

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

[2023] SGIPOS 12

Trade Mark Nos. 40202122485U, 40202122484Q, 40202122483R and
40202122482Y

**IN THE MATTER OF TRADE MARK APPLICATIONS
IN THE NAME OF
ALLSCHOOLS PTE LTD**

... Applicant

AND

**OPPOSITIONS BY
OUTSCHOOL INC**

... Opponent

FOUNDATIONS OF DECISION

TABLE OF CONTENTS

INTRODUCTION.....	1
BACKGROUND OF PARTIES	2
PROCEDURAL HISTORY	3
OPPONENT’S EVIDENCE.....	4
APPLICANT’S EVIDENCE.....	5
GROUND OF OPPOSITION	5
APPLICABLE LAW AND BURDEN OF PROOF	5
GROUND OF OPPOSITION UNDER S 8(4)(A) READ WITH S 8(4)(B)(I) AND UNDER S 8(4)(A) READ WITH S 8(4)(B)(II)	5
WHETHER THE OPPONENT’S MARK IS WELL KNOWN IN SINGAPORE	8
THE OPPONENT’S MARK IS NOT WELL KNOWN	11
CONCLUSION ON OPPOSITION UNDER S 8(4)(A) READ WITH S 8(4)(B)(I) AND UNDER S 8(4)(A) READ WITH S 8(4)(B)(II).....	15
GROUND OF OPPOSITION UNDER SECTION 8(7)(A).....	15
GOODWILL	16
MISREPRESENTATION.....	17
<i>Distinctiveness of “OUTSCHOOL”</i>	<i>18</i>
<i>Likelihood of confusion.....</i>	<i>19</i>
CONCLUSION ON OPPOSITION UNDER S 8(7)(A)	25
CONCLUSION	26

OUTSCHOOL INC
v
ALLSCHOOLS PTE LTD

[2023] SGIPOS 12

Trade Mark Nos. 40202122485U, 40202122484Q, 40202122483R and
40202122482Y

Principal Assistant Registrar Tan Mei Lin
5 September 2023

5 December 2023

Principal Assistant Registrar Tan Mei Lin:

Introduction

1 This matter involves four consolidated opposition proceedings concerning the trade mark “ **ALLSCHOOL** ” applied for by ALLSCHOOLS PTE LTD (the “Applicant”). Details of the opposed trade mark applications (collectively “Application Marks”) are as follows:

Application No.	Class	Specification
40202122485U (the “Class 9 Application”)	9	Downloadable graphics for mobile phones; computer software applications, downloadable; teaching apparatus and instruments; downloadable image files; downloadable electronic books; computer software platforms, recorded or downloadable; downloadable video files; compiler software; multimedia projectors; teaching and instructional apparatus; Children's educational software.

<p>40202122484Q (the “Class 35 Application”)</p>	<p>35</p>	<p>Rental of advertising space on the internet; online advertising on a computer network; provision of commercial information via the internet; arranging and concluding commercial transactions for others; presentation of goods on communication media, for retail purposes; sales promotion for others; commercial information agency services; import-export agency services; provision of space on websites for advertising goods and services; providing business information; business information and research services.</p>
<p>40202122483R (the “Class 41 Application”)</p>	<p>41</p>	<p>Providing online electronic publications, not downloadable; providing online videos, not downloadable; career and vocational training; organization of training; educational examination; educational consultancy; Providing information, including online, about education, training, entertainment, sporting and cultural activities; Providing information about education; Organisation of congresses and conferences for cultural and educational purposes; Online electronic publishing of books and periodicals.</p>
<p>40202122482Y (the “Class 42 Application”)</p>	<p>42</p>	<p>Creating and maintaining web sites; development of computer programs; software authoring; design and development of multimedia products; maintenance of computer software; computer software design; software as a service [SaaS]; recovery of computer data; information technology [IT] consultancy; data encryption services.</p>

2 Outschool Inc (the “Opponent”) opposed the registration of the Application Marks.

Background of parties

3 The Opponent is a California-based company that was founded in 2015

by Amire Nathoo, Mikhail Seregine, and Nick Grandy, who are engineers formerly employed by IBM, Google, and Airbnb respectively.

4 The Opponent operates an online platform known as “**OUTSCHOOL**” (the “Opponent’s Mark”) providing virtual online classes for children. The platform currently offers more than 140,000 live online classes to more than 1,000,000 learners in 183 countries worldwide, including Singapore.

5 The Applicant, founded in Singapore in 2021, offers online classes to children through its platform known as “**ALLSCHOOL**”. The Applicant’s parent company is Spark Education Limited (“Spark Education”), which is also in the education technology industry. Headquartered in Beijing, China, Spark Education has provided online live, interactive, small-group classes to children in China since 2017.

6 The Applicant currently has more than 20,000 registered users and more than 3,000 paid learners from numerous countries and regions worldwide, including Singapore, on its online education platform.

Procedural history

7 The Applicant applied to register the Application Marks on 18 September 2021. The Application Marks were published for opposition purposes on:

- (a) 7 January 2022 in respect of the Class 9 Application;
- (b) 14 January 2022 in respect of the Class 42 Application;
- (c) 21 January 2022 in respect of the Class 35 Application; and

(d) 27 April 2022 in respect of the Class 41 Application.

8 The Opponent filed its Notices of Opposition:

(a) on 9 May 2022 in respect of the Class 9 Application;

(b) on 17 May 2022 in respect of the Class 42 Application;

(c) on 23 May 2022 in respect of the Class 35 Application; and

(d) on 14 June 2022 in respect of the Class 41 Application.

9 The Applicant filed its Counter-Statements:

(a) on 6 July 2022 in respect of the Class 9 Application;

(b) on 13 July 2022 in respect of the Class 42 Application;

(c) on 20 July 2022 in respect of the Class 35 Application; and

(d) on 3 August 2022 in respect of the Class 41 Application.

10 On 1 September 2022 the four sets of opposition proceedings were consolidated.

Opponent's evidence

11 The Opponent's evidence comprises the following:

(a) a statutory declaration made by Delphina Yuen, General Counsel of the Opponent, dated 30 October 2022 ("OSD1"); and

(b) a statutory declaration in reply made by the same Delphina Yuen dated 16 May 2023 ("OSD2").

Applicant's evidence

12 The Applicant's evidence comprises a statutory declaration made by Xiaonan Wang, General Manager of the Applicant, dated 16 March 2023 ("ASD").

Grounds of opposition

13 The Opponent relies on the following grounds of opposition in these proceedings:

- (a) Section 8(4)(a) of the Trade Marks Act 1998 ("the Act") read with s 8(4)(b)(i) of the Act;
- (b) Section 8(4)(a) of the Act read with s 8(4)(b)(ii) of the Act; and
- (c) Section 8(7)(a) of the Act.

Applicable law and burden of proof

14 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.

Grounds of opposition under s 8(4)(a) read with s 8(4)(b)(i) and under s 8(4)(a) read with s 8(4)(b)(ii)

15 Section 8(4) 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;

(ii) if the earlier trade mark is well known to the public at large in Singapore –

(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

Section 2(1) of the Act, in relation to “well known trade mark”, reads:

“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;

Section 2(7) to (9) of the Act reads:

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

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of —

- (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
 - (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
 - (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
 - (e) any value associated with the trade mark.
- (8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark is deemed to be well known in Singapore.
- (9) In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:
- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
 - (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
 - (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

16 Section 8(4)(b)(i) relates to marks that are well known in Singapore, whereas s 8(4)(b)(ii) relates to marks that are well known to the public at large in Singapore. However, since a mark that is not well known in Singapore cannot be well known to the public at large in Singapore, if the Opponent cannot establish that its mark is well known in Singapore, the opposition on both these grounds will fail. I will therefore deal with this element first.

Whether the Opponent's Mark is well known in Singapore

17 The relevant date for determining whether “**OUTSCHOOL**” is well known in Singapore is 18 September 2021, the date the Applicant applied to register the Application Marks.

18 The Opponent has the following trade mark applications/registrations for “**OUTSCHOOL**”:

Application No.	Country	Filing Date	Classes
87760376	United States of America	18/01/2018	9,35,38, 41
1910229	Canada	18/07/2018	9,35,38, 41
1501048	Australia	16/10/2019	9,35,38, 41
1501048	China	16/10/2019	9,35,38, 41
1501048	European Union	16/10/2019	9,35,38, 41
1501048	UK	16/10/2019	9,35,38, 41
1501048	India	16/10/2019	9,35,38, 41
1501048	Republic of Korea	16/10/2019	9,35,38, 41
1501048	New Zealand	16/10/2019	9,35,38, 41
1501048	Singapore	22/12/2021	9,35,38, 41
1501048	Japan	22/12/2021	9,35,38, 41

19 The Opponent asserts that it has been using “**OUTSCHOOL**” in Singapore since 25 January 2015¹, the date when a user in Singapore first signed up to use the “**OUTSCHOOL**” platform. Since then, the sign-ups from Singapore have been increasing year-on-year as follows:

¹ It seems a little odd that the date a user in Singapore first signed up to use the Opponent's platform is earlier than the date of the Opponent's first sign up worldwide which is 5 August 2015 (the date of first sign up in the United States). (Tab 9 of OSD1)

Financial Year (FY)	Sign-ups² from Singapore
2015	1
2016	8
2017	35
2018	368
2019	473
2020	3,625
2021	5,187

20 In terms of enrolments, the figures are:

Financial Year (FY)	Enrolments from Singapore
2015	3
2016	17
2017	12
2018	55
2019	263
2020	4,859
2021	8,606

21 The Opponent’s revenue from the Singapore market is as follows:

Financial Year (FY)	Revenue from Singapore in US\$
2015	12
2016	21
2017	635
2018	3,983
2019	12,124
2020	144,263
2021	370,026

² The Opponent did not explain what the difference is between “sign-ups” and “enrolments” (referred to in the next paragraph of these grounds of decision). I also note that in the years 2017-2019 the number of sign-ups exceed the number of enrolments whereas in other years the number of sign-ups is usually fewer than the number of enrolments. No reason was offered by the Opponent for the change in trend over those years.

22 The Opponent states that it initially limited the promotion of its goods and services to the United States and Canada. However, beginning in September 2020, the Opponent expanded the promotion of its goods and services to jurisdictions outside of the United States and Canada. Facebook and Google ads in the English language were targeted towards English speakers in international territories, including consumers in Singapore. In 2021³, Facebook and Google ads in the Mandarin language were targeted towards Mandarin speakers in Asia, including consumers in Singapore. The Opponent’s advertising expenditure for the Singapore market is as follows:

Year	Advertising figures for Singapore market in SG\$
2017	13.38
2018	-
2019	340.35
2020	23,668.66
2021	80,745.70

23 The Opponent further highlights the following:

(a) Its official Facebook page has 375,000 likes and 403,000 followers, and its Instagram page has over 148,000 followers as of October 2022.

(b) The American business magazine, Inc., has named the Opponent as #58 in its Top 5000 Companies of 2020, and #70 in its Top 5000 Companies of 2021. Another American business magazine, Fast Company, named the Opponent as the #1 most innovative educational

³ The month was not indicated so it is not clear whether this was done before or after the relevant date.

company and the #12 most innovative company across all categories of 2021.

(c) The Opponent is ranked first out of 757 competitors in the sphere of online education in the rankings of the data platform Tracxn, which collates the business data and metrics of various startups. The Opponent is also well-funded, and has a total funding of US\$240 million. Its funding has been consistently on the rise between 2016 and 2021, with the bulk of its fundraising having occurred before April 2021.

(d) The Opponent has been featured in various international publications, including ABC News, USA TODAY, Forbes, NPR, VOX, Washington Examiner, San Francisco Chronicle, CNET, Fox Business, Yahoo Finance, Business Insider, CNBC, New York Times, Wall Street Journal, CNN, MarthaStewart.com, Parents, Psychology Today, Good Housekeeping and the Los Angeles Times, among others.

(e) The Applicant’s application to register “ **ALLSCHOOL** ” in the United States was abandoned after it was opposed by the Opponent.

The Opponent’s Mark is not well known

24 It appears that the Opponent has been receiving sign-ups, enrolments, and purchases from customers in Singapore for around seven years prior to the relevant date. During the initial five years, the number of sign-ups and enrolments from Singapore, were modest but they improved significantly in 2020 and 2021. However, apart from these, there is very little else that I can glean regarding the degree the Opponent’s Mark was known in Singapore at the relevant date.

25 Among other things, it is not entirely clear:

- (a) what is the size of the online education market in Singapore or the market share held by the Opponent;
- (b) to what extent did the Opponent’s promotional efforts, as well as the articles featuring the Opponent in international publications, reach consumers in Singapore;
- (c) what proportion of the Opponent’s following on social media are from Singapore; and
- (d) how the Opponent’s favourable ranking by Tracxn, Fast Company and Inc 5000 show that the Opponent’s mark is well known in Singapore.

26 Parties putting forward evidence in support of its case that its mark is well known should bear in mind the need to show how the evidence has led to its mark being well known in Singapore. Merely putting forward evidence before this tribunal without establishing the link between the evidence and Singapore or its impact on consumers in Singapore is not helpful.

27 In my view, the Opponent’s evidence falls short of showing whether, how and to what extent it impacts the relevant sector of the public in Singapore such that the Opponent’s mark is well known to it. The burden lies on the Opponent to show that its mark is well known in Singapore but based on the evidence submitted I am not persuaded that the case has been made out.

28 In this regard, I am mindful of what the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) said:

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

[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.

...

[114] ...The fact that a trader has some business within Singapore will generally be insufficient in itself to establish that the mark is well known.

29 In *Caesarstone*, the Court of Appeal found that the mark “CEASAR” was not well known in Singapore even though the sales and advertising figures (see below) were much higher than in the present case.

Year	Singapore sales (\$)	Worldwide sales (\$)
2002	3,390,094	119,929,925
2003	1,874,266	108,568,093
2004	935,055	119,036,242
2005	1,433,751	159,243,918
2006	203,634	173,550,987
2007	577,656	176,795,005

Appellant’s worldwide promotional expenditure figures	
Year	Amount (\$)
2002	273,387
2003	247,812
2004	1,339,131
2005	2,092,412
2006	2,234,788
2007	1,120,784

(For the avoidance of doubt, I am aware that the figures need to be looked at in the context of the overall size of the relevant market. However, there was no evidence of this in *Caesarstone* and neither is there in the current case).

30 With specific regard to the Opponent’s overseas trade mark applications/registrations, the Court of Appeal in *Caesarstone* said at [113]:

... although the overseas registrations of the mark and the successful enforcement of rights are relevant factors under s 2(7)(c) and (d) of the TMA, the language of s 2(7) of the TMA makes it abundantly clear that the ultimate inquiry is whether a trade mark is well known *in Singapore*. The crucial point, therefore, is that the Appellant has to show how the overseas registrations of the Appellant’s CAESAR Mark and the successful enforcement of its rights has *led to* its mark being well known *in Singapore*. In our judgment, this has not been done. These factors therefore do not go towards establishing that the Appellant’s CAESAR Mark is well known in Singapore.

Conclusion on opposition under s 8(4)(a) read with s 8(4)(b)(i) and under s 8(4)(a) read with s 8(4)(b)(ii)

31 The grounds of opposition under s 8(4)(a) read with s 8(4)(b)(i) and under s 8(4)(b)(a) read with s 8(4)(b)(ii) fail.

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

32 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;

33 To succeed on this ground of opposition, the Opponent has to establish the "classical trinity" of passing off, being the three elements set out below⁴:

(a) **Goodwill**, namely that the Opponent's goods/services have acquired a reputation in Singapore as at the relevant time. Further:

(i) The relevant date for establishing goodwill is at the date where the acts complained of were carried out (*Mopi Pte Ltd v Central Mercantile Corporation (S) Ltd* [2001] SGHC 328 at [113]).

(ii) Goodwill must attach to a business (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [46]).

⁴ *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [27] to [28].

(b) **Misrepresentation**, namely that the Applicant has made a misrepresentation to the public (whether intentional or otherwise) leading (or which is likely to lead) the public to believe that the goods offered by the Applicant are those of the Opponent's; and

(c) **Damage**, namely that the Opponent suffers (or is likely to suffer) damage by reason of the erroneous belief engendered by the Applicant's misrepresentation.

Goodwill

34 The relevant date for establishing goodwill in the present case is the date the Applicant commenced use of “**ALLSCHOOL**” which is “[s]ince its inception in 2021”⁵.

35 In order to succeed in a passing off action in Singapore, the court in *Staywell* at [130] emphasised that “goodwill must exist *in Singapore*”, and in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) at [34], that goodwill “...attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys...Goodwill may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up with they bear.”

36 Taking into consideration the Opponent's sign up, enrolment and revenue figures at [19]-[21], I accept that the Opponent has the relevant goodwill in Singapore. In this regard, the Applicant also acknowledges that the

⁵ ASD at [11].

Opponent’s 2020 to 2021 booking figures in Singapore “are not insignificant” and that “the Opponent has some business in Singapore”⁶.

Misrepresentation

37 The Court of Appeal in *Singsung* provided the following guidance in relation to determining misrepresentation in an action for passing off:

[38] In our judgment, the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation. Simply put, *if a mark or get-up is not distinctive of the plaintiff’s products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant’s products or services are the plaintiff’s or are economically linked to the plaintiff...*

...

[40] ... *The misrepresentation in question must give rise to confusion (or the likelihood thereof) in order to be actionable under the law of passing off. This is ultimately a matter for the court’s judgment and it is not to be determined on a visual side-by-side comparison. Rather it is to be assessed from the vantage point of a notional customer with imperfect recollection.*” (Emphasis added)

38 Therefore, the preliminary issue to be considered is whether “**OUTSCHOOL**” is distinctive of the Opponent’s goods and services. If so, the Opponent will have to satisfy two further requirements: first, that there was a misrepresentation made by the Applicant in using “**ALLSCHOOL**”, and second, that actual confusion or a sufficient likelihood of confusion arose from this (*Singsung* at [70]).

⁶ Applicant’s written submissions at paragraph 54.III.B.

Distinctiveness of “OUTSCHOOL”

39 Regarding the threshold inquiry of distinctiveness, the Court of Appeal in *Singsung* at [39] cited the following in *The Singapore Professional Golfers’ Association v Chen Eng Waye* [2013] 2 SLR 495 (at [20]) (“SPG”):

... [The second inquiry (ie, of misrepresentation)] typically begins with a consideration of how the defendant is said to be doing this. In general, it will entail the use of some element that serves as a badge or identifier marking the goods or services in question as emanating from the claimant ... *It will be necessary here to consider whether that element does serve as a badge or identifier, or, in the parlance of the action, whether it is “distinctive” of the claimant’s goods and services, and whether the claimant’s goodwill (established under the first stage of the inquiry) is in fact associated with that element.* 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. ...” (Emphasis added)

40 Further, the Court of Appeal in *SPG* at [34], cited with approval Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011):

But, as observed by the learned author of *The Law of Passing Off* at para 8-003, the distinctiveness of a name or mark is just one aspect of the wider question of whether there has been a misrepresentation, He puts it thus at para 8-003:

...

Distinctiveness is a matter of degree, and marks of low inherent distinctiveness may be protected against precise copying but not against slight variations.

41 The fact that “**OUTSCHOOL**” is distinctive of the Opponent’s goods and services is not in dispute. The more pertinent issue is the degree of distinctiveness of “**OUTSCHOOL**”.

42 “**OUTSCHOOL**” consists of a single word, with all letters in equal size, in the same font and of the same colour. Although “**OUTSCHOOL**” is meaningless, it will not go unnoticed that it is made up of two common English words “OUT” and “SCHOOL”. The element “SCHOOL” is obviously descriptive and has little or no distinctive character in relation to the goods and services offered by the Opponent. This is not disputed by the Opponent.”⁷ It is therefore not likely to be perceived as the distinctive and dominant element of “**OUTSCHOOL**”. The distinctiveness of “**OUTSCHOOL**” lies in the prefix “OUT”, a point conceded by the Opponent⁸. Overall, in my view, the distinctiveness of “**OUTSCHOOL**” is low as it will be understood as having allusive connotations to the goods and services i.e. they are offered beyond the confines of a physical classroom.

Likelihood of confusion

43 Professor Ng-Loy Wee Loon, SC, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 3rd Ed, 2021), states:

[18.2.37] The following are some of the factors which have been applied by Singapore courts in this factual inquiry:

- (a) Degree of similarity between the parties’ marks.
- (b) Degree of distinctiveness of the plaintiff’s mark.
- (c) Defendant’s intention in adopting the mark.
- (d) Significant price differences between the parties’ goods or services.
- (e) Proximity of the parties’ fields of activity.

[18.2.38] This is not an exhaustive list of factors. Furthermore, the above factors are not listed in any particular order. It is not possible to assign a particular weight to any of these factors. It is a matter of balancing all these and other factors in “as

⁷ Opponent’s written submissions at 4.7.

⁸ Opponent’s written submissions at 4.8.

commonsensical and as fair a manner as possible”. The “highly subjective” nature of the confusion inquiry has been acknowledged and accepted by the courts.

44 I consider the degree of similarity between the parties’ mark -
“**OUTSCHOOL**” and “ **ALLSCHOOL** ”.

45 On visual similarity, the High Court in *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] SGHC 49 (“*Dr August Wolf*”), said at [29]:

Visual similarity is ascertained by “reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components”: *Hai Tong* at [62(b)]. An overall impression may “in certain circumstances, be dominated by one or more of its components”: *Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5 at [60]; *Hai Tong* at [62(c)]. A descriptive element of a complex mark is not likely to be perceived “as the distinctive and dominant element of the overall impression conveyed by that mark”: *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) at [41]. Nevertheless, “[t]he finding of distinctiveness of the separate components of the mark must ultimately be related back to the impression given by the mark as a whole” because “it is the entire mark, and not only a component of it, that must function as the badge of origin”: *Staywell* at [29].

46 I am of the view that marks concerned are visually more dissimilar than similar. While the marks coincide in the number of letters and share the common element “SCHOOL”, this common element is descriptive and is not likely to be perceived as the distinctive and dominant element of the overall impressions conveyed by the marks. Instead, consumers would pay more attention to the non-descriptive features of the respective marks and to distinguish them by those other features - in the present case, “ALL” and “OUT”. Although, “ALL”

and “OUT” each have three letters each, they do not share any letters in common and are not visually similar.

47 The Opponent reminded me that in *Dr August Wolf*, the High Court concluded at [30], in respect of the competing marks “VAGISIL” and “VAGISAN”, that:

...based on a comparison of the overall impressions of the marks, the marks are visually similar. The fact that two out of three letters in the “SIL” and “SAN” components are different does not overshadow the coincidence of five letters (ie, “V”, “A”, “G”, “I” and “S”) in the two marks that comprise only seven letters each. Assessing the marks in terms of their overall visual impressions and as wholes, I found the marks to be visually similar. That being said, the visual similarity here is only to an average degree (as opposed to an above-average degree) owing to the differences in the distinctive components (ie, “SIL” and “SAN”).

48 I do not find *Dr August Wolf* helpful on the present set of marks. Among other differences, the competing marks in *Dr August Wolf* shared a common prefix, whereas here, the marks share a common suffix. In my view, the differences in the prefix of both marks, “ALL” and “OUT”, being seen first (coupled with the fact that they are distinctive and dominant for the reasons given at [46]), have greater visual impact than the commonality in the suffix, “SCHOOL”.

49 I turn next to aural similarity. *Staywell* makes it clear that there are two possible approaches: the first is to consider the dominant components of both marks (“**Dominant Component Approach**”), and the second is to undertake a quantitative assessment as to whether the competing marks have more similar syllables than not (“**Quantitative Approach**”). Under both approaches, I find that the marks are more dissimilar than similar.

50 Finally, I consider the conceptual similarity between the marks, and I find that they are conceptually more dissimilar than similar. “**OUTSCHOOL**” conveys the idea of education that “transcends the confines of a physical classroom” whereas “ **ALLSCHOOL** ” evokes the idea of variety in education.

51 Having assessed the marks visually, aurally, and conceptually, I find that the marks are more dissimilar than similar overall and this points against a likelihood of confusion.

52 As for the degree of distinctiveness of “**OUTSCHOOL**”, I have found at [42] that it is low. This means that small differences between the marks may be sufficient to avert confusion.

53 At the same time, I bear in mind that the parties are competitors in the same field of activity, a fact not disputed by the Applicant. This is a factor pointing to confusion occurring.

54 As for the Applicant’s intention in adopting “ **ALLSCHOOL** ”, I note the Opponent’s allegation that the Applicant has “plagiarised the Opponent’s trade dress and content” as well as other elements from its website. To name a few, these include⁹:

- (a) desktop website design including homepage layout, class search and user profile management interface;

⁹ The allegations are summarised in the Opponent’s written submissions at [3.5], [3.6], [7.6] and [7.8].

- (b) feature to allow users to request private classes or new subjects;
and
- (c) after-sales services marketed under a “happiness guarantee”.

55 I also note the Opponent’s submission¹⁰ that “the Applicant’s conduct was clearly intended to cause members of the public to believe that its “

ALLSCHOOL ” platform was in fact the Opponent’s better established “OUTSCHOOL” platform or was related thereto.”. Insofar as the Opponent is alleging that the confusion is caused by the similarities in the “trade dress and content”, this falls outside the ambit of s 8(7)(a) and I do not consider it. For the avoidance of doubt, I recognise that there might be a possibility that the Opponent’s Mark is copied as well if other elements of the Opponent’s website are copied but in the absence of a direct allegation that the Application Marks have been filed in bad faith, I also do not consider it.

56 I move on to consider how a member of the relevant public in Singapore would perceive the respective marks when used on the respective goods and services. The relevant consumers here are parents/guardians who purchase education-related goods and services for their children/wards. They might also be teachers looking to offer their materials and classes on the parties’ platforms. Parents/guardians would pay a relatively high degree of attention and care in choosing the goods and services concerned as they would want what is most suitable for the development of their child/ward. They would pay attention to matters such as the type of classes offered, the mark used in relation to the goods and services, its reputation in the field, the cost of the classes, etc.

¹⁰ Opponent’s written submissions at [7.9].

57 I further note that the parties here offer their goods and services through online platforms. Online purchases will require the consumer to have more regard to the marks as they would have to key in the correct mark into the text field of the address bar to arrive at the website at which they wish to make a purchase from.

58 Having regard to all the above, I find that there is no misrepresentation, and it follows that there is no damage.

59 Before I conclude, I wish to address the Opponent’s submission that actual confusion has in fact arisen. It referred me to the four incidents below as evidence of actual confusion:

(a) Email exchange involving Mrs Claire Hilton (“Mrs Hilton”): Mrs Hilton, a teacher providing materials to the Applicant, requested a change in class on the Applicant’s platform but mistakenly sent her administrative request to the Opponent instead. She realised her mistake of her own accord.

(b) Email exchange involving Ms Lisa Edwards (“Ms Edwards”): Ms Edwards, a teacher providing materials to both the Applicant and the Opponent mistakenly mentioned the Applicant when she wrote to the Opponent about the issues with regard to her application to teach on the Opponent’s platform.

(c) Email exchange involving Ms Cristina V (“Ms V”): Ms V forwarded an email she received from the Applicant to the Opponent saying, “I received the below message from Allshcool today and wanted to share it with you. I wasn’t sure of the protocol, but felt it was in poor taste.”

(d) Email exchange involving Ms Lisa Diber (“Ms Diber”): Ms Diber enrolled her son on a class through the Applicant’s platform but wrote to the Opponent after finding the class on both parties’ platforms. She then asked “Is Allschool and Outschool the same thing?”.

60 I did not find it helpful to rely on the incidents above to arrive at the conclusion whether confusion is likely. Firstly, the parties involved in the emails above were not called to make any statutory declaration and were therefore not subject to sanctions for knowingly making a false declaration, should this be established. Secondly, the contents of the emails are vague. Even if the emails show that there was confusion, there is no elaboration on the cause of the confusion or extent of it. Based on the emails per se, the confusion, if any, did not occur at the point of purchase. Thirdly, I am concerned with the relevant public in Singapore and there is no evidence that the parties’ involved in the above incidents fall within this group. Fourthly, the likelihood of confusion required is that which is to be expected amongst a “substantial portion of the relevant segment of the public”, going beyond a “de minimis level”: *Caesarstone* at [57], *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941; [2013] SGCA at [78(e)]. It does not appear to me that even if the above incidents are indeed incidents of confusion, they are representative of a “substantial portion of the relevant segment of the public”.

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

61 The ground of opposition under s 8(7)(a) fails.

Conclusion

62 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds.

63 I have considered the parties' submissions on costs and, having regard to all the circumstances, award the Applicant the sum of S\$8,080.00 (inclusive of disbursements).

Tan Mei Lin
Principal Assistant Registrar

Suhaimi Lazim and Jin WenRu (Mirandah Law LLP) for the
Opponent;
Yuen Kit Kuan and Denise Thia (Drew & Napier LLC) for the
Applicant.

[An appeal from this decision to the General Division of the High Court is pending.]