

# IPOS Decisions 2022: Year-in-Review


## Selected Issues, Holdings and Comments of Interest

Please note:



- (1) Full Grounds of Decision and case summaries (where available) are accessible at: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>
- (2) We have a mailing list where we provide regular updates on recent developments in the field of IP/Tech dispute resolution in Singapore. To join, please contact [ipos\\_hmd@ipos.gov.sg](mailto:ipos_hmd@ipos.gov.sg).

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## IPOS CASES IN 2022

Case Reference	Selected Issues, Holdings and Comments of Interest
<p><i>Daimler AG v Vivo Mobile Communication Co., Ltd.</i> [2022] SGIPOS 1</p>	<p>This trade mark opposition was commenced by Daimler AG against “VIVO”, which Vivo Mobile Communication Co Ltd sought to register in Class 12 by in respect of “<i>Electric vehicles; Cars; Motorcycles; Driverless cars [autonomous cars]; Bicycles; Mobility scooters; Trolleys; Tires for vehicle wheels; Remote control vehicles, other than toys; Water vehicles; Air vehicles; Upholstery for vehicles</i>”. Daimler AG relied on its earlier “VITO” mark in Class 12, registered for “<i>Motor vehicles; parts and fittings therefor</i>”. In dismissing the opposition, the hearing officer found, among other things, that: (a) the competing marks are more similar than dissimilar; (b) the goods overlap; but (c) there would be no likelihood of confusion in relation to motor vehicles and parts and fittings because of the high price point of vehicles and parts in Singapore and the manner in which the goods would be sold.</p>
<p><i>Choi Sun Mi v Comfort Lab Inc.</i> [2022] SGIPOS 2</p>	<p>This was a trade mark non-use revocation action against the mark “COMFORTLAB”, registered in Class 25 for “Coats; sweaters; shirts; underwear (underclothing); nightwear; socks and stockings; T-shirts; headgear for wear; shoes and boots; all included in Class 25”. The proprietor only adduced evidence of use of the mark on insoles, and attempted to conflate this with the use of the mark in relation to “shoes”. The hearing officer did not accept this, and since there was no evidence of use of the mark in relation to any of the goods claimed, made an order for revocation.</p>
<p><i>Hotel Cipriani S.P.A. v Altunis - Trading, Gestão E Serviços, Sociedade Unipessoal, LDA</i> [2022] SGIPOS 3</p>	<div style="text-align: right; margin-bottom: 10px;">  </div> <p>This was a successful opposition by Hotel Cipriani against Altunis Trading’s application to register the mark. Although the opponent did not have any prior trade mark registrations in Singapore, it was able to establish a case of passing off since it had, among other things, existing customers (and hence goodwill) in Singapore who had travelled to Venice, Italy to stay at the high-end Belmond Hotel Cipriani.</p> <p>Although the parties were known to each other and had been embroiled in long-running multi-jurisdictional disputes relating to the “CIPRIANI” mark, the opponent was unable to sufficiently prove that the application had been made in bad faith. Notably, the opponent attempted to run the interesting and unusual — but ultimately unsuccessful — argument of transnational issue estoppel premised on foreign decisions in its favour: see [59]-[69].</p>

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<p><i>Twitter, Inc. v V V Technology Pte Ltd</i> [2022] SGIPOS 4 (upheld on appeal by the General Division of the High Court: see [2022] SGHC 293)</p>	<p>Twitter succeeded in its opposition to a trade mark application for a bird device  in Class 42. It relied on its prior registration for its bird device  (registered in a number of classes including 42) as well as its prior unregistered marks that were essentially earlier versions of its twitter bird logo. The dispute raised interesting and complex issues regarding the assessment of similarity between two device marks (in this case: two “bird” devices), including the relevance (or otherwise) of aural and conceptual similarity. The decision also considered the effect of the reputation of the opponent’s mark on the likelihood of confusion.</p> <p>Note: the decision of the General Division of the High Court directly addresses the role of distinctiveness in the marks-similarity inquiry. For convenience, paragraph 119 of the decision which summarises JC Goh Yihan’s key conclusions is reproduced below.</p> <p>“This has been a long section. I therefore summarise my conclusions in relation to the concept of “distinctiveness” in the marks-similarity inquiry.</p> <p>(a) First, I would suggest the consistent use of the following expressions when discussing the concept of distinctiveness at the marks-similarity inquiry: (a) inherent technical distinctiveness; (b) acquired technical distinctiveness; and (c) non-technical distinctiveness. The consistent use of these expressions would aid in the formulation of coherent arguments before decision-makers, as well as enhance the comprehensibility of our intellectual property law jurisprudence.</p> <p>(b) Second, I would suggest a faithful return to Staywell and not consider “distinctiveness” as a “threshold” enquiry (even for reasons of convenience or ease of analysis), as this is in reality a separate step to the analysis that is not permitted by Staywell. Treating distinctiveness as integrated within the step-by-step approach would ensure that it is properly applied in the right context.</p> <p>(c) Third, I hold that acquired technical distinctiveness should not be considered at the marks-similarity inquiry based on reasons of precedent, principle, and policy. The issue of acquired technical distinctiveness should be considered at the likelihood of confusion stage of the inquiry to preserve conceptual clarity.”</p>



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<p><i>BEABA v Biba (Zhejiang) Nursing Products Co., Ltd</i> [2022] SGIPOS 5</p>	<p>This dispute involved two consolidated trade mark opposition actions commenced by a French company against a Chinese company's application to register  in Classes 5 (for baby food, babies' diaper-pants, and other goods) and 16 (for paper, stationery, and related products). The opponent, which sells baby food making products and other childhood care-related products, relied on its earlier registration for "BEABA" which is registered in Classes 7, 9, 10, 11, 20 and 21 (but not 5 and 16). The hearing officer found that the competing marks had a very high degree of similarity and that the circumstances justified a finding that the applications had been made in bad faith. Accordingly, she allowed the oppositions against both applications.</p> <p>Although the finding on bad faith was sufficient to dispose of the matter, the hearing officer also addressed the various other grounds of opposition raised. She also allowed the opposition against the Class 5 application on grounds of 'confusing similarity' under s 8(2)(b) despite the fact that the opponent did not have a registration in that class. Here, the pertinent finding was that "babies' diaper-pants" in Class 5 are similar to "potties for babies" in the opponent's Class 21 registration. However, the opponent was not able to establish similarity of goods vis-à-vis the Class 16 application and so the ground of opposition could not succeed there.</p> <p>The decision also deals with the passing off ground of opposition (result: opposition succeeded against the Class 5 application but not against the Class 16 application) and copyright under s 8(7)(b) (result: succeeded against the Class 16 application and was not raised against the Class 5 application).</p>
<p><i>Sociedad Anonima Damm v Hijos de Rivera, S.A.</i> [2022] SGIPOS 6</p>	<p>The applicant and the opponent are both beer manufacturers from Spain. The applicant is known for its beer "ESTRELLA GALICIA" whereas the opponent is known for "ESTRELLA DAMM". The parties have co-existed for many years in Spain and countries in Europe and in the UK. However, as the parties expanded outside of the jurisdictions where they co-existed, they opposed the registration of each other's mark. In this case, the opponent opposed the application for the stylised "" ESTRELLA GALICIA mark based on, among other things, its "ESTRELLA DAMM" mark (registered for beers in Class 32). The IP Adjudicator found, among other things, that the competing marks are dissimilar. The opposition failed on all grounds.</p>



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<p><i>Consorzio del Formaggio Parmigiano Reggiano v Fonterra Brands (Singapore) Pte. Ltd.</i> [2022] SGIPOS 7</p>	<p>Under the Geographical Indications Act 2014, protection for a geographical indication (“GI”) may extend to translations of a GI. However, there is no need to specify translations at the point of an application for GI registration. Any issues pertaining to the protection of translations of a GI can be dealt with via the request for qualification procedure. This case concerned Fonterra’s request to qualify “Parmigiano Reggiano” by carving out the term “Parmesan” from the scope of GI protection. The Consorzio opposed the request for qualification. The hearing officer found, on the evidence, that “Parmesan” is indeed a translation of “Parmigiano Reggiano” and allowed the opposition to the request for qualification.</p> <p>Note: please also see [2022] SGIPOS 11 below, which is the full form of this shorter Registrar’s Decision</p>
<p><i>In the matter of a Trade Mark Application by Arangur UG (haftungsbeschränkt)</i> [2022] SGIPOS 8</p>	<p>The applicant sought to register the slogan “PARTY LIKE GATSY” as a trade mark for a variety of entertainment and catering-related services in Classes 41 and 43. However, it did not adduce any evidence of use in Singapore. The examiner refused to accept the sign on the basis that it is inherently non-distinctive and hence objectionable under s 7(1)(b) of the Trade Marks Act. The applicant then applied for a hearing. At the hearing, it argued that the slogan was inherently distinctive. The IP Adjudicator disagreed, and maintained the examiner’s objection. The average man or woman on the MRT would not be sufficiently acquainted with the storyline of “The Great Gatsby” to appreciate the contrast between the fun and enjoyment of a party and the character Jay Gatsby’s loneliness so as to perceive the sign to be imaginative, surprising or unexpected.</p>
<p><i>In the matter of a Trade Mark Application by Floor Xpert Pte. Ltd.</i> [2022] SGIPOS 9</p>	<p>This was an application to register “FLOOR XPERT” in Class 37 for various flooring related services. The examiner objected to the application on the basis that the mark is non-distinctive and under ss 7(1)(b) and (c) of the Trade Marks Act. In response, the applicant filed evidence of use, but the examiner took the view that the evidence was deficient in that it showed use of different versions of the sign and in relation to goods or services that were outside the scope of the specifications applied for. The applicant then applied for a hearing. The hearing officer disagreed with the examiner and found that the evidence of use was sufficient to prove that the sign had acquired distinctiveness through use and allowed the mark to be accepted. In so doing, the hearing officer made various observations relating to trade mark examination procedure.</p> <p>Note: On 1 October 2021, rule 24(5A) of the Trade Marks Rules came into effect. It provides that the Registrar can, of the Registrar’s own accord, send the grounds of decision to the applicant. If this rule is invoked by the Registrar, the public will have access to the grounds of decision without the need for the applicant to file a request for it. This decision was issued under this rule.</p>



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<p><i>Pauline New Ping Ping v Eng's Char Siew Wantan Mee Pte. Ltd.</i> [2022] SGIPOS 10 (note: appeal to the General Division of the High Court pending)</p>	<p>There are various disputes surrounding the successful “wanton mee” hawker stall in Singapore known as “Eng’s”. The present one concerns a trade mark opposition against three trade marks:  , applied for by Eng’s Char Siew Wantan Mee Pte. Ltd. The founder of the Eng’s wanton mee business operated a hawker stall at Dunman Food Centre. In 2012, the founder and his son were approached by a businessman who proposed a collaboration. Eventually, this culminated in the incorporation of a new company, Eng’s Noodle House (“ENH”). The founder’s son, as well as the opponent (who is the businessman’s wife), were shareholders and directors of the new company. In 2013, the founder passed away. In 2017, the relationship between the businessman and the founder’s son started to deteriorate. Seeing this, the latter’s sister registered a sole proprietorship under the name of “Eng’s Char Siew” with a view to carrying on the family business. In 2018, ENH ceased business operations. Various events took place thereafter, but in brief there resulted two competing businesses selling wanton mee under the “Eng’s” name.</p> <p>The opponent’s case in the opposition was that the three application marks should not be registered on two grounds: (1) passing off; and (2) bad faith. The IP Adjudicator found that both grounds were not established and dismissed the opposition. Interestingly, the opponent’s arguments on the passing off ground were premised on the alleged impingement of ENH’s earlier rights. However, since ENH had ceased business in 2018, the IP Adjudicator found that there was no goodwill attached to the company for it to be capable of sustaining an opposition on the passing off ground.</p>
<p><i>Consorzio del Formaggio Parmigiano Reggiano v Fonterra Brands (Singapore) Pte. Ltd.</i> [2022] SGIPOS 11 (note: appeal to the General Division of the High Court pending)</p>	<p>Please see Registrar’s Decision in [2022] SGIPOS 7 to allow the Consorzio’s opposition to Fonterra’s request to qualify protection for “Parmigiano Reggiano” by carving out the term “Parmesan” from the scope of geographical indication protection. Central to the outcome was the hearing officer’s finding, on the evidence, that “Parmesan” is a translation of “Parmigiano Reggiano”. Both parties wrote in to request for the full grounds of decision (which in essence is a longer version of the Registrar’s Decision), which have now been issued and published as [2022] SGIPOS 11.</p> <p>Note: pending appeal on 6 February 2023 (HC/TA 8/2022).</p>
<p><i>The a2 Milk Company Limited v Société des Produits Nestlé S.A</i> [2022] SGIPOS 12</p>	<p>a2 Milk Company was unsuccessful in its opposition to Nestle’s application to register  (note: the mark reads S-26 followed by Pro-Atwo below) in Classes 5 and 29 for infant formula and milk products respectively. The primary earlier trade mark relied on by a2 Milk Company was “A2”, also registered in Classes 5 and 29.</p>

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<p><i>Swatch AG (Swatch SA) (Swatch Ltd.) v Apple Inc.</i> [2022] SGIPOS 13</p>	<p>Apple overcame an opposition to successfully register the mark “THINK DIFFERENT” in Class 9 for, among other things, smartwatches. This application was opposed by Swatch (registered proprietor of the “Tick different” trade mark in Singapore) on grounds that the application was made in bad faith. Swatch made various arguments in this vein, including that: (a) Apple had no intention to use the mark in Singapore; and (b) Apple intended to use the mark as a tool to stop others from applying for, registering or using any two-word expression with “different” as the second word. However, the hearing officer was not persuaded that the grounds were made out. In relation to the latter allegation, there is nothing inherently wrong with asserting one’s registered trade mark against a later mark through opposition – opposition is a mechanism provided in law for an opponent to object to the registration of a mark based on particular grounds in the law and there would be a judicial or quasi-judicial determination on the merits of the case. There were no grounds to conclude that the opposition process would be misused by Apple, on the evidence.</p>
<p><i>GCIH Trademarks Limited v Hardwood Private Limited</i> [2022] SGIPOS 14</p>	<p>This was the second of two related opposition actions filed by GCIH Trademarks (the opponent) against (the applicant) Hardwood’s trade mark applications. The opponent is the proprietor of the trade mark “TANGO” in Class 30 (registered for chocolate and cocoa products). In the first dispute, the opponent successfully opposed the registration of “OT TANGO”, which was applied for in Class 30 in respect of chocolate and cocoa products. In this case, the application</p> <div style="text-align: center;">  </div> <p>mark was . However, the opposition was unsuccessful. In dismissing the opposition, the hearing officer found the application mark to be visually “more dissimilar than similar”, aurally “more similar than dissimilar”, and conceptually “dissimilar to a material degree”. Overall, the marks were considered to be dissimilar on balance. Consequently, the grounds of opposition tied to similarity of marks could not be established.</p> <p>On bad faith, the opponent had argued that there was no <i>bona fide</i> intention by the Applicant to use the mark as applied for given that in actual commerce the products are packaged and sold in a way which emphasises the “TANGO Element” over the “OT Element”. Notwithstanding this, the hearing officer was also of the view that there was insufficient evidence to establish bad faith: see discussion at [42] – [55].</p>
<p><i>Tata Sons Private Limited v Tata’s Natural Alchemy, LLC</i> [2022] SGIPOS 15</p>	<p>Tata Sons, part of the international TATA Group headquartered in India, was unsuccessful in its attempt to oppose</p> <div style="text-align: center;">  </div> <p>an application to register the following TATA HARPER (and device) mark: “ TATA HARPER ”, which was applied for</p>

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	in Class 3 in respect of cosmetics and related products. The “TATA” word mark and the opposed mark were found visually, aurally and conceptually dissimilar.
<i>Skins IP Limited v Symphony Holdings Limited</i> [2022] SGIPOS 16 (note: appeal to the General Division of the High Court pending)	Skins IP Limited applied to revoke the trade mark registration of “S SKINS” in the name of Symphony Holdings Limited in Classes 10, 18, 25 and 28. The registered proprietor could show some use of its mark, including on-line use where active steps were taken to target consumers in Singapore. However, there was no evidence of use on certain items in the specifications and as such, the application for revocation was partially successful.
<i>The a2 Milk Company Limited v Société des Produits Nestlé S.A.</i> [2022] SGIPOS 17	<p>Although this case bears the same name as [2022] SGIPOS 12, it concerns a different trade mark application. Here, a2 Milk Company sought to oppose Nestle’s applications to register  (which reads “Atwo Illumina”) and  (which reads “Atwo Illumcare”) in classes 5 and 29 for infant formula and milk products respectively. Just like in the earlier case, a2 Milk Company relied on its earlier registration for “A2” in Classes 5 and 29. Its central case was that the marks conflicted because “Atwo” would be perceived by consumers as “A2”. However, the hearing officer did not agree, and found that the marks were overall more dissimilar than similar. Accordingly, the opposition was unsuccessful.</p>
<i>Aramara Beauty LLC (dba Glow Recipe) v Sinchen Group Pte. Ltd.</i> [2022] SGIPOS 18	Aramara Beauty LLC (dba Glow Recipe) applied for a declaration of invalidity against the registration of the “GLOW RECIPE” trade mark in the name of Sinchen Group Pte. Ltd. By procedural default, the registered proprietor was deemed to admit to the facts alleged in the application for a declaration of invalidity; the requisite elements of s 8(2)(a) of the Trade Marks Act were established; and the registration was declared invalid.
<i>Fair Isaac Corporation v LAC Co., Ltd.</i> [2022] SGIPOS 19	Fair Isaac Corporation, which is the proprietor of the “FALCON” mark, failed in its attempt to oppose an application to register “CloudFalcon” as a trade mark. Among other things, the hearing officer was of the view that: (1) When a later trade mark (“CloudFalcon”) wholly incorporates an earlier trade mark (“FALCON”), the inherent technical distinctiveness (or otherwise) of the earlier mark is critical in determining whether the later mark is similar to the earlier mark (see [34]-[43]; for detailed discussion, see [22]-[43]); and (2) The state of the register can be considered when assessing whether a particular mark or word is distinctive (see [67]-[72]; for detailed discussion, see [55]-[74]).

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