

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

Trade Mark No. 40201908644W
3 September 2021

IN THE MATTER OF A TRADE MARK REGISTRATION BY

OFF-WHITE LLC

AND

APPLICATION FOR DECLARATION OF INVALIDITY THEREOF BY

S. C. JOHNSON & SON, INC.

Hearing Officer: David Llewelyn
IP Adjudicator

Representation:

Ms Ferzana Haq and Ms Tasmeen Haq (hslegal LLP) for the Applicant
Ms Vicki Heng (instructed) and Mary Thomas (Mary Thomas IP Strategies & Solutions Pte. Ltd.) for the Registered Proprietor

GROUND OF DECISION

1 When considering an application for invalidity of a registered trade mark where that application is based on the applicant's earlier registered trade mark comprised of a number of different components (such as a word together with a logo), it is important to keep in mind what the earlier mark is *not* a registration of: it is not a registration of only one of those components. It is a registration of a composite mark. A composite mark must be viewed in its entirety, although one component may be more distinctive than the other(s). Otherwise, the registration of a composite mark can lead to unfairness through an illegitimate broadening of the scope of protection given by registration.

2 This can occur where an unregistrable word or one that is difficult to register on its own because it is commonplace or descriptive is combined with other matter, such

as a logo and/or another word, in a composite trade mark. The logo and/or other word may be relatively simple, banal or descriptive.

3 *Hey voila!* The composite trade mark is registered. Indeed, this is as it should be: the trade mark is clearly not *exclusively* descriptive, nor is it *devoid* of distinctive character or commonplace. So, the trade mark does not fall to be rejected under the absolute grounds for refusal in section 7(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”), as would have been the word on its own had it been applied for *simpliciter*.

4 The registered mark is then prayed in aid against others who have the temerity to use the word, on its own or even together with a different logo. To argue against another’s registered trade mark costs money, so those using the unregistrable word may be warned off (pun intended, as will be seen below), even when they use their own, different, composite trade mark.

5 A recent example where the High Court had to deal with such a composite mark (*TMRG Pte Ltd and another v Caerus Holding Pte Ltd* [2021] SGHC 163 (“*Luke’s*”)) involved the possessive form of the common and storied name Luke: LUKE’S. The earlier mark was a composite mark comprising LUKE’S together with a number of other words: “OYSTER BAR”, “CHOP HOUSE” and “Travis Masiero Restaurant Group”. The later marks objected to unsuccessfully by the proprietor of that earlier mark were “LUKE’S LOBSTER” and “LUKE’S LOBSTER [plus a logo]”.

6 As exemplified by that case, when dealing with a composite mark it is crucial to consider all its components and not only one. Of course, this is different from, but often related to, the quite separate enquiry as to whether the additional matter is so simple, banal or descriptive as to be ignored by the average consumer, which must be done when determining whether the marks are similar. Nevertheless, unless the composite nature of the mark is borne in mind, what is described at [2] to [4] above may succeed in pulling the wool over the trade mark system’s eyes.

7 Off-White LLC is the Registered Proprietor (“the Proprietor”) of the following series of two marks:



(“the Subject Mark”), in Singapore in Classes 3, 9, 14 and 18. The Subject Mark was registered in Singapore on 22 April 2019. The specification of goods relevant to the invalidation is set out below:

Class 3

Colognes; toilet water; perfumes; fragrances for personal use; Soaps; **Lotions for skin care**; Antiperspirants; Deodorants for personal use; Cosmetics; Body

wash; Non-medicated bath preparations; **Non-medicated skin care preparations**; Room fragrances; Potpourri; Aromatherapy oils, namely, essential oils for aromatherapy use, essential oils contained in inhalers, for use in aromatherapy; Fragrances in the form of beads for use in the home; Nail care preparations; Nail polish and nail polish remover; Essential oils; Make-up; **Non-medicated toiletry preparations**; Hair care preparations; Hair styling preparations; Hair lotions; Hair spray; Shampoo; Hair conditioner; Gel for hair; Mousse for hair; none of the aforementioned goods being intended for use as a repellent for insects, vermin or fungi.

8 S. C. Johnson & Son, Inc. (“the Applicant”) applied for a declaration of invalidity on 25 February 2020. The Applicant seeks a partial invalidation of the Subject Mark’s registration in respect only of these goods: “lotions for skin care”, “non-medicated skin care preparations” and “non-medicated toiletry preparations” (“the Objectionable Goods”), reflected in bold in the specification at [7].

9 On 13 March 2020, the Proprietor qualified its specification with the phrase “none of the aforementioned goods being intended for use as a repellent for insects, vermin or fungi”, underlined in the specification at [7]. A counter-statement was filed by the Proprietor on 2 June 2020 in defence of the registration of the Subject Mark.

10 The Applicant filed evidence in support of the invalidation on 22 December 2020. The Proprietor filed evidence in support of the registration on 17 March 2021. The Applicant filed evidence in reply on 11 May 2021. Following the close of evidence, a pre-hearing review was held on 15 June 2021. The parties made their oral submissions before me on 3 September 2021 and made additional written submissions on 17 September 2021.

Grounds of Opposition

11 The Applicant relies on a number of grounds in the Act. They are section 8(2)(b) read with section 23(3)(a)(i), section 8(4)(b)(i) read with section 23(a)(iii) and section 8(7)(a) read with section 23(3)(b).

Applicant’s Evidence

12 The Applicant’s evidence comprises the following:

- (i) a Statutory Declaration made by Renata Ferraiolo, Vice President of Global Marketing, Pest Control, of the Applicant, on 5 December 2020 in Wisconsin, the United States of America (“Ferraiolo-1”); and
- (ii) a Statutory Declaration in Reply made by the same Renata Ferraiolo, on 3 May 2021 in Wisconsin, the United States of America (“Ferraiolo-2”).

Proprietor’s Evidence

13 The Proprietor’s evidence comprises a Statutory Declaration made by Virgil Abloh, President of the Proprietor, on 10 March 2021 in New York, the United States of America (“Abloh-1”).¹

Applicable Law and Burden of Proof

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

Background

15 The Applicant, S.C. Johnson & Son, Inc., is a large, well-known multinational company founded in 1886 in Racine, Wisconsin, the United States of America, with business operations in over 70 countries, and, *inter alia*, is engaged in the business of manufacturing and marketing a wide range of household and personal care products, including but not limited to household cleaning products, personal repellents and pest control products, skincare products, home fragrances, household food storage products and consumer chemicals. The history and business activities are set out at Section A [1] to [10] of Ferraiolo-1.

16 The Applicant started selling its OFF! brand of insect repellents in the United States in 1957 and it has since become one of the Applicant’s leading brands with its own brand-specific website at <https://off.com/en>. The history of the OFF! brand is set out at Section B of Ferraiolo-1. The Applicant’s OFF! personal repellents come in a variety of forms including creams, sprays, spritzes, aerosols, lotions, liquids, sticks, towelettes and wipes. The Applicant states that the majority of these are to be used topically and applied directly onto the skin, and may also be applied onto the face. The Applicant further states, at [6] of Section B of Ferraiolo-1, that OFF! personal repellents are also made with “various pleasant fragrances and scents and are formulated to be non-greasy, which makes them more pleasant and appealing for topical use”. The OFF! brand was named the “Most Trusted Bug Repellent” by BrandSpark International in 2015 and has featured in articles ranking the best insect repellents available on the market (globally and in Singapore) (at Section E [2] to [4] of Ferraiolo-1). The Applicant has also made significant contributions to public awareness programmes and campaigns under its OFF! brand aiming to “educate the public on the risks of mosquito-borne diseases such as dengue and zika virus” (at Section F of Ferraiolo-1).

17 The Applicant states, at Section B [4] of Ferraiolo-1, that the OFF! brand is usually used in the form of its orange and white logo (see Trade Mark No. T0620792B at [21] below), which was created and first used by the Applicant as early as 1962 and remains in use today. The Applicant states, at Section D [4] of Ferraiolo-1, that “OFF! personal repellents ... are widely available in Singapore in popular supermarkets such as NTUC Fairprice, Sheng Siong, Giant and Cold Storage, personal stores such as Watsons and Guardian Pharmacy, as well as online.”

18 The Proprietor, Off-White LLC, is the owner of the luxury brand Off-White (founded in 2013), which licenses, manufactures and sells clothing, accessories,

¹ As this decision was being finalized, it was announced in the media on 28 November 2021 that Mr Abloh had died of cancer at the age of 41.

furniture and other ready-made goods (at [1] of Abloh-1) through its own OFF-WHITE boutiques (more than 60 stores in at least 15 countries globally), via its official website at www.off---white.com and through selected third-party retailers (at [19] of Abloh-1). The Proprietor was listed as the world’s most popular brand on The Lyst Index in 2018, and has held a top 3 place on The Lyst Index (a quarterly index of ‘fashion’s hottest brands’) each quarter since the Index’s inception in 2018 (at [10]); it has collaborated with designers and brands of international repute (including Jimmy Choo, Nike, Warby Parker, Rimowa, Byredo, AmorePacific); and its products and collaborations are “featured in virtually every relevant periodical and internet website (including Vogue, Allure, Cosmopolitan, Elle, Marie Claire, GQ, Women’s Wear Daily, Wall Street Journal, the Chicago Tribune and the New Yorker)” (at [15], Exhibit F, and Exhibit G of Abloh-1). The history and business activities of the Proprietor are set out at [5] to [15] of Abloh-1.

19 The Proprietor states, at [9] of Abloh-1, that (i) its most notable trade mark is “OFF-WHITE” (which it refers to as its “Housemark”), (ii) it also uses elements of the Housemark “OFF” and “WHITE” in various permutations (which it refers to as the “Formative Marks” and which also includes the Subject Mark), and (iii) it uses graphical elements such as “its signature crossed arrow logo which comes in a myriad of variations, as well as parallel lines and quotation marks” (which it refers to as the “Graphical Marks”). A selection of these marks is provided at Exhibit C of Abloh-1. The Proprietor describes the Housemark as having been “inspired by or derived from the space between universally understood concepts of black and white”, and the Formative Marks and Graphical Marks “while seemingly ordinary and simple” as intending to “challenge the world to look deeper, and to find meaning in what some may consider the mundane” (at [16] of Abloh-1).

20 The Proprietor identifies its target consumer as being “the millennial, who is not necessarily confined to a traditional wardrobe” (at [20] of Abloh-1), “the young, trendy and well-heeled” (at [41] of Abloh-1), “discerning not only in terms of fashion and design” and “one that is specifically and knowingly buying into the [Proprietor’s] philosophy and lifestyle” (at [22] of Abloh-1). The Proprietor further states that its main Instagram account @off___white has 11 million followers, while its Instagram account for its Singapore stores @off___white___singapore has more than 79,500 followers (at [26] of Abloh-1).

The Trade Marks Relied On by the Applicant

21 The Applicant relies on the following earlier registered marks (“Applicant’s Marks”) in this invalidation, although their Written Submissions focussed on what they describe as the two “Combination Marks” included in the table below (Trade Marks Nos. T0620794I and T0620792B). Likewise, in their oral submissions at the hearing the Applicant’s counsel focused on the Applicant’s Combination Marks. I will do the same as there is less similarity between the Subject Mark and the first of the Applicant’s Marks below than between the Subject Mark and the Combination Marks.

Trade Mark No.	Mark	Registration Date	Specification of Goods
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T6843313F		26 January 1968	<u>Class 5</u> Insecticides, pesticides, herbicides, fungicides, rodenticides, preparations for the deterrence and control of insects, pests, weeds, rodents, and other noxious things.
T0620794I		5 October 2006	<u>Class 5</u> Preparations for killing weeds and destroying vermin; insecticides; moth proofers; insect repellents; fungicides; rodenticides.
T0620792B		5 October 2006	<u>Class 5</u> Preparations for killing weeds and destroying vermin; insecticides; moth proofers; insect repellents; fungicides; rodenticides.

MAIN DECISION

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

22 Section 23(3)(a)(i) of the Act reads:

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

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

(i) the conditions set out in section 8(1) or (2) apply;

...

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

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

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

...

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

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

Decision on Section 8(2)(b)

The Three-Step Approach

24 The Applicant relies on the Applicant's Combination Marks but not the Applicant's T6843313F for the purposes of the comparison required under section 8(2)(b).²

25 The leading case on the interpretation and application of section 8(2)(b) is the Court of Appeal's decision in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 ("*Staywell*"). This decision sets out the step-by-step approach that should be taken to the application of this ground of refusal, at [15], and hence to invalidation where section 23(3)(i)(a) is relied on. The first step is to determine whether the Applicant's and Proprietor's marks are similar; if not, the enquiry ends there but if so, the second step is to determine if the goods and/or services are identical or similar; if not, again the enquiry ends there but if so, the third step is to determine whether as a result of the similarity found in relation to the first two steps there 'exists a likelihood of confusion on the part of the public'.

26 At each stage of the enquiry, it is important to recognise that the average (or normal) consumer of the relevant goods/services is unlikely to have the opportunity to compare side-by-side the Applicant's and Proprietor's marks, and therefore his/her recollection of either or both may well be imperfect. Also, it is through the eyes and ears of the average consumer of the particular goods in respect of which the Applicant's Marks are registered, and of those for which the Proprietor has registered the Subject Mark, that the three-step approach must be followed: it is not through the eyes and ears of an unusually observant or dilatory member of the public.

27 It was agreed by the Applicant and the Proprietor at the hearing that the average consumer of the relevant goods is the man or woman in the street who buys sprays and lotions for topical use relatively frequently in outlets such as drugstores and supermarkets. However, the Applicant considered average consumers would display only an average degree of attention when making their choice of product, whereas the Proprietor submitted that a relatively high degree of attention would be accorded to the choice of any product that would be applied to the skin. Although nothing hinges on this difference of opinion, I consider that the average consumer would pay more attention (but not significantly more) when choosing products such as the Objectionable Goods and those within the specification of goods for the Applicant's Combination Marks than s/he would when purchasing confectionery in a supermarket. The average consumer is reasonably observant and careful when purchasing goods s/he intends to apply to the skin, whether they are skincare lotions or insect repellents.

² Applicant's Written Submissions at Section F, [4(a)].

28 As the application is being made to remove only the Objectionable Goods from the specification of goods for which the Subject Mark is registered, it is necessary to consider ‘notional and fair use’ of the Subject Mark only in relation to those goods but to compare such use with notional and fair use in relation to all the goods contained in the specification for the Applicant’s Combination Marks, which is identical in both.

29 Before moving on to consider the first *Staywell* step, I consider it important to observe that the shared element in the composite trade marks I am comparing is the common word OFF that has relatively low inherent distinctiveness as an indication of trade origin. I also refer to the Court of Appeal decision in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) where the Court stated at [32]:

In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816, Lai Kew Chai J held (at [26]) that “[i]n cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially”. We agree with this.

(Lest the reference to mark and sign be misunderstood, as that refers to the comparison under the infringement provision in section 27, when making the salient comparison for the purposes of an opposition (and an application for invalidity based on one or more of the section 8 grounds), it is one between mark applied for and earlier mark(s).)

Similarity of Marks

30 The marks for comparison are reproduced below only for ease of reference. As noted already, I am very mindful that visual comparison is done through the lens of imperfect recollection of the average consumer, and that the analysis itself should not be conducted with the marks side by side. However, it would be obvious to the average consumer that both the Subject Mark and each of the Applicant’s Combination Marks is a composite trade mark in which OFF and OFF!, respectively, is integrated with (or superimposed upon) the device (or graphical) element to form a distinctive whole.

Subject Mark	Applicant’s Combination Marks
	
	

31 In this first step, my task is to decide whether the Subject Mark and either or both of the Applicant’s Combination Marks are ‘similar’ as opposed to dissimilar, taking into account the presence or absence of visual, aural and conceptual similarities. ‘Similarity’ can lie anywhere on a spectrum that ranges from identical (or 100% similarity) to no similarity (or 100% dissimilarity), with degrees of low and high in between. The Court of Appeal in *Staywell* cautioned against a ‘checkbox exercise’ rather than a ‘sensible appraisal of the marks as a whole’ when deciding “whether the marks, when observed in their totality, are similar rather than dissimilar”, all at [17].

32 The Subject Mark and the Applicant’s Combination Marks must thus each be considered as a whole and not broken down into its component parts, for that is the way the average consumer of the relevant goods would consider it (at least as far as visual and conceptual similarities are concerned), although the possible impact of imperfect recollection must be borne in mind. The average consumer would observe that both the Subject Mark and each of the Applicant’s Combination Marks is a composite trade mark in which OFF and OFF!, respectively, is integrated with (or superimposed upon) the device (or graphical) element to form a distinctive whole. This case, involving two opposing marks where a not insignificant portion of the distinctiveness of each as an indication of trade origin lies in the melding of word and device, can thus be distinguished from *Caesarstone*, in which what the Court characterized as a ‘simple’ device element positioned alongside a word was found to be purely decorative rather than an element indicating trade origin (at [38]).

33 As far as the consideration of aural similarity is concerned, a composite mark which contains one or more graphic elements can make aural comparison relatively pointless or even misleading as it is not possible to ‘speak’, and therefore ‘hear’, graphic components and sensibly this fact must be borne in mind when weighing up the different similarities (or lack of them).

34 In its Written Submissions the Applicant contended that “[i]n terms of use, the Applicant’s OFF! personal repellents are most famously represented by the signature orange and white logo” (TM No. T0620792B, see [17] above). Although that could be argued to be a reason why the Subject Mark, which is clearly not an orange and white logo, is dissimilar to the Applicant’s Combination Marks (or at least the coloured one), such an argument would not be legitimate as I should not take into account at this stage any enhanced distinctiveness as a result of use *after registration* that may have been acquired by the Applicant’s Combination Marks. As, in my view, the Court of Appeal in *Staywell* made clear, at [20], the level of distinctiveness of the earlier mark in relation to the goods for which it is registered is an issue reserved for the likelihood of confusion enquiry, if it is reached. As this appears to be an issue on which there are differing opinions, it bears repeating what I said in *Valentino S.p.A v Matsuda & Co* [2020] SGIPOS 8 at [20, footnote 1] (with necessary amendment to take into account that this case is an application for invalidity and that was an opposition):

Contextual evidence may be adduced by the [Applicant] only in relation to the third, likelihood of confusion, step where the greater protection accorded by the statutory regime to an earlier registered mark that has acquired (or, more accurately, heightened) its distinctiveness through use is an important factor. Conversely, the first and second steps, on evaluating similarity, are made by taking the [Subject Mark] and the goods for which [it is registered] and simply

comparing with the [Applicant's] earlier mark as appears on the Register and the goods for which it is registered. Whether the [Applicant's] earlier registered trade mark has or has not acquired (additional) distinctiveness through use after registration is not relevant at that stage (after all, unless it has at least some inherent distinctiveness it would not have been registered): all that is required in the first two steps is a common-sense overall comparison of mark-for-mark.

Visual similarity

35 In its Written Submissions, the Applicant submitted that “the dominant and distinctive component [of both the Applicant's Combination Marks] is the word “OFF”” and argued that “the component that would stand out and grab the average consumer's attention is the word ‘OFF’” [applying what it described as “the test set out at paragraph 23 of *Staywell*”].³

36 I disagree: what is registered in the Applicant's Combination Marks is OFF!, with the letters in capital letters in a slightly stylised form (i.e., not in block capitals) together with a prominent exclamation mark having at least the visual impact of the letters preceding it, in front of (or superimposed upon) a broad oval device that slants up from left to right (roughly the shape of a lopsided egg). In the coloured Combination Mark (TM No. T0620792B) the oval is coloured orange with a red border and the exclamation mark has an orange border on its right-hand side that gives the impression that the exclamation mark is three-dimensional (when compared to the two-dimensional rendering of the word OFF).

37 The Subject Mark is the relatively common word OFF, similarly in capital letters although stylised differently and slanted noticeably from left to right, in front of (or superimposed upon) a device comprising three narrow ellipses positioned in parallel and slanting up from right to left. In one of the two marks in the series the mark is a red colour, in the other it is grey.

38 The Subject Mark is visually different to each of the Applicant's Combination Marks: as a whole, in its device element and even in its rendition of the word OFF. In the Applicant's Combination Marks the word OFF is accompanied by a prominent exclamation mark, with the obvious visual effect that one of the two distinctive elements of the composite mark is OFF! and the other is the oblong device element. In the Subject Mark the word OFF is as distinctive as the three parallel ellipses device on which it is placed. I consider it unrealistic to consider that the average consumer would disregard or be uninfluenced by the important visual impact of the exclamation mark in each of the Applicant's Combination Marks, just as the High Court in *Luke's* was unwilling to ignore the additional wording in the Plaintiff's composite mark at issue in that case. Instead, the exclamation mark would play an important part in the overall visual impact upon the average consumer of each of them.

39 Taking into account the various visual differences, I consider that the Subject Mark is more dissimilar than it is similar to either or both of the Applicant's Combination Marks.

³ Applicant's Written Submissions at Section F, [4e].

Aural similarity

40 When it comes to making a comparison between composite marks, the weight to be accorded to aural similarity must vary, as what may be distinctive graphic elements of a particular composite mark cannot be spoken or heard. To accord it more-or-less equal weight to the visual aspect would seem not to be sensible or fair when considering a composite mark in which there is one or more distinctive graphic element(s). All that can be compared aurally are the word elements that can be spoken and to give this aspect of similarity equal weight would run the risk of elevating the word or words to the status of registration on its or their own.

41 The only element in the Subject Mark and the Applicant's Combination Marks that can be spoken is the word OFF. It was contended by the Proprietor in its Written Submissions that the inclusion of the exclamation mark in the Applicant's Combination Marks means that "the word 'OFF!' would be shouted or yelled, whereas the [Subject Mark] would in comparison be said in a normal tone".⁴ I cannot agree: if a stockist were to order by telephone the Applicant's and the Proprietor's products by reference to its respective trade mark, s/he would refer to each of them as 'OFF' and, absent external factors, would not shout or yell when referring to the Applicant's.

42 The question of whether the Subject Mark is aurally similar to either or both of the Applicant's Combination Marks admits of only one answer: the only element in each that can be heard is identical, albeit it may be uttered or enunciated differently and therefore have a different aural impact in view of the presence in the latter of the exclamation mark which is absent in the former.

Conceptual similarity

43 Conceptual similarity "seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole" (*Staywell* at [35], affirmed in *Caesarstone* at [48]). The Applicant submitted at the hearing that the word OFF is the only element to be taken into account when considering conceptual similarity between the Subject Mark and the Applicant's Combination Marks. However, once again, the marks being compared must be viewed in their entirety where, as here, elements other than the word(s) would impact upon the understanding of the average consumer. The word is only one element, and there are others that would affect that understanding.

44 In addition, it must be borne in mind that technical distinctiveness is an integral factor in the marks-similarity inquiry; a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (eg, *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [36]). Conversely, a mark which has less technical distinctiveness has a low threshold before a competing sign will be considered dissimilar to it. As noted above at [29], the shared element "OFF" is of low technical distinctiveness. Thus, there is a low threshold to cross before the respective marks, when the remaining conceptual elements are taken together with that shared word element, are considered dissimilar conceptually when looked at in their entirety.

⁴ Proprietor's Written Submissions at [30].

45 I consider that the average consumer would pay due attention to the presence of the exclamation mark in the Applicant's Combination Marks as it clearly impacts how the Combination Marks would be understood conceptually. An exclamation mark converts the meaning of the word or phrase it follows into an instruction, an outburst or an ejaculation (in the sense of a short emotional utterance, as might result from the landing of a mosquito on one's bare arm).

46 On the device element of the Subject Mark, the Proprietor submitted in its counter-statement that what I describe as the three parallel ellipses (the Proprietor's counsel described them at the hearing as 'space orbits') are meant to convey a 'futuristic and other worldly impression, consistent with the [Proprietor's] fashion direction.'⁵ While I am not wholly convinced that the average consumer would be so aware as to be informed of that specific idea without being educated about it, whatever idea those three ellipses (or orbits) would convey is clearly different to whatever might be conveyed, if anything more than its obvious presence, by the single oblong device (or lopsided egg) element of the Applicant's Combination Marks (which the Applicant ignored in its Written Submissions on conceptual similarity).

47 Along with the conceptual difference between the superimposed "OFF" and "OFF!", respectively, that would clearly inform the understanding of and be readily discernible to the average consumer, this difference between the 'three orbits' in the Subject Mark and the 'lopsided egg' in each of the Applicant's Combination Marks contributes to them being more dissimilar conceptually than they are similar. Unlike in *Caesarstone*, the average consumer would not understand the presence of the device element in the Subject Mark to be purely decorative as it is an integral part of the composite mark as a whole: it cannot therefore be disregarded when considering "the ideas that lie behind and inform the understanding of the mark as a whole".⁶

Overall similarity

48 Having considered separately the three aspects of mark-for-mark similarity, I now weigh these in the balance, while taking into account both imperfect recollection and the fact that the respective marks are composite marks and therefore less weight should be given to aural similarity than would be the case if comparing two word marks. Following again the Court of Appeal's guidance in *Staywell* (particularly at [17]) and making a sensible appraisal of the marks when observed in their totality, I find that the Subject Mark is patently more dissimilar than it is similar to either or both of the Applicant's Combination Marks. Even if broken down into their different elements, the only element shared by them is the common word OFF which has low

⁵ Counter-Statement at [19].

⁶ In this context, I consider it noteworthy in this case that, as set out in [21] above, the Applicant has obtained trade mark registrations for both of the Combination Marks in addition to its registration of OFF! itself (T6843313F) and ask rhetorically, if the Applicant did not consider there was a difference in the likely understanding and impact of the Combination Marks as a whole, why do so? I recognise that whatever difference there might be between word mark and composite mark, ie the impact of the device element, does not fall easily or firmly into one or the other of the discrete categories of visual impact and conceptual understanding. However, that there is no difference between OFF! and the composite marks [OFF! superimposed on device] seems unarguable on the facts. The average consumer would certainly notice a difference and therefore it would have an impact on the functioning as an indication of trade origin of the composite mark as a whole.

inherent distinctiveness and even then the Subject Mark does not include the exclamation mark that is visually and conceptually a significant element of the Applicant's Combination Marks. Viewed as a whole the average consumer would find the respective composite marks to be markedly different.

Similarity of Goods

Applicant's Goods	Objectionable Goods in Subject Mark Specification
Class 5: Preparations for killing weeds and destroying vermin; insecticides, moth proofers, insect repellents; fungicides; rodenticides.	Class 3: Lotions for skin care; Non-medicated skin care preparations; Non-medicated toiletry preparations; <u>none of the aforementioned goods being intended for use as a repellent for insects, vermin or fungi.</u>

49 As stated above at [8] and [9], the Application concerns only the Objectionable Goods contained in the specification of the Subject Mark and that specification has been qualified by the addition of the words underlined in the table above: 'none of the aforementioned goods being intended for use as a repellent for insects, vermin or fungi.'

50 In *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459 the High Court (Woo Bih Li J) set out at [75] the factors to be taken into account when assessing similarity of goods: "(a) the respective uses of the respective goods; (b) the respective end users of the respective goods; (c) the physical nature of the goods; (d) the respective trade channels through which the goods reach the market; (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves; and (f) whether the respective goods are competitive or complementary."

51 Like that for similarity of marks, the comparison of goods should be made in a common-sense way by comparing the goods for which the earlier mark is registered and their normal (or notional) use with the normal use of those for which the later mark is either applied for (in the case of an opposition to registration) or has been registered (in the case of an application for invalidity, as here). In that common-sense comparison, the goods in question must be viewed according to their primary purpose and not by taking into account fanciful or unusual purposes that the average consumer of the respective goods would not expect. Thus, watches and computers are not similar goods notwithstanding the fact that both may be used to find out the time.

52 In Ferraiolo-1 and Ferraiolo-2 the Applicant makes much of the fact that "the majority of the Applicant's products are formulated specifically for application on the skin and are sold in the form of lotions, sprays, aerosols, towelettes and wipes which are for topical use"⁷ and examples are cited of what the Applicant's deponent Ms Ferraiolo describes as 'personal repellents' sold as part of a skincare range.⁸ However, it cannot be gainsaid that the Applicant's Combination Marks are each

⁷ Ferraiolo-2 at [F1], referring to Ferraiolo-1 at Sections B and D.

⁸ Ferraiolo-2 at [F8].

registered in Class 3 and include ‘insect repellents’ in the specification of goods; while the Subject Mark is registered in Class 5 and the Objectionable Goods relate to skin care and toiletry goods. Although the form in which both the Applicant’s goods and the Objectionable Goods may be made and sold includes lotions, sprays, aerosols, etc, the primary purpose for which the average consumer would seek out the goods in the Applicant’s specification and the Objectionable Goods is different. The former is to repel insects, the latter is to care for the skin.

53 In these circumstances, the fact that the Applicant’s Combination Marks are each registered in Class 3 and the Subject Mark in Class 5 should not be ignored totally. While the main purpose of the classes introduced by the Nice Classification is administrative convenience (see *Festina Lotus SA v Romanson Co Ltd* [2010] SGHC 200 at [65]), the classes and class headings are used to indicate a range of particular goods, often (but not necessarily) similar, and hence function to ensure that a person searching the Register knows where to direct his/her initial checks (although of course those must then be extended to similar goods in other classes).

54 The Nice Classification heading of Class 3 includes ‘non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions’ and that of Class 5 includes ‘preparations for destroying vermin; fungicides, herbicides’. This is the reason why the Subject Mark is registered with a specification of goods falling within Class 3 and the Applicant’s Combination Marks with one that falls within Class 5. However, goods may be similar even though in different classes: this can be seen from the Explanatory Notes to the List of Classes that states, for example, ‘medicated lotions’ fall within Class 5 whereas ‘non-medicated toiletries’ fall within Class 3.⁹ despite being in different classes, it would be very difficult if not impossible to argue that medicated and non-medicated lotions are other than similar goods.

55 That being said, my task is to look at the respective specifications and decide whether the goods are similar, not whether the form that those goods may take is similar. In this context, it is irrelevant that the Proprietor states in its evidence that “Registrant’s goods will never be sold in supermarket, personal stores or the same websites as those of the Applicant”:¹⁰ what must be considered are all normal uses of the Subject Mark on or in relation to the Objectionable Goods, and that must include use in such trade channels.

56 My decision on this element of the *Staywell* step-by-step approach is that the goods are dissimilar: insect repellents are not similar to skin care and toiletry preparations, notwithstanding the fact that they may be purchased in the same outlets by the same users. In my view, it cannot be the law that all goods sold in trade channels such as pharmacies, supermarkets and the like are to be considered similar merely because of the places they are sold from, and the people to whom they are sold, being in common. Instead, what must be determined in a common-sense way is whether the average consumer would view them as similar goods and I consider s/he would not.

57 I have reached this conclusion even without taking into account the fact that the Proprietor has qualified its specification of goods with the disclaimer “none of the

⁹ See *Kerly’s Law of Trade Marks and Trade Names*, 16th ed., at A23-004 and A23-006.

¹⁰ Abloh-1 at [37].

aforementioned goods being intended for use as a repellent for insects, vermin or fungi” (see [9] above). The Applicant contended in its Written Submissions that “the disclaimer merely reflects the Registrant’s intention not to sell repellents”.¹¹ I cannot agree: it is an important concession by the Proprietor.

58 Although the qualification falls short of an undertaking by the Proprietor that it will not use the Subject Mark for goods falling within the specification that are intended for use as an insect repellent etc, the qualification means that the Proprietor has voluntarily ceded the protection that it would otherwise have under section 28(3) of the Act. This states “a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered”. Thus, following the qualification, the Applicant would be free to sue the Proprietor for trade mark infringement under section 27 of the Act if the Proprietor used the Subject Mark on an insect repellent. Obviously, I make no comment on whether such an action for trade mark infringement would be successful but the consequence of the qualification is that the Proprietor is no longer able to avail itself of the defence in section 28(3) of the Act.

59 As I have found that the Applicant has failed to establish either that the marks are similar or the relevant goods are similar, there is no need for me to move on to the final *Staywell* step of considering whether there is a likelihood of confusion arising from those similarities.

Conclusion on Section 8(2)(b)

60 The ground of invalidation under section 8(2)(b) therefore fails.

Ground of Invalidation under Section 8(4)(b)(i)

61 Section 23(3)(a)(iii) of the Act reads:

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

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

...

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

...

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

62 Section 8(4) of the Act reads:

¹¹ Applicant’s Written Submissions at Section F, [22].

(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;

Decision on Section 8(4)(b)(i)

63 The threshold requirement to fall within this ground of invalidation is that the later “trade mark is identical with or similar to an earlier trade mark”. As I have already found that the Applicant’s Combination Marks (the earlier trade marks) and the Subject Mark (the later trade mark) are not similar, this ground must fail at the first hurdle. It is therefore not necessary to delve into the evidence submitted by the Applicant to establish whether either or both of the Applicant’s Combination Marks are well known in Singapore. Suffice it to say that had it been necessary, I would have found on the evidence before me that they are both well known in Singapore but that, by reason of its dissimilarity, use of the Subject Mark on the Objectionable Goods would not indicate a connection with the proprietor of either or both of the Applicant’s Combination Marks.

Conclusion on Section 8(4)(b)(i)

64 The ground of invalidation under section 8(4) therefore fails.

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

65 Section 23(3)(b) of the Act reads:

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

...

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

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

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

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

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

Decision on Section 8(7)(a)

67 To succeed on the ground of opposition under section 8(7)(a), an opponent must establish the classical trinity of goodwill, misrepresentation and damage (*The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 and *Singsung Pte Ltd v LG Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”). In its Written Submissions, the Applicant submitted that goodwill in its business is connected to the use of the coloured Combination Mark and the word “OFF!”,¹² and that such goodwill would be harmed by the misrepresentation that is likely to arise by use by the Proprietor of the Subject Mark in relation to the Objectionable Goods.¹³

68 In *Singsung* the Court of Appeal explained, at [67], “goodwill clearly exists in Singapore when a business offers a product or service for sale in this jurisdiction, and a customer purchases the product or consumes the service here.” The Applicant states, at Section D of Ferraiolo-1, that its sales of products under the OFF! Marks for the year 2020 in Singapore had a value of more than SGD 1,000,000, while the approximate total promotional expenditure for these products was more than SGD 100,000. The Applicant further states that in 2020 the total gross sales in Singapore of OFF! products in lotion form alone was more than SGD 100,000, while the approximate total promotional expenditure was more than SGD 8,000. The approximate figures for the total gross sales and annual promotional expenditure in Singapore of products under the OFF! Marks for the years 2010 to 2020 are set out at [8] and [9] of Section D of Ferraiolo-1. Notwithstanding that the Applicant has not adduced documentary evidence (for example, in the form of invoices or financial reports) to support these figures, they are contained in a sworn statement by Ms Ferraiolo, the Applicant’s Global Marketing Director, Pest Control, and the Proprietor has sensibly not wasted time or money contesting them. I consider it clear that the Applicant owns goodwill in Singapore.

69 Likewise, there is no doubt on the evidence at Sections D and E of Ferraiolo-1, including that referred to at [16] and [17] above, that the Applicant’s Combination Marks are distinctive of the Applicant’s products, so the threshold identified by the Court of Appeal at [38] of *Singsung* is easily crossed:

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

¹² Applicant’s Written Submissions at Section H, [9].

¹³ Applicant’s Written Submissions at Section H, [16].

70 Indeed, the Applicant's evidence shows that the Applicant's Combination Marks have acquired heightened distinctiveness as a result of their extensive use in Singapore on insect repellents.

71 Once goodwill and distinctiveness have been established, it must be shown by the claimant in a passing off action that there is deception, or a serious likelihood of it, for it is deception that is at the heart of a passing off action. This must be judged having regard to all the circumstances, albeit that those circumstances are necessarily more limited in the hypothetical passing off action that is considered for the purposes of section 8(7)(a) than they are in an actual passing off action where the actual behaviour of the parties in the marketplace must be considered. I do however bear in mind that the circumstances in this case include the heightened distinctiveness of the Applicant's Combination Marks as a result of extensive use in the Singapore marketplace to which I refer in the previous paragraph.

72 That being said, the level of similarity between the distinctive element(s) relied on by the hypothetical plaintiff (the Applicant in this decision) and those used by the hypothetical defendant (the Proprietor) is of particular importance, for it is only if these are sufficiently similar that there might be an actionable misrepresentation, i.e., the similarities would cause the relevant public to think, wrongly, that there is some kind of commercial link between the defendant's goods and the plaintiff. (See, for example, *Singsung* at [39]; *The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] 2 SLR 495 at [20]).

73 In the light of my finding at [47] that the Subject Mark is markedly different to the Applicant's Combination Marks in all respects other than its inclusion of the common word OFF, and even then the exclamation mark in the latter alters significantly the visual and conceptual impact of the use of the word in the respective marks, I do not consider there is a realistic possibility of deception being caused by any representation inherent in the use by the Proprietor of the Subject Mark in relation to the Objectionable Goods or indeed any goods falling within the Subject Mark's specification.

Conclusion on Section 8(7)(a)

74 The ground of invalidation under section 8(7)(a) therefore fails.

Overall Conclusion

75 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the application for a declaration of invalidity fails on all grounds. The Proprietor is entitled to its costs to be taxed, if not agreed.

Date of Issue: 15 December 2021