

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

Trade Mark No. 40201816895W
17 June 2021

IN THE MATTER OF A TRADE MARK APPLICATION BY

DR. AUGUST WOLFF GMBH & CO. KG ARZNEIMITTEL

AND

OPPOSITION THERETO BY

COMBE INTERNATIONAL LTD.

Hearing Officer: Sheik Umar Bin Mohamed Bagushair
IP Adjudicator

Representation:

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

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

GROUND OF DECISION

1 The Applicant, Dr. August Wolff GmbH & Co. KG Arzneimittel (“Applicant”), had previously registered the trade mark “VAGISAN” in relation to intimate care products. The Opponent, Combe International Ltd. (“Opponent”), who owns the “VAGISIL” mark in Singapore and has been selling intimate care products with that mark, applied to invalidate the Applicant’s registration. The Opponent succeeded before the Registrar of Trade Marks because it was found that the marks “VAGISAN” and “VAGISIL” were similar and there existed a likelihood of confusion amongst the

public if goods were sold bearing the “VAGISAN” mark. The decision was upheld on appeal.

2 The Applicant now seeks to register “DR. WOLFF’S VAGISAN” for use in relation to intimate care products. The registration is opposed by the Opponent. I had to decide whether I should allow the registration.

Background Facts

3 The Applicant is part of a family business, the Dr. Wolff Group, that was founded in 1905 and named after its founder Dr. August Wolff. The Applicant researches, manufactures and markets dermatological, medicinal and cosmetic products that are distributed in many countries. In 1994, the Dr. Wolff Group conceived the name “VAGISAN” for use in connection with intimate care products. According to the Applicant, “VAGISAN” was conceptualised to be a portmanteau of the English word “vagina” and the Latin word “sanitas” (which means “health”). The Applicant’s intimate care products, which are now sold in many countries, first bore the “VAGISAN” mark in 1998. The Applicant registered the “VAGISAN” mark in Singapore on 19 March 2012. However, the Opponent commenced proceedings to invalidate the Applicant’s registration for “VAGISAN”. The invalidation action before the Registrar was decided in favour of the Opponent (see *Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2020] SGIPOS 3 (“*Vagisan (IPOS)*”). The appeal against the Registrar’s decision was heard before Hoo Sheau Peng J, who dismissed the appeal (see *Dr. August Wolff GmbH & Co. KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626 (“*Vagisan (HC)*”).

4 On 25 May 2018, the Applicant applied to register the trade mark  (“Application Mark”) in Singapore under Trade Mark No. 40201816895W in Classes 3 and 5. The specifications of goods relevant to this opposition are set out below:

Class 3

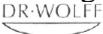
Toiletries, namely non-medicated cleansers for intimate personal hygiene purposes, vaginal moist crèmes and vaginal salves (not for medical purposes).

Class 5

Medical preparations, namely, medicated ointments for vaginal application, vaginal anti-dermo-infectives suppositories and vaginal anti-dermo-infectives capsules; dietetic preparations and dietary supplements for preserving health of the vaginal mucosa; sanitary preparations and articles for vaginal application.

5 The Applicant says that the name “DR. WOLFF”, apart from referring to the founder of the Group, is also used as a trade mark and has, for several decades, appeared on the packaging and marketing materials relating to the Applicant’s products, such as Plantur, Alpecin, Linola, and Vagisan. “DR. WOLFF” has been used in Singapore since as early as 2015.

6 The Applicant is the registered proprietor of the mark “DR. WOLFF” and other “DR. WOLFF” formative marks, covering goods in Classes 3 and 5 in many countries and regions worldwide, including in the United Kingdom, Australia, Hong Kong, Malaysia, India, and the European Union.

7 In Singapore, the Applicant is the proprietor of Trade Mark No. 40201700582X for “”, which covers “perfumery, essential oils, cosmetics, hair lotions, dentifrices” in Class 3, and “pharmaceutical and veterinary preparations; sanitary products for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth and dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides” in Class 5.

8 The Opponent is a personal care company founded in the United States of America in 1949, with products sold in 64 countries on 6 continents. Vagisil is one of the Opponent’s brands which has become a trusted feminine care brand around the world, and has been a global leader in intimate health for 40 years. The Opponent commenced use of the trade mark “VAGISIL” in 1973 and has since been continuously using the trade mark “VAGISIL” extensively worldwide in the course of trade. In Singapore, the VAGISIL trade mark was used as early as 1989.

9 The Opponent is the registered proprietor of the following “VAGISIL” registered marks and rely on them in this opposition (“Earlier Marks”):

Trade Mark No., Mark and Registration Date	Specification of Goods
T9804751Z VAGISIL 20 May 1998	Class 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.
T9804752H VAGISIL 20 May 1998	Class 5: Pharmaceutical preparations, medicated creams, and vaginal suppositories.
T0813410H VAGISIL 29 September 2008	Class 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.
T1112897J VAGISIL	Class 5: Vaginal lubricants; and medicated products for feminine use, including medicated feminine anti-

19 September 2011	itch creams, and premoistened feminine hygiene wipes.
40201507713Y VAGISIL 5 December 2014	<p>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; non-medicated douches; non-medicated moisturizers for the skin at the external vaginal area; non-medicated pre-moistened 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>

Procedural History

10 As stated earlier, the Applicant applied to register the Application Mark on 25 May 2018 in Classes 3 and 5.

11 The application was accepted and published on 7 December 2018 for opposition. The Opponent filed its Notice of Opposition to oppose the registration of the Application Mark on 8 April 2019. The Applicant filed its Counter-Statement on 23 August 2019.

12 The Opponent filed its evidence in support of the opposition on 3 April 2020. The Applicant filed its evidence in support of the application on 3 July 2020. The Opponent filed its evidence in reply on 3 November 2020. Following the close of evidence, a Pre-Hearing Review was held on 24 November 2020 and parties were directed to inform the Registrar how they wished to proceed with this opposition after the High Court decided on the appeal from the decision in *Vagisan (IPOS)*. After the High Court released its decision on 25 February 2021 (see *Vagisan (HC)*), the parties indicated that they wished to proceed with this opposition. A second Pre-Hearing Review was held on 9 April 2021 to prepare the matter for hearing. The opposition was heard on 17 June 2021.

13 After the hearing, parties were requested to file brief written submissions on the recent decision of *GCIH Trademarks Limited v Hardwood Pte Ltd* [2021] SGIPOS 6

(which was released on 3 June 2021) (“*GCIH*”) that discussed (amongst other things) whether evidence of use can be considered in the marks-similarity assessment stage.

Grounds of Opposition

14 The Opponent relies on Section 8(2)(b), Section 8(4) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (the “Act”) in this opposition.

Opponent’s Evidence

15 The Opponent’s evidence comprises the following:

- (a) a Statutory Declaration made by Laura Quintano, Vice President of the Opponent, on 1 April 2020 in the United States of America;
- (b) a Statutory Declaration in Reply made by the same Laura Quintano on 30 October 2020 in the United States of America.

Applicant’s Evidence

16 The Applicant’s evidence comprises a Statutory Declaration made by Angela Thevessen, Export Manager of the Applicant, on 2 July 2020 in Bielefeld, Germany.

Applicable Law and Burden of Proof

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

MAIN DECISION

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

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

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

...

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

19 The marks under comparison are reproduced below for ease of reference. While there are differences in the font of the Earlier Marks set out at [9] above, the differences are very slight. The Earlier Marks all appear in upper case in a plain font and the differences in font have no bearing on my visual comparison of the marks. I set out the representation of the Opponent’s trade mark number T9804751Z below for the purposes of comparison.

Application Mark	Earlier Mark
	

Applicable legal principles: Marks-similarity assessment

20 Save for the issue of whether evidence of use can be considered at the marks-similarity assessment stage, I do not believe parties dispute the broad principles applicable when considering the similarity of marks. The applicable principles can be summarised as follows (see *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [40] (“*Hai Tong*”)):

- (a) The thrust of the inquiry into similarity is directed at assessing substantive similarity. The three aspects of this evaluation, namely, visual, aural and conceptual similarities, aid the court’s evaluation by signposting its inquiry. They do not serve as a mechanistic formula of any sort. It follows that the law does not require all three similarities (visual, aural and conceptual) to be made out before the registered mark and the allegedly infringing mark may be found to be similar. Conversely, the fact that any one similarity is made out does not necessarily mandate a finding that the two marks are similar. Nor is each aspect of similarity of equal importance. Rather, the relative importance of each will depend on the circumstances, including the nature of the goods and the types of marks involved and a trade-off can be made between the three aspects of similarity.
- (b) In assessing the similarity between two contesting marks, the court considers them “as a whole”, but does not take into account “any external added matter or circumstances” because the comparison is “mark for mark”.
- (c) The viewpoint the court should assume is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.
- (d) Furthermore, it is assumed that the average consumer has “imperfect recollection”. As such, the two contesting marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, the court will consider the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.

21 The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) emphasised that the analysis comprises a “step-by-step” approach. The court is required to systematically assess the similarity of marks, the similarity of goods

or services, and then the likelihood of confusion arising from the two similarities. Only after the court has determined the presence of the first two elements individually can it then ascertain the likelihood of confusion.

22 Integrated into the analysis of visual, aural and conceptual similarity is a consideration of whether the earlier mark is distinctive (in both its technical and non-technical sense) (*Staywell* at [30]). In the non-technical sense, distinctiveness refers to “what is outstanding and memorable about the mark”. Such components tend to draw the average consumer’s attention and stand out in the average consumer’s imperfect recollection (*Staywell* at [23]).

23 In the technical sense, distinctiveness ordinarily refers to a mark’s inherent capacity (i.e., relating to a mark’s fanciful or descriptive nature) or acquired capacity (i.e., based on the duration and nature of the use of the mark) to operate as a badge of origin (*Hai Tong* at [31]–[33]). A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (*Staywell* at [25]).

24 The Court of Appeal in *Hai Tong* emphasised that ultimately the matter is one of “the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.”

The distinctiveness of the Earlier Marks

25 Although distinctiveness is not a separate step at the marks-similarity assessment stage, it made sense to consider it separately in this instance. I do so for two reasons. First, the court in *Vagisan (HC)* had already opined on the distinctiveness of the Earlier Marks as at 19 March 2012 (which was the registration date of the Applicant’s “VAGISAN” trade mark) and I consider that decision to be binding on me. The court in *Vagisan (HC)* had held that, as a whole, the Earlier Marks possessed a normal degree of distinctiveness (at [24]). The court pointed out at [25] of *Vagisan (HC)* that as a result the threshold to surmount before a competing mark (such as the Application Mark) will be regarded as being dissimilar is but a moderate one.

26 Second, the Opponent has made a specific argument that between 19 March 2012 and 25 May 2018 (the application date of the Application Mark), the Earlier Marks have acquired a higher level of distinctiveness through use. The specific argument by the Opponent raised a legal issue which I understand to have been the subject of differing views from hearing officers and IP Adjudicators, namely whether it is permissible to consider evidence of use at the marks-similarity assessment stage.

27 The reason why the issue is of some difficulty is because the Court of Appeal in *Staywell* at [20] had stated that the assessment of marks similarity is “mark-for-mark without consideration of any external matter.” Yet, the case law is also clear that technical distinctiveness “*is an integral factor in the marks-similarity inquiry*” (*Staywell* at [25]) and that technical distinctiveness can be inherent or acquired through use. How else can one establish that distinctiveness has been acquired through use if not through “external matter”? Indeed, in *Hai Tong*, the Court of Appeal explained that to determine whether a mark had acquired distinctiveness through use, the factors the court considers would include (at [33]):

- (a) the market share held by the registered mark;
- (b) the nature of its use (whether or not it was intensive, widespread and long-standing);
- (c) the amount invested in promoting the mark;
- (d) the proportion of the relevant class of individuals who identified goods sold under the mark as emanating from a particular source; and
- (e) any statements from trade associations and chambers.

28 In *GCIH*, the opponent argued that evidence of acquired distinctiveness can be taken into account at the marks-similarity assessment stage. However, Principal Assistant Registrar Ong Sheng Li, Gabriel held that the opponent was in truth relying on evidence of acquired distinctiveness not so much to support arguments on mark-similarity but to enhance its case on confusion. As such, PAR Ong did not think it was strictly necessary for him to decide whether evidence of acquired distinctiveness can be taken into account at the marks-similarity assessment stage. Nevertheless, he considered the issue in some detail in a postscript. At [103] to [113] of *GCIH*, PAR Ong summarised the differing views of different hearing officers and IP Adjudicators and set out various arguments which could support either approach.

29 The decision in *GCIH* was released on 3 June 2021, shortly before the hearing on 17 June 2021. As I thought that PAR Ong’s discussion in *GCIH* on whether evidence of acquired distinctiveness can be taken into account at the marks-similarity assessment stage was useful, I asked parties to make brief submissions on it. Not unexpectedly, the Opponent argued that such evidence can be taken into account at the marks-similarity assessment stage whilst the Applicant argued otherwise.

30 It is not necessary for me to set out the details of the arguments. I appreciate that fair arguments can be made either way. I would however approach the matter more simply, as a matter of *stare decisis*. In my view, it is acceptable to take into account evidence of acquired distinctiveness at the marks-similarity assessment stage as that was explicitly allowed in *Hai Tong* at [33] and *Doctor’s Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193 at [21] (“*Doctor’s Associates*”). PAR Ong in *GCIH* at [33] suggests that since cases like *Hai Tong* were decided before *Staywell*, they “do not advance the discussion on this specific issue.” I respectfully disagree. I would be cautious about holding that earlier rulings of the Court of Appeal are no longer good law because they appear to contradict more recent rulings of the Court of Appeal, unless the position is explicitly clear. The situation is far from clear in this case and it cannot be said with certainty that the effect of the pronouncements in *Staywell* at [20] meant that the principles in *Hai Tong* at [33] are no longer good law. The fact that the situation is less than clear can be seen from the decision of Lee Seiu Kin J in *Polo-Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 at [28] where he says that “it is less clear whether *Staywell* contemplates that earlier trade marks which are already inherently distinctive can become more distinctive through use and that this enhanced distinctiveness can be taken into consideration at the marks-similarity stage.”

Whether the Earlier Marks had acquired a high level of distinctiveness through use

31 The starting point is that, as at 19 March 2012, the Earlier Marks possess a normal degree of distinctiveness (*Vagisan (HC)* at [24]). In assessing whether the Earlier Marks have acquired enhanced distinctiveness since then through use, I will need to consider the non-exhaustive indicia set out *Hai Tong* at [33] (see above at [27]).

32 The Opponent argued that the Earlier Marks had acquired a high level of distinctiveness through use because of the following matters:

- (a) The Opponent's Vagisil products are sold in several popular retailers island wide, including Watson's, Guardian, NTUC FairPrice, Unity Pharmacy and Cold Storage, lower trade stores such as Venus Beauty, Pink Beauty and Tomato, and several popular 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.
- (b) As of 27 August 2018, the Vagisil Singapore Facebook page had 20,249 followers.
- (c) Between the 8-month period from January 2014 to August 2014, the content of Vagisil Singapore's Facebook page had an estimated total of 728,226 views.
- (d) In a hospital sampling exercise in 2015, the Opponent distributed a total of 9,000 Vagisil samples over a 6-month period at 2 hospitals.
- (e) In a hospital sampling exercise in 2017, the Opponent distributed a total of 24,500 Vagisil samples over a 5-month period at 8 hospitals.
- (f) In a hospital sampling exercise in 2018, the Opponent distributed a total of 42,000 Vagisil samples over a 12-month period at 8 hospitals.
- (g) In June and July 2016, 96 panel advertisements for the Opponent's Vagisil products were placed on the platform screen doors at Buona Vista MRT station. Buona Vista MRT station is an interchange station on the East West Line and the Circle Line.
- (h) The Opponent sponsored the Great Eastern Women's Run in 2015 and 2016. For the event in 2016, there were 17,000 participants. The Opponent provided vouchers for Vagisil products in the event goodie bag and set up a promotional booth on the day of the event. The "VAGISIL" mark appeared on banners and other promotional material in connection with the event.
- (i) The Opponent ran brand activation campaigns in various locations in 2017 and 2018, including the Institute of Mental Health (twice a month for 4 months), Changi General Hospital, Gleneagles Hospital, KK Women's and

Children’s Hospital, Mount Elizabeth Hospital, the NTUC Union Bazaar and the SingHealth Bazaar where the “VAGISIL” mark and Vagisil products were prominently displayed.

- (j) The Opponent sponsored four articles which were accompanied by advertisements for Vagisil products in the Chinese language U-Weekly magazine from November 2017 to February 2018 to target Chinese-speaking females in Singapore.
- (k) The Opponent collaborated with Amore Fitness in November 2016 and January 2017. Amore Fitness is a leading fitness centre with 8 locations in Singapore. The Opponent set up a contest through Facebook for users to win passes for free classes at Amore Fitness, and also collaborated with Amore Fitness to develop four exercise videos which were posted on the Vagisil Singapore Facebook page. The videos garnered no less than 4,300 views each, with top watched video garnering no less than 8900 views.
- (l) From March to April 2018, advertisements for the Opponent’s Vagisil products appeared on 210 advertisement panels in SMRT trains.
- (m) The Opponent has used the “VAGISIL” trade mark in Singapore from as early as 1989.
- (n) The Opponent has spent the following amounts in trade promotion spend and consumer advertising and promotional expenses in Singapore from 2011 to June 2018:

Year	Trade promotion spend (USD)
2011	144,450
2012	174,305
2013	165,196
2014	105,762
2015	145,407
2016	147,333
2017	173,904
Jan to June 2018	57,017

33 I should point out that the above matters are the same matters which the Opponent relies on to establish that the Earlier Marks are well known under Section 8(4)(b)(i) of the Act.

34 The Applicant argued that the matters relied on by the Opponent at [32] above are insufficient to establish enhanced distinctiveness through use. Broadly speaking, the Applicant argued that there is scant evidence that the Opponent Marks have been used since 1989, the evidence of advertising and promotional activities is not consistent and there is no evidence of the market share of Vagisil products or of the size of the market for similar products.

35 Having considered the evidence carefully, I am unable to agree with the Opponent that the Earlier Marks have acquired a high level of distinctiveness through use. I say this for five reasons.

36 First, no evidence has been provided as to the market share of Vagisil products in Singapore, or even of the market size of similar products generally in Singapore. I would be surprised if the Opponent did not possess this information. I note, for example, that the Opponent’s related company Combe Incorporated had no problems producing evidence of Vagisil products’ “market dominance in both percentage of and numeric rank within its markets (ranging from 50 to 94% of certain products’ market share since the 1990s and several products ranking in the first and second best-selling spots for their markets)” in opposition proceedings in the United States (*Combe Incorporated v. Dr. August Wolff GMBH*, Appeal No. 19-1674 (4th Cir. 2021) at 7 (“*Vagisan (US)*”).

37 Second, there is also no evidence produced of the proportion of the public who identified goods sold under the “VAGISIL” mark as emanating from a particular source. Whilst this information may not be readily available, it is something that can be procured by the Opponent by conducting a consumer study or survey. I note that such a study was produced in the US opposition proceedings (see *Vagisan (US)* at 8).

38 Third, the amounts invested in promoting the Earlier Marks have not been consistent through the years. I note that in 2012, USD 174,305 was spent but the figure dropped significantly to USD 105,762 in 2014. Whilst the figures have increased since, they have not matched the amount spent in 2012. Indeed, in the first half of 2018, the amount spent on trade promotion was only USD 57,017, suggesting that the full-year sum is likely to be in the range of USD 120,000 or so.

39 Fourth, I am unable to conclude that the Opponent’s promotional and advertising activities for Vagisil products are widespread, intensive and consistent. There is no evidence of consistent and widespread advertising in one or more mediums. For example, in relation to the advertising on trains and train stations, the Opponent could only point to two occasions when this was done – in June and July 2016 and March to April 2018. Similarly, the brand activation campaigns in a number of hospitals and other locations only occurred in 2017 and 2018. I acknowledge that the promotional activities for the Great Eastern Women’s Run in 2015 and 2016 could have led to significant public exposure but the Opponent did not conduct similar activities after 2016, even for other events. I also acknowledge that the hospital sampling exercises in 2015, 2017 and 2018 could potentially be an instance of widespread promotional activities. However, based on the number of Vagisil product samples distributed, the duration of the exercise and the hospitals covered, it appeared to me that only the sampling exercises in 2017 and 2018 could possibly be said to be widespread.

40 Fifth, if indeed the Earlier Marks had acquired a high level of distinctiveness between 2012 to 2018, this did not correlate to increased sales of Vagisil products during the same period. The Opponent’s gross sales figures for Vagisil products in Singapore from 2011 to 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
Jan to June 2018	174,336

41 It is fair to say that the sales figures of Vagisil products in Singapore do not present a picture of a mark that has through the years become more distinctive or recognisable. There is a significant drop in sales in 2014. Sales figures have not reached the peak in 2012. In 2018, it also looks like sales figures for the whole year is likely to be at around \$400,000, based on extrapolating the sales figures for the first half of the year. That would represent the lowest sales ever of Vagisil products in Singapore since 2014. A finding that the Earlier Marks have in 2018 acquired a high level of distinctiveness is incongruous with the sales figures, especially the 2018 sales figures. Whilst I acknowledge that it is possible for a mark to become more distinctive over time without being accompanied by increased sales, I think the sales figures provide some indirect support for my conclusion that the Earlier Marks have not acquired a high level of distinctiveness through use over the years.

42 I therefore conclude that the Earlier Marks have not acquired a high level of distinctiveness through use as at 25 May 2018.

Mark-similarity assessment

The dominant and distinctive element in the Application Mark

43 The central thrust of the Opponent's case is that the dominant and distinctive element in the Application Mark is the word "VAGISAN" because:

- (a) The word "VAGISAN" appears in a larger and fancier font than the word "DR. WOLFF'S".
- (b) "VAGISAN" is an invented word and hence more distinctive. DR-formative marks are less distinctive when used in relation to Class 3 and Class 5 goods because it is not unusual for such goods to have some degree of association with a medical professional. The use of "DR" followed by a name is also commonly used for Class 3 and Class 5 goods in Singapore; consequently, consumers are likely to look to other components in the Application Mark to differentiate it from other DR-formative marks in the market.
- (c) Consumers in Singapore are also unlikely to recognise "DR. WOLFF" as a badge of origin because of its limited use in Singapore as a brand name. They are likely to perceive "DR. WOLFF" as the name of an individual, a doctor whose name is Wolff, rather than as a badge of origin.

44 The Applicant however argued that the element "DR. WOLFF'S" in the Application Mark is more than or at least of equal distinctiveness with the element

“VAGISAN”. “VAGISAN” is not the dominant and distinctive element in the Application Mark. This is because:

- (a) The words “DR. WOLFF’S” and “VAGISAN” are of almost equal font size. No one component is larger than the other in any material way. The words are also in an identical font and they occupy the same visual space in the Application Mark.
- (b) A trade mark can be considered to have a high level of inherent distinctiveness even though the words and phrases are not newly coined if the meaning has little bearing on the product to which it is to be applied. Here, “DR. WOLFF’S” has no bearing on the goods being sold and is also not a common surname in Singapore. As such, “DR WOLFF’S” has a high level of inherent distinctiveness.
- (c) “DR. WOLFF’S” is even more distinctive because of the presence of the possessive modifier and the fact that the possessive noun comes before the words “VAGISAN”.
- (d) The Opponent argued that “VAGISAN” is the dominant and distinctive element in the Application Mark and that the element “DR. WOLFF’S” was less distinctive because it was common to see trade mark registrations of DR-formative marks in Class 3 and Class 5 goods, and the sale of such goods bearing DR-formative marks. The Applicant however argued that this disregards the fact that a consumer viewing the mark would focus on the entire word, namely “DR. WOLFF’S” and not just “DR.” alone. The Opponent’s argument therefore wholly disregards the existence of “WOLFF’S”.
- (e) If anything, the existence of trade mark registrations of DR-formative goods for Class 3 and Class 5 goods as well as the sale of such goods suggested instead that customers are accustomed to recognising DR-formative marks as distinctive and indicative of trade origin. To put it another way, if DR-formative marks did not function well as indicators of trade origin, they would not be heavily utilised to sell Class 3 and Class 5 products.
- (f) Even if “DR.” was commonly used, the consumer would turn to other elements of the Application Mark, namely “WOLFF’S VAGISAN” and not “VAGISAN” alone.

45 I am in broad agreement with the Applicant and find that the element “DR. WOLFF’S” in the Application Mark is at least of equal distinctiveness with the element “VAGISAN”. I am unable to agree that the dominant element in the Application Mark is “VAGISAN”. I say this for the following reasons.

46 First, I disagree that the size of the word “VAGISAN” is obviously larger than “DR. WOLFF’S”. Counsel for the Opponent at the hearing tendered an A4 sized print-out containing a magnified image of the Application Mark to show that there was a significant difference in the sizes of the two words. However, the Application Mark

when used in products and packaging would never be blown up to such a size and so I am not sure comparing it in this way is helpful or realistic. I would acknowledge that there is a difference in size but the difference is not significant especially when printed in smaller sizes on the packaging of products. I also disagree that the fonts of the two words are different. The word “VAGISAN” is not in a fancier font. This can be seen by comparing the letter “S” which is common to both words.

47 Second, I disagree that DR-formative marks are less distinctive when used in relation to Class 3 and Class 5 goods. Whilst I acknowledge that there are many examples of DR-formative marks used for Class 3 and Class 5 goods, I do not think it follows that DR-formative marks are less distinctive or do not function well as a badge of origin. On the contrary, the fact that many companies register and use DR-formative marks for Class 3 and Class 5 goods suggests that they actually function well as a badge of origin. If the Opponent is correct that consumers are likely to gloss over DR-formative marks and look to other components of the mark, how would the owner of these DR-formative marks otherwise distinguish themselves from their competitors when selling common products such as moisturisers, face washes or eye creams?

48 Third, a number of elements in “DR. WOLFF’S” also point to it being distinctive and at the very least of equal distinctiveness with “VAGISAN”. The first is the fact that the Applicant has successfully registered the trade mark “DR. WOLFF” in Class 3 and Class 5 (see [7] above). Second, the element “DR. WOLFF” has no obvious bearing or link to the goods being sold. I acknowledge of course that DR-formative marks are not uncommonly used for similar products but the element as a whole, i.e., “DR. WOLFF’S”, is not something obviously linked to the goods. Third, “WOLFF” is an uncommon surname in Singapore. Fourth, the presence of the possessive modifier in “DR. WOLFF” and the fact that the possessive noun comes before “VAGISAN” also does make “DR. WOLFF’S” more striking, or at least somewhat more memorable than not. All in all, these elements pointed to “DR. WOLFF’S” being distinctive and at the very least of equal distinctiveness with “VAGISAN”.

49 Finally, whilst I acknowledge that the Earlier Marks are distinctive, they only possess a normal degree of distinctiveness (*Vagisan (HC)* at [24]). I do not agree that the Earlier Marks have now acquired a higher level of distinctiveness through use.

50 I therefore find that the element “DR. WOLFF’S” in the Application Mark is distinctive and is at least of equal distinctiveness with the element “VAGISAN”. I do not agree that the dominant element in the Application Mark is “VAGISAN”.

Visual similarity

51 On the premise that the dominant and distinctive element in the Application Mark is the word “VAGISAN”, the Opponent argued that the Application Mark and Earlier Marks have visual similarity. This is because the court in *Vagisan (HC)* had found that the “VAGISAN” and “VAGISIL” marks were visually similar.

52 The Applicant argued that the Application Mark is dissimilar from the Earlier Marks because:

- (a) The Application Mark has 15 letters where else the Earlier Marks have 7 letters. The Application Mark is more than twice the length of the Earlier Marks.
- (b) The Application Mark has two additional words compared to the Earlier Marks and so the structure of the Application Mark is different from the Earlier Marks.
- (c) Only 5 out of the 15 letters in the Application Mark are common to the Earlier Marks. Further, of the 5 letters, 4 of them (i.e., “V”, “A”, “G” and “I”) are of weak distinctive character and insufficient to displace the dissimilarity created by the other elements in the Application Mark, namely “DR.”, “WOLFF’S” and “SAN”.

53 As the Opponent’s argument on visual similarity is premised on a prior finding that the dominant and distinctive element in the Application Mark is “VAGISAN”, in light of my contrary finding, the argument falls away. Quite apart from this, the Applicant’s argument is in any event sound and is supported by authorities.

54 I start with *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 (“*Ozone*”) where at [49] the court held that a determination of visual similarity typically involves looking at:

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

55 In respect of the length of the marks, in *Ozone*, the compared marks were 15 and 7 letters respectively. In *Monster Energy Company v Glamco Co, Ltd* [2021] 3 SLR 319 (“*Monster*”), the compared marks were 12 and 7 letters respectively. In *Clarins Fragrance Group fka Thierry Mugler Parfums SAS v BenQ Materials Corp* [2018] SGIPOS 2 (“*Clarins*”) and *Itochu Corporation v Worldwide Brands, Inc* [2007] SGIPOS 9 (“*Itochu*”), the marks were 10 and 5 letters respectively. In *Beats Electronics, LLC v LG Electronics Inc* [2016] SGIPOS 8 (“*Beats*”), the marks were 8 letters and 5 letters respectively. In all of these cases, the marks were found held to be visually dissimilar.

56 The Application Mark has 15 letters whilst the Earlier Marks have 7 letters. The Application Mark is more than twice the length of the Earlier Marks. Based on the cases cited above, this points towards visual dissimilarity.

57 In respect of the structure of the marks, the compared marks in *Ozone*, *Monster*, and *Clarins* were between a mark with two words on the one hand, and a mark with a single word on the other hand. It was held in those cases that consumers with an imperfect recollection would still remember that one mark has an additional word.

58 In the case here, there are two additional words (“DR. WOLFF’S”) and based on the cases above, this would point towards visual dissimilarity.

59 In respect of the common letters used, in *Ozone*, the marks coincided in 7 out of 15 letters. In *Monster*, the marks coincided in 7 out of 12 letters. In *Clarins* and *Itochu*, the marks coincided in 5 out of 10 letters. In *Beats*, the marks coincided in 4 out of 8 letters. In those cases, the compared marks were held to be visually dissimilar, even though the marks coincided in 50% or more of the letters.

60 The Application Mark and the Opponent Marks only coincide in 5 letters out of 15 letters, i.e., one-third (33.33%) of the letters. This again points towards visual dissimilarity.

61 Finally, in *Ozone*, *Monster*, and *Clarins*, the second word of the later two-word mark (HYSTERIC GLAMOUR, SWEET MONSTER, DERMA ANGEL) is identical with the earlier compared mark (GLAMOUR, MONSTER, ANGEL). Likewise, in *Itochu*, the second of the two words that make up the single word mark SWEETCAMEL, “CAMEL”, is identical with the compared mark, “CAMEL”. In those cases, the marks were held to be visually dissimilar. Here, *none* of the words in the Application Mark are identical with the Earlier Marks. This again points towards visual dissimilarity between the marks.

62 The length of the marks, the structure of the marks and the lack of common letters between the marks all point towards visual dissimilarity. I therefore found the Application Mark to be visually dissimilar to the Earlier Marks.

Aural similarity

63 The Opponent argued that the proper approach to be adopted when assessing aural similarity in this case is the “Dominant Approach”, following *Vagisan (HC)*, as the Application Mark contains multiple components and these components differ significantly in their distinctive character. Under the Dominant Approach, the court considers the common dominant and distinctive elements in question and determines if they are aurally similar. As the dominant and distinctive element in the Application Mark is the word “VAGISAN”, and that element has already been found to be aurally similar in *Vagisan (HC)*, the Opponent argued that the Application Mark and Earlier Marks are therefore aurally similar. Even if “DR. WOLFF’S” is not to be ignored, the element is not as dominant as the element “VAGISAN”.

64 The Applicant accepted that the Dominant Approach is applicable, but argued that the marks were aurally dissimilar because:

- (a) “DR. WOLFF” is more or at least of equal dominance as “VAGISAN” in the Application Mark.
- (b) Consumers will pronounce all the words in the Application and not neglect “DR. WOLFF’S”.
- (c) The only syllables common to both the Application Mark and the Earlier Marks are “VA” and “GI”, making up the word “VAGI” which is of weak

distinctive character and therefore insufficient to overcome the substantial differences created by the other distinctive components, namely “DR. WOLFF’S” and “SAN”.

65 The principles governing aural similarity were summarised by the court in *Vagisan (HC)* as follows (at [39]-[40]):

- (a) There are two approaches for assessing aural similarity. The first is the Dominant Approach which requires identification of the dominant component of the marks, and the second is the “Quantitative Approach” which requires a quantitative assessment as to whether the competing marks have more syllables in common than not.
- (b) When choosing the proper approach to apply, the Dominant Approach would be more suitable for marks containing multiple components, particularly where the components on their face differ significantly in their distinctive character.

66 I consider the following findings to be relevant:

- (a) the element “DR. WOLFF’S” in the Application Mark is distinctive and is at least of equal distinctiveness with the element “VAGISAN”;
- (b) the Earlier Marks, whilst distinctive, only possess a *normal* degree of distinctiveness;
- (c) the Earlier Marks have not acquired a high level of distinctiveness through use;
- (d) “VAGI” is of weak distinctive character;
- (e) the dominant element in the Application Mark is not “VAGISAN”.

67 In light of these findings, I am unable to agree with the Opponent that the marks are aurally similar. The only common elements between the marks are “VA” and “GI”, making up the word “VAGI” but the element “VAGI” is of weak distinctive character. All other syllables in the marks are different. I do not think the element “VAGI” is sufficiently dominant or distinctive such that it overcomes the other differences between the marks. Furthermore, the element “DR. WOLFF’S” is at least of equal distinctiveness with the element “VAGISAN”, and therefore a consumer seeing or remembering the Application Mark is not likely to gloss over or ignore “DR. WOLFF” to remember only “VAGISAN”.

68 I therefore find that the Application Mark and the Earlier Marks are not aurally similar.

Conceptual similarity

69 The Opponent argued that the Application Mark and Earlier Marks were not conceptually dissimilar. The element “DR. WOLFF’S” was not sufficiently distinctive

and would not stand out in the minds of customers. What is left is the element “VAGISAN”, an invented word just as “VAGISIL” is an invented word.

70 The Applicant argued that the marks were conceptually dissimilar. The Application Mark contains the possessive modifier, which causes the concept of possession or ownership to spring to mind. The immediate impression therefore is of a product owned by one Dr. Wolff. The Earlier Marks on the other hand comprise an invented word with no dictionary meaning.

71 Conceptual similarity is directed at the ideas that lie behind or inform the marks or sign in question (*Hai Tong* at [70]). The Applicant referred me to the following extract from *Han’s (F & B) Pte Ltd v Gusttino World Pte Ltd* [2015] 2 SLR 825 at [141] where George Wei J highlighted the possible effect of a possessive modifier on conceptual distinctiveness (in the context of a claim that the defendant’s HAN sign infringed the plaintiff’s “HAN’S” mark):

It is well-established that conceptual similarity involves the consideration of the ideas that lie behind or inform the earlier mark: *Sarika v Ferrero* at [34]. In comparing the visual and phonetic similarity of “HAN” with “Han’s”, the effect of the possessive modifier is minor. **But, in my view, the significance of a possessive modifier is greatly amplified where conceptual similarity is concerned.** HAN evokes a reference to a group of people or a cuisine in a cultural or geographical sense. “Han’s”, on the other hand, causes the concept of possession or ownership to spring to mind. The immediate impression is of a house or a restaurant owned by a person named “Han” (be it his (Dutch) first name or his (Chinese) surname). This conceptual distinction is reinforced by the inclusion of the phrase “Cuisine of Naniwa” in the subtext of the HAN sign, which suggests that “HAN” is being used in its geographical and cultural form. As between the HAN sign and the Han’s word marks, I am of the view that there is conceptual dissimilarity. [emphasis in bold added]

72 I agree with the Applicant that the concepts or ideas behind the competing marks are different – whilst the Applicant’s Mark suggests a product owned or created by a Dr. Wolff, the Earlier Marks contain no such idea and is merely an invented word. I therefore consider that the marks are conceptually dissimilar.

Conclusion on mark-similarity assessment

73 The Opponent argued that 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. The Opponent referred me to *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR 816 (“*Polo (HC)*”) where the court stated the following (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. In order to decide this, I first have to consider whether the plaintiff’s mark can be considered to be so distinctive that the differences would not negate the similarity...

74 The Court of Appeal in *Staywell* at [27] said the question in cases like *Polo (HC)* was “whether the common element of the competing marks was so dominant as to render the different elements ineffective to obscure the similarity between the marks.”

75 The Opponent also referred me to the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (OHIM) in *Dr Grandel GmbH v S.A. SPA Monopole, Compagnie fermière de Spa, en abrégé S.A. Spa Monopole N.V.* (Case No. R 91/2003-4) (“*Dr Grandel*”). In that case, the applicant’s mark was “DR. GRANDEL SPA” in Classes 3 and 5, and the opponent had an earlier trade mark registration for “SPA” in Class 3. The relevant consumers consisted of the general public in the Benelux countries. The Board noted that the relevant public “perceive the word ‘SPA’, immediately and overwhelmingly, as a reference to the Belgian town of SPA and its mineral water sources” (at [30]), and further said (at [31]):

the word ‘SPA’ is not descriptive of goods in Classes 3 or 5, but that it has, due to the well-known character of the town of the same name and its mineral waters, an enhanced distinctive character. As a result thereof, for the perception of the average Benelux consumer, the word part ‘SPA’ of the applicant’s mark is to be considered its more distinctive word part, since the word part ‘DR. GRANDEL’ is perceived as the surname of an otherwise unknown doctor. The association between the opponent’s and the applicant’s sign with the town of SPA and its famous natural waters is all the more likely to occur, since the goods at issue are for body and beauty care so that the public will ascribe to its use a health and wellness quality similar to the healthy effect the Spa water is deemed to have. For those reasons, the Board concurs with the Opposition Division’s finding that since the most distinctive element of the applied-for mark coincides with the earlier mark, the visual, phonetic and conceptual dissimilarities between them, resulting from the earlier mark’s additional element ‘DR. GRANDEL’, even though this element constitutes the first part of the mark, do not outweigh the major impact of the presence of the word ‘SPA’ in both signs. Given, furthermore, that in the sector of cosmetics and beauty and wellness products in general, it is rather usual for a manufacturer to market several lines of products under a specific sub-brand, while bearing the same house mark, the Board is satisfied that with respect to the goods at issue the relevant public will consider that the ‘DR. GRANDEL SPA’ goods concerned will be marketed under the control of the manufacturer of identical or highly similar goods bearing the ‘SPA’ trade mark...

76 The Opponent argued that the addition of the element “DR. WOLFF’S” is not sufficient to avoid a finding that the Application Mark captures the distinctiveness of the Earlier Marks. This is because the dominant and distinctive element in the Application Mark is the word “VAGISAN” and (applying *Dr Grandel*) “DR. WOLFF” is likely to be perceived as the “surname of an otherwise unknown doctor”. Since the

most distinctive element of the Application Mark is confusingly similar to the Earlier Marks, and the Earlier Marks have acquired a high level of distinctiveness, any visual, aural or conceptual dissimilarities arising from the inclusion of “DR. WOLFF’S” in the Application Mark do not outweigh the major impact of the presence of “VAGISAN” in the Application Mark. As such, the inclusion of “DR. WOLFF’S” in the Application Mark is not sufficient so as not to capture the distinctiveness of the Earlier Marks.

77 I would first say that the case of *Dr Grandel* can be distinguished. In that case, the common element in both marks, “SPA” was found to be the most distinctive part of the applicant’s mark. In our case, the common element, “VAGI” was in fact found to be of weak distinctive character (*Vagisil (HC)* at [24]).

78 But even if *Dr Grandel* can be applied to our facts, that does not assist the Opponent. This is because the Opponent’s arguments are premised on several matters which I have not been able to accept. I have not found that the dominant and distinctive element in the Application Mark is the word “VAGISAN”. I have instead found that the element “DR. WOLFF’S” in the Application Mark is distinctive and is at least of equal distinctiveness with the element “VAGISAN”. Neither have I found that the Earlier Marks have acquired a high level of distinctiveness.

79 What I have found is that the Application Mark and Earlier Marks are visually dissimilar, aurally dissimilar and conceptually dissimilar. In light of that it is not open to me to conclude otherwise than that the marks are dissimilar.

Conclusion on opposition under Section 8(2)(b)

80 Since the similarity of competing marks is a threshold requirement that had to be satisfied before the confusion inquiry is undertaken (*Staywell* at [15]), my finding that the Application Mark and Earlier Marks are dissimilar disposes of the opposition under Section 8(2)(b). This ground of opposition therefore fails.

Ground of Opposition under Section 8(4)

81 Section 8(4) of the Act reads:

- (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;

- (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.

82 The Opponent, relying on Section 8(4)(b)(i) and Section 8(4)(b)(ii), argued that the Earlier Marks were well known to a relevant sector of the public in Singapore (females who use intimate care products) and well known to the public at large in Singapore. In order to succeed in an opposition under Section 8(4), similarity of the marks must be established (*Staywell* at [119]). Given my views above that the Application Mark and Earlier Marks are dissimilar, this ground of opposition therefore fails, even if it can be established that the Earlier Marks are well known to a relevant sector of the public or well known to the public at large. However, I do not think the Earlier Marks are well known to a relevant sector of the public (much less to the public at large). Although it is not necessary for me to make specific findings on this, I offer three observations.

83 First, the starting point must be that as at 19 March 2012, the Earlier Marks were not well known to a relevant sector of the public. This was the finding in *Vagisan (IPOS)* and I see no good grounds to depart from it.

84 Second, there must be good evidence that the Earlier Marks, whilst not being well known as at 19 March 2012, had become well known in Singapore as at 25 May 2018. The evidence to establish this is however lacking. I would repeat what I said at [35] to [41] above. Simply producing advertising figures or sales figures (which in any event were inconsistent and did not show an obvious trend) would not suffice. The Opponent could have produced evidence of its market share in Singapore (as it did in *Vagisan (US)*) or of the total value of the market for similar products in Singapore. To support its further claim that the Earlier Marks were well known to the public at large in Singapore, which has a higher threshold than being well known to a relevant sector of the public in Singapore, it could have commissioned a survey to gauge the Singapore public’s awareness of the “VAGISIL” brand and its products (as it did in *Vagisan (US)*) but it did not. This information would have greatly assisted the Opponent in establishing that the Earlier Marks were well known. I should mention that the lack of information as to the size of the market in Singapore or of the Opponent’s market share was also highlighted in *Vagisan (IPOS)* at [79].

85 Third, the evidence the Opponent has produced suggests that in fact the Earlier Marks have *not* become well known. The most obvious evidence is the sales of Vagisil products. I set out once again the sales of Vagisil products in Singapore from 2011 to 2018:

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
Jan to June 2018	174,336

86 If indeed the Earlier Marks had become well known as at 25 May 2018 (though they were not well known as at 19 March 2012), then how would that explain the fact that the Opponent’s sales peaked in 2012, have not recovered since, and that sales for the whole 2018 are likely to be in the range of \$400,000, which is approximately 30% lower than the peak sales figures in 2012? A finding that the Earlier Marks have become well known as at 25 May 2018 is somewhat inconsistent with the sales performance of Vagisil products in Singapore since 2011.

87 The ground of opposition under Section 8(4) therefore fails.

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

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

- (7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —
- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

89 The three elements of passing off are (a) goodwill, (b) misrepresentation, and (c) damage to goodwill: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 at [37] and affirmed in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [28].

90 On the issue of goodwill, the Applicant does not dispute that the Opponent has acquired goodwill in its business in Singapore under the Earlier Marks, in respect of vaginal care products.

91 The Applicant disputed the existence of any misrepresentation. The test for misrepresentation under passing off is substantially the same as that for “likelihood of confusion” under Section 8(2)(b) of the Act (*Vagisan (HC)* at [65]). It is not disputed that the “likelihood of confusion” inquiry may consider factors relating to the impact of the marks-similarity and goods-similarity on consumer perception. They include the following (see *Staywell* at [96]):

- (a) The degree of similarity of the marks
- (b) The reputation of the marks
- (c) The impression given by the marks
- (d) The possibility of imperfect recollection of the marks

- (e) The normal way in or the circumstances under which consumers would purchase goods of that type
- (f) Whether the products are expensive or inexpensive
- (g) 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
- (h) 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

Analysis of “likelihood of confusion” in Vagisan (HC)

92 My starting point would be the analysis of the “likelihood of confusion” in *Vagisan (HC)*. Whilst the court’s assessment of some of the factors are not binding on me (for example the degree of similarity of the marks given the competing marks here are different), the assessment of other factors (such as the nature of the goods or likely characteristics of customers) would be persuasive, if not binding.

93 I first turn to the two factors which the court in *Vagisan (HC)* found militated against a finding of a likelihood of confusion (at [54]):

(a) First, while the relevant goods are relatively inexpensive, I was mindful that the nature of the goods would tend to command a greater degree of fastidiousness and attention on the part of prospective purchasers. The goods in question are highly personal self-care products for women, which require greater care in selection: *Consolidated Artists B.V. v THEFACESHOP Co., Ltd.* [2017] SGIPOS 7 (“THEFACESHOP”) at [123]. In concluding that there was no likelihood of confusion, the Registrar at [120] observed that, while the goods in Class 3 for body and face care were not very expensive and were purchased off the shelf, consumers “will be cautious about what they are purchasing”. Furthermore, such a purchasing decision would not be made “lightly” as it was a “choice with possible adverse consequences if the wrong products are used, e.g. allergies or acne breakouts”: see [120]. Similarly, the Federal Court of Australia in *August Wolff (AU)* opined at [68] that “[t]he proposition that a woman is likely to pay little attention to the particulars of any product that she might put in her vagina or on her vaginal area inherently lacks credibility”. Female consumers in Singapore would likely pay at least a medium level of attention before or during the purchase of the products in question. Accordingly, I agreed with the PAR (at [65] of the GD) that the relevant segment of the public would not simply purchase the goods in question in a hurry without putting in some care and attention into the purchase process.

(b) Second, while a portion of consumers would purchase the relevant products online, it seemed to me that, at present, consumers still normally purchase these goods in brick-and-mortar shops. In THEFACESHOP, the

Registrar held at [123] that although the facial and body care products were self-service items, “specialists abound to assist in the purchase, having regard to the deeply personal nature of the same”. Furthermore, the Registrar held at [122] that “consumers will be more particular about the origin or marks (emphasis original) of such goods, as they are likely to trust certain brands more than others”. This applies with equal if not greater force to purchases of intimate care products. Notwithstanding that intimate care products may be self-service items, when purchased from shops, decisions to buy these items are likely to be made with the assistance of specialists.

94 I agree with the court’s analysis of these two factors. The Opponent however sought to distinguish *Consolidated Artists B.V. v THEFACESHOP Co., Ltd.* [2017] SGIPOS 7 (“*THEFACESHOP*”) (which the court had relied on) and argued that consumers purchasing the products in brick-and-mortar stores may in fact do so without the assistance of specialists. The Opponent argued that THEFACESHOP is a skincare and cosmetics manufacturer and retailer, and its stores only sell THEFACESHOP-branded items. Hence, staff in THEFACESHOP stores are specifically familiar with and specialise in THEFACESHOP products, and are able to assist consumers with their purchase in the store. In contrast, Vagisil products are sold at multi-brand retailers such as Watson’s, Guardian, NTUC FairPrice, Unity Pharmacy and Cold Storage. The Applicant’s products are sold overseas through “*pharmacy wholesalers, retail pharmacies, drug stores*”, which are also multi-brand stores. Staff in multi-brand stores are unlikely to have specialist knowledge of specific brands of items because these stores often sell a wide variety of goods from hundreds of brands. The Opponent therefore submitted that even where the products are purchased from brick-and-mortar stores, there is still a real likelihood that the consumer may be confused into selecting the wrong product, or mistakenly believe that the two products originate from the same undertaking.

95 Whilst I agree that *THEFACESHOP* could be distinguished, the larger point remains that in relation to intimate care products, the consumer is likely to seek some assistance first before deciding which product to purchase. The assistance could come from doctors, from their own research on the Internet (in the form of reviews, for example) or from staff at the brick-and-mortar stores. The fact that such research would be done beforehand goes against a finding of likelihood of confusion.

96 The court in *Vagisan (HC)* considered the following six factors to support a finding of a likelihood of confusion (at [53]):

- (a) The marks in question are similar to an average degree. Even if the “VAGI” component is regarded to have a descriptive connotation, the Earlier Marks are distinctive as a whole.
- (b) The Earlier Marks have a respectable degree of reputation in Singapore. Products bearing the “VAGISIL” marks were first available in 1990 and continue to be sold at popular Singapore retailers. They have been advertised and sold in Singapore at creditable volumes between 2011 and 2018. They have also been referred to by prominent third parties in television shows, movies, books and articles.

- (c) The Applicant conceded that the goods covered by the Earlier Marks in Classes 3 and 5 are similar. In fact, some of the goods claimed under the respective marks are identical. For example, the Applicant's "soaps" and "cosmetics" in Class 3 overlap with the Opponent's "cosmetics and toiletries for feminine use", while the Applicant's "pharmaceutical products" in Class 5 overlap with the Opponent's "pharmaceutical preparations, medicated creams, and vaginal suppositories".
- (d) Both the "VAGISIL" and "VAGISAN" products target the same segment of the market, namely females in the Singapore market. As this segment comprises both the public at large and those in the trade, many if not most consumers are not likely to have specialist knowledge. Moreover, a portion of the relevant segment of the public are likely to purchase these items on e-commerce websites without specialist assistance.
- (e) The relevant segment of the public (i.e., females in Singapore) would carry in their minds an imperfect recollection of the overall impression of the marks.
- (f) It was not disputed that the products in question are relatively inexpensive, ranging from S\$8 to S\$17. They do not involve the type of expenditure that would mandate significant prior due diligence on the part of the relevant segment of the public.

97 Factors (a) (degree of similarity of the marks) and (e) (the impression given by the marks and the possibility of imperfect recollection of the marks) are different in this opposition given the competing marks are different and my findings that the competing marks are dissimilar, and that "VAGISAN" is not the dominant and distinctive element in the Application Mark. Consequently, these two factors would point away from a likelihood of confusion.

98 In respect of factor (b) (i.e., the reputation of the Earlier Marks), whilst the reputation may be respectable, I am unable to agree that in Singapore at least, products bearing the Earlier Marks have a strong reputation. This is in light of my observations above that the Earlier Marks are not well known. In particular, I would point to the sales figures for Vagisil products from 2011 to 2018. As I observed above at [85]–[86], the sales figures do not show a consistent trend and in fact show that sales peaked in 2012 and has not recovered since. Furthermore, sales for the whole of 2018 are likely to be in the range of \$400,000, which is approximately 30% lower than the peak sales figures in 2012. I therefore consider the reputation of the Vagisil products to be neutral or at best only pointing slightly towards a likelihood of confusion.

99 That leaves factors (c) (similarity of goods), (d) (market for products are the same and consumers not likely to have specialist knowledge) and (f) (products are inexpensive). I accept that these factors point towards confusion, though I would say that the fact that the products are inexpensive only point slightly towards confusion because given the nature of the products, a consumer is likely to do some research or seek advice first and doing so means there is a lesser likelihood of confusion.

100 Not every factor has the same weight and applies equally. But having considered and weighed the factors that point towards a likelihood of confusion and those that point away from a likelihood of confusion, I would conclude that there is no likelihood of confusion. I consider especially weighty the fact that the competing marks are dissimilar and that the element “DR.WOLFF’S” is at least as equally distinctive as the element “VAGISAN” in the Application Mark, and that consumers are likely to do some research or seek some advice before purchasing intimate care products sold by the Applicant and Opponent under their respective marks.

101 Consequently, I conclude that the use of the Application Mark is not likely to result in consumers being deceived or confused into thinking that the Applicant’s goods are, or emanate from a source that is linked to, the Opponent’s.

102 As misrepresentation is not established, the opposition based on passing off fails. The ground of opposition under Section 8(7)(a) therefore fails.

Overall Conclusion

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

Date of Issue: 17 September 2021

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