

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

Trade Mark No. 40201724079R
Hearing Date: 10 September 2020

IN THE MATTER OF A TRADE MARK APPLICATION BY

MORINAGA & CO., LTD.

AND

OPPOSITION THERETO BY

WEIDER GLOBAL NUTRITION, LLC

Hearing Officer: Ms Tan Mei Lin
Principal Assistant Registrar

Representation:


Ms Gloria Goh and Ms Amanda Soon (Allen & Gledhill LLP) for the Applicant
Mr Suhaimi Bin Lazim and Mr Khoo Lih-Han (Mirandah Asia (Singapore) Pte Ltd) for
the Opponent

GROUND OF DECISION

1 Morinaga & Co., Ltd (“the Applicant”) is a company established in Japan in 1899 by Taichiro Morinaga with the objective to deliver nutritious and delicious Western confectionaries to the people of Japan. Today, the Applicant has sales and manufacturing bases in the United States, Indonesia, China, and Taiwan.

2 Weider Global Nutrition, LLC (“the Opponent”), on the other hand, is an active nutrition¹ company based in Phoenix, Arizona with over 70 years of expertise in nutritional sciences. Its goods are available in over 120 countries through a network of associates, licensees and distributors.

3 On 5 December 2017 (“Application Date”), the Applicant applied to register the following trade mark (“the Application Mark”) in Singapore:

Trade Mark No.	Mark	Specification
40201724079R	 <p>(Series of two marks.)</p>	<p><u>Class 5</u> Dietary supplements for human; Nutritional supplements; Dietary supplemental bar; Meal replacement bar; Mineral nutritional supplements.</p> <p><u>Class 30</u> Confectionery; Cereal bars; Low calorie sweeteners; Low calorie sugar substitutes.</p>

4 The Application Mark was accepted and published on 4 April 2018 for opposition purposes. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 7 June 2018. The Applicant filed its Counter-Statement on 12 October 2018. The Opponent filed evidence in support of the opposition on 19 June 2019. The Applicant filed evidence in support of the application on 20 September 2019. The Opponent filed its evidence in reply on 5 December 2019. A Pre-Hearing Review was conducted on 17 December 2019 wherein leave was granted to the parties to submit English translations of the foreign language documents in their earlier evidence, by way of supplementary statutory declaration. The parties did so on 12 February 2020 and the matter was set down for hearing on 12 May 2020. Due to the Covid-19 Circuit Breaker and extended Circuit Breaker measures, the parties only filed their written submissions and bundle of authorities on 22 May 2020, and the hearing was postponed to 14 July 2020.

5 On 23 June 2020, I asked the Opponent to indicate the mark(s) it was relying on as representing its best case in this opposition and to lodge further submissions in relation to certain issues under one of its grounds.

¹ Active nutrition products are formulated and positioned to support consumers of all ages leading a healthy lifestyle which incorporates physical activity.

² The Register further states: The transliteration of the Japanese characters in the mark is "Wefaa" meaning "Wafer", "Nattsu" meaning "Nuts", "Purotein" meaning "Protein", "Baa" meaning "Bar", "Tegaruni Tanpakushitsu" meaning "Easy Way To Get Protein" and "Shashin Wa Imeeji Desu" meaning "Image Photo".

6 The Opponent filed its supplementary submissions on 21 July 2020, after requesting for a 2-week extension of time. Consequently, the hearing was postponed to 13 August 2020. The Opponent's counsel, however had another hearing in the High Court on that day and the hearing at IPOS had to be rescheduled. The opposition was heard on 10 September 2020.

Grounds of Opposition

7 The Opponent relies on Sections 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the "Act") in this opposition.

Opponent's Evidence

8 The Opponent's evidence comprises the following:

- (i) a Statutory Declaration made by Douglas York, Corporate Chief Financial Officer of the Opponent, on 29 April 2019 ("OSD1");
- (ii) a Statutory Declaration in reply made by the same Douglas York on 20 November 2019 ("OSD2"); and
- (iii) a Supplementary Statutory Declaration made by the same Douglas York on 7 February 2020 ("OSD3").

Applicant's Evidence

9 The Applicant's evidence comprises the following:


- (i) a Statutory Declaration made by Masao Hoshino, General Manager, General Affairs Division of the Applicant, on 10 September 2019 ("ASD1"); and
- (ii) a Supplemental Statutory Declaration made by the same Masao Hoshino on 7 February 2020 ("ASD2").

Applicable Law and Burden of Proof


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

Background

11 The Opponent is the registered proprietor in Singapore of the trade marks numbered 1 to 6 while its associate, Mariz Gestao E Investimentos Limitada ("Mariz"), is the registered proprietor in Singapore of the trade marks numbered 7 and 8, in the table below:

S/N	Trade Mark	Trade Mark No.	Registration Date	Goods
1	 <p>(Series of two marks.)</p>	T0421581B	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.
2	WEIDER ENERGY IN	T0105928C	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; non-alcoholic vitamin drinks; all included in Class 32.
3	WEIDER FIBER IN	T0105927E	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.
4	WEIDER VITAMIN IN	T0105926G	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; non-alcoholic vitamin drinks; all included in Class 32.

³ The Register further states: The transliteration of the Japanese characters appearing in the mark is "Weider" which has no meaning.

5	WEIDER IN JELLY	T0419503Z	09/11/2004	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; non-alcoholic vitamin drinks, all included in Class 32.
6	 <p>4</p> <p>(Series of two marks.)</p>	T0421579J	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.
7	MULTI VITAMIN IN	T0421582J	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.
8	IN	T0105925I	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.

12 The following is a summary of the facts set out by the Opponent.

⁴ The Register further states: The transliteration of the Japanese characters appearing in the mark is "Weider" which has no meaning.

13 Mariz was initially the owner of all “Weider” and “Weider”-formative trade marks, including “IN” alone and “IN”-formative trade marks. In 2007, by way of a Purchase and Sale Agreement dated 31 August 2007 (“Purchase and Sale Agreement 2007”), the Opponent acquired from Mariz all “Weider” and “Weider”-formative marks, excluding “IN” and “IN”-formative trade marks. Mariz is thus still the owner of all “IN” and “IN”-formative marks.⁵

14 Concurrently with the Purchase and Sale Agreement 2007, a License Agreement was entered into between Mariz and the Opponent, granting Mariz various rights to the “Weider” and “Weider”-formative marks so that Mariz could continue to support the rights it had previously licenced to Rayo International Trading Company B.V. (“Rayo”), which included not just the “Weider” and “Weider”-formative marks, but also the “IN” and “IN”-formative marks. Rayo in turn granted a sub-licence to JWO Corporation (“JWO”).

15 JWO first entered into a Licence and Technical Assistance Agreement (“LTAA”) with the Applicant in 1983, and this agreement was subsequently renewed in 1988, 1993, 1998 and 2013 respectively. According to the Opponent, the 1983, 1988 and 1993 LTAA Agreements only contained the “Weider” marks. When the LTAA was renewed in 1998 and 2013, the scope was extended to include “Weider”-formative marks and also the “IN” and “IN”-formative marks. The latest LTAA between JWO and the Applicant is valid till 2028.

16 In 1997, by way of addendum to the 1989 Rayo-JWO Licence Agreement, JWO acknowledged that it was receiving royalties from the Applicant in respect of, among other things, “Project 58 “In” Products” and agreed to pay Rayo a percentage of the royalties it receives from the Applicant. Below is the “current list” of the “Project 58 “In” Products” listed at Exhibit B of the agreement.

Project 58 “In” Products

1. Canned drinks which bear the following names:
 - a. Protein-In
 - b. Energy-In
 - c. Vitamin-In
 - d. Collagen-In

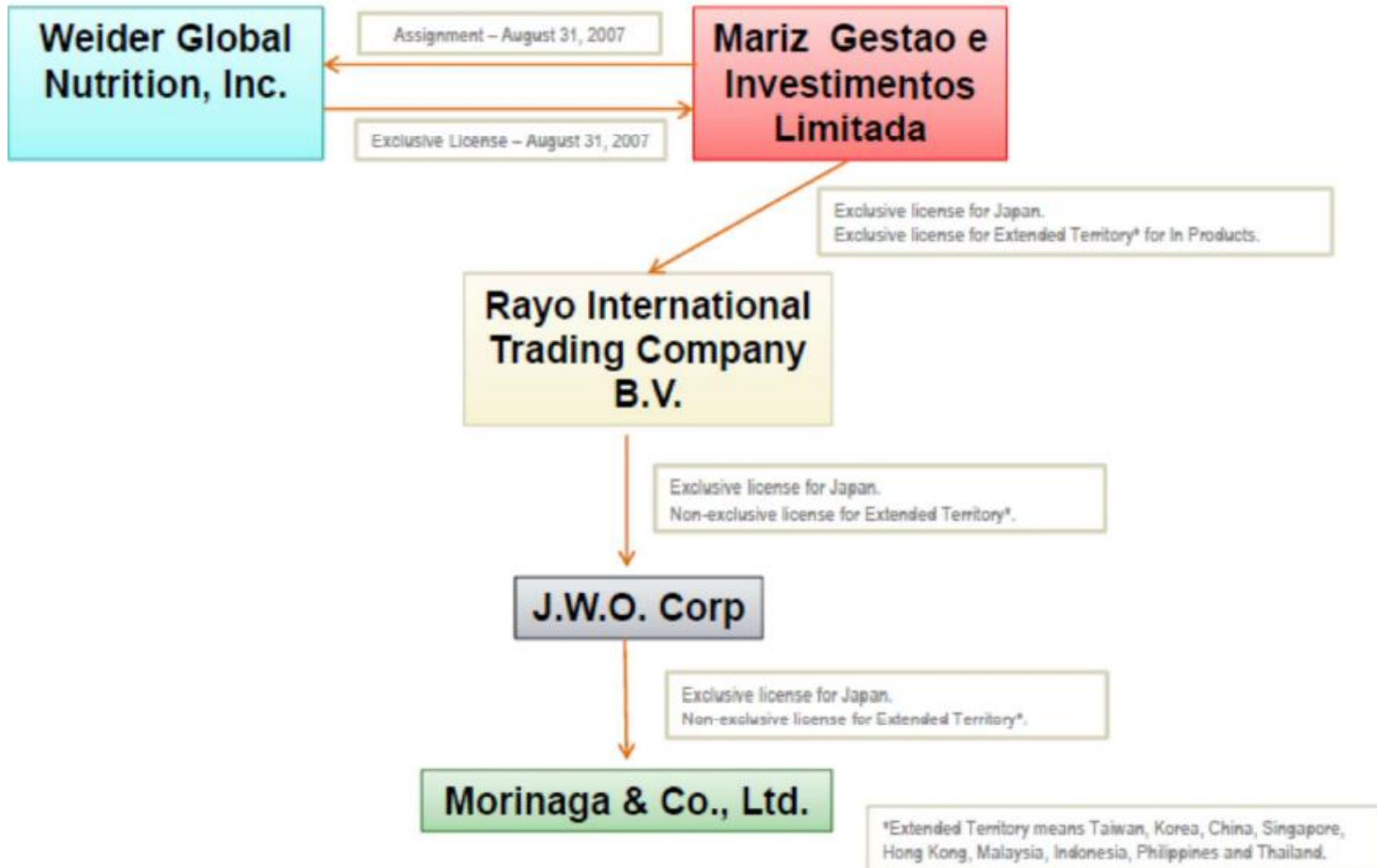
2. Gelatinous drinks which bear the following names:
 - a. Protein-In
 - b. Energy-In
 - c. Vitamin-In
 - d. Fiber-In

3. The following chewable vitamins/minerals in re-sealable pouches:
 - a. Vitamin C
 - b. Calcium
 - c. Iron

⁵ OWS at [5.12] and [5.13].

17 The Applicant therefore always had only those rights licenced to it by JWO through the LTAA and was never the owner of the “IN” and “IN”-formative marks.

18 The diagram below shows in a nutshell the licensing structure between the parties.



MAIN DECISION

Ground of Opposition under Section 7(6)

19 I will start with the ground of bad faith as the Opponent focussed almost entirely on this ground at the oral hearing.

20 Section 7(6) of the Act reads:

A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The law

21 The leading case on Section 7(6) of the Act is the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). A restatement of the key principles in *Valentino* is set out below.

- (i) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion. (*Valentino* at [20] referring to *Rothmans of Pall Mall Ltd v Maycolson International Ltd* [2006] 2 SLR(R) 551 at [29] and Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell Asia, 2nd Ed, 2005) at para 5.71.)
- (ii) The legal burden of proof needed to substantiate an action on this ground lies on the party bringing the application. (*Valentino* at [21] referring to *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [33].)
- (iii) Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark. (*Valentino* at [28] referring to *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [48].)
- (iv) The test for determining the presence of bad faith is a “combined” one, in that it contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Bad faith as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case. (*Valentino* at [29] referring to *Wing Joo Long* at [105] – [117].)
- (v) An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference. (*Valentino* at [30] referring to *Nautical Concept Pte Ltd v Jeffery Mark Richard and anor* [2007] 1 SLR(R) 1071 (“*Nautical Concept*”) at [15].) However, as observed in Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 at [21.4.1], footnote 109, this does not mean that there is an absolute prohibition against drawing inferences. (In support of this observation, Professor Ng-Loy cited the decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)

Decision on Section 7(6)

22 The Opponent’s case on this ground hinges on two critical points. Firstly, Mariz owns the “IN” alone and “IN”-formative marks, and secondly, the Applicant has no right to register the Application Mark. I will elaborate on each point in turn.

Mariz owns the “IN” alone and “IN”-formative marks without the “Weider” element

23 It is not in dispute that Mariz is prima facie the owner of the plain word mark “IN” in Class 32 which covers “Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.”. However, the Application Mark is filed in Classes 5 and 29. The registration owned by Mariz of “IN” alone in Class 32 does not grant it a monopoly over “IN” in Classes 5 and 29. This fact alone, without more, is not sufficient to warrant a finding of bad faith.


24 The Applicant on the other hand, owns the following “IN” trade mark registration in Class 5 in Singapore:

Trade Mark No.	Mark	Registration Date	Specification
40201711769U	 (Series of two marks.)	22 June 2017	<u>Class 5</u> Dietary supplements for human; Nutritional supplements; Dietary supplemental drinks; Liquid nutritional supplements; Meal replacement drinks; Mineral nutritional supplements.

25 The registration was neither opposed by the Opponent nor Mariz and it was only on 20 August 2019, more than one year after these opposition proceedings were commenced, that the Opponent initiated proceedings to invalidate the registration. The proceedings are currently pending.

26 This also means that when the Application Mark was applied for, the Applicant



had a valid registration for “” in Class 5 and seen in that context, it is not entirely inappropriate for the Applicant to apply to register the Application Mark to protect its interest further.

27 At the oral hearing, I asked the Opponent’s counsel for the evidence showing that Mariz is the owner of “IN” alone and “IN”-formative trade marks. I was referred to the Second Amended and Restated License Agreement dated 31 August 2007⁶ entered into between the Opponent and Mariz, in particular, clause 3.3 which reads:

⁶ Exhibit 2 of OSD1.

3.3 Notwithstanding the sale and transfer of the Combination Trademarks by Mariz to WGN pursuant to the Mariz-WGN Purchase and Sale Agreement, WGN acknowledges and agrees that it does not have and, will not have at any time in the future, any rights, title or interest in or to the “IN” component of the Combination Marks (the “IN Components”). [REDACTED] WGN agrees not to use any IN Component as a trademark and/or service mark in association with any product or service anywhere in the world and to maintain the confidentiality of, and not use to the benefit of WGN or any of its Affiliates or licensees, any information acquired in respect of any product or service in respect of which any IN Component, or any new trademark and/or service mark incorporating any IN Component, in whole or in part, will be used by the Third Party Licensee.

(redaction in original)

28 In my view, the clause is insufficient to prove that Mariz is the owner of the “IN” alone and “IN”-formative marks. It merely shows that the Opponent does not have any rights to them and is silent on the rights of Mariz.

29 I have considered the fact that the Applicant is paying royalties to JWO for certain “Project 58 “In” Products” (see [16]). However, neither the Application Mark nor the goods concerned fall within the scope of those listed at Exhibit B of the agreement. Further, the agreement was entered into in 1997 and does not help to shed any light on the situation as at the Application Date (i.e. 5 December 2017).

30 I am therefore unable to conclude from the evidence before me and without the benefit of any cross-examination, that Mariz is the owner of “IN” alone and “IN”-formative marks in the classes concerned.

The Applicant has no right to register the Application Mark

31 The Opponent alleges at paragraph 12 of its pleading:

In 2013, the sublicense agreement was renewed and the parties agreed that any future trade marks developed by the Applicant for use in association with the Weider and Weider-formative trade marks would be registered and owned by the Applicant, in Japan. As such, the only marks that the parties expressly agreed would belong to the Applicant were marks designed for use with a “Weider” component, with or without an “IN” component. The parties had never contemplated that the “IN” or “IN-formative” marks, used alone and specifically without a Weider component would be owned by the Applicant, particularly in territories other than Japan. In view of the terms of the sublicense agreement, the Applicant has no right to use or register the “IN” and/or “IN-formative” brand, in Singapore.

32 However, the 2013 sublicense agreement referred to by the Opponent does not appear to support the Opponent’s case. In particular, the agreement refers to several “IN”-formative trade marks (without the “Weider” component) that were developed by the Applicant and that the trade mark registrations in Japan would be returned by JWO to the Applicant (referred to as “MAC” in the agreement). Clause 13.01 of the agreement is reproduced below:

13.01 Notwithstanding the foregoing, JWO shall transfer and return to MAC the trademark rights regarding the trademarks developed by MAC whose registered owner in Japan is JWO, as per the agreement set forth in page 2 of the Minutes of Meeting dated February 26, 2013 which was signed by both parties on the same date and is attached hereto as SCHEDULE G. The list of the trademark rights which JWO shall transfer and return to MAC was attached to the Minutes of Meeting. Furthermore, any future trademarks developed by MAC to be used in connection with the Trademarks will be registered and owned by MAC. This transfer of trademark rights becomes effective immediately once this Agreement is signed by JWO and MAC even if this Agreement is signed before this Agreement becomes effective pursuant to Article 10.01. JWO shall fully cooperate with and give all necessary documents to MAC in relation to such transfer of trademark rights to ensure the implementation of the agreement set forth in the Minutes of Meeting.

33 The relevant paragraph of “page 2 of the Minutes of Meeting dated February 26, 2013” and which is attached to the agreement as Schedule G states:

With regard to the renewal of the Existing Agreement, Morinaga and JWO agreed that JWO shall transfer and return to Morinaga the trademark rights regarding the trademarks developed by Morinaga whose registered owner in Japan is JWO. The list of trademarks attached to these minutes covers the trademarks which Morinaga and JWO agreed that JWO shall transfer and return to Morinaga. Furthermore, any future trademarks developed by Morinaga to be used in connection with Weider marks will be registered and owned by Morinaga. This transfer of trademark rights will become effective immediately once the renewal agreement is signed by Morinaga and JWO.

34 Among the trade marks listed in the attachment to the Minutes of Meeting in respect of which JWO agreed to transfer to the Applicant, in Japan, is:

IBAR	inBAR	5373196 2010/12/03	29 30	2010/12/03	2010/05/25	登	2020/12/03
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35 While it is clear that it is only the registration in Japan that is to be transferred and the agreement is silent on the ownership of “**inBAR**” in other territories, a fact I find disturbing is the acknowledgement that “**inBAR**” was developed by the Applicant.

⁷ The representation of the mark in the first column is partially cropped. The full representation should appear as “**inBAR**”.

If this is so, the Opponent's case that the Applicant has no rights to "IN" or "IN"-formative marks, without the "Weider" component may not be as simple as it makes it out to be.

36 Furthermore, if the Applicant had truly developed "**inBAR**", its attempt to register the Application Mark in Singapore after its successful registration of "**in**", cannot be said to be entirely unjustified.

37 Having considered all relevant matters and in particular bearing in mind that an allegation of bad faith is a serious one, I find that the Opponent has not met the standard of proof that is required to establish bad faith.

Conclusion on Section 7(6)

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

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

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

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

...

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

Decision on Section 8(2)(b)8(2)(b)

40 The law in Singapore on the approach to be taken in applying Section 8(2)(b) of the Act is now well-settled. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 ("*Staywell*") reaffirmed the "step-by-step" approach which may be summarised as follows. The first step is to assess whether the respective marks are similar. The second step is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected. If the first and second steps are answered in the affirmative, the third step is to consider whether there exists a likelihood of confusion as a result of the similarities and/or identities. The court made it clear that "the first two elements are assessed individually before the final element which is assessed in the round" (*Staywell* at [15]).


Similarity of Marks


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

- (i) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. (*Staywell* at [20].)

- (ii) The marks are to be compared “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].)
- (iii) 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].)
- (iv) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side or examined in detail for the sake of isolating particular points of difference because the person who is confused often makes a comparison from memory removed in time and space from the marks. (*Hai Tong* at [40(d)], [62(a)]).
- (v) 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)].)

42 The Opponent relies upon the following trade marks as representing its best case in these proceedings:



S/N	Trade Mark	Trade Mark No.	Registration Date	Goods
1		T0421581B	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.


2		T0421579J	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.
3	IN	T0105925I	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.

Visual Similarity

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

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

<i>Opponent's Mark</i>	<i>Application Mark</i>
 <p>(“Composite Mark 1”)</p>	


 <p>(“Composite Mark 2”)</p>	
<p>IN</p> <p>(“Opponent’s Word Mark”)</p>	

Comparison between “” v “” and “” v “”





45 The Opponent submits that the prominence of the word “IN” in Composite Mark 1 and Composite Mark 2 renders this word to be the dominant element of the marks.


46 While I agree that the “IN” element is *a* dominant element of Composite Mark 1 and Composite Mark 2, I do not agree that it is *the* only dominant element or that the overall impression of the marks will be dominated only by the element “IN”.

47 Composite Mark 1 and Composite Mark 2 both contain, among other things, the following:

- (i) The “” device with the word “WEIDER” under it
- (ii) The word “WEIDER”
- (iii) The word “IN”
- (iv) The Japanese characters “ウイダー”
- (v) The word “Multivitamin” in Composite Mark 1 and “Energy” in Composite Mark 2
- (vi) The words “Weider In Jelly Multivitamin” in Composite Mark 1 and “Weider In Jelly Energy” in Composite Mark 2.

48 The word “IN” appears in largest font. It is preceded by the word “WEIDER” in relatively smaller font but nevertheless still large and clearly visible. Above the word

“WEIDER” is the “” device with the word “WEIDER” and below it is the Japanese characters “”. The word “WEIDER” and the “” device have no meaning in the context of the goods claimed and as such they have a high degree of technical distinctiveness. The Japanese characters “” are unlikely to be understood by the average consumer in Singapore and as such will not be particularly memorable save for the fact that the mark contains Japanese characters. The words “Multivitamin” and “Energy” will be seen as descriptive and subsidiary to the words “WEIDER” and “IN” as they are in smaller and fainter font and because they appear below them.

49 Overall, I find that the following elements are dominant and distinctive in Composite Mark 1 and Composite Mark 2: the “” device, the word “WEIDER” and the word “IN”. These elements would feature in the consumer’s imperfect recollection of the marks.

50 The Application Mark on the other hand represents a picture of a packaging, which will clearly be seen as a packaging of the goods. It comprises of the word “IN” in large font and in bold, the word “BAR” in relatively smaller font, a picture of a wafer and three shapes containing Japanese text.


51 In my view, given the respective sizes and the roles the various elements play in the mark, it is the word “IN” that would dominate the consumer’s overall impression of the Application Mark. The other elements have less significance given that they are either just decorative, consist of text which is descriptive or unintelligible to the average Singaporean consumer, or depict the goods or a packaging for the goods.

52 Visually, the marks in comparison have in common the “IN” element. Further, the font and stylisation used is similar, if not identical. However, the High Court stated in *The Polo/Lauren Co LP v United States Polo Association* [2016] SGHC 32 at [17] that the test for visual similarity is not one of substantial reproduction, but rather, visual similarity is to be assessed by examining each of the marks in question as a whole, bearing in mind their dominant and distinctive components and by reference to the overall impressions created by the mark or signs.

53 A well-established approach for the assessment of marks-similarity, in cases where there is a common component, is to consider whether the differences between the marks are sufficient such that the latter mark does not capture the distinctiveness of the earlier mark. In *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] SGHC 175, the High Court said (at [26]–[27]):

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


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

54 I have found above that the following elements would feature in the consumer’s imperfect recollection of Composite Mark 1 and Composite Mark 2: the “” device,

the word “WEIDER” and the word “IN”. It is obvious that the Application Mark does not have the first two elements and in this regard is enough so as not to capture the distinctiveness of Composite Mark 1 and Composite Mark 2.

55 I find that the marks are more dissimilar than similar.




Comparison between “IN” v “”

56 The Opponent’s Word Mark has only one component: the word “IN”. It consists of a common English word and is in plain font, without any colour. In my view its distinctiveness is normal or average. While “IN” does not describe the goods for which it is registered, it does not qualify as a mark that has greater technical distinctiveness. Consequently, it does not enjoy a high threshold before a competing sign will be considered dissimilar to it.

57 As for the Application Mark, I have found at [51] that it is the word “IN” that would dominate the average consumer’s overall impression of it. The word “IN” in the Application Mark is in a particular font but it is not unusual or highly stylised.

58 In this regard, it is to be noted that the Opponent’s Word Mark is in block capital letters and as such covers use of the mark in every font or style (*Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA [2013] 1 SLR 531 at [24]*). I must therefore consider use of the Opponent’s Word Mark in the font used for the word “IN” in the Application Mark.

59 There is therefore a considerable overlap in the marks and again I must consider whether the differences between the marks are sufficient such that the Application Mark does not capture the distinctiveness of the Opponent’s Word Mark.

60 The Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”), in relation to the comparison between the earlier ·CÆSAR· mark and the later  mark, said as follows:

41 We agree with the Appellant that the word “stone” is merely descriptive of the goods in Class 19. In this regard, the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (*Honda Motor Europe Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-363/06) [2009] ETMR 34 at [39]) and, for this reason, we do not think that the presence of such a descriptive element can fairly be regarded as being effective to displace similarity.

42 The Respondent contends that the amalgamation of the words “caesar” and “stone” creates a unique textual juxtaposition which is distinctive and not descriptive of the relevant goods. We disagree. The question is not so much one of the distinctiveness of the Respondent’s CAESARSTONE Mark on its own. Rather, the real question here is whether the word “stone” serves to *sufficiently and substantially distinguish* the Respondent’s CAESARSTONE Mark from the

Appellant’s CAESAR Mark (see [32] above). In our judgment, and as we have explained in the previous paragraph, because the word “stone” is merely descriptive of the goods in Class 19, it does not.

61 In the present case, the word “BAR” is similarly merely descriptive of the claimed goods that come in the form of bars. Following the approach of *Caesarstone*, this descriptive element cannot be regarded as being effective to displace similarity. As for the other elements of the Application Mark, for the same reason that I found that they are not likely to feature in the consumer’s imperfect recollection of it, they are also insufficient to displace similarity.

62 I therefore find that the Applicant has failed to sufficiently distinguish its mark from the Opponent’s and the marks are more similar than dissimilar. Having regard to the fact that the level of distinctiveness of the Opponent’s Word Mark is average, I would say that the degree of similarity is average.

Aural Similarity

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




64 As with the visual assessment, the Opponent’s case on the aural comparison focused on the common element “IN”, whereas the Applicant presented arguments to the effect that “WEIDER” was a distinguishing feature.

65 In my view, Composite Mark 1 and Composite Mark 2 would most likely be aurally referred to either as “WEIDER IN” in both cases or “WEIDER IN MULTIVITAMIN” and “WEIDER IN ENERGY” respectively. Whichever way they are referred to, their aurally dominant component would be the word “WEIDER” as it is technically distinctive in relation to the goods concerned as well as distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer. The Applicant’s Mark on the other hand, would be referred to as “IN BAR” and the aurally dominant component is the word “IN” as the word “BAR” describes the goods which come in the form of bars. The marks are therefore aurally dissimilar based on the dominant component approach.

66 As for the quantitative approach, I would also reach a similar conclusion. If Composite Mark 1 and Composite Mark 2 are read as “WEIDER IN”, they would have three syllables. On the other hand, the Application Mark has two. The marks cannot be said to have more syllables in common than not.

67 Considering the above, I therefore find that the marks are aurally more dissimilar than similar.



Comparison between “IN” v “”

68 Under the first approach, the dominant component of the Opponent’s Word Mark is the word “IN” as that is the only component in the mark. As for the Application Mark, I have found above that its aurally dominant component is the word “IN” (as the word “BAR” is descriptive) and consequently the marks are aurally identical. In this regard, it is to be recalled that the Court of Appeal in *Caesarstone* found the Respondent’s CAESARSTONE Mark aurally identical to the Appellant’s CAESAR Mark based on the dominant component approach.

69 As for the second approach, the marks have one syllable in common and one different. The marks cannot be said to have more syllables in common than not.

70 Overall, I find that the two marks have a high level of aural similarity.

Conceptual Similarity

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



Comparison between “” v “” and “” v “”

72 Here as before, the Opponent’s argument is that the marks are conceptually similar as they both contain the dominant element “IN”.

73 In my view the Opponent’s submission does not take into account the Court of Appeal’s caution in *Staywell* at [35] that greater care is needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts.

74 Composite Mark 1 and Composite Mark 2 have many components. However, the word “Weider”, which appears three times in each of the marks, is clearly a dominant component conceptually. To some, the word may be a family name, while others may see it as an invented word. In either case, this concept does not exist in the Application Mark and the marks are conceptually dissimilar.



Comparison between “IN” v “”

75 The Opponent’s Word Mark consists only of the word “IN”. “In” has several meanings in the dictionary but in the context of the goods, “in” is most likely to be taken as conveying something fashionable or popular.

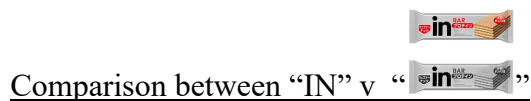
76 As for the Application Mark, the Applicant submits that it conveys the idea of a snack in a bar form, particularly since it includes an image of a wafer bar. However, this does not take into account the idea conveyed by the word “IN” in the Application Mark. As a whole, in my view, the Application Mark would convey the idea of a snack in bar form which is fashionable or popular.

77 Consequently, I consider that the marks are conceptually similar to a high degree.

Conclusion on Similarity of Marks



78 With regard to Composite Mark 1 and Composite Mark 2 in comparison to the Application Mark, I have concluded that they are visually and aurally more dissimilar than similar and conceptually dissimilar. Overall, they are therefore more dissimilar than similar.



79 With regard to the Opponent’s Word Mark and the Application Mark, I have concluded that they are visually similar to an average degree, and aurally and conceptually similar to a high degree. Overall, my conclusion is that they are more similar than dissimilar, and the degree of similarity is above average.

Similarity of Goods

80 The second step is to compare the goods for which registration is sought as against the goods for which the Opponent’s Word Mark is registered.

81 It is undisputed that in assessing the similarity of goods and services, I should have regard to the factors, or guidelines, set out in **British Sugar plc v James Robertsons & Sons Ltd** [1996] RPC 281 at 296. They are as follows:

- (i) the respective uses of the respective goods or services;
- (ii) the respective users of the respective goods or services;
- (iii) the physical nature of the goods or acts of service;
- (iv) the respective trade channels through which the goods or services reach the market;
- (v) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;
and

(vi) the extent to which the respective goods or services are competitive, including how the trade classifies them.

82 I now set out the respective goods in table form below.

Opponent’s Word Mark	Application Mark
<p><u>Class 32</u> Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.</p>	<p><u>Class 5</u> Dietary supplements for human; Nutritional supplements; Dietary supplemental bar; Meal replacement bar; Mineral nutritional supplements.</p> <p><u>Class 30</u> Confectionery; Cereal bars; Low calorie sweeteners; Low calorie sugar substitutes.</p>

83 The Applicant’s goods in Class 5 are dietary and nutritional supplements and meal replacement bars. The Opponent’s goods, on the other hand, are “non-alcoholic protein and/or carbohydrate energy drinks”. In my view, the uses of the respective goods are similar as they are consumed to increase physical well-being and health. In particular, meal replacement bars are consumed for the energy and nutrition they provide which is also the case for the Opponent’s protein and/or carbohydrate energy drinks.

84 The users of the respective goods are similar. They are both targeted at the public at large, in particular those seeking a quick nutritional or energy boost.

85 With regard to the physical nature of the goods, while I do not disagree with the Applicant’s submission that they are different as the Applicant’s goods are solid foodstuff in a bar form whereas the Opponent’s goods are liquid beverages sold in a pouch, I find that for the present set of goods this factor is not helpful. This is because some goods can come in different forms but yet be similar. For example, chocolate can be in liquid form or in the form of a bar, but the different forms would not prevent the goods (both being chocolate) from being regarded as similar by the consumer. I therefore find that this factor is neutral and not in favour of similarity or dissimilarity.

86 In terms of trade channels, the Opponent’s goods and the Applicant’s goods are made available to consumers through supermarkets and specialty stores. They therefore have similar trade channels. The goods are, however, not found on the same shelves in the supermarkets. Nonetheless, I do not consider this is fatal to a finding of goods-similarity as the average consumer is not unaccustomed to seeing such goods coming from the same origin despite them being found on different shelves of the supermarket. The Applicant is an example of such a manufacturer producing both meal replacement bars and energy drinks.

87 Finally, both the Applicant’s and Opponent’s goods serve to provide energy and/or nutrition. There is likely to be a degree of competition between them.

88 Having regard to the above, I find that the parties' goods are more similar than dissimilar, and the degree of similarity is average.

Likelihood of Confusion

89 As I have found that there is the requisite similarity of marks and of goods, I now proceed to consider whether there is a likelihood of confusion as a result of those similarities.

90 In *Caesarstone* at [56] the Court of Appeal explained:

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

91 At this stage, the following factors relating to consumer perception may be taken into account (*Staywell* at [96(a) and (b)]):

- (i) Factors that affect the impact of mark similarity on the consumer: the degree of similarity of the marks themselves, the reputation of the marks, the impression given by the marks and the possibility of imperfect recollection.
- (ii) Factors that affect the impact of goods similarity on the consumer: these include the normal way in or the circumstances under which consumers would purchase goods of that type, whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of attention on the part of the purchaser, and the likely characteristics of the relevant consumer and whether the relevant consumers would or would not tend to apply care or have specialist knowledge in making the purchase.

Factors Relating to the Impact of Marks-similarity

92 I have concluded at [80] that the Opponent's Word Mark and the Application Mark are similar to an above average degree.

93 In relation to the reputation of the marks, the Opponent submits that the family of "IN" and "IN-formative" marks has a strong reputation by virtue of the Applicant's extensive use of them in and outside of Singapore since 1983. However, it appears to me that the Opponent's evidence on this point is weak. Firstly, a large amount of the Opponent's evidence relates to use outside Singapore and secondly, all the evidence shows use of the Opponent's Word Mark in conjunction with other distinctive elements such as the "W" device and the word "WEIDER". An example of such use is:



94 The evidence thus falls short of showing that the Opponent’s reputation lies in the word “IN” in Singapore, even if I am prepared to consider the family of marks point which has not been pleaded. This factor is thus neutral and does not assist the Opponent.

95 As for impression of the marks, the Opponent’s Word Mark has only the word “IN” and that is the only factor contributing to its impression. On the other hand, the Application Mark has several other elements in addition to the word “IN” which can potentially contribute to the impression of the mark. However, the other elements are descriptive, and the average consumer is unlikely to place trade mark significance on them. Consequently, their impression of the Application Mark will be on the word “IN”. The average consumer is thus very likely to be confused into thinking that the Application Mark is an example depicting the packaging of the Opponent’s product for meal replacement bars and hence assume that it comes from the same or an economically linked undertaking.

Factors Relating to the Impact of Goods-similarity

96 I have concluded at [88] that the parties’ goods are similar to an average degree.

97 The goods concerned are ordinary consumer products that are commonly purchased in supermarkets or establishments where goods are arranged on shelves and where consumers are guided more by the visual impact of the marks they are looking for. I have found earlier that the marks have a medium degree of visual similarity. I do not however, discount the fact that the goods may also be purchased aurally and in this regard the marks are aurally similar to a high degree.

98 While the goods are relatively inexpensive, because the goods are to be consumed for energy and nutritional benefits, the consumer is likely to devote some attention and care to the purchase. Nonetheless, overall, I do not think that this is sufficient to obviate a likelihood of confusion, taking into account the similarities between the marks and the goods, and particularly that it is not uncommon for the goods concerned to come from the same origin. The Opponent’s customers or potential customers encountering the Applicant’s goods may assume that they come from the same or an economically linked undertaking.

Conclusion on Likelihood of Confusion

99 Taking all the above factors into account, I find that there is a real risk of a likelihood of confusion between the Application Mark and the Opponent’s Word Mark.

Conclusion on Section 8(2)(b)

100 The ground of opposition under Section 8(2)(b) therefore succeeds.

Ground of Opposition under Section 8(4)(b)(i), 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B)

101 Section 8(4) of the Act reads:

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

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

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

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

(ii) if the earlier trade mark is well known to the public at large in Singapore —

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

Decision on Sections 8(4)(b)(i), 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B)

102 As it can be seen from the above, there are three sub-grounds of opposition within Section 8(4) of the Act, namely: 8(4)(b)(i); 8(4)(b)(ii)(A); and 8(4)(b)(ii)(B). Two elements are common to all three sub-grounds, namely:

(i) The whole or essential part of the later trade mark must be shown to be identical with or similar to the earlier trade mark; and

(ii) The earlier trade mark must be shown to be well known in Singapore. (Although Sections 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B) concern marks that are *well known to the public at large* in Singapore, a mark that is not well known in Singapore cannot be well known to the public at large in Singapore.)

If either (or both) of these elements cannot be established, the opposition under all three sub-grounds of Section 8(4) of the Act will fail.

Similarity of Marks

103 The High Court in ***Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd*** [2015] 5 SLR 618 (“***Rovio***”) held, at [146], that while there is a difference in the wording of the two provisions, there is no material difference between the similarity of marks enquiry under Section 8(2)(b) and Section 8(4) of the Act.

104 I have dealt with the issue of marks-similarity earlier under Section 8(2)(b) and found as follows: (a) in respect of Composite Mark 1 and Composite Mark 2, they are more dissimilar than similar to the Application Mark; and (b) in respect of the Opponent’s Word Mark, there is an above average degree of similarity to the Application Mark.

105 The inquiry therefore ends here in respect of Composite Mark 1 and Composite Mark 2, and I will proceed with the analysis for the Opponent’s Word Mark.

Whether the Opponent’s Word Mark is Well Known in Singapore

106 Given my finding earlier at [93] that the Opponent has not adduced evidence of use of the Opponent’s Word Mark on its own but only use of it in conjunction with other distinctive elements such as the “W” device and the word “WEIDER”, I am unable to conclude that by virtue of such use, the Opponent’s Word Mark has become well known. In fact, it appears that in some supermarkets, the Opponent’s goods are tagged as Weider Jelly Drink and no reference is made to the Opponent’s Word Mark at all⁸.

107 Having found (on the evidence adduced by the Opponent) that the Opponent’s Word Mark is not well known in Singapore, all three sub-grounds of Section 8(4) of the Act will fail.

Conclusion on Sections 8(4)(b)(i), 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B)

108 The three grounds of opposition under Sections 8(4)(b)(i), 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B) therefore fail.

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

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

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)

110 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:

26 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.

⁸ OSD1 pp 387 and 455.

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.

27 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.

28 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, focusing 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) (“*Wallow 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.

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

Goodwill

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

33 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. ...

34 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 (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 (“*Lifestyle 1.99*”) at [20]–[24]; *Wallow 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]).

113 I have no doubt that the Opponent operates a business and that the business has acquired sufficient goodwill to justify protection under the law of passing off.

Misrepresentation

114 The Court of Appeal in *Singsung* clarified at [38]:

...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...*

(Emphasis mine)

115 I have examined the Opponent's evidence of use earlier and found that there is no use of the Opponent's Word Mark on its own, independently of the "W" device and the word "WEIDER". There is therefore no evidence to support a finding that it is the word "IN" that is distinctive of the Opponent's goods.

116 Consequently, I am unable to find that there is misrepresentation from the use of the Application Mark, merely because it contains the word "IN".

Conclusion on Section 8(7)(a)

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

Conclusion

118 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds on the ground under Section 8(2)(b) but fails on the other five grounds raised by the Opponent. The application shall therefore be refused.

Costs

119 As the Opponent has succeeded on only one out of six grounds of opposition and taking into account all the circumstances of the case, the Opponent will be entitled to 50% of its costs, which are to be taxed, if not agreed.

Date of Issue : 8 December 2020