

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

REGISTRAR’S DECISION UNDER TRADE MARKS RULE 37(4)

Introduction

1 Aramara Beauty LLC (dba Glow Recipe) (“the Applicant”), a company constituted under the laws of New York, United States of America, applied for a declaration of invalidity against the registration of the following trade mark:

GLOW RECIPE

(“the Subject Mark”)

The Subject Mark was registered in Singapore under Trade Mark No. 40201917164W on 8 August 2019 (“the Relevant Date”) in the name of Sinchen Group Pte. Ltd. (“the Proprietor”), a company incorporated in Singapore. The registration is in Classes 3, 5 and 32, in respect of:

Class 3

Beauty masks; Collagen preparations for cosmetic purposes; Cosmetics; Cosmetic creams; Lipstick; Lotions for cosmetic purposes; Make-up; Skin whitening creams; Cream for skin whitening; Cream for whitening the skin.

Class 5

Dietary fiber; Albumin dietary supplements; Dietary supplements with a cosmetic effect; Enzyme dietary supplements; Glucose dietary supplements; Nutritional supplements; Nutritive substances for microorganisms; Propolis dietary supplements; Protein dietary supplements; Royal jelly dietary supplements.

Class 32

Beer; Energy drinks; Mineral waters [beverages]; Non-alcoholic beverages; Seltzer water; Soda water; Soft drinks; Table waters; Vegetable juices [beverages]; Waters [beverages].

2 The Applicant’s application is based on Sections 7(6)¹, 8(1)², 8(2)(a)³, 8(4)⁴, 8(7)(a)⁵ and 23(4) of the Trade Marks Act 1998 (“the Act”).

Procedural Conduct

¹ Read with Section 23(1)

² Read with Section 23(3)(a)(i)

³ Read with Section 23(3)(a)(i)

⁴ Read with Section 23(3)(a)(iii)

⁵ Read with Section 23(3)(b)

3 The Proprietor filed evidence with the Registrar of Trade Marks (“the Registrar”) on 16 April 2022. The Applicant did not receive a copy of the Proprietor’s evidence, notwithstanding that the Proprietor was required to serve a copy of its evidence on the Applicant under Rule 33(3) read with Rule 59(2) of the Trade Marks Rules (all references hereafter to “Rule” and “Rules” are to provisions of the Trade Marks Rules).

4 The Registrar directed the Proprietor to show proof of service of its evidence on the Applicant by 9 May 2022, to which the Proprietor did not respond. The Registrar again directed the Proprietor to show proof of service by 6 June 2022, this time with the caution that if no proof of service is received by the deadline, the Proprietor will be deemed to admit to the facts alleged by the Applicant in its application for a declaration of invalidity, in accordance with Rule 59(2)(d).

5 As the Proprietor did not respond at all by the deadline of 6 June 2022, the Registrar confirmed in writing on 27 June 2022 that the Proprietor was deemed to admit to the facts alleged by the Applicant. It is on this basis – that the Proprietor admits to the facts alleged by the Applicant – that the present decision is made. We will return to this point further below.

Procedural Provision Relating to Hearings

6 This application for a declaration of invalidity was set down for a hearing on 28 September 2022.

7 The Rules provide for the procedure relating to hearings. The relevant extract from Rule 37 is set out below:

Opposition hearing

37.—(1) Upon completion of the filing of evidence by the parties, the Registrar shall give notice to the parties of a date on which he will hear arguments on the case.

(2) The parties shall file with the Registrar their written submissions and bundles of authorities at least one month before the date of hearing, and shall at the same time exchange with one another their respective written submissions and bundles of authorities.

(3) Any party who intends to appear at the hearing shall file with the Registrar Form HC1 before the hearing.

(4) Any party who does not file with the Registrar Form HC1 before the hearing may be treated as not desiring to be heard, and the Registrar may proceed with the hearing in the absence of that party or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit.

8 As Rule 37(3) above provides, a party who intends to appear at the hearing needs to file Form HC1. If this is not done, there is a range of possible consequences, as found in Rule 37(4) above.

9 Before the hearing, on 25 September 2022, the Applicant informed the Registrar in writing that it would not attend the hearing in order to save costs, highlighting that its non-attendance is not for a lack of interest in pursuing the application. The

Applicant's view is that it would be more cost-efficient for the Registrar to decide based on its written submissions already filed, especially in light of the non-response of the Proprietor. The Registrar did not receive any communication from the Proprietor in this regard.

10 On the day of the hearing, the Proprietor still had not filed Form HC1. Neither did it attend the hearing. Given the conduct of the Proprietor on the one hand and the public interest in the time- and cost-effective resolution of these proceedings on the other hand, as well as the expense incurred and delay suffered by the Applicant because of the Proprietor's unresponsive conduct, it would be appropriate to conclude this matter expeditiously and at lower cost by giving a short decision without proceeding with a hearing. The Registrar therefore exercises her power under Rule 37(4) to issue a decision without having proceeded with a hearing.

Applicant's Evidence

11 The Applicant's evidence comprises a statutory declaration made by Jeffrey Klein, the Applicant's Chief Financial Officer and Chief Operating Officer, on 30 September 2021 in New Jersey, United States of America.

Applicable Law and Burden of Proof

12 As the applicable law is the Act, there is no overall onus on the Proprietor either before the Registrar during examination or in the present proceedings relating to an application for a declaration of invalidity. The burden of proof in the present case falls on the Applicant.

Ground of Invalidation under Section 8(2)(a)

13 Section 8(2)(a) of the Act reads:

(2) A trade mark must not be registered if, because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; ...

there exists a likelihood of confusion on the part of the public.

14 The Applicant's pleading under this ground is found at [17] of its statement of grounds:

Further or in the alternative, as the Registered Mark is identical to the GLOW RECIPE mark of the Applicants and the goods covered by the said Singapore TM No. 40201917164W are identical or similar to the Applicants' goods and services, the conditions of section ... 8(2)(a) apply, and the said Singapore TM No. 40201917164W should be declared invalid under section 23(3)(a)(i) of the Trade Marks Act (Chapter 332).

Application of Section 8(2)(a)

15 The treatment of this case differs significantly from typical cases which reach the hearing stage. In typical cases, an applicant for a declaration of invalidity bears the burden of proving the facts it alleges. In this case, under Rule 59(2)(d), the Proprietor is deemed to admit to the facts alleged by the Applicant.

16 The Applicant alleges the following in its statement of grounds:

- (i) The Applicant’s “GLOW RECIPE” mark is well known in Singapore: [14].
- (ii) The Subject Mark is identical to the Applicant’s “GLOW RECIPE” mark: [17].
- (iii) The respective goods and services are similar: [17].
- (iv) The conditions of Section 8(2)(a) apply because of (ii) and (iii): [17].

17 Rule 59(2)(d) operates, with the outcome that the Proprietor is deemed to admit to the specific facts set out in the Applicant’s statement of grounds. I elaborate on the effect of this rule below.

18 The requisite elements under Section 8(2)(a) are:

- (i) There is an “earlier trade mark”.
- (ii) The Subject Mark is identical to the “earlier trade mark”.
- (iii) The Subject Mark is registered for goods (in this case, rather than “services”) similar to the goods and services for which the earlier trade mark is protected.
- (iv) Because of (ii) and (iii) above, there exists a likelihood of confusion on the part of the public.

19 As regards the first element of Section 8(2)(a), the following definitions from Section 2(1) of the Act are relevant:

“earlier trade mark” means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a *well known trade mark*,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

(*emphasis mine*)

“well known trade mark” means —

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

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

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

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

20 The Applicant is constituted under the laws of New York, United States of America (a “Convention country”) and continues to operate in that country as well as worldwide, including in Singapore. The Applicant, who owns the earlier “GLOW RECIPE” mark, accordingly fulfils the criteria required of the owner of an (as claimed) unregistered well known trade mark.

21 The Applicant started business with its online store Glow Recipe (www.glowrecipe.com) in 2014, and now also has pop-up retail stores, as well as sales channels through other platforms such as amazon.com and sephora.com. The Singapore market is exposed to www.glowrecipe.com – for example, the Daily Vanity magazine (dailyvanity.sg) in February 2018 featured www.glowrecipe.com in a list of online beauty stores, and the Applicant’s store was also regularly referenced in other magazines in Singapore, such as Harpers Bazaar Singapore, Her World and Tatler Asia, in 2016 and 2017, all before the Relevant Date. The Applicant’s Glow Recipe products have been reviewed alongside other familiar brands like Clinique, Shiseido, Estee Lauder, Origins, Lush, Etude House. Customers in Singapore can purchase Glow Recipe products from websites such as www.glowrecipe.com (which states it ships internationally, including to Singapore), sephora.sg, amazon.sg, shopee.sg, lazada.sg and qoo10.sg.

22 The Proprietor is deemed to admit to the fact that the Applicant’s “GLOW RECIPE” mark is well known in Singapore. Hence, the first element, an “earlier trade mark”, of Section 8(2)(a), at [18(i)] above is satisfied.

23 Second, Section 8(2)(a) requires the Subject Mark to be identical to the “earlier trade mark”. The Subject Mark is **GLOW RECIPE** and the earlier trade mark is “GLOW RECIPE”. It is obvious that this element is satisfied.

24 Third, Section 8(2)(a) requires the goods in respect of which the Subject Mark is registered to be similar to the goods and services for which the earlier trade mark is protected.

25 The Applicant’s statement of grounds does not expressly state the goods and services in respect of which the Applicant’s “GLOW RECIPE” mark is protected. From the description in its statement of grounds of the Applicant’s business in which the “GLOW RECIPE” mark is used, the most significant goods would be beauty and skincare products, in Class 3, and, given that the Applicant is an e-commerce company, possibly online retail services in respect of beauty and skincare products, in Class 35.

26 The Proprietor’s goods in its Class 3 specification are identical to the Applicant’s goods in Class 3 (see preceding paragraph), and clearly similar to the latter’s services in Class 35 (see preceding paragraph). The Proprietor’s goods in Class 5 are health-related products, and with the prevalence of “cosmeceuticals” (a combination of cosmetic and skincare products in Class 3 and health-related products in Class 5), it is plausible that the Proprietor’s goods in Class 5 are similar to the Applicant’s goods in

Class 3. Likewise, the range of beverage products claimed by the Proprietor in Class 32 (e.g. “vegetable juices”) are also ingested, including plausibly for health reasons, just like goods in Class 5 (ingestible and for health reasons); and it is plausible that the Proprietor’s goods in Class 32 are similar to the Applicant’s goods in Class 3. The Proprietor is deemed to admit to the facts set out in the Applicant’s statement of grounds. In the absence of any submissions by the Proprietor, I find that the Subject Mark is registered for goods similar to the goods and services for which the earlier trade mark is protected.

27 Because the relevant “GLOW RECIPE” marks are identical, and their respective goods and services are identical or similar, a likelihood of confusion is more likely than not to exist. Specifically, in view of the fame of the Applicant’s earlier trade mark, and the nature of the goods (and the Applicant’s services in Class 35) which the general public can access readily through online and bricks and mortar trade channels with low barriers to entry, for the purposes of health and beauty, it is plausible that a likelihood of confusion exists. In view of the Proprietor’s deemed admission and in the absence of any submissions by the Proprietor, I find that the conditions of Section 8(2)(a) apply because of the identity of marks and the identity and/or similarity of the respective goods and services.

28 As such, the requisite elements of Section 8(2)(a) are established by the Proprietor’s admission. The Applicant has therefore made out its case under Section 8(2)(a) of the Act.

29 The unusual nature of the present case cannot be overstated. Ordinarily, the Registrar would have to be persuaded by the party who bears the burden of proof (in this case, the Applicant) of each requisite element in the claimed ground of invalidation. The outcome here did not result from a strict weighing of the evidence against the alleged facts which support the legal elements in each ground of invalidation. There was no robust argument and presentation of each party’s best case before me. Instead, it resulted from the Proprietor’s deemed admission to the Applicant’s alleged facts as linked to the requisite legal elements, subject to a minimum threshold of plausibility.

Conclusion

30 Having considered the pleadings, evidence and the Applicant’s submissions made in writing, and applying the presumption under Rule 59(2)(d), the Registrar finds that the Applicant succeeds under Section 8(2)(a). It is not necessary for the Registrar to consider the other grounds of invalidation, especially as the Proprietor has not demonstrated current interest in maintaining the registration of the Subject Mark.

31 The registration of the Subject Mark is accordingly declared invalid. In accordance with Section 23(10) of the Act, the registration is deemed never to have been made, but this does not affect transactions past and closed.

32 The Applicant has made brief submissions on costs. I award costs of \$4211.00 (inclusive of official fees of \$1071.00) to the Applicant.

[2022] SGIPOS 18

See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

30 November 2022