

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

**[2022] SGIPOS 14**

Trade Mark No. 40201913705S

**IN THE MATTER OF A TRADE MARK APPLICATION BY  
HARDWOOD PRIVATE LIMITED**

*... Applicant*

**AND**

**IN THE MATTER OF AN OPPOSITION THERETO BY  
GCIH TRADEMARKS LIMITED**

*... Opponent*

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**GROUND OF DECISION**

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**GCIH Trademarks Limited**  
**v**  
**Hardwood Private Limited**

**[2022] SGIPOS 14**

Trade Mark No. 40201913705S  
Principal Assistant Registrar Ong Sheng Li, Gabriel  
5 July 2022

3 October 2022

**Principal Assistant Registrar Ong Sheng Li, Gabriel:**

**Introduction**



1 This is the second of two trade mark opposition actions commenced by GCIH Trademarks Limited (the “Opponent”) in response to trade mark applications filed by Hardwood Private Limited (the “Applicant”).

2 The first dispute, which I heard early last year, was decided in the Opponent’s favour: see *GCIH Trademarks Limited v Hardwood Private Limited* [2021] SGIPOS 6 (“*Tango I*”). That case concerned the Applicant’s application to register “OT TANGO” in Class 30 for, among other things, chocolate and cocoa products. The Opponent’s primary line of attack was premised on its earlier “TANGO” trade mark, registered in Class 30 for chocolate and cocoa products. My key findings in *Tango I* were that: (a) the competing marks “TANGO” and “OT TANGO” are similar to a strong degree; (b) the goods are identical; and (c) there would be a likelihood of confusion. Given the conflict between “OT TANGO” and the Opponent’s earlier “TANGO” mark, the application was not allowed to proceed to registration.

3 In these proceedings, the Opponent is once again seeking to stop the

registration of a mark containing “OT” and “TANGO”. In issue is the



Applicant’s mark “ ”, applied for as a series of marks<sup>1</sup> in Class 30 under Application No. 40201913705S (the “Application Mark”) in respect of “*Wafers, Candy, Chocolate-based beverages; Coffee-based beverages; Tea-based beverages*” (the “Application Goods”). Given the various similarities between *Tango I* and this case, the natural question is whether the outcome of this dispute should be any different, and if so: why?

### **The Application Mark**

4 The Applicant applied to register the Application Mark on 24 June 2019. This is the relevant date by which the parties’ rights are to be assessed.

### **Grounds of opposition**

5 At the hearing, the Opponent relied on four grounds of opposition under the Trade Marks Act 1998 (“TMA”) against the Application Mark. They were: ss 8(2)(b), 8(4)(b)(i), 8(7)(a), and s 7(6) TMA. Two other grounds were originally pleaded but later withdrawn at the Pre-Hearing Review on 29 April 2022. They were: ss 8(4)(b)(ii)(A) and 8(4)(b)(ii)(B) TMA.

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<sup>1</sup> In practice, traders file for series marks to protect multiple minor variants of the same trade mark in a single registration. The definition of a series of trade marks is set out in s 17(2) of the Trade Marks Act 1998.

### **Statutory declarations**

6 Each side gave evidence via the usual way: through statutory declarations (“SD(s)”). Wong Shuk Fuen, a director of the Opponent, gave evidence on its behalf (“Opponent’s SD”). Ng Chee Wooi Michael, a director of the Applicant, gave evidence on its behalf (“Applicant’s SD”). They were the same individuals who gave evidence in *Tango 1*.

7 The Applicant did not file any evidence-in-reply. Since there was no cross-examination, the above-mentioned SDs formed the entirety of the evidence before this tribunal. While the evidence tendered in this case was not identical to that which was submitted in *Tango 1*, it overlapped significantly. For the record, the Opponent’s SD was affirmed on 9 August 2021 and the Applicant’s SD was affirmed on 7 February 2022. In other words, both sides’ SDs were made after my decision in *Tango 1* (issued 3 June 2021).

### **Background facts**

8 A detailed description of the relevant background is set out in *Tango 1* (at [6]-[7]). Unless indicated otherwise, the salient background facts recorded in *Tango 1* should be read as part of this decision as well. Thus, I can be brief. The Opponent and the Applicant are part of corporate groups that are in the business of, among other things, the manufacture and sale of chocolate and confectionery. The Opponent’s group of companies is mainly based out of Malaysia, whereas the Applicant’s “Orang Tua”<sup>2</sup> or “OT” Group operates primarily out of Indonesia. Both sides have used marks with the word “TANGO” (primarily in stylised form) in connection with chocolate and

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<sup>2</sup> Which, according to the Applicant, refers to “elderly man” in the Indonesian language: Applicant’s SD at [17].

confectionery in Singapore.

9 At least in Singapore, the Opponent is the incumbent user of “TANGO”. It has sold its “TANGO” chocolate and confectionery in this country for decades. Exhibited to the Opponent’s SD were copies of invoices demonstrating the sale of TANGO chocolate and confectionery in Singapore between 2000-2020.<sup>3</sup> There were also documents which suggested that the Opponent’s “TANGO” mark may have been used in Singapore as far back as 1991 or 1992.

10 By contrast, the Applicant is a relative newcomer to the Singapore market. Although there was a bare assertion that the Application Mark had been first used in Singapore in 2012,<sup>4</sup> this was not supported by the documents. (A slightly different claim was made in the earlier case where the Applicant said that it first used “OT TANGO” in 2000: see *Tango I* at [7].) Upon scrutiny of the Applicant’s evidence, the following picture emerges. In or around 2013, the Applicant appointed a Singapore company, Pepper Sion Pte. Ltd., to distribute its various “OT” products globally. In 2019, the OT Group appointed a local distributor, Meng Chong Foodstuffs Pte Ltd to distribute the Applicant’s “OT TANGO” products in Singapore.<sup>5</sup> Prior to 2019, the Applicant did not have a local distributor in Singapore and there is scant evidence that “OT TANGO” goods were sold to consumers in Singapore. There may have been small quantities of such chocolate and confectionery sold here through unofficial trade channels, but in the grand scheme of things any use of “OT TANGO” in Singapore prior to 2019

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<sup>3</sup> Opponent’s SD at [18] and corresponding Annex F

<sup>4</sup> Applicant’s SD at [21]

<sup>5</sup> Applicant’s SD at [21]-[23]

appeared to be relatively limited in nature.

11 At this juncture, it is helpful to reproduce extracts from the evidence illustrating one instance of how the parties used “TANGO”. While there were some variations in the way the parties used their respective marks, overall it did not deviate materially from what is depicted below.

Applicant’s use<sup>6</sup>



Opponent’s use<sup>7</sup>



### **First ground: s 8(2)(b) TMA**

12 It is convenient to begin with the s 8(2)(b) TMA ground of opposition. The provision reads:

8. (2) A trade mark shall not be registered if because —  
 (a) [omitted]

<sup>6</sup> Applicant’s SD at Exhibit S, page 372

<sup>7</sup> Opponent’s SD at Annex B, page 24

(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

### ***Opponent's earlier trade marks***

13 For this ground of opposition, the Opponent relied on the same two earlier marks as it did in *Tango I*, namely: (a) the plain word mark “TANGO” (TM No. T9109669H), registered on 25 October 1991 in Class 30 in respect of “Cocoa powder and products and chocolate in Class 30” (“TANGO Mark”); and (b) the “TANGO Composite Mark” depicted below (TM No. T1006585A), registered in series<sup>8</sup> on 25 May 2010 in Class 30 in respect of chocolates and various types of confectionery. (See *Tango I* at [4].)



14 Both parties approached this dispute on the premise that the TANGO Mark represented the Opponent's best case against the Application Mark. (This was also the perspective that I adopted in deciding the opposition against the “OT TANGO” mark: see *Tango I* at [22]-[27].) It is clear that the TANGO Composite Mark adds little, if anything, to the Opponent's case against the

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<sup>8</sup> See footnote 1 above.



Application Mark under s 8(2)(b) TMA that is not already covered by the TANGO Mark. For these reasons, the rest of this decision will primarily focus on the comparison between the TANGO Mark and the Application Mark.

### ***The three-step test***

15 In *Tango 1*, I discussed the relevant legal principles in some detail. For brevity, I will outline only the essentials. In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held that s 8(2)(b) TMA entails the following test. First, are the competing marks similar? Second, are the goods identical or similar? Third, is there a likelihood of confusion arising from the foregoing? All three steps must be established for the opposition under this ground to succeed.

### ***Similarity of marks***

16 It is trite law that in assessing similarity, three aspects or facets must be considered: the visual, the aural, and the conceptual. However, the ultimate question is whether the marks, when observed in totality, are similar rather than dissimilar: see *Staywell* at [17]-[18].

### ***Distinctiveness***

17 Although it is not a separate element under the step-by-step test, distinctiveness plays an integral role in the marks-similarity assessment. The term distinctiveness is used in two senses: (a) the ordinary and non-technical sense, which refers to what is outstanding and memorable about the mark in question; and (b) the technical sense, which refers to the opposite of “descriptiveness” and denotes the capacity of the mark to function as a badge of origin. Generally speaking, the more technically distinctive the senior (earlier) mark, the more difficult it would be for the user of (or applicant for)

the junior (later) mark to escape a finding of similarity: see *Staywell* at [25].

18 In *Tango I*, I found the TANGO Mark to be inherently distinctive to an ordinary degree because the word is meaningless in relation to chocolate and cocoa products. That finding must necessarily apply here as well. Unlike invented/coined words which may be highly distinctive, the TANGO Mark cannot be said to enjoy any higher threshold before a competing sign will be considered dissimilar to it.

*Evidence of acquired distinctiveness at the marks-similarity stage*

19 This brings me to the Opponent's argument that the TANGO Mark enjoys a higher level of distinctiveness because of the use that was made of it. This argument was also run in *Tango I*, and so that decision contains an extensive discussion on the vexed issue of whether (and if so, the extent to which) evidence relating to acquired distinctiveness through use may be taken into account at this first step (see *Tango I* at [33]-[40] and my postscript at [103]-[112]). Since then, there have been other decisions of this tribunal which have grappled with the topic,<sup>9</sup> as well as articles published by practitioners who have weighed in with their thoughts.<sup>10</sup> While it is tempting to add further opinions of my own, I note that the counsel for the Applicant steered clear of this issue and did not address it in written submissions. Given this, and for reasons that will become clear shortly, I think it best to dispose of this facet of

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<sup>9</sup> See, for instance, *Twitter, Inc. v V V Technology Pte Ltd* [2022] SGIPOS 4 (appeal to General Division of the High Court pending), and the various cases cited therein.

<sup>10</sup> See Lim Siau Wen & Teo Xuan Lang, *The Role of Acquired Distinctiveness in the Marks-Similarity Analysis* [2022] SAL Prac 9 (31 March 2022), and Vignesh Vaerhn & Avery Yew, *Distinctly Confusing: Clarifying the Applicability of Acquired Distinctiveness under Singapore Trade Mark Law* SAclJ (published on e-First 31 August 2022).

the Opponent's case by setting out my findings on the evidence.

20 The Opponent provided the annual sales figures for chocolate products and confectionery under the TANGO Mark, followed by its estimated annual global advertising expenditure incurred to promote the TANGO Mark (including in Singapore) from 2011 to 2018.<sup>11</sup> As recorded in the earlier case, there was evidence that the Opponent's goods were sold in Singapore through supermarket chains (both in-store and online) such as NTUC Fairprice, GIANT, Sheng Siong and PRIME: see *Tango 1* at [35]. The Singapore sales figures and worldwide advertising expenditure numbers are set out below.

Year	Annual Sales in Singapore (in SGD)	Worldwide Advertising Expenditure (in SGD)
2011	\$220,000	\$17,000
2012	\$143,000	\$11,000
2013	\$148,000	\$11,000
2014	\$131,000	\$10,000
2015	\$233,000	\$18,000
2016	\$267,000	\$22,000
2017	\$328,400	\$25,000
2018	\$407,000	\$31,000

21 In *Tango 1*, I observed (in relation to substantially the same evidence) that the Opponent had indeed advertised and sold chocolate and confectionery in Singapore in connection with "TANGO" as well as variants of the sign for a number of years. I also opined that while the Opponent's customers might not form a large proportion of the populace (as evidenced by the fact that its

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<sup>11</sup> Opponent' SD at [17] and supporting exhibits at Annexes F and G

annual sales figures are in the lower hundreds-of-thousands range), it has undoubtedly carved out a respectable slice of the market in Singapore in connection with the “TANGO” mark: see *Tango I* at [77(a)].

22 Notwithstanding the above, to my mind the Opponent’s evidence is clearly insufficient to support a finding of enhanced or heightened distinctiveness through use so as to justify a higher threshold before the Application Mark will be considered dissimilar to it. It is common knowledge that chocolate and confectionery are not niche goods. They are consumed by a very large proportion of the population in Singapore. The market is large, and it is well known that there are many brands in the market. I accept that the Opponent has a pool of customers in Singapore for its “TANGO” chocolate and confectionery (as evidenced by its respectable sales figures), and that it has indeed conducted advertising in Singapore. But, when viewed against the backdrop of the large and crowded market for chocolate and confectionery, “TANGO” must surely represent a very small slice of the market indeed.

23 During the hearing, I expressed these concerns to Ms Celine Teo, counsel for the Opponent. In response, Ms Teo urged me to bear in mind that the Opponent’s products are relatively inexpensive and so annual sales figures in the low hundreds-of-thousands would represent a proportionately higher volume of sales as compared to, say, more expensive chocolates. I take the point. Even so, I have difficulty seeing how, when viewed in context, the Opponent’s evidence of use and advertising would be sufficient to move the needle on acquired distinctiveness.

24 For these reasons, even if the correct position in law is that evidence of acquired distinctiveness can be considered at the marks-similarity stage, I find that this does not make any difference given my finding that the TANGO

Mark does not enjoy a higher degree of distinctiveness through use.

*Visual similarity*

25 I turn next to the first aspect of similarity: visual similarity. Although the law is that the competing marks should not be compared side-by-side, it is convenient to reproduce the marks alongside each other for ease of reference.

Opponent's TANGO Mark

**TANGO**

Application Mark



26 The parties' battle lines were drawn in ways that would not surprise a reader familiar with *Tango I*. The Opponent argued that the Application Mark incorporates the whole of the Opponent's TANGO Mark and placed significant reliance on my previous finding that the plain word marks "TANGO" and "OT TANGO" are visually similar to a significant degree: *Tango I* at [55]. The core of the Opponent's case was that "TANGO" is unmistakably the common distinctive element in both marks, whereas the other elements do not sufficiently distinguish the Application Mark from the TANGO Mark. In response, the Applicant submitted that this present case concerns a completely different mark, and that due consideration ought to be given to the additional devices and stylisation in the Application Mark which render the marks visually dissimilar overall.


27 In all fairness, I think that this case comes relatively close to the borderline. It is obvious that there is some minimal similarity between the competing marks in that they coincide in the ordinary English word: “tango”. But the Court of Appeal has rejected the notion that any particularly or notably low threshold of marks-similarity applies: see *Staywell* at [16]-[19]. Minimal similarity, without more, is insufficient to ground a finding of marks-similarity. The question is whether the marks, when observed in their totality, are similar rather than dissimilar. And for the reasons below, I ultimately prefer the view that the marks are visually more dissimilar than similar.

28 First, I think that the visual significance of “TANGO” in the Application Mark should not be exaggerated. It is one of many visual elements present in the Application Mark. On the left is what the parties have taken to calling the “Face Element”. It comprises two conjoined components: a representation of a bearded bald old man against a circular background, followed by the stylised letters “OT” against another circular background. Critically, both the old man as well as the letters “OT” are formed out of negative space, the effect of which is visually striking. And on the right of the Application Mark is what the parties refer to as the “Tango Element”. The letter “g” in “TANGO” is capped off by a small crown, and the entire word is also set against the backdrop of a larger crown device with a series of protruding vertical stripes bordering it. Both the Face Element and the Tango Element are of equal size and presence. Given all of this, “TANGO” alone cannot, in my view, be said to be the dominant element of the Application Mark. This case is very different from *Tango 1* where the application mark “OT TANGO” was a plain word mark with no other elements or features.

29 Second, although the TANGO Mark is inherently distinctive to an ordinary degree, the Application Mark contains at least one significant

component that is inherently distinctive to a high degree: the Face Element. Counsel for the Opponent argued that trade marks containing illustrations of faces are relatively common in the food and confectionery sector. I accept the point. But humans are exceedingly well accustomed to distinguishing countless faces from each other. More importantly (and perhaps for this very reason), traders using a head or face device have a commercial interest in distinguishing their marks from that of other traders. So, too, here. In this case, the Face Element is unique. Its features (viz. the bearded bald old man and the stylised letters “OT” set against a background of two conjoined circles) visually communicate a message that is much more than simply “OT” in plain letters. It would no doubt stand out as a strong badge of origin in the mind’s eye of the average consumer of the goods in question; perhaps even more so than the Tango Element. Given this and bearing in mind that the Tango Element also bears stylistic features of its own, I find that the commonality in the word “TANGO” would be displaced or outweighed by the other described visual differences between the marks.

30 Third, the contours of this dispute are analogous to earlier decisions of this tribunal where the presence of highly stylised distinctive elements were found to be sufficient to distinguish a composite mark from another mark. For instance, in *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17,<sup>12</sup> the plain word mark “MONSTER” was relied upon in opposition to the

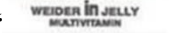

application mark “”. The hearing officer found the marks to be visually more dissimilar than similar on account of the so-called

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<sup>12</sup> The “ICE MONSTER” decision was upheld on appeal by the High Court. No written grounds of decision are available.

“cube man device” as well as the additional “ICE” word element. *Morinaga & Co., Ltd. v Weider Global Nutrition LLC* [2021] SGIPOS 15 is another



example. The competing marks were “” and “”. They were found to be visually dissimilar on account of the various additional distinctive elements in the application mark.

#### *Aural similarity*

31 I turn next to aural similarity. Here, the verbal elements of the competing marks are “TANGO” and “OT TANGO”. Since these are the same word elements assessed in *Tango I*, my findings in that case would apply here as well. For the reasons stated there, I am of the view that the marks are aurally more similar than dissimilar (see *Tango I* at [56]-[62]).

#### *Conceptual similarity*

32 The assessment for conceptual similarity seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole: *Staywell* at [35]. In *Tango I*, I observed that it was undisputed that “TANGO” has an ordinary meaning in the English language: it refers to a type of dance. That specific point would necessarily apply in this case as well. However, my findings in relation to the plain letters “OT” in *Tango I* do not carry over in the same way. In that case, I considered the plain letters “OT” to be



meaningless and neutral in the assessment for conceptual similarity: see *Tango I* at [64]-[65]. But the present case involves an Application Mark with very different conceptual elements. I elaborate below.

33 The letters “OT” in the Face Element (in the left half of the Application Mark) are depicted together with a device depicting a bearded bald old man. Even though consumers might not know what those letters “OT” stand for, the Face Element component would nonetheless stick in their minds. I accept that unlike the plain letters “OT” (see discussion in *Tango I* at [79]-[88]) the Face Element may be regarded as a distinguishing house mark.<sup>13</sup> As for the Tango Element, the stylisation evokes something quite different from “TANGO” as a dance form; indeed, the small crown above the “G” and the larger crown device in the background suggest, if nothing else, the concept of royalty of some sort. Taken together, the unlikely juxtaposition of an “OT” bearded bald old man house mark on the one hand and the concept of royalty on the other are conceptually quite different indeed from the idea and symbolism of “TANGO” as a dance. I therefore find that the marks are conceptually dissimilar to a material degree.

### ***Conclusion on s 8(2)(b) TMA***

34 I have found the competing marks to be: (a) visually more dissimilar than similar; (b) aurally more similar than dissimilar; and (c) conceptually dissimilar to a material degree. The law does not require that all three aspects of similarity be made out before the marks can be found to be similar. It likewise stands to reason that a finding of dissimilarity does not require a unanimous finding of dissimilarity for all three facets.

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<sup>13</sup> A house mark generally refers to a primary trade mark that is applied across all (or most) of the products supplied by a certain trader.

35 Having considered the marks in totality, for the reasons stated above, I find that the additional elements and features present in the Application Mark render it, on balance, dissimilar to the TANGO Mark. Broadly the same analysis would apply to the TANGO Composite Mark. (I am aware that slightly different arguments could be made on account of the stylisation and other elements in the TANGO Composite Mark, but there is nothing that would change the result.) The common law is largely built on the bedrock of treating like cases alike. But trade mark cases often turn on nuanced differences and each case must be decided having regard to its own facts. I may have decided in a certain manner in *Tango I*. However, the Application Mark here is different from the plain “OT TANGO” word mark for the reasons already stated. Thus, a different outcome has been reached.

36 My findings on marks-similarity mean that the essential first step in the three-step test has not been established. Accordingly, the opposition under s 8(2)(b) TMA fails. Although it is unnecessary for me to comment on the rest of the three-step test, for completeness and in case it is of assistance, I would offer some very brief remarks. On the issue of similarity of goods, I take the view that the goods for which the TANGO Mark are registered (namely: *Cocoa powder and products and chocolate*) are obviously similar to the Application Goods (in particular: *Wafers, Candy, Chocolate-based beverages*). Notwithstanding the foregoing, because the marks are—in my view—dissimilar on balance, there would not be a likelihood of confusion under the third step of the test.

37 Before moving on to the rest of the grounds of opposition, I would like to quickly touch on two points raised by parties in argument.

(a) First, the Applicant submitted that “TANGO” is a mark that is commonly used in the chocolate industry and should accordingly be given less significance because traders should not be given a complete monopoly over words that are common, or which other traders in the same industry may like to use. A similar argument was made in the earlier dispute. In *Tango I* (at [77(b)]) I made some observations in this vein before concluding on the basis of the evidence before me that while there was some evidence that chocolate/confectionery manufacturers outside of Singapore used “TANGO” in connection with their goods, as far as Singapore was concerned, apart from the Applicant (and the Opponent) there was no evidence that any other trader in Singapore had used “TANGO” in connection with chocolate and confectionery. In the Applicant’s SD (filed after the *Tango I* decision was issued), the deponent Mr Ng gave substantially the same evidence in these proceedings (namely: that there were other traders using “TANGO” in connection with the relevant goods in Singapore).<sup>14</sup> However, the supporting documents that he provided once again did not clearly establish use of “TANGO” by third parties prior to the relevant date. At best, the evidence relating to Singapore is inconclusive. Therefore, while I have found in the Applicant’s favour under s 8(2)(b) TMA, in so doing I have not given much weight to its arguments on this specific point. (Be that as it may, the Applicant’s evidence relating to the use of “TANGO” outside of Singapore is nonetheless relevant to the “bad faith” ground of opposition under s 7(6) TMA, something that I will come to later.)

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<sup>14</sup> Applicant’s SD at [37] and corresponding Exhibit O.

(b) Second, the Opponent drew my attention to several trade mark decisions from the European Union involving a finding of similarity between an earlier word mark and a later composite mark containing that same word element.<sup>15</sup> The Opponent appeared to be relying on these cases for the proposition that for composite marks involving both word and figurative elements, the word element usually has a greater impact on the consumer than figurative devices. I do not propose to deal with these decisions in any detail. After all, in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (at [41]), the Court of Appeal rejected the proposition that words “talk” in composite marks and made clear that the correct approach is to consider the marks in totality without placing undue emphasis on any particular component of such marks unless such emphasis is warranted on the facts. For the reasons already stated, it would not be justified to place special significance on the word “TANGO” over and above the other elements present in the Application Mark.

**Second ground: s 8(4)(b)(i) TMA**

38 I now turn to the next ground of opposition: s 8(4)(b)(i) TMA. This provision prohibits the registration of trade marks which conflict with an earlier well known trade mark provided certain conditions are met. One of these conditions is that the earlier well known trade mark relied upon must be shown to be identical with or similar to the competing mark. If identity or similarity of the competing marks is not established, the opposition under this ground will necessarily fail.

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<sup>15</sup> Opponent’s Written Submissions at [122] onwards.

39 Above, in the context of the s 8(2)(b) TMA ground of opposition, I have found that the marks relied upon by the Opponent (namely: the TANGO Mark and the TANGO Composite Mark) are dissimilar to the Application Mark. That finding applies equally here as well. Consequently, this ground of opposition is likewise unsuccessful.

**Third ground: s 8(7)(a) TMA**

40 To succeed in an opposition under s 8(7)(a) TMA, the Opponent must establish a notional case of passing off: see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]. The classic elements of the tort of passing off are trite. They are: (a) goodwill; (b) misrepresentation; and (c) damage or likelihood of damage to goodwill. The key principles in relation to each element have been discussed in various decisions of the Court of Appeal, including *The Singapore Professional Golfers' Association v Chen Eng Waye and others* [2013] 2 SLR 495 (“SPGA”) and *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“Singsung”).

41 Given my finding under the s 8(2)(b) TMA ground of opposition that the TANGO Mark and the TANGO Composite Mark are dissimilar to the Application Mark, I can dispose of this ground in a straightforward fashion. In most cases (and this one is no exception), the misrepresentation complained of is that the newcomer’s sign (or some other indicia) misrepresents to the relevant public that its goods are those of, or are related to or associated with, that of the incumbent (see *SPGA* at [25]). To be actionable under the law of passing off, misrepresentation must give rise to confusion or the likelihood thereof (see *Singsung* at [40]). If the competing marks are dissimilar to begin with, then it must follow that there would not be a likelihood of confusion as

to trade origin. Misrepresentation cannot be established. For this reason, I must necessarily also dismiss the opposition under this ground.

**Fourth ground: s 7(6) TMA**

42 I come now to the fourth and final ground of opposition: bad faith. Section 7(6) TMA provides that a trade mark “*shall not be registered if or to the extent that the application was made in bad faith*”.

43 The essential legal principles underlying this area are trite. In summary, bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark. (*Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”) at [28].) The test for determining bad faith is a “combined” one, in that it contains both a subjective element (viz. what the particular applicant knows) and an objective element (viz. what ordinary persons adopting proper standards would think). Bad faith as a concept is context dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case. An allegation of bad faith is a serious claim to make, and it must be sufficiently supported by the evidence. It needs to be distinctly proved and this will rarely be possible by a process of inference. (*Valentino* at [29]-[30].) Although the law requires bad faith to be determined as at the date of the application (here: 24 June 2019), it is permissible to also consider matters (including the applicant’s conduct) which occur after the date of application since they may assist in determining the applicant’s state of mind at the date of registration: *PT Swakarya Indah Busana v Dhan International*

*Exim Pte Ltd* [2010] 2 SLR 109 (“*PT Swakarya*”) at [91]. Although the Opponent always bears the legal burden of establishing the ground, if it makes out a *prima facie* case of bad faith then the evidential burden shifts to the Applicant to disprove the element of bad faith (see *Valentino* at [21] and [36]).

44 The Opponent’s case on bad faith was advanced along two main lines. First, it contended that the Applicant was aware of the Opponent’s rights to “TANGO” at the time the application was filed and so it was bad faith for the Applicant to have applied for the Application Mark which contains the word “TANGO”. In this connection, it pointed out that by the relevant date (24 June 2019), the Opponent had already filed an opposition against the “OT TANGO” word mark that was the subject of the proceedings in *Tango 1* and despite this, the Applicant nevertheless went ahead to apply for the Application Mark. Second, the Opponent submitted that the evidence of actual use (see, for instance [11] above) showed that the Applicant had been consistently using the Tango Element of the Application Mark in a way that takes centre stage whereas the Face Element was presented in a much smaller size and positioned away from the Tango Element. Here, the argument was that the Applicant had no *bona fide* intention to use the mark in the form applied for (where the Face Element and the Tango Element are of equal size and presence) and was merely seeking to secure a registration.

45 The Applicant’s counter was that mere knowledge of the Opponent’s marks was insufficient and in any event the Applicant had itself been using the Application Mark in Indonesia as far back as 2004. As regards the Opponent’s contention regarding use, the Applicant submitted that its current use was not determinative of its *bona fide* intention to use the Application Mark and, in any case, it had not been shown that the Applicant’s actions would be considered dishonest or commercially unacceptable by reasonable persons. In

its submission, the high degree of dissimilarity and stylisation of the Tango Element suggests that the Application Mark was developed independently and in any event is clearly distinguishable from the Opponent’s marks, which pointed away from any dishonesty or deception.

46 It is convenient to first address the Opponent’s submission concerning the alleged lack of *bona fides* on the Applicant’s part when it filed for the Application Mark. By way of background, the issue of *bona fides* originates from s 5(2)(e)(ii) TMA, which provides that when a trade mark is applied for, the applicant must state that there is a *bona fide* intention “*that the trade mark should be so used*”. It was undisputed that the lack of *bona fide* intention can amount to bad faith for the purposes of a s 7(6) TMA ground of opposition. I begin the analysis by discussing, in brief, the cases that the Opponent relied on: *PT Swakarya* and *BETTY’S KITCHEN CORONATION STREET Trade Mark* [2000] RPC 825 (“*Betty’s Kitchen*”).

47 In *PT Swakarya*, the plaintiff’s shirts bore the trade mark “MARTIN”. Its “MARTIN” shirts had a reputation in Singapore and a good number of them were sold in this country from 1997 to 2008. The defendant originally started out selling the plaintiff’s “MARTIN” shirts to the public in Singapore. However, the defendant later discovered that there was a demand for cheaper shirts that looked like “MARTIN” shirts and subsequently engaged in a pattern of selling such products. It also obtained registration of the “EMPEROR MARTIN”<sup>✳</sup> trade mark. But, in actual use, the word “EMPEROR” on the defendant’s products was typically given lesser prominence, for example,

in the following way: “”. The court found that the defendant’s conduct showed that it had exceeded the boundaries of normal and



fair use of the mark “MARTIN” and that there was an obvious and conscious effort to copy the plaintiff’s mark. In those circumstances, the court held that the defendant’s “EMPEROR MARTIN<sup>®</sup>” mark was clearly never intended to be used in the registered form when it was filed. In the result, the plaintiff succeeded in obtaining a declaration of invalidity and order for revocation.

48 In arriving at its conclusion, the court in *PT Swakarya* considered and adopted the reasoning in *Betty’s Kitchen*. That latter case concerned an application to register the plain word mark “**Betty’s Kitchen Coronation Street**” in the UK for various food products in classes 29 and 30. The application was opposed by the proprietors of a number of restaurants and associated shops which were run under “BETTYS” / “BETTY’S”. A representation of the packaging for the applicant’s “Spicy Pork Hot Pot” product (which showed the manner of actual use) is set out below.



As can be seen from the above image, there were various disparate trade mark elements on the product packaging including: (a) the mark “HOLLAND’S” with the device of a chef or butcher; (b) “BETTY’S KITCHEN” within a banner device; (c) a representation of a pub (apparently from a television series); and (d) the words “CORONATION ST.” in a white background in the form of a street sign. There was evidence that the applicant’s food products were advertised as the “Betty’s Kitchen range from Holland’s” or by reference to “Betty’s Kitchen” alone. The applicant had also been aware of the opponent’s registrations for “BETTYS” / “BETTY’S” because of the applicant’s earlier failed application to register “BETTY’S KITCHEN”. Given the circumstances, the hearing officer concluded that:

Against that background it seems to me that the mark applied for is an attempt by the applicants to put sufficient distance between themselves and the opponents for the purposes of securing a registration but without the mark being a true reflection of what is conceded to be the intended and actual form of use. Taking all these circumstances into account I have come to the view that the applicants’ dealings fall short of “acceptable commercial behaviour” [...]

Needless to say, the bad faith ground of opposition succeeded.

49 I acknowledge that multiple parallels can be drawn between this case and the cases of *PT Swakarya* and *Betty’s Kitchen*. However, as observed in *Betty’s Kitchen*, it is “unusual for an opponent to suggest that the applicants do not intend to use their mark in the form applied for”. When all is said and done, the enquiry is a highly fact specific one. In my considered view, this case is unique and distinguishable from *PT Swakarya* and *Betty’s Kitchen* in at least the following ways.

- (a) The applicant in *Betty’s Kitchen* conceded that the intended and actual use of the mark would be in the form reproduced at [48] above.

Given this, and the fact that such use diverged drastically from the intended registration (so much so that there was an additional distinctive element “HOLLAND’S” with a device), one can readily see why the UK Registrar found that this would not be normal and fair use of the mark applied for (which was a plain word mark). In contrast, in this case there was no such concession or admission. The Opponent’s arguments hinged on evidence of the Applicant’s past conduct. However, for reasons I will come to very shortly, this can only carry the matter so far. It does not establish a *prima facie* case of bad faith.

(b) Relatedly, there was strong evidence in *PT Swakarya* that the defendant had no intention to use the mark in the registered form. Notably, *PT Swakarya* was not an opposition case. It was an action for invalidation and revocation against a registered mark. The defendant’s “EMPEROR MARTIN” trade mark had been registered in May 2002 and approved for registration in May 2003. It stayed registered for a relatively long period of time prior to the commencement of proceedings. By the time the plaintiff conducted investigations into the defendant’s use, it was already February 2008. Quite obviously, the situation here is different. The Opponent pointed out that the Applicant’s SD was affirmed around 3 years after the relevant date. Even so, the mark has not yet been registered and it seems premature to find a lack of intention to use in this case.

(c) Additionally, unlike “MARTIN” and “BETTY’S”, which are personal names, “TANGO” is an ordinary word in the English language. I do not propose to discuss at length issues concerning the use of personal names as trade marks; all I will say is that in the ordinary case, unless the name happens to also be personal to the

junior trader, it is difficult to justify using it as a sign in relation to the junior trader's goods or services. These same considerations do not apply to most other ordinary words in the English language (like "TANGO"). Indeed, the Applicant's evidence that other traders outside of Singapore were using "TANGO" in connection with chocolate and confectionery (e.g. Nestle's "TANGO MINI" and Ghiradelli's "CHERRY TANGO")<sup>16</sup> lends support to the contention that it would not—leaving aside the issue of conflict with earlier trade mark rights—be out of the ordinary for other industry players to apply for a mark containing "TANGO".

(d) Flowing from the above, even if the focus is solely on the Applicant's past and present actual use, I do not think that the situation can be likened to *PT Swakarya* and *Betty's Kitchen*. The Application Mark is a composite mark featuring the Face Element and Tango Element in equal prominence. In trade, the Applicant has advertised and used both the Face Element and the Tango Element together. It is true, of course, that the use is not in the exact form set out in the Application Mark. But all things considered, the past and present use does not diverge as dramatically from the proposed registration as compared to those cases.

(e) Finally, in *PT Swakarya*, there was a deliberate effort to copy the plaintiff's mark and ride on it by selling knockoff "MARTIN" shirts at a lower price. In *Betty's Kitchen* there was some evidence of advertising focussing on "*Betty's Kitchen*" without the accompanying words "Coronation Street" or the other trade mark "HOLLAND'S".

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<sup>16</sup> Applicant's SD at Exhibit O, pp 289 and 291

The facts of this case are more akin to an incumbent trader seeking to keep a newcomer out of the territory. It is one thing to argue a case of bad faith premised on the alleged similarity of marks. It is another thing entirely to have the evidence show a deliberate pattern of deception or active misrepresentation.

50 I have some sympathy for the Opponent's argument concerning the alleged lack of *bona fide* intention to use. I acknowledge that it seems slightly odd that the Applicant filed for a trade mark with the Face Element and Tango Element situated side-by-side when in commerce its products are packaged and advertised in a manner which emphasises the Tango Element over the Face Element. I also can see how the timing of the filing of the Application Mark might raise some eyebrows.<sup>17</sup> But all that said, an accusation of bad faith is a very serious allegation to make. After a trade mark is registered, a proprietor has a 5-year grace period to put it into genuine use before it (subject to some conditions) becomes vulnerable to an action for non-use revocation. Could this be open to abuse? For sure. But there are also many legitimate commercial reasons why trade mark owners in Singapore are given the flexibility of time to put their registered marks into use. I would imagine that it is for this reason, coupled with the extreme difficulty of proving the allegation, that it is rare for an opponent to suggest that an applicant does not intend to use its mark in the form applied for.

51 And at the end of the day, it all comes down to evidence. I do not think the Opponent has put forward sufficient evidence to establish a *prima facie*

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<sup>17</sup> The Application Mark was filed on 21 June 2019, by which time the earlier opposition against the plain "OT TANGO" word mark which culminated in the *Tango 1* decision was well under way.

case that the Applicant has no *bona fide* intention to use the Application Mark in the form applied for (or a normal and fair use variant of the same). Here, the Opponent relied primarily on evidence of the Applicant's past conduct. I am not saying that such evidence will never be enough. All I am saying is that it is too early to tell in the present case. What other evidence could the Opponent have put forward? Well, at the very least it could have applied to cross-examine the Applicant's Mr Ng. Let me illustrate the point by reference to a concrete example. In the Opponent's written submissions, it made the point that the Applicant had applied to register the same mark as the Application Mark on 16 January 2014 in Mexico, and that despite the lapse of almost 8 years since, there was no evidence to show use of the Application Mark in the same or substantially the same manner depicted in the form of the application. The point is fairly made. But as a submission it only goes so far. Should the question not have been put to Mr Ng in cross-examination?

52 I now turn to the remaining issue which relates to the alleged knowledge of the Opponent's earlier rights. The law in this area is uncontroversial. Knowledge has always been a relevant factor to be considered. However, mere knowledge of another trader's rights, without more, is not enough. As discussed earlier, "TANGO" is an ordinary English word and there is some evidence that there are a number of traders outside of Singapore who use "TANGO" as a sign in connection with chocolate or confectionery (see [37(a)] above). Moreover, in actual trade the Opponent itself uses "TANGO" in the form represented by the stylised TANGO Composite Mark (see [11] above). In the circumstances, while the Opponent might be the incumbent user of "TANGO" and have earlier registrations for the TANGO Composite Mark and the plain TANGO Mark, I think that reasonable and experienced persons in the chocolate and confectionery industry would *not* consider it commercially unacceptable to use or apply to

register a mark with the word “TANGO” in it, provided it contains sufficient stylisation and other distinguishing elements. To be clear, I am not saying there can be no bad faith if the marks are dissimilar. That would be incorrect in law. All I am saying is that mere knowledge, without more, is not enough especially where the earlier mark is an ordinary English word and the later mark contains sufficient distinguishing features.

53 I would therefore dismiss the opposition under s 7(6) TMA.

### **Conclusion and costs**

54 For the reasons stated, I dismiss the opposition on all grounds and allow the Application Mark to proceed to registration. The parties would have been notified that for most trade marks hearings fixed from 2 June 2022, the Registrar will assess costs summarily. This approach is intended to be more cost and time effective for parties as compared to taxation proceedings after the substantive decision. I have considered the parties’ submissions on costs and, having regard to all the circumstances, would award the Applicant the sum of S\$9,000 (inclusive of disbursements).

55 A final word of exhortation: If sufficient time has elapsed and the Applicant still has not aligned its actual use with the representation applied for under the Application Mark, that may be grounds for invalidating the registration and/or applying for non-use revocation. Since the factual circumstances may have changed by then, the issue of *res judicata* may not arise. But any objection to the Applicant’s actual use of “TANGO” in the marketplace must necessarily be pursued before the courts. Whether or not the registration will serve as a defence under s 28(3) TMA to an infringement action will depend on the factual circumstances. A persuasive argument could be made that the Applicant’s use in the format depicted at [11] above would

not be shielded by the representation in the form applied for under the Application Mark. But that is an issue for the courts to decide if proceedings are brought, not the Registrar of Trade Marks.

Ong Sheng Li, Gabriel  
Principal Assistant Registrar

Ms Celine Teo (Union Law LLP) for the Opponent;  
Ms Christine Saw and Mr Melvin Pang (Amica Law LLC) for the  
Applicant

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