

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

Trade Mark No. 40201721937Q
Hearing Date: 29 October 2020
Further Submissions: 19 November 2020

**IN THE MATTER OF A TRADE MARK APPLICATION BY
ELEMENTS COSMECEUTICALS PTE. LTD.**

AND

OPPOSITION THERETO BY

B.R.

Hearing Officer: Ong Sheng Li, Gabriel
Principal Assistant Registrar of Trade Marks

Representation:

Mr Wilson Foo (Trident Law Corporation) for the Applicant

Ms Teresa O'Connor and Ms Millicent Lui (Infinitus Law Corporation) for the Opponent

GROUND OF DECISION

Background

1 On 7 November 2017 (the “Relevant Date”), Elements Cosmeceuticals Pte Ltd (the “Applicant”), a company incorporated in Singapore, applied to register Trade Mark No. 40201721937Q (the “Application Mark”) in Classes 3 and 44 for the following:

Class 03

Anti-aging skincare preparations; Skincare cosmetics; Skincare preparations for cosmetic purposes; Cosmetic products in the form of aerosols for skincare; Beauty masks; Beauty gels; Beauty milk; Beauty soap; Beauty creams; Beauty serums; Beauty lotions; Beauty face packs; Beauty balm creams; Facial beauty masks; Beauty care cosmetics; Facial oils; Facial cream; Facial masks; Facial packs; Facial soaps; Facial lotion; Facial scrubs; Facial toners; Facial washes; Facial lotions; Facial cleansers;

Facial emulsions; Facial beauty masks; Facial moisturisers; Facial preparations; Cosmetic facial masks.

Class 44

Beauty salons; Beauty services; Beauty counselling; Beauty treatment; Beauty care of feet; Beauty salon services.

A representation of the Application Mark is set out below. It comprises the word “Recherché” in a colour which appears to my eye to be a shade of grey.

Recherché

2 The Application Mark was opposed by B.R. (the “Opponent”). The Opponent is a French company in the skincare business. It was founded in Paris. Pertinently, the Opponent owns an earlier trade mark in Singapore: Trade Mark No. T1200582A (“Opponent’s Mark”), registered in Class 3 for the following goods.

Class 03

Soap, perfumery goods, essential oils, cosmetics, cosmetic creams for facial and body skin care, hair lotions, shampoos, dentifrices, incense, deodorants for personal use (perfumery); cosmetic preparations for slimming purposes; cosmetic preparations for toning purposes; make-up removing preparations; beauty masks, except wipes; shaving preparations, after-shave lotions, tissues impregnated with cosmetic lotions, nail care preparations.

A representation of the Opponent’s Mark is set out below. It comprises the words “BIOLOGIQUE RECHERCHE” in dark blue block letters set against an illustration of flowers and plants in the background. The illustration, which I shall call the botanical device, is rendered in faded shades of light brown or yellow.



Translation clause

3 The Opponent’s Mark was endorsed with a translation clause which recorded that “*The French words appearing in the mark mean “Biological research”*”. By contrast, the Applicant did not provide the Registrar with any translation for the Application Mark because it relied on the fact that “recherché” is also an English word (and hence no translation was necessary): see [22] and [98] below. Although the Opponent raised various objections to the Applicant’s approach, it accepted that “recherché” can be found in the English dictionary (albeit as a loanword from the French language) and even submitted documentary evidence in this regard.

Grounds of opposition

4 Five grounds of opposition were raised by the Opponent against the Application Mark. They were: ss 7(1)(c), 7(6), 8(2)(b), 8(4)(b)(i) and 8(7)(a) of the Trade Marks Act (Cap. 332) (“TMA”). In this decision, I deal with the grounds in the order I consider most convenient.

Statutory declarations

5 Evidence was led in these proceedings in the usual way: via statutory declarations (“SD(s)”). Pierre-Louis Delapalme (“Delapalme”), a Director General of the Opponent, gave SD evidence (“Delapalme’s SD”) on its behalf. Ong Lay Koon (Wang Lijun) (“Ong”), a Director of the Applicant, gave SD evidence (“Ong’s SD”) on its behalf. The Opponent did not submit any evidence in reply and neither side applied for cross-examination. Consequently, the two SDs before this tribunal formed the entirety of the evidence in the proceedings.

The parties

6 The Applicant was founded in Singapore in July 2017. It manufactures skincare products as well as food & beverage products that are said to help with skincare (one such example being the Applicant’s fish collagen beauty tea, a product that was developed in collaboration with local bubble tea chain LiHO Tea¹). The Application Mark is the Applicant’s main trade mark. According to Ong, “Recherche” skincare products are specifically designed for Asian skin,² and are available to mass market consumers in Singapore through online platforms³ as well as through departmental stores.⁴ Ong’s evidence was that “Recherche” has been advertised on social media⁵ as well as in mainstream media (via newspaper and radio) in Singapore.

7 The Opponent was founded in Paris in the early 1970s. It develops and manufactures luxury skincare products and treatments. The Opponent uses the Opponent’s Mark as well as the plain word mark “BIOLOGIQUE RECHERCHE” in the course of trade. According to Delapalme, the Opponent enjoys a global reputation for its clinical approach to beauty and skincare, its skincare protocols and procedures, and its use of pure, concentrated, raw ingredients.⁶ In Singapore, a number of well-established beauty spa outlets (for example CHI, The Spa at Shangri-La Hotel) have offered beauty treatments using the Opponent’s “Biologique Recherche” products.⁷ The Opponent’s products have also been sold in Singapore through retail outlets (essentially: the spas that also offer the Opponent’s beauty treatments) as well as online through third party websites.⁸

The hearing

8 The substantive hearing took place on 29 November 2020. Both sides filed written submissions beforehand and were represented by counsel at the hearing.

¹ Ong’s SD at [5] and Exhibit OLK-1 at Tab 2

² Ong’s SD at [5]

³ Ong’s SD at [12]

⁴ Ong’s SD at [11] and Exhibit OLK-1 at Tab 1

⁵ Ong’s SD at [17]

⁶ Delapalme’s SD at [3]

⁷ Delapalme’s SD at [9] and Exhibit PD-3

⁸ Delapalme’s SD at [10]

9 Before the hearing began, Ms O'Connor (lead counsel for the Opponent) produced a 16-page hardcopy document titled "Opponent's Rebuttal Submissions" dated 29 October 2020 and sought permission to tender it. Ms O'Connor explained that the document was prepared as a rebuttal to certain segments of the Applicant's written submissions and that it constituted a skeletal outline of what would be raised in oral argument. Since Mr Foo (counsel for the Applicant) did not raise any objections, I allowed the Opponent to tender the hardcopy document and directed that the softcopy be filed electronically via IP'SG after the hearing.

10 At the close of the hearing, I gave parties leave to provide further brief written submissions by way of letter in relation to the issue of whether the goods for which the Opponent's Mark is registered in Class 3 can be considered similar to the services in Class 44 in respect of which registration is sought under the Application Mark. Both sides did so in accordance with the given timelines. I will address the parties' submissions, where relevant and necessary, in the course of this decision.

Post-hearing events

11 After the hearing, the Opponent filed a version of the "Opponent's Rebuttal Submissions" via IP'SG which differed from the hardcopy tendered at the hearing. The Opponent explained in its cover letter that "*At paragraphs 35 to 42, we included the written version of the verbal arguments we made at the hearing* [in relation to a specific issue under s 7(1)(c) TMA]".

12 In response, the Applicant wrote in to observe that my directions did not entitle the Opponent to file an amended version of the document. While the Applicant did not ask for the document to be rejected altogether, it contended that the Opponent's conduct was unfair and prejudicial and resulted in unnecessary wasted time and costs. Such conduct, the Applicant submitted, was wrongful and should be taken into account in assessing costs.

13 While the Opponent might have been well-intentioned, I agree that it should not have taken the liberty of doing what it did. The sole reason why I directed that the document be filed was so that the electronic record would be complete. That said, I do not think that the Opponent's conduct was egregious. After all, the Opponent had expressly highlighted the changes in its cover letter and the new paragraphs did not contain any new arguments. Given the circumstances, it would not be justified for a costs penalty to be awarded. However, such leniency might not be exercised in future cases. Counsel—and here I am referring to all who appear on behalf of their clients before this tribunal—would do well to bear this in mind.

MAIN DECISION

Opposition under s 8(2)(b) TMA

14 Section 8(2)(b) TMA provides that:

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

(a) [omitted]

(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.”


The step-by-step approach

15 In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”), the Court of Appeal held that the provision entails a three-step test: First, are the competing marks similar? Second, are the goods and/or services identical or similar? Third, is there a likelihood of confusion arising from (or to use the words of the section: because of) the foregoing? All three steps must be established for the opposition under this ground to succeed. If any one step cannot be established, the opposition under this ground will fail.

Are the competing marks similar?

16 In this case, the “*earlier trade mark*” is the Opponent’s Mark.

17 The first step is to compare the competing marks and come to a decision as to whether they are similar or not. The comparison is mark-for-mark, without consideration of any external matter (*Staywell* at [20]). For ease of reference, the competing marks are reproduced below.

<u>Opponent’s Mark</u>	<u>Application Mark</u>
	<p data-bbox="954 927 1248 981">Recherche</p>

Essential principles

18 It is trite law that three aspects or facets of similarity need to be considered: the visual, the aural and the conceptual. Be that as it may, the law does not prescribe a requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Each of these aspects are signposts towards answering the question of whether the marks are similar, and trade-offs can occur among the three aspects. The ultimate question is whether the marks, when observed in totality, are similar rather than dissimilar. (See *Staywell* at [17]-[18]; *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [16].)

19 In the analysis, the viewpoint that must be adopted is that of the average consumer of the goods or services in question who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry. The average consumer has imperfect recollection and makes comparison from memory removed in time and space from the marks. For this reason, the competing marks cannot be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, what must be considered is the general impression that will likely be left by the essential or dominant features of the marks on the average consumer, since it is those features that tend to stand out in the consumer’s imperfect recollection. (See *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) at [27]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(c)-(d)] and [62(a)]; *Staywell* at [23].)

20 While not a separate element under the step-by-step test, distinctiveness is a factor that plays an integral role in the marks-similarity assessment. In trade mark law, the term “distinctiveness” is used in two senses: (a) the ordinary and non-technical sense; and (b) the technical sense. The former refers to what is outstanding and memorable about the mark in question – i.e. the parts that tend to stand out in the consumer’s imperfect recollection. As regards the latter, it carries a meaning that is the opposite of “descriptiveness”, and refers to the capacity of the mark to function as a badge of origin. Technical distinctiveness may be inherent (e.g. where the words comprising the mark are meaningless) or acquired (through long-standing or widespread use). (See *Staywell* at [23] – [24].)

21 Ever since *Staywell*, there have been differing views, at least at the tribunal level, concerning the precise role of technical distinctiveness and whether (and if so, the extent to which) evidence relating to technical distinctiveness can be taken into account in the marks-similarity assessment. While there is no need to wade into the waters of controversy for the purposes of deciding this dispute, I will set out my reading of *Staywell* since it informs my approach. And it is this. The prohibition against “*consideration of any external matter*” in the mark-for-mark comparison (see *Staywell* at [20]) does not prevent a court or tribunal from considering whether a sign is descriptive or distinctive in relation to the relevant goods or services. After all, the Court of Appeal in *Staywell* at [31] took into account the context (there: hotels and hospitality services) in arriving at its conclusion that “Regis” enjoyed a substantial degree of technical distinctiveness. Thus, it stands to reason that evidence and contextual information which sheds light on whether average consumers would regard the sign as being inherently distinctive may be taken into account at the marks-similarity stage.⁹

Parties’ arguments

22 Arguments relating to distinctiveness were at the front and centre of the Opponent’s case. The Opponent’s key arguments were as follows. The starting point is that “BIOLOGIQUE RECHERCHE” is in French—a language which the public in Singapore would not be presumed to know. However, not all French words would be perceived the same way. Because of the linguistic similarities between English and French, “biologique”—much like the term “organic”—would be perceived and understood as a reference to natural and living products from biological ingredients. In other words, “biologique” is descriptive of the goods for which the Opponent’s Mark is registered (essentially: cosmetics and skincare products). By way of contrast, the second word “recherche” (which could be translated from French to English as “rare”, “refined”, or “research”)¹⁰ would hold no meaning for average consumers in Singapore. Thus, “RECHERCHE” would be regarded as the distinctive and dominant component of the

⁹ As regards evidence of use or advertising submitted for the purposes of supporting an argument that the sign has acquired distinctiveness leading to a “*high threshold before a competing sign will be considered dissimilar to it*” (see *Staywell* at [25]), my view is that such evidence is best taken into account at the third stage. While I would not go so far as to say that it cannot be taken into account at the first stage, reserving it for the third stage seems to better preserve the conceptual clarity of the step-by-step test as laid down by the Court of Appeal in *Staywell*. For a fuller discussion, see *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S v BenQ Materials Corp.* [2018] SGIPOS 2 (“*Clarins*”) at [20] – [25] where I set out my views in greater detail. I am aware that in *Monster Energy Company v Glamco Co, Ltd* [2018] SGHC 238 (a case decided after *Clarins*), Chan Seng Onn J considered (at [50] – [51]) Monster Energy Company’s evidence of use and advertising under the “Technical distinctiveness” subheading in the context of the mark-for-mark comparison. Nevertheless, the present issue was not discussed in the judgment and did not appear to have been argued before the court. In any event, the learned Judge found that the earlier marks did not possess a high level of technical distinctiveness and so this factor did not come into play.

¹⁰ Delapalme’s SD at Exhibit PD-11

Opponent's Mark. And since the Application Mark consists of the same word (albeit with an accented final "é"), the marks should be found to be similar as a whole.

23 The Applicant's main counterargument was that "RECHERCHE" is not the distinctive and dominant element in the Opponent's Mark. It raised various arguments in this regard, chief among them that "recherché" is an English word. In support, the Applicant relied on the Opponent's documentary evidence which showed that English dictionaries defined "recherché" as "exquisite" and "rare".¹¹ According to the Applicant, the Application Mark was selected because of its meanings in both languages since these positive attributes made "Recherché" a fitting and appropriate trade mark for the Applicant's products.¹² From this premise, the Applicant made the following further arguments. The fact that "recherché" has an English definition means that average consumers would not pay "RECHERCHE" in the Opponent's Mark special attention and thus it cannot be regarded as the distinctive and dominant part of the Opponent's Mark. Consequently, having regard to the various points of difference between the marks—and in particular because the Application Mark lacks the word "biologique"—the marks ought to be found dissimilar overall.

Distinctiveness

24 At this juncture, it is convenient to first identify the distinctive and dominant features of the Opponent's Mark, a composite mark. After considering the evidence and contextual information (to the limited extent that it can be taken into account at this stage: see [21] above) in light of the parties' arguments, I have come to the following conclusions.

25 First, the fact that the words "biologique recherche" in French mean "biological research" in English does not carry the matter further in either direction. As the Opponent rightly pointed out, there is no law or practice in Singapore that requires marks in a foreign language to be automatically translated into English for the purposes of a marks-similarity assessment in the context of a trade mark dispute (see *Aalst Chocolate Pte Ltd v The Patissier LLP* [2019] SGIPOS 7 at [42] – [43]). What is imperative is how the mark would be perceived by average consumers of the relevant goods or services as at the relevant date.

26 Second, the mere fact that a word has a dictionary meaning in English does not mean that it would necessarily be known to and used by the public in Singapore. Experience and common general knowledge (to borrow a term from patent law) would inform that "recherche" is not a word that forms part of the local lexicon. By this, I am not suggesting that the public in Singapore is uneducated or unaware. Rather, the point is that "recherche" is an exceedingly obscure word in the English language—at least from the perspective of the public in Singapore. In the rare event that one encounters it, one might not be aware that it is an English word with a French origin. Some might consider it to be a French word with no English equivalent. Others may yet regard it as an invented term. Whatever the case might be, there is no evidence to suggest that the relevant public in Singapore would ascribe any meaning to the word (let alone "exquisite" or "rare" or "research"). I therefore find "recherche" (with or without an accented final letter "é") to be inherently distinctive to a significant degree.

27 Third, the evidence did not shed much light on whether "biologique" is descriptive of the goods for which the Opponent's Mark is registered. (The parties were content to rely on the

¹¹ Ong's SD at [8] referring to Delapalme's SD at p 334

¹² Applicant's Counter Statement at [5] and Ong's SD at [8]

translation clause where the word was translated as “biological” but neither side produced any documentary evidence on this point.) In submissions, the Opponent argued that one would not need to turn to a translation dictionary to understand that “biologique” carries a similar meaning to “biological” given the close resemblance between the French word and the English equivalent—an attractive argument which the Applicant did not have any meaningful response to. Consequently, this tribunal is left to draw its own conclusions.

28 And my conclusions (this is the fourth point) are as follows. One does not need to be an expert in etymology or language in order to make a mental connection between “biologique” (in French) and “biological” (in English). From there one might see a further link between what is “biological” (or perhaps “organic” or “natural”) to skincare and cosmetic products. But given the state of the evidence—or lack thereof—I am not prepared to go so far as to find that “biologique” is descriptive of the goods in question. However, I will say this: the fact that average consumers are likely to make some sort of connection between “biologique” and “biological” means that it is inherently less distinctive than “recherche” (which would hold no meaning for average consumers).

29 Fifth, it is plain and obvious that the faded-colour botanical device in the background of the Opponent’s Mark is primarily decorative and not distinctive in nature. It possesses precious little trade mark significance except to the extent that it forms part of the Opponent’s Mark. Although the botanical device cannot be disregarded altogether, it plays a minor role at most in the marks-similarity analysis.

30 In my judgment, the combination of the above culminates in a finding that “RECHERCHE” is the most distinctive and dominant element of the Opponent’s Mark. For the avoidance of doubt, this does not mean that the Opponent’s Mark (as a whole) and/or the plain word mark “BIOLOGIQUE RECHERCHE” are not inherently distinctive. They are. All it means is that when comparing the Applicant Mark and the Opponent’s Mark for similarity, this tribunal is entitled to accord greater weight to “RECHERCHE” since this is the feature that will tend to stand out in the average consumer’s imperfect recollection.

Visual similarity

31 In advancing its case that the competing marks “*look obviously different*”,¹³ the Applicant relied on the following visual points of difference between the marks: (a) the word “BIOLOGIQUE” in the Opponent’s Mark (which is not in the Application Mark); (b) the accent over the final letter “é” (which is stylised in the Application Mark but absent from the Opponent’s Mark); (c) the “illustration of various plants” in the background of the Opponent’s Mark; and (d) various stylistic differences such as font,¹⁴ colour (“earth green” in the Application Mark and dark blue in the Opponent’s Mark) and positioning (in the Opponent’s Mark “BIOLOGIQUE” appears above “RECHERCHE” and both are of equal length).

32 The Opponent sought to downplay the significance of “BIOLOGIQUE” by arguing that this is a descriptive element in the Opponent’s Mark. In support, it relied on *Caesarstone* (at [41]) for the proposition that “*the public will generally not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall*

¹³ Applicant’s Written Submissions at [16]

¹⁴ And here the Applicant pointed out that it had specially commissioned a designer to create an original font known as “Novel Pro” which is not commonly found on computers: see Ong’s SD at [22]

impression conveyed by that mark". The competing marks in *Caesarstone* were the earlier trade mark "CÆSAR" and the application mark "caesarstone". In arriving at the conclusion that the marks were visually similar, the Court of Appeal found "caesar" to be distinctive in relation to non-metallic building materials whereas "stone" was found to be descriptive. Arguing by analogy, the Opponent submitted that, likewise, "BIOLOGIQUE" is descriptive of cosmetic and skincare products which often contained biological ingredients.

33 Although *Caesarstone* is a helpful point of reference, I do not think that "BIOLOGIQUE" in the Opponent's Mark presents a close analogy to "stone" in "caesarstone". Stone is a common word in the English language with a clear and unambiguous meaning and one can easily see why it was found to be descriptive of the goods in question such that the analysis focussed on the common "caesar" element. In contrast, "biologique" is at least one step removed because it is not an English word. Average consumers may well make a mental connection between "biologique" and "biology" or "biological" because they share the first six letters in common. But average consumers in Singapore are not presumed to know French. Thus, the question of whether "biologique" is descriptive of the goods does not even arise.

34 So then, where does this leave the analysis? Earlier, I have taken the view that "biologique" is inherently less distinctive than "recherche", and that "RECHERCHE" is the most distinctive and dominant element of the Opponent's Mark. For this reason, even though "BIOLOGIQUE" occupies some degree of visual weight in the Opponent's Mark, its absence from the Application Mark is insufficient to outweigh the similarity arising from the common "recherche" element between the competing marks. As regards the other allegedly differentiating features (such as the accented "é", the botanical device, and the font, positioning, colour and stylisation), it is clear that these are minor and/or decorative, and in any event non-distinctive. The average consumer, who has imperfect recollection and makes comparison from memory, would not regard such features as serving to distinguish the competing marks from each other.

35 I therefore conclude that the marks are visually similar to a slight degree.

Aural similarity

36 Although neither party led evidence as to how "recherche" should be pronounced, counsel on both sides were in agreement that it would be pronounced as "re-sheer-shay" or "ruh-sheer-shey". It was also common ground that the word would be pronounced the same way in both the Application Mark as well as the Opponent's Mark. (And here it was not disputed that the word would be pronounced the same in French or English.) As for "biologique", it was suggested by Opponent's counsel that it should be pronounced as "byo-lo-jik" and Applicant's counsel did not dispute this.

37 Returning to the applicable legal principles, *Staywell* makes it clear that there are two possible approaches that can be taken in the comparison for aural similarity (*Staywell* at [31] – [32]). The first is to consider the dominant components of both marks ("Dominant Component Approach") and the second is to undertake a quantitative assessment as to whether the competing marks have more syllables than not ("Quantitative Approach").

38 The Opponent's case was that it is immaterial whether this tribunal adopts the Dominant Component Approach or the Quantitative Approach for the result would be the same: the marks

are aurally similar to a high degree on account of the common word “RECHERCHE”. In response, the Applicant submitted that the marks are aurally dissimilar since: (a) “BIOLOGIQUE” is not in the Application Mark and (b) because “BIOLOGIQUE” is the first word in the Opponent’s Mark, a listener would notice from the outset that “BIOLOGIQUE” is absent from the Application Mark.

39 Earlier, I have found “RECHERCHE” to be the most distinctive and dominant component of the Opponent’s Mark. Substantially similar considerations would apply to the aural analysis as well. While it is true that “BIOLOGIQUE” would be pronounced first, it is not an unfamiliar sounding word: “biologique” sounds like “biologic”. And from there, words such as “biological” or “biology” would not be too far off. On the other hand, the average consumer in Singapore would be hard pressed to pronounce “recherche”, a completely foreign-looking word. Therefore, under the Dominant Component Approach—where the focus is on the common element “recherche”—the marks are aurally similar. That said, because “BIOLOGIQUE” possesses some aural weight (since it is the first word in the Opponent’s Mark), the aural similarity between the words can best be described as “slight”.

40 I have some reservations about the usefulness of the syllable-counting Quantitative Approach where foreign words like “biologique” and “recherche” are concerned. Nevertheless, I am inclined to the view that a similar result would be reached. Realistically speaking, average consumers might enunciate the words thus: “bi-yo-logic” (which could be three or four syllables) and “re-cher-chey” (three syllables). Indeed, there could be various possible ways which an average consumer would pronounce the words, ranging from “byo-lo-jik” to “bi-yo-logic” and “re-she-shay” to “ruh-she-shey”. But whatever the case, the marks would share close to half of their syllables. This points towards a finding of slight aural similarity.

41 The Applicant also suggested that some might pronounce the word using two syllables e.g. “re-church”. While this is certainly possible, it is highly doubtful that a significant number of people would automatically render the final letter “e” in “recherche” silent. There are at least two reasons for this. First, the Application Mark contains the accented “é”, and people naturally emphasise accented letters not omit them. An example of this is “café” (also of French origin). English speakers pronounce it as “caf-fay” or “caff-ay”; not “caff”. Second, when encountering completely unfamiliar or foreign words, it is only natural to try and pronounce every syllable as it appears. The same does not apply for “biologique” since words ending with “-que” are not uncommon in the English language and speakers are accustomed to pronouncing such words (examples include: antique, cheque, clique, torque, unique) with the ending “k” sound.

42 To conclude, I find the marks to be aurally similar to a slight degree.

Conceptual similarity

43 The conceptual analysis “*seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole*” (Staywell at [35]).

44 In submitting that the marks are “*entirely disparate and bear no similarity to each other at all*”, the Applicant made reference to the fact that it chose “Recherché” for its double meaning in both English and French and in particular because it stood for “exquisite” and “rare”.¹⁵ The Applicant also explained that it adopted a Traditional Chinese Medicine based


¹⁵ Ong’s SD at [8]

approach in formulating its products with the “*key concept being synergy, the idea of making sure that every component in the formula helps to bring the best out of each ingredient*”.¹⁶

45 The Opponent’s counterargument was that average consumers in Singapore would not understand that the word “Recherché” refers to “rare” or “exquisite”; at the very most, they would perceive it as a word in a foreign language. Likewise, average consumers would also not know the exact meaning of “BIOLOGIQUE RECHERCHE” and therefore the words would not convey any particular idea or concept (except to the extent that there might be a biological facet to the Opponent’s goods). Since meaningless words do not evoke any ideas (see *Sarika* at [34]) there would be conceptual similarity insofar as there is an overlap in “recherche”.

46 Should the marks be considered conceptually similar having regard to the shared element “recherche”? In answering the question, it is apposite to recall the Court of Appeal’s reminder in *Staywell* that the conceptual analysis differs from the aural¹⁷ because the latter “*involves the utterance of the syllables without exploring the composite meaning embodied by the words*”. For this reason, “*greater care*” is required “*in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts*” (*Staywell* at [35].) In that case, the competing marks



were “ST. REGIS” and “ ”. Pertinently, while the Court of Appeal agreed with the High Court’s assessment that “Regis” was the distinctive component from an aural perspective, it disagreed that “Regis” would be a dominant component on a conceptual analysis. The court went on to emphasise that while “Regis” might connote royalty, that connotation became secondary with the introduction of “Park” and “St.”. Ultimately, the court found conceptual similarity between the marks but for a different reason: in its view, both “ST. REGIS” and “Park Regis” had the tendency to connote a place or location or building.

47 Returning to the present case, the fact that the competing marks share the word “recherche” is not determinative of the issue. Average consumers in this country would not know what “recherche” means in either English or French. As mentioned earlier, it is an exceedingly obscure word in English and the public in Singapore is not presumed to know French. To my mind, “Recherché” would be regarded by average consumers as a word in a foreign language—nothing more, and nothing less. Likewise, average consumers would not know what “BIOLOGIQUE RECHERCHE” means other than that they are foreign words. They might suspect a link between “biologique” and “biological”. But even so, they would not understand the “*ideas that lie behind... the mark as a whole*”.

48 At the end of the day, since both marks hold no clear conceptual meaning for average consumers in this country, I find that there is no conceptual similarity between the two. But make no mistake: a finding of no conceptual similarity is not the same as a finding of a conceptual dissimilarity. This facet of similarity is ultimately neutral.

49 For completeness, I should briefly touch on the Applicant’s argument that its underlying key concept in formulating its products was “synergy” in the Traditional Chinese Medicine sense. While that might be so, such a business concept is not encapsulated within, or

¹⁶ Ong’s SD at [6]

¹⁷ The issue of visual similarity was not before the Court of Appeal because the parties had not appealed against the first instance finding that the marks were visually dissimilar.

communicated to consumers through, the mark “Recherché”. Ideas or concepts which lie behind the formulation or choice of mark are irrelevant unless they can be discerned by average consumers perceiving the mark in question.

50 To conclude, I find that the marks are conceptually neither similar nor dissimilar.

Conclusion on marks-similarity

51 I have found the competing marks to be visually and aurally similar to a slight degree. Conceptually, they are neither similar nor dissimilar to each other. I therefore find that when observed in their totality, the marks are similar to a slight degree.

Are the goods and services similar?

52 The second step under the step-by-step test is to compare the goods and services for which registration is sought as against the goods for which the Opponent’s Mark is registered. The position in Singapore is that the similarity of goods/services analysis does not require a detailed comparison between each and every item in the specification of both marks. In the present case, it is sufficient if the Opponent is able to show that at least one of the goods covered under the Opponent’s Mark is similar to at least one of the goods in Class 3 as well as at least one of the services in Class 44 for which registration is sought under the Application Mark.

53 For convenience, I reproduce the specification of goods and services in table form below.

<u>Application Mark</u>	<u>Opponent’s Mark</u>
<p><u>Class 03</u> <i>Anti-aging skincare preparations; Skincare cosmetics; Skincare preparations for cosmetic purposes; Cosmetic products in the form of aerosols for skincare; Beauty masks; Beauty gels; Beauty milk; Beauty soap; Beauty creams; Beauty serums; Beauty lotions; Beauty face packs; Beauty balm creams; Facial beauty masks; Beauty care cosmetics; Facial oils; Facial cream; Facial masks; Facial packs; Facial soaps; Facial lotion; Facial scrubs; Facial toners; Facial washes; Facial lotions; Facial cleansers; Facial emulsions; Facial beauty masks; Facial moisturisers; Facial preparations; Cosmetic facial masks.</i></p> <p><u>Class 44</u> <i>Beauty salons; Beauty services; Beauty counselling; Beauty treatment; Beauty care of feet; Beauty salon services.</i></p>	<p><u>Class 03</u> <i>Soap, perfumery goods, essential oils, cosmetics, cosmetic creams for facial and body skin care, hair lotions, shampoos, dentifrices, incense, deodorants for personal use (perfumery); cosmetic preparations for slimming purposes; cosmetic preparations for toning purposes; make-up removing preparations; beauty masks, except wipes; shaving preparations, after-shave lotions, tissues impregnated with cosmetic lotions, nail care preparations.</i></p>

54 Insofar as the Class 3 to Class 3 comparison is concerned, the analysis is relatively straightforward. It cannot be seriously disputed that the goods on each side essentially cover

cosmetics and skincare products. No matter how one slices and dices it, the specification of goods on both sides are identical at least in relation to such goods.

55 I turn next to the comparison between the Class 44 services (applied for by the Applicant) and the Class 3 goods (registered under the Opponent's Mark). The Opponent's starting point, which I agree with, was that there is no rule which prevents this tribunal from finding that the goods under the registration are similar to the services applied for. Indeed, as I have observed elsewhere, there is authority for the proposition that goods and services can, in certain circumstances, be regarded as similar to each other: see *Daidoh Limited v New Yorker S.H.K Jeans GmbH & Co. KG* [2018] SGIPOS 18 ("*Daidoh*") at [31] to [33] citing *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 ("*Guccitech*") at [35] and *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 at 296 ("*British Sugar*") at 297. The classic example (given *obiter* in *British Sugar*) is that "*a service of repair might well be similar to the goods repaired*". Following this line of reasoning, "*clothing*" (as a good) in *Daidoh* was found to be similar to the service of "*retail services with regard to clothing*". Naturally, there are limits to this proposition. For instance, "*it cannot be the case that a general retail services specification that does not refer to any particular goods must be regarded as similar to any goods that may be sold in a retail outlet*: see *Guccitech* (at [35]).

56 In the assessment for goods/services similarity, a court or tribunal may have regard to the guidelines set out in *British Sugar*, which have been looked to and applied in *Staywell* as well as a number of other local cases. These *British Sugar* guidelines are not rigid requirements and at the end of the day they must be considered having regard to the relevant circumstances. After all, the real question is how the goods or services in question would be regarded for the purposes of trade (*Staywell* at [43]). And in this case, the *British Sugar* guidelines¹⁸ which assist in the assessment include: (a) the respective uses and users of the goods or services; (b) the physical nature of the goods or acts of service; (c) the trade channels through which the goods or services reach the market; and (d) the extent to which the respective goods or services are competitive.

57 The Opponent argued, by reference to the *British Sugar* guidelines, that the goods and services in issue are similar because: (a) the users of the respective goods and services would be the same (since skincare is skincare after all, and the users of cosmetics and skincare products—namely, the general public—would also be the users of beauty services); (b) cosmetic/beauty products (which would be in small containers) are not only used as part of a beauty or spa treatment, they are usually also available for sale for customers to use at home; (c) the goods and services are close substitutes of each other since their ultimate goal is to improve beauty and looks; and (d) it is common for brand owners in the beauty industry to render consultancy and beauty treatment services for customers who use their products.

58 However, it was not entirely clear to me that cosmetics and skincare products are similar to beauty services for the purposes of the second step of the three-step test. While a service of retailing or repairing a certain product can be similar to the product itself, it is uncertain whether the logic could be extended to the facts of the present case. Consider, for instance, the following item in the product specification under the Opponent's Mark: "*beauty masks, except wipes*". Across the entire spectrum of beauty salons or spas, one would encounter a wide smorgasbord of beauty services that may (e.g. in the case of facial treatments) or may not (e.g. in the case of nail salon services, hair dressing services, etc.) involve beauty masks. In contrast, there is a

¹⁸ The only other *British Sugar* guideline is of very limited relevance to the present case because it concerns self-serve consumer items and whether they are usually found on the same or different shelves.

direct connection between car repair services and the sale of cars (to give one example), or clothing retail services with clothing as a product (to give another example). Since neither party cited any case authorities which dealt with this particular situation, I invited the parties to conduct additional research and furnish further submissions by way of letter after the hearing.

59 In its further submissions, the Applicant did not cite any case authorities which dealt with this specific situation. Instead, it drew my attention to *Monster Energy Company v Chun-Hua Lo* [2017] SGIPOS 17 which it considered to be relevant. In that case, it was argued that beverages (including vitamin drinks, energy drinks, isotonic drinks, fruit juices and soda water) in Classes 5 and 32 were similar to ice (and related products) in Class 30 because they all served the common purpose of quenching thirst. However, the hearing officer rejected this argument and found (at [120]) that the goods were dissimilar since they had different uses (e.g. beverages quench thirst but ice cubes chill a drink), users, physical nature, and they would be sold separately in supermarkets. The Applicant argued that I should similarly reject the Opponent's arguments because: (a) beauty services may nor may not involve the use of cosmetics or skincare products; and (b) the goods are sold as physical packaged products whereas beauty services are provided to customers who physically visit beauty salons.

60 The Opponent, on the other hand, was able to provide persuasive authority from relevant foreign jurisdictions that were more or less on point.

- a. The first case was a UK trade mark opposition case (O/519/19) commenced by Parfums Parour against the mark "LOMNI; lomni". In that case, the hearing officer held that beauty products in Class 3 (including cosmetics, make up, perfumes, shampoo and hair lotions) were similar to the following services in Class 44: *treatments with cosmetic preparations, body lotions, creams, fragrances, essential oils and/or treatments requiring posterior treatment with body lotions, moisturizing cream, etc.* The hearing officer acknowledged that while the goods and services are different in nature, they shared the same general purpose: beauty care and hair care. It was also observed that the goods in question were important, if not essential, to provide the beauty care and haircare services and the same consumers were targeted. Finally, the trade channels were shared in that beauty salons and hair salons often sell their own beauty and haircare products and recommend them for further home treatments. Accordingly, the hearing officer concluded that the commercial origin of the goods in services could coincide, and found the services in Class 44 to be similar to a medium degree to the goods in Class 3.
- b. The second case was a UK trade mark opposition case (O-010-20) commenced by Tiffany and Company against the mark "COTSWOLD LASHES BY TIFFANY". In that case, the hearing officer found the opponent's Class 3 goods (cosmetics) to be "*clearly complementary to beauty treatments*" (for which registration was sought in Class 44), and concluded that there was "*at least a low degree of similarity*" between the two.
- c. The third case was an Australian Trade Marks Office case: *Deanna Campese v LASH HQ PTY LTY* [2020] ATMO 99. In that case, the opponent's mark was registered in Class 3 for beauty products and related implements, whereas the application mark was sought to be registered in Class 44 for beauty services and cosmetic services. The opponent gave evidence that consumers of beauty care

services and lash extension services often seek to purchase beauty products from their trusted beauticians and lash technicians, and that it is common for beauticians and lash technicians to offer (to their clients for purchase) skin care products and lash products respectively. The hearing officer ultimately found the goods in Class 3 to be similar to the services in Class 44.

- d. The fourth case was a decision of the Eighth Chamber of the General Court of the European Union: *Costa Crociere SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-388/13). In that case, the court found “*Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices*” in Class 3 to be similar to “*Spas, Turkish baths, sauna services, health spa services, all provided on board cruise ships*” in Class 44 having regard to the fact that they shared the same purpose (beauty and healthcare), had overlapping distribution channels, and targeted the same segment of the public.

61 While the above foreign decisions are not binding on me, I consider the reasons given to be persuasive. I acknowledge that beauty services may not necessarily involve the use of cosmetics or skincare products and that there are inherent differences in the nature of the goods and services. Nevertheless, there is a material overlap between the goods and services in respect of the uses (here: to improve looks and beauty), the users (here: a large proportion of the general public that purchase and use products and services which improve looks and beauty), and the extent to which the goods and services are complementary to, or substitutes, for each other. It is also reasonable for a business in beauty services to offer beauty products or vice-versa. There is therefore a moderate degree of similarity between the goods and services. (This is higher than in the second case, “COTSWOLD LASHES BY TIFFANY”, because Tiffany and Company’s Class 3 registration did not cover skincare. There is a stronger connection between skincare and beauty services as compared to cosmetics and beauty treatments.)

62 To conclude, I find that the goods in Class 3 under the Opponent’s Mark are: (a) identical with the goods in Class 3 under the Application Mark at least insofar as both relate to cosmetics and skincare products; and (b) similar to a moderate extent to beauty services in Class 44 under the Application Mark. This satisfies the second step of the step-by-step test.

Is there a likelihood of confusion?

63 There are at least two aspects to the element of likelihood of confusion. The first is mistaking one mark for another. The second is where the relevant segment of the public may well perceive that the contesting marks are different, but may yet remain confused as to the origin which each mark signifies and may perceive that goods bearing the two marks emanate from the same source or from sources that are economically linked or associated. (See *Caesarstone* at [57]; *Hai Tong* at [74].)

64 In any case, the only relevant type of confusion for the purposes of grounding an opposition action is that which is brought about by the similarity between the competing marks and the similarity (or identity) between the respective goods and services in question. (See *Staywell* at [15].) Thus, the test requires the court or tribunal to look at: (a) *how* similar the marks are; (b) *how* similar the goods/services are; and (c) given this, how likely the relevant segment of the public will be confused. (See *Staywell* at [55].) Pertinently, it is not necessary to show that a majority of the relevant public would be confused; instead, it is sufficient to

establish that a substantial portion (which is more than a *de minimis* level) of the relevant public would likely be confused. (See *Hai Tong* at [78(e)].)

65 It is settled law that in assessing likelihood of confusion, certain factors may be taken into account whereas others cannot. The permissible factors, which include things like purchasing practices and degree of care paid by the consumer where acquiring the goods/services in question, are those which: (a) are intrinsic to the very nature of the goods/services and/or (b) affect the impact that the similarity of marks and goods has on the consumer. The impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps. Such impermissible factors, which cannot be taken into account in the assessment because they are not inherent to the goods or services and are susceptible to changes which can be made from time to time, include pricing differentials, (choice of) packaging, and other superficial marketing choices which could possibly be made by the trader. (See *Staywell* at [95].)

66 In arguing that there would be no likelihood of confusion, the Applicant submitted that its products: (a) focussed on Asian skin (as opposed to the Opponent's products which did not focus on any ethnicity); (b) were associated with local (as opposed to foreign) celebrities; (c) are available to the mass market through departmental stores (as opposed to being marketed through spas); (d) were marketed through collaborations with food and beverage outlets through the sale of its edible beauty products (which is something that the Opponent does not do); (e) were sold in smaller packages at retail prices (and here the contention was that the Opponent's packaging methods and trade channels were slightly different); and (f) were sold directly through the Applicant's website (in contrast with the Opponent which relied on its trade partners and distributors to re-sell its products). With respect, it is patently clear from *Staywell* that these are all impermissible factors which cannot be taken into account.

67 Needless to say, cosmetics, skincare products and beauty services are goods and services that are not specialised and are purchased and used by the general public. Nevertheless, because they relate to beauty and self-care, such products and services are "*very personal*" and would not be "*purchased on impulse with fleeting attention*". In other words, they would "*attract greater interest and attention on the part of the consumer*". (See *Staywell* at [94].) In certain cases, the higher degree of attention paid might mean that average consumers would be less likely to be confused. However, in this case the competing marks coincide in a common distinctive element: "recherche". And in the context of cosmetics, skincare products and beauty services, it is not uncommon for a distinctive mark to be accompanied by other signs which designate product lines or sub-brands or related brands. In such circumstances, the greater interest and attention paid would not necessarily dispel or diminish the likelihood of confusion. On the contrary, it might even increase it.

68 Earlier, I have found the competing marks to be similar albeit to a slight degree. Integral to this finding was my conclusion that "RECHERCHE" would be regarded by average consumers in Singapore as meaningless and consequently the most distinctive and dominant component of the Opponent's Mark. As a matter of general knowledge and common sense, average consumers in Singapore would not be aware that "recherche" is a French word, let alone an English word of French origin. Since the Application Mark constitutes this very same word, it stands to reason that once imperfect recollection is taken into account, average consumers encountering the junior mark in relation to cosmetics or skincare products (which are identical with at least some of the goods for which the Opponent's mark is registered) or

beauty services (which are moderately similar to the goods in question) would likely be confused into believing that they originate from the same or economically-linked sources.

69 The fact that the Application Mark does not contain the word element “BIOLOGIQUE” does not diminish the likelihood of confusion either. Although the word cannot be regarded as descriptive (since average consumers would not know for sure what it means), given that it shares so many letters in common with English words like “biology” or “biological” there is a reasonable likelihood that they would perceive it as a foreign equivalent of those words. Whatever the case might be, having regard to the nature of the goods/services, it would be perfectly reasonable given the circumstances for average consumers to perceive “BIOLOGIQUE RECHERCHE” as a cosmetics/skincare product line or beauty service originating from “Recherché” or vice-versa.

70 As regards the other slight differences between the competing marks, I have found that average consumers would regard them as minor, decorative and in any event non-distinctive. They, too, would not diminish the likelihood of confusion.

71 Before concluding, I would make some brief points on the marketplace evidence.

- a. First, the Applicant did not produce any evidence to contradict Delapalme’s claim¹⁹ that the Opponent was not aware of any other trader in the skincare or spa treatment industry in Singapore that had prominently used the word “recherche” as a trade mark. As far as I can tell, prior to the Applicant’s entry into the market in mid to late 2017, the Opponent was the only trader in the skincare/cosmetics industry in Singapore that used a trade mark which consists of or contained the word “recherche”. Indeed, the Applicant’s evidence disclosed that it only started marketing and selling goods in connection with the Application Mark in 2018, sometime after the Relevant Date (7 November 2017).²⁰
- b. Second, the evidence showed that average consumers regarded the Opponent’s Mark as well as “BIOLOGIQUE RECHERCHE” as distinctive badges of origin. There was evidence that the Opponent’s Mark and the plain word mark “BIOLOGIQUE RECHERCHE” were advertised and used in Singapore prior to the Relevant Date (7 November 2017). For instance, Delapalme’s evidence was that the Opponent sold more than S\$190,000 worth of goods (at wholesale price, not counting resale mark-ups) to its distributor Ryo Esthetics Pte Ltd in Singapore in 2016.²¹ There was also evidence that the Opponent’s products were available to consumers via retail or through spa treatments in Singapore prior to the Relevant Date. For example, Shangri-La Hotel’s website carried a press release dated 16 February 2015 which stated that “*CHI, The Spa at Shangri-La is The Exclusive Hotel Spa to Offer Biologique Recherche Treatments in Singapore*”.²² And on various dates in 2016, Beauty Link Facial Point uploaded photographs to its Facebook page which clearly advertised products bearing the Opponent’s

¹⁹ Delapalme’s SD at [21]

²⁰ Ong’s SD at [13] gave sales figures starting from the year 2018

²¹ Delapalme’s SD at [12]

²² Delapalme’s SD at [16] and Exhibit PD-3 at p 37 and 174

Mark.²³ (There were also other examples in evidence and it is not necessary for present purposes for me to go through every one of them.²⁴)

All things considered, there was nothing in the evidence that militated against a finding that there would be likelihood of confusion on the part of a substantial portion of the public.

72 I therefore find that the third element of likelihood of confusion has been established.

Conclusion: s 8(2)(b) TMA

73 For the reasons above, I find that the opposition succeeds under s 8(2)(b) TMA. Consequently, the Application Mark is refused registration.

Opposition under s 8(7)(a) TMA

74 Section 8(7)(a) TMA provides that a trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented “*by any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*”. The classic elements of the tort of passing off are: (a) goodwill; (b) misrepresentation; and (c) damage. To succeed under s 8(7)(a) TMA, the Opponent must establish a *prima facie* case of passing off (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]). The key principles relating to each element have been discussed in a number of decisions of the Court of Appeal, including *Staywell, Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) and *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 (“*Amanresorts*”), which I have had regard to.

Goodwill

75 Goodwill, simply put, is the legal property that the law of passing off protects. An “*amorphous idea that does not sit well with strict definitions*” (see *Singsung* at [32]), goodwill is perhaps best explained as a term which “*describes the state of the trader’s relationship with his customers*” (see *Singsung* at [32] citing *The Singapore Professional Golfers’ Association v Chen Eng Waye* [2013] 2 SLR 495 (“*SPGA*”) at [22]). In *The Commissioners of Inland Revenue v Muller & Co’s Margarine, Limited* [1901] AC 217 at 223-224 (cited in *Singsung* at [32]), Lord Macnaughten famously described it as “*the benefit and advantage of the good name, reputation, and connection of a business*” and “*the attractive force which brings in custom*”.

76 Because passing off concerns the relationship of a trader and its customers, the goodwill that is relevant to a passing off action does not lie in the “*constituent elements, such as the mark, logo or get-up*” which a business uses. Rather, goodwill is concerned with the business “*as a whole*”. Goodwill “*does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys*” (See *Singsung* at [34] and the authorities cited there.) Goodwill may be proved “*by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear*” (*Singsung* at [34] citing *SPGA* at [22]).

²³ Delapalme’s SD at Exhibit PD-3 at pp 50-51

²⁴ Although the Opponent did not engage in direct advertising, the spa outlets in Singapore which carried its products did advertise. For more examples, see table in Delapalme’s SD at [16]

77 In the context of the s 8(2)(b) TMA ground of opposition discussed above, I found that the Opponent's Mark and the plain word mark "BIOLOGIQUE RECHERCHE" were advertised and used in Singapore prior to the Relevant Date. The evidence showed that customers in Singapore actively sought out and purchased goods and services that were offered and sold under the Opponent's Mark. As such, the element of goodwill is clearly established.

Misrepresentation

78 In *SPGA* (at [25]), the Court of Appeal stated that: "*Misrepresentation in the tort of passing off can take many forms, but a common form is where the defendant [here: the Applicant], by its choice of mark or name, misrepresents to the relevant public that its good or services are actually those of, or are related to or associated with the claimant's [here: the Opponent]. To put it another way, the question may be asked whether the defendant is tapping on the claimant's established goodwill by using the mark, name or get-up in question*". Here, the form of misrepresentation relates to the Application Mark's sole element: "recherche".

79 In *Singsung* the Court of Appeal explained the interplay between distinctiveness and misrepresentation in the following way: "*...the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation. Simply put, if a mark or get-up is not distinctive of the plaintiff's products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant's products or services are the plaintiff's or are economically linked to the plaintiff... If it is found that the mark or get-up is distinctive of the plaintiff, then the next question is whether the use of similar indicia by the defendant amounts to a misrepresentation*" (at [38]). Having considered the evidence in detail, I have no doubt that average consumers regarded the Opponent's Mark as well as the plain word mark "BIOLOGIQUE RECHERCHE" as being distinctive badges of origin. Furthermore, as between the two parties, the Opponent was the first (by some years) to use a mark in Singapore containing "recherche".

80 As regards the principles that guide the misrepresentation analysis, the Court of Appeal in *Singsung* held that: "*Whether misrepresentation has occurred is a question to be determined by the court in the light of the surrounding circumstances. The misrepresentation in question must give rise to confusion (or the likelihood thereof) in order to be actionable under the law of passing off. This is ultimately a matter for the court's judgment and it is not to be determined on a visual side-by-side comparison. Rather it is to be assessed from the vantage point of a notional customer with imperfect recollection...*" (at [40]). Above, in the context of s 8(2)(b) TMA, my conclusion was that there would be a likelihood of confusion as between the competing marks. For substantially the same reasons, I also find that the element of misrepresentation has been established.

Damage

81 The third and final element is damage, or the likelihood thereof, to the claimant's goodwill. The law recognises the possibility of various categories or "heads" of damage. In this case, there would be damage in at least two categories: (a) diversion of sales (see *Hai Tong* at [118]) since both sides are in direct competition for cosmetics and skincare products in Class 3; and (b) restriction of business expansion opportunities (see *Staywell* at [125] – [127]) since the Opponent would not be able to expand to the related field of beauty services in Class 44.

Conclusion: s 8(7)(a) TMA

82 For the reasons above, I would also allow the opposition under s 8(7)(a) TMA.

Opposition under s 8(4)(b)(i) TMA

83 In simplistic terms, s 8(4)(b)(i) TMA prohibits the registration of trade marks which conflict with an earlier well known trade mark provided certain conditions are met.

84 To succeed under s 8(4)(b)(i) TMA, four elements need to be established by the Opponent: (a) the Opponent's Mark was well known in Singapore as at the Relevant Date (i.e. 7 November 2017); (b) the Application Mark is identical or similar to the Opponent's Mark; (c) the use of the Application Mark in relation to the goods and services for which registration is sought would indicate a connection between those goods and services and the Opponent; and (d) the connection is likely to damage the Opponent's interests.

85 Earlier, in the context of the s 8(2)(b) TMA analysis, I have found the competing marks to be similar. This deals with the second element. And for the third element, the Court of Appeal in *Staywell* observed that *Amanresorts* (at [226] and [233]) “has put it beyond doubt that the connection requirement of [s 8(4)(b)(i) TMA] will be satisfied where there is a likelihood of confusion”. In this case, for substantially the same reasons as those set out earlier in the s 8(2)(b) TMA likelihood of confusion evaluation, I find that the connection requirement has been likewise established. As regards the fourth element, I have found in the context of the s 8(7)(a) TMA analysis that the Opponent's interests would be damaged through diversion of sales and restriction of business expansion opportunities. Those findings would apply here as well.

86 As such, the only issue I have left to consider is the first element: whether the Opponent's Mark was well known in Singapore as at 7 November 2017—the date on which the Application Mark was applied for. Sections 2(7) to 2(9) TMA are the starting point in the assessment for whether a mark is “well known in Singapore”. They provide as follows:

“(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of —
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;

(e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

(9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.”

87 In *Amanresorts* (at [137]– [154]), the Court of Appeal examined the above provisions in detail. What follows is a brief outline (and at certain points a restatement) of the salient principles. First, there is no single universally applicable test to ascertain whether a trade mark is well known, but the guidelines in s 2(7) TMA strive towards some semblance of objectivity. Second, s 2(7)(a) TMA is “*arguably the most crucial factor when determining whether a trade mark is well known in Singapore*”. This is because of the provision in s 2(8) TMA which provides that once a trade mark has been found to be well known to any relevant sector of the public in Singapore, it shall be deemed to be well known in Singapore. For this reason, a court (or tribunal) cannot disregard s 2(7)(a) TMA. On the contrary, all of the other factors listed in s 2(7) TMA are irrelevant once it is determined that the trade mark in question is well known to any relevant sector of the public in Singapore. Third, apart from s 2(7)(a) TMA, the court (or tribunal) is free to disregard any or all of the other factors in s 2(7) TMA as the case requires, or to take additional factors into consideration. Fourth, the law does not require that a trade mark be well known across the entire country before it is regarded as a well-known trade mark. To qualify for protection, the mark must be not just “known” but “well known” to any relevant sector of the public in Singapore; in this regard, the inquiry is focussed on the actual and potential consumers of the claimant’s goods and services.

88 In *Caesarstone*, the Court of Appeal referred to its earlier decision in *Amanresorts* and emphasised that while the relevant sector of the public “*need not be large in size*”, this should not be read as standing for the more general proposition that the threshold for a trade mark to be regarded as well known is a low one. The relevant paragraphs are reproduced below:

“*Not too difficult*”

101 Although we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore (see [100] above), the Judge thought that this comment should not be taken to mean that the hurdle that trade mark owners had to cross was minimal. Rather, the comment had to be applied with judicious caution to the actual facts and circumstances of each case.

102 We do not think that this comment in *Amanresorts* was made to lay down a general principle. In this regard, we agree with the Respondent’s submission that the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be

any relevant sector of the Singaporean public, and this sector need not be large in size. Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.”

89 In the present case, it was undisputed that the relevant sector of the public in Singapore would be the Opponent’s actual and potential consumers, which would comprise actual and potential consumers of cosmetics and skincare products and treatments. However, both sides differed as to whether the evidence showed that the Opponent’s Mark crossed the threshold and was truly well known to this segment of the public. At this juncture, I should emphasise two preliminary points. First, the Opponent’s goods and services are not specialised in nature. They are cosmetics/skincare products and beauty services. And such goods and services are ordinarily consumed by a very large proportion of the public in Singapore. Second, the Opponent’s goods and services are not prohibitively expensive, and not targeted at any specific sub-segment of the market. (Indeed, the Opponent took pains to highlight that its products were not just available in high-end spas like CHI, The Spa in Shangri-La Hotel, but also in less upscale residential locations across Singapore.²⁵) This was unlike *Amanresorts* where the plaintiff’s target market for its ultra-luxury hotels/resorts was limited to high-income individuals and once-in-a-lifetime visitors and aspirants.

90 After careful consideration, I find that the evidence does not pass the requisite threshold and is ultimately insufficient to show that the Opponent’s Mark was well known to the relevant sector of the public at the Relevant Date. This conclusion might come as a surprise to some. After all, in the context of the s 8(2)(b) and s 8(7)(a) TMA assessment, I found that: (a) the Opponent had the requisite goodwill to sustain a notional action in passing off; (b) the Opponent’s Mark was distinctive; and (c) there was no evidence that any other trader in the skincare or spa treatment industry—apart from the Opponent—used a mark in Singapore comprised of or containing “recherche”. But the point is this. Despite having many similarities, the goodwill analysis under the tort of passing off and the inquiry as to whether a trade mark is well known cannot be conflated with each other. In the former, the focus is on the trader’s goodwill, which describes the business relationship between the trader and its customers in connection with a distinctive sign or some other indicia. In the latter, the focus is on whether the trade mark in issue was well known to the relevant sector of the public in Singapore. This includes not just the actual consumers but also potential consumers of the Opponent’s goods or services, as well as other relevant persons in the trade: see s 2(9) TMA.

91 The overall picture that emerges from the evidence is that the products and beauty treatments under the Opponent’s Mark had a small but loyal “cult” following in Singapore. When the Opponent’s products were first available in Singapore in 2013, they were difficult to obtain (and even then, not the entire range was available) but still there were a number of individuals who actively sought them out. Even so, in 2016 and 2017 the gross sales figures (at wholesale price, excluding distributor/retailer or beauty spa/salon mark-ups) were in the region of S\$180,000 to slightly more than S\$190,000 per annum. While these numbers are respectable and not in any way insignificant, they likely represented a small segment of the entire cosmetics/skincare and beauty treatments industry in Singapore. The same can also be said about the 22 spa outlets which offered “BIOLOGIQUE RECHERCHE” treatments in

²⁵ Opponent’s Rebuttal Submissions at [19]

Singapore.²⁶ While this clearly showed the existence of market demand, it is obvious that the Opponent's treatments commanded no more than a small slice of the market.

92 I turn next to consider the potential customers of the Opponent's goods and beauty treatments as well as relevant members of the trade/industry. The Opponent's case was that the Opponent's Mark was well known to these segments of the public because of advertising/promotion efforts by its spa outlet partners (since the Opponent does not engage in much direct advertising), as well as through media mentions and other means such as industry awards and accolades. However, I do not think that the evidence goes quite so far. My difficulty with the Opponent's evidence relating to advertising/promotion is that most of the documents related to events which were after the Relevant Date,²⁷ and the little that did relate to matters prior to the Relevant Date was rather limited. Additionally, while the Opponent did tender evidence of media mentions and industry awards and accolades relating to matters between 2013 and 2017,²⁸ what was missing was evidence which fleshed out the context by linking these mentions and awards back to potential customers and members of the trade in Singapore. Allow me to give some examples prior to the Relevant Date:

- a. In August 2013, Her World published an interview on its website. In it, celebrity spa therapist Cecilia Westberry (who operates a spa in Singapore featuring the Opponent's products and treatments) mentioned to the interviewer (from StraitsTimes.com) that she swears by "*French skincare brand Biologique Recherche's products*". However, it was unclear how many online "hits" the article received and out of those how many originated from IP addresses in Singapore. One might also ask: were the articles/advertorials also published in print, and if so: how many copies were sold in Singapore? These same issues were present in many of the other documents that the Opponent tendered in evidence.
- b. In July 2016, Singapore Yahoo News featured an article titled "Help! I've Fallen In Love with a Stupid-Expensive Cult-Favorite Exfoliator and I Can't Give It Up". The article had good things to say about the Opponent's Biologique Recherche P-50 Lotion. However, upon careful reading, the author was in fact based in New Zealand, and obtained the product—with the assistance of a friend—from Philadelphia. Perhaps the only connection it had with Singapore was that some in this country might have come across the article through Singapore Yahoo News, but even so the evidence was unclear in this regard.
- c. In June 2017, Singapore blog "Go4Glow" featured a glowing review of the Biologique Recherche P-50 Lotion. The author posted her conclusion that: "*In Singapore, a 150ml bottle costs around \$150. But to get the best skin of your life? Worth it*". Although this write up was relevant and helpful evidence, I could not tell from the documentary extract exhibited in evidence whether this blog (and this post specifically) had substantial reach in Singapore or not.

93 When viewed in totality, the Opponent's evidence showed that its products and treatments had been available in Singapore for a few years prior to the Relevant Date. The

²⁶ According to Delapalme' SD, there were 22 spa outlets in all that offered its treatments and they were located in various places around the island. However, it seems that this described the situation at the time the SD was made and there may have been fewer outlets at the Relevant Date.

²⁷ This observation applies to a large number, but not all, of the documents in Delapalme's SD at Exhibit PD-6.

²⁸ See, in particular, the documents in Delapalme's SD at Exhibits PD-7 and PD-8.

evidence also established that the Opponent had loyal customers in Singapore for its products (e.g. the “Biologique Recherche P-50 Lotion”) and also spa treatments involving the Opponent’s products. I am therefore satisfied that the mark was well known to the actual consumers of the Opponent’s products and related services in Singapore. This was not a situation where customers were purchasing goods or services without paying attention to the mark that was attached thereto (see *Amanresorts* at [153]). However, the Opponent’s share of the overall cosmetics/skincare and beauty treatments market in Singapore appeared to be quite small and therefore it would not be possible to find, on the basis of its clientele alone, that the Opponent’s Mark was well known to the relevant sector of the public in Singapore. More was required to show that the Opponent’s Mark was sufficiently well known to the sector.

94 As a practical matter, the market for cosmetics/skincare and beauty services in Singapore is not just large but it is also crowded in nature. We know this through common experience. And in such circumstances, sufficient advertising and promotion needs to be done for brands and trade marks in order to stand out and be known to and recognised by potential consumers and relevant members of the trade. In *Amanresorts* (at [153]) the Court of Appeal gave the example of ‘unsuccessful advertising’ “*thus leaving no imprint of the plaintiff’s trade mark on the target market*” as a situation where potential customers might not know of the plaintiff’s trade mark. To be clear, I am not saying that the evidence in this case falls into that category. All I am saying is that there was not enough evidence prior to the Relevant Date and whatever there was did not go far enough.

Conclusion: s 8(4)(b)(i) TMA

95 In summary, the evidence was on balance insufficient to show that the Opponent’s Mark was well known to the relevant sector in Singapore. Hence, the Opponent’s Mark did not qualify as a well known trade mark for the purposes of the s 8(4)(b)(i) TMA assessment. Consequently, the opposition on this ground fails. However, if I had found the Opponent’s Mark to be a well known trade mark, I would have allowed the opposition since my findings in respect of the other elements of this ground of opposition are in the Opponent’s favour.

Opposition under s 7(6) TMA

96 Section 7(6) TMA provides that a trade mark “*shall not be registered if or to the extent that the application is made in bad faith*”. The law is well settled. Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark. (*Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”) at [28].) An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence. A finding of bad faith needs to be distinctly proved and this will rarely be possible by a process of inference (*Valentino* at [30]).

97 The Opponent’s case was that the Applicant had failed to notify the Registrar that “*Recherche*” is a French word which means “research” or even “exquisite” or “rare”. It argued that there were two consequences that flowed from this failure: (a) the Application Mark is not in compliance with Rule 20(1) of the Trade Marks Rules (Cap 332, R 1, 2008 Rev Ed), which provides (among other things) that trade marks in a language other than English shall, unless the Registrar otherwise directs, be endorsed with a translation in English; and (b) if the

Registrar had known that “Recherché” means “research” or even “exquisite” or “rare”, it may have encountered a descriptiveness/non-distinctiveness objection by an Examiner.

98 With respect, I think that the Opponent’s case under this ground of opposition has no merit whatsoever. The Applicant’s counterargument, which I agree with, was there are words in English that are connected with words in other languages, e.g. French, and “Recherché” is one such example. The evidence clearly shows that “Recherché” originated from French. But, as the Applicant rightly pointed out, the fact that “Recherché” entered the English lexicon from the French language does not make it any less of an English word. Accordingly, I find that the Applicant had no obligation to inform the Registrar of the French meaning of the word, and thus did not act in bad faith in applying for the Application Mark. There is also no rule of law or practice which dictates that trade mark applicants are required to inform the Registrar of the meaning of obscure words in the English language. All things considered, there was nothing dishonest or commercially unacceptable about the Applicant’s actions (or inaction). Plain common sense dictates as much, and I need say no more.

Conclusion: s 7(6) TMA

99 For the reasons stated, the opposition under s 7(6) TMA is refused.

Opposition under s 7(1)(c) TMA

100 I come now to s 7(1)(c) TMA, which prohibits the registration of 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*”. For the record, the Opponent had initially pleaded s 7(1)(b) TMA as well (which prohibits the registration of trade marks which are devoid of any distinctive character) but decided to abandon the ground prior to the hearing in order to focus on s 7(1)(c) TMA.²⁹

101 In simple terms, the s 7(1)(c) TMA ground is meant to guard against signs which are descriptive in nature. The Opponent’s case under this ground was essentially that “Recherché” is descriptive in that it can mean “research” and since the cosmetics and skincare industry has a strong emphasis on research and development, words such as “Recherché” should be free for all traders to use in respect of Class 3 goods and related services in Class 44. In response, the Applicant argued that “Recherché” is inherently distinctive.

102 During the hearing, I invited counsel for the Opponent, Ms O’Connor, to explain the apparent inconsistency between its argument on the one hand that “Recherché” is descriptive in the Application Mark, with the argument on the other hand that “RECHERCHE” is the most distinctive and dominant element in the Opponent’s Mark for the purposes of the marks-similarity analysis under s 8(2)(b) TMA. Counsel’s submission was that there was in fact no inconsistency. As I understand it, the reason is that s 8(2)(b) TMA deals with confusion as between two potentially conflicting marks and this has no direct impact on the Registrar’s duty to ensure that descriptive words are not registered in contravention of s 7(1)(c) TMA.

²⁹ This was somewhat surprising since s 7(1)(c) is essentially a sub-set of s 7(1)(b) TMA: see *Marvelous AQL Inc* [2017] SGIPOS 3 citing *Han’s (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 at [59]. However, it is a party’s prerogative to run its case in any way it deems fit.

103 Various other arguments were raised on both sides, but it is not necessary to detail them all. The way I see it, the Opponent's case under s 7(1)(c) TMA cannot stand for one simple reason: as I have found earlier in the context of the s 8(2)(b) TMA analysis, average consumers in Singapore are not presumed to know French and would not know what the word means. Further and in any event, they would not recognise that "Recherché" is an English word either. A word that holds no meaning to average consumers would be inherently distinctive.

Conclusion: s 7(1)(c) TMA

104 I would therefore refuse the opposition under s 7(1)(c) TMA.

Outcome and costs

105 The Opponent has successfully established its case under ss 8(2)(b) and 8(7)(a) TMA.³⁰ However, there was insufficient basis for the grounds of opposition under ss 8(4)(b)(i), 7(1)(c) and 7(6) of TMA. Since the opposition succeeds if any one ground is established, registration of the Application Mark is refused. Having regard to all the circumstances, I award the Opponent 75% of its costs, to be taxed if not agreed.

Date of issue: 15 February 2021

³⁰ Although nothing turns on it, I note that on 12 May 2020, the Opponent succeeded in a parallel opposition in China against the Applicant's application to register "RECHERCHE" in Class 3: see the Opponent's further submissions (tendered by way of letter dated 19 November 2020).