

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

[2023] SGIPOS 9

Trade Mark No. 40201614827X

**IN THE MATTER OF A PROTECTED TRADE MARK
IN THE NAME OF**

BITFLYER INC.

... Proprietor

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
BY**

COINBASE, INC.

... Applicant

GROUND OF DECISION

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Coinbase, Inc.

v

bitFlyer Inc.

[2023] SGIPOS 9

Trade Mark No. 40201614827X
Principal Assistant Registrar See Tho Sok Yee
22 February 2023

2 May 2023

Principal Assistant Registrar See Tho Sok Yee:

Introduction

1 Two major cryptocurrency exchanges lock horns over a trade mark which is the name of one party. The initiating party established its right to the mark, which the responding party usurped. Hence, a declaration of invalidity is granted against the protection of the latter’s international registration designating Singapore.

2 Coinbase, Inc. (“the Applicant”) applied for a declaration of invalidity against International Registration No. 1308248 (TM No. 40201614827X) designating Singapore. The latter has been protected in Singapore in the name of bitFlyer Inc. (“the Proprietor”) since 3 February 2016 (“the Relevant Date”). The details of the mark are as follows:

Trade Mark No.	Mark (the “Subject Mark”)
40201614827X (IR No. 1308248)	coinbase

Class	Specification
35	<p>Promoting the goods and services of others through the administration of sales and promotional incentive schemes involving trading stamps; business management analysis or business consultancy; business management of hotels; preparation of financial statements; employment agencies; auctioneering; import-export agencies; arranging newspaper subscriptions; shorthand services; transcription; document reproduction; office functions, namely filing, in particular documents or magnetic tape; compilation of information into computer databases; providing business assistance to others in the operation of data processing apparatus namely, computers, typewriters, telex machines and other similar office machines; reception services for visitors in buildings; publicity material rental; rental of typewriters, copying machines and word processors; providing employment information; news clipping services; rental of vending machines; retail services or wholesale services for liquor; retail services or wholesale services for meat; retail services or wholesale services for sea food; retail services or wholesale services for vegetables and fruits; retail services or wholesale services for confectionery, bread and buns; retail services or wholesale services for rice and cereals; retail services or wholesale services for milk; retail services or wholesale services for carbonated drinks [refreshing beverages] and nonalcoholic fruit juice beverages; retail services or wholesale services for tea, coffee and cocoa; retail services or wholesale services for processed food; advertising and</p>

	<p>publicity services; marketing research or analysis; providing information concerning commercial sales (which includes information provision via the Internet); providing information concerning advertisement and publicity services (which includes information provision via the Internet); intermediary services on sale and purchase contracts for goods in electronic commerce transactions; business operation and management concerning electronic commerce transactions; systematization of information into computer databases; retail services or wholesale services for clothing; retail services or wholesale services for diapers; retail services or wholesale services for footwear; retail services or wholesale services for bags and pouches; retail services or wholesale services for woven fabrics and beddings; retail services or wholesale services for personal articles; retail services or wholesale services for foods and beverages; retail services or wholesale services for automobiles; retail services or wholesale services for two-wheeled motor vehicles; retail services or wholesale services for bicycles; retail services or wholesale services for furniture; retail services or wholesale services for joinery fittings; retail services or wholesale services for tatami mats; retail services or wholesale services for ritual equipment; retail services or wholesale services for bladed or pointed hand tools, hand tools, and hardware; retail services or wholesale services for kitchen equipment, cleaning tools, and washing utensils; retail services or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; retail services or wholesale</p>
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	<p>services for cosmetics, toiletries, dentifrices, soaps and detergents; retail services or wholesale services for agricultural machines, implements and supplies; retail services or wholesale services for natural flowers and trees; retail services or wholesale services for fuel; retail services or wholesale services for printed matter; retail services or wholesale services for paper and stationery; retail services or wholesale services for sports goods; retail services or wholesale services for toys, dolls, game machines and apparatus; retail services or wholesale services for musical instruments and records; retail services or wholesale services for photographic machines and apparatus and photographic supplies; retail services or wholesale services for clocks, watches, and spectacles; retail services or wholesale services for tobaccos and smokers' articles; retail services or wholesale services for building materials; retail services or wholesale services for semi-wrought precious stones and their imitations; retail services or wholesale services for pet animals.</p>
38	<p>News agencies; rental of telecommunication equipment including telephones and facsimile apparatus; telecommunication [other than broadcasting]; telecommunication for electronic commerce transactions via telecommunications systems or data communication systems; broadcasting; giving time to access computer databases where users can search and obtain information concerning electronic commerce transactions.</p>
42	<p>Providing meteorological information; architectural design;</p>

	<p>surveying; geological surveys or research; designing of machines, apparatus, instruments [including their parts] or systems composed of such machines, apparatus and instruments; designing; technological advice relating to computers, automobiles and industrial machines; testing, inspection or research of pharmaceuticals, cosmetics or foodstuffs; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing, inspection or research on agriculture, livestock breeding or fisheries; testing or research on machines, apparatus and instruments; rental of measuring apparatus; rental of laboratory apparatus and instruments; rental of drawing instruments; designing, programming, or doing maintenance of computer programs for use in electronic commerce transactions; providing search engines for electronic commerce transactions; designing, programming, or doing maintenance of computer programs (software) for authenticating users in electronic commerce transactions; designing, programming, or doing maintenance of Internet websites for electronic commerce transactions.</p>
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The Proprietor had sought protection of the Subject Mark in Classes 9 and 36 as well, but these classes were treated as withdrawn in the process.

Background of parties

3 The Applicant was founded in June 2012 and is based in California,

USA. It is a leader in the provision of digital asset and currency exchange services and related software and services. It operates a digital currency wallet and platform where merchants and consumers can transact using digital currencies such as Bitcoin, Ethereum and Litecoin. As Wall Street Journal article “Coinbase Nabs \$5m in Biggest Funding for Bitcoin Startup” dated 7 May 2013 puts it in simple terms, of some of the service offerings, “Coinbase is an online platform that allowed users to buy Bitcoin, the virtual currency taking the tech world by storm. Users can also store Bitcoin in a digital wallet and pay merchants for goods or services with it.” CoinDesk also interviewed the Applicant’s CEO, Brian Armstrong and published an article “Coinbase aims to become the Gmail of Bitcoin” on 28 October 2013, where “Armstrong breaks its services down into three main categories: user wallets, bitcoin buying and selling, and merchant tools. It has competitors in all three areas ... but capitalises on being one of the only companies – if not the only one – to offer an end-to-end ecosystem.”

4 The Proprietor is also a Bitcoin exchange and marketplace which enables its customers to buy, sell and spend Bitcoins. It was founded in January 2014 in Tokyo, Japan. It is Japan’s largest cryptocurrency exchange. CNBC, in a news article “World’s largest bitcoin exchange, bitFlyer, enters the US” published on 28 November 2017, wrote that “The world’s largest bitcoin exchange by trading volume is launching in the US.” Incidentally, in the same article, the Applicant was also referred to as the “leading US platform for buying and selling bitcoin”.

Grounds of invalidation

5 The Applicant relies on Section 23(1) read with Section 7(6) and Section 23(3)(a)(i) read with Section 8(2)(a) and (b) of the Trade Marks Act 1998 (“the Act”) in this application for a declaration of invalidity.

Applicant’s evidence

6 The Applicant’s evidence comprises the following:

- (a) a Statutory Declaration made by Juan Suarez, Vice President of Legal, of the Applicant, on 16 September 2019 in California, USA (“ASD1”);
- (b) a Statutory Declaration in Reply made by the same Juan Suarez on 19 February 2020 in California, USA; and
- (c) a Supplementary Statutory Declaration made by Ariana Woods, Head of Intellectual Property, of the Applicant, on 6 October 2022 in Virginia, USA (“ASSD”).

Proprietor’s evidence

7 The Proprietor’s evidence comprises a Statutory Declaration made by Midori Kanemitsu, Intellectual Property Manager of the Applicant, on 14 November 2019 in Tokyo, Japan (“PSD”).

Applicable law and burden of proof

8 There is no overall onus on the Proprietor before the Registrar during examination or in invalidation proceedings. The undisputed burden of proof in the present case falls on the Applicant.

Procedure

9 On 10 August 2022, the Proprietor’s agent filed Form CM1 to discharge itself. Pursuant to Rule 10(7) of the Trade Marks Rules (subsequent references to “Rule” are references to rules from the Trade Marks Rules), the Registrar sent a notice to the Proprietor requesting it to provide an address for service within 3 months after the date of the notice. By the deadline of 22 November 2022, the Proprietor had not provided any address for service. In accordance with Rule 10(9)(b) read with Rule 9(6B)(c), the Proprietor was not permitted to take further part in these proceedings relating to the application for a declaration of invalidity. In fact, since the discharge of its agent on 10 August 2022, the Registrar has not heard from the Proprietor at all.

Ground of invalidation under Section 23(1) read with Section 7(6)

10 Section 23(1) of the Act reads:

The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

11 Section 7(6) of the Act reads:

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

The law on bad faith

12 The fundamental legal principles underlying the law on bad faith are set out in the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”):

(a) The term ‘bad faith’ embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though

such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark (*Valentino* at [28]).

(b) The test for determining bad faith contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Bad faith as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case (*Valentino* at [29]).

(c) Once a *prima facie* case of bad faith is made out by the alleging party, the burden of disproving any element of bad faith on the part of the responding party would arise (*Valentino* at [36]).

(d) An allegation of bad faith is a serious claim to make and must be sufficiently supported by evidence. It must be fully and properly pleaded and should not be upheld unless it is distinctly proved, and this will rarely be possible by a process of inference (*Valentino* at [30]).

(e) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion (*Valentino* at [20]).

Application of Section 7(6) to the facts

13 The Applicant alleges that the application to protect the Subject Mark was made in bad faith for the following reasons:

(a) First, the Proprietor was well aware of the Applicant’s “COINBASE” mark before the Relevant Date, but nonetheless

proceeded to apply for the protection of the Subject Mark in Singapore without the Applicant's knowledge, consent or authority.

(b) Second, the Proprietor has no *bona fide* intention to use the Subject Mark in Singapore.

Applied to protect Subject Mark despite knowledge of Applicant's "COINBASE" mark

14 The Applicant has had its International Registration No. 1216587 protected in Singapore under Trade Mark No. T1415229E since 4 June 2014, before the Relevant Date. The details of the mark are as follows:

Trade Mark No.	Mark (the "Applicant's Mark")
T1415229E (IR No. 1216587)	COINBASE
Class	Specification
9	Downloadable computer software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, and managing digital currency payment and exchange transactions.
36	Currency exchange services; on-line real-time currency trading; cash management, namely, facilitating transfers of electronic cash equivalents; digital currency exchange transaction services for transferrable electronic cash equivalent units having a specified cash value.
42	Providing temporary use of online non-downloadable software for use in electronically trading, storing, sending, receiving, accepting and transmitting digital currency, and managing digital

	currency payment and exchange transactions.
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15 Apart from the above, the Applicant has also protected its trade mark **coinbase** || exchange in Singapore since 6 August 2015, before the Relevant Date, with details as follows:

Trade Mark No.	Mark
40201518193Y (IR No.1268814)	coinbase exchange
Class	Specification
36	Provision of a financial exchange for the trading of virtual currency; financial services, namely, selling and purchasing of virtual currency in exchange for fiat currency via a retail trading platform.

16 The Applicant’s services have been extended to Singapore users since its launch in Singapore in September 2015. In Exhibit 1A of ASD1, David Farmer, the Applicant’s international expansion lead, was quoted as saying, *“Singapore expresses an important market for us. To date, more than 15,000 people in Singapore have signed up for a Coinbase wallet, and by extending our buy and sell service to the country, we’re helping to make their on-ramp to the bitcoin world as simple and as safe as possible ...”*

17 The Applicant has also adduced evidence in its ASSD that the Proprietor had actual knowledge of the Applicant’s existence and its “COINBASE” mark.

18 This is seen from the Proprietor’s press release on 16 October 2014 announcing that it had secured fundraising from an entity known as Bitcoin Opportunity Corp (“BOC”). In the press release, the Proprietor stated that BOC

had “*invested in notable virtual currency related companies such as Coinbase ... proving that their investment reach goes beyond the US market and expands internationally ...*”

19 Second, the Proprietor issued another press release on 28 January 2015 which again described BOC’s profile as having investments in “*noted virtual currency companies such as Coinbase, Xapo, and Bitpay*”.

20 Having regard to the above two press releases, the Applicant submits that by referring to the Applicant as a “notable” virtual currency company, the Proprietor was clearly aware of the esteemed reputation that was attached to the Applicant and its “COINBASE” mark.

21 Third, the Proprietor’s and Applicant’s representatives both appeared on the same panel discussion on “Bitcoin as a new means of currency and payment” at the “B Dash Camp 2015” conference in Fukuoka, Japan. The Proprietor shared a Facebook post by what appears to be the organiser, B Dash Ventures, which listed the panellists, including bitFlyer Co., Ltd.’s Kato-san and Coinbase’s Smuel (*sic*) Rosenblum. The post also featured a picture of the panellists seated alongside each other onstage.

22 All the above evidence of the Proprietor’s knowledge of the Applicant’s existence and its “COINBASE” mark pre-dates the Relevant Date.

23 To further strengthen its case, the Applicant also points to circumstances which suggest that the Proprietor would have known of the Applicant, such as the parties’ background as described at [3] and [4] above. Both are recognized providers of cryptocurrency exchange services and it would be impossible for

each to not be aware of the other competitor in this niche field, especially when both have international operations and operate in major markets like the USA.

24 On the other hand, the Proprietor did not give a clear explanation on how the Subject Mark was derived. It simply claimed that the word “coinbase” was originally a technical term meaning “the first transaction of the block in which mining reward is generated”. In support, it exhibited an extract from Bitcoin Wiki on the term “Coinbase” at page 22 of the PSD. The extract is dated 26 January 2018 (after the Relevant Date) and explains the term as follows:

The coinbase is the content of the “input” of a generation transaction. While regular transactions use the “inputs” section to refer to their parent transaction outputs, a generation transaction has no parent, and creates new coins from nothing.

The coinbase can contain any arbitrary data. The genesis block famously contains the dated title of an FT article:

The Times 03/Jan/2009 Chancellor on brink of second
bailout for banks

25 The Proprietor also claimed to have used the Subject Mark on its blockchain explorer service, chainFlyer, as shown in the following screenshot (at page 24 of its PSD):

The screenshot displays the chainFlyer interface for a Bitcoin transaction. At the top, the transaction ID is `a54692c119dd1375bfd02ab57131851fc7815a3005b897e7aca11225d225e995`. The transaction is labeled as **Pending (1 Confirmations)** and was received on **2018/08/21 13:32:00 JST**. The amount sent is **12.62500234** BTC, with a block height of **537750**. The transaction size is **206 bytes** (479 vbytes) and has a weight of **716**. The **Input** section shows **No Inputs**. The **Output** section shows one output to address `13Djmm45v1mkym8QJ3c3qbDnTP24aEZCfs` for **12.62500234** BTC. The **Output Scripts** section lists: `OP_DUP`, `OP_HASH160`, `OP_PUSHDATA:1858f277d8501b58f9af3895d37a4ccc0b04237a`, `OP_EQUALVERIFY`, `OP_CHECKSIG`, and `Unspent`. The word "Coinbase" is highlighted in yellow in the bottom left corner of the screenshot.

26 The Proprietor has not explained what its blockchain explorer service, chainFlyer, does. However, it appears from the above screenshot that it displays a Bitcoin transaction made on 21 August 2018, after the Relevant Date.

27 I have doubts whether the above screenshot indeed demonstrates that the Proprietor has used the Subject Mark as a trade mark in relation to the specifications of services. If anything, how the word “Coinbase” is used in the screenshot (as highlighted in yellow in the bottom left corner) appears to lend support to the technical meaning quoted by the Proprietor in the paragraph immediately preceding the screenshot. This leans against trade mark use by the Proprietor.

28 Further and in any case, such purported use in August 2018 is not shown to have taken place in Singapore and also post-dates the Applicant’s first use of its “COINBASE” mark in Singapore since September 2015. The High Court in *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 (“*Weir Warman*”) stated at [76] that:

The proposition that the first user of the mark in Singapore is the true owner of the mark is acknowledged in *Sifco Industries Inc v Dalic SA* [1997] 3 SLR(R) 930.

29 Hence, the facts before me are that:

- (a) The Proprietor was well aware of the Applicant and its “COINBASE” mark before the Relevant Date.
- (b) The Applicant has used its “COINBASE” mark in Singapore since 2015 and is the true owner of the mark, whereas the Proprietor has not established use of the Subject Mark in Singapore at any time.
- (c) The Proprietor has nonetheless sought the protection of the Subject Mark in Singapore without the Applicant’s consent or authority.

30 I go on to consider whether the Proprietor’s act of seeking protection for the Subject Mark in Singapore will be commercially unacceptable to reasonable and experienced persons in the financial market.

31 The Applicant cites two cases in support: *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”) and *Comite Interprofessionnel du vin de champagne and anor v Keep Waddling International Pte. Ltd.* [2020] SGIPOS 10 (“*ChamPengWine*”).

32 In *Festina*, the High Court found the respondent’s derivation of its mark “J.ESTINA” extremely contrived and noted the lack of explanation why the meaningless word “ESTINA” was chosen. This led to the irresistible conclusion that “ESTINA” was blatantly copied from the appellant’s “FESTINA”. Tay J (as he then was) pronounced at [123] that “*Such outright copying of the Appellant’s mark is an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.*”

33 In *ChamPengWine*, the Principal Assistant Registrar found that the word “ChamPeng” in the component “*ChamPengWine*” of the application mark was copied from the geographical indication “Champagne”, and cited, at [84a], *Festina* that “... *outright copying ... is an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.*”

34 The Applicant submits that there has been outright copying in the present case. Such copying is all the more blatant because the Proprietor made no attempt to distinguish the Subject Mark from the Applicant’s Mark. The Proprietor has not explained why it chose the word “coinbase” as the Subject Mark. In line with *Festina* and *ChamPengWine*, such outright copying would fall short of “*the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade.*”

35 I agree. The Proprietor was aware of the Applicant and its “COINBASE” mark before the Relevant Date. The Proprietor has nonetheless sought the protection of the Subject Mark, the name of its direct competitor, in Singapore without the Applicant’s consent or authority. Such conduct would surely be considered commercially unacceptable by reasonable and experienced persons in the financial market.

36 As such, the application to protect the Subject Mark was made in bad faith across the entire scope of the specifications for which protection was obtained.

No bona fide intention to use Subject Mark on the specifications claimed

37 In the alternative, the Applicant submits that the Proprietor did not have any *bona fide* intention to use the Subject Mark on the specifications claimed when making the application to protect the Subject Mark; and that this accordingly indicates bad faith on the part of the Proprietor.

38 We have already considered the sole instance of the Proprietor’s purported use of the Subject Mark above, and I have noted my doubts whether the use was trade mark use in the sense of indicating trade origin, and whether the use was in relation to the specifications of services.

39 In *Audi AG v Lim Ching Kwang* [2017] SGIPOS 2 (“*Audi AG*”) at [60], the Principal Assistant Registrar expressly noted that the application form for registration requires a declaration by the applicant that “*The trade mark is being used by the applicant or with his consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used*”. If there is no intention to use the trade mark “*in relation to the goods or services stated*”, the declaration is untrue and the application can be said to be made in bad faith, as an untrue declaration of such nature has been made to the Registrar of Trade Marks. In the case of international registrations under the Madrid Protocol (as is the case here), the relevant Form MM2 to apply for protection in designated contracting parties, at footnote 16b, similarly cautions applicants that “*By designating ... Singapore ..., the applicant declares that the applicant has the intention that the mark will be used by the applicant or with the applicant’s*

consent in that country in connection with the goods and services identified in this application.”

40 In further support of its primary contention that the Proprietor did not intend to use the Subject Mark across the entire scope of the specifications, the Applicant submits that the services claimed by the Proprietor in Classes 35, 38 and 42 are of an extremely broad range where various specified items are wholly unrelated to one another, so much so that the Proprietor likely never intended to put the Subject Mark to genuine use in respect of those services.

41 The Applicant cites examples from the Proprietor’s specifications in Classes 35 and 42. For instance, the Class 35 specification includes:

... auctioneering; arranging newspaper subscriptions; rental of vending machines; retail services or wholesale services for liquor; retail services or wholesale services for meat; retail services or wholesale services for sea food; retail services or wholesale services for vegetables and fruits; retail services or wholesale services for clothing; retail services or wholesale services for automobiles; retail services or wholesale services for ritual equipment; retail services or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; retail services or wholesale services for cosmetics, toiletries, dentifrices, soaps and detergents; retail services or wholesale services for clocks, watches, and spectacles; retail services or wholesale services for pet animals.

42 In Class 42, the specification includes:

Providing meteorological information; architectural design; surveying; geological surveys or research; testing, inspection or research of pharmaceuticals, cosmetics or foodstuffs; research on building construction or city planning; testing or research on prevention of pollution; testing or research on electricity; testing or research on civil engineering; testing, inspection or research on agriculture, livestock breeding or fisheries; rental of laboratory apparatus and instruments.

43 The Applicant submits that many of the claimed services are completely unrelated to each other and to the Proprietor’s business. At all material times,

the Proprietor provided only cryptocurrency exchange-related services. This is supported by the Applicant's ASSD at Exhibit 19. Extracts from the Proprietor's website every year between 2018 and 2022 set out the scope of the Proprietor's services, namely cryptocurrency-related services. Articles featuring interviews with the Proprietor's key personnel also show that it had never indicated an intention to expand its range of services beyond cryptocurrency-related services and that its focus was firmly on cryptocurrency-related services.

44 It is interesting to observe the connection between an invalidation on the ground of bad faith for a lack of bona fide intention to use a registered mark; and a revocation of the registered mark on the ground of non-use for a continuous period of 5 years. These are different grounds of challenge to registered marks, but they overlap on the issue of lack of use. In the former, it is the lack of intent to use that is in view (as may be evidenced by a lack of use); in the latter, it is the fact of lack of use (or proper reasons for non-use) that is disputed.

45 At the point of examination, shortly after a trade mark application is filed, the Registrar is generally slow to refuse the application on the basis that the applicant does not intend to use the application mark across all the goods and services claimed (although such objections would be made in exceptional cases). After all, an application can be filed on the basis of intended use; and the safeguard against clogging up the register is the registration's vulnerability to revocation for non-use if the registered mark is not used on the specification(s) for a continuous period of 5 years after the completion of registration.

46 At the same time, and not inconsistently, the High Court in *Weir Warman* emphasizes at [42] that:

„, it is also important that these registered marks be *in actual use* or be *bona fide intended to be used* by the registered proprietors; any contrary approach would result in unjust monopolies where devious registered proprietors could prevent the use of a mark by others despite not having any intention to use it, *simply* by reason of prior registration.

In this regard, *Weir Warman* sets out three scenarios, at [42], which suggest bad faith:

- (a) The applicant¹ has no *bona fide* intention to use the trade mark at all, but wishes to prevent a competitor from using the, or a similar, mark;
- (b) The applicant has no present or fixed intention to use the mark, but wishes to stockpile the mark for use at some indeterminate time in the future; and
- (c) The applicant becomes aware that someone else plans to use the mark, and files a pre-emptive application with a view to selling it.

47 The Applicant submits that the scenario in (b) above applies in the present case and that we therefore have an instance of bad faith.

48 While the principles in *Weir Warman* are not in dispute, the challenge lies in the process of proof. It is not a straightforward process to arrive at the conclusion that a proprietor had no *bona fide* intention to use its mark at the time it filed the trade mark application. Even if, in revocation proceedings, the registration of a trade mark is revoked for non-use for a continuous period of 5

¹ For avoidance of doubt, “applicant” as used in the three scenarios in *Weir Warman* refers to “applicant for registration”. The “Applicant” as appears in these grounds of decision refers to the “applicant for a declaration of invalidity” whereas the counterparty, the Proprietor, was formerly the “applicant for registration” when its application for protection in Singapore was still pending.

years from the completion of registration, the revocation proceedings do not entail an inquiry into the mental state of the trade mark applicant. Hence, it is not necessarily the case that revocation of a registered trade mark means that, at the time the trade mark application was filed, the proprietor had not intended to use the mark on the goods/services claimed. He could simply have changed his mind due to other reasons, e.g. a change in market conditions such that it was no longer economically attractive to use the mark on the goods/services claimed. While a lack of intent to use a trade mark, at the time a trade mark application is filed, *may* be proven by the lack of use after the mark is registered, the converse does not necessarily follow: a lack of use does not always stem from a lack of intent to use at the time the trade mark application was filed.

49 The Applicant referred me to the opposition case of *USA Pro IP Limited v Montfort Services Sdn. Bhd.* [2018] SGIPOS 4, where the applicant conceded at the hearing for the related revocation proceedings that there was no use of the subject mark in question. The Principal Assistant Registrar noted at [33] that:

The fact that the Applicants conceded that there was no use of the Subject Mark shed light (*sic*) as to the likely intention of the Applicants. This is especially so since the Applicants relied on the same evidence here to buttress their argument that they had every intention to use the Application Mark.

50 At first blush, it may appear that this is authority for the proposition that the lack of use, without more, points to the trade mark owner's state of mind whether or not there was an intention to use. However, the Principal Assistant Registrar makes clear the following at footnote 9:

As indicated in the Related Invalidation, "bad faith" cases may be broadly categorised into two groups: (a) ownership of the trade mark and knowledge of third-party claims; and (b) intention to use the trade mark and width of specification of goods and services and for clarity, the discussion of the Proprietors' intention to use the Subject Mark under this sub-heading is *not in the context of establishing an independent*

basis for bad faith under category (b). Instead, it is only one of the elements in a multifactorial inquiry into the bad faith objection in the current case under category (a).

(emphasis added)

51 In the present case, the Applicant’s contention relates to scenario (b) described in the above footnote, that the Proprietor’s specifications have such an extremely broad range (and many of the claimed services are completely unrelated to each other and the Proprietor’s business) that it likely never intended to put the Subject Mark to genuine use in respect of those services claimed. Importantly, the larger context of this is the Applicant’s submission that the Proprietor had no present or fixed intention to use the mark, but wished to stockpile the mark for use at some indeterminate time in the future.

52 If this invalidation application were filed *after* 5 years from the completion of registration on 18 January 2018, one would have the benefit – only as a starting point (see considerations at [48] above) – of ascertaining whether or not the Subject Mark was used in relation to its specifications of services in that 5-year period. Here, however, the invalidation application was filed *during* that 5-year period, and thus, the Proprietor could still have the remainder of the 5 years to put the Subject Mark to use in respect of the scope of services claimed. Even the Applicant’s ASSD of 6 October 2022, and its Exhibit 19 as described at [43] above is still within the 5-year period from 18 January 2018, a few months short of the end of the 5 years. At the hearing, counsel for the Applicant submitted that to date (beyond the 5-year period), the Proprietor still had not used the Subject Mark on its specifications in a trade mark sense. However, this is “evidence from the Bar” and not sworn evidence; I therefore cannot give weight to this bare assertion.

53 Nonetheless, the Applicant’s sworn evidence bears consideration on its own merit. Exhibit 19 of the ASSD contains extracts from the Proprietor’s website from 2018 to 2022. These set out the nature and scope of the Proprietor’s services, which are cryptocurrency-related services. Interviews with the Proprietor’s key personnel demonstrate that the Proprietor was firmly focused on cryptocurrency-related services and did not evince any intention to expand its range of services beyond cryptocurrency-related services. Although this evidence post-dates the Relevant Date, it is still relevant and useful in shedding light on the Proprietor’s state of mind as on the Relevant Date.

54 A similar scenario was examined in the English High Court case of *Total Limited v YouView TV Limited* [2014] EWHC 1963 (Ch) (“*Total*”). There, Sales J first observed, as a matter of principle, that the application form to register a trade mark required an applicant to declare that “*the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.*” Singapore has the same position, see [39] above. Sales J accepted that “*if a false declaration were knowingly made to this effect in the application form, that would be capable of being regarded as evidence of bad faith...*”

55 On the facts in *Total*, the proprietor was a telecommunications service provider and registered its mark in Class 38 in respect of “*Providing access to computer databases; telecommunications services.*” The item “*telecommunications services*” was broadly claimed as such. The judge stated at [72] that he was satisfied by the “*evidence that Total applied for its trade mark for its own entirely legitimate business purposes*” and explained at [75]:

In her evidence, Ms White accepted that in June 2009 Total had no positive intention to use its trade mark for the purpose of broadcasting TV content, providing access to databases of TV content or similar activities. However, she also made it clear

that Total had not taken any kind of decision to exclude moving into these fields and using its trade mark in relation to them, should opportunity arise. In the context of fields of activity which were in the process of **significant change and convergence** in 2009, this struck me as truthful and credible evidence. In my view, Total adopted a **legitimate and sensible commercial position** in registering its trade mark in the way it did.

(emphasis in bold at [72] and [75] added)

56 The key considerations in *Total* that led to no finding of bad faith revolve around whether the filer had “*legitimate business purposes*” and “*adopted a legitimate and sensible commercial position*”. The judge gave another example in [76], that:

... a luxury clothing manufacturer may legitimately use the specification, “clothing”, even if at the time of application it has no positive intention to use its trade mark in relation to manufacture and sale of sportswear clothing goods. The specification which it asks for is properly related to the area in which it proposes to use the trade mark and allows legitimate commercial flexibility for future adaptation by the manufacturer to the market and competitive environment in the general area covered by the “clothing” specification.

57 In the present case, the Applicant has adduced cogent evidence reflecting the Proprietor’s business interest and focus, which squarely relate to cryptocurrency and no other area, such as the fields of services set out above in [41] and [42] – to give a flavour, these include “*arranging newspaper subscriptions*”, “*rental of vending machines*”, “*providing meteorological information*”, “*architectural design*”, “*testing or research on electricity*”, “*testing, inspection or research on agriculture, livestock breeding or fisheries*”, “*rental of laboratory apparatus and instruments*” and so on. One asks: In February 2016, did the Proprietor, a prominent global cryptocurrency exchange, have a “*legitimate business purpose*” to claim the aforementioned services? Did it have a “*legitimate and sensible commercial position*” in seeking to protect the Subject Mark in respect of such services entirely divorced from the service of

running a cryptocurrency exchange? Was there “*significant change and convergence*” in 2016 (as there was for content broadcasting and telecommunications, as accepted in *Total*) that a cryptocurrency exchange would be naturally expected to also provide meteorological, architectural and agricultural services of the nature exemplified above? I think not.

58 As such, the evidential burden of proof has shifted to the Proprietor to show that it nonetheless had the *bona fide* intention to use the Subject Mark on the services set out at [41] and [42], which are diverse and not related to the Proprietor’s commercial field in cryptocurrency (*Valentino* at [36]). If the Proprietor had a *bona fide* intention to use the Subject Mark in relation to all the claimed services, it would be in a choice position to state and explain this by way of sworn evidence. However, the Proprietor has not done so even though, if it indeed had such *bona fide* intention, it could easily have given its explanation at the minimum, and adduced supporting evidence (such as notes of internal business discussions), if any, in reply to the ASSD. Instead, the Proprietor disqualified itself from taking part in these proceedings by not providing an address for service (after its counsel discharged itself) according to procedural rules. Consequent to this self-induced handicap, the Proprietor had no answer to the Applicant’s evidence which *prima facie* showed that the Proprietor had an exclusive focus on cryptocurrency-related services and did not intend to expand its range of services beyond cryptocurrency-related services to other diverse fields such as meteorology, architecture and agriculture.

59 In this specific context, I find that the Proprietor did not have a *bona fide* intention to use the Subject Mark on the services set out at [41] and [42] at the Relevant Date. The application to protect the Subject Mark was therefore made in bad faith to this extent. I must caveat that this conclusion was reached in a

very unique situation, where, in an *inter partes* contentious setting, one party, the Applicant, adduced cogent evidence to raise serious questions over the *bona fide* intention of the Proprietor, and the other party, the Proprietor, did not avail itself of the right to adduce evidence to support its best case. Had it done so, and had it participated in the hearing to make its submissions on how it did have a *bona fide* intention, the outcome here might have been different.

60 My finding on the facts of this case should not affect the common practice of trade mark applicants claiming a penumbra of goods and services beyond what they already offer, and which is part of a “*legitimate business purpose*” and defensible as a “*legitimate and sensible commercial position*” to take.

Conclusion on Section 7(6)

61 I have found bad faith on the part of the Proprietor on both heads advanced by the Applicant.

62 First, the Proprietor has knowingly sought the protection of the Subject Mark despite it being the name of its direct competitor, without the Applicant’s consent or authority. Such conduct would be considered commercially unacceptable by reasonable and experienced persons in the financial market. This taints the protection of the Subject Mark across the entire scope of its specifications.

63 Second, the Proprietor did not intend to use the Subject Mark in respect of the services listed at [41] and [42] despite its declaration to the Registrar of Trade Marks. For avoidance of doubt, this finding is not premised on an objection in itself that the specification is too wide without more but that the Proprietor had no *bona fide* intent to use the Subject Mark on specific items in

its protected scope of services, having regard to the nature of the Proprietor's business. The Proprietor had the opportunity to readily give an explanation for claiming the diverse services in [41] and [42], but did not avail itself of it even though the evidential burden had shifted to the Proprietor. The finding of bad faith under this head results in a partial invalidation of the Subject Mark's protection, in that it should not enjoy protection in respect of the services in [41] and [42]. However, the remaining items of services in the specifications are untainted as they are related to the Proprietor's cryptocurrency business.

64 Taking into account the above, the net effect is that the ground of invalidation under Section 7(6) is made out in respect of the entire scope of the protection (applying the broader outcome from the first head of bad faith successfully advanced).

Ground of invalidation under Section 23(3)(a)(i) read with Section 8(2)(a) and (b)

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

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;

66 Section 8(2)(a) and (b) of the Act reads:

A trade mark must not be registered if, because —

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

(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.

Application of Section 8(2)(a) to the facts

Whether the marks are identical

67 Section 8(2)(a), instead of Section 8(2)(b), applies if the competing marks are identical. This therefore becomes the first issue for consideration.

68 The Subject Mark is “coinbase” in lower case; the Applicant’s Mark is “COINBASE” in upper case.

69 There is some judicial guidance on this point. The High Court in *Intuition Publishing Ltd v Intuition Consulting Pte Ltd* [2012] SGHC 149 (“*Intuition*”) found at [24] as follows:

As regards the plaintiff’s word Marks, Signs A and B are identical to the plaintiff’s word Marks. This is because a mark registered in upper case in plain font covers all stylistic permutations of the mark.

In the above case, both the plaintiff’s “word Marks” comprise the word “INTUITION” in upper case, Sign A comprises the word “intuition” in lower case, and Sign B comprises the word “INTUITION” in upper case. In effect, the High Court had found that “INTUITION” and “intuition” were identical.

70 I also have regard to the Intellectual Property Office of Singapore’s Trade Marks Work Manual (version 9.1 of November 2022). Chapter 7 on “Relative Grounds for Refusal of Registration” gives examples of the approach taken by the Registrar of Trade Marks when assessing whether marks are identical, at paragraph 5.2.3.

The following cases illustrate the approach that will be taken:

Subject mark	Earlier mark	Elaboration
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“intuition”	“INTUITION”	<p>The same words in plain font are considered identical despite the difference in letter case.</p> <p><i>Intuition Publishing Ltd v Intuition Consulting Pte Ltd</i> [2012] SGHC 149 at [24], citing the decision of <i>Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd</i> [2011] SGHC 176 (“<i>Sarika (HC)</i>”) at [58].</p>
“INTUITION CONSULTING”	“INTUITION”	<p>Not identical.</p> <p>The subject mark has the additional word “CONSULTING”.</p> <p><i>Intuition Publishing Ltd v Intuition Consulting Pte Ltd</i> [2012] SGHC 149 at [25].</p>
“Origin”	“Origins”	<p>Not identical.</p> <p>The subject mark “Origin” is not identical to the earlier mark “Origins” because of the omission of the letter “s”.</p> <p><i>Origins Natural Resources Inc v Origin Clothing Ltd</i> [1995] FSR 280; cited as an example in <i>Polo (CA)</i> at [21].</p>

71 The above practice is also partly derived from the judicial guidance in *Intuition*, among other cases.

72 Accordingly, I find that “coinbase” and “COINBASE”, respectively the Subject Mark and the Applicant’s Mark, are identical. Following from this, I continue the line of inquiry under Section 8(2)(a) instead of under Section 8(2)(b).

Whether the Proprietor’s services and the Applicant’s goods and services are similar

73 Having found the marks identical, the second step of the three-step test in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc. and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) entails a comparison of the relevant goods and services to determine whether they are similar.

74 The Applicant provided the following table in its written submissions to aid in a comparison of the respective goods and services. The services listed in the left column are selected from the Proprietor’s specifications of services, which the Applicant submit are similar to the Applicant’s goods or services (services in respect of which the Subject Mark is registered which are *not* listed in the left column are those which are *not* similar, in the Applicant’s view). Out of these services listed in the left column, the Applicant further distinguishes between services which are highly similar (underlined) and services which are similar but not to as high a degree (not underlined).

Subject Mark’s services in Class 35	Applicant’s Mark’s similar goods or services (in Classes 9, 36 or 42)
business management analysis or business consultancy; preparation of financial	Class 9: Downloadable computer software for use in electronically trading, storing,

<p>statements; <u>compilation of information into computer databases</u>; providing business assistance to others in the operation of data processing apparatus namely, computers, typewriters, telex machines and other similar office machines; marketing research or analysis; providing information concerning commercial sales (which includes information provision via the Internet); <u>intermediary services on sale and purchase contracts for goods in electronic commerce transactions</u>; <u>business operation and management concerning electronic commerce transactions</u>; <u>systematization of information into computer databases</u>.</p>	<p>sending, receiving, accepting, and transmitting digital currency, and managing digital currency payment and exchange transactions.</p> <p>Class 36: Currency exchange services; cash management, namely, facilitating transfers of electronic cash equivalents.</p> <p>Class 42: Providing temporary use of online non-downloadable software for use in electronically trading, storing, sending, receiving, accepting and transmitting digital currency, and managing digital currency payment and exchange transactions.</p>
<p>Subject Mark's services in Class 38</p>	<p>Applicant's Mark's similar goods or services (in Classes 9, 36 or 42)</p>
<p>telecommunication [other than broadcasting]; <u>telecommunication for electronic commerce transactions via telecommunications systems or data communication systems</u>; <u>giving time to access computer databases where users can search and obtain information concerning electronic commerce transactions</u>.</p>	<p>Class 9: Downloadable computer software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, and managing digital currency payment and exchange transactions.</p> <p>Class 36: Currency exchange services; on-line real-time currency trading.</p> <p>Class 42: Providing temporary use of online non-downloadable software for use in electronically trading, storing, sending, receiving,</p>

	accepting and transmitting digital currency, and managing digital currency payment and exchange transactions.
Subject Mark's services in Class 42	Applicant's Mark's similar goods or services (in Classes 9, 36 or 42)
<u>technological advice relating to computers, automobiles and industrial machines; designing, programming, or doing maintenance of computer programs for use in electronic commerce transactions; providing search engines for electronic commerce transactions; designing, programming, or doing maintenance of computer programs (software) for authenticating users in electronic commerce transactions; designing, programming, or doing maintenance of Internet websites for electronic commerce transactions.</u>	<p>Class 9: Downloadable computer software for use in electronically trading, storing, sending, receiving, accepting, and transmitting digital currency, and managing digital currency payment and exchange transactions.</p> <p>Class 36: Currency exchange services; on-line real-time currency trading; digital currency exchange transaction services for transferrable electronic cash equivalent units having a specified cash value.</p> <p>Class 42: Providing temporary use of online non-downloadable software for use in electronically trading, storing, sending, receiving, accepting and transmitting digital currency, and managing digital currency payment and exchange transactions.</p>

75 The relevant factors to aid in a determination of goods/services-similarity are set out in the English case of *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) at pp 296-297:

- (a) the respective uses of the respective goods or services;
- (b) the respective end users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the respective trade channels through which the goods or services 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 or services are competitive or complementary. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies who act for the industry put the goods or services in the same or different sectors.

76 As I have earlier found bad faith in respect of the *entire scope* of the Subject Mark’s protection, there is no need to delve into the *minutiae* of assessing whether each of the Proprietor’s services listed in the table above is indeed similar to the Applicant’s goods or services. Some specification items are clearly similar to the Applicant’s goods and services based on the factors in *British Sugar*. For example, the Proprietor’s Class 42 service of “*designing, programming, or doing maintenance of computer programs (software) for authenticating users in electronic commerce transactions*” is similar to the Applicant’s Class 9 goods of “*Downloadable computer software for use in electronically ... transmitting digital currency*” and Class 42 service of “*providing temporary use of online non-downloadable software for use in*

electronically ... transmitting digital currency". This is because these goods and services are used to facilitate electronic transactions, by likely the same group of end users; and their nature is closely connected to software for this purpose. Such goods and services are also possibly offered through the same trade channels.

77 I am satisfied that there is some degree of goods/services-similarity between the *underlined* specification items belonging to the Proprietor and the Applicant's goods and services, as tabulated in [74] above.

78 At this juncture, I am mindful of Section 23(9) of the Act:

Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark must be declared invalid as regards those goods or services only.

79 If the third element of likelihood of confusion under Section 8(2)(a) is also satisfied, and the Applicant succeeds in making out its case under this provision, the outcome would be a partial invalidation in respect only of those services of the Proprietor's which are similar to the Applicant's goods and services. The Applicant acknowledged as such during the hearing, unless their ground of invalidation under Section 7(6) (under the first head of argument for bad faith) also succeeds.

Whether there is a likelihood of confusion

80 I then consider whether there is a likelihood of confusion because of the identical marks and similar goods and services of the parties. In this regard, I am to have regard to (a) factors relating to the impact of marks-similarity (or, in this case, marks-identity) on consumer perception; and (b) factors relating to the impact of goods/services-similarity on consumer perception: *Staywell* at [96].

81 In the present case, the parties' respective marks are identical and thus, this factor is highly weighted towards a likelihood of confusion, as compared to where the marks are only similar, not identical.

82 As regards the parties' similar goods and services, the Applicant submits that these are generally software and services relating to electronic commerce. The relevant public who consumes these goods and services is the general public, as electronic commerce has become the norm amongst ordinary consumers in the modern age. Such a member of the general public does not need to possess specialist knowledge and is less fastidious during purchase. The goods and services are also relatively inexpensive. The Applicant refers to *Xiaomi Inc. v Michat Pte Ltd* [2021] SGIPOS 2 where the Principal Assistant Registrar opined, at [86] and [87]:

86 ... I would add that even if a mobile application is chargeable, the typical price range for the same is at the low end such that the downloading (and purchasing process, where appropriate) is *not* likely to entail much care and attention.

87 Further, the relevant consumers in this instance would be the general public and clearly no specialist knowledge is required for downloading (and purchasing) a mobile application.

83 The Applicant also refers to *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165 ("*Digi*"), where the competing goods and services involved computer software, hardware, and IT-related goods and services in Classes 9, 38 and 42. In this regard, the Court noted at [186] that:

[n]otionally, the appellant's goods and services and the respondent's goods may involve high-end and complex technology on one end of the spectrum, and low-end and simple technology on the other. Put another way, the parties may provide both expensive and inexpensive goods and services.

84 On the above, the Applicant submits that even if the member of the relevant public is a sophisticated consumer of high-end and complex technology-related goods and services, the likelihood of confusion is still high due to the identity of the marks and the similarity of the goods and services. This is consistent with the observation of the High Court in *Digi* at [187] that “a higher degree of similarity between contesting marks might have to be shown to warrant a finding of likely confusion” for such products.

85 I think the proper characterisation of the relevant public is that there is a range of consumers owing to the wide range of similar goods and services, which can be inexpensive, readily accessible products, or more highly technical, specialised ones (and the two are not even mutually exclusive). The relevant public could be used to selecting electronic commerce-related goods and services without too high a degree of care and attention, or it may go through a more involved process of research and comparison, perhaps even with the help and advice of sales staff, before making a selection. The upshot, though, is that the competing marks are identical (which is even higher than the threshold envisaged by the High Court in *Digi* at [187]). Thus, I am led to conclude that there is a reasonable likelihood of confusion in the relevant public, arising from the identity of marks and similarity of goods and services.

Conclusion on Section 8(2)(a) and (b)

86 At the outset, I have found that the competing marks are identical. As such Section 8(2)(a) rather than Section 8(2)(b) applies. I have also found similarity between some of the Proprietor’s services and the Applicant’s goods and services. Finally, I have found a likelihood of confusion arising from the identity of marks and similarity of goods and services.

87 The Applicant succeeds in its ground of invalidation under Section 8(2)(a) in respect only of those of the Proprietor's services found similar to the Applicant's goods and services (the underlined items in [74]), and not in respect of the remaining services.

Overall conclusion

88 The Applicant has succeeded in its different grounds of invalidation to varying degrees. The outcome with the broadest impact applies. Specifically, further to my finding that there has been bad faith on the part of the Proprietor under Section 7(6) (in that the Proprietor has knowingly sought the protection of the Subject Mark despite it being the name of its direct competitor, without the Applicant's consent or authority, and that such conduct would be considered commercially unacceptable by reasonable and experienced persons in the financial market), the entire scope of the application to protect the Subject Mark in Singapore has been tainted.

89 I therefore grant the application for a declaration of invalidity. The protection of International Registration No. 1308248 (TM No. 40201614827X) in Singapore is declared invalid as a whole. The Subject Mark is deemed never to have been a protected international trade mark (Singapore), but this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

90 Having considered the Applicant's helpful submissions on costs, I award costs of \$9807.00 (inclusive of disbursements of \$2885.00) to the Applicant.

See Tho Sok Yee
Principal Assistant Registrar

Melvin Pang and Zachery Tan (Amica Law LLC) for the Applicant.
