

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

**[2022] SGIPOS 9**

Trade Mark No. 40201800571T-02

**IN THE MATTER OF A TRADE MARK APPLICATION BY  
FLOOR XPERT PTE. LTD.**

---

**GROUNDS OF DECISION**

---

**In the matter of a trade mark application by  
Floor Xpert Pte. Ltd.**

**[2022] SGIPOS 9**

Trade Mark No. 40201800571T-02  
Principal Assistant Registrar Ong Sheng Li, Gabriel  
12 April 2022

20 May 2022

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

**Introduction**

1 This is an application by Floor Xpert Pte. Ltd. (the “Applicant”) to  
FLOOR XPERT  
register “ Floor Xpert ” (Trade Mark No. 40201800571T-02) as a  
series<sup>1</sup> of trade marks in Class 37 (the “Application Mark”) for the services  
 (“Application Services”) set out below.

Class 37

Floor polishing; installing wood flooring; floor maintenance services; fitting of floor coverings; maintenance and repair of flooring; advisory services relating to flooring; constructing decks; tiling services; application of floor coating materials; installation services; repair, maintenance and installation consultancy services.

2 It would be immediately apparent to the reader that “Floor Xpert” is a misspelling of “Floor Expert”. This communicates to the public that the proprietor of the Application Mark is an expert in relation to flooring. Such a

---

<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.

mark is inherently non-distinctive and is, in and of itself, ineligible for registration as a trade mark for the Application Services (which largely concern flooring-related services).

3 In this application, the Applicant does not seek to contend that the Application Mark is inherently distinctive. Instead, it submits that its evidence proves that the Application Mark has acquired distinctiveness through use so as to qualify for registration as a trade mark. The central question raised in this hearing is whether this is correct. The trade mark examiner who reviewed the evidence in conjunction with the Applicant's arguments did not think so, and was unwilling to allow the Application Mark to be accepted for registration.

### **Outcome**

4 After careful consideration, I agree that the Application Mark has acquired distinctiveness through use. I therefore allow the Application Mark to be accepted for registration. Although I could have notified the Applicant of my decision to accept the Application Mark directly in writing (or in such other manner as the Registrar thinks fit): see rule 24(5) of the Trade Marks Rules 2008 ("TMR"),<sup>2</sup> for reasons that will become clear in due course, I have decided to send these Grounds of Decision to the Applicant under rule 24(5A) TMR<sup>3</sup> so that the public has access to my full reasons for accepting the Application Mark.

5 Before proceeding further, I must preface my decision with two brief points. First, this hearing was *ex parte*, meaning that I did not have the benefit of reviewing evidence or hearing counter arguments from any other party. (At

---

<sup>2</sup> After all, the issue of an appeal does not arise where the Registrar allows a trade mark application to be accepted.

<sup>3</sup> Note: Rule 24(5A) TMR came into effect on 1 October 2021.

this stage of the trade mark application process, third parties cannot intervene.)  
Second, after the mark is accepted for registration, it will next be published in the Trade Marks Journal where, for a period of time, any party may oppose the registration of the mark. Even after the window for opposition passes (and the mark proceeds to registration), any party may apply to invalidate a registered trade mark. In the event of any challenge, the person hearing the matter is not bound by this present decision and will be able to consider the issue afresh.

### **Procedural background**

6 The Application Mark (Trade Mark No. 40201800571T-02) was initially filed on 9 January 2018 under Trade Mark No. 40201800571T (the “Original Application”).

## FLOOR XPERT

7 The Original Application for “ **Floor Xpert** ” was sought to be registered in respect of the specification of goods in Classes 19 and 27 (set out in full below), as well as in respect of the Application Services in Class 37 (detailed in full at [1] above).

### Class 19

Wooden flooring; hardwood flooring; non-metallic floors; flooring made of wood; non-metallic flooring; floor tiles, not of metal; laminate flooring, not of metal; floor panels made of non-metallic materials; non-metallic decking; non-metallic flooring materials; panels made of wood coated with plastics for use in building; panels made of wood veneered with plastics for use in building.

### Class 27

Floor coverings; vinyl floor coverings; floor coverings of wood; floor tiles made of carpet; cork tiles (floor coverings); floor coverings for indoor use; Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; artificial turf.

8 The trade mark examiner who first considered the Original Application (the “1<sup>st</sup> Examiner”) found “Floor Xpert” to be descriptive and non-distinctive in relation to the Application Services in Class 37 and raised objections under ss 7(1)(b) and (c) of the Trade Marks Act 1998 (the “Act”). The section provides, in material part, as follows.

**Absolute grounds for refusal of registration**

7.—(1) The following must not be registered:

- (a) [omitted]
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) [omitted]

9 The central thrust of the 1<sup>st</sup> Examiner’s objections, as set out in the first Examination Report, was as follows:

The word “Xpert” in “Floor Xpert” is a common misspelling for the English word “Expert”. In turn, consumers would understand “Floor Xpert” to mean “Floor Expert”. The noun “Expert” refers to “a person who is very knowledgeable about or skilful in a particular area” [...] When the mark “Floor Xpert” is considered in relation to the services claimed in Class 37, it merely conveys that the Applicant possesses the knowledge and skills to provide quality floor-related services. The overall impression of the mark on the average consumers is likely to be laudatory, rather than function as a badge of trade origin.

10 The first Examination Report concluded with an invitation to overcome the objection by filing evidence (if any) that the mark had acquired distinctiveness through use. The Applicant responded to this invitation by filing the statutory declaration of Lim Lena, sole director of the Applicant (“Lim’s SD”), together with written representations arguing that the evidence showed

that “Floor Xpert” had acquired sufficient distinctiveness through use as designating the services provided by the Applicant.

11 Curiously, however, the 1<sup>st</sup> Examiner did *not* raise any objections in respect of the application for the specified goods in Classes 19 and 27. This eventually led the Applicant to file a request for division of the Original Application, which enabled the application for registration under Classes 19 and 27 (designated as Trade Mark No. 40201800571T-01) to proceed to registration even whilst the application to register the Application Mark in Class 37 remained under review at the examination stage.

12 Although it is not open for me to review the 1<sup>st</sup> Examiner’s approach (which was to *not* object to the Original Application) in Classes 19 and 27, I would have thought that the reasons given by the examiner for objecting to the Application Mark in Class 37 would have applied with equal force in respect of the goods in Classes 19 and 27 — both of which relate to flooring products (see [7] above). It could be said that “Floor Xpert”, when considered in relation to flooring-related *products*, should also be regarded as inherently non-distinctive because it would communicate to the public that the products offered thereunder are provided by an expert and therefore possess a certain quality. That said, all of this is now water under the bridge given that Trade Mark No. 40201800571T-01 is registered and it can be argued that my finding that the Application Mark has distinctiveness through use would likewise apply to flooring products.

13 Returning to the main timeline, the Application Mark was subsequently handled by a different trade mark examiner (the “2<sup>nd</sup> Examiner”). After reviewing Lim’s SD and the accompanying arguments, the 2<sup>nd</sup> Examiner issued a second Examination Report which indicated that the objections would be maintained. The main concern expressed in the second Examination Report was

that the evidence was deficient in that it showed use of the following instead of use of the Application Mark: (a) “FLOOR XPERT PTE. LTD.” (that is, the Applicant’s full corporate name); (b) the Applicant’s stylised “Floor Xpert” mark reproduced below; (c) the domain name <http://www.floorxpert.com/>; and (d) the social media handle @FloorXpert. In addition, the 2<sup>nd</sup> Examiner was of the view that the evidence of use did not relate to the Application Services in Class 37; instead, it showed use in relation to the distribution and sale of flooring products. (The examiner’s reasons are also summarised at [25]-[26] below.)

The stylised “Floor Xpert” Mark



14 Although the Applicant attempted to address the 2<sup>nd</sup> Examiner’s concerns through two rounds of further arguments, the examiner remained unpersuaded and issued a third and thereafter a fourth Examination Report which sustained the objections. Both reports maintained that the evidence did not show that the Application Mark had in fact acquired distinctiveness through use. The fourth Examination Report concluded with the following exhortation:

Please note that any further written representations on the same issue(s) are unlikely to assist in the examination of this application. However, if you are of the view that the application has merits despite this letter, you may write in within 4 months from the date of this letter to apply for an *ex parte* hearing via Form HC 4.

Please let us hear from you in writing on the above by 28 May 2022 or the application shall be treated as withdrawn.

15 After receiving the fourth Examination Report, the Applicant requested for an *ex parte* hearing under rule 24(2)(b) TMR. Counsel for the Applicant advanced submissions in writing as well as orally during the hearing.

### **Applicant's case**

16 The arguments presented by the Applicant during the hearing were premised on s 7(2) of the Act, which is a saving provision for trade marks that are inherently non-distinctive (see [8] above) but which have nevertheless acquired distinctiveness through use prior to the date of application for registration. The section is reproduced below.

7.—(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Since the date of application for registration of the Application Mark was 9 January 2018 (the “Relevant Date”), to satisfy the requirements of the provision the Applicant must show that the Application Mark had acquired a distinctive character through use prior to this Relevant Date.

### ***Applicable law***

17 It is trite law that in assessing whether a sign has acquired distinctiveness through use, it must be shown that a significant proportion of the relevant class of persons relied upon the sign on its own as indicating that the goods or services in question originated from a particular trader. This entails an overall assessment of the evidence. As the Court of Appeal stated in *Société des Produits Nestlé SA v Petra Foods Ltd* [2017] 1 SLR 35 at [51]:

...the question of reliance is directed at whether consumers perceive the sign in question as an indicator of the origin of the goods or services to which the sign is applied. The key question, in broad terms, is whether consumers treat that sign as a trade mark, that is to say, as a guarantee of origin. This inquiry will entail an **overall assessment** of the evidence.

(emphasis in original)



***The evidence***

18 I now summarise the salient aspects of the evidence set out in Lim’s SD.

19 The Applicant is a Singapore company in the business of providing premium flooring solutions, including resilient vinyl flooring, laminate flooring, wood flooring and outdoor flooring in wooden (or wood replacement) decking, and artificial turf. It serves homeowners and commercial partners such as contractors and interior designers and provides customer service throughout the entire process from pre-consultation to installation, clean-up and after-sales. From its incorporation in 2010, the Applicant has only served customers in Singapore. In its first year of business, the Applicant’s annual sales turnover was S\$ 724,296. By 2016, this had grown to S\$ 3,826,243.

20 The Application Mark was first used in Singapore at the time of its incorporation, more than 8 years prior to the Relevant Date. Ever since then, “Floor Xpert” has been continuously used as the Applicant’s badge of origin. Although the Applicant is a distributor for various premium flooring brands like “Quick-Step”, “Grandeur”, “EzDeck”, “zSNAP.Deck” and “zSNAP.Turf”, all its business is conducted under and in connection with the “Floor Xpert” mark. The Applicant’s website contains the words “floorxpert” in the domain name (<http://www.floorxpert.com/>), first registered in February 2010. Its Facebook page is located at <https://www.facebook.com/FloorXpert/>, with “Floor Xpert Pte Ltd” as the title of the page (which means that it appears on every single post). In all of its communications to the public (e.g. through Facebook posts), the Applicant refers to itself as “Floor Xpert”, and the handle “@FloorXpert” is used on the Applicant’s Facebook page. There is no other trader in Singapore that uses “Floor Xpert” as a badge of origin.

21 Over the years, the Applicant engaged in advertising and marketing efforts. The Applicant primarily did this through Facebook advertising and by having an active business presence on Facebook. In addition, it also had media exposure through sponsorships on television. Since the Applicant exclusively serves customers in Singapore, all its advertising and promotion is targeted at the public in this country. Pertinently, the Applicant's Facebook advertisements were intentionally geo-limited (note: this is an option that Facebook offers for advertisements on its platform) to reach only users in Singapore and its television advertising was broadcast on Singapore national television through English as well as Chinese language channels.

22 Further details relating to the Applicant's advertising and marketing efforts are sketched out below under the relevant categories.

(a) Facebook advertising and corporate presence: The Applicant's annual advertising expenditure on Singapore-only Facebook advertisements amounted to S\$23,864.68 in 2015, S\$47,585.24 in 2016, and S\$25,972.30 in 2017. These figures were supported by exhibited documents showing billing reports from Facebook. From 2014 to 2017, the Applicant's Facebook advertisements bearing the Application Mark achieved more than 1,383,401 "People Reached" and 193,864 "Engagements" in Singapore. As of 28 September 2018, the Applicant's Facebook page had 68,147 likes and 68,322 follows. These numbers were supported by sample screenshots and printouts from the Applicant's Facebook Paid Posts Insights page as well as corresponding monthly billing reports issued by Facebook.<sup>4</sup>

---

<sup>4</sup> However, the evidence does not disclose the figures for unique individuals. Given the nature of advertising on social media platforms, it is no doubt the case that the targeted individuals would have viewed the same advertisements numerous times.

(b) Media exposure: The Applicant and the Application Mark were featured on the following local television programmes prior to the Relevant Date: (i) the 8<sup>th</sup> episode of “*Designer in the House*”, broadcast on Channel 5 on 24 January 2017; (ii) the 8<sup>th</sup> episode of “*Please Be My Guest! 客人来咯!*”<sup>5</sup> (Season 2), broadcast on Channel 8 on 24 October 2016; and (iii) the 6<sup>th</sup> episode of “*PLAY HOUSE 室内新玩家*”,<sup>6</sup> broadcast on Channel 8 on 27 November 2017. These programmes remain accessible on local broadcaster MediaCorp Pte Ltd’s video streaming service Toggle (now known as MeWatch) even today. All of these programmes featured film footage from the Applicant’s showroom, and there was evidence the Applicant was referred to (at least in the English-language show) by name as “Floor Xpert”.

(c) Search Engine Advertising: Between 26 November 2015 and 29 September 2016 alone, the Applicant spent S\$64,035.49 on its search engine marketing efforts. The Applicant also exposed its brand (and consequently the Application Mark) through leading search engine, Google, and its AdSense advertising programme. This resulted in more than 20,000,000 views and 38,819 clicks by Internet users in Singapore and led to an increase in calls and quotation requests submitted through digital channels. At the relevant time, an average of S\$10,000 was spent on Google advertising per month. These figures were provided in the main body of Lim’s SD. However, Lim’s SD did not exhibit supporting documents in relation to this category.

---

<sup>5</sup> Pronounced “kè rén lái lo”. This Chinese phrase is related to, but is not a direct translation of, the English title “Be My Guest”.

<sup>6</sup> Pronounced “shì nèi xīn wán jiā”. This Chinese phrase is related to, but is not a direct translation of, the English title “PLAY HOUSE”.


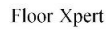
23 Notably, there was evidence that the reviews posted by the Applicant’s customers made direct reference to the Application Mark: “Floor Xpert”. I reproduce examples from Lim’s SD on this point below.



24 There were also printouts exhibited in evidence from a local internet forum thread as well as an online review posted on a personal blog mentioning the Application Mark. The forum post, from Hardware Zone, dated 1 March 2017, referenced “*floorxpert - LURF from Belgium*”. The blogpost on Dayre, dated 2 April 2017, referenced “*LURF, Select oak light from Floor Xpert*” and “*Please ask for her to serve you when you visit Floor Xpert for a consultation!*”.

### **Examiner’s reasons**

25 As mentioned earlier, the 2<sup>nd</sup> Examiner did not agree that the evidence was sufficient to show acquired distinctiveness through use. The examiner’s main reasons were summarised in the second numbered paragraph of the fourth (and final) Examination Report, reproduced in material part below.

As explained in our Examination Reports (dated 11 January 2020 and 14 January 2021), we are of the view that the use of the Stylised Mark “” would not constitute use of the Subject Mark as filed (“”). The evidence pertaining to the company name “*FLOOR XPERT PTE. LTD.*”, domain name (*www.floorxpert.com*) and the Applicant’s social media handle (*@FloorXpert*) also could not adequately show use of the Subject Mark “*FLOOR XPERT*” in a trade mark sense. We opine that

consumers are likely to perceive these instances of use as mainly serving the purposes of a company name, a domain name and a social media handle respectively.

26 Broadly speaking, the examiner’s key objections were founded on two propositions: first, that the Applicant’s use of the Application Mark in different forms could not be taken into account in the assessment for acquired distinctiveness through use; and second, even if the evidence demonstrated use in connection with other goods or services, such use did not relate to the Application Services. However, the Examination Reports did not appear to address the further question of whether, if these propositions were incorrect, the evidence as a whole would be sufficient to satisfy s 7(2) of the Act.

**First issue: Use of the Application Mark**

27 As detailed in my sketch of the evidence, a great deal of the Applicant’s marketing and promotional activities was undertaken via targeted Facebook advertisements in connection with its Facebook page. To briefly recapitulate: the Applicant’s handle is “@FloorXpert” and its Facebook account name bears its full corporate name, “Floor Xpert Pte. Ltd.” (which would have appeared on every one of its Facebook posts). In addition, the Applicant’s Facebook page contained a link to its website, [www.floorxpert.com](http://www.floorxpert.com), and where appropriate the advertisements also contained a link to this same webpage.

28 The central question is whether this evidence should be disregarded on the premise that it did not show use of the Application Mark as filed. I have carefully scrutinised the various Examination Reports and the reasons therein. I think the view (maintained in the fourth Examination Report: see [25] above) that the use of “Floor Xpert Pte. Ltd.”, “@FloorXpert” and [www.floorxpert.com](http://www.floorxpert.com)” did not adequately show use of the Subject Mark “Floor Xpert” in a trade mark sense cannot be sustained on the present facts. It does

not gel with commercial reality as well as the perspectives of the relevant public (here: homeowners and businesses as well as contractors and interior designers).


29 As the Applicant rightly pointed out in its written submissions, company names and trade names can serve dual functions: they can be a corporate name as well as serve as an identifier and badge of origin for the goods or services in question. Here, the only difference between the Application Mark and the Applicant’s corporate name is the element “Pte. Ltd.”. It is common knowledge amongst the public in Singapore that this is an abbreviation for “Private Limited”. Some might not know or care about the intricacies of corporate law and the various business vehicles that are available. But practically everyone would know that “Pte. Ltd.” refers to a company. This element is therefore wholly descriptive and functional. Accordingly, consumers would focus on the words that appear in front of “Pte. Ltd.” (here: “Floor Xpert”). While “Floor Xpert” might not be inherently distinctive (such that it would merit trade mark registration without use), it is not wholly incapable of distinguishing one trader from another. The fact that “Xpert” is an obvious misspelling of “expert” would not be lost on average consumers. The whole point of incorporating a company is to do business. Thus, if anything, the use of “Floor Xpert Pte. Ltd.” would send the message that the Applicant is a company known as “Floor Xpert”. Given this, the public would likely treat the Application Mark as a badge of origin; a signifier of the trade source for goods and services offered thereunder.

30 Of course, I am by no means suggesting that the mere fact that a company has been incorporated under a specific name means that such a sign would automatically count in the assessment for acquired distinctiveness through use. The analysis is context-dependent and much depends on the nature and extent of the use. If a trader incorporates a company but the entity does not engage in business, there would not be any use of the company name as a trade

mark. If, however, the company has been trading under its corporate name for a material length of time and the overall effect of the manner of use on consumers is that they would regard the business or company name as a badge of origin, it must logically follow that the company or business name would count as trade mark use. In this case, the Applicant was actively using its full company name as a trade mark in connection with its corporate Facebook page. It ran Facebook advertisements over long periods of time, spending material sums of money—which then led to average consumers in this country being targeted and engaged by these advertisements. This, in turn, led to actual sales which, based on the evidence, did trend upwards with time. Since these activities were all tied to the business of providing flooring solutions under the “Floor Xpert” sign, it must stand to reason that the evidence relating to “Floor Xpert Pte. Ltd.” is relevant in the distinctiveness assessment.

31 Similar lines of analysis apply in relation to the Applicant’s evidence of use relating to its website and social media handle. This is not a case involving a business with one company name, a different social media handle, and yet another domain name for its products and services. Here, the corporate name, the website, and the social media handle all contain the exact same key elements: “Floor Xpert”. The words may have been combined (as in “FloorXpert”) since domain names and social media handles do not permit blank spaces. But the critical point is that the key elements are unmistakably “Floor Xpert”. It is true (as was pointed out in the second Examination Report) that domain names primarily serve as a directional reference. However, it does not follow that domain names cannot serve as a source identifier. To reiterate: I am not saying that it is enough to have a mere registration for a website and Facebook account. What I am saying is that the evidence in this case goes beyond mere registration or internet presence. Upon scrutiny, the evidence bears out the argument that the Applicant made constant active steps to target and

engage Singapore-based actual and potential customers in connection with the domain name (which was regularly advertised) and the social media handle, which then converted into actual sales. Also, lest it be forgotten, the whole point of clicking or typing a domain name is to seek out the person or entity that is operating the website. In this case, it buttresses the point that the goods or services provided originate from a business known as “Floor Xpert”. On these facts, the use goes far beyond mere internet presence. It indicates trade origin.

32 What then of the Applicant’s evidence relating to “”? The 2<sup>nd</sup> Examiner’s view was that the use of the stylised mark would not constitute use of the Application Mark as filed since the fanciful representation of the letter “X” as a butterfly is what confers distinctiveness on the highly stylised version. In response, the Applicant argued that the mark is not so heavily stylised and that it remains apparent that the words within (that is: “Floor Xpert”) are identical to the Application Mark. From my perspective, I do not think it necessary to make a concrete finding either way. Based on an overall assessment of the evidence, it seems that whenever the stylised mark is used, the plain word mark “Floor Xpert” (sometimes with “Pte. Ltd.” or the full domain name) also appears somewhere nearby. Therefore, nothing really turns on the evidence relating to the stylised mark.

### **Second issue: Whether use was in relation to the Application Services**

33 I now turn to the second issue, which concerns the objections (set out in the second to fourth Examination Reports) premised on the view that the evidence showed use in relation to goods or services (e.g. the distribution and sale of flooring products) other than the Application Services.



34 The Applicant relied on various statements in, and documents exhibited to, Lim's SD to prove its case that the evidence of use did indeed relate to the Application Services. I now reproduce some relevant extracts from the evidence with the addition of my brief comments. For context, each of these documents were printouts of Facebook posts that had been boosted through paid advertising targeted at consumers in Singapore. It is also worth repeating that since the Applicant's Facebook corporate profile was named "Floor Xpert Pte Ltd", this meant that those words would have appeared at the beginning of each post accompanied by relevant promotional photographs or illustrations.

(a) Exhibit C1: "*Come join us for a FREE consultation and quotation*". This demonstrates use in relation to "*advisory services relating to flooring*" as well as "*repair, maintenance and installation consultancy services*".

(b) Exhibit C10: "*our friendly and experienced flooring consultants would be more than happy to help you select your floors*". This demonstrates use in relation to "*advisory services relating to flooring*" as well as "*repair, maintenance and installation consultancy services*".

(c) Exhibit C13: "*we guarantee you peace of mind with our 15 year product warranty + LIFETIME workmanship warranty*". This demonstrates use in relation to "*floor maintenance services*"; "*maintenance and repair of flooring*"; and "*repair, maintenance and installation consultancy services*".

(d) Exhibit C21: "*Be floored by the entire filming & installation process*". This demonstrates use in relation to "*installing wood flooring*"; "*fitting of floor coverings*"; "*constructing decks; tiling services; application of floor coating materials; installation services*;

*repair, maintenance and installation consultancy services*". And, since polishing would be required after installation, it demonstrates use in relation to "*Floor polishing*" as well.

35 From a review of the evidence, I agree that the Applicant's services were provided in a package which includes consultation and advice, sale of flooring, installation, clean-up, and after-sales service (including the provision of a warranty on certain terms). These activities — which were conducted under and in connection with the Application Mark (including use of the full corporate name, domain name, and social media handle) — fall within the direct scope of, or at least closely relate to, one or more of the items in the specification of the Application Services.

36 Before moving on, I should highlight that the Applicant also had evidence that it referred to itself as "Floor Xpert" (that is, without any accompanying additional indicia). This further reinforces the conclusion that the Application Mark has acquired distinctiveness through use. I reproduce some of the relevant documents in issue below.

(a) Exhibit C2:



(b) Exhibit C7:



(c) Exhibit C23:



37 The third Examination Report acknowledged that the evidence set out in the three exhibits (C2, C7 and C23) demonstrated the use of the Application Mark. However, the report took the view that the use of the Application Mark in these instances appeared to relate to design services and design consultancy services (which would not fall under Class 37 but instead belong to a different class of services) rather than the Application Services.

38 I take a different view. True, the Applicant’s advertisements may have referenced interior design or flooring design. But it does not follow that the Applicant’s actions related to matters outside the scope of the Application Services. As counsel for the Applicant sensibly pointed out, when the Applicant provides advice on choice of flooring, it would also have to recommend designs which would be suitable for the floor area, having regard to various other consideration such as materials used, durability, structural integrity, weather resistance, and so on. By nature, these business activities would be closely connected to “*advisory services relating to flooring*” and “*repair, maintenance and installation consultancy services*”, both which fall squarely within the scope of the Application Services. Moreover, it is self-evident from the Facebook post in Exhibit C23 that the Applicant was not offering design services and design consultancy services. The event advertised by the Applicant involved a “*reputable interior design firm*” as well as a “*Feng Shui master in Singapore*”. If the Applicant was offering design services or design consultancy services, it would not have partnered with an interior design firm to offer a joint event.

### **Conclusion**

39 The Applicant’s evidence was certainly not without its flaws. To use the year 2016 as an example, one could argue that an annual turnover of less than S\$4,000,000 Singapore dollars and an annual advertising spend for Facebook advertisements (which was the primary mode of marketing) of slightly less than S\$50,000 was rather modest in nature. One could also say that Lim’s SD provided insufficient information as to the Applicant’s presence in the context of the overall market for flooring-related goods and services. Yet others might note from my sketch of the evidence that the Applicant did not provide documents to support the statements made in Lim’s SD to the effect that the Application Mark had been exposed to more than 20,000,000 views and 38,819

clicks by Internet users in Singapore (and it is arguable that even if one were to take this evidence at face value, it should have little weight since a viewer might have seen or clicked on the same advertisement many times, thus leading to inflated numbers). Various other criticisms could be levelled.

40 However, the shortcomings in the Applicant’s evidence did not denude of significance the fact that the Applicant made substantial efforts to use and advertise the Application Mark over the 8 years leading up to the Relevant Date. Even though the Applicant distributed various flooring brands, its trading activities (which led to the generation of revenue) were ultimately carried out under one sign: “Floor Xpert”. In arriving at the conclusion that the Application Mark should be accepted, I have given significant weight to the Applicant’s evidence that there was no other trader in the marketplace using “Floor Xpert”; a claim that seems consistent with the fact that: (a) some of its customers were able to post reviews relating to “Floor Xpert” on a separate internet forum as well as a personal blog (see [23]-[24] above)<sup>7</sup> without triggering confusion as to trade source; and (b) the Applicant was featured on local English and Chinese television channels in 2016 and 2017 (see [22(b)] above) by reference to “Floor Xpert”. I would assume that the flooring business is a relatively niche industry and if there were any others providing services under “Floor Xpert” this fact would have found its way into the evidence (and it did not).

41 Granted, there is no other party present to challenge the Applicant’s evidence or draw the Registrar’s attention to some other evidence. This is a feature, not a flaw, of the trade mark examination process. Any party who disagrees with my conclusion and wishes to put forward some other evidence

---

<sup>7</sup> The blogpost received 48 likes and 29 comments, which suggests that there was at least some degree of engagement. Furthermore, none of the commenters appeared to have any issues with “Floor Xpert” being used as an identifier of trade origin.

(e.g. that there was some other trader using “Floor Xpert” in connection with flooring services) or arguments for the Registrar’s consideration may do so at the appropriate juncture: see [5] above.

### **Closing observations**

42 The careful reader may have observed that these Grounds of Decision do not contain any significant discussion of case law. This is intentional. After all, the assessment of distinctive character through use is a highly fact specific inquiry and the cases (or at least the ones which were cited in the examination process) did not necessarily provide guidance at the level of granularity required in this case. When dealing with descriptive and non-distinctive signs, it is right and prudent for trade mark examiners to treat any alleged evidence of use submitted by an applicant with a healthy dose of caution. The Registrar must carefully assess whether the evidence in each case supports the claim that a significant proportion of the relevant public would in fact rely on the sign as a badge of origin. However, in so doing, the Registrar should adopt an approach consistent with common-sense and marketplace realities, having regard to the perception of the relevant public for the goods and services.

Ong Sheng Li, Gabriel  
Principal Assistant Registrar

Ms Gillian Tan and Mr Mark Teng (That.Legal LLC) for the  
Applicant

---