

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

Trade Mark No. 40201711769U
Hearing Date: 24 August 2021

IN THE MATTER OF TRADE MARK REGISTRATION

IN THE NAME OF

MORINAGA & CO., LTD.

AND

APPLICATION FOR DECLARATION OF INVALIDITY

THEREOF BY

WEIDER GLOBAL NUTRITION LLC

Hearing Officer: Ms Tan Mei Lin
Principal Assistant Registrar of Trade Marks

Representation:

Mr Suhaimi Bin Lazim and Mr Siddharth Sriram (Mirandah Asia (Singapore) Pte Ltd)
for the Applicant

Ms Amanda Soon (Allen & Gledhill LLP) for the Registered Proprietor

GROUND OF DECISION

1 Morinaga & Co., Ltd (“the Proprietor”) is the Registered Proprietor of Trade



Mark Registration No. 40201711769U “in”¹ (“the Subject Mark”) in Class 5 in

¹ Series of two marks.

respect of “*Dietary supplements for human; Nutritional supplements; Dietary supplemental drinks; Liquid nutritional supplements; Meal replacement drinks; Mineral nutritional supplements*” (“the Registration”), registered in Singapore on 22 June 2017.

2 The Proprietor was established in Japan in 1899 by Taichiro Morinaga, to deliver nutritious and delicious Western confectionaries to the people of Japan. Today, the Proprietor’s main business activities are the manufacture, purchase, and sale of confectionaries (caramel, biscuits, chocolate, etc.), foods (cocoa, cake mix, etc.), frozen desserts (ice cream, etc.) and health products (jelly drinks, etc.). The Proprietor has established sales and manufacturing bases in the United States, Indonesia, China and Taiwan.

3 Weider Global Nutrition, LLC (“the Applicant”) is an active nutrition² company based in Phoenix, Arizona with over 70 years of expertise in nutritional sciences and goods available in over 120 countries.

4 The Applicant filed an application for declaration of invalidity on 20 August 2019. Amended Statement of Grounds was filed on 12 September 2019. The Counter-Statement was filed by the Proprietor on 13 January 2020 in defence of the Registration. The Applicant filed evidence in support of its application on 26 August 2020. The Proprietor filed evidence in support of the Registration on 11 January 2021. The Applicant filed evidence in reply on 11 March 2021. Following the close of evidence, a Pre-Hearing Review was held on 29 April 2021. Supplementary evidence was filed by the Proprietor on 25 May 2021. The Applicant filed its written submissions (“AWS”) on 23 July 2021 and the Proprietor filed its written submissions (“PWS”) on 26 July 2021. I heard parties who made oral submissions before me on 24 August 2021.

Grounds of Invalidation

5 The Applicant relies on three grounds in the Trade Marks Act (Cap 332, 2005 Rev Ed) (the “Act”). They are Section 23(3)(a)(i) read with Section 8(2)(b) of the Act, Section 23(3)(b) read with Section 8(7)(a) of the Act, and Section 23(1) read with Section 7(6) of the Act³.

Applicant’s Evidence

6 The Applicant’s evidence comprises the following:

- (a) a Statutory Declaration made by Douglas York, Corporate Controller of the Applicant, on 21 August 2020 (“ASD1”); and
- (b) a Statutory Declaration in Reply made by the same Douglas York on 4 March 2021 (“ASD2”).

² Active nutrition products are products that are formulated and marketed to consumers of all ages for the purpose of living a healthy lifestyle with integrated physical activity.

³ The grounds under Section 23(3)(a)(iii) read with Section 8(4)(b)(i) of the Act, and Section 23(3)(a)(iii) read with Section 8(4)(b)(ii)(A) and (B) of the Act were pleaded but the Applicant indicated by letter dated 6 May 2021 that those grounds will not be pursued.

Proprietor's Evidence

7 The Proprietor's evidence comprises the following:

- (a) a Statutory Declaration made by Masao Hoshino, General Manager, General Affairs Division of the Proprietor, on 8 January 2021 ("PSD1"); and
- (b) a Supplementary Statutory Declaration made by the same Masao Hoshino on 25 May 2021 ("PSD2").

Applicable Law and Burden of Proof

8 The applicable law is the Act, and in accordance with Section 101(c)(i) of the Act, "the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of the validity of the original registration". The undisputed burden of proof in this case thus falls on the Applicant.

Background

9 The Applicant is the proprietor of the following marks:

S/N	Trade Mark	Trade Mark No.	Registration Date	Goods
1	 <p>4</p> <p>(Series of two marks.)</p>	T0421581B	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.

⁴ The Register further states: The transliteration of the Japanese characters appearing in the mark is "Weider" which has no meaning.

2	 <p>(Series of two marks.)</p>	T0421579J	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.
3	WEIDER IN JELLY	T0419503Z	09/11/2004	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; non-alcoholic vitamin drinks, all included in Class 32.
4	WEIDER ENERGY IN	T0105928C	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; non-alcoholic vitamin drinks; all included in Class 32.
5	WEIDER FIBER IN	T0105927E	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.
6	WEIDER VITAMIN IN	T0105926G	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; non-alcoholic vitamin drinks; all included in Class 32.

⁵ The Register further states: The transliteration of the Japanese characters appearing in the mark is "Weider" which has no meaning.

10 The Applicant’s associate, Mariz Gestao E Investimentos Limitada (“Mariz”), is the proprietor of the following marks:

S/N	Trade Mark	Trade Mark No.	Registration Date	Goods
1	MULTI VITAMIN IN	T0421582J	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.
2	IN	T0105925I	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.

11 The marks referred to in [9] and [10] are collectively referred to as the “Applicant’s Marks”.

12 The following is a summary of the facts as set out by the Applicant.

13 Mariz was initially the owner of all “Weider” and “Weider”-formative trade marks, as well as “IN” and “IN”-formative trade marks. In 2007, by way of a Purchase and Sale Agreement dated 31 August 2007 (“Purchase and Sale Agreement 2007”), the Applicant acquired from Mariz all “Weider” and “Weider”-formative marks, excluding “IN” and “IN”-formative trade marks. Mariz is thus still the owner of all “IN” and “IN”-formative marks.⁶

14 Concurrently with the Purchase and Sale Agreement 2007, a licence agreement was entered into between Mariz and the Applicant, granting Mariz various rights to the “Weider” and “Weider”-formative marks so that Mariz could continue to support the rights it had previously licenced to Rayo International Trading Company B.V. (“Rayo”), which included not just the “Weider” and “Weider”-formative marks, but also the “IN” and “IN”-formative marks. Rayo in turn granted a sub-licence to JWO Corporation (“JWO”). The 1989 Rayo-JWO Licence Agreement is an example of such a sub-licence⁷.

15 By way of addendum to the 1989 Rayo-JWO Licence Agreement, JWO was also authorised to sell “In-Products” in association with “Weider” and “Weider”-formative marks, as well as “IN” and “IN”-formative trade marks⁸.

⁶ AWS at [5.11] and [5.12].

⁷ AWS at [5.13].

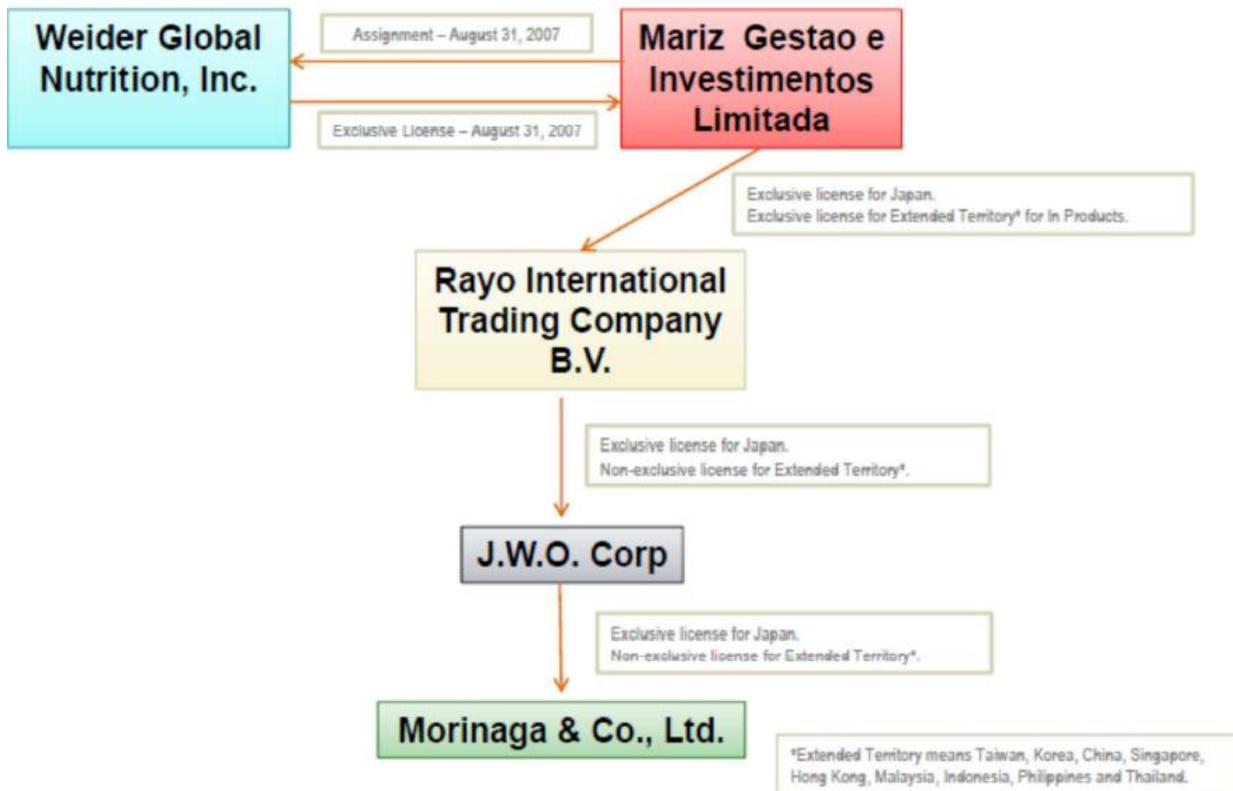
⁸ AWS at [5.08].

16 JWO first entered into a Licence and Technical Assistance Agreement (“LTAA”) with the Proprietor in 1983, and this agreement was subsequently renewed in 1988, 1993, 1998 and 2013 respectively. The 1983, 1988 and 1993 LTAA Agreements only contained the “Weider” marks. When the LTAA was renewed in 1998 and 2013, the scope was extended to include “Weider”-formative marks and also the “IN” and “IN”-formative marks⁹.

17 The latest LTAA between JWO and the Proprietor is the 2013 LTAA Agreement, which continues to be valid till 2028¹⁰.

18 The Proprietor therefore always had only those rights licenced to it by JWO through the LTAA and was never the owner of the “IN” and “IN”-formative marks.

19 The diagram below shows in a nutshell the licensing structure between the parties.



20 The parties were previously involved in another case before this tribunal, namely, *Weider Global Nutrition, LLC v Morinaga & Co., Ltd* [2020] SGIPOS 13 (“WGN”). In that case, I allowed the Applicant’s opposition under Section 8(2)(b) but not under Sections 8(4)(b)(i), 8(4)(b)(ii)(A), 8(4)(b)(ii)(B), 8(7)(a) and 7(6) of the Act. I will make reference to WGN in my decision below where relevant but it is worth highlighting here that the marks and goods concerned in WGN are not identical to the present case. They are as follows:

⁹ AWS at [5.04].
¹⁰ AWS at [5.05].

	Proprietor's Mark (The Proprietor was the applicant in WGN)	Applicant's Mark (among others) (The Applicant was the opponent in WGN)
Mark	 <p>(Series of two marks.)</p>	IN
Specification	<p><u>Class 5</u> Dietary supplements for human; Nutritional supplements; Dietary supplemental bar; Meal replacement bar; Mineral nutritional supplements.</p> <p><u>Class 30</u> Confectionery; Cereal bars; Low calorie sweeteners; Low calorie sugar substitutes.</p>	<p><u>Class 32</u> Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.</p>

MAIN DECISION

Ground of Invalidation under Section 23(3)(a)(i) read with Section 8(2)(b)

21 The relevant provisions are:

23.—(3) The registration of a trade mark may be declared invalid on the ground —

- (a) that there is an earlier trade mark in relation to which —
(i) the conditions set out in section 8(1) or (2) apply...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

¹¹ The Register further states: The transliteration of the Japanese characters in the mark is "Wefaa" meaning "Wafer", "Nattsu" meaning "Nuts", "Purotein" meaning "Protein", "Baa" meaning "Bar", "Tegaruni Tanpakushitsu" meaning "Easy Way To Get Protein" and "Shashin Wa Imeeji Desu" meaning "Image Photo".

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.

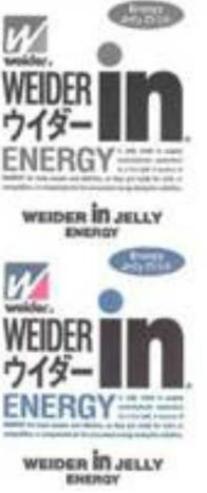
Decision on Section 23(3)(a)(i) read with Section 8(2)(b)

22 The law in Singapore on the approach to be taken in applying Section 8(2)(b) of the Act is now well-settled. The Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) reaffirmed the “step-by-step” approach which may be summarised as follows. The first step is to assess whether the respective marks are similar. The second step is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected. If the first and second steps are answered in the affirmative, the third step is to consider whether there exists a likelihood of confusion as a result of the similarities and/or identities. The court made it clear that “the first two elements are assessed individually before the final element which is assessed in the round” (*Staywell* at [15]).

Similarity of Marks

23 The Applicant relies on the trade marks below as representing its best case in these proceedings:

S/N	Trade Mark	Trade Mark No.	Registration Date	Goods
1	IN (“Applicant’s Word Mark”)	T0105925I	26/04/2001	Class 32: Non-alcoholic drinks; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks; all included in Class 32.
2	 (“Composite Mark 1”)	T0421581B	08/12/2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.

<p>3</p>	 <p>(“Composite Mark 2”)</p>	<p>T0421579J</p>	<p>08/12/2004</p>	<p>Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; non-alcoholic protein and/or carbohydrate energy drinks; non-alcoholic mineral and glucose drinks.</p>
----------	---	------------------	-------------------	--

24 The Proprietor does not dispute that the Subject Mark is similar to the Applicant’s Word Mark and only disputes that it is similar to the Applicant’s composite marks.

Comparison between Subject Mark and Applicant’s composite marks

25 For ease of reference, the marks to be compared are:

<p>Applicant’s Composite Marks</p>	<p>Subject Mark</p>
 <p>(“Composite Mark 1”)</p>	



Visual Similarity

26 The Applicant’s composite marks contain, among other things, the following:

- (a) The “” device with the word “WEIDER” under it;
- (b) The word “WEIDER”;
- (c) The word “IN”;
- (d) The Japanese characters “ウイダー”;
- (e) The word “Multivitamin” in Composite Mark 1 and “Energy” in Composite Mark 2;
- (f) The words “Weider In Jelly Multivitamin” in Composite Mark 1 and “Weider In Jelly Energy” in Composite Mark 2.

27 The word “IN” appears in the largest font. It is preceded by the word “WEIDER” in relatively smaller font but nevertheless still large and clearly visible. Above the word “WEIDER” is the “” device with the word “WEIDER” and below it, the Japanese characters “ウイダー”. The word “WEIDER” and the “” device have no meaning in the context of the goods claimed and as such they have a high degree of technical distinctiveness. The Japanese characters “ウイダー” are unlikely to be understood by the average consumer in Singapore and as such will not be particularly memorable save for the fact that the mark contains Japanese characters. The words “Multivitamin” and

“Energy” will be seen as descriptive, and also subsidiary to the words “WEIDER” and “IN” as they are in smaller and fainter font and because they appear below them.

28 Overall, I find that the following elements are dominant and distinctive in Composite Mark 1 and Composite Mark 2: the “” device, the word “WEIDER” and the word “IN”. These elements would feature in the consumer’s imperfect recollection of the marks.

29 The Subject Mark on the other hand, only has one component: the word “IN”. Consequently, that is the only thing that contributes to its overall impression.

30 Visually, the marks in comparison have in common the “IN” element. Further, the font and stylisation used is similar, if not identical. However, the High Court stated in *The Polo/Lauren Co LP v United States Polo Association* [2016] SGHC 32 at [17] that the test for visual similarity is not one of substantial reproduction, but rather, visual similarity is to be assessed by examining each of the marks in question as a whole, bearing in mind their dominant and distinctive components and by reference to the overall impressions created by the mark or signs.

31 A well-established approach for the assessment of marks-similarity, in cases where there is a common component, is to consider whether the differences between the marks are sufficient such that the latter mark does not capture the distinctiveness of the earlier mark. In *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] SGHC 175, the High Court said (at [26]–[27]):

... In cases where there is a common denominator, it is important to look at the differences between the mark and the sign in order to decide whether the challenged sign has been able to distinguish itself sufficiently and substantially ...

In the present case, the differences are obvious: the addition of the word “PACIFIC” together with the sign’s different font and design. The question, then, is whether these differences are enough so as not to capture the distinctiveness of the registered mark...

32 I have found above that the following elements would feature in the consumer’s imperfect recollection of Composite Mark 1 and Composite Mark 2: the “” device, the word “WEIDER” and the word “IN”. It is obvious that the Subject Mark does not have the first two elements and in this regard is enough so as not to capture the distinctiveness of Composite Mark 1 and Composite Mark 2.

33 I find that the marks are visually more dissimilar than similar.

Aural Similarity

34 The Court of Appeal in *Staywell* (at [31] to [32]) established two approaches to assessing aural similarity. The first is to consider the dominant component of the marks and the second is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not.

35 Composite Mark 1 and Composite Mark 2 would most likely be aurally referred to either as “WEIDER IN” in both cases or “WEIDER IN MULTIVITAMIN” and “WEIDER IN ENERGY” respectively. Whichever way they are referred to, their aurally dominant component would be the word “WEIDER” as it is technically distinctive in relation to the goods concerned as well as distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer. The aurally dominant component of the Subject Mark on the other hand, is the word “IN” as that is the only component in the mark. The marks are therefore aurally dissimilar based on the dominant component approach.

36 As for the quantitative approach, I would also reach a similar conclusion. If the Applicant’s composite marks are read as “WEIDER IN”, they would have three syllables. On the other hand, the Subject Mark has one. They have only one syllable in common and cannot be said to have more syllables in common than not.

37 Considering the above, I therefore find that the marks are aurally more dissimilar than similar.

Conceptual Similarity

38 Conceptual similarity is directed at the ideas that lie behind and inform the understanding of the marks as a whole (*Staywell* at [35]).

39 The Subject Mark consists only of the word “IN”. “IN” has several meanings in the dictionary but in the context of the goods, “IN” is most likely to be taken as conveying something fashionable or popular.

40 The Applicant’s composite marks have many components. However, the word “Weider”, which appears three times in each of the marks, is clearly a dominant component conceptually. To some, the word may be a family name, while others may see it as an invented word. In either case, this concept does not exist in the Subject Mark and the marks are conceptually dissimilar.

Conclusion on Similarity of Marks

41 I have concluded that the Applicant’s composite marks in comparison to the Subject Mark is visually and aurally more dissimilar than similar and conceptually dissimilar. Overall, I am of the view that the marks are more dissimilar than similar.

42 Having regard to the 3-step test, my conclusion above ends the analysis with regard to the Applicant’s composite marks (and that the application for a declaration of invalidity on this ground fails in relation to these marks).

43 The rest of the discussion will focus on the Applicant’s Word Mark.

Similarity of Goods

44 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 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.

45 For ease of reference, the goods to be compared are:

Proprietor’s Goods	Applicant’s Goods
Class 5: Dietary supplements for human; <i>Nutritional supplements; Dietary supplemental drinks; Liquid nutritional supplements; Meal replacement drinks; Mineral nutritional supplements.</i>	Class 32: Non-alcoholic drinks; <i>non-alcoholic protein and/or carbohydrate energy drinks</i> ; non-alcoholic mineral and glucose drinks; all included in Class 32.

46 The goods I will be considering in greater detail below are indicated in italics and it is not in dispute that as long as there is similarity or overlap between one item, this step in the analysis is made out.

47 The Applicant submits:

- (a) the goods are subject to similar use by consumers as both parties’ goods are nutritional supplements;
- (b) the users are the same as both parties’ goods are targeted at the public at large and, in particular, to consumers of health foods and consumers seeking a fast nutritional or energy boost.

48 The Proprietor, on the other hand, submits:

- (a) the uses and main function of the Applicant’s goods and the Proprietor’s goods are dissimilar. As Class 32 goods, the Applicant’s goods are predominantly intended to quench thirst. On the other hand, the Proprietor’s goods in Class 5, which are dietary supplements in general, are mainly intended for balancing nutritional deficiencies or used for medical purposes in the broad sense, and not to quench thirst or to form part of standard human nutrition;

(b) the users of the respective goods are also dissimilar. Taking into account the intended purposes of the respective goods, the users of the Applicant's goods will be those who wish to drink a beverage to quench their thirst, whereas the users of the Proprietor's goods are those who wish to balance nutritional deficiencies and supplement their diet.

49 I agree that some of the Applicant's goods may be consumed to quench thirst. However, there are also others, such as "non-alcoholic protein and/or carbohydrate energy drinks", which are not consumed for that purpose. Energy drinks are generally drunk for their nutritional value or functional benefit (to enhance mental alertness and physical performance) and such nutritional value and functional benefit may also be provided by the Proprietor's goods such as "nutritional supplements" and "dietary supplemental drinks". For this reason their uses are similar.

50 Further, the Proprietor's goods, for example, "nutritional supplements" and "liquid nutritional supplements", are broad enough to include protein and/or carbohydrate supplements. In this regard, the Applicant's "non-alcoholic protein and/or carbohydrate energy drinks", provide the same nutrients as the Proprietor's goods.

51 There is thus an overlap in the users of the respective goods – those seeking energy boosting carbohydrate and/or protein supplements or drinks.

52 With regard to the physical nature of the goods, there is also an overlap between the Proprietor's "liquid nutritional supplements" and the Applicant's "non-alcoholic protein and/or carbohydrate energy drinks" as they are both in liquid form.

53 In terms of trade channels, both the Applicant's goods and the Proprietor's goods are made available to consumers through supermarkets and specialty stores. They therefore have similar trade channels. The goods are, however, not found on the same shelves in supermarkets.

54 Finally, moving on to whether the goods are competing or complementary, I have found above that the nutritional and functional value of the Applicant's "non-alcoholic protein and/or carbohydrate energy drinks" may also be obtained by consuming the Proprietor's goods (such as "nutritional supplements" and "liquid nutritional supplements"). The goods are thus in competition with one another.

55 Considering all the factors above, I find that the parties' goods are more similar than dissimilar, and the degree of similarity is above average.

Likelihood of Confusion

56 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.

57 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]).

58 Although the Court of Appeal in *Caesarstone* was concerned with opposition proceedings whereas the proceedings here are for invalidation, the same test is applicable.

59 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.

Factors Relating to the Impact of Marks-similarity

60 The Proprietor does not dispute that there is similarity between the Subject Mark and the Applicant’s Word Mark. Indeed, I find that the marks are similar to an above average degree. The registration of a word in block letters suffices to cover the use of that word in “*every font or style*” as was affirmed in *Allergan, Inc and another v Ferlandz Nutra Pte Ltd* [2016] SGHC 131 at [44]. Thus, the Applicant’s Word Mark covers the use of the Subject Mark which, though in a particular font, is not unusual or highly stylised.

61 In relation to the reputation of the marks, the Applicant submits that it has a strong reputation in its “IN” and “IN”- formative marks by virtue of the use by the Proprietor, as a licensee, and this is evident in royalty and advertising expense reports for goods bearing the Applicant’s Marks. The Applicant asserts¹² that it owns a family of “IN” related trade marks and that “consumers are most likely aware that products bearing the common element “IN” hail from a single trade origin, namely the Applicant/Mariz”.

62 I am not persuaded, based on the evidence that has been lodged, that the Applicant has a strong reputation in the element “IN” for the following reasons.

63 Firstly, the Applicant has provided little evidence of use in Singapore that pre-dates the filing date of the Registration. Most of the evidence is either undated, dates from 2019 onwards or relates to use outside Singapore.

¹² AWS at [7.34].

64 Secondly, while the Applicant has submitted royalty reports for Singapore¹³, these figures alone merely show that the marks have been used in Singapore but are not helpful in showing the size of the market it commands or its reputation.

65 Thirdly, the evidence does not show that there has been any use of the element “IN” on its own. Instead, “IN” has always been used in conjunction with other distinctive elements such as the “W” device and the word “WEIDER”. An example of such use is:



66 Fourthly, the Applicant should not be permitted to argue that it has a family of “IN” marks as this was not pleaded in the Statement of Grounds. If the Applicant seriously intended to pursue this claim, it should have indicated so at the first opportunity or applied to amend its pleadings to state so.

67 The evidence thus falls short of showing that the element “IN” has a reputation in Singapore.

68 As for impression of the marks, both parties’ marks have only the word “IN” and that is the only factor contributing to their impression. The consumer is thus very likely to be confused into thinking that the Subject Mark is a stylised or updated version of the Applicant’s Word Mark and hence assume that goods labelled with the Subject Mark emanate from the Applicant or from an economically linked undertaking.

Factors Relating to the Impact of Goods-similarity

69 I have concluded at [55] that the parties’ goods are similar to an above average degree.

70 The goods concerned are ordinary consumer products that are commonly purchased in supermarkets or establishments where goods are arranged on shelves and where consumers are guided more by the visual impact of the marks they are looking for. I do not, however, discount the fact that the goods may also be purchased aurally.

71 While the goods are relatively inexpensive, because the goods are to be consumed for its nutritional value and to improve physical well-being, the consumer is likely to devote attention and care to the purchase of the goods. Nonetheless, overall, I do not think that this is sufficient to obviate a likelihood of confusion, taking into account the above average degree of similarity between the parties’ marks and goods. The

¹³ Exhibit 10 of ASD1.

Applicant's customers or potential customers encountering the Proprietor's goods may assume that they come from the same or an economically linked undertaking.

Conclusion on Likelihood of Confusion

72 Taking all the above factors into account, I find that there is a real risk of a likelihood of confusion between the Subject Mark and the Applicant's Word Mark.

Conclusion on Section 23(3)(a)(i) read with Section 8(2)(b)

73 The ground of invalidation under Section 23(3)(a)(i) read with Section 8(2)(b) therefore succeeds.

Ground of Invalidation under Section 23(3)(b) read with Section 8(7)(a)

74 The relevant provisions are:

23.—(3) The registration of a trade mark may be declared invalid on the ground —

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

8.—(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;

Decision on Section 23(3)(b) read with Section 8(7)(a)

75 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] SGCA 33 ("*Singsung*") set out the legal framework for the tort of passing off at [26]-[28] as follows:

26 The basic principle undergirding the law of passing off is that a trader should not sell his or her goods on the pretext that they are the goods of another trader. There are two oft-quoted formulations of the tort of passing off. The first is found in Lord Diplock's speech in *Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Ltd and another* [1979] 1 AC 731 ("*Advocaat*") at 742 where Lord Diplock stated five characteristics of a cause of action in passing off, namely: (1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

27 The second formulation is the “classical trinity” stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] WLR 491 (“*JIF Lemon*”) at 499:

...The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get-up” (whether this consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. ... Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.

28 Both Lord Diplock’s five characteristics in *Advocaat* and Lord Oliver’s reformulation in *JIF Lemon* have found expression in the judgments of our courts (see, for example, *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Novelty*”) at [36]). It has been suggested in a number of cases that there is no difference between these formulations, and that the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty* at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 (“*Nation Fittings*”) at [148]). We accept this, by and large, as the correct position. However, we also agree with Prof Wadlow’s view that Lord Diplock’s five characteristics, focusing as they do on the issue of misrepresentation and damage, “probes more deeply into the inwardness of the tort” (Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011) (“*Wadlow on Passing Off*”) at para 1–027). The essence of passing off – that no person is permitted to steal another’s trade *by deceit* – must not be forgotten. What the tort seeks to protect is not the plaintiff’s use of a mark, name or get-up *per se*; rather, the tort seeks to prevent the defendant from causing damage to the plaintiff by committing an actionable misrepresentation.

76 With the above in mind, I examine the elements of passing off in turn.

Goodwill

77 The Court of Appeal in *Singsung* clarified the nature of goodwill at [33]-[34] as follows:

33 The goodwill relevant to a passing off action is not goodwill in the mark, logo or get-up (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“*CDL Hotels*”) at [45]). Instead, the tort of passing off protects a trader’s *relationship* with his customers. As was stated by Lord Parker of Waddington in *AG Spalding & Bros v A W Gamage Ld* (1915) 32 RPC 273 at 284:

There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question – property in what? Some authorities say property in the mark, name, or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v Banham* (LR (1906) AC 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think strong reasons for preferring the latter view. ...

34 In our judgment, goodwill, in the context of passing off, is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses (see *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 (“*Lifestyle 1.99*”) at [20]–[24]; *Wadlow on Passing Off* at paras 3–003 and 3–004; James Mellor QC *et al*, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) (“*Kerly’s Law of Trade Marks and Trade Names*”) at para 18–100). Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys: *CDL Hotels* at [46]. Goodwill may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear (see *SPGA* at [22]).

78 The Proprietor does not dispute that the Applicant has acquired goodwill in Singapore¹⁴.

Misrepresentation

79 I have found earlier that there is an above average degree of similarity between the Subject Mark and the Applicant’s Word Mark but the Subject Mark is more dissimilar than similar to the Applicant’s composite marks. The rest of the discussion will focus on the Applicant’s Word Mark as my finding on dissimilarity is sufficient to dispose of the question of misrepresentation (*ie*, to justify a finding that there is no misrepresentation), in the use of the Subject Mark *vis-à-vis* the Applicant’s composite marks.

¹⁴ PWS at [69].

80 Under this element I have to consider whether the Applicant’s goodwill is sufficiently associated with the Applicant’s Word Mark, or, put another way, whether the Applicant’s Word Mark is distinctive of the Applicant’s goods. If so, the Applicant will have to satisfy two further requirements: first, that there is a misrepresentation made by the Proprietor in adopting the use of the Subject Mark, and second, that a sufficient likelihood of confusion will arise from this.

81 The significance of distinctiveness was further elaborated upon by the Court of Appeal in *Singsung* at [38] as follows:

...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...*

(Emphasis mine)

82 It is to be borne in mind that distinctiveness is generally considered in relation to the class of consumers of the goods in question (*ie*, the relevant public). This means that the Applicant has to prove that the Applicant’s Word Mark is distinctive of the Applicant in the eyes of the consumer.

83 Having reviewed the Applicant’s evidence, I find that the Applicant has not sufficiently discharged its burden of showing that the word “IN” is sufficiently associated with its goodwill to sustain a claim under the tort of passing off.

84 In this regard, I repeat the reasons given in [63]-[65].

85 Additionally, the Proprietor’s evidence¹⁵ shows that where the Applicant’s Weider-IN Jelly product is sold online in Singapore or referred to on local blogs and forums, the product is always referred to by its distinctive name “Weider”, in the form of “Weider in”, “Weider in Jelly” or “Weider Energy Jelly”. This suggests that consumers in Singapore do not associate the Applicant’s goodwill to the word “IN”, but “Weider” or “Weider in”.

86 Consequently, the element of misrepresentation is not made out.

Conclusion on Section 23(3)(b) read with Section 8(7)(a)

87 The ground of invalidation under Section 23(3)(b) read with Section 8(7)(a) fails.

Ground of Invalidation under Section 23(1) read with Section 7(6)

88 Section 23(1) of the Act reads:

¹⁵ PSD1 at [20] and Exhibit MH-5

23.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

89 Section 7(6) of the Act reads:

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

The law

90 The leading case on Section 7(6) of the Act is the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). A restatement of the key principles in *Valentino* is set out below.

(a) 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] referring to *Rothmans of Pall Mall Ltd v Maycolson International Ltd* [2006] 2 SLR(R) 551 at [29] and Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell Asia, 2nd Ed, 2005) at para 5.71.)

(b) The legal burden of proof needed to substantiate an action on this ground lies on the party bringing the application. (*Valentino* at [21] referring to *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [33].)

(c) 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] referring to *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [48].)

(d) The test for determining the presence of bad faith is a “combined” one, in that it contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). 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] referring to *Wing Joo Long* at [105] – [117].)

(e) 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] referring to *Nautical Concept Pte Ltd v Jeffery Mark Richard and anor* [2007] 1 SLR(R) 1071 (“*Nautical Concept*”) at [15].) However, as observed in Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 at [21.4.1], footnote 109, this does not mean that there is an absolute prohibition against drawing inferences. (In support of this observation, Professor Ng-Loy cited the decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115], where the

High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)

Decision on Section 23(1) read with Section 7(6)

91 The Applicant's position on this ground is that Mariz is the owner of the "IN" alone and "IN"-formative trade marks without the "Weider" element ("IN" trade mark"). The Proprietor is merely a licensed manufacturer of the products sold under the "IN" trade mark, using the technical knowledge from JWO in accordance with the LTAA agreement, and does not have independent rights to the trade mark.

92 The Applicant's allegations, however, are not supported by the evidence.

93 Firstly, the evidence is insufficient to support a finding that Mariz owns the "IN" trade mark.

94 The licensing agreements and renewals also do not show that Mariz is the owner of the "IN" trade mark. The Applicant's best evidence on this point appears to be in the Second Amended and Restated License Agreement dated 31 August 2007¹⁶ entered into between the Applicant and Mariz, in particular, clause 3.3 which reads:

3.3 Notwithstanding the sale and transfer of the Combination Trademarks by Mariz to WGN pursuant to the Mariz-WGN Purchase and Sale Agreement, WGN acknowledges and agrees that it does not have and, will not have at any time in the future, any rights, title or interest in or to the "IN" component of the Combination Marks (the "IN Components"). [REDACTED] WGN agrees not to use any IN Component as a trademark and/or service mark in association with any product or service anywhere in the world and to maintain the confidentiality of, and not use to the benefit of WGN or any of its Affiliates or licensees, any information acquired in respect of any product or service in respect of which any IN Component, or any new trademark and/or service mark incorporating any IN Component, in whole or in part, will be used by the Third Party Licensee.

(redaction in original)

95 However, the clause is inconclusive as to ownership of the "IN" trade mark. It merely shows that the Applicant does not have any rights to it and is silent on the rights of Mariz.

96 As for the fact that Mariz has a registration of the plain word mark "IN" in Class 32, this fact is not helpful as the Subject Mark is in Class 5. The registration in Class 32 does not grant Mariz a monopoly over "IN" in other classes.

97 Coupled with this lack of evidence, I note that Mariz has remained completely silent throughout these proceedings. This is so even though I have found earlier in *WGN* that I was unable to conclude from the evidence that Mariz is the owner of the "IN" trade mark. In view that Mariz is the Applicant's associate, it should not have been difficult for the Applicant to obtain a statement from Mariz as to its ownership of the "IN" trade mark or explain why it was not able to procure such a statement. It is puzzling why the Applicant did not do so and instead chose to prove ownership in such an indirect manner.

¹⁶ Exhibit 7 of ASD1.

98 Secondly, it is the Proprietor's position that it is, in fact, the proprietor of the "IN" trade mark. The Proprietor supports its contention with evidence to show:

- (a) it had used the names PROTEIN IN, ENERGY IN and VITAMIN IN for sports drinks as early as 1992;
- (b) the package design of the Weider IN Jelly products were produced at the request of the Proprietor as early as 1992.

99 While the above documents do not demonstrate who owns the "IN" trade mark, it shows that the Proprietor may possibly have some interest in the "IN" trade mark which pre-dates the registration Mariz has in Singapore.

100 Having considered all relevant matters and in particular bearing in mind that an allegation of bad faith is a serious one, I find that the Applicant has not met the standard of proof that is required to establish bad faith.

Conclusion on Section 23(1) read with Section 7(6)

101 The ground of invalidation under Section 23(1) read with Section 7(6) fails.

Conclusion

102 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the application for a declaration of invalidity succeeds on the ground under Section 23(3)(a)(i) read with Section 8(2)(b) but fails on the other two grounds.

Costs

103 As the Applicant has succeeded on only one out of three grounds and taking into account all the circumstances of the case, the Applicant will be entitled to one-third of its costs, which are to be taxed, if not agreed.

Date of Issue : 23 November 2021