

IPOS Decisions 2023: Year-in-Review

Selected Issues, Holdings and Comments of Interest




Please note:

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

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IPOS CASES IN 2023

Case Reference	Selected Issues, Holdings and Comments of Interest
<p><i>In the matter of a Trade Mark Application by Schweiger, Martin Rainer Gabriel</i> [2023] SGIPOS 1</p>	<p>This case involved an application to register the trade mark “STRONG BY CHOICE” in Class 25 for “Shorts; T-shirts”. The trade mark examiner took the view that the application mark was devoid of distinctive character. The applicant requested for a hearing. The case was heard by an IP Adjudicator who took a different view: he considered the slogan to be inherently distinctive in relation to the goods in question and ultimately allowed it to proceed to registration.</p>
<p><i>Baidu Online Network Technology (Beijing) Co., Ltd v Baidu Europe BV</i> [2023] SGIPOS 2</p>	<div style="text-align: right; margin-bottom: 10px;">  </div> <p>Baidu Europe had trade mark registrations in Singapore for “baidu” and “BAIDU” in Class 38 for telecommunications services. The company is linked to Michael Gleissner, an individual who has been described by publications such as the World Trade Mark Review as being an “infamous troll”.</p> <p>Baidu Online, a subsidiary of the NASDAQ listed Baidu Inc, applied to invalidate the above registrations. The applicant does not have any earlier registration for the plain word mark “baidu” in Singapore, and had</p> <div style="text-align: center; margin: 10px 0;">  </div> <p>to rely on its earlier  mark, registered in Class 42 for internet search engine services and computer software design services. (The mark also used to be registered in Class 38 for telecommunications services, but this was revoked for non-use following an earlier separate action by Baidu Europe: see [2021] SGIPOS 8.) In allowing the invalidation action, the hearing officer found that the marks were filed for in bad faith and that the competing marks were confusingly similar.</p>
<p><i>Soon Ailing v Chen & Partners (S) Pte. Ltd.</i> [2023] SGIPOS 3</p>	<p>This case involved a design registered for a “Customized Watch Bezel”. The sole ground of objection was that the design was not novel at the date of its registration. Although the registered owner of the impugned design initially filed a counter-statement to defend the registration, it did not file any evidence in support. In such a situation, r 43(2) of the Registered Designs Rules provides that the registered owner “<i>shall, unless the Registrar otherwise directs, be deemed to have admitted to the facts alleged by the applicant in his application for revocation</i>”. Since the registered owner did not have any evidence in response to the applicant’s evidence that the design lacked novelty, the registration was revoked.</p>



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<p><i>Yap Fei Fei v Chuan Hong Seng Pte. Ltd.</i> [2023] SGIPOS 4</p>	<p>This trade mark opposition was against the stylised mark “SOFEI gold”. The sole ground of opposition was that the trade mark had been applied for in bad faith.</p> <p>The opponent, Ms Yap, was a shareholder and director of So Fei Pte. Ltd. (“SFPL”), a Singapore company. SFPL had imported citron tea from South Korea and distributed/sold it in Singapore under the brand “SOFEI Gold Citron Tea”. SFPL was the registered proprietor of the marks “SOFEI gold citron tea” (in Class 30 for “Korean Citron Tea”) and “SOFEI” (in Class 35 for “Retail services, wholesale services, import and export services”) in Singapore. The citron tea business, which enjoyed some success, was later sold to the applicant, Chuan Hong Seng Pte. Ltd (“CHSPL”), together with the registered trade marks for \$30,000. In accordance with the Sale and Purchase Agreement (SPA), CHSPL was recorded as the new owner of the “SOFEI gold citron tea” and “SOFEI” marks on the IPOS register. The SPA also provided that Ms Yap would be appointed as an agent to assist CHSPL with importing citron tea for a 3-year period. This appointment later gave rise to various other commercial disputes.</p> <p>The opponent’s case was that she / SFPL did not intend to permanently transfer the “SOFEI Gold Citron Tea” and “SOFEI” marks to the applicant. She argued that the SPA was a 3-year distribution arrangement under which the applicant had a limited right to use and be seen as the proprietor of the marks. The applicant countered that: (a) the agreement clearly indicated that SFPL had agreed to sell the entire business and trade marks to CHSPL; and (b) Ms Yap had arranged for the recordal of the transfer of trade mark ownership from SFPL to CHSPL. Following this logic, the argument was that the applicant did not act in bad faith by applying to register the stylised “SOFEI gold” mark.</p> <p>The IP Adjudicator was satisfied that the applicant held the genuine belief that it had legal title to the marks and that there was no impropriety on its part in filing for the application mark. The opposition was dismissed.</p>
<p><i>NCL Corporation v Norwegian Brand Ltd.</i> [2023] SGIPOS 5</p>	<p>This case involves two parties with established businesses in the global travel industry. The trade mark applicant provides air travel services and the opponent operates cruises under “NORWEGIAN CRUISE LINE”. They share a common word in their respective trade marks, “Norwegian”. There is some overlap between the cruise company’s services and the services claimed by the airline company in its international registrations designating Singapore.</p>

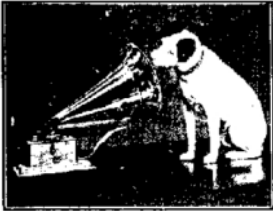


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	 <p>The opponent, NCL, relied on two main grounds in this opposition against . First, it relied on the “well known mark” provision under Section 8(4) of the Trade Marks Act 1998 (“the Act”). The opposition on this first ground failed because the opponent’s marks were found to be not well known. Second, it relied on the “passing off” provision under Section 8(7)(a) of the Act. In this regard, the hearing officer decided that there was no likelihood of deception or confusion under the law of passing off as long as the airline company’s specifications of services were appropriately qualified.</p> <p>Two novel issues were considered in the grounds of decision.</p> <p>The first relates to the requirement of a “real and effective commercial establishment” in a Convention country when it comes to well known marks. This arose because Section 2(1) of the Act defines a unregistered well known trade mark as one that is well known in Singapore and which belongs to a person who: (a) is a national of a Convention country; or (b) is domiciled in, or has a real and effective industrial or commercial establishment in a Convention country. It was undisputed that the opponent was organised under the laws of Bermuda, which is not a Convention country (being neither a party to the Paris Convention nor a member of the World Trade Organisation). However, the opponent contended, and the hearing officer accepted on the evidence, that it had a real and effective commercial establishment in the USA, a Convention Country.</p> <p>The second concerns the hearing officer’s order that the opposed specifications should be qualified by adding the phrase “<i>none of the aforesaid related to cruise services</i>”. By qualifying the applicant’s air travel services in this way, the public would be protected against trade source confusion, while ensuring that the words “Norwegian Cruise Line” (which have low inherent distinctiveness) are not given too much protection. The hearing officer considered this qualification order appropriate having regard to the words “<i>to the extent that</i>” in Section 8(7)(a) of the Act (which provides in material part, that: “<i>A trade mark shall not be registered ... to the extent that ... its use in Singapore is liable to be prevented ... by virtue of ... the law of passing off</i>”). (Please see [79]-[83] of the decision.)</p> <p>Finally, the case also demonstrates how considerations in an opposition based on the ground of passing off under Section 8(7)(a) differ from considerations in a civil action for passing off. In addition, it illustrates how it may be the case that goodwill is sufficiently associated with an opponent’s mark with relatively low</p>




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	<p>inherent distinctiveness, and, at the same time, because of the low inherent distinctiveness of that mark, the opposed mark is more readily assessed to be sufficiently different from the former.</p> <p>Additionally, the decision also addresses a separate (but related) opposition directed at another of</p>  <p>Norwegian Brand's international registrations, namely: . This mark was found to be distinguishable from "NORWEGIAN CRUISE LINE" as their memorable and dominant elements differed. Here, the opposition was unsuccessful.</p>
<p><i>Vetements Group AG v Xiamen VETEMENTS Brand Management co,LTD. [2023] SGIPOS 6</i></p>	<p>Vetements Group AG (the "applicant") is a Swiss company which owns the "Vetements" European luxury brand (founded in 2013 by Demna Gvasalia, a famous designer who is also the creative director of Balenciaga). It applied for a declaration of invalidity against "VETEMENTS", a trade mark in Class 25 for clothing and related goods registered in the name of Xiamen VETEMENTS Brand Management Co, LTD (the "proprietor"), a Chinese company. In its statement of grounds, the applicant alleged that the proprietor had produced copies in China of the former's goods (and similar items) and sold them under the mark "VETEMENTS" with the false claim that it was the applicant's collection for the Asian market.</p> <p>Although the proprietor defended the action by filing a counter-statement, it did not file its evidence by the required deadline. Under the Trade Marks Rules, the effect of this failure to file evidence is that it is deemed to have admitted to the facts alleged by the applicant. After considering the pleadings, and the applicant's evidence and submissions, the hearing officer allowed the invalidation action on the ground that the mark had been registered in bad faith.</p>
<p><i>HMV Brand Pte. Ltd. v Yongfeng Trade Co., Limited [2023] SGIPOS 7</i></p>	<p>HMV, the music and entertainment retailer, closed its last store in Singapore in 2015. In 2019, Yongfeng Trade Co., Limited, a Hong Kong company, applied to register the following dog and gramophone mark "</p>  <p>" in Classes 9 and 25 ("subject mark"). The examiner who first considered the</p>

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	<p>application initially refused to allow it, citing a conflict with three earlier trade marks including</p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p>“ HIS MASTER'S VOICE ” in Class 9 and “ ” in Classes 9 and 25. Yongfeng then applied to revoke the three cited marks on the basis of non-use. It succeeded because the owner of the cited marks, Mermaid (Brands) Limited, which was part of the HMV group of companies, did not respond. With the cited marks out of the way, the subject mark was allowed to proceed to registration. In 2020, what remained of HMV’s trade mark portfolio in Singapore was transferred to HMV Brand Pte Ltd. (the “applicant”). The applicant commenced invalidation proceedings against the subject mark in 2021. The hearing officer found that the subject mark had been registered in bad faith.</p>
<p><i>Nidec Control Techniques Limited v Uni-Drive Systems (S) Pte Ltd</i> [2023] SGIPOS 8</p>	<p>This was an unsuccessful non-use revocation action against the registered trade marks “UNI-DRIVE” and</p> <div style="display: flex; align-items: center;">  UNI-DRIVE </div> <p>“ ”, both registered in Class 7 for mechanical power transmissions and related products. One of the key arguments raised by the applicant seeking revocation was that the evidence did not show that the marks had been affixed onto the goods. However, this contention was rejected since there was other types of evidence of use in connection with the goods in question.</p>
<p><i>Coinbase, Inc. v bitFlyer Inc.</i> [2023] SGIPOS 9</p>	<p>This case saw two major cryptocurrency exchanges in a dispute over the registered trade mark “coinbase”, which bitFlyer, a Japanese company, had obtained in Singapore in respect of Classes 35, 38 and 42 since 3 February 2016. Coinbase, Inc., a leading US platform, successfully applied to invalidate the trade mark on grounds that the Japanese company had applied for “coinbase” in bad faith. BitFlyer Inc. had knowingly sought the protection of “coinbase” despite it being the name of its direct competitor Coinbase, Inc., without consent or authority, and such conduct would be considered commercially unacceptable by reasonable and experienced persons in the financial market.</p>

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<p><i>In the matter of a trade mark application by Louis Vuitton Malletier</i> [2023] SGIPOS 10</p>	 <p>Can “”, which is essentially a pattern comprised of Louis Vuitton’s flower quatrefoil marks (viz. ), be registered as a trade mark for a wide variety of goods in Classes 9, 14, 18 and 25? The trade mark examiner considering LV’s mark refused to allow the application to proceed to registration. LV requested for an ex parte hearing. However, it did not file any evidence of use, arguing instead that the pattern was inherently distinctive. After consideration, the hearing officer allowed the application to proceed in Classes 9, 14 and 18 in relation to a much narrower band of products on the basis that: (1) these products do not normally bear any patterns at all; and (2) the pattern sought to be registered is fanciful, unusual and/or arbitrary, or departs from the norm or customs of the relevant sector. (See [51] of the decision and related discussion.)</p>
<p><i>ZERODENSITY YAZILIM ANONIM SIRKETI v Novel Brands USA LLC</i> [2023] SGIPOS 11</p>	<p>This opposition was against the Singapore designation of an international registration. The mark in question is “REALITY ENGINE”, filed in Class 9 for “downloadable and recorded computer software”. The applicant for the “REALITY ENGINE” mark intends to use it for software products sold directly to consumers and developers, to make it easier for them to prototype and produce high-quality augmented reality experiences. However, its goods are still in the development stage.</p> <p>The opponent is in the business of developing broadcasting products and solutions in the field of augmented reality, live events and e-sports, among other things. The opponent has a non-exclusive distributor based in Singapore named Cgangs International. In 2019, the opponent, together with Cgangs, Mediacorp and ITE College Central, collaborated on the 2019 Countdown Show which aired on Channel 5 to the public in Singapore. For the event, a photo-realistic 3-D mermaid was seen swimming around the arena; a performance made possible by the opponent’s “reality engine” hardware and software.</p> <p>The hearing officer found, on the evidence, that the opponent had used “reality engine” in respect of software in Singapore and that it enjoyed the requisite goodwill. The opposition was allowed on the basis of passing off and the application was refused protection in Singapore.</p>

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<p><i>Otschool Inc v ALLSCHOOLS PTE LTD</i> [2023] SGIPOS 12</p> <p>Note: an appeal against this decision has been filed to the General Division of the High Court.</p>	<p>This decision relates to four consolidated opposition actions against “ALLSCHOOL” in Classes 9, 35, 41 and 42. The application mark was applied for by Allschools Pte Ltd (“applicant”), the Singapore subsidiary of Spark Education Limited, an education technology company headquartered in Beijing, China. “ALLSCHOOL” is the name of the platform through which the applicant offers online classes to children.</p> <p>The oppositions were filed by Otschool Inc (“opponent”), a California-based company founded in 2015 by former employees of IBM, Google and Airbnb. The opponent operates an online platform known as “OUTSCHOOL”, which provides virtual online classes for children across the world. The opponent’s case was premised on two main contentions. First, that the application mark conflicted with “OUTSCHOOL”, which was said to be protected as a well known trade mark in Singapore. Second, that the application should be refused on grounds of passing off.</p> <p>In dismissing the oppositions, the hearing officer found that the evidence did not support a finding that “OUTSCHOOL” was a well known trade mark in Singapore at the relevant time. Moreover, she found that the marks are more dissimilar than similar overall – which would mean that there would not be any likelihood of confusion between the two.</p>
<p><i>Monster Energy Company v IICOMBINED Co., Ltd.</i> [2023] SGIPOS 13</p>	<p>GENTLE MONSTER is a South Korean luxury eyewear brand with two stores in Singapore: one in ION Orchard and the other in the Shoppes of Marina Bay Sands. The brand is owned by IICombined Co., Ltd. (“applicant”), which has had a Singapore trade mark registration for “GENTLE MONSTER” in Class 9 for “spectacles, sunglasses” since 11 June 2013. In 2018, the applicant filed a new application to register “GENTLE MONSTER” in Class 9 for “smartglasses”. Not long thereafter, GENTLE MONSTER and Huawei Technologies launched smartglasses under the label HUAWAI X GENTLE MONSTER eyewear.</p> <p>The application to register “GENTLE MONSTER” for “smartglasses” was opposed by Monster Energy Company (“opponent”), which relied on its registration (dated 10 December 2014) for “MONSTER ENERGY” in Class 9 which covers goods such as “eye glasses” and “sunglasses”.</p> <p>The hearing officer dismissed the opposition. Central to his decision was the finding that the competing marks are visually and aurally more dissimilar than similar, and conceptually dissimilar to a material degree.</p>

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<p><i>Monster Energy Company v YG Entertainment Inc</i> [2023] SGIPOS 14</p>	<p>YG Entertainment, the South Korean entertainment agency behind BabyMonster, one of the newest K-pop girl groups, applied to protect “BABYMONSTER” and “BABYMONSTERS” (both international registrations) in Singapore in Classes 9, 25, 28 and 41. The marks were opposed by Monster Energy Company on the grounds of confusing similarity and passing off, premised on its earlier “MONSTER ENERGY” trade marks. In dismissing the opposition, the IP Adjudicator found that “BABYMONSTER” / “BABYMONSTERS” are not visually, aurally, nor conceptually similar to “MONSTER ENERGY”, and that “the differences between the marks are sufficient for there to be no likelihood of confusion”.</p>

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