

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

[2022] SGIPOS 5

Trade Mark Nos. 40201909817Y and 40201909820Q

IN THE MATTER OF A TRADE MARK APPLICATIONS BY

BIBA (ZHEJIANG) NURSING PRODUCTS CO., LTD

... Applicant

AND OPPOSITION THERETO BY

BEABA

... Opponent

GROUNDS OF DECISION

TABLE OF CONTENTS

| | |
|--|-----------|
| INTRODUCTION | 1 |
| BACKGROUND FACTS | 1 |
| GROUNDS OF OPPOSITION | 6 |
| OPPONENT’S EVIDENCE | 6 |
| APPLICANT’S EVIDENCE | 7 |
| APPLICABLE LAW AND BURDEN OF PROOF | 7 |
| GROUND OF OPPOSITION UNDER SECTION 8(2)(B) | 7 |
| APPLICABLE LEGAL PRINCIPLES: MARKS-SIMILARITY ASSESSMENT | 8 |
| THE DISTINCTIVENESS OF THE OPPONENT’S MARK..... | 9 |
| MARKS-SIMILARITY ASSESSMENT | 10 |
| GOODS-SIMILARITY ASSESSMENT | 11 |
| <i>Comparison with the Applicant’s Class 5 Goods</i> | 14 |
| <i>Comparison with the Applicant’s Class 16 Goods</i> | 15 |
| LIKELIHOOD OF CONFUSION (FOR THE CLASS 5 APPLICATION)..... | 17 |
| <i>My Findings</i> | 18 |
| CONCLUSION ON OPPOSITION UNDER SECTION 8(2)(B) | 19 |
| GROUND OF OPPOSITION UNDER SECTION 8(7)(A) | 19 |
| CONCLUSION ON OPPOSITION UNDER SECTION 8(7)(A) | 22 |
| GROUND OF OPPOSITION UNDER SECTION 8(4)(B)(I) | 23 |
| CONCLUSION ON OPPOSITION UNDER SECTION 8(4)(B)(I)..... | 32 |

| | |
|--|-----------|
| GROUND OF OPPOSITION UNDER SECTION 7(6) | 32 |
| CONCLUSION ON OPPOSITION UNDER SECTION 7(6) | 38 |
| GROUNDS OF OPPOSITION UNDER SECTION 7(4)(A) AND (B) | 38 |
| CONCLUSION ON OPPOSITION UNDER 7(4)(A) AND (B)..... | 40 |
| GROUND OF OPPOSITION UNDER SECTION 8(7)(B) | 40 |
| CONCLUSION ON OPPOSITION UNDER SECTION 8(7)(B) | 44 |
| OVERALL CONCLUSION..... | 44 |
| COSTS | 45 |

BEABA
v
Biba (Zhejiang) Nursing Products Co., Ltd

[2022] SGIPOS 5

Trade Mark Nos. 40201909817Y and 40201909820Q
Principal Assistant Registrar Tan Mei Lin
13 December 2021

14 March 2022

Principal Assistant Registrar Tan Mei Lin:

Introduction

1 This matter involves two trade mark opposition actions that have been consolidated as the parties are the same and the trade marks concerned are the same.

Background facts

2 On 6 May 2019, Biba (Zhejiang) Nursing Products Co., (“**the Applicant**”) lodged two separate applications to register **BEABA** (“**the Application Mark**”) in Classes 5 and 16. Details of the applications are as follows:

| Trade Mark No. | Class | Specification |
|--|--------------|---|
| 40201909817Y (“ Class 5 Application ”) | 5 | Lacteal flour for babies; food for babies; nutritional supplements; infant formula; powdered milk for babies; sanitary towels; diapers for incontinence; babies' diaper-pants; adult diapers; diapers for pets; linseed oil dietary supplements; medicines for human purposes; porcelain for dental prostheses; |

| | | |
|---|----|--|
| | | veterinary preparations; panty liners [sanitary]; insecticidal animal shampoos; adjuvants for medical purposes; cotton for medical purposes; drugs for medical purposes; pants, absorbent, for incontinence. (“Applicant’s Class 5 Goods”) |
| 40201909820Q (“Class 16 Application”) | 16 | Paper; towels of paper; advertisement boards of paper or cardboard; note books; magazines [periodicals]; pictures; wrapping paper; stationery; stamps [seals]; steel pens; writing instruments; writing or drawing books; page holders; books; pads [stationery]; envelopes [stationery]; printing blocks; drawing rulers; envelope sealing machines for offices; toilet paper. (“Applicant’s Class 16 Goods”) |

3 Goods bearing the Application Mark have been sold in Singapore since 2020.

4 BEABA (“**the Opponent**”) is a French company established in 1989 by its French founder, an entrepreneur by the name of Mr Jean Louis Berchet. It was also in 1989 that the Opponent’s iconic and best-selling line of baby food-making product under the BABYCOOK® sub-brand was created. The Opponent’s products are available in nearly 70 countries with more than 260 childhood care-related products.

5 The Opponent is the registered proprietor in Singapore of the trade mark “BEABA” (“**the Opponent’s Mark**”), under Trade Mark No. 40201401833P (“**the Opponent’s Registered Trade Mark**”) covering the following goods:

| Class | Opponent’s Registered Goods | Registration Date |
|--------------|--|--------------------------|
| 7 | Electromechanical kitchen apparatus; electromechanical food preparation machines; food | 7 August 2014 |

| | |
|----|--|
| | mixers; electric food blenders; electric fruit presses for household use; electric food processors. |
| 9 | Weighing apparatus and instruments (scales and food scales); thermometers not for medical use; sunglasses; electric visual and/or sound monitoring apparatus; covers for electric outlets; safety harnesses for children (other than for vehicle seats or sports equipment); nets for protection against accidents; light dimmers (regulators). |
| 10 | Surgical, medical, dental and veterinary apparatus and instruments; apparatus and instruments for the treatment of babies; apparatus and instruments for babies namely, feeding bottles, incubators and teats; feeding bottles; feeding bottle teats; feeding bottle valves; babies' pacifiers [teats]; thermometers for medical use; teething rings. |
| 11 | Apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating; apparatus and utensils for heating and cooking by electricity; plate warmers; stoves; electric feeding bottle warmers; electric baby food jar warmers; electric apparatus for heat conditioning; sterilizers for bottles and breastfeeding equipment; lighting apparatus; nightlights. |
| 20 | Furniture; mirrors; display frames and mirror frames; baby changing tables; seats for children; booster seats for children for feeding (furniture), not for use in vehicles; high chairs for children; baby bouncers; infant walkers; cradles; umbrella beds (furniture); playpens for babies; mats for infant playpens; toy chests; baskets of wicker; hooks, not of metal, for clothes rails; clothes hangers and covers; mobiles for decoration; cushions; packaging containers of plastic. |
| 21 | Non-electric household or kitchen utensils and containers (neither of precious metal, nor coated therewith); non-electric cooking utensils; table plates; glasses; bowls; cups; egg cups; non-electric feeding bottle warmers; baby food jar warmers (non-electric); refrigerating containers (not electric or gas powered); insulated containers, bags, small bags and pouches for food or beverages, for household use; |

| | | |
|--|---|--|
| | microwave containers; feeding bottle drainers; hand-held shakers; brushes for cleaning feeding bottles; combs, sponges and brushes (except paint brushes); articles for cleaning purposes; potties for babies; portable baby baths; trash cans; babies' diaper disposal bins; toilet cases; hair brushes; toilet sponges, toothbrushes; flasks; perfume vaporizers; soap boxes; cotton bud boxes for household use; powder boxes. | |
|--|---|--|

6 The Opponent's products have been available in Singapore since 2009.

In actual use, the Opponent's mark appears as **BÉABA** ("the Opponent's **Stylised Mark**").

7 The Opponent's Mark and/or its related trade marks (such as 芭亚芭 (BEABA in Chinese characters) and **BÉABA**) are registered in China, Australia, Algeria, Egypt, France, Germany, Hong Kong, Iran, Israel, India, Indonesia, Japan, Korea, Malaysia, Mexico, Morocco, Monaco, Norway, the Philippines, Singapore, Tunisia, Turkey, Ukraine, the United States and Vietnam, amongst others.

8 Finally, the Applicant (including its related companies/affiliates) and the Opponent are familiar with each other, having been engaged in disputes over their respective marks in several other jurisdictions, such as those set out below.

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| No. | Jurisdiction | Details |
|-----|--------------|---|
| 1. | Australia | Biba (Zhejiang) Care Products Co., Ltd. attempted to file the BEABA marks in Classes 16, 24 and 25 in 2019. The Opponent filed an opposition against the marks in early 2020. Biba (Zhejiang) Care Products Co., Ltd.'s BEABA mark applications then <u>lapsed</u> as it failed to file the Notices of Intention to Defend. |
| 2. | Indonesia | The Opponent opposed against Biba (Zhejiang) Care Products Co., Ltd.'s BEABA marks filed in Classes 5 (No. DID2019034400), 12 (No. DID2019034401) and 16 (No. DID2019034402). A refusal decision for Biba (Zhejiang) Care Products Co., Ltd.'s Class 12 mark is issued, whilst the decisions for Class 5 and 16 marks are pending. |
| 3. | Russia | The Opponent filed an observation against Biba (Zhejiang) Care Products Co., Ltd.'s BEABA mark (No. 2019745401) on 16 January 2020. As Biba (Zhejiang) Care Products Co., Ltd. did not file any reply, a refusal decision was issued on 12 November 2020. |
| 4. | Mexico | Biba (Zhejiang) Care Products Co., Ltd attempted to file the BEABA marks in Class 5 (Nos. 2263638, 2264939). The Opponent filed observations, and decisions of refusal for Biba (Zhejiang) Care Products Co., Ltd.'s BEABA marks were issued. |
| 5. | Vietnam | The Opponent filed an opposition against Biba (Zhejiang) Care Products Co., Ltd.'s BEABA mark in Classes 3, 5, 16 and 21 (No. 4-2019-19628) in December 2019. The proceedings are currently pending. |
| 6. | Italy | The Opponent filed oppositions against Biba (Zhejiang) Care Products Co., Ltd.'s BEABA (No. 302019000036249) and BEABA (No. 302019000036258) marks in 2020. The proceedings are currently pending. |
| 7. | China | The Opponent filed an invalidation proceeding against Shanghai Jie Qiao Industry Co., Ltd.'s BEABA mark in Class 5 (Mark No. 12315473) in China, and was successful where the Trade Marks Registry issued an invalidation decision for the same mark. The Opponent separately filed BEABA Marks in Class 5 in China as well. |

Grounds of opposition

9 The Opponent relies on Sections 8(2)(b), 8(4)(b)(i), 8(7)(a) and 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**the Act**”) in its opposition to the Class 5 Application and the Class 16 Application.

10 Additionally, the Opponent relies on Sections 7(4)(a) and (b) of the Act in its opposition to the Class 5 Application and Section 8(7)(b) of the Act in its opposition to the Class 16 Application.

Opponent’s evidence

Class 5 Application

11 The Opponent’s evidence in the opposition to the Class 5 Application comprises:

- (a) a Statutory Declaration made by Bruno Rochette de Lempdes, General Secretary of the Opponent, on 19 October 20202 (“Class 5 BRDL SD”); and
- (b) a Statutory Declaration in reply made by the same Bruno Rochette de Lempdes on 13 July 2021.

Class 16 Application

12 The Opponent’s evidence in the opposition to the Class 16 Application comprises:

- (a) a Statutory Declaration made by the same Bruno Rochette de Lempdes on 19 October 20202; and
- (b) a Statutory Declaration in reply made by the same Bruno Rochette de Lempdes on 11 May 2021.

Applicant's evidence

Class 5 Application

13 The Applicant's evidence in the opposition to the Class 5 Application comprises a Statutory Declaration made by Zhang Dong, President of the Applicant, on 15 April 2021.

Class 16 Application

14 The Applicant's evidence in the opposition to the Class 16 Application comprises:

- (a) a Statutory Declaration made by the same Zhang Dong on 15 March 2021;
- (b) a Statutory Declaration made by Mara Scaglione on 30 June 2021; and
- (c) a Statutory Declaration made by Tam Kin Man on 1 July 2021.

Applicable law and burden of proof

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

Ground of Opposition under Section 8(2)(b)

16 Section 8(2)(b) of the Act reads:

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

...

(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.

Applicable legal principles: Marks-similarity assessment

17 In assessing the marks for similarity, the applicable principles can be summarised as follows:

(a) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) at [20].)

(b) The marks are to be compared “as a whole” (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(b)]). When speaking of the assessment of a mark as a whole, the similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. (*Staywell* at [23], [26].)

(c) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry.

(d) Integrated into the analysis of visual, aural and conceptual similarity is a consideration of whether the earlier mark is distinctive (in both its technical and non-technical sense (*Staywell* at [30])). In the non-technical sense, distinctiveness refers to “what is outstanding and memorable about the mark”. Such components tend to draw the average consumer’s attention and stand out in the average consumer’s imperfect recollection. (*Staywell* at [23]).

(e) In the technical sense, distinctiveness ordinarily refers to a mark's inherent capacity (i.e., relating to a mark's fanciful or descriptive nature) or acquired capacity (i.e., based on the duration and nature of the use of the mark) to operate as a badge of origin (*Hai Tong* at [31]–[33]). A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it. (*Staywell* at [25]).

(f) When assessing two contesting marks, it should be borne in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side or examined in detail for the sake of isolating particular points of difference because the person who is confused often makes a comparison from memory removed in time and space from the marks. (*Hai Tong* at [40(d)], [62(a)]). Ultimately, the matter is one of “the general impression that will likely be left by the essential or dominant features of the marks on the average consumer.”

The distinctiveness of the Opponent's Mark

18 I am mindful of the Court of Appeal's guidance in *Staywell* at [30] that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar, and it is not a separate step within the marks-similarity inquiry. However, following the approach of the Court of Appeal in *Hai Tong* at [26], for the purpose of elucidating the analytical process, I will highlight it here as a separate step first before applying my findings within the context of the marks-similarity analysis.

19 I find that the Opponent's Mark, being an invented word, has a high degree of technical distinctiveness. Consequently, it enjoys a high threshold before a competing sign will be considered dissimilar to it.

Marks-similarity assessment

20 The marks under comparison are reproduced below for ease of reference.

| Application Mark | Opponent's Mark |
|------------------|-----------------|
| BEABA | BEABA |

21 Visually, the marks concerned consist of one word each and each word has five capitalised letters. The letters used are identical and they appear in the same order. Although the fonts are different, the Opponent's Mark is registered in plain block capitals. This means that protection is granted to the word itself irrespective of font, typeface or design (*Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA 56 (“*Sarika*”) at [24]). Therefore, this fact does not render the marks visually different. I find that the marks have a very high degree of similarity.

22 Aurally, the marks are identical as they have identical spelling.

23 Conceptually, the marks are also identical as whatever concept that is evoked by the Opponent's Mark would be evoked by the Application Mark. As mentioned above, the difference in font is irrelevant.

Conclusion on marks-similarity assessment

24 I have found that the Application Mark and Opponent's Mark are visually similar to a high degree, and aurally and conceptually identical.

Overall, the marks are more similar than dissimilar and the degree of similarity is very high.

Goods-similarity assessment

25 The second step is to compare the goods for which registration is sought as against the goods for which the Opponent’s Mark is registered.

26 It is undisputed that in assessing the similarity of goods and services, I should have regard to the factors, or guidelines, set out in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“**British Sugar**”) at 296. They are as follows:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- (f) the extent to which the respective goods or services are competitive, including how the trade classifies them.

27 It is pertinent to note that there is no requirement that all factors in ***British Sugar*** must be satisfied before goods can be treated as “similar”. As

explained in *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2006] SGHC 241; [2007] 1 SLR(R) 1082 at [18]:

... In any case, Jacob J's factors in *British Sugar* ([14]; *supra*) must not be regarded as requirements that must all be satisfied before the goods can be treated as similar.

28 For ease of comparison, the goods claimed under the Opponent's Mark and the Application Mark are set out below:

| Applicant's Goods | Opponent's Registered Goods |
|---|---|
| <p>Class 5: Lacteal flour for babies; food for babies; nutritional supplements; infant formula; powdered milk for babies; sanitary towels; diapers for incontinence; babies' diaper-pants; adult diapers; diapers for pets; linseed oil dietary supplements; medicines for human purposes; porcelain for dental prostheses; veterinary preparations; panty liners [sanitary]; insecticidal animal shampoos; adjuvants for medical purposes; cotton for medical purposes; drugs for medical purposes; pants, absorbent, for incontinence.</p> <p>Class 16: Paper; towels of paper; advertisement boards of paper or cardboard; note books; magazines [periodicals]; pictures; wrapping paper; stationery; stamps [seals]; steel pens; writing instruments; writing or drawing books; page holders; books; pads [stationery]; envelopes [stationery]; printing blocks; drawing rulers; envelope</p> | <p>Class 7: Electromechanical kitchen apparatus; electromechanical food preparation machines; food mixers; electric food blenders; electric fruit presses for household use; electric food processors.</p> <p>Class 9: Weighing apparatus and instruments (scales and food scales); thermometers not for medical use; sunglasses; electric visual and/or sound monitoring apparatus; covers for electric outlets; safety harnesses for children (other than for vehicle seats or sports equipment); nets for protection against accidents; light dimmers (regulators).</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments; apparatus and instruments for the treatment of babies; apparatus and instruments for babies namely, feeding bottles, incubators and teats; feeding</p> |

| | |
|--|--|
| <p>sealing machines for offices; toilet paper.</p> | <p>bottles; feeding bottle teats; feeding bottle valves; babies' pacifiers [teats]; thermometers for medical use; teething rings.</p> <p>Class 11: Apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating; apparatus and utensils for heating and cooking by electricity; plate warmers; stoves; electric feeding bottle warmers; electric baby food jar warmers; electric apparatus for heat conditioning; sterilizers for bottles and breastfeeding equipment; lighting apparatus; nightlights.</p> <p>Class 20: Furniture; mirrors; display frames and mirror frames; baby changing tables; seats for children; booster seats for children for feeding (furniture), not for use in vehicles; high chairs for children; baby bouncers; infant walkers; cradles; umbrella beds (furniture); playpens for babies; mats for infant playpens; toy chests; baskets of wicker; hooks, not of metal, for clothes rails; clothes hangers and covers; mobiles for decoration; cushions; packaging containers of plastic.</p> <p>Class 21: Non-electric household or kitchen utensils and containers (neither of precious metal, nor coated therewith); non-electric cooking utensils; table plates; glasses; bowls; cups; egg cups; non-electric feeding bottle warmers; baby food jar</p> |
|--|--|

| | |
|--|--|
| | warmers (non-electric); refrigerating containers (not electric or gas powered); insulated containers, bags, small bags and pouches for food or beverages, for household use; microwave containers; feeding bottle drainers; hand-held shakers; brushes for cleaning feeding bottles; combs, sponges and brushes (except paint brushes); articles for cleaning purposes; <i>potties for babies</i> ; portable baby baths; trash cans; babies' diaper disposal bins; toilet cases; hair brushes; toilet sponges, toothbrushes; flasks; perfume vaporizers; soap boxes; cotton bud boxes for household use; powder boxes. |
|--|--|

Comparison with the Applicant's Class 5 Goods

29 In submitting its case on goods-similarity, the Opponent relied primarily on the goods which are shown in bold in the table above. However, for these purposes I will further confine my analysis to the comparison between the Applicant's "babies' diaper-pants" (Class 5) and the Opponent's "potties for babies" (Class 21). This is because so long as *any* of the respective goods are identical or similar, the enquiry can proceed to the third step: likelihood of confusion.

30 Uses: babies' diaper-pants and baby potties serve the same purpose – to contain human waste.

31 Users: the users are the same, namely, parents or caregivers of babies.

32 Physical nature of the goods: the physical nature of the goods is different as one is to be worn whereas the other cannot.

33 Trade channels: The trade channel for the respective goods overlap as the goods are found in the children's section of department stores or in retail stores which specialises in baby and child products.

34 Whether they are likely to be found in supermarkets on the same or different shelves: In view that the goods serve the same purpose, I am satisfied that they are likely to be found on shelves which are in close proximity even if they are not found on the same shelves¹.

35 Whether the goods are competitive: In so far as babies' diaper pants and baby potties are to be used at home, the goods are competitive as they serve a similar purpose.

36 Having regard to the above factors, I find that the goods are more similar than dissimilar and the degree of similarity is moderate.

Comparison with the Applicant's Class 16 Goods

37 The Opponent's submission in respect of the Applicant's Class 16 Goods is as follows.

As for the Applicant's specification of goods in Class 16, we submit that these are essentially stationeries and advertising materials which can be used to promote, advertise or used in conjunction with the Opponent's Registered Goods and as such the goods are similar as they have the same end uses and end users.

¹ Page 179 of CI 5 BRDL SD shows baby diaper products being sold in close proximity to the Opponent's products which are used for feeding of babies and children.

38 I am unable to agree with the Opponent. It cannot be said that just because the Applicant’s “advertisement boards of paper or cardboard” may be used to advertise any good/service, all goods and services are consequently similar to the Applicant’s “advertisement boards of paper or cardboard”. Such an approach does not take into account how the goods in question are regarded for the purposes of trade.

39 In my view, none of the Applicant’s Class 16 Goods can be said to be similar to any of the Opponent’s Registered Goods in Classes 7, 9, 10, 11, 20 or 21. Since the Opponent focussed its submissions on its goods which are “essentially stationeries and advertising materials”, I will do the same.

40 The uses and the nature of the goods are different. Whilst there may be an overlap in users and trade channels, the respective goods are clearly not competitive or complementary. Overall, in my view, the goods are more dissimilar than similar.

41 As for the Opponent’s submission that it also uses its mark on books, I do not consider this here² as the Opponent’s Registered Goods do not include “books”. The comparison I have to make is between the specification of goods in respect of which the Application Mark is applied for and the specification of goods in the Opponent’s Registered Trade Mark. I must not, and do not, consider any actual use of either or both marks in question (see Court of Appeal in *Sarika* at [47], whilst bearing in mind that that case involved an infringement under Section 27 rather than an opposition under Section 8).

² I will however consider it under the ground of passing off under Section 8(7)(a).

Conclusion on goods-similarity assessment

42 I have found that there is goods-similarity between the Applicant’s Class 5 Goods and the Opponent’s Registered Goods but there is no goods-similarity between the Applicant’s Class 16 Goods and the Opponent’s Registered Goods.

43 Having regard to the 3-step test, my conclusion ends the analysis with regard to the Class 16 Application, and the opposition to this application under Section 8(2)(b) fails. The rest of the discussion will focus on the Class 5 Application.

Likelihood of Confusion (for the Class 5 Application)

44 I now proceed to consider whether there is a likelihood of confusion as a result of the similarities in the respective parties’ marks and goods.

45 In *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”) at [56] the Court of Appeal explained:

The likelihood of confusion inquiry directs the court to look at (a) how similar the marks are; (b) how similar the goods or services are; and (c) given this, how likely it is that the relevant segment of the public will be confused (*Staywell* at [55]). In opposition proceedings, the inquiry takes into account the actual and notional fair uses of both the existing and the application mark (*Staywell* at [60]).

46 At this stage, the following factors relating to consumer perception may be taken into account (*Staywell* at [96(a) and (b)]):

(a) Factors that affect the impact of mark similarity on the consumer: the degree of similarity of the marks themselves, the reputation of the marks, the impression given by the marks and the possibility of imperfect recollection;

(b) Factors that affect the impact of goods similarity on the consumer: these include the normal way in or the circumstances under which consumers would purchase goods of that type, whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of attention on the part of the purchaser, and the likely characteristics of the relevant consumer and whether the relevant consumers would or would not tend to apply care or have specialist knowledge in making the purchase.

My Findings

47 I have concluded above that the marks are similar to a high degree (aurally and conceptually identical and visually similar to a high degree). This points strongly towards a likelihood of confusion on the part of consumers.

48 As for impression of the marks, both parties' marks have only the word "BEABA" and the word is likely to dominate consumers' impression of them. The consumer is thus very likely to be confused into thinking that goods labelled with the Application Mark emanate from the Opponent or from an economically linked undertaking.

49 Moving on to the impact of goods-similarity on consumer perception, I have concluded earlier that both sets of goods may be offered for sale and sold by the same sellers, they may be viewed and chosen for purchase by the same purchasers on the same occasion in the same place. I consider that these point to a likelihood of confusion as consumers tend to believe the origin of the goods to be the same if they are both sold in the same specialised shops and on shelves which are in close proximity of each other.

50 The Applicant submits that there would not be a likelihood of confusion as the goods are not inexpensive and the average consumer would exercise care and great caution when purchasing goods meant for children. Even if I agree with the Applicant that a higher degree of attention would be paid (which I do not), I find that given the high degree of similarity between the marks, coupled with imperfect recollection in consumers, it would be virtually impossible for consumers to be able to differentiate between the competing marks, even if great care is exercised.

51 I therefore find there is a likelihood of confusion that the marks are one and the same or emanate from economically linked undertakings.

Conclusion on opposition under Section 8(2)(b)

52 The ground of opposition under Section 8(2)(b) therefore succeeds in relation to the Class 5 Application, but fails in relation to the Class 16 Application.

Ground of Opposition under Section 8(7)(a)

53 Section 8(7)(a) of the Act reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of 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...

54 The three elements of passing off are (a) goodwill, (b) misrepresentation, and (c) damage to goodwill: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [37] and affirmed in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) at [28].

Goodwill

55 It is not in dispute that the Opponent has acquired goodwill in its business in Singapore.

Misrepresentation

56 Under this element, the Opponent must show that the use of the Application Mark, in a normal and fair manner in respect of the goods for which registration is sought, amounts to a misrepresentation. The misrepresentation (whether intentional or not) must be such that it would lead or be likely to lead the public into believing that the goods (in respect of which registration is sought) are the goods of the Opponent or from a commercially related trade source.

57 The Court of Appeal in *The Singapore Professional Golfers' Association v Chen Eng Waye and others* [2013] SGCA 18 provided a helpful summary of misrepresentation at [20] as follows:

... It will then be necessary to consider, amongst other factors, whether there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant's goods or services are, or emanate from a source that is linked to, the claimant's...

58 Distinctiveness is a threshold inquiry in the context of determining whether an actionable misrepresentation has taken place (*Singsung* at [38]). The distinctiveness of the Opposition Mark and the Opponent's Stylised Mark is not in dispute. What is in dispute is whether the Application Mark misrepresents to the relevant public that its goods are those of, or are related to or associated with the Opponent.

59 Above, in the context the ground under Section 8(2)(b) of the Act for the Class 5 Application, I found that: (a) the marks are similar to a very high degree; (b) the Applicant's "babies' diaper-pants" and the Opponent's "potties for babies" are similar to a moderate degree; and (c) there exists a likelihood of confusion. For substantially the same reasons, I also find that Application Mark communicates and misrepresents to average consumers that the goods offered under it are that of, or commercially connected to, the Opponent.

60 As for the Class 16 Application, my finding earlier in the context of Section 8(2)(b) was that there was no goods-similarity and I consequently did not move on to consider the likelihood of confusion. I will do so here.

61 I have found above that: (1) the Opponent's Mark has a high level of technical distinctiveness; and (2) there is a high degree of similarity between the Application Mark and the Opponent's Mark. Consequently, consumers are very likely to recognise the similarities between the marks and to recall the Opponent's Mark when they see the Application Mark. They might even be caused to wonder whether the Applicant's goods emanate from the Opponent or an economically linked undertaking. However, given the dissimilarities between the parties' goods (the Applicant's goods are "*essentially stationeries and advertising materials*" and the Opponent's Registered Goods are baby care products), I do not think that consumers would react to the Application Mark with an expectation that goods offered them have an economic connection with the Opponent. As said by the Court of Appeal in *Hai Tong* at [75]:

... "mere association" by the relevant segment of the public of the earlier registered mark with the later allegedly infringing sign based on their similar use is not *in itself* a sufficient basis for concluding that there is a likelihood of confusion in the absence of any possibility of misapprehension as to the *origin* of the goods or services concerned...

62 The opposition under this ground also requires me to consider the Opponent’s claim that it has used its marks in relation to books³ which I was not permitted to do under Section 8(2)(b). Nonetheless, having examined the Opponent’s evidence on this, I find that the evidence of its use on books is extremely weak, consisting only of a few undated photographs that its books are available on Amazon.sg. As a result, I am unable to determine whether the books were sold by the Opponent prior to the Relevant Date.

63 The opposition in relation to the Class 16 Application therefore fails and I will proceed to consider whether the element of damage is made out in relation to the Class 5 Application only.

Damage (for Class 5 Application)

64 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) blurring (see *Amanresorts* at [97]) since both sides are in direct competition for some of their goods (the Opponent’s “potties for babies” in Class 21 and the Applicant’s “babies’ diaper-pants” in Class 5); 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 in Class 5.

Conclusion on opposition under Section 8(7)(a)

65 The opposition under Section 8(7)(a) succeeds in relation to the Class 5 Application but fails in relation to the Class 16 Application.

³ The Applicant has also claimed “books” in its Class 16 Application.

Ground of Opposition under Section 8(4)(b)(i)

66 Section 8(4)(b)(i) of the Act reads:

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

- (a) the earlier trade mark is well known in Singapore; and
- (b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark...

Decision on Section 8(4)(b)(i)

67 Under this ground, the Opponent has the burden of establishing the following:

- (a) The Application Mark is identical with or similar to the Opponent’s mark;
- (b) The Opponent’s Mark is well known in Singapore;
- (c) Use of the Application Mark in relation to the goods claimed would indicate a connection with the Opponent; and
- (d) Use of the Application Mark is likely to damage the Opponent’s interests.

Similarity of Marks

68 In relation to this ground, the first element that must be satisfied is that "the whole or an essential part of the trade mark" must be "identical with or

similar to an earlier trade mark". This element is essentially the same as the element of marks-similarity under Section 8(2)(b).⁴ Thus, my conclusion in relation to this is the same as that for the ground under Section 8(2)(b) above. The Application Mark is overall more similar than dissimilar in comparison to the Opponent's Mark.

Well-known in Singapore

69 The critical question here is whether the Opponent's Mark is well known in Singapore at the relevant date of 6 May 2019, which is the date of application of the Application Mark ("**the Relevant Date**").

70 The definition of a well known trade mark is provided in Section 2 of the Act:

2.—(1) In this Act, unless the context otherwise requires —

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore;

71 Section 2(7), (8) and (9) of the Act elaborate on the matters to consider in determining if a mark is “well known in Singapore”. Section 2(7) of the Act states:

⁴ See *Sarika* at [70] and [71].

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.

Section 2(8) of the Act reads:

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.

Section 2(9) of the Act states:

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.

72 These provisions have been the subject of further exposition by the Courts:

Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because section 2(8) of the Act *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore. (*Amanresorts* at [139]).

(A) Aside from section 2(7)(a) of the Act, the court is ordinarily free to disregard any or all of the factors listed in section 2(7) as the case requires and to take additional factors into consideration. (*Amanresorts* at [137]).

(B) In relation to section 2(8) of the Act, the Court of Appeal in *Caesarstone* clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore⁵...

[102] We do not think that this comment in *Amanresorts* was made to lay down a general principle...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.*

[Emphasis in italics mine]

⁵ The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “*any* relevant sector of the public in Singapore” which could in certain cases be *miniscule* ([229] *Amanresorts*).

(C) Last but not least, with regard to the ambit of section 2(9)(a), the inquiry is into the specific goods or services to which the opponent's trade mark has been applied. (*Amanresorts* at [152])).

73 Having reviewed the evidence carefully, I am satisfied that the Opponent's Mark is well known in Singapore to the actual and potential consumers of baby food blenders and other childcare and baby-related products.

74 The Opponent's brand has been and continues to be established in nearly 70 countries with more than 260 products. In Singapore, the Opponent has been distributing, selling, promoting and exporting goods bearing the Opponent's Mark since 2009, a period of 11 years before the Relevant Date.

75 The Opponent's products are available in Singapore via multiple avenues including physical retail stores (such as Tangs, OG, Mothercare, Mothers Work, First Few Years, Takashimaya, Kiddy Palace, Thomson Medical Centre and Bove) and online stores (such as Pupsik Studio, Krissshop, Shopee Singapore, Lazada Singapore and Amazon Singapore). These are some examples of advertisements showing the type of products available at some of the stores mentioned above.

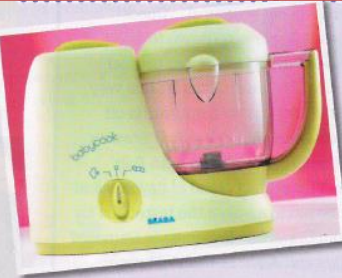
A Mother's Touch

Show your precious baby the tender loving care that she deserves by using Mother's Touch Deluxe Baby Bather from Summer Infant. Designed to suit your growing infant's needs, the bather has a large frame and soft mesh sling seat to ensure your little one's comfort and safety at all times. It also comes with a removable deluxe head support for that added stability, as well as a quick drying, foldable fabric that can be used in both bathtubs and undivided sinks. This product is available at M&B, all major department stores, and baby specialty shops.

Hold It Right

Get your child raring to get to the drawing board (literally!), with the GROOVE, an award winning brand of colour pencils specially designed to allow your children's fingers to automatically seek out the strategically placed grooves on them. This encourages intuitive and ergonomically correct positioning of the fingers when drawing and writing. And in case you were wondering, the grooves on this unique product are specially placed so that they are not lost even after the pencil has been re-sharpened. It's tough, colour intense lead also enables your little one to write or draw boldly, thus expressing himself freely. GROOVE is now being displayed at the Red Dot Museum of Singapore. For more information, visit www.lyra-groove.de

motherhood | February 2010



Yummy For His Tummy

Preparing your little munchkin's meals is now a breeze with the Beaba Babycook steamer-cooker-blender, which does all the work for all you busy mums. This fantastic easy to clean product can help you to steam, blend de-frost and even re-heat

your baby's food, at the same time preserving it's vitamins. It can hold up to 600ml of food and also comes with a spatula for removing the basket and scraping the bowl. Quick, efficient and reliable, it can take just 15 minutes to prepare the yummiest meals that your darling deserves! BabyCook costs \$289 and can be purchased at Mothers Work Baby (Great World City), Mothers Work Kids (Tanglin Mall), Takashimaya Nursery Level 3 and Thomson Medical Centre's ParentCraft Shop.

Go Organic

Enjoy all the goodness that nature has to offer with Bentley Organic products. Certified by the UK Soil Association, the products in this line are not tested on animals and do not contain ingredients of animal origin, are paraben-free, GMO-free and do not contain SLS or any petro-chemicals, making them sensitive on your baby's skin. Some of the fabulous products in this range include the Bentley Organic Toy Sanitizer, Baby Wash, Baby Lotion and Baby Lotion, all containing organic ingredients. They are available at SuperNature, 21 Orchard Boulevard, #01-21/23/ 27 Park House, S (248645). Tel: (65) 6304 1338



www.motherhood.com.sg



BEABA BABYBOOST BOOSTER SEAT

This seat combines convenience and style. It comes with a curved backrest and removable foam cushion for your sweetie's comfort. You'll also love that it's a breeze to clean – the foam doesn't soak up messes. The removable table (not shown), however, is small and doesn't come with a shoulder strap. The seat is 27cm wide and weighs 1.7kg. It's recommended for babies from 12 months old.

YP'S VERDICT One of the most expensive models on the market, it boasts designer looks and will appeal to style-conscious parents looking for something that blends with their modern home decor. You can choose from two colour combos: white and green, as well as dark grey and beige.

GET IT \$135, from retailers including Motherswork and OG



76 The Opponent's sales turnover figures and advertising expenditure figures (see below) in Singapore do not appear to be very significant but an assessment of the renown of a trade mark goes beyond mere examination of sales and advertising as is clear from Section 2(7) of the Act.

Breakdown of sales figures (totalling SG\$2,753,000 over a span of 11 years):

| Year | Amount (in SGD) |
|------|-----------------|
| 2009 | 55,000 |
| 2010 | 179,000 |
| 2011 | 200,000 |
| 2012 | 210,000 |
| 2013 | 228,000 |
| 2014 | 242,000 |
| 2015 | 255,000 |
| 2016 | 263,000 |
| 2017 | 281,000 |
| 2018 | 360,000 |
| 2019 | 480,000 |

Breakdown of advertising expenditure figures (totalling SG\$67,927 over a period of 4 years):

| Year | Amount (in SGD) |
|------|-----------------|
| 2016 | 19,427 |
| 2017 | 24,709 |
| 2018 | 7,971 |
| 2019 | 15,820 |

77 The Opponent's products have been promoted in Singapore in the following ways:

(a) Advertisements in Young Parents magazine in the following issues: January 2012, March 2012, March 2013, June 2013, September 2013, October 2013, December 2013, February 2014, May 2014, June 2014, July 2014, August 2014, September 2014, January 2015 and February 2016;

- (b) Advertisements in Singapore Motherhood magazine in the following issues: February 2010, June 2010, April 2014, June 2014 and November 2014;
- (c) Sponsorships of workshops for mothers (e.g. “Bove Journey Workshop for Postnatal Heal and Wellness” held in October 2017);
- (d) Promotional events by “influencers” in Singapore (e.g. “BEABA & Mothercare Babycook Neo Launch” event held in March 2019);
- (e) Participation in baby fairs (Takashimaya Baby Fair 2011, 2012, 2013 and 2014), and other B2B and B2C events.

78 Based on the above, I am satisfied that the Opponent’s Mark is well known to actual and potential consumers of baby food blenders and other childcare and baby-related products.

Indicate a connection between the Applicant’s goods with the Opponent

79 This element is satisfied so long as there is a likelihood of confusion. The Court of Appeal in *Staywell* at [120] said:

...As for the third element, the detailed analysis in *Amanresorts* ([105] supra) has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion (see *Amanresorts* at [226] and [233])...

80 I found above at [51], in relation to the Class 5 Application, that there exists a likelihood of confusion on the part of the public. For the same reasons, I find this element to be satisfied here as well for the Class 5 Application.

81 As for the Class 16 Application, I found above at [61]-[62] that there is no likelihood of confusion and for the same reasons I find that this element is not satisfied here as well. The Class 16 opposition therefore fails.

82 I will proceed to the next stage of the enquiry for the Class 5 Application.

Likely to damage the interests of the proprietor (for the Class 5 Application)

83 The heads of damage that are recognised under Section 8(4)(b)(i) of the Act are essentially the same as those for the element of damage under the tort of passing off.

84 I have found the element of damage under the passing off ground to be made out in respect of the proposed use of the Application Mark. In the circumstances, I find that there would be a likelihood of damage to the Opponent's goodwill.

Conclusion on opposition under Section 8(4)(b)(i)

85 In light of the findings that all four elements of this ground of opposition under Section 8(4)(b)(i) have been made out, I therefore find that this ground succeeds in relation to the Class 5 Application. This ground of opposition however fails in relation to the Class 16 Application.

Ground of Opposition under Section 7(6)

86 Section 7(6) of the Act reads:

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

Decision on Section 7(6)

87 The legal test for determining the presence of bad faith is not in dispute and is encapsulated in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“**Valentino**”). The key principles were helpfully summarised by the Principal Assistant Registrar (“PAR”) in *Christie Manson & Woods Limited v Chritrs Auction Pte. Limited* [2016] SGIPOS 1 (“**Christie Manson**”) at [166]:

[166(a)] “Bad faith” embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve ‘no breach of any duty, obligation, prohibition or requirement that is legally binding’ upon the registrant of the trade mark: **Valentino** at [28].

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

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

[166(d)] An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference: **Valentino** at [30]...[However] this is not an absolute prohibition...in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115]...the High Court pointed out that a finding of bad faith is largely, if not invariably, based on **circumstantial evidence**.

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

[Emphasis in bold and in italics mine]

88 The Opponent’s case on this ground is essentially as follows:

(a) The identity/similarity of marks/signs;

- (b) Applicant’s knowledge of use of the Opponent’s Mark;
- (c) Dishonest intention of the Applicant.

I will deal with each in turn.

Identity/similarity of marks/signs

89 As held in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“**Festina**”) at [115], similarity (or identity) of marks is a relevant consideration:

... despite the broad nature of the notion of bad faith, one must show some sort of nexus between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in vacuum. **A clear-cut example of such a nexus would be an outright copying of the proprietor’s mark such that the two competing marks are practically identical...**

[Emphasis in bold mine]

90 I have concluded in relation to the objection under section 8(2)(b) above that the Application Mark is similar to a very high degree to the Opponent’s Mark. As for the Opponent’s Stylised Mark, the similarity with the Application Mark is even greater as they have almost identical stylisation and font, save for the lack of the accent above the letter “E” in the Application Mark. The 2 marks are reproduced below for ease of reference.

| Application Mark | Opponent’s Stylised Mark |
|------------------|--------------------------|
| BEABA | BÉABA |

Applicant's knowledge of use of the Opponent's Mark

91 The Opponent contends that it is not plausible that the Applicant, being involved in the same field of business distributing childcare and baby-related products, would not have been aware of the Opponent or its marks given the following:

- (a) The Opponent's products have been sold in boutiques and retail stores in Singapore since 2009 and promoted and advertised in Singapore since 2010.
- (b) The Opponent's Mark has been registered in various classes of goods in Singapore since 7 August 2014.
- (c) The Opponent has been using its marks in China, including in Zhejiang where the Applicant is based, since 2013. The Opponent's products are distributed and promoted via its distributor "Shanghai Beijie Babies and Ladies Goods Co., Ltd" and is currently available in over 1,200 retail stores across China.
- (d) The Opponent has obtained registration of its marks in China as early as 28 September 2015, which long pre-date the filing of the Application Mark.
- (e) A simple search on "Beaba" over the internet would have revealed results of the Opponent's official website as well as numerous other social media pages, web-links and listings comprising details of the Opponent and the Opponent's marks.

92 The Applicant does not deny any knowledge of the Opponent or its marks. However, it contends that it is the originator of the “Beaba” trade mark. It states as follows, although no evidence was provided to substantiate it:

4. The design of the trade mark **BEABA** from Beautiful baby, the mark consist of the words **BEA** and **BA**, and which pronunciation in Chinese is “碧芭”, we also have the mark “碧芭宝贝”. The mark **BEABA** and “碧芭宝贝” which means “Every baby is the beautiful angel, born to be spoiled, and we pass the love with our products, and let’s find the delicacy and beauty of art in ordinary life” .

93 I find the Applicant’s explanation as to how it came to adopt a mark so similar to the Opponent’s Mark unconvincing to say the least. Even if I accept that the Application Mark is derived from the words “Beautiful Baby”, it does not explain how it came about to choose an almost identical font and stylisation as the Opponent’s Stylised Mark coincidentally.

94 In *Festina*, the High Court found at [123] that “the failure to furnish the court with a credible explanation of how “ESTINA” in the brand name “J.ESTINA” was derived, where the explanation is particularly pertinent since six out of seven letters are in identical sequence in the two competing marks, can only lead to the irresistible conclusion that the word “ESTINA” was blatantly copied from the Appellant by a “cut and paste” job”.

95 Similarly, in the present case, I find that the Applicant’s failure to furnish a credible explanation of how the Application Mark was derived where the explanation is particularly pertinent, can only lead to the irresistible

conclusion that the Application Mark was blatantly copied from the Opponent by a “cut and paste” job.

Dishonest intention of the Applicant

96 The High Court in *Festina* held at [123], that “[s]uch outright copying of the Appellant’s mark [was] an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade” and that the respondent’s application was undoubtedly made in bad faith.

97 In the same vein, given my finding that the Applicant has blatantly copied the Opponent’s Mark, without the Opponent’s consent, the obvious inference is that the Applicant did so dishonestly with the intention to “free-ride” on the reputation of the Opponent and to take advantage of that reputation.

98 For the avoidance of doubt, while the Opponent had referred me to certain “false, dubious and inconsistent statements” made by the Applicant in its statutory declaration, I did not see the need to rely on them to arrive at the finding that there is bad faith on the part of the Applicant.

99 Before I conclude on this ground, I should mention two other points that were brought up in these proceedings. Firstly, the question arose whether an application which is tainted by bad faith, would affect only the class(es) which contain(s) goods and services similar to those of the opponent’s or whether the entire application should be refused registration. In my view, the entire application should be refused registration. It was held in *Valentino* at [20] (citing *Rothmans of Pall Mall Ltd v Maycolson International Ltd* [2006] 2 SLR(R) at [29]) that the bad faith ground is a distinct and independent argument

from the issue of confusing similarity and once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion. I would add that this is so even though the goods/services are dissimilar. This is particularly so in this case where I have found that the bad faith relates to the Applicant's choice of the Application Mark.

100 Secondly, the Applicant argued that the Opponent had not applied to cross-examine the Applicant and as such the Applicant had not been afforded an opportunity to clarify, substantiate its evidence or respond to the Opponent's objections. It would thus not be appropriate to make any adverse inferences against the Applicant without such opportunity being afforded to the Applicant to respond. I disagree. It is the duty of parties themselves to substantiate their own evidence or, alternatively, they make the call not to do so for whatever reasons they may have. In the present case, the Applicant clearly had knowledge that the Opponent was alleging bad faith against it but it chose to give only a brief response without providing any supporting evidence. Having made that choice, the Applicant cannot now turn around to say that it had no opportunity to clarify, substantiate or respond to the allegations because the Opponent did not elect to cross-examine it.

Conclusion on opposition under Section 7(6)

101 In light of the above, the ground of opposition under Section 7(6) succeeds in relation to both the Class 5 and Class 16 Applications.

Grounds of Opposition under Section 7(4)(a) and (b)

102 Section 7(4)(a) and (b) of the Act reads:

(4) A trade mark shall not be registered if it is —

- (a) contrary to public policy or to morality; or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

103 The Opponent relies on these grounds only in respect of the Class 5 application.

Decision on Section 7(4)(a) and (b)

104 The Opponent's case under these grounds is pleaded as follows:

14. ...the Applicant seeks to use the Application Mark for goods, inter alia, to be consumed and ingested by babies...and products that will be used on babies...There are strong public policy reasons, namely issues of health and safety risks, for why the Applicant's Mark should not be allowed for registration. Consumers that buy the Opposed Goods sold by the Applicant under the Application Mark may be misled into thinking that they emanate from the Opponent and/or from a reputable and trusted source...

105 However, it is to be noted that Section 7 grounds are absolute grounds. Therefore, to succeed under Section 7(4)(a) and (b), there must be some connotation or sign inherent in the mark itself that when used in relation to the goods claimed, is likely to be contrary to public policy or to deceive the public. Relevant guidance on these grounds have been provided in **Kerly's Law Of Trade Marks And Trade Names** (16th ed., London: Sweet & Maxwell, 2017) at [10.207]:

Like other absolute grounds, these provisions are directed at the **intrinsic qualities of mark itself**, and they are **not concerned** with circumstances relating to the **conduct of the applicant**, nor apparently to the **way in which the applicant uses the mark...**"

(emphasis added)

106 This is clearly not the Opponent's case here and the Opponent's opposition under these grounds must fail.

Conclusion on opposition under 7(4)(a) and (b)

107 This ground of opposition therefore fails.

Ground of Opposition under Section 8(7)(b)

108 The Opponent relies on this ground only in respect of the Class 16 application.

109 Section 8(7)(b) of the Act reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

...

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

Decision on Section 8(7)(b)

110 In this regard, it is the Opponent's case that the Application Mark is a copy of the Opponent's Stylised Mark in which copyright subsists.

111 In order to succeed under this ground, the Opponent must at the very least establish a prima facie case of copyright infringement. This means that the Opponent must prove:

(a) Firstly, the subsistence and its ownership of copyright in the work relied on; and

(b) Secondly, that the Application Mark is a copy of a substantial part of the work.

Subsistence and ownership of copyright

112 Section 130(1A) of the Copyright Act provides:

...where the defendant puts in issue the question of whether copyright subsists in the work or other subject-matter or whether the plaintiff is the owner of the copyright, but does not satisfy the court that he does so in good faith, the presumption as to the subsistence or ownership of copyright under subsection (1)(a) or (b), as the case may be, shall apply notwithstanding that the defendant puts that question in issue.

113 It was also held by the Court in *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 (“*Rovio*”) at [220]:

While I agree that s 130 of the CA only applies in actions brought under Pt V of the CA, **this does not mean that s 130 of the CA is irrelevant in deciding whether opposition under s 8(7)(b) of the TMA may succeed.** ... If the plaintiff in the notional copyright infringement action is able to invoke the presumptions in s 130 of the CA, **a court assessing opposition under s 8(7)(b) of the TMA should be permitted, and indeed, required, to consider the likely success of any copyright infringement proceeding in light of s 130 of the CA.**

[Emphasis in bold mine]

114 The Opponent asserts that the Applicant’s purported challenge to the Opponent’s ownership of copyright to the Opponent’s Stylised Mark was not done in good faith. As such, the presumption that the Opponent is the copyright owner of the Opponent’s Stylised Mark should continue to apply.

115 Even if the Applicant’s challenge was deemed to be done in good faith (which I do not find), Section 130(1B) of the Copyright Act allows for an affidavit to be made on behalf of the Opponent to show that copyright subsists and the Opponent is the owner of the relevant copyright.

116 In opposition proceedings, there is only a need to decide whether there is basis for the conclusion that the Opponent will likely be able to produce an

affidavit or indeed otherwise prove subsistence of copyright in and ownership of the copyright work. This was stated in *Rovio* at [217], [223], [224] and [239]:

217 ... In 2004, protection given to copyright owners was strengthened such that where a defendant challenges the subsistence and ownership of copyright without good faith, the presumptions in s 130 still operate (s 130(1A) of the CA). Further, even where the defendant does challenge the subsistence and ownership of copyright in good faith, the plaintiff under the amended provisions was permitted to file an affidavit to show that copyright subsists and that he is the owner (s 130(1B) of the CA).

...

223 Keeping in mind that the presumptions in s 130(1) of the CA do not apply in trade mark opposition proceedings *per se*, but is a *relevant factor* in light of s 8(7)(b) of the TMA, the question before me is whether the presumptions therein are likely to be successfully invoked in potential copyright infringement proceedings. Thus, it is *not* for me to decide if the Applicant has, in good faith, “put into question” the subsistence or the Opponent’s ownership of copyright in *the present opposition proceedings*. There is also no need for the affidavit mentioned in s 130(1B) of the CA to be filed in opposition proceedings. This is because the court is not concerned with actually invoking the presumptions in such proceedings. Instead, a court in my position is asked to determine whether, on a balance of probabilities, the defendant is likely to put into question the subsistence and the plaintiff’s ownership of the relevant copyright *in copyright infringement proceedings*, and whether it is likely to have good grounds to do so. If so the question that arises next is whether the plaintiff is likely to be able to produce the affidavit required in s 130(1B) of the CA. Again, I acknowledge that this is a rather speculative exercise. However, the court is unfortunately required by statute and the nature of trade mark opposition proceedings to engage in some degree of speculation.

224 In the present case, I find that the Applicant will in all likelihood put into question the subsistence and/or the Opponent’s ownership of the designs if copyright infringement proceedings were to be commenced between the parties. Assuming that this is done in good faith (for I have no reason to believe otherwise on the material before me), and bearing in mind the concerns that the Applicant and the PAR have about the evidence adduced by the Opponent in support of their claim to copyright, the question which arises is whether there is a basis for the conclusion that the Opponent will likely be able to produce an affidavit or indeed otherwise prove subsistence of

copyright in and ownership of the Artistic Works. Whilst the evidential gaps are, of course, theoretically surmountable, this is a decision that I must take *based on the material before the court*.

...

239 What remains is the question of originality. Put broadly, did the author(s) originate the Artistic Works, or were they slavish copies of existing works? There is neither evidence on the process by which the Artistic Works were created, nor is there any evidence which suggests that the works were slavish copies. This being the state of the evidence, and bearing in mind that the Applicant has not raised any argument or evidence which suggests that the artistic works lacked originality, I find that, on a balance of probabilities the Opponent would likely be able to demonstrate that the Red Bird Mark and the Fancy Word Mark are original works in copyright infringement proceedings. Hence, I find that the Opponent is, on a balance of probabilities, likely to be able to satisfy the requirement in s 130(1B) of the CA in potential copyright infringement proceedings. Of course, my decision here is not to be taken as a conclusive decision on the subsistence and ownership of copyright in the works should an actual copyright infringement action be litigated between the parties.

117 In reaching a decision on subsistence in and ownership of copyright, I thus need only choose which version of the truth I will steer closer to, after considering both parties' evidence, even if limited (see *Campbell v Sugar Media Ltd* [2008] E.T.M.R. 56 at [26], as affirmed by *Rovio* at [225] and [226]).

118 In the present case, the Opponent has adduced evidence to show that its founder, Jean Louis Berchet created the BEABA brand in 1989. In comparison to what has been put forth by the Applicant, the Opponent is certainly in a more deserving position to be recognised as the owner of the artistic works in the Opponent's Stylised Mark, which copyright subsists in.

119 The Applicant contends, relying on *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [72] that a corporate entity cannot be an author and hence the Opponent's claimed

copyright through the Opponent's (i.e. the entity BEABA) expending of skill and labour to design the Opponent's Stylised Mark, must fail. I accept that the Opponent cannot be the author and that the Opponent could have put in more evidence as to authorship and origination of the work such as when the work was created, who it was created by and how did the Opponent come to own it. Nonetheless, on the present facts, I am prepared to accept that the Opponent may well be able to establish a sufficient chain of title whether by employment relationship, assignment or exclusive licence or otherwise (see *Rovio* at [237]-[238]).

Copying

120 It leaves me now to consider whether “copying” has taken place and if so, whether the Application Mark does reproduce a substantial part of the claimed works.

121 The visual appearance and stylisation used by the Applicant in the Application Mark is almost identical (save for the lack of the accent above the letter “E” in the Application Mark). I therefore find that the Opponent's Stylised Mark has been substantially copied by the Applicant in the Application Mark.

Conclusion on opposition under Section 8(7)(b)

122 The ground of opposition under Section 8(7)(b) therefore succeeds.

Overall Conclusion

123 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds on: (1) the ground under Section 8(2)(b) for the Class 5 Application; (2) the ground under Section 8(7)(a) for the Class 5 Application; (3) the ground of bad faith

under Section 7(6) for both the Class 5 and the Class 16 Applications; and (4) the ground under Section 8(7)(b) for the Class 16 Application; but fails on the other grounds raised by the Opponent. Both the applications shall therefore be refused.

Costs

124 The Opponents have succeeded on three grounds out of six grounds relied on for the Class 5 Application and two out of five grounds relied on for the Class 16 Application. Overall, I am of the view that it is fair to award the Opponent 50% of its costs for the Class 5 Application and 30% of its costs for the Class 16 Application, to be taxed if not agreed.

Tan Mei Lin
Principal Assistant Registrar

Mr Alvin Tan and Ms Kristen Lim (Shook Lin & Bok LLP) for
the Applicant;
Mr Stanley Lee and Ms Kimberly Chen (ZICO Insights Law
LLC) for the Opponent.
