

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

Trade Mark No. T1206670G (International Registration No. 985168)
Hearing Date: 21 November 2019

**IN THE MATTER OF TRADE MARK REGISTRATION
IN THE NAME OF
DR. AUGUST WOLFF GMBH & CO. KG ARZNEIMITTEL
AND
APPLICATION FOR DECLARATION OF INVALIDITY
THEREOF BY
COMBE INTERNATIONAL LTD**

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

Representation:

Ms Amanda Soon (Allen & Gledhill LLP) for the Applicant

Ms Ruby Tham and Mr Edsmond Cheong (Drew & Napier LLC) for the Registered Proprietor

GROUND OF DECISION

1 Dr. August Wolff GmbH & Co. KG Arzneimittel is the Registered Proprietor (“the Proprietor”) of the following trade mark in Singapore:

Vagisan

(“the Subject Mark”)

The Subject Mark is a Singapore designation of IR No. 985168 and was registered on 19 March 2012 (“the Relevant Date”) under Trade Mark No. T1206670G (in Classes 3 and 5) with the following details:

Trade Mark No.	Application Date	Class
T1206670G	19 March 2012	3 and 5
Specification		
Class 3 Soaps, perfumery, essential oils, cosmetics, hair lotions.		
Class 5 Pharmaceutical products, sanitary products for medical purposes; dietetic substances for medical purposes.		

2 Combe International Ltd (“the Applicant”) applied for a declaration of invalidity on 14 November 2017. The statement of grounds annexed to the application was amended on 5 December 2017 and further amended on 14 December 2017. The Counter-statement was filed by the Proprietor on 14 February 2018 in defence of the registration of the Subject Mark. The Applicant filed evidence in support of its Application on 27 August 2018. The Proprietor filed evidence in support of the registration on 27 February 2019. The Applicant filed evidence in reply on 24 May 2019. Following the close of evidence, leave was granted to the Applicant to file supplementary evidence, and it did so on 23 August 2018. The parties filed their written submissions on 21 October 2019. I heard parties who made oral submissions before me on 21 November 2019.

Grounds of Invalidation

3 The Applicant relies on three grounds in the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). They are Section 23(3)(a)(i) read with Section 8(2)(b) of the Act, Section 23(3)(a)(iii) read with Section 8(4)(b)(i) of the Act, and Section 23(3)(b) read with Section 8(7)(a) of the Act.

Applicant’s Evidence

- 4 The Applicant’s evidence comprises the following:
- (a) a statutory declaration made by Trevor David Norman, General Manager of Combe Asia Pacific Pty Ltd, a wholly owned subsidiary of the Applicant, dated 27 August 2018; and
 - (b) a statutory declaration in reply made by the same Trevor David Norman, dated 22 May 2019; and
 - (c) a supplementary statutory declaration made by Laura Quintano, Vice-President of the Applicant, dated 22 August 2019.

Proprietor's Evidence

5 The Proprietor's evidence comprises a statutory declaration made by Angela Thevessen, Export Manager of the Proprietor, on 22 February 2019.

Applicable Law and Burden of Proof

6 The applicable law is the Act, and in accordance with Section 101(c)(i) of the Act, "the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of the validity of the original registration". The undisputed burden of proof in this case thus falls on the Applicant.

Background

The Applicant

7 The Applicant is a company founded in America in 1949. It owns a range of brands in feminine health and intimate skin care, men's hair colour and grooming, and oral device care. These brands include JUST FOR MEN, SEA-BOND, GRECIAN FORMULA and VAGISIL. Its products are sold in 64 countries.

8 The Applicant owns the following VAGISIL registered trade marks in Singapore:

No.	TM No.	Mark	Class	Specification	Application Date
1	T9804752H	VAGISIL	5	Pharmaceutical preparations, medicated creams, and vaginal suppositories.	20 May 1998
2	T9804751Z	VAGISIL	3	Cosmetics and toiletries for feminine use, lotions, powders, sprays, towels impregnated with non-medicated preparations, and washes; and all other goods in Class 3.	20 May 1998
3	T1112897J	VAGISIL	5	Vaginal lubricants; and medicated products for feminine use, including	19 September 2011

No.	TM No.	Mark	Class	Specification	Application Date
				medicated feminine anti-itch creams, and premoistened feminine hygiene wipes.	
4	T0813410H	VAGISIL	10	Vaginal pH testing kits containing testing swabs and color guides; testing apparatus for sale in kit form [medical]; medical diagnostic testing apparatus; test apparatus for medical use; surgical, medical, dental and veterinary apparatus and instruments.	29 September 2008
5	40201507713Y	VAGISIL	3, 5, 10	Class 3: Feminine antiperspirant creams, gels, lotions, powders, and sprays; feminine deodorant creams, gels, lotions, powders, and sprays; non-medicated feminine soothing creams, gels, lotions, powders, and sprays for the skin; nonmedicated douches; non-medicated moisturizers for the skin at the	5 December 2014 ¹

¹ This is after the Relevant Date and is not an earlier trade mark.

No.	TM No.	Mark	Class	Specification	Application Date
				<p>external vaginal area; non-medicated premoistened feminine towelettes and wipes; non-medicated feminine hygiene washes.</p> <p>Class 5: Preparations for external and internal lubrication and moisturization of the vagina; medicated feminine anti-itch creams, gels, lotions, powders, and sprays for the skin; medicated douches; vaginal lubricants; vaginal moisturizers; medicated pre-moistened feminine towelettes and wipes; medicated feminine hygiene washes.</p> <p>Class 10: Massagers.</p>	

9 The trade marks listed in rows numbered 1-4 of the table above have an earlier filing date than the Subject Mark and the Applicant relies on them as earlier trade marks in these proceedings.

10 The Applicant first used the VAGISIL mark in Singapore in 1989 and the following VAGISIL products are available in Singapore:

Itch relief, odour control and cleansing	Dryness relief
<ul style="list-style-type: none"> • VAGISIL pH Plus Wash • VAGISIL Clean Scent Intimate Wash (Sensitive) • VAGISIL Medicated Crème • VAGISIL Intimate Powder 	<ul style="list-style-type: none"> • VAGISIL Prohydrate Plus Intimate Wash • VAGISIL Daily Moisturising Fluid

11 In Singapore, VAGISIL products are available at retailers such as Watsons, Guardian, NTUC Fairprice, Unity Pharmacy and Cold Storage, and other trade stores such as Venus Beauty, Pink Beauty and Tomato. They are also available through online retailers such as Lazada, Redmart, Qoo10, Shopee, Amazon Prime Now, Daily Mart, Tan Tock Seng Hospital Pharmacy, Splendideals.sg, Cloversoft & Co., EA Mart SG, Corlison and the VAGISIL e-store.

12 The Applicant's trade promotion spend and consumer advertising and promotional expenses in Singapore from 2011 to June 2018 are as follows:

Year	Advertising and Promotion (USD)
2011	144,540
2012	174,305
2013	165,196
2014	105,762
2015	145,407
2016	147,333
2017	173,904
YTD June 2018	57,017

13 The unit sales of the VAGISIL goods in Singapore over the years 2011 to June 2018 (based on sales by the Applicant's Singapore distributor Corlison to retailers in the Singapore market) are as follows:

Year	Unit Sales
2011	154,123
2012	126,947
2013	133,979
2014	154,313
2015	167,053
2016	147,455
2017	156,598
YTD June 2018	77,605

14 The Applicant's gross sales figures in Singapore, based on sales made by the Applicant to its Singapore distributor Corlison, from 2011 to June 2018 are as follows:

Year	Gross Sales (USD)
2011	440,761
2012	562,865
2013	517,220
2014	349,228
2015	469,591
2016	505,178
2017	505,550
YTD June 2018	174,336

15 Products sold under the VAGISIL trade mark have been referenced in television shows such as Saturday Night Live, Big Bang Theory, South Park, Shameless, Orange is the New Black, Eastbound & Down and Scrubs, and in movies such as Major League, Anger Management, Blue Mountain State, Rescue Me, The Evil Woods and Jennifer’s Body.

16 The VAGISIL mark has been referenced in both fiction and non-fiction literary works, for example, in books such as Sometimes I Dream in Italian, The Vast Fields of Ordinary, More Than It Hurts You, Water Cooler Talk with Clarby, The Edge of Never, Pale Girl Speaks – A Year Uncovered, I Wish I Were Engulfed in Flames, My Insane Life Raising Two Boys With Autism, End Your Menopause Misery The 10-Day Self-Care Plan, A Beautiful Life Cut Short by Early Onset Alzheimer’s – Marcia’s Journey, Everybody Curses I Swear!, and Above the Thunder.

17 The VAGISIL mark has also been referred to in online articles and blogs. In particular, the VAGISIL screening kit was recommended in Her World article “Questions About Vaginal Health Answered” dated 4 June 2010, and The New Paper article “Vigil over V-Spot” dated 30 April 2010, which has been reproduced on the National University Hospital website.

18 The Applicant has registrations for its VAGISIL and VAGISIL-formative marks in Argentina, Australia, Benelux, Bolivia, Brazil, Canada, Chile, Hong Kong, Italy, New Zealand, Russia, Saudi Arabia, Spain, Taiwan, United Arab Emirates and the UK.

19 The Applicant successfully opposed the Proprietor’s application for VAGISAN in Australia, New Zealand and the US, and cancelled the Proprietor’s registration for VAGISAN in the EU. The Australian and New Zealand decisions were pending appeal as of February 2019².

The Proprietor

20 The Proprietor, Dr. August Wolff GmbH & Co. KG Arzneimittel, is the medical division of the Dr. Wolff-Group, a cosmetics and pharmaceutical products company based in Germany with origins traced back to 1905.

² The Proprietor wrote in after this matter was heard to inform that its appeal was allowed by the Federal Court of Australia in a decision dated 3 February 2020.

21 The trade mark, VAGISAN, for vaginal care products was conceived in 1994 and first used since 1998. Today, VIGISAN products are sold in Austria, Belgium, Bulgaria, Croatia, Czech Republic, Estonia, Finland, Hong Kong, Hungary, Germany, Iran, Lithuania, Latvia, Malaysia, the Netherlands, Poland, Portugal, Romania, Sweden, Switzerland, Serbia and Montenegro, Slovenia and the United Kingdom.

MAIN DECISION

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

22 The relevant provisions are:

23.—(3) The registration of a trade mark may be declared invalid on the ground —

- (a) that there is an earlier trade mark in relation to which —
 - (i) the conditions set out in section 8(1) or (2) apply...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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.

The “Step-By-Step” Approach Under Section 8(2)(b)

23 The law in relation to Section 8(2)(b) of the Act is now well-settled – it is the “step-by-step” approach re-affirmed by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) 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

24 To assess the similarity of marks, 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, it is to be borne 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

Distinctiveness of the Applicant’s VAGISIL mark

25 I am mindful of the Court of Appeal’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 mark-similarity analysis.

26 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 *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA 56 (“*Sarika*”) at [20]:

...the “distinctiveness” of the registered trade mark is a factor to be considered in the visual, aural and conceptual analysis to determine whether the allegedly infringing sign and the trade mark are similar. It stands to reason that the more distinctive the registered trade mark, the more it is necessary to show sufficient

alterations to, or difference in, the sign in order that it may not be held to be similar to the trade mark ...

27 In making this assessment, account should be taken, in particular of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered. In this regard, the Proprietor submits that in the context of the goods concerned, the “VAGI” component of the earlier trade marks would be perceived as a direct reference to vagina and the intended treatment or purpose of the products.

28 The Proprietor further submits:

- (a) “VAGI” is commonly used by other third parties as part of the name of vaginal care products. These names include VAGISTAT, VAGIFEM, VAGINNE, VAGICAL, VAGIKOOL, VAGICAINE, VAGIFIRM, VAGI-PAL, VAGI-SITZ, VAGI-CLEAR, VAGI TIGHT, VAGI DOC, and VAGI SNUG.
- (b) VAGISTAT and VAGIFEM have already been in the Singapore market since at least as early as 2013 and 2008 respectively.
- (c) There are a number of marks prefixed with “VAGI” (VAGINNE, VAGILUR, and VAGIFEM) that are registered in Singapore for products such as, “vaginal cleaning liquids for personal sanitary or deodorizing purposes”, “gynaecological preparations”, and “pharmaceutical products”.

29 I am not persuaded on the evidence before me that marks with the “VAGI” prefix are commonly used in Singapore in relation to vaginal care products as of the Relevant Date which is 19 March 2012. It appears from the evidence that only VAGIFEM has been used in Singapore before the Relevant Date and even then the extent of its use is unclear. As for the state of the register, this is also not helpful as it does not necessarily reflect the situation in the marketplace.

30 However, I note that there is an extremely small number of words in the English language that begins with the prefix “VAGI”. According to the New Oxford American Dictionary, 3rd edition, Collins English Dictionary & Thesaurus, 3rd edition, Dictionary of Contemporary English, 3rd edition, and the Oxford English Reference Dictionary, 2nd edition, there are only a total of nine words that begin with the prefix “VAGI”, namely vagina, vagina dentata, vaginal plug, vaginate, vaginectomy, vaginismus, vaginitis, vaginoplasty, and vaginosis³. Of these words, “vagina” is the most commonly used word in ordinary parlance. Further, all but one of these nine words (i.e. vaginate⁴) relate to vagina and vaginal health.

31 Accordingly, when the relevant public encounters the element “VAGI” in connection with the goods in question, they are likely to recognise it as a shortening of the word “vagina” and as indicating the intended treatment area of the goods.

³ Proprietor’s SD at [29(b)], Exhibit 11.

⁴ Defined as “(esp. of plant parts) sheathed: *a vaginate leaf*” in the Collins English Dictionary & Thesaurus.

“VAGI” is thus of weak distinctive character and the distinctiveness of the VAGISIL mark lies in the combination of “VAGI” and “SIL” and the fact that it is conjoined to form an invented word.

32 Normally invented words are considered to have a very high degree of distinctive character, however, as the word will be understood as having allusive connotations to the treatment area of the goods, the mark is, as a consequence, only endowed with a normal level of inherent distinctive character.

33 The Applicant in the instant case did not argue that the VAGISIL mark has acquired a higher than normal level of distinctiveness due to the use made of it (and hence ought to enjoy a higher threshold before a competing mark is found different from it). As such, I will confine myself to assessing the inherent distinctiveness of the VAGISIL mark and not consider acquired distinctiveness.

Visual Similarity

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

<i>Applicant's Mark</i>	<i>Subject Mark</i>
VAGISIL	Vagisan

35 The Applicant's mark is a word-only mark registered in plain block capitals. Such a registration protects the word itself irrespective of font, capitalisation or stylisation⁵. Therefore, the fact that the Applicant's mark is in capitals and the Subject Mark is not, is not relevant. This is because a word mark in capitals covers use in lower case and vice versa.

36 Both marks consist of a single conjoined word made up of two components (VAGI-SIL and VAGI-SAN respectively), with no other elements or stylisation. They are both seven letters long out of which five of the letters are identical. The five identical letters appear at the front of the respective marks and in the same sequence. The last two letters of the marks are different.

37 I bear in mind that “VAGI” is not the distinctive element in the marks and the distinctiveness of the marks lies in the way “VAGI” is conjoined with their respective suffixes. However, the suffixes of the marks in the instant case also share some similarity – they are three letters long and both begin with the letter “S”.

38 Ultimately, having regard to the marks as wholes, the fact that they coincide in the majority of the letters, as well as in their structure and number of letters, I am of the view that the marks are more similar than dissimilar and the degree of similarity is above average.

⁵ *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 at [56].

39 The Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) opined at [32]:

In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816, Lai Kew Chai J held (at [26]) that “[i]n 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”. We agree with this.

40 In this connection, the marks in the instant case only differ in the two letters at the end of the mark. Given the similarities I have identified above, I do not think that this difference allows the Subject Mark “to distinguish itself sufficiently and substantially” from the VAGISIL mark. In other words, I find that the Subject Mark captures the distinctiveness of the VAGISIL mark which lies in way the VAGI prefix is conjoined with a 3-letter suffix starting with the letter “S”.

Aural Similarity

41 I now consider whether the Subject Mark is aurally similar to the VAGISIL mark.

42 There are two possible approaches in the assessment: the first is to undertake the analysis by reference to the dominant components of the marks; whereas the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. (*Staywell* at [31]-[32].) It is also important to bear in mind that the aural analysis involves the utterance of the syllables without exploring the composite meaning embodied by the words. (*Staywell* at [35].)

43 The Applicant submits that under the dominant component approach, the first syllable of the marks would be the most dominant and distinctive, because when the marks are pronounced, the stress is on the first syllable for both marks. In addition, not only do both marks share an identical first syllable, they also share an identical second syllable, and the third syllable of each mark begins with the “S” sound. As such, the Applicant submits that the marks are aurally similar.

44 As for the quantitative approach, the Applicant submits that both marks comprise three syllables, and the first two syllables are identical between the marks.

45 The Proprietor however urged me to consider the fact that “VAGI” is a weak element in the marks, and that even taking into account careless pronunciation and speech, the last syllable of the marks in question cannot be pronounced in a way that the last syllable is slurred.

46 While I agree with the Proprietor that slurring is unlikely to occur with this set of marks, I consider that the overall phonetic impression produced by the marks, which is influenced by the number and sequence of its syllables, and the rhythm and intonation of the marks, point to them being more similar than dissimilar and that the degree of similarity is above average. In arriving at this view I also consider that in the aural context, “VAGI” may not be immediately associated with the word “vagina” due to the difference in pronunciation.

Conceptual Similarity

47 Conceptual similarity is directed at the ideas that lie behind or inform the marks or sign in question. (*Hai Tong* at [70].)

48 The marks VAGISAN and VAGISIL are both invented words with no dictionary meanings. As such there is no conceptual similarity or dissimilarity. Or in other words, the marks are conceptually neutral. (*Caesarstone* at [52].)

Conclusion on Marks-Similarity

49 Overall, I have found that the Subject Mark and the Applicant's VAGISIL mark are:

- (a) visually similar to an above average degree;
- (b) aurally similar to an above average degree; and
- (c) conceptually neutral.

50 As recognised in *Staywell* at [18], 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, as the Court of Appeal in *Staywell* highlights (at [17]-[18]).

51 Overall, my finding is that the marks are similar to an above average degree.

Identical or Similar Goods

52 The second step of the three-step test in *Staywell* requires identity or similarity of goods to be established.

53 The Proprietor concedes that its goods are similar to the goods covered by the VAGISIL mark in Classes 3 and 5.

54 In my view, some goods are identical. For example, the Proprietor's "soaps" and "cosmetics" in Class 3 overlaps with the Applicant's "cosmetics and toiletries for feminine use" and the Proprietor's "pharmaceutical products" in Class 5 overlaps with the Applicant's "pharmaceutical preparations, medicated creams, and vaginal suppositories".

Likelihood of Confusion

55 There are at least two types of confusion under Section 8(2)(b) of the Act. The first is where the consumer mistakes one mark for another. The second is where consumers may perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies, and may perceive that goods or services of both marks emanate from the same source or from sources that are economically linked or associated (see *Hai Tong* at [74]). The Court of Appeal,

nonetheless, recognised at [75] that confusion in the sense of “mere association” is not enough. This means that “it is not sufficient that the relevant segment of the public would recognise or recollect similarities between the contesting marks if there is no likelihood of confusion as to origin ensuing”. Similar views were also expressed by the Court of Appeal in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [58].

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

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

57 In assessing the likelihood of confusion, certain “extraneous factors” may be taken into account, whereas others cannot (see *Staywell* at [63]–[93]). The permissible “extraneous factors” are considered below.

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

The degree of similarity of the marks

58 I have held above that overall there is an above average degree of similarity between the marks. As stated by the Court of Appeal in *Staywell* at [96], “the greater the similarity between the marks, the greater the likelihood of confusion”. Conversely, the lesser the similarity between the marks, the lower the likelihood of confusion.

59 Since the degree of similarity is above average, this factor points towards a likelihood of confusion.

The reputation of the marks

60 Relying on the matters set out at [10]-[19] above, and the dicta of the Court of Appeal in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] SGCA 14 at [34] which said “the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection is likely to be afforded to it”, the Applicant submits that this factor points towards a likelihood of confusion.

61 I will mention more about the matters set out at [10]-[19] later when I come to the next ground of invalidation. For present purposes, while I accept that VAGISIL products were first available in Singapore in 1989 and is available at major supermarkets and retailers (such as Watsons, Guardian, National Healthcare Group

Pharmacy, NTUC Fairprice, Unity and Changi General Hospital Retail Pharmacy) as of the Relevant Date, I am not persuaded, even if the VAGISIL mark has a reputation, this points towards a likelihood of confusion. This is because the approach is not “reputation-and-therefore-confusion” (*Rovio* at [125])⁶ and there is no evidence before me to indicate whether, on the facts, the reputation (if any) of the VAGISIL mark is one that points towards a likelihood of confusion or otherwise.

62 I therefore find that this factor is at best neutral.

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

63 The Court of Appeal in *Sarika* at [23] noted:

... the effect of imperfect recollection of consumers cannot be discounted, particularly since the difference between the words here is merely a single ending letter. As stated in *Ozone Community* (at [50]) citing *Bently & Sherman* at p 865, “where at first glance the sign and the mark may appear dissimilar, when the possibility of imperfect recollection is taken into account, they may in fact appear similar”...

64 In a similar vein, with regard to the present set of marks, VAGISAN and VAGISIL, due to the marks’ similar structure, beginnings, lengths, and the fact that they only differ by their final two letters, I find when imperfect recollection is taken into account, there is a likelihood of confusion.

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

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

65 The goods concerned here may be bought from brick-and-mortar shops or on the Internet. When the goods are purchased from a brick-and-mortar shop, customers can take their time to select the relevant products they wish to buy and/or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item to buy is generally made visually. Accordingly, the visual aspect plays an important role in the assessment of likelihood of confusion. However, I do not discount that aural considerations may also play a part, such as word of mouth recommendations, whether in a shop or elsewhere. If bought from the Internet, consumers would only perceive the trade marks visually.

⁶ In Europe, the position appears to be that the presence of a reputation invariably makes it easier for the trade mark owner to establish confusion. However, in Singapore, reputation may sometimes work against the trade mark owner as “[t]he more a mark is etched in the minds of consumers, and the more familiar consumers are with the details of a mark, the more discerning they may be in some cases, especially where on the facts, the consumers will likely be able to detect differences at a glance.” (*Rovio* at [125].)

66 This factor points towards a likelihood of confusion as the degree of mark similarity, whether visually or aurally, is above average.

Whether the products are expensive or inexpensive items

67 It appears from the evidence that the goods in question are priced from about SGD 8 to SGD 17 on average. The goods in question are not expensive but due to the nature of the goods (see the elaboration below), such purchases are not likely to be made in a hurry without putting in some care and attention into the purchasing process. I therefore find that this factor is not very useful in the circumstances of this case, and is neutral.

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

68 The goods in question here, vaginal care products, are to be used on a part of the body that is intimate and sensitive. Consumers are likely to be careful in the selection and purchase of the goods as the application of wrong or unsuitable products may have undesired consequences. This means that direct confusion is less likely, but I must also consider the likelihood of indirect confusion, i.e. the possibility that the average consumer might, on recognising that the marks are different, nevertheless assume that there is a connection between the two undertakings. In my view, this second type of confusion is not necessarily obviated by the fact that consumers are careful and, in fact, is likely due to the similarities between the marks.

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

69 The average consumer of the goods in question consists of both the public at large as well as those in the trade. The goods concerned are used widely across segments of the public and the consumers may not have specialist knowledge. Nonetheless, given the nature of the goods, consumers are likely to exercise care when purchasing the goods to ensure that they buy what is suitable for them. As mentioned above, while this makes direct confusion less likely, the possibility of indirect confusion still remains.

Whether the transactions are routine or infrequent

70 The goods concerned here range from moisturising and cleansing goods to pharmaceutical preparations, medicated creams, and vaginal suppositories. While some of these products may be bought on a more routine basis, others are only bought when certain symptoms occur such as itch, odour or dryness. However, regardless whether the goods are required on a routine or infrequent basis, consumers are likely to purchase the goods with care and consequently with greater attention being paid to the trade marks used on those goods.

Conclusion on Likelihood of Confusion

71 My conclusion is as follows. The identity between the goods is a factor that points to the existence of a likelihood of confusion. Where similarity of the marks is

concerned, I have assessed that the degree of similarity is above average, and this points to the existence of a likelihood of confusion. The overall impression of the marks also point towards a likelihood of confusion. On the other hand, I have found that consumers will pay a fairly high degree of attention to the purchase of the goods concerned. As I have alluded to above, while this factor may render direct confusion less likely, the possibility of indirect confusion is still present. When I assess all these factors in the light of the doctrine of imperfect collection, I find on balance that there is a likelihood of confusion in this case. This is because even consumers paying a higher degree of attention need to rely on their imperfect recollection of trade marks.

Conclusion on Section 23(3)(a)(i) read with Section 8(2)(b)

72 The ground of invalidation under Section 23(3)(a)(i) read with Section 8(2)(b) therefore succeeds.

Ground of Invalidation under Section 23(3)(a)(iii) read with Section 8(4)(b)(i)

73 The relevant provisions are:

23.—(3) The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which —

(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8(4) apply;

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

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

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

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

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

Decision on Section 23(3)(iii) read with Section 8(4)(b)(i)

Similarity of Marks

74 The High Court in *Rovio* (at [146]) held that there was no difference between the similarity of marks comparison in Section 8(2)(b) and Section 8(4) of the Act. I have dealt with the issue of marks-similarity earlier under Section 8(2)(b) and found that the marks are more similar than dissimilar and the degree of similarity is above average.

Well Known in Singapore

75 The relevant provisions of the Act are:

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

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of –
(i) any use of the trade mark; or
(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;

(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;

(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;

(e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

(9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

(a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;

(b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;

(c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

76 The provisions have been the subject of further exposition by the Courts:

- (a) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This because Section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] SGCA 13 ("*Amanresorts*").
- (b) Aside from Section 2(7)(a) of the Act, the court is ordinarily free to disregard any or all of the factors listed in Section 2(7) as the case requires and to take additional factors into consideration. (*Amanresorts* at [137].)
- (c) In relation to Section 2(8) of the Act, the Court of Appeal in *Caesarstone* clarified:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore⁷...

[102] We do not think that this comment in *Amanresorts* was made to lay down a general principle...the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be any relevant sector of the Singaporean public, and this sector need not be large in size. Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.

77 The Applicant relies on the matters set out at [10]-[19] above as evidence that the VAGISIL mark is well known in Singapore. Having considered the evidence tendered by the Applicant, I am of the view that the Applicant has not discharged its burden of proving that the VAGISIL mark is well known in Singapore. My reasons are as follows.

78 First, the Applicant must show that its VAGISIL mark is well known in Singapore by the Relevant Date i.e. 19 March 2012. However, most of the evidence tendered by the Applicant post-dates the Relevant Date. Whilst I do not completely ignore such evidence given that reputation is usually built up over the years, the evidence must be evaluated in conjunction with the rest of the evidence.

79 Second, for the year 2011, the Applicant sold 154,123 units of VAGISIL products in Singapore and its gross sales (based on sales made by the Applicant to its Singapore distributor) is USD 440,761. While these figures are not insubstantial, I do not consider it sufficient to prove that the mark is well known in Singapore. In this

⁷ The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “any relevant sector of the public in Singapore” which could in certain cases be *miniscule* ([229] *Amanresorts*).

regard, in *Caesarstone*, the sales figures of SGD 577,656 to SGD 3,390,094⁸ over a period of 6 years was not sufficient to render the CAESAR mark well known in Singapore. In addition, in the present case, no context was provided as to the size of the market in Singapore for the goods and the market share held by the Applicant. Without the relevant context I am unable to reach the finding that the VAGISIL mark is well known in Singapore.

80 Third, whilst the Applicant spent a reasonable amount on advertising and promotion of the VAGISIL mark in Singapore (USD 144,540 in 2011), the expenditure before 2011 was not provided and I cannot form a complete picture as to how much the public was exposed to the VAGISIL mark before that.

81 Fourth, I note the references made to VAGISIL in television shows, books and articles. Some were made before the Relevant Date and others after. Nonetheless, in respect of all of them, it is not clear to what extent the relevant public in Singapore were exposed to them and what effect, if any, they have on them. They therefore do not assist me to reach a conclusion as to whether the VAGISIL mark is well known in Singapore.

82 Fifth, I note the overseas registrations of VAGISIL and VAGISIL formative marks and the successful enforcement of the rights over the VAGISIL mark in other jurisdictions. However, unless the Applicant can show how those have led to the mark being well known in Singapore, their relevance is limited. This was what the Court of Appeal said in *Caesarstone* at [113]:

In *Formula One Licensing BV v Idea Marketing SA* [2015] 5 SLR 1349, Tay Yong Kwang J (as he then was) stated (at [66]) that “registrations do not automatically equate to trade mark use”. As for foreign decisions, he held (at [72]) that they do not assist in determining the threshold issue of whether the mark in question is well known to the relevant sector of the public in Singapore. Indeed, although the overseas registrations of the mark and the successful enforcement of rights are relevant factors under s 2(7)(c) and (d) of the TMA, the language of s 2(7) of the TMA makes it abundantly clear that the ultimate inquiry is whether a trade mark is well known in Singapore. The crucial point, therefore, is that the Appellant has to show how the overseas registrations of the Appellant’s CAESAR Mark and the successful enforcement of its rights has led to its mark being well known in Singapore. In our judgment, this has not been done. These factors therefore do not go towards establishing that the Appellant’s CAESAR Mark is well known in Singapore.

83 Taking the evidence as a whole into account, I am not satisfied that the Applicant has demonstrated that the VAGISIL mark is well known in Singapore at the Relevant Date.

Conclusion on Section.23(3)(a)(iii) read with read with Section 8(4)(b)(i)

84 There being no well known trade mark in Singapore, the ground of invalidation under Section 23(3)(a)(iii) read with Section 8(4)(b)(i) accordingly fails.

⁸ *Caesarstone* at [104] and [114].

Ground of Invalidation under Section 23(3)(b) read with Section 8(7)(a)

85 The relevant provisions are:

23.—(3) The registration of a trade mark may be declared invalid on the ground

—
(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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 23(3)(b) read with Section 8(7)(a)

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

The basic principle undergirding the law of passing off is that a trader should not sell his or her goods on the pretext that they are the goods of another trader. There are two oft-quoted formulations of the tort of passing off. The first is found in Lord Diplock’s speech in *Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Ltd and another* [1979] 1 AC 731 (“*Advocaat*”) at 742 where Lord Diplock stated five characteristics of a cause of action in passing off, namely: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

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

... The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether this consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the

public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. ... Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

Both Lord Diplock's five characteristics in *Advocaat* and Lord Oliver's reformulation in *JIF Lemon* have found expression in the judgments of our courts (see, for example, *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Novelty*") at [36]). It has been suggested in a number of cases that there is no difference between these formulations, and that the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty* at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 ("*Nation Fittings*") at [148]). We accept this, by and large, as the correct position. However, we also agree with Prof Wadlow's view that Lord Diplock's five characteristics, focussing as they do on the issue of misrepresentation and damage, "probes more deeply into the inwardness of the tort" (Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011) ("*Wadlow on Passing Off*") at para 1–027). The essence of passing off – that no person is permitted to steal another's trade *by deceit* – must not be forgotten. What the tort seeks to protect is not the plaintiff's use of a mark, name or get-up *per se*; rather, the tort seeks to prevent the defendant from causing damage to the plaintiff by committing an actionable misrepresentation.

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

Goodwill

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

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

There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question – property in what? Some authorities say property in the mark, name, or get-up

improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v Banham* (LR (1906) AC 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think strong reasons for preferring the latter view. ...

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

89 The High Court in *Allergan, Inc and another v Ferlandz Nutra Pte Ltd* [2016] SGHC 131, referring to *Singsung*, summarised the position at [170] – [171] as follows:

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

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

90 The fact that the Applicant has goodwill in Singapore is not in dispute.

Misrepresentation

91 Under this element, the Applicant must show that its goodwill is associated with its marks and that the use of the Subject Mark in respect of the goods for which registration is sought, amounts to a misrepresentation. The misrepresentation (whether intentional or not) must be such that would lead or be likely to lead the public into believing that the goods (in respect of which registration is sought) are the goods of the Applicant or from a commercially related trade source. In this connection, a threshold question which arises is whether the Applicant’s mark is distinctive of its goods. This was expressed by the Court of Appeal in *Singsung* at [38] as follows:

In our judgment, the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an

actionable misrepresentation. Simply put, if a mark or get-up is not distinctive of the plaintiff's products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or are economically linked to the plaintiff. Indeed, it has been said (in the context of an alleged representation consisting of the use of a name in connection with goods) that proof that the name has become distinctive of the plaintiff's goods is a "condition precedent" to the success of a passing off action: per Viscount Simmonds in *T Oertli AG v E J Bowman (London) Ltd* (1959) RPC 1 at 4. Similarly, where the alleged representation consists of the use of the get-up, the plaintiff is required to prove that the get-up in question has become distinctive in the sense that the relevant segment of the public recognises goods with that get-up as originating from the plaintiff. If it is found that the mark or get-up *is* distinctive of the plaintiff, then the next question is whether the use of similar indicia by the defendant amounts to a misrepresentation.

92 An applicant's case under Section 8(7)(a) must be based on the mark it has actually used and on the actual goods sold under it (unlike the position under Section 8(1) and Section 8(2) where all normal and fair uses of the applicant's registered mark in relation to goods as registered may be considered).

93 I note from the Applicant's advertising and promotional materials that it sometimes uses its mark in conjunction with a "V" device, either to the left or top of the word, VAGISIL, such as:



94 Nonetheless, I am of the view that the use of the "V" device does not detract from the distinctiveness of the word VAGISIL and that consumers would still distinguish the Applicant's goods by the word VAGISIL with or without the "V" device.

95 Turning to the crux of the second element, namely, whether the use of the Subject Mark amounts to a misrepresentation which creates a likelihood of confusion, I have found in respect of the invalidation ground under Section 8(2)(b) of the Act that there is a likelihood of confusion. I reiterate my reasons set out above for arriving at that conclusion. Although the relevant tests for the tort of passing off and a claim

under Section 8(2)(b) are not identical, and although in an action for passing off, this tribunal is not constrained in the same way that it would be in considering the case under Section 8(2)(b) in identifying the factors it may take into account, I am satisfied here that for those same reasons, the element of misrepresentation is made out.

Damage

96 As regards damage, the Court of Appeal stated in *Singsung* at [87] as follows:

The element of damage may be dealt with briefly. In our judgment, in view of the respondent's misrepresentation, it is indisputable that the appellant's goodwill would be adversely affected through a diversion of custom, given that the appellant and respondent were competing in exactly the same line of products and in the same export jurisdictions.

97 For the same reason, I find in the present case, given the Proprietor's misrepresentation, the fact that the parties compete in the same line of products, and the likelihood of confusion which I have found in relation to the case under Section 8(2)(b), there is a real likelihood of damage to the Applicant's goodwill arising from the diversion of custom if consumers from the relevant segment of the public were led to believe that goods bearing the Subject Mark were the goods of the Applicant or were otherwise associated with or connected with the Applicant. The claim in passing off is therefore made out.

Conclusion on Section 23(3)(b) read with Section 8(7)(a)

98 The ground of invalidation under Section 23(3)(b) read with Section 8(7)(a) therefore succeeds.

Overall Conclusion

99 Having considered all the pleadings, evidence, and submissions made in writing and orally, I find that the application for a declaration of invalidity succeeds on the grounds of:

- (a) Section 23(3)(a)(i) read with Section 8(2)(b); and
- (b) Section 23(3)(b) read with Section 8(7)(a),

but not Section 23(3)(a)(iii) read with Section 8(4)(b)(i) of the Act. As the Applicant has succeeded on two out of three grounds, the Applicant will be entitled to 65% of the costs, which are to be taxed, if not agreed.

Date of Issue: 21 February 2020

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