

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

Trade Mark No. 40201909725V
24 March 2021

IN THE MATTER OF A TRADE MARK APPLICATION BY

NIPPON PAINT (SINGAPORE) CO. PTE. LTD.

AND

OPPOSITION THERETO BY

WARRIOR PTE LTD

Hearing Officer: Ms See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

Representation:

Mr Maurice Cheong and Mr Eugene Lau Yunkang (Lee & Lee) for the Applicant
Mr Aaron Thng and Mr Marcus Hoh (Amica Law LLC) for the Opponent

GROUNDS OF DECISION

1 This is a dispute between an established market player and a relative newcomer to the arena. The marks in issue are, interestingly, both model numbers and trade marks. The earlier entrant's concerns appear to go beyond the mark under opposition, but, as we shall see, the issues argued and adjudicated upon do not always neatly mirror concerns in real life.

2 Nippon Paint (Singapore) Co. Pte. Ltd. ("**the Applicant**") applied to register the trade mark **NW1** ("**the Application Mark**") in Singapore on 3 May 2019 ("**the Relevant Date**") under Trade Mark No. 40201909725V in Class 1, in respect of the following specification of goods:

Adhesives for industrial purposes; adhesives for floor, ceiling and wall tiles; roofing adhesive; adhesives for use in bonding materials [industrial]; adhesives for cement manufactured products; adhesives for waterproofing; adhesives for plaster; industrial adhesives for use in coating and sealing; preparations for bonding purposes, other than for stationery or household use; quick bonding adhesives for industrial use; bonding agents for concrete; bonding agents for masonry; bonding agents for admixture with grouts; bonding agents for admixture with mortars; chemical additives for use in industry; chemical additives for use with concrete; chemical products for use as additives to cement; chemical products for use as additives to mortar; chemical additives for grouting materials; chemical additives for plaster; polymers for industrial use; hardening agents; chemical compositions for hardening cement; compositions for setting cement; binders for use in the formulation of sealants; waterproofing preparations [chemical]; anti-damp insulating compositions, other than paint; damp-proofing chemicals, except paints, for masonry; chemical compounds for use in repair; chemical preparations for repairing worn surfaces; plasticisers; curing preparations; chemical compositions for curing concrete; reinforcing fillers.

Opposition

3 Warrior Pte Ltd (“**the Opponent**”) filed its Notice of Opposition to oppose the registration of the Application Mark on 12 September 2019. The Opponent relies on Section 8(2)(b) and Section 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**the Act**”) in this opposition.

Opponent’s Evidence

4 The Opponent’s evidence comprises the following:

- (i) a Statutory Declaration made by See Keat Seng Patrick, General Manager of the Opponent, on 1 June 2020 in Singapore (“**See’s SD**”); and
- (ii) a Statutory Declaration in Reply made by the same See Keat Seng Patrick, on 23 November 2020 in Singapore (“**See’s SD in Reply**”).

Applicant’s Evidence

5 The Applicant’s evidence comprises a Statutory Declaration made by Ng Hwee Heng Davis, Senior Manager, Design and Contracts, of the Applicant, on 1 October 2020 in Singapore (“**Ng’s SD**”).



Applicable Law and Burden of Proof

6 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Background

7 The Opponent is a Singapore company specialising in the development and provision of industrial chemicals and waterproofing products to the construction industry. It commenced trading as “Keats Agencies” in 1984, and changed its name to “Warrior Pte Ltd” in 2004 as it expanded its business¹. The Opponent claims that its most famous product is its “W1” brand of cement strengtheners², which has been sold for more than three decades³.

8 The Opponent markets its “W1” cement strengtheners under the following marks (“Opponent’s Marks”)⁴, and also relies on these earlier marks in its opposition to the registration of the Application Mark.

| Trade Mark No. | T0613382A | T0312646H |
|---------------------------------------|--|---|
| Mark |  |  |
| Limitation on Register of Trade Marks | The mark is limited to the color(s) green as shown in the representation on the form of application. | The mark is limited to the color(s) green as shown in the representation on the form of application. |
| Status | Registered | Registered |
| Registration Date | 6 July 2006 | 23 August 2003 |
| Goods | Class 1: Adhesives for industrial purposes namely adhesives for tiles; adhesives for flooring; adhesives for bathtubs and sanitary ware; tiling and flooring grout additive [chemical]; bonding agent; additives [chemical] for cement and cement-type materials with hardening or strengthening properties; sealants [chemicals] for tiles and flooring; waterproofing preparations [chemical] for cement and cement-type materials; cement-waterproofing preparations (except paints); damp proofing preparations | Class 1: Adhesives for industrial purposes, adhesives for wall tiles, grout, bonding agent, dust sealer, waterproofing chemicals for cement, cement-waterproofing preparations except paints, damp proofing preparations, except paints, for masonry, plasticiser. |

¹ [3] of See’s SD

² Cement strengtheners are bonding agents added to cement mixtures to enhance the quality of cement and improve its characteristics.

³ [4] of See’s SD

⁴ [7] of See’s SD

| | | |
|--|---|--|
| | (except paints) for masonry; plasticiser. | |
|--|---|--|

9 The Applicant is the main Singapore distributor and an affiliate of Japanese paint and paint products manufacturing company, Nippon Paint Holdings Co., Ltd. Its founder, Mr Goh Cheng Liang, set up his first paint shop in Singapore in 1955, and the Applicant itself was established in 1962⁵. The Applicant provides a broad range of paint products and professional painting services, essentially end-to-end solutions for different kinds of painting needs.

10 The Application Mark, **NW1**, was coined by the Applicant to represent “Nippon Water-based 1 pack”. The underlying concept was that the product bearing the Application Mark is water-based, comprising one pack, rather than two packs⁶. The Application Mark is used in relation to cement strengthener, as seen from the Applicant’s technical data sheet for “NW1 Cement Strengthener”⁷.

MAIN DECISION

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

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

(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.

Three-Step Test

12 The Court of Appeal in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”) set out the approach under Section 8(2)(b) of the Act – namely the “*step-by-step*” approach, which may be summarised as follows:

- (i) The first step is to assess whether the respective marks are similar.
- (ii) 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 protected⁸.
- (iii) The third step is to consider whether there exists a likelihood of confusion because of the marks- and goods/services-similarities.

⁵ [6] and Exhibit 1 of Ng’s SD

⁶ [17vii.] of Ng’s SD. The intention is to inform purchasers that there is no need to add a second pack of hardener to activate a base for their product.

⁷ Exhibit 7 of Ng’s SD

⁸ In the present case, it is not in dispute that the respective goods in Class 1 are identical or at least similar: [55] of the Applicant’s written submissions.

The Court of Appeal made it clear that “*the first two elements are assessed individually before the final element which is assessed in the round*” (*Staywell* at [15]). If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

13 The above approach was subsequently applied by the same court in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”). In the latter decision, the Court of Appeal gave further guidance on the application of the “*step-by-step*” approach and I shall make references to this in the present case.

Marks-Similarity: Principles

14 In assessing the respective marks for similarity, the following principles are relevant:

- (i) The assessment of marks similarity is mark-for-mark, without consideration of any external matter⁹: *Staywell* at [20].
- (ii) The marks are to be compared “as a whole”: *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”; also a Court of Appeal decision) at [40(b)]. When speaking of the assessment of a mark as a whole, the similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components: *Staywell* at [23], [26].
- (iii) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression: *Staywell* at [17] – [18].
- (iv) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side and examined in detail for the sake of isolating particular points of difference. This is because the person who is confused often makes a comparison from memory removed in time and space from the marks: *Hai Tong* at [40(d)], [62(a)].
- (v) The marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some care and a measure of good sense in making his purchases: *Hai Tong* at [40(c)].



Marks-Similarity: Analysis

⁹ See *GCIH Trademarks Limited v Hardwood Pte Ltd* [2021] SGIPOS 6 at [33] to [40] and [104] to [113] for a fuller discussion of this principle in a recent decision of the Registrar of Trade Marks. This is also the reason why, in the present case, the Opponent’s evidence of use was not considered at Step 1 of the Three-Step Test from *Staywell*.

Visual Similarity

15 With the above in mind, I first consider whether the Application Mark is visually similar to either of the Opponent’s Marks.

16 The marks under comparison are reproduced below only for ease of reference. I am very mindful that visual comparison is done through the lens of imperfect recollection of the average consumer, and that the analysis itself should not be conducted with the marks side by side.

| Application Mark | Opponent’s Marks |
|-------------------|---|
| <p>NW1</p> |  <p>(“Opponent’s Mark 1”)</p> |
| |  <p>(“Opponent’s Mark 2”)</p> |

Application Mark Compared With Opponent’s Mark 1

17 It is the Opponent’s submission that the distinctive and dominant component of Opponent’s Mark 1 is “W-1”, and that the rectangular device is of negligible significance, if any. The Applicant takes the opposite position, that the green rectangle is a distinctive and dominant component of the mark when it is viewed as a whole. This is because the rectangular device occupies a central position and comprises about 70% of the entire mark by size. The Applicant submits that the alphanumeric “W-1” is much smaller in size, comprising only about 30% of the Opponent’s Mark 1 and is unlikely to alter the overall visual impression left by the large, green rectangle in the mind of the average consumer. In rebuttal, the Opponent submits that size is only one factor and that it is equally important to consider the significance of the component.

18 I am not inclined to think that Opponent’s Mark 1 has *one* visually distinctive and dominant component as such. Rather, it is the mark as a whole, being the combination of the alphanumeric component “W-1”, the very large, solid rectangle, and the green mono-colour of the entire mark, that makes a distinctive visual impact¹⁰. It is not always

¹⁰ The conclusion on an aural or conceptual comparison, would, however, differ.

the case that the alphanumeric element of a composite mark is the visually distinctive and dominant component.

19 As regards the Application Mark, the Opponent submits that it is dominant and distinctive as a whole. The Applicant appears to agree with this, as its submissions on marks-similarity was on the basis of “NW1” as a whole, and not any particular constituent component. The point is relatively straightforward, and I take the same view.

20 I further find that Opponent’s Mark 1 is of a low level of inherent distinctiveness¹¹. It is not an invented word (such as “Kodak”), and thus, is not of a high level of distinctiveness. The structure and length of the component “W-1” comes across strongly as a model number (which is of a functional nature, to allow consumers to conveniently pinpoint the technical product they wish to purchase from among the Opponent’s offerings) and not purely as a badge of origin. The Opponent submitted at the hearing that the fact that “W-1” is a model number does not preclude it from also functioning as a trade mark. I agree. However, the fact that it is a model number (of a functional nature unrelated to trade origin) diminishes its distinctiveness as a trade mark, a badge of origin. Opponent’s Mark 1 therefore enjoys (only) a low threshold before a competing mark, such as the Application Mark, would be considered visually dissimilar to it.

21 The Court of Appeal in *Caesarstone* opined at [32]:

In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816, Lai Kew Chai J held (at [26]) that “[i]n 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”. We agree with this.

22 Here, the only common denominator in both marks is the letter “W” and the numeral “1” in that sequence. The main visual differences between the Application Mark and Opponent’s Mark 1 lie in the first letter “N” of the Application Mark; the hyphen in “W-1” of the Opponent’s Mark 1, separating the letter “W” from the numeral “1”; and the large, green rectangle of the latter.

23 It is further noted that Opponent’s Mark 1 is subject to a colour limitation: The mark is limited to the color(s) green as shown in the representation on the form of application. It is debatable whether a limitation on the register should be a factor in the marks-similarity analysis – because it is conducted from the consumer’s perspective and the consumer is not always aware of the state of the register of trade marks. Nonetheless, the limitation points to the Opponent’s belief that the colour green is significant to some degree in relation to the visual perception of Opponent’s Mark 1 as a whole. Otherwise, there would have been no need to subject the registration to such a limitation.

¹¹ The Opponent submits at [31] of its written submissions that “*the registered marks’ technical distinctiveness is also evident from the considerable acquired distinctiveness they enjoy in Singapore*”. See footnote 9 on why I did not take into account the Opponent’s evidence of use, and, accordingly, any acquired distinctiveness, at Step 1 of the *Staywell* test.

24 Thus, comparing both marks as wholes (with no specific distinctive and dominant components), I consider whether the differences highlighted above allow the Application Mark “*to distinguish itself sufficiently and substantially*” from Opponent’s Mark 1.

25 The parties have cited various case authorities from the European Boards of Appeal and the UK Comptroller General of Trade Marks in support of their respective positions on comparing short marks. These turn on the facts of each case, and use the global assessment test rather than the 3-step *Staywell* test. Thus, I have not found them particularly compelling to rely on either way.

26 Bearing in mind that the comparison of the marks is not made side by side, but based on the imperfect recollection of the average consumer, I find the Application Mark has “*distinguish(ed) itself sufficiently and substantially*” from Opponent’s Mark 1 based on a low threshold. The differences between the alphanumeric elements “NW1” and “W-1”, as well as the wholly different structure and look of Opponent’s Mark 1



with the large, visually impactful green rectangle, formed the basis of my finding.

27 Thus, I find that the Application Mark and Opponent’s Mark 1 are rather more dissimilar than similar visually.

Application Mark Compared With Opponent’s Mark 2

28 The main difference between Opponent’s Mark 1 and Opponent’s Mark 2 lies in the large, green rectangle in the former, and the words “cement strengthener” in the latter. The additional words in Opponent’s Mark 2 are wholly descriptive and not distinctive. The component “W-1” is also in larger, bolder font compared to the descriptive words and appears first, reading from left to right. Hence, it is uncontroversial that the dominant and distinctive component of Opponent’s Mark 2 is the alphanumeric element “W-1”.

29 As with Opponent’s Mark 1, I likewise find Opponent’s Mark 2 to be of a low level of inherent distinctiveness. The difference in words between the Opponents’ Marks, namely “cement strengthener”, do not increase the level of distinctiveness of Opponent’s Mark 2 in any way. They are wholly descriptive and non-distinctive. In fact, without the visual content of the large, green rectangle in Opponent’s Mark 1, Opponent’s Mark 2 may even be considered less distinctive visually, than the former.

30 I come to the visual comparison of the Application Mark and Opponent’s Mark 2. In essence, I compare “NW1” and “W-1” as dominant and distinctive subject matter, but bearing in mind that the latter is combined with the words “cement strengthener” to form an overall visual impression of Opponents’ Mark 2 as a longer mark with two sections of text – the left section comprising the element “W-1” in block lettering, and the right comprising a long line of text “floating” at the top end of the mark.

31 I find the Application Mark has “*distinguish(ed) itself sufficiently and substantially*” from Opponent’s Mark 2 based on a low threshold. In addition to the different visual impression created by the length and structure of Opponent’s Mark 2,

the differences between the alphanumeric elements “NW1” and “W-1” are sufficient to visually distinguish the marks as wholes. The difference of the letter “N” would be very significant in the context of very short marks such as those here. Looking at it from another perspective, it is also against public policy to easily allow a trader to monopolise a simple combination of one letter of the alphabet combined with one numeral to the exclusion of other longer marks (such as the Application Mark) using the same letter and numeral with other element(s).

Aural Similarity

Application Mark Compared With Opponent’s Mark 1

32 I now consider whether the Application Mark is aurally similar to the Opponent’s Mark 1.

33 Again, I assess the distinctive and dominant component of Opponent’s Mark 1, this time aurally. The pronunciation of the mark would be “W” “one”¹², and I can fairly conclude that “W-1” is the distinctive and dominant aural component of Opponent’s Mark 1. As for the Application Mark, it is simply the mark as a whole that is aurally distinctive and dominant, rather than any particular constituent. The Application Mark would be pronounced “N” “W” “one”.

34 Aurally, Opponent’s Mark 1 possesses a low level of technical distinctiveness, again because it comes across strongly as a model number when pronounced, and not purely as a badge of origin. Opponent’s Mark 1 therefore enjoys a low threshold before a competing mark would be considered aurally dissimilar to it.

35 Overall, I am persuaded that the Application Mark (pronounced “N” “W” “one”) and Opponent’s Mark 1 (pronounced “W” “one”) are marginally more aurally similar than they are dissimilar.

Application Mark Compared With Opponent’s Mark 2

36 Similar to my comments at [28] to [29] on Opponent’s Mark 2, the additional words “cement strengthener” do not modify the aural impression of the mark much from a “badge of origin” perspective¹³. This is such that the average consumer may not verbalise the words “cement strengthener”, or if he does, the aural impression of these words is diminished as compared to that of “W-1” (pronounced “W” “one”).

37 Hence, I come to the same conclusion as above, that the Application Mark and Opponent’s Mark 2 are marginally more aurally similar than they are dissimilar.

¹² The Applicant submits that Opponent’s Mark 1 is pronounced as “DOUBLEYOU-DASH-ONE” with the hyphen pronounced as “DASH”. This is highly unnatural and doubtful from the perspective of the average consumer.

¹³ See, for example, [28] of *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 where the mark in question had a strapline, “Innovation Saves Space” beneath the word “GUCCITECH”. The IP Adjudicator found that “*the strapline would again play a relatively insignificant role in the aural rendition of the Application Mark ... In view of the fact that the dominant and distinctive part of the Application Mark remains GOO-CHEE notwithstanding the addition of other matter that is either descriptive or without trade mark significance, I find that the two marks are very similar aurally.*”

Conceptual Similarity

38 Conceptual similarity “*seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole*” (*Staywell* at [35], affirmed in *Caesarstone* at [48]).

Application Mark Compared With Opponent’s Mark 1

39 The Opponent submits that the respective marks are invented words which do not evoke any concept and thus, the factor of conceptual similarity is neutral. On the other hand, the Applicant presents two alternative lines of argument. First, the Applicant submits that the marks are conceptually dissimilar. Second, in the alternative, the Applicant submits that the marks are neither similar nor dissimilar conceptually, leading to a similar conclusion as the Opponent.

40 In connection with the Applicant’s first line of argument, the derivation of the Application Mark has been set out at [10] above. It represents “**N**ippon **W**ater-based **1** pack”. The intention is to inform consumers that there is no need to add a second pack of hardener to activate a base for their product. Even if this is not generally known to consumers, the Applicant submits that the letter “N” at the beginning of the Application Mark would suggest the origin of the goods, namely “**N**ippon”; whereas in Opponent’s Mark 1, the letter “W” would suggest the Opponent’s name, “**W**arrior”. Accordingly, the Applicant argues that the marks are conceptually not similar.

41 I have sought to find the derivation (e.g. whether “W” was indeed derived from “Warrior” as the Applicant suggests) of Opponent’s Mark 1 in the pleadings, evidence and written submissions but found none. At the hearing, I asked the Opponent’s counsel whether this was to be found in the case documents and he responded that there was no evidence on what the underlying intention of the mark is.

42 The ideas behind the marks must manifest in their look and feel, and not in something that is known only to its creator: *Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 at [43]. Hence, putting myself in the shoes of the average consumer to consider what the natural conceptual apprehension of the marks, in particular their components “NW1” and “W-1”, would be, I am inclined to think that there is none, since both marks have no particular meaning to the average consumer. Accordingly, the marks are neither conceptually similar nor dissimilar. This factor is neutral.

Application Mark Compared With Opponent’s Mark 2

43 The main difference in the analysis of conceptual similarity vis-à-vis Opponent’s Mark 2 lies in the additional words “cement strengthener” in the latter. These words lend a definite concept to Opponent’s Mark 2, albeit a descriptive and non-distinctive one. Where one part of the mark has no conceptual meaning, the instinctive tendency is for the average consumer to look to other parts of the mark in a search for conceptual meaning. Since “W-1” has no particular conceptual meaning, we end up with the unusual situation

of perceiving that the mark *in its totality*, , being

a *combination* of the meaningless alphanumeric term “W-1” and the descriptive words “cement strengthener”, points conceptually to a brand of cement strengthener called “W-1”. This is the idea that “*lie(s) behind and inform(s) the understanding of the mark as a whole*”. In this limited respect, I am inclined to find that the Application Mark and Opponent’s Mark 2 are conceptually dissimilar.

Conclusion on Marks-Similarity

44 Overall, I have found that the Application Mark and Opponent’s Mark 1, when compared as wholes, are:

- (i) visually, more dissimilar than similar;
- (ii) aurally, marginally more similar than dissimilar; and
- (iii) conceptually neutral in relation to each other.

45 I have also found that the Application Mark and Opponent’s Mark 2, when compared as wholes, are:

- (i) visually, more dissimilar than similar;
- (ii) aurally, marginally more similar than dissimilar; and
- (iii) conceptually dissimilar to each other.

46 As recognised at [14(iii)] above, trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression, as the Court of Appeal in *Staywell* highlights (at [17] – [18]).

47 The visual dissimilarity of the marks is the starkest, and bears heavily on the impression of the average consumer. With this, accompanied by only marginal aural similarity, and conceptual dissimilarity (with respect to Opponent’s Mark 2), I am persuaded that the average consumer would conclude that the Application Mark and the Opponent’s Marks are, overall, more dissimilar than similar.

48 Given that the similarity of the competing marks is a “*threshold requirement that had to be satisfied before the confusion inquiry is undertaken*” (*Staywell* at [15]), my finding of overall dissimilarity between the Application Mark and the Opponent’s Marks sufficiently disposes of the ground of opposition under Section 8(2)(b) in the Applicant’s favour.

Conclusion on Section 8(2)(b)

49 The ground of opposition under Section 8(2)(b) therefore fails.

Postscript on Section 8(2)(b)

50 The Opponent has made clear what it thought of the Applicant’s entry into the cement strengthener market, alleging that the latter “*deliberately chose to call its product the “NW1 Cement Strengthener” and adopt the Application Mark. The*

Applicant also deliberately chose to sell its product in a get-up almost identical (or highly similar) to that of the Opponent’s “W1” strengthener¹⁴. The parties’ respective products are seen in the photograph¹⁵ below.



51 The Opponent is at liberty to express its thoughts on the way both parties use their marks in the market as competitors. However, the questions of fact and law pertaining to an opposition under Section 8(2)(b) address something different. The comparison of the relevant marks (see [16] above) is quite different from the comparison of the competing products’ packaging (in [50] above). If the root of the Opponent’s concern is really how the competing goods are packaged as a whole – how they appear to customers – its recourse may lie somewhere else other than an opposition under Section 8(2)(b).

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

52 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 ...

Elements of Passing Off

¹⁴ [21] of See’s SD
¹⁵ Exhibit M of See’s SD

53 To succeed on the ground of opposition under Section 8(7)(a), an opponent must establish the classical trinity of goodwill, misrepresentation and damage (*Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 at [36]; also applied in the more recent Court of Appeal decisions of *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 and *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”).

Opponent’s Pleading

54 Under this ground of opposition, the Opponent does not rely on the Opponent’s Marks set out in [8] above. Rather, it relies on the “W1” name¹⁶, as borne out by its pleading at [12] to [14] of the grounds of opposition:

12 First, the Opponent has built up substantial goodwill in respect of the “W1” name. Further, the “W1” name has been used continuously and consistently on the Opponent’s goods in Singapore well before the Application Mark was filed.

13 Second, due, *inter alia*, to the confusing similarity between the Application Mark and the “W1” name and the identical or overlapping fields in which the parties operate, the Applicant’s use of the Application Mark on its goods will constitute a misrepresentation that the Applicant’s goods emanate from the Opponent or an associated entity.

14 Third, there is a real and tangible likelihood of damage to the Opponent’s goodwill as a result of the Applicant’s misrepresentation.

Goodwill

55 The Court of Appeal, at [33] to [34], and [67], in *Singsung*, made clear the following:

33 The goodwill relevant to a passing off action is not goodwill in the mark, logo or get-up ... Instead, the tort of passing off protects a trader’s *relationship* with his customers...

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 ... 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...

67 In our judgment, goodwill clearly exists in Singapore when a business offers a product or service for sale in this jurisdiction, and a customer purchases the product or consumes the service here.

¹⁶ I note that this is without the hyphen found in the Opponent’s Marks at [8]

56 There is no dispute that the Opponent has sold and advertised the product referred to as “W1” cement strengthener in Singapore before the Relevant Date¹⁷. I find that the Opponent has the relevant goodwill in its business.

Misrepresentation

Threshold Issue: Distinctiveness

57 Next, I apply my mind to the threshold issue of distinctiveness, bearing in mind *Singsung* at [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 ... 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.

58 The Opponent’s annual sales revenue from 2011 to 2019 (the year of the Relevant Date) exceeds S\$3 million each year. These sales revenue figures are substantial and significant.

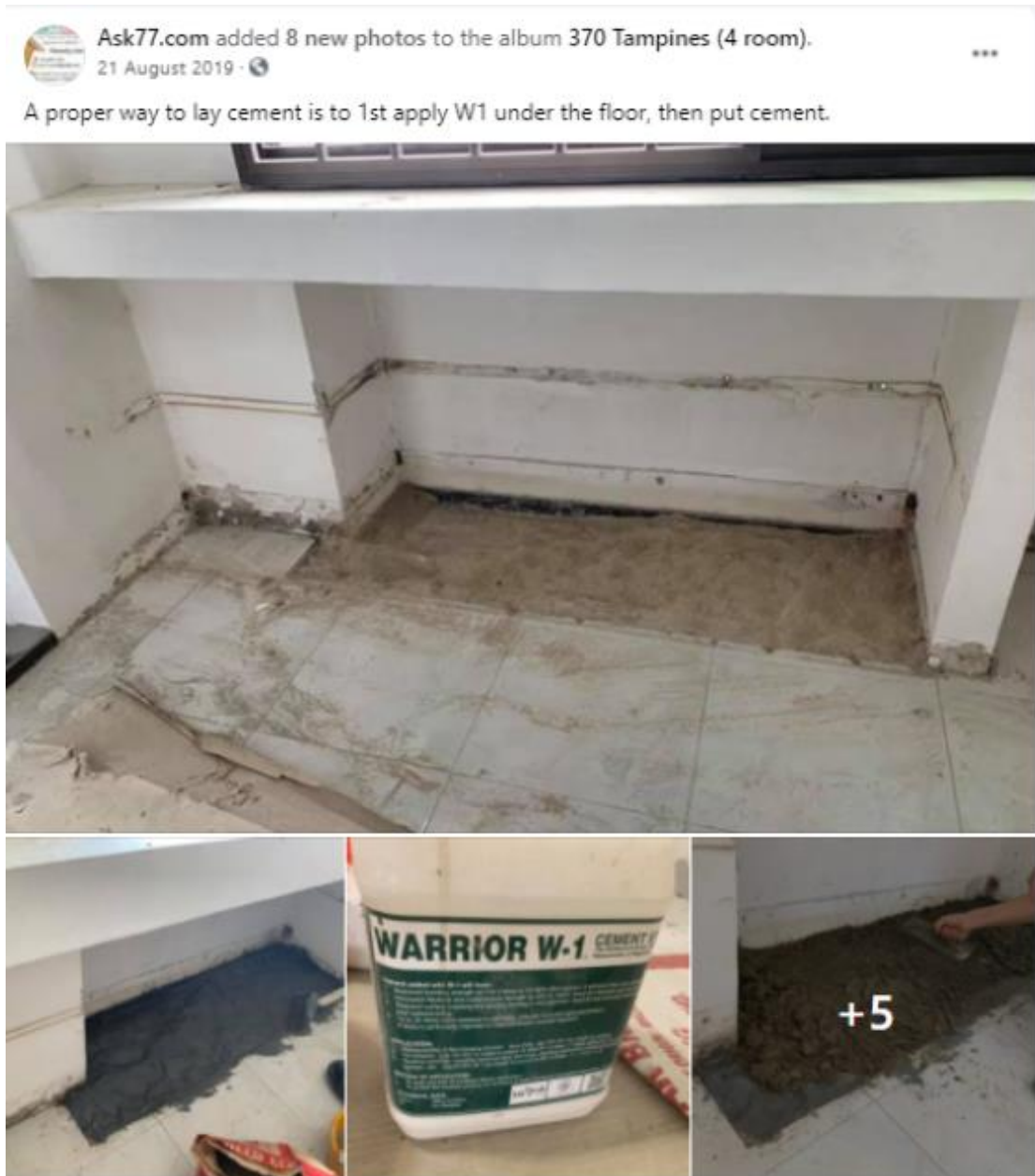
| Year | Annual Sales Revenue of Opponent’s “W1” Cement Strengthener |
|-------------|--|
| 2007 | S\$ 1,941,875 |
| 2008 | S\$ 2,322,530 |
| 2009 | S\$ 2,223,167 |
| 2010 | S\$ 2,706,636 |
| 2011 | S\$ 3,048,829 |
| 2012 | S\$ 3,285,923 |
| 2013 | S\$ 3,615,540 |
| 2014 | S\$ 3,795,041 |
| 2015 | S\$ 3,745,008 |
| 2016 | S\$ 3,440,746 |
| 2017 | S\$ 3,260,486 |
| 2018 | S\$ 3,641,770 |
| 2019 | S\$ 3,291,504 |

59 There is also evidence that users of the Opponent’s “W1” cement strengthener associate the mark with the Opponent, such as in the following Facebook posts¹⁸. The first of these is a post dated 21 August 2019, by Ask77.com, who appears to be in the renovation business. The post refers to “W1” in the sentence “A proper way to lay cement is to 1st apply W1 under the floor, then put cement”, and has a photo of the

¹⁷ [12], [14] to [15] of See’s SD

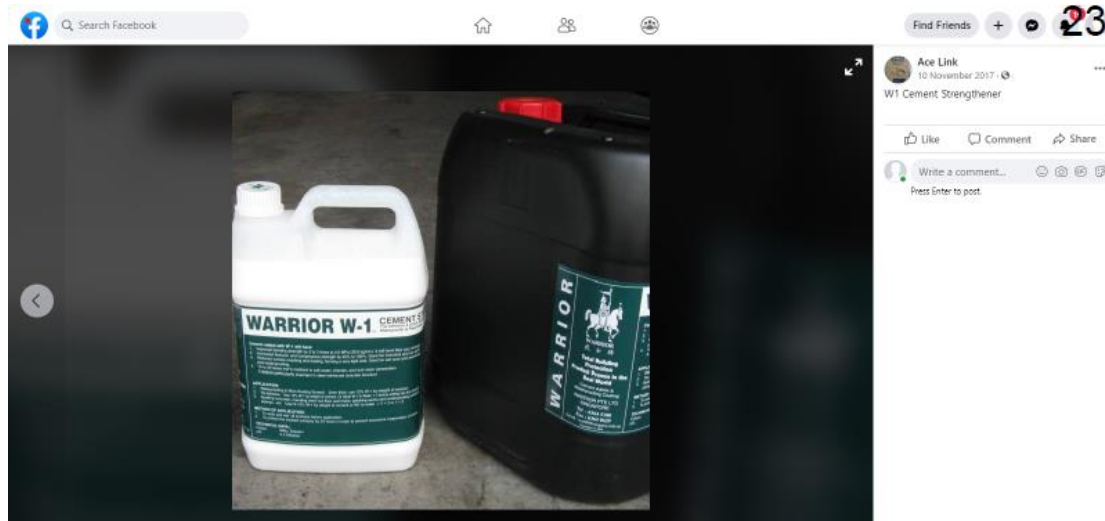
¹⁸ Exhibit O of See’s SD in Reply

Opponent’s “W1” cement strengthener uploaded below the sentence, associating “W1” with the Opponent.



60 The second example is a Facebook post dated 10 November 2017, by Ace Link Private Limited, an industrial company that supplies building material and services. Its post features a photo of the Opponent’s “W1” cement strengthener and the written description says “W1 Cement Strengthener”.

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61 The threshold issue of distinctiveness of “W1” is readily crossed.

Similarity of Elements and Likelihood of Confusion

62 Once distinctiveness has been considered and established, two further criteria come into view. The Court of Appeal at [39] of *Singsung*, citing *The Singapore Professional Golfers’ Association v Chen Eng Waye* [2013] 2 SLR 495 at [20], said:

... 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 ...

63 The Court of Appeal in *Hai Tong*, at [115], reiterated the same factors considered under “likelihood of confusion” under Section 27(2)(b)¹⁹, in respect of misrepresentation under passing off; though it also recognised that “*the relevant tests for the tort of passing off and a claim for trade mark infringement are not identical, and ... in an action for passing off, the court is **not constrained in the same way that it would be in a trade mark infringement action in identifying the factors it may take into account...***” (emphasis in bold added). In the same decision at [110], the Court of Appeal recognised that “*in an action in passing off, the likelihood of deception is to be assessed having regard to **all the circumstances**, whereas in a trade mark infringement under s 27(2)(b) of the Act, the likelihood of confusion must stem from the similarity between the contesting marks and the similarity between the goods or services to which they are applied...*” (emphasis in bold added).

64 In an assessment of the ground of opposition under Section 8(7)(a), the comparison is between the normal and fair use of the Application Mark and the actual use of the Opponent’s “W1”²⁰. This is a case where, as noted in [54], the Opponent

¹⁹ The “infringement” provision analogous to Section 8(2)

²⁰ This is where the Opponent’s evidence of use is properly considered, instead of at the first step of the three-step test under Section 8(2)(b) as dealt with above. See, also, footnote 9.

does not rely on the Opponent’s Marks set out in [8] above, but on the “W1” name as used in trade.

65 The perception of whether there is any similarity between “**NW1**” and “W1”, and whether there is a reasonable likelihood of confusion, is considered in relation to the class of the consumers in question. Here, the parties agree that the relevant public comprise trade consumers from the building and construction industry, as well as ordinary retail consumers doing home improvement works.

66 The Opponent does not dispute that trade consumers have specialist knowledge and are likely to make purchase decisions carefully, displaying a higher than average level of attention to the goods and respective marks. The same, however, is not true of the general purchasing public, who are likely to be confused.

67 We consider the following factors in turn.

The Comparison of the Application Mark and “W1”

68 Comparing “**NW1**” and “W1”, one can see the following similarities and differences. This is fairly balanced, and the question of confusion will likely be answered by a consideration of the factors to follow.

| Similarities | Differences |
|---------------|--|
| End with “W1” | Start with “N” and “W” respectively |
| | Three characters versus two characters |

The Reputation of “W1”

69 The Opponent claims that its most famous product is the “W1” brand of cement strengtheners²¹. Its evidence in See’s SD and See’s SD in Reply, such as the examples of use, promotion and internet presence, is consistent with this claim.

70 The Opponent’s annual sales revenue from 2011 to 2019 is also very significant, exceeding S\$3 million each year. The annual breakdown has been set out at [58] above.

In contrast, the Applicant’s sales of its “**NW1**” goods are S\$9,665.00 from May to December 2019, and S\$14,102.75 from January to August 2020²²; a far cry from the Opponent’s sales revenue.

71 Significantly, the Opponent’s “W1” cement strengthener has been sold for a long time, for more than three decades²³, compared to the Applicant, whose earliest recorded sales of “NW1” cement strengtheners in evidence was in May 2019.

72 The Court of Appeal in *Staywell* elaborated at [96(a)]:

²¹ [4] of See’s SD, which is preceded by the header “The Opponent’s flagship product – the ‘W1’ Cement Strengthener”

²² [13] and Exhibit 9 of Ng’s SD

²³ [4] of See’s SD

... As to the reputation of the mark, *Mobil Petroleum Co, Inc v Hyundai Mobis* [2010] 1 SLR 512 (“*Mobil*”) at [74] makes it clear that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect as in *McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 (see at [64]).

73 The reputation of the Opponent’s “W1”, taking account of its length of sale (more than three decades) and sales revenue (more than S\$3 million each year from 2011 to 2019), is very strong. Comparatively speaking, it also overshadows any reputation of the Applicant’s “NW1”. In this connection, people in the construction and renovation circles also refer to “W1” cement strengtheners in a matter-of-fact way and relate them to the Opponent²⁴.

74 Hence, I take into consideration the Court of Appeal’s remarks in *Staywell* above and find that the strong reputation of “W1” points away from a likelihood of confusion.

The Normal Way in which the Goods are Purchased

75 The Opponent submits that the trade channels of both parties’ cement strengtheners are through brick-and-mortar stores as well as online marketplaces²⁵. While this is supported by the Opponent’s evidence, the position is not as clear on the part of the Applicant.

76 The closest Ng’s SD comes to trade channels is at [8]. However, this paragraph refers to the “*more than 180 authorised dealers of the paint products*” and “*location of exclusive retailers or authorised dealers of Nippon Paint*”, rather than to the products in the Application Mark’s specification at [2] (such as cement strengtheners). [11] of Ng’s SD claims that the Applicant’s products under the Application Mark are promoted through (i) its own website; (ii) the Singapore Green Building Council website; (iii) catalogues, brochures; and (iv) trade fairs it participates in; and the corresponding exhibit²⁶ merely shows: (i) a technical data sheet for NW1 Cement Strengthener, with enquiries/contact details on the last page; (ii) a Singapore Green Building Product Certificate for the product model: NW1 Cement Strengthener; and (iii) poster designs drafted by dna LIFE, a marketing agency. Nonetheless, since, as observed at [64], the comparison is between the normal and fair use (which is notional) of the Application Mark and the actual use of the Opponent’s “W1”, the lack of more concrete evidence and details of the use and promotion of the Applicant’s goods under its mark is not critical.


77 The Opponent’s evidence shows various examples of its “W1” cement strengtheners being made available for sale online²⁷, just three of which are set out below by way of example. They are screenshots from the websites of hardware stores BuildMate, Hardware Store online convenience 4U, and Fastener Group Pte Ltd. Out of these examples, at least BuildMate also has brick-and-mortar addresses, in Jurong and Eunos.

²⁴ For example, in the Facebook posts replicated at [59] and [60] above

²⁵ [16] of See’s SD, [8] and [11] of Ng’s SD, from [42] of the Opponent’s written submissions

²⁶ Exhibit 7 of Ng’s SD

²⁷ Exhibit I of See’s SD



BUILDmate
Your One Stop Building Material Supply

6631 0188 (1 Joo Yee Road)
6589 5388 (3 Eunus Avenue
8A)

sales@buildmate.com.sg

Enquire List | 0 Item(s)


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SHOP BY CATEGORY

- ABRASIVES
- BRICKS & CONCRETE BLOCKS
- CEMENT & CONSTRUCTION CHEMICALS
- CLEANING PRODUCTS
- ELECTRICAL PRODUCTS
- GRANITE & SAND
- HARDWARE & TOOLS
- MESH & WIRE
- PACKING SUPPLIES
- PAINTS, CHEMICALS & INSECTICIDES
- PIPES & FITTINGS
- POWER TOOLS & LASER TOOLS
- PRECAST
- SAFETY PRODUCTS
- SCREWS, BOLTS, NUTS & FASTENERS
- STATIONERY
- STRUCTURAL & BUILDING MATERIALS
- STRUCTURAL STEEL
- TIMBERS & PLYWOODS
- WELDING PRODUCTS

HOME > CEMENT & CONSTRUCTION CHEMICALS > Cement Strengthener (W1) – WARRIOR



CEMENT STRENGTHENER (W1) – WARRIOR

Specification

| | |
|----------|-----------|
| Packing: | 5kg, 20kg |
|----------|-----------|

Tag: [Bonding Agent](#)

Brand: [Warrior](#)

Category: [CEMENT & CONSTRUCTION CHEMICALS](#)

Add to enquiry

DESCRIPTION :

Strengthens cement. Improves bonding strength by 2 to 3 times to 30.57 kg/cm². Especially good for bonding homogeneous tiles, granites and marble tiles, and to prevent staining. Increases flexural and compressive strength by 40% to 100%. Compressive strength to 56.00 N/mm². Flexural strength to 10.00 N/mm². (ASTM C 39).

Quickens cement setting time. Reduced surface cracking and dusting, forming a very tight seal. Good for wall plaster, wet area and swimming pool waterproofings. 10 to 20 times more resistant to oil, salt water, chloride, acid and vapour penetration. A feature particularly important in steel reinforced concrete structure.

Improved plasticity and flow (ASTM C 124-71), easier to work with, reduces porosity.

W1 cement strengthener is deemed to be suitable for use in contact with water intended for human consumption tested against SS375 : 2001.

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HARDWARE STORE Online Commerce AU

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Home / Industrial Consumable Goods / Chemical Products / **WARRIOR W1 CEMENT STRENGTHENER**


POPULAR PRODUCTS



Soundtech™ LED Flexible Light Strip 1Meter LS-570



Soundtech™ Wireless Digital Doorbell DA-40



WARRIOR W1 CEMENT STRENGTHENER
\$ 26.00
Cement Strengthener

1 Add to cart Add to Wishlet

SKU: WARR-W1

| DESCRIPTION | ADDITIONAL INFORMATION | REVIEWS (0) |
|---|------------------------|-------------|
| <p>Wall Plaster & Cement Mortar for diverse range of Sealing, Repairs & Waterproofing:</p> <ul style="list-style-type: none">• Wall plastering, spalling concrete, corrosion preventing prime coat on reinforced steel bar, mending worn out floor and holes, patching works around piping, re-pointing of brick works, tile joints, sealing of old concrete, Asbestos sheet, fish tank & swimming pool.• Coating or Injection into Floor Screed, Wall & Absorbent Surface to Prevent Seepage & Waterproof• Use W1 or Mix W1 + W5 MULTI-BOND, dilute as needed, to coat, or inject into the brick or cement, to seal up porosity. Injection pressure is 100 psi. Normal drying time is 10 days at 30°C. | | |

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Home / Paints & Chemicals / Chemical Products / Other Chemical Agents / Warrior W1 Cement Strengthener

Warrior W1 Cement Strengthener

Write a review

\$25.00

Size: *

Model: W1

Availability: In stock

[Facebook](#) [LinkedIn](#) [Twitter](#)

The Warrior W1 Cement Strengthener is used for waterproofing thin set tile bonding, tile bonding, new to old concrete bonding, anti-chloride, plasticiser, injection polymer and sealer.

Size

5 kg / 20 kg

78 It is readily perceptible from the above screenshots of online hardware stores that “W1” cement strengthener is commonly associated in the course of trade – both through the line description as well as the accompanying photograph – with the house brand, “Warrior”, which is part of the Opponent’s name, Warrior Pte Ltd.

79 The Opponent has filed evidence in reply to demonstrate that its cement strengthener is also referred to as “W1”, standalone. Some examples are reproduced below²⁸.

To minimise the defects, the cement screed floor shall do it on clean/ free of oily bare finish, using cement strengthening chemical (eg. W1 Chemical), one operation of cement screed floor finishing and minimise / avoid the joints. If there is not way to avoid joints, consider to lay PVC Inlay to break the flooring and allow the floor expansion.
Learn more of other floor finishes available. www.9reno.com
Need to talk to us ? We will provide non-obligation quote.

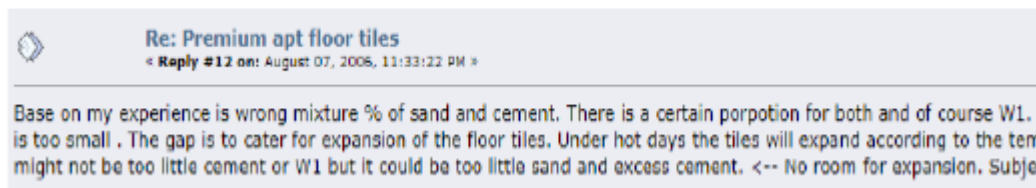
[\(https://9reno.com/cement-sand-screed-flooring/\)](https://9reno.com/cement-sand-screed-flooring/)

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²⁸ [7] of See’s SD in Reply



<https://www.facebook.com/HIPbyEIC/photos/pcb.370324330518713/370324163852063>



http://www.punggol.sg/forum/complaints/premium_apt_floor_tiles-t358.0.html;msg5683

80 It is reasonably clear that “W1” in itself is used as a term of reference in the trade. Thus, in the first example above, builder and contractor 9 Reno Pte Ltd profiles its expertise on its website, on how to achieve cement sand screed flooring and minimise defects on the surface by referring to a type of cement strengthening chemical called “W1 Chemical”. Likewise, in the second example above, EIC Pte Ltd, an interior design studio, puts up a Facebook post²⁹ on a part of a customer’s wall that needed repair works and similarly profiles its expertise by saying “Apply 1-2 layers of cement strengthener (W1).”

81 However, if one only reads the above extracts from, respectively, a website, a social media post, and a Punggol.sg forum entry, without knowledge of the Opponent’s use and promotion of “W1” in relation to cement strengtheners, there is no certainty in conclusion whether “W1” is a generic term for a type of chemical product or a brand of cement strengthener. In contrast, it is examples such as those in [59] and [60] above that help one conclude that some users of the Opponent’s “W1” cement strengthener associate the mark with the Opponent (this was how the threshold of “distinctiveness” was established in the first place).

82 In any case, the above extracts showing the use of “W1” without other indicia of origin are not in the context of the normal way the goods are purchased. They appear in the context of discussions or posts on renovation and construction; and do not diminish the observation that when it boils down to the process of selection and purchase, the consumer is exposed to the get-up of the Opponent’s “W1” cement strengthener, which include distinctive indicia of origin such as the “Warrior” house brand.

²⁹ Full post not shown above, but seen in Exhibit O of See’s SD in Reply

83 The Opponent also refers to its own website to show that “W1” is used on its own³⁰, for example, as indicated by the arrows in the following screenshots.

WARRIOR PTE LTD

Choose Language: English

HOME Job References

W1 CEMENT STRENGTHENER

BUILDING PRODUCTS W4 WATER REPELLENT

CLEANING PRODUCTS W7 CHRISTY SEAL

WARRIOR PTE LTD
 Blk 17 Marsiling Industrial Estate Road 1, # 01-11
 Singapore 739279
 Tel: (65) 6364 5100 / 6364 5060 / 6367 3676
 Fax: (65) 6364 0629

GST & Co. Reg. No. 20-0401392-H
11
war99@singnet.com.sg
<http://www.warrior.com.sg>

W1 JOB REFERENCE



Tiling work by using W1 cement mortar
 Camel Nut Factory, Defu Lane 10.
 2010 August



W1 + cement to prevent rising dampness
 Pasir Panjang Village.
 2010 June

84 Even if the consumer were at the Opponent’s website to make a purchase of cement strengthener, and sees the “W1” standalone mark, the sighting is still in proximity to the Opponent’s name, Warrior Pte Ltd, which appears like a header on the webpage in question.

85 The upshot of all the foregoing observations and inferences is that, in the normal way the goods are purchased, “W1” cement strengthener is strongly associated with the

³⁰ [6] and Exhibit N of See’s SD in Reply

house brand, “Warrior”, and/or the Opponent’s name, Warrior Pte Ltd. This points away from a likelihood of confusion.

The Nature of the Marks

86 It is also worth pointing out that both marks, “NW1” and “W1” are also model numbers for their respective products.

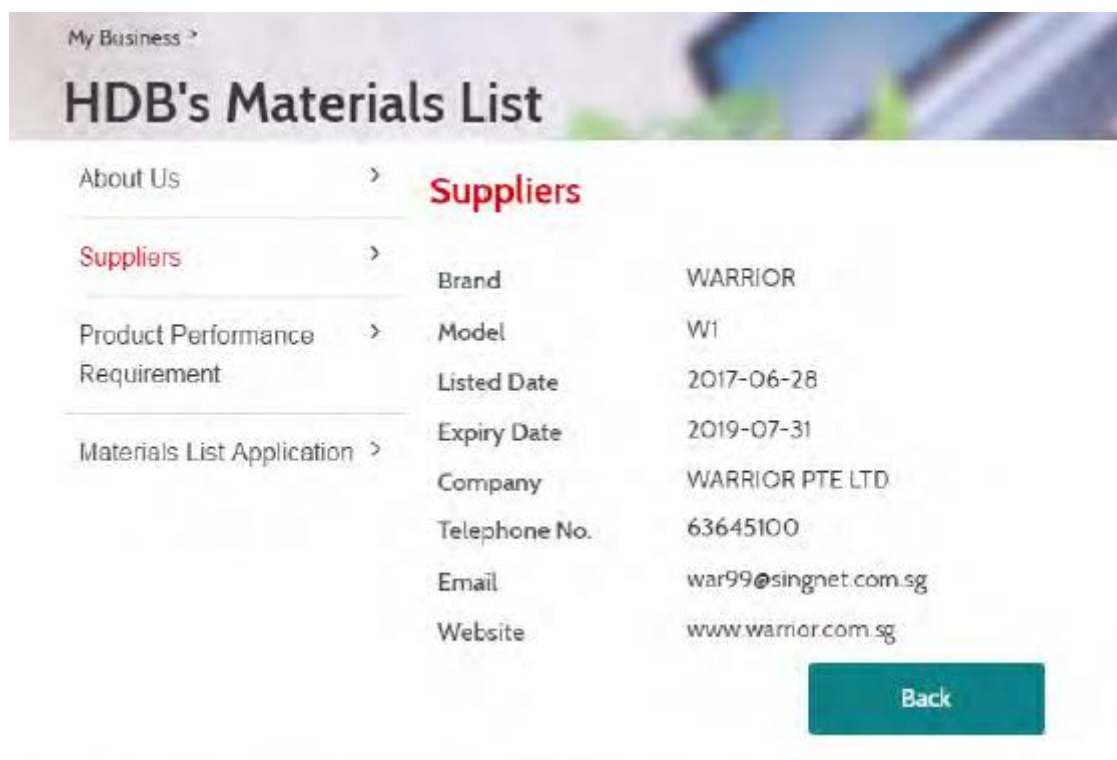
87 The Applicant’s Singapore Green Building Product Certificate³¹ below bears the product model description: NW1 Cement Strengthener.



88 The Opponent’s entry in HDB’s Materials List³² below reflects the model as “W1” and the brand as “Warrior”. The Opponent explains³³ that “*The HDB Materials List provides consultants and contractors with a selection of products needed for construction projects, and requires the Opponent’s “W1” strengthener to undergo a series of stringent tests to verify its technical properties and suitability for the*

³¹ Exhibit 7 of Ng’s SD
³² Exhibit F of See’s SD
³³ [13] of See’s SD

governmental authority's recommendation." In the same screenshot below, at the left column, the last option is "Materials List Application", suggesting that suppliers who wish to be included in HDB's Materials List can make an application. This further suggests that the final content in HDB's Materials List is not something drafted by HDB, but rather content that is submitted by successful applicants (suppliers) whose goods can then be listed and bought by project consultants and contractors. Hence, this would not be a case of HDB mistaking "W1" for a model number, but the Opponent representing that it is one.



89 I also refer to the Opponent's product listing on its website at www.warrior.com.sg³⁴ and the Opponent's promotional calendar³⁵ below. In the product listing, under the category "Cement Admixtures & Treatment", besides "W1 Cement Strengthener", the following goods sold by the Opponent appear:

- W1SL Self-Levelling Admix
- W1T Cement Modifier
- W2 Flexi Guard
- W5 Multi Bond
- W8L Stone Hardener
- W1000 Integral Waterproof

In the promotional calendar, the following goods sold by the Opponent appear below "W1 Cement Strengthener":

- W1T Cement Modifier

³⁴ Exhibit N of See's SD in Reply

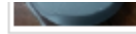
³⁵ Exhibit J of See's SD

- W2 Flexi Guard
- W4 Water Repellent
- W5 Multi Bond
- W7 Christy Seal
- W11 CEMSEAL Cementitious

W1 CEMENT STRENGTHENER

MSDS

Waterproofing cement additive for thin set tile bonding, tile bonding, anti-chloride, plasticiser, injection polymer and sealer.



W1SL SELF-LEVELLING ADMIX

MSDS

Admix to improve the flow of cement.



WARRIOR GROUT PIGMENT

High grade, colourfast, micronized iron oxide pigment for tile and mosaic work.



W1T CEMENT MODIFIER

MSDS

Cement additive to improve tile bonding, injection polymer, repair mortar and floor screeding.



W2 FLEXI GUARD

Elastic waterproofing cement admix. A water based polymer designed to modify cement into a flexible waterproofing membrane.



W5 MULTI BOND

Flexible multipurpose waterproofing additive for tile bonding, new to old concrete plastering and bonding.



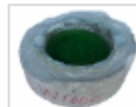
W8L STONE HARDENER

Reduce Dusting, Efflorescence, and Improve hardness.



W1000 INTEGRAL WATERPROOFER

Liquid Admixture that reduces pores and capillaries.



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Innovative Products For Total Building Protection
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Products List:

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- E1
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- PU 10
- QP1
- SC 10
- GreenZU
- Damp Proof Coating
- Epoxy
- Roof Tile Coating
- Christy Hard
- Hard Floor Coating
- PU Waterproofing
- Quick Plug
- Solvent Clear
- Bamboo Deck & Panel
- Lamonchi
- W1
- W1T
- W2
- W4
- W5
- W7
- W11
- WET SKIM
- Vinyl Wall Covering
- Cement Strengthener
- Cement Modifier
- Flexi Guard
- Water Repellent
- Multi Bond
- Christy Seal
- CEMSEAL Cementitious
- Lime Plaster

WARRIOR PTE LTD
 17 Marsiling Industrial Estate Road 1 #01-11 Singapore 739279
 Tel: (65) 6364 5100 Fax: (65) 6364 0629
 war99@singnet.com.sg www.warrior.com.sg

November 2019
 Rabiulawal - Rabiulakhir 1441 十一月 己亥年十月小至十一月大

Calendar:

| | | | | |
|---------------------------|--------------------------|---------------------------|---------------------------|---------------------------|
| 星期日 SUN AHAD | 十月初七 3 Rabiulawal 星期一 | 十月十四 10 Rabiulawal 星期二 | 十月廿一 17 Rabiulawal 星期三 | 十月廿八 24 Rabiulawal 星期四 |
|---------------------------|--------------------------|---------------------------|---------------------------|---------------------------|

90 The products listed above have a commonality in their terms of reference. They start with the letter “W” combined with a numeral. Taken together, all the more each “W_” reference looks like a model number. The Opponent’s counsel did not deny this at the hearing, but submitted that a mark can function both as a model number and as a trade mark at the same time, citing examples such as BMW’s M series models: M2, M3, M4; and Mercedes-Benz R-Class models: R300, R400, R500.

91 I accept that a mark may be both a model number and also a badge of origin³⁶. However, because of the nature of such marks as model numbers, the consumer’s tendency would be to find the source and associate the model number with its source, as may be represented by a house brand, or the actual name of the source³⁷. In the present case, it would be most natural for consumers to associate the model number “W1” with the source, whether as represented by the house brand “Warrior” or the name of the Opponent itself, “Warrior Pte Ltd”.

92 Once this association is formed, the mental construct comprises a combination of the house brand and the model number: hence, BMW M2, Mercedes-Benz R300 and, in this case, Warrior W1. This is reinforced by what meets the consumer’s eye at the point of purchase, as borne out by the sample screenshots set out at [77] above. This in no way negates the fact that a model number may be a trade mark, but puts into practical context the fact that different types of trade marks are used differently in the market.

³⁶ I express no view on whether the Opponent’s examples of specific BMW car models and Mercedes-Benz car models are trade marks or not.

³⁷ Thus, for example, the relevant public would, in its mind, associate “M2”, “M3” or “M4” with the house brand “BMW”.

The primary trade mark could be the house brand or the name of the trader, and the secondary trade mark could be the model number if it points to a trade source³⁸.

93 The above explanation comes from a market perspective. From a legal perspective, it may be said that a mark that is both a model number and a trade mark is inherently less distinctive, and weaker in its function as a badge of origin. Thus, it leans on a stronger trade mark, such as the house brand, to better perform its function of indicating origin. With much use over time, it could perform better as a badge of origin (due to acquired distinctiveness), and the owner may even venture to use it as a standalone mark on some occasions, but will most likely never let it stray too far from the house brand which has the most distinctiveness and contributes the most to its goodwill.

94 Thus, the fact that “W1” is both a model number and a trade mark points towards a lower likelihood of confusion. In use, there is an undeniable, strong association with the house brand “Warrior”, or with the Opponent’s name itself.

The Nature of the Goods

95 The Opponent submits that the cement strengtheners in question are predominantly functional in nature, unlike luxury goods which derive most of their value from their branding. As such, the retail customer would likely focus almost exclusively on the functional attributes and price of the product, rather than the particular trade marks. Minor differences between the marks would likely go unnoticed in the retail customer’s imperfect recollection. In this regard, the Opponent cites *Caesarstone* at [79]:

For these reasons, we are satisfied that consumer indifference towards the mark used in relation to the relevant goods or services does not preclude the question of a likelihood of confusion from arising. **Consumer indifference would, in the normal course of events, point towards a likelihood of confusion in so far as consumers would pay less attention to the differences between the marks.** Conversely, where consumers are especially sensitive towards the mark used in relation to the relevant goods or services (for example, in the case of luxury goods), this would likely point away from a likelihood of confusion as consumers would pay more attention to the differences between the marks. **Accordingly, the finding that consumers of Class 19 goods are likely to be indifferent towards the mark used in relation to the goods (see [64] above) points towards, rather than away from, a likelihood of confusion in the present case.** (emphasis in bold and underline added by the Opponent)

96 I accept that cement strengtheners are predominantly functional in nature and agree that this factor on its own points towards a likelihood of confusion.

The Price of the Goods

97 The price of the parties’ respective cement strengtheners under their marks can be discerned from their evidence. The Applicant’s “NW1” cement strengtheners cost

³⁸ And, arguably, put together, the combination of the primary trade mark and secondary trade mark forms a third trade mark.

S\$17.80 for 5L and \$65.50 for 20L³⁹. The Opponent's "W1" cement strengtheners cost S\$16.00 for 4kg, S\$19.00 for 5kg and S\$70.00 for 20kg⁴⁰. In both cases, the invoices in evidence had the purchasers' identities redacted. However, based on the quantities purchased, it is reasonable to infer that the purchasers are distributors or purchasers from the building and construction industry who buy in bulk, rather than individual retail buyers doing home improvement who buy in small quantities. For the latter, the cost of the goods would be higher⁴¹.

98 The Opponent submits that the goods are generally inexpensive, and therefore do not demand a high degree of fastidiousness from the general purchasing public.

99 I accept that the notional range of prices of the goods in question is at the less expensive end of things. As such, compared to more expensive goods (e.g. luxury goods), this factor points towards a greater likelihood of confusion.

The Frequency of Purchase of the Goods

100 The Opponent also contends that, because home improvement works are usually not conducted on a frequent basis, the purchase of cement strengtheners by retail customers would also not be frequent. As such, these retail customers are unlikely to be able to distinguish between the competing marks in their imperfect recollection. On the other hand, the Applicant submits that consumers would pay more attention and care to the purchase precisely because these transactions are infrequent. The Applicant's point is that the general public is not likely to be confused.

101 The Opponent's argument appears reasonable at first glance, but assumes, too narrowly, that customers only learn how to distinguish between the competing marks through frequency of purchase. However, ability to distinguish can be exercised even on the first purchase, and not only through frequency of purchase. On the other hand, if the similarity between the marks is to a high degree, even frequency of purchase may not protect the purchaser from confusion. In reality, it would be difficult to assess this factor in isolation and I consider it a neutral factor here.

The Nature of the Consumers⁴²

102 There is very little in the evidence, if any at all, on the profile of the retail customer doing home improvement works who would need to buy the parties' cement strengtheners.

103 Based on the nature of the goods – cement strengtheners – one infers that a homeowner who wants to embark on such a labour intensive undertaking involving cement, and thus cement strengtheners, without the assistance of a contractor or interior design house, would be firstly, rare, and secondly, prepared. The Applicant submits that

³⁹ Exhibit 9 of Ng's SD

⁴⁰ Exhibit E of See's SD

⁴¹ Exhibit I of See's SD, at page 93, shows 5kg of "W1" cement strengtheners retailed at S\$25.00 by Fastener Group Pte Ltd

⁴² The parties do not dispute that trade consumers in the building and construction industry are not likely to be confused: [66] above. The dispute lies over whether retail consumers are likely to be confused.

“such consumers would minimally possess technical knowledge on (1) the purpose and function of industrial adhesives and chemical preparations; and (2) how to undertake construction and repair works. For example, they would necessarily need to know how to use the industrial adhesives and chemical preparations for works such as “tile-over-bonding”, “sealing, repairs and waterproofing”, or “old concrete bonding”.⁴³” In conjunction with this, the Opponent’s technical datasheet⁴⁴ in which these terms are found is set out below. The content of this datasheet gives some inkling of the technical knowledge that a retail consumer who needs to buy cement strengthener for home improvement would probably have to know (at least by referring to a datasheet such as this).

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⁴³ [89] of the Applicant’s written submissions

⁴⁴ Exhibit B of See’s SD

LISTED ON HDB'S MATERIAL LIST



W1 CEMENT STRENGTHENER



WATERPROOFING THIN SET TILE BONDING, TILE BONDING, NEW TO OLD CONCRETE BONDING, ANTI-CHLORIDE, PLASTICISER, INJECTION POLYMER AND SEALER.

FEATURES

Cement added with W 1 will have

1. Improved bonding strength by 2 to 3 times to 30.57 kg/cm². Especially good for bonding Metal, glass, homogeneous tiles, granites and marble tiles and to prevent staining.
2. Increase flexural and compressive strength by 40% to 100%. Compressive strength to 56.00 N/mm². Flexural strength to 10.00 N/mm². (ASTM C 39).
3. Quicken cement setting time. Reduced surface cracking and dusting, forming a very tight seal. Good for wall plaster, wet area and swimming pool waterproofing.
4. 10 to 20 times more resistant to oil, salt water, chloride, acid and vapour penetration. A feature particularly important in steel reinforced concrete structure.
5. Improved plasticity and flow (ASTM C 124-71), easier to work with, reduces porosity.
6. **W1 CEMENT STRENGTHENER** is deemed to be suitable for use in contact with water intended for human consumption tested against SS375 : 2001.

High Performance product

APPLICATION METHOD

Based on Cement: Sand ratio of 1 : 3.

1. The amount of water needed is 24 % by weight of cement.
2. This can be replaced totally with 24 % or lesser of W1 for optimum performance.

A. Tile Bonding Aid, Grouting Vapour & Waterproofing:

1. Dilute W 1 + Water = 1 + 1 by Volume, before adding into the Cement.
2. It will waterproof and bond tiles very strongly onto glass, glazed tile, steel and wood. Fine silica sand of 0.5 mm diameter can be added for grouting the tile joints.

B. Tile-Over-Tile Bonding:

1. Dilute W 1 + Water = 1 + 1 by Volume, before adding into the Tile Bond Cement or Cement.
2. Hard brushing this slurry onto the existing tile surface. Thickness about 1.5 mm. While it is still wet, bond on the tile.

Consumption:

For Floor Screed:

W 1 + Water = 1 + 1 by Volume
W1 usage = 0.4 kg / m² / 10 mm thick



Tile Bonding & Waterproofing
at Camel Nut Factory

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LISTED ON HDB'S MATERIAL LIST



W1 CEMENT STRENGTHENER



WATERPROOFING THIN SET TILE BONDING, TILE BONDING, NEW TO OLD CONCRETE BONDING, ANTI-CHLORIDE, PLASTICISER, INJECTION POLYMER AND SEALER.

Wall Plaster & Cement Mortar for diverse range of Sealing, Repairs & Waterproofing:

- Wall plastering, spalling concrete, corrosion preventing prime coat on reinforced steel bar, mending worn out floor and holes, patching works around piping, re-pointing of brick works, tile joints, sealing of old concrete, Asbestos sheet, fish tank & swimming pool.

Coating or Injection into Floor Screed, Wall & Absorbent Surface to Prevent Seepage & Waterproof:

- Use W1 or Mix W1 + W5 MULTI-BOND, dilute as needed, to coat, or inject into the brick or cement, to seal up porosity. Injection pressure is 60 to 100 psi. Normal drying time is 10 days at 30°C.

Type 2 Bonding Method:

1. **Priming Slurry** $W1 + Cement = 1 + 2$

Brush the slurry onto the cement surface, while it is still wet (10 minute drying time)

Apply the mortar directly onto it.

2. **Type 2 save on the W1 consumption, bonding strength is also higher.**

Old Concrete Bonding:

1. **Priming Slurry** $W1 + Water = 1 + 1 \text{ or } 2$

Before adding into Portland Cement or Tile Bond Cement at 30% level

Brush the slurry onto the Old Concrete surface, while it is still wet (20 minute Open time)

Pour the New Concrete mix directly onto it.

104 I think the Applicant is right. The retail consumer selecting and purchasing cement strengtheners would likely differ from the retail consumer who only selects and purchases tiles (as in *Caesarstone*). The former would have a lower likelihood of being confused or deceived by the use of the Application Mark, in comparison with the Opponent's "W1" mark. He would possess some technical knowledge relating to construction and renovation, and not be overwhelmed and therefore deceived or confused by the Application Mark.

Conclusion on Misrepresentation

105 Having considered the foregoing factors individually, I now have to take a step back and weigh them up in the scale. Not all factors factor equally and there can be trade-offs between them. I have considered:

- (i) The similarities and differences between the Application Mark and "W1"
- (ii) The reputation of "W1"
- (iii) The normal way in which the goods are purchased

- (iv) The nature of the marks
- (v) The nature of the goods
- (vi) The price of the goods
- (vii) The frequency of purchase of the goods
- (viii) The nature of the consumers.

106 Out of the above, (ii), (iii), (iv) and (viii) point away from a likelihood of confusion; (v) and (vi) point towards a likelihood of confusion; and (i) and (vii) are neutral. There is much interconnection between (ii), (iii) and (iv), and this group of factors, when encountered by a retail consumer of the nature described in the analysis under (viii), would quite definitively tilt the balance away from a likelihood of confusion. Any concerns of possible deception or confusion arising from (v) and (vi) should dissipate at the point of selection and purchase, when the circumstances considered under (iii) prevail in the light of (ii) and (iv).

107 Accordingly, I conclude that the use of the Application Mark is not likely to result in retail consumers⁴⁵ being deceived or confused into thinking that the Applicant's goods are, or emanate from a source that is linked to, the Opponent's.

Damage

108 On this element of passing off, the Court of Appeal in *Singsung* has said, at [41], that “*the claimant need not show actual damage as long as a real tangible risk of substantial damage is present*”.

109 Since the element of misrepresentation above has not been established, it cannot be said that there is a “*real tangible risk of substantial damage*”.

Conclusion on Section 8(7)(a)

110 The ground of opposition under Section 8(7)(a) therefore fails.

Overall Conclusion

111 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on both grounds. The application will proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

112 I record my appreciation for the Opponent's counsel's efforts towards the quality and organisation of its evidence and arguments.

Date of Issue: 23 June 2021

⁴⁵ The Opponent does not canvass its case under Section 8(7)(a) in relation to trade consumers: [66] above.