGLO** consists entirely of the letters which make up the first 2 words in the Opponent’s Mark **WONG LO KAT**. The letters in “WONGLO” which make up the entirety of the Application Mark and the first two parts of Opponent’s Mark, form the essential and dominant part of the Opponent’s Mark and ought to be given special attention in the consideration for mark similarity. Further, because of the common denominator between the two competing marks, it is important to look at the differences between the marks and determine whether the challenged mark is able to distinguish itself sufficiently and substantially.

36 The Applicant submits that the Opponent’s Mark may be perceived as a personal name and is not particularly intrinsically distinctive. Hence in the absence of other elements (such as its corresponding Chinese character or other stylisations) in the Opponent’s Mark, the Applicant does not have to cross a high threshold to show that Application Mark is dissimilar to the Opponent’s Mark. The Applicant says that the Opponent’s Mark has no intrinsic distinctiveness and also has not acquired distinctiveness in light of the scarce evidence filed in the Opponent 1<sup>st</sup> SD.

37 The Court of Appeal in *Staywell* at [23]-[24] sets out the two different aspects of “distinctiveness” in trade mark law:

- (i) Distinctiveness in the ordinary and non-technical sense – this refers to what is outstanding and memorable about the mark that tends to stand out in the average consumer’s imperfect recollection.
- (ii) Distinctiveness in the technical sense which refers to the capacity of a mark to function as a badge of origin. This can be either inherent or acquired distinctiveness. Inherent distinctiveness is where the words in the mark are meaningless and can say nothing about the goods or services. Acquired distinctiveness is one where words do have a meaning and might well say something about the good or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use.

38 In the distinctiveness enquiry, I will first look at the distinctiveness of components or elements of the Opponent’s Mark and the Application Mark in comparison. Thereafter, I will look at the distinctiveness of the earlier mark as a whole, bearing in mind that “the finding of distinctiveness of the separate components of the mark must ultimately be related back to the impression given by the mark as a whole.” I am also mindful that in the assessment of the distinctive and memorable components, an average consumer “only rarely has the chance to make a direct comparison between the different marks and must place his trust in the imperfect picture of them that he has in his mind” (*Lloyd Schuhfabrik*

*Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97) [1999] 2 CMLR 1343 (“Lloyd”) at 1358 and *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 at [50]).

*The distinctive components of the Opponent’s Mark and the Application Mark*

39 Both the Opponent’s Mark and the Application Mark are plain word marks printed in block letters, without devices or other form of embellishment. The font used may be different (this was not raised or pursued by either of the parties) but the difference is not remarkable. In both the marks, each of the letters in the respective marks is of equal size.

40 The Opponent submits that given that “WONGLO” makes up the majority of the Opponent’s Mark, it is clearly an essential and dominant feature of the Opponent’s Mark. The Opponent goes further to say that “WONGLO” is the common denominator of both marks. I am not able to accept this view because the Opponent’s Mark is made up of three distinct elements “WONG”, “LO” and “KAT”, the elements being separated by a space in between. The actual form in which the Opponent’s Mark is presented does not support the Opponent’s argument that the first two words are the essential and dominant part and should enjoy a high level of protection given its distinctiveness and non-descriptiveness in relation to the goods.

41 I do not find that there is any particular feature of the Opponent’s Mark that stands out. I am of the view that although the individual elements “WONG”, “LO” and “KAT” are not descriptive of the goods of the Opponent’s Mark, I cannot conclude that any element is more dominant or distinctive compared to the others. Each element is presented in identical plain block letters of equal size, thickness and colour, and none of the elements is more embellished than the others. Hence, I am not able to agree with the Opponent’s submission that the first two elements of its mark are the essential and dominant elements of the mark. I cannot see how one or even two of the three elements should be set apart from the others to be given special regard and receive a higher level of protection.

42 With respect to the Application Mark which is a single word with 2-syllables, and which is presented in plain block letters of equal size, thickness and colour, there is similarly no component that dominates which would be memorable to stand out in the consumer’s imperfect recollection.

43 I am guided by *Staywell* at [29] and having considered the distinctiveness (or lack thereof) of the separate elements in the Opponent’s Mark, I must look at the mark as a whole and assess what impression is given by the mark. Would the sum of the individual elements in the Opponent’s Mark have sufficient distinctiveness such that it has “a flavour of that which is unusual (or stands out in a crowd) and is therefore easy to recognise and to remember”<sup>4</sup>?

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<sup>4</sup> Lord Walker in *BUD and BUDWEISER BUDBRÄU Trade Marks* [2003] RPC 25 at [39] in his description of distinctiveness in the non-technical sense.



44 The Applicant acknowledges that the Opponent’s Mark is the common name of the founder of the herbal tea, Mr Wong Chak Bong. However, the Applicant argues that personal names are not particularly distinctive, citing the cases of *Kenzo v Tsujimoto Kenzo* [2013] SGIPOS 2 (“*Kenzo*”) at [36]-[42], and *Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd* [2014] SGIPOS 11 (“*Taylor*”) at [48]-[54]. In *Kenzo*, it was held at [40] that the “average member of the public in Singapore is equally likely to construe the word “KENZO” as a personal name of Japanese origin, as much as a sign that may serve as a badge of origin”. Evidence in that case was lodged to show that the name “Kenzo” was used in relation to a number of live business entities in Singapore. Similarly, in *Taylor*, the name “Taylor” was perceived as a personal name *not uncommonly* used in Singapore, and the Hearing Officer assessed the Opponents’ Mark “Taylor’s” as not particularly distinctive, based on evidence that the name was used as the trading name of a number of live business entities in Singapore.

45 There is a difference between the cases of *Kenzo* and *Taylor*, and the present matter. I am of the view that the impression of the Opponent’s Mark taken as a whole is that it is a *personal full name* as opposed to a personal name. More precisely, the Opponent’s Mark stands out as a personal *Chinese full name*. Unlike their Western counterparts, the Chinese follow a different naming convention for the giving of personal full names. Generally, the personal Chinese full name is made up of 2 components: – the surname or *xing* (姓) and the given name or *ming* (名) or *mingzi* (名字). The given name is more often than not, disyllabic, comprising a generational name and a chosen name. A generational name is the common name shared by one’s siblings and paternal cousins of the same sex, and who are within the same generation. The chosen name is the name selected for a child by its parents or elders and is often a Chinese character which imbues the virtues, qualities and aspiration that the elders hope the child will have. The surname always precedes the generational name and the chosen name, and this is to emphasize that the family comes first in an individual’s identity. An example may be used from the table showing the chronology of events at page 10 of the Opponent’s 1<sup>st</sup> SD. Founder Wong’s three sons are named in the chronology as follows:

“Wong Kwai Shing (王貴成)”

“Wong Kwai Chang (王貴祥)”

“Wong Kwai Fa (王貴發)”

As can be seen from the above names, the surname or the family name is “Wong”. The generational name is “Kwai” - this name is shared by the Founder’s sons which shows that they are of the same generation. The chosen names for the Founder’s sons are “Shing”, “Chang” and “Fa”.

46 The distinctiveness of a full name in a mark is observed by Susanna H S Leong, in *Intellectual Property Law of Singapore (Academy Publishing, 2013)* at para 28.143:

“In general, a *full name*, by its nature, is better able to distinguish goods or services of one undertaking than a name or surname. Therefore a *full name*, unless it is extremely common and the number of traders involved in the relevant trade is very

large, is likely to succeed in an application for trade mark without evidence of factual distinctiveness.” [emphasis mine]

47 The paragraph relates to distinctiveness of trade marks in relation to sections 7(1) and 7(2) of the Trade Marks Act, but it is instructive in the distinctiveness inquiry at hand. Full names it would suggest, when used as trade marks, will automatically imbue the mark with the capacity to distinguish, subject to whether the full name is deemed extremely common or whether it is used in a trade where there is a large number of traders.

48 I am of the view that the Opponent’s Mark being a personal full name is one that is capable of distinguishing the Opponent’s goods and can be said to possess technical inherent distinctiveness.

*Acquired distinctiveness*

49 In order to assess the level of technical distinctiveness of the Opponent’s Mark, it will be prudent to look at the Opponent’s evidence to decide whether the Opponent’s Mark has acquired distinctiveness from use or advertising and brand promotion exercises. I am aware that there is still some contention as to whether such evidence may be considered at the marks-similarity stage and this issue has been discussed at [41] to [48] by the IP Adjudicator in *Monster Energy Company v NBA Properties, Inc* [2018] SGIPOS 16 (“*NBA Properties*”).<sup>5</sup> I agree with the IP Adjudicator who states at [46] of *NBA Properties*:

In my view, how the average consumer *understands* what he *sees* (which is the essence of the mark-similarity analysis) must necessarily depend on *what he knows*. As such, the knowledge of the average consumer, and *how* he is likely to *understand* or *interpret* the word device element of a composite mark, must be relevant to mark-similarity assessment. What words (or images, for that matter) *mean* to the average consumer must be evaluated contextually. It follows that the parties should be permitted to adduce evidence of those surrounding circumstances that are relevant towards establishing the general knowledge possessed by the average consumer. To consciously ignore this context would entail the adoption of a highly contrived, and artificially blinkered, approach towards mark-similarity assessment that is incompatible with the commercial realities within which the trade mark regime operates.

Hence, for the purposes of establishing if the Opponent’s Mark has in fact acquired distinctive character, I will assess the Opponent’s evidence.

50 The Opponent submitted that it has used and promoted its marks in Singapore and internationally continuously and substantially. In support of this, the Opponent points out

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<sup>5</sup> In *Monster Energy Company v Glamco Co, Ltd* [2018] SGHC 238 at [51], the High Court considered, albeit *obiter*, acquired distinctiveness at the mark similarity stage without any discussion on this issue. The decision in *Monster Energy Company v Glamco Co, Ltd* [2018] SGHC 238 is on appeal to the Court of Appeal

that its marks have been registered and used in Singapore since 1991 and state that earlier versions of the Opponent's marks have been registered as early as 1951.

51 The Applicant stressed that the Opponent has not adduced sufficient evidence to show that its mark has acquired distinctiveness. The Applicant points out that there is a dearth of evidence showing the promotion, use, and recognition of the Opponent's Mark.

52 I now look at the Opponent's evidence of use collectively filed as CHT-9 in [36] Opponent's 1<sup>st</sup> SD at pages 277 to 286. I have distilled the evidence filed into the table below:

S/n	Date	Document type	Issued to	Goods indicated	Amount
1	30 January 2014	Invoice by JDB Hangzhou Limited of Units 3806-10, 38F Cosco Tower, Grand Millenium Plaza , 183 Queens Road Central, Hong Kong	CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	1,296 cartons of Wang Lao Ji Can Beverage	USD 12,052.80
2	30 January 2014	Invoice no. INVSG-002 made by Wing Tung Drinks (Malaysia) Sdn Bhd	CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	1,296 cartons of "Wong Lo Kat Canned Herbal Drink"	USD 12,052.80
3	30 January 2014	Packing list made by Wing Tung Drinks (Malaysia) Sdn Bhd in relation to Invoice no. INVSG-002	CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	1,296 cartons of "Wong Lo Kat Canned Herbal Drink"	(no price indicated)
4	18 February 2014	(Not clear from the copy what type of document this is) By Wing Tung Drinks (Malaysia) Sdn Bhd	CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	1,296 cartons of "Wong Lo Kat Herbal Tea 300ml Drink"	(price column blacked out)

S/n	Date	Document type	Issued to	Goods indicated	Amount
5	18 February 2014	(Not clear from the copy what type of document this is) By Wing Tung Drinks (Malaysia) Sdn Bhd	CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	1,296 cartons of “Wong Lo Kat Herbal Tea 300ml Drink”	20,023.20 (currency not stated)  Note: The documents nos. 4 & 5 appear to be the same document as both bear the same number WT000425 on the top left of the document. Other indications such as signatures and stamps are identical and appear in exactly the same position on both the documents
6	20 February 2014 (2 pages)	Invoice No 21450202 “Shipping Description” Consignee/shipper - Wing Tung Drinks (Malaysia) Sdn Bhd Consigner/consignee reference: INVSG-002 Corresponding Delivery Order no: 50698 Light/Vessel/Lorry No: BJH 9720	CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	12 pallets (1296 cartons) of “WONG <u>LOMKAT</u> ” canned herbal drink (*presumably a spelling error in the name)	SGD2963.21

S/n	Date	Document type	Issued to	Goods indicated	Amount
		Document stamped by TONG CARRIAGE			
7	20 February 2014 (3-page document stamped date by the Singapore Immigration and Customs Authority)	Delivery order Cargo Clearance Permit Port of loading indicated as “Kuala Lumpur” in name of MY JDB HERBAL TEA Conveyance reference No: BJH 9720	Released to CHINA FOODS PTE LTD of No 1 Playfair Road, Singapore 367981	Consignment details indicate the goods as “WONG LO KAT Canned Herbal Drink (Herbal Tea)” Quantity – 1296 cartons	-

53 A total of 7 documents were filed in the Opponent’s 1<sup>st</sup> SD. A closer perusal shows that:

- (i) The second and third documents in the table relate to the same invoice number (Invoice No. INVSG-002).
- (ii) Similarly, the fourth and the fifth documents in the table are one and the same, the difference being that the fourth document has its pricing column blacked out.
- (iii) The sixth document in the table bears the header “Shipping Description” and makes a reference to Invoice No INVSG-002.
- (iv) The seventh document is not an invoice but a cargo clearance permit and the particulars of the permit match the particulars in the sixth document: the consignee’s name, the number of cartons imported into Singapore, the mode of transport of the goods from Malaysia to Singapore (via the same vehicle bearing the licence plate BJH 9720).

54 Hence, the sum total of the Opponent’s evidence of use is a mere 3 invoices for the year 2014. I also note that the Opponent at [36] Opponent’s 1<sup>st</sup> SD indicated that the sales revenue of the Opponent’s products in 2014 is about \$20,340.00, representing an export sale of around 1,130 cartons. This does not appear consistent with the evidence filed. As an example, the invoice dated 30 January 2014 issued by JDB Hangzhou Limited to China Foods SG shows that a total of 1,296 cartons were exported into Singapore amounting to USD 12,952.80 (approximately SGD16,510.93, using the prevailing rate of 1 USD to SGD1.2747 as at 30 January 2014<sup>6</sup>).

55 The Opponent also mentions “sale of Opponent’s products in Singapore” but the invoices tendered (see table above) only support the import of the products into Singapore and not any other form of sales, for example, retail trade.

<sup>6</sup> Source: XE Corporation at [www.xe.com](http://www.xe.com)

56 It bears noting that the Opponent did not disclose any evidence of advertising figures in Singapore in relation to the Opponent's mark on the goods. Save for the exhibits in the Opponent's evidence showing "iterations of the packaging used for the Opponent's famous canned drink product over the years" (Opponent's 1<sup>st</sup> SD at [29] and pages 242 to 245), there are no invoices for advertisement or promotion of the Opponent's marks.

57 I find it disconcerting that the Opponent has taken pains to highlight the long and illustrious history of its mark then tenders 7 documents - which upon closer inspection, effectively translates into only 3 invoices showing the import of its goods into Singapore - to support its claim of use. The low number of invoices aside, I also note that these invoices all relate to transactions made within one single month in 2014, that is between 30 January to 20 February 2014.

58 I therefore assess that the Opponent's evidence in relation to acquired distinctiveness falls short of establishing that the Opponent's Mark has in fact acquired distinctive character.

59 I conclude therefore that the Opponent's Mark has no dominant element or component, but as a whole, it has some inherent distinctiveness by virtue of being a personal full name. However, it does not have the acquired distinctiveness that gives it greater technical distinctiveness.

### *Marks Similarity*

60 With the finding on distinctiveness, I now move on to the step-by-step approach and well-established principles for the assessment of mark-similarity, with the reiteration of the Court in *Staywell* at [26] which states that the "visual, aural or conceptual 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"

61 Applying the step-by-step approach and well-established principles for the assessment of mark-similarity, I will first consider whether there is visual, aural and conceptual similarity between the marks.

### *Visual Similarity*

62 For ease of reference, the Opponent's and the Applicant's marks are reproduced below:

Opponent's Mark	Application Mark
WONG LO KAT	WONGLO

63 When comparing the visual similarity of two word marks, the following are considered:

- (a) The length of the marks
- (b) The structure of the marks, i.e. whether there are the same number of words
- (c) Whether the same letters are used in the marks

64 From my earlier inquiry into distinctiveness of the marks, I have concluded that there is no feature or element that is dominant in the Opponent's Mark. Hence, I will compare the marks as wholes without any special regard to any element in the competing marks.

65 The Application Mark is a single word mark made up of 6 letters, whereas the Opponent's Mark is a 3-word mark with 9 letters and the 9 letters are spread out in a 4-2-3 formation over the 3 words. The 6 letters in the Application Mark correspond to the first 2 words of the Opponent's mark. The fact that the letters in the Application Mark correspond to the Opponent's Mark does not point to a definite conclusion of visual similarity. Whilst this exercise of comparing the length, structure and letters of the marks is useful for the visual-similarity inquiry, ordinary consumers of goods rarely will have the opportunity to put two competing marks side-by-side and to compare them.

66 The Opponent states that the element "KAT" is minor and insubstantial, given that the dominant feature of the marks is "WONGLO". I do not agree with this submission. The structure of the Opponent's mark clearly shows that it is a 3-word mark. A common and known surname "WONG" precedes the second and third words "LO KAT". Seen as a whole, the average consumer with an imperfect recollection will remember the Opponent's Mark as a Chinese full name: "WONG LO KAT". The element "KAT" can hardly be considered insubstantial or minor. The Application Mark on the other hand is a one-word mark "WONGLO", which has no meaning and will be perceived as an invented word.

67 In conclusion, I find that that the Opponent's Mark is more visually dissimilar than similar to the Application Mark.

#### *Aural Similarity*

68 The Court of Appeal in *Staywell* stated at [31] and [32] that there are two approaches to the inquiry into aural similarity:

- (i) Consider the dominant component of the marks to assess whether the competing marks are aurally similar as wholes ("Dominant Component Approach")
- (ii) Undertake a quantitative assessment as to whether the competing marks have more syllables in common than not ("Quantitative Assessment Approach").

69 Having concluded the inquiry into distinctiveness that the marks do not possess a distinctive or dominant component, I will approach the inquiry into aural similarity based on the Quantitative Assessment Approach.

70 The Opponent submits that whilst the Application Mark consist of 2 syllables to the Opponent's 3, the 2 syllables correspond exactly to the first 2 of the 3 syllables in the Opponent's mark. The average consumer in Singapore would therefore pronounce "WONGLO" in the Application Mark in a similar if not identical manner to the Opponent's Mark WONG LO KAT. The average consumer in Singapore with imperfect recollection is also likely to slur and/or carelessly pronounce the "WONG" and "LO" such that there would be no discernible aural distinction between "WONG LO" and "WONGLO", difference in spacing notwithstanding.

71 The Applicant states that the Application Mark consists of a single word with 2 syllables, whereas the Opponent's Marks consists of 3 words with 3 syllables. Additionally, the syllable in the Opponent's Mark is the word "KAT", which starts with a cacophonous "K" consonant sound and ends with a plosive "T" sound, and is easy to pronounce. It will be equally vocalised as the other syllables and not under-enunciated. The additional syllable "KAT" hence changes the sound of the mark considerably such that it will be distinguished from the Application Mark.

72 In the quantitative assessment of the Opponent's Mark and the Application Mark, I will first look at the syllables present in the competing marks. The Opponent's Mark has 3 syllables "WONG – LO – KAT" whilst the Application Mark has 2: "WONG-LO" or "WON-GLO" depending on where the reader puts the emphasis when reading through the word.

73 It bears reiterating that the Opponent's Mark is made up of three discreet words "WONG", "LO" and "KAT" whereas the Application Mark is a single word "WONGLO". Hence, the enunciation of the Opponent's Mark is likely to have slight pauses in between each of the syllables, given the spacing between the words. The Court of Appeal in *Hai Tong* at [68] gives guidance here and states:

“...[t]he syntax of the marks or signs being compared is also considered. Hence, it is relevant to consider the total number of syllables in each mark or sign concerned and ascertain whether there is a pause in the reading of the mark or sign, as when a mark or sign is made up of two discrete words (see *Ozone Community* at [14] and *Intuition Publishing* ([30] *supra*) at [54]).”

74 The Application Mark on the other hand is a single word which could either be enunciated as "WON-GLO" or "WONG-LO". The former enunciation is reasonable given that many words with the "G-L" consonant blend preceding a vowel are enunciated in this manner. Examples of some of such words include "ENGLISH", "TANGLE", "SINGLY", "UNGLOVE" AND "BUNGLER".

75 Besides the number of syllables in each mark, the Applicant submits that it would be difficult to under-enunciate the additional syllable "KAT" in the Opponent's Mark which "starts with a cacophonous "K" consonant sound and ends with a plosive "T" sound." The Opponent on the other hand submits that there is a tendency for the words to be slurred or otherwise carelessly pronounced.



76 I find that there is a very low tendency for the ending of the Opponent’s WONG LO KAT mark to be slurred. The mark ends with the word “KAT” – a word that begins with a harsh “K” sound and ending with an equally hard “T” sound. This may be distinguished from the ending of the Application Mark which elicits the euphonious “ou” sound as opposed to a plosive “T” sound.

77 In light of the above, applying the Quantitative Assessment Approach, I find therefore that the Opponent’s Mark is more aurally dissimilar than similar to the Application Mark.

#### *Conceptual Similarity*

78 The inquiry into conceptual similarity “seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole” (*Staywell* at [35], affirmed in *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2017] 2 SLR 308 (“*Caesarstone*”) at [48]).

79 The Opponent argues that conceptually, the Application Mark and the Opponent’s Wong Lo Kat Mark are similar if not identical. Both marks are intended to reference Mr Wong Chak Bong, the creator of the famous 王老吉 or Wong Lo Kat herbal tea. The Applicant accepts that the name “Wong Lo Kat” was itself derived from Mr Wong Chak Bong, being a combination of his surname “Wong” and his nickname “Ah Kat”.<sup>7</sup> As such, there is no question that the Application Mark and the Opponent’s Wong Lo Kat Mark give off the same underlying idea, and are thus conceptually similar, if not identical. To support its argument further, the Opponent also made reference to a statutory declaration filed by Mr Chen Zhizhao in an earlier invalidation proceeding before the Registrar to support its argument that the Applicant’s mark is derived from and inspired by the name of the creator of the Wong Lo Kat herbal tea.

80 The thrust of the Opponent’s arguments on conceptual similarity hinges strongly on the derivation of the Chinese mark 王老吉 mark and is based on the Chinese mark’s historical background. The Applicant does not agree with the Opponent’s submission that the average consumer will perceive that the Application Mark and the Opponent’s Mark originate from the same source. Ordinary consumers have no such background when faced with the marks in the market.

81 It bears stating again that *Staywell* provided at [20]: ... “that the assessment of marks similarity is mark-for-mark without consideration of any external matter”: see *Mediacorp* at [33], *Sarika* at [17] and *Hai Tong* at [40(b)] Historical background about a mark’s derivation is external matter which should not be considered in this inquiry. In any event, it is difficult to see how an average consumer will have access to this historical information when purchasing the goods.

82 In my view, the ideas suggested by the Opponent’s Mark WONG LO KAT and Application Mark WONGLO are different. To an average consumer, the Opponent’s Mark will evoke the idea of a Chinese person with the surname of “Wong” and having the given

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<sup>7</sup> Applicant’s SD at [4]

name “Lo Kat”. On the other hand, the Application Mark WONGLO is a meaningless word; the average consumer who looks at the word will recognise that it is not a known English word and will perceive it to be an invented word.

83 I find therefore that the Opponent’s Mark is conceptually dissimilar to the Application Mark.

*Conclusion on Marks-Similarity*

84 I have found that the competing marks are (a) visually more dissimilar than similar; (b) aurally more dissimilar than similar and (c) conceptually dissimilar. I find therefore that overall when observed in their totality, the Application Mark is more dissimilar rather than similar to the Opponent’s Mark.

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

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

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

86 Sections 8(4)(a) and 8(4)(b)(i) of the Act read:

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

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered –
  - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark;

...

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

87 In order to succeed under this ground of opposition, the Opponent has the burden of establishing the following:

- (i) The whole or an 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) The use of the Application Mark in relation to the goods claimed would indicate a connection with the Opponent
- (iv) The use of the Application Mark would damage the interests of the Opponent

88 Under Section 8(4), the preliminary element to be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark". If this element is not made out, the ground of opposition under any limb of Section 8(4) will fail. Although the relevant wording of Section 8(4) is different from that found in Section 8(2)(b), the High Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [146] has made it clear that there is no material difference between the marks-similarity enquiry under Section 8(2)(b) and Section 8(4) of the Act.

89 I have already found that the Opponent's Mark is dissimilar rather than similar to the Application Mark (see [32] to [84] above). For the same reasons, I find that the whole or essential part of the Application Mark is not identical with or similar to the Opponent's Mark under Section 8(4). Since the Opponent has not satisfied the essential element of marks-similarity here, it will not be necessary for me to consider the remaining elements, and the ground of opposition under the limbs of Section 8(4) therefore fails.

90 In any event, even if my finding on marks-similarity is wrong, based on the conclusions reached in respect of the use of Opponent's mark at [49] to [59] above, the Opponent will not be able to support its claim that the Opponent's Mark is a well known earlier trade mark under Section 8(4).

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

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

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

92 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)***

93 To succeed on the ground of opposition under Section 8(7)(a), an opponent must establish the classical trinity of goodwill, misrepresentation and damage (*Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 at [36]; *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [80]).

94 I have earlier found that the Opponent's Mark is dissimilar rather than similar to the Application Mark at [32] to [84] above, and that there is no likelihood of confusion under Section 8(2)(b) of the Act. Accordingly, misrepresentation for the purpose of passing off - that which would lead or be likely to lead the public into believing that the goods of the Application Mark are the goods of the Opponent - cannot be established. Similarly, if misrepresentation cannot be established, it follows that the element of damage cannot be made out.

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

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

**Overall Conclusion**

96 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. Protection in Singapore is conferred on International Registration No. 1297792 (Singapore Trade Mark No. 40201608455Q). The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 1 November 2019

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