

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

**[2022] SGIPOS 4**

Trade Mark No. 40201818292X

**IN THE MATTER OF A TRADE MARK APPLICATION BY**

**V V TECHNOLOGY PTE LTD**

*... Applicant*

**AND OPPOSITION THERETO BY**

**TWITTER, INC.**

*... Opponent*

---

**GROUND OF DECISION**

---

## TABLE OF CONTENTS

---

<b>INTRODUCTION.....</b>	<b>1</b>
<b>CHRONOLOGY OF PROCEEDINGS.....</b>	<b>1</b>
<b>THE EVIDENCE.....</b>	<b>7</b>
<b>BACKGROUND .....</b>	<b>8</b>
<b>GROUNDS OF OPPOSITION.....</b>	<b>16</b>
<b>APPLICABLE LAW AND BURDEN OF PROOF .....</b>	<b>16</b>
<b>GROUND OF OPPOSITION UNDER SECTION 8(2)(B).....</b>	<b>16</b>
SIMILARITY OF MARKS .....	17
<i>The distinctiveness of the Opponent’s Mark.....</i>	<i>23</i>
<i>Inherent technical distinctiveness .....</i>	<i>24</i>
<i>Acquired technical distinctiveness (and whether it can be considered at the marks-similarity stage) .....</i>	<i>29</i>
<i>Comparison between the Application Mark and the Opponent’s Mark ..</i>	<i>32</i>
<i>Visual similarity.....</i>	<i>33</i>
<i>Aural similarity.....</i>	<i>40</i>
<i>Conceptual similarity.....</i>	<i>42</i>
<i>Conclusion on marks-similarity assessment .....</i>	<i>45</i>
SIMILARITY OF SERVICES .....	45
LIKELIHOOD OF CONFUSION .....	48
<i>The characteristics of the average consumer of the relevant services ....</i>	<i>49</i>
<i>Effect of Opponent’s reputation in its mark.....</i>	<i>52</i>

<i>Overall Assessment of Likelihood of Confusion</i> .....	55
CONCLUSION ON OPPOSITION UNDER SECTION 8(2)(B) .....	56
<b>GROUND OF OPPOSITION UNDER SECTION 8(7)(A)</b> .....	<b>56</b>
<b>OVERALL CONCLUSION</b> .....	<b>58</b>

**Twitter, Inc.**  
v  
**V V Technology Pte Ltd**

**[2022] SGIPOS 4**

Trade Mark No. 40201818292X  
Principal Assistant Registrar Mark Lim  
2 December 2021, 16 December 2021

11 March 2022

**Principal Assistant Registrar Mark Lim:**


**Introduction**

1 This case raises interesting, important and complex issues regarding the assessment of similarity between two device marks (in this case, two “bird” devices). What test do you apply such that you do not under-protect the prior device (confine protection only to *a specific depiction* of a bird) or over-protect the prior device (extend protection to *any depiction* of a bird)? What is the relevance (if any) of aural similarity and conceptual similarity? Does any acquired distinctiveness or reputation of the prior mark increase or reduce the likelihood of confusion on the part of consumers? What if the acquired distinctiveness of the prior mark is confined to only some of the services for which it is registered? And what if these services are not the ones for which the later mark is applied for?


**Chronology of Proceedings**

2 On 10 September 2018 (“**the Relevant Date**”), V V Technology Pte.



Ltd. (the “**Applicant**”) applied to register  in Class 42 for “Information services relating to information technology; Maintenance of computer software relating to computer security and prevention of computer risks; Maintenance of software for internet access; Monitoring of computer systems by remote access; Preparation of reports relating to computer programs; Providing Information on Computer technology and programming via a web site; Provision of information relating to computer programming” (the “**Application Mark**”).

3 The Application Mark was published for opposition purposes on 24 May 2019.

4 Twitter, Inc. (the “**Opponent**”) filed its Notice of Opposition (“**NO**”) on 24 September 2019. It relies on its prior registration for  (the “**Opponent’s Mark**”), which is registered for a broad range of goods and services, namely:

<p>Class 9</p>	<p>Apparatus for recording, transmission or reproduction of sound or images; compact discs, DVDs and other digital recording media; computer software; computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer software and software applications to enable transmission, access, organization, and management of text messaging, instant messaging, online blog journals, text, weblinks, audio, video and images via databases, computer networks and the internet; computer software used to enhance the capabilities and features of other software and non-downloadable online software; software for accessing information on a global computer network; downloadable software via the internet and wireless devices; software for accessing, sending, and receiving information on a global computer network; software for computers, communication devices, mobile devices, and wired and wireless communication apparatus for facilitation of communication and data transmission in the field of social networking; software applications for use with mobile devices;</p>
----------------	--

	<p>software applications for use with mobile devices, computers, communication devices, and wired and wireless communication devices for facilitation of communication; computer software in the nature of a mobile application for social networking; software applications for use with mobile devices for real-time delivery of data, messages, location, photographs, links, audio, video, images, text and other data related thereto; downloadable software for posting, sharing, displaying and viewing user-generated content in real-time; computer software to facilitate online advertising, business promotion, connecting social network users with businesses and for providing strategy, insight, and marketing; application programming interface (API) for third-party software; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer e-commerce software to allow users to perform electronic business transactions via mobile devices, and computer and communications networks; computer software, namely, software applications for use by consumers to facilitate electronic payments and commercial transactions; computer software for collecting, analyzing, storing and transmitting data and information regarding electronic payment transactions; downloadable computer software and mobile application software for use in providing retail and ordering services for a wide variety of consumer goods and services of others; downloadable computer software and mobile application software that enables merchants to provide information about and consumers to obtain discounts, rebates, rewards, coupons, credits, and special offers for goods and services; downloadable software for running, administering, participating in, and monitoring customer loyalty programs.</p>
<p>Class 35</p>	<p>Business management; business administration; office functions; advertising and marketing; advertising services; online advertising and marketing services; business data analysis; promotional services; business networking; services provided online to assist social network users in establishing a connection with businesses; business consulting and information services; business monitoring and consulting services, namely, providing business strategy, insight, marketing consultancy, and for analysis of business and market research data, business and marketing activity, and business and marketing trends; business, consumer, and market research; Promoting the products and services of others by distributing advertising materials; data processing in the field of electronic payments; providing business information, advertising information and market research information via a searchable online business database; market research and market research information services; compiling information into computer databases; providing consumer product information and reviews via a website; provision of an online marketplace for buyers and sellers of goods and services; on-line ordering services featuring a wide variety of consumer goods and services of others; computerized processing of on-line purchase orders; business intermediary services for the sale</p>

	<p>and purchase of goods and services; data retrieval services for transmitting, displaying and storing transaction, identification and financial information; data management and tracking (collecting) services relating to payment transaction information, including such information relating to credit card, debit card, gift card, pre-paid card, deferred payment card, and other forms of payment transactions for business purposes; providing an on-line commercial information directory and advertising guide featuring the goods and services of others; promoting the goods and services of others by providing an online platform that enables users to obtain discounts, rebates and special offers on products and services; promoting the goods and services of others by providing rewards, coupons, credits, rebates, special offers, links to the retail web sites of others, and discount information via the internet and other communications networks; arranging and conducting incentive reward programs to promote the sale of a wide variety of third party goods and services; organisation, operation, supervision, administration and management of customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; organisation, operation, supervision, administration and management of incentive award programs for prepaid cash card, debit card and credit card customers through the issuance and processing of loyalty coupons for frequent use of participating businesses.</p>
Class 38	<p>Telecommunications; telecommunication services; telecommunication services, namely, providing online and telecommunication facilities for real-time interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; providing access to telecommunications networks for individuals to send and receive text, audio and video via email, SMS, mobile application, instant messaging or a website; providing online chat rooms and electronic bulletin boards for transmission of text, audio and video among users in the field of general interest; providing an online community forum for users to share information, photos, audio and video; transmission of messages; electronic message sending, receiving and forwarding; electronic exchange of messages using chat lines, chat rooms, and Internet forums; providing online forums for transmission of messages among computer users; electronic transmission of data; electronic transmission of streamed audio and video files via computer and communications networks; electronic transmission of downloadable audio and video files via a computer and communications networks.</p>
Class 41	<p>Entertainment; sporting and cultural activities; education; online publication of journals or diaries (blog services), namely, blogs featuring user-defined content in the field of social networking; online publication of journals or diaries (blog services), namely, blogs featuring personal information and opinions in the field of general interest; providing real-time information relating to the</p>

	<p>latest stories, ideas, opinions, news and to information of personal interest, all being in the fields of entertainment, sports, fashion, education, hobbies, recreation, training, celebrity, culture, current events (relating to the aforesaid fields) and blogging via the internet and other communications networks; providing information related to the latest stories, ideas, opinions, news and to information of personal interest via a website, all information being in the fields of entertainment, sports, fashion, education, hobbies, recreation, training, celebrity, culture and blogging; providing information relating to a wide variety of topics, namely in the fields of news, entertainment, sports, fashion, education, hobbies, recreation, training, celebrity, culture, and current events (relating to the aforesaid fields); providing non-downloadable electronic publications (blogs) and non-downloadable text, video and audio files; providing entertainment information in the field of topics and people in the entertainment and sports industries via a searchable online database; providing information in the field of entertainment via an online database; providing information in the field of sports, education and cultural news and entertainment.</p>
<p>Class 42</p>	<p>Design and development of computer hardware and software; scientific and technological services and research and design relating thereto; software as a service (SAAS) services, namely, hosting software for use by others for use in communications between people and organizations, using wireless and wired networks, through computers and mobile devices; hosting a platform for mobile device communications; hosting online web facilities for others for conducting interactive discussions; providing temporary use of non-downloadable software applications accessible via a website; providing temporary use of online non-downloadable software; application service provider featuring application programming interface (API) software; computer services, namely, hosting a platform featuring technology that enables internet users to post, upload, view, and share data, information and multimedia content; computer services, namely, hosting an online community web platform for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services; hosting an interactive website and online non-downloadable software for real-time delivery of data, messages, location, photographs, links, text, audio, video and other data; hosting an online platform and non-downloadable software for posting, sharing, displaying and viewing user-generated content in real-time; hosting a website that allows users to review text, audio and video material and provide commentary; computer services, namely, hosting an online community web platform for users to participate in discussions and engage in social networking; providing temporary use of non-downloadable computer software for creating, designing, editing and organizing text, images, audio and video files; providing online non-downloadable software collecting, analyzing, storing and transmitting data and information regarding</p>

	<p>electronic payment transactions; providing online non-downloadable software to facilitate electronic payments and commercial transactions; hosting an online platform and interactive website for use in providing retail and ordering services for a wide variety of consumer goods and services of others; hosting an online platform and interactive website that enables merchants to provide information about and consumers to obtain discounts, rebates, rewards, coupons, credits, and special offers for goods and services; providing temporary use of non-downloadable software for running, administering, participating in, and monitoring customer loyalty programs; electronic data storage services for transmitting, displaying and storing transaction, identification and financial information; providing a web-based system and online portals in the field of consumer-to-business commerce for consumers to enter, manage and modify their consumer preference, transaction and payment information and for merchants to create, advertise, manage and provide offers to consumers; providing a website on the internet for the purpose of social networking; providing online computer databases and online searchable databases in the field of social networking; providing a social networking website for entertainment purposes; computer security services in the form of authentication and verification of identity of users, and monitoring computer systems for security purposes.</p>
<p>Class 45</p>	<p>Online social networking services; providing user authentication services in transactions; on-line social networking services accessible by means of downloadable mobile applications.</p>

5 The Opponent also relies on its following prior unregistered marks:



6 The Applicant filed its Counter-Statement (“CS”) in support of the application on 18 November 2019.

7 The Opponent filed evidence in support of the opposition on 18 September 2020. The Applicant filed evidence in support of the application on 19 January 2021. The Opponent filed its reply evidence on 20 March 2021. A Pre-Hearing Review was held on 16 April 2021. The parties submitted the dispute to mediation but did not reach a settlement. A further Pre-Hearing Review was held on 2 August 2021, after which the opposition was heard on 2

December 2021.

8 In advance of the hearing, the parties filed their written submissions on 2 November 2021 (Applicant’s Written Submissions (“**AWS**”) and Opponent’s Written Submissions (“**OWS**”) respectively). The Opponent filed its Supplemental Written Submissions (“**OWS-2**”) in response to the AWS on 18 November 2021. The Applicant filed its Rebuttal Submissions (“**AWS-2**”) in response to both the OWS and OWS-2 on the morning of the hearing. In accordance with IPOS HMD Circular 5.2H, the Opponent was given leave to respond to these submissions within two weeks after the hearing. It duly filed its Reply Written Submissions (“**OWS-3**”) on 16 December 2021.

### **The Evidence**

9 The following Statutory Declarations (“**SDs**”) were tendered in evidence:

- (a) SD of Mr Naser Baseer, the Director, Associate General Counsel of the Opponent, dated 18 September 2020 (“**OSD**”).
  
- (b) SD of Mr Lim Boon Kiat, the General Manager of the Applicant, dated 19 January 2021 (“**ASD**”).
  
- (c) SD in Reply of Mr Naser Baseer dated 20 March 2021 (“**OSDR**”).

## Background

10 The Applicant is a technology start-up which was established to leverage on advancements in artificial intelligence, blockchain technologies, cloud computing and big data to achieve its objective in driving the world’s transition to smart commerce. Together with two other companies which are based in China, it is part of the V V group of companies.<sup>1</sup>

11 Since December 2018, the Applicant has been chiefly engaged in the development of a mobile application named “V V Life” (“App”). The App is developed to serve as a user’s smart personal concierge by operating as a single platform hosting a wide range of products and services catering to a user’s personal lifestyle needs.<sup>2</sup> The Opponent points out that social networking appears to be a crucial and core feature of the App.<sup>3</sup>

12 The App has not been launched yet. From the Applicant’s marketing slides<sup>4</sup>, it is intended that the Application Mark will be prominently displayed at the bottom of a user’s handphone screen when the App is in use, with the

Applicant’s company name (  ) depicted at the top left-hand corner of the screen as follows:

---

<sup>1</sup> See ASD at [4] & [5].

<sup>2</sup> See ASD at [6] & [7]. For more details of what the App is intended to do, see ASD at [7]-[12].

<sup>3</sup> See OSDR at [7]-[11], and the exhibits referred to therein.

<sup>4</sup> See ASD, Exhibit “LBK-2”.



13 According to the Applicant, the Application Mark contains a pictorial representation of the Applicant’s initials, “V V”, and depicts a hummingbird. The hummingbird was allegedly chosen “*given that symbolic parallels could be drawn between a hummingbird, which is nimble given its small size but also capable of traveling great distances, and the Applicant, which is committed to being responsive to market demand and to the wide-ranging needs of the communities it serves.*”<sup>5</sup> The Applicant relies on its Facebook posts dated 7

<sup>5</sup> See ASD at [14].

October 2020 and 4 November 2020 as evidence of the derivation of the Application Mark.<sup>6</sup> The Opponent disputes that the Application Mark depicts a humming bird, and submits that “*the average consumer is unlikely to regard the Application Mark as anything more than an abstract, stylized representation of a bird embodying the same core features of the [Opponent’s Mark].*”<sup>7</sup> I also note that the Facebook posts relied on by the Applicant were published more than two years after the Relevant Date.

14 The Applicant’s bird device has been registered for a very broad range of goods and services in Classes 3, 9, 21, 29, 30, 31, 32, 33, 35, 38, 39, 41 and 43.<sup>8</sup> Some of the goods and services overlap with the goods and services for which the Opponent’s Mark has been registered (e.g. “computer software applications, downloadable” in Class 9, “advertising” in Class 35, “providing online forums” in Class 38 and “entertainment services” in Class 41, among many other examples).

15 The Opponent was founded on 21 March 2006, and subsequently incorporated in the State of Delaware, United States of America on 19 April 2007. It has been a publicly-listed company on the New York Stock Exchange since 2013.<sup>9</sup>

16 Among other things, the Opponent owns and operates the Twitter platform, a microblogging and social networking service where registered users can post and interact with each other with messages known as “Tweets”. Twitter

---

<sup>6</sup> See ASD at [22] and Exhibit LBK-5.

<sup>7</sup> See OWS at [44]-[45].

<sup>8</sup> See ASD, Exhibit LBK-6. After the Relevant Date, the Applicant’s bird device also secured registration in Class 36: see AWS at [5].

<sup>9</sup> See OSD at [3].

is one of the biggest social networks worldwide.<sup>10</sup> It counts high-profile celebrities and politicians like Katy Perry, Justin Bieber, Barack Obama and Donald Trump amongst its most-followed users. Their “Tweets” reach a global audience, including in Singapore.<sup>11</sup>

17 The Twitter platform has been accessible to the Singapore public since its launch in 2006. It has a strong presence here. Numerous local public institutions, celebrities and politicians (such as the Singapore Government, singer-songwriter JJ Lin and Prime Minister Lee Hsien Loong) have created and frequently use official Twitter accounts.<sup>12</sup> According to *statista.com*, as of 11 June 2020, there were over 1.3 million Twitter users in Singapore.<sup>13</sup>

18 In the period from 2015-2019, the Opponent’s approximate annual worldwide revenue / sales figures under the “Twitter” brand ranged from USD 2.22 billion in 2015 to USD 3.46 billion in 2019.<sup>14</sup> The Opponent also spends a significant amount on advertising and promotions. Their worldwide marketing expenditure ranged from USD 717 million to USD 957 million a year between 2015-2019.<sup>15</sup> Much of the Opponent's advertising expenditure is spent on digital marketing with global reach.<sup>16</sup>

19 The goods and services offered under the Opponent’s Mark allow individuals and/or companies to provide and/or consume an extensive range of

---

<sup>10</sup> See OSD at [4] and [5].

<sup>11</sup> See OSD at [7].

<sup>12</sup> See OSD at [25].

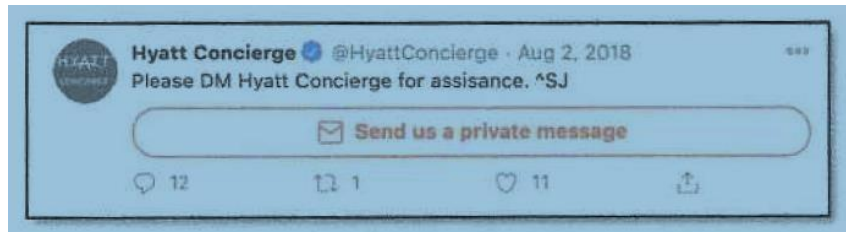
<sup>13</sup> See OSD at [27] and Exhibit “OSD-14”.

<sup>14</sup> See OSD at [21].

<sup>15</sup> See OSD at [16].

<sup>16</sup> See OSD at [18].

conversation and/or information. According to the Opponent, these include concierge-related services. One example of such a service provided by the Opponent is Hyatt Concierge (<https://twitter.com/HyattConcierqe>) and Hyatt's use of the direct message feature on Twitter:



20 The Opponent provided numerous examples of other goods and services which it offers.<sup>18</sup> These appear to be different in nature from the services which the Applicant intends to provide (briefly described at [11] above), but nothing turns on these differences for the purposes of the current opposition proceedings.

21 The Twitter platform operates under the Opponent's Mark and variations thereof.<sup>19</sup> According to the Opponent's co-founder, Jack Dorsey, "*Twitter means a short inconsequential burst of information, chirps from birds*", and this name was chosen as it best embodied the instantaneous nature of the microblogging platform.<sup>20</sup>

22 In the same vein, much of the Opponent's brand strategy since its founding has been geared towards cultivating the symbol of a bird as

---

<sup>17</sup> See OSD at [9].

<sup>18</sup> See OSD at [8]-[10] and OSDR at [13]-[17] for details.

<sup>19</sup> See OSD at [8].

<sup>20</sup> See OSD at [11].

synonymous with the Opponent and its products and services.<sup>21</sup> The Opponent has been extensively using and promoting, as an integral part of its brand, a variety of bird logos in connection with its products and services since 2006. These include:



(collectively, the “**Twitter Bird Logos**”).<sup>22</sup>

23 The Opponent is unable to provide the precise dates (month/year) in which each of the Twitter Bird Logos was introduced.<sup>23</sup> From an article in *The New York Times Magazine* entitled “Who Made That Twitter Bird?” dated 8 August 2014<sup>24</sup>, the “evolution” of the Opponent’s bird logo was depicted as follows:

---

<sup>21</sup> See OSD at [13].

<sup>22</sup> See OSD at [14]. In the NO (at [2]) and OWS (at [6]), the Opponent only lists the 1<sup>st</sup>, 2<sup>nd</sup>, 3<sup>rd</sup> and 6<sup>th</sup> logos as prior bird logos, but nothing turns on this.

<sup>23</sup> See OWS-3 at [71]-[72].

<sup>24</sup> See OSDR, Exhibit OSD-27 (page 130).

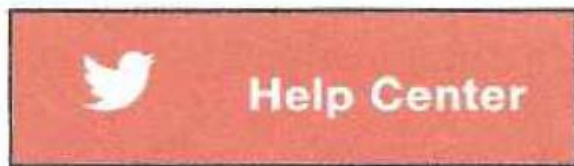


From screenshots of The Straits Times' online Twitter profile every year between 2009 and 2013, it appears that the following bird logos were used in

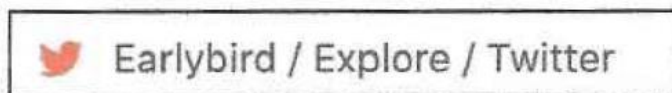
Singapore during this period:  (2009),  (2010 & 2011) and  (2012 & 2013).<sup>25</sup>

<sup>25</sup> See OSD at [31] and Exhibit “OSD-17”. I note that some of the exhibits are undated.

24 According to the Opponent, the Twitter Bird Logos are used in various colours (including yellow and orange) and backgrounds. Some examples provided by the Opponent are as follows<sup>26</sup>:



(Source: <https://help.twitter.com/en/rules-and-policies#twitter-rules>)



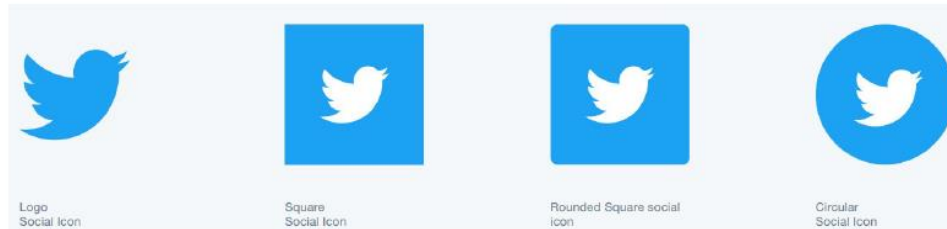
(the last example was used for beta testing)

25 However, the Applicant points out that the Opponent’s own brand guidelines stipulate that the Opponent’s Mark “*is always either blue or white*”, and that therefore users of the Opponent’s Mark should “[*o*nly show the logo

---

<sup>26</sup> See OSD at [15].

in *Twitter blue or white*” (emphasis added by Applicant), illustrated as follows<sup>27</sup>:



### Grounds of Opposition

26 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.

### Applicable Law and Burden of proof

27 The applicable law is the Act. The Opponent bears the burden of proof to establish the grounds of opposition (*Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 at [21]).

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

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

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

...

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.

<sup>27</sup> See ASD at [86] and Exhibit “LBK-24”.

29 To succeed in an opposition under this ground, the opponent must establish that:

- (a) the competing marks are similar;
- (b) the goods and services of the competing marks are identical or similar; and
- (c) there exists a likelihood of confusion arising from the similarities in (a) and (b) above.

30 These conditions are assessed “step-by-step.” As stated by the Court of Appeal in the landmark decision of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) at [15]:

“... Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round.”

31 There are thus three “gates” which an opponent must pass through to succeed in an opposition under Section 8(2)(b) of the Act. I will examine each of them in turn.

### ***Similarity of Marks***

32 The key principles relating to the evaluation for marks-similarity have been set out in a number of decisions of the Court of Appeal, including *Staywell* and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”). These can be summarised as follows:

(a) There are three aspects of this evaluation, namely, visual, aural and conceptual similarities. These aid the court’s evaluation by signposting its inquiry. There is no requirement that all three similarities (visual, aural, and conceptual) need to be made out before the marks or signs being compared may be found to be similar. The relative importance of each aspect of similarity will depend on the circumstances, including the nature of the goods and the types of marks involved and a trade-off can be made between the three aspects of similarity. (*Hai Tong* at [40])

(b) When assessing two contesting marks or signs, the court does so with the “*imperfect recollection*” of the average consumer. The two marks or signs should not be compared side by side or examined in detail because “*the person who is confused often makes comparison from memory removed in time and space from the marks*”. (*Hai Tong* at [40])

(c) Further, the assessment of marks-similarity is “mark-for-mark without consideration of any external matter” (*Staywell* at [20])





(d) The similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components. (*Hai Tong* at [40])

(e) The greater the earlier mark’s technical distinctiveness, the higher the threshold before a competing mark is considered dissimilar to it (*Staywell* at [25]). This is because highly distinctive marks—unlike descriptive or laudatory marks, for instance—are strong badges of origin. Such marks deserve greater protection to protect their strong source-denoting ability. Thus, to overcome an opposition based on a

highly distinctive mark, an applicant will have to prove “to a more compelling degree that his mark or sign is indeed dissimilar from the registered mark”. (*Hai Tong* at [30])


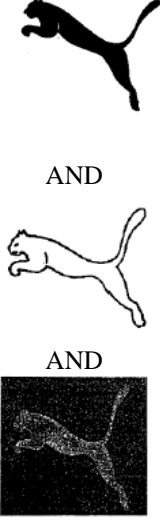
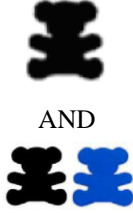
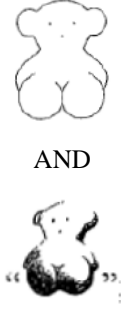



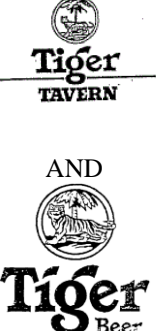
33 The application of these well-known principles in the assessment of marks-similarity between two device marks presents intriguing and difficult issues.













34 Before analysing these issues in greater detail, it is interesting to briefly set out the conclusions reached by some of the various courts and tribunals in the cases relied on by the parties. These cases will be discussed in greater detail where appropriate.

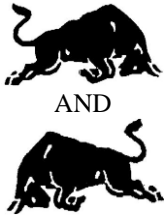









S/N	Case	Court/ Tribunal	Mark applied for	Prior mark(s)	Decision on mark- similarity
01	<i>MediaCorp News Pte Ltd v Astro All Asia Networks plc</i> [2009] 4 SLR(R) 496 (“ <i>MediaCorp</i> ”)	Singapore High Court	 28		Similar
02	<i>Adidas International Marketing BV v Lutong Enterprise Corp.</i> [2018] SGIPOS 12	IPOS			Dissimilar <sup>29</sup>

<sup>28</sup> The words at the base of the mark read “ASTRO ALL ASIA NETWORKS plc”.

<sup>29</sup> The decision was reversed on appeal to the High Court, which did not issue written grounds of decision.

<p>03</p>	<p><i>PUMA SE v Sinda Poland Corporation Sp. z o.o.</i> (EUIPO Case R 1304/2016-1) (“<i>Puma SE</i>”)</p>	<p>European Union IP Office (“<b>EUIPO</b>”)</p>		 <p>AND</p> <p>AND</p>	<p>Similar to a higher-than-average degree.</p>
<p>04</p>	<p><i>S Tous, S L v Ng Wee Ping</i> [2010] SGIPOS 6 (“<i>Ng Wee Ping</i>”)</p>	<p>IPOS</p>	 <p>AND</p>	 <p>AND</p>	<p>Dissimilar</p>
<p>05</p>	<p><i>Arctic Cat Inc v European Union Intellectual Property Office</i> (Case T-113/16) (“<i>Arctic Cat</i>”)</p>	<p>EUIPO</p>		 <p>(Class 25) AND (Class 12)</p>	<p>Similar</p>
<p>06</p>	<p><i>Glenn Elliott v Heineken Asia Pacific Pte. Ltd</i> [2014] NZIPOTM 18 (“<i>Glenn Elliott</i>”)</p>	<p>IP Office of New Zealand (“<b>IPONZ</b>”)</p>		 <p>AND</p>	<p>Similar</p>

				<p>AND</p>  <p>AND</p>  <p>AND</p>  	
07	<p><i>Puma SE v Slazengers Limited</i> (Opposition No. B 2 531 351) ("Slazengers")</p>	<p>EUIPO</p>		<p></p> <p>AND</p> <p></p> <p>AND</p> <p></p> <p>AND</p> <p></p>	<p>The signs do present similarities</p>
08	<p><i>Red Bull GmBH v Carabao Tawandang Company Limited</i> [2005] NZIPOTM 25 ("Red Bull IPONZ");</p>	<p>IPONZ</p>		<p><b>Red Bull</b></p> <p></p> <p>AND</p> <p></p> <p>AND</p>	<p>Similar</p>


	affirmed on appeal in <i>Carabao Tawandang Company Limited v Red Bull GmbH</i> (CIV2005-485-1975) (“ <b>Red Bull HCNZ</b> ”)				
09	<i>Trade Mark Inter Partes Decision</i> O368/21 (“ <b>W Device</b> ”)	UK IP Office		 <p>AND</p>  <p>AND</p>  <p>AND</p> 	Dissimilar (visually dissimilar, aurally identical and conceptually neutral)
10	<i>GSMA Ltd. v ZIH Corp.</i> (Case R 1978/2014-5) (“ <b>GSMA</b> ”)	Office for Harmonization in the Internal Market (now known as EUIPO), Fifth Board of Appeal			Similar (but this similarity is limited)
11	<i>Polo/Lauren Co LP v United States Polo Association</i> [2016] 2 SLR 667 (“ <b>Polo</b> ”)	Singapore High Court			Similar (but only to a low degree)

*The distinctiveness of the Opponent's Mark*

35 Distinctiveness is integrated into the marks-similarity comparison, and is not a separate step (*Staywell* at [30]). It is, however, more convenient to consider it separately as a threshold enquiry.

36 There are two aspects to distinctiveness – non-technical and technical.

37 In the non-technical sense, distinctiveness refers to “what is outstanding and memorable about the mark”. Such components tend to draw the average consumer’s attention and stand out in the average consumer’s imperfect recollection (*Staywell* at [23]). In *MediaCorp*, for example, the triangular or “A”

device in the applicant’s mark (  ) would be distinctive in the non-technical sense compared to the words in the mark (i.e. “ASTRO ALL ASIA NETWORKS plc”) as these words are barely legible relative to the device.

38 In the technical sense, distinctiveness refers to a mark’s capacity to operate as a badge of origin. A mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (*Staywell* at [25]). An invented word such as “XEROX”, for example, would have greater technical distinctiveness and enjoy stronger protection. There is no reason why a competitor would legitimately want to use a similar mark for its own goods; use of a similar mark would therefore be suggestive of a competitor’s intention to benefit from an association with the trade mark owner.


39 Technical distinctiveness may be inherent (i.e., relating to a mark’s fanciful or descriptive nature, e.g., the example of “XEROX” mentioned above) or acquired (i.e., based on the duration and nature of the use of the mark) (*Hai*

*Tong* at [33]). It is not clear whether acquired distinctiveness can be considered at the marks-similarity assessment stage (discussed further below at [55]-[62]).

*Inherent technical distinctiveness*

40 Not surprisingly, the Applicant argues that the Opponent’s Mark is of low inherent technical distinctiveness, whereas the Opponent asserts that it enjoys a high level of inherent technical distinctiveness.

41 The Applicant contends that only the specific bird logo depicted by the Opponent’s Mark is protected.<sup>30</sup> The Applicant notes that 37 marks bearing a bird device were registered in Singapore in Class 42 as at 24 September 2019, which was the date that the NO was filed.<sup>31</sup> As at the date when the ASD was declared (i.e. 19 January 2021), three of these had either been removed or had expired and a further 14 marks bearing a bird device were registered in Class

42.<sup>32</sup> According to the Applicant, one of these bird devices (  ) is more similar to the Opponent’s Mark than the Application Mark.<sup>33</sup>

42 The Applicant also asserts that four of these bird devices have been used on the websites of the respective proprietors of these marks, including the bird device which the Applicant asserts is more similar to the Opponent’s Mark than the Application Mark.<sup>34</sup>

---

<sup>30</sup> See CS at [5].

<sup>31</sup> See ASD at [49] and Exhibit “LBK-16”.

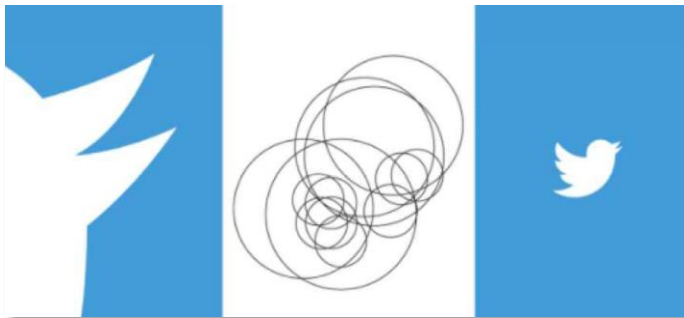
<sup>32</sup> See ASD at [53] and Exhibit “LBK-19”.

<sup>33</sup> See AWS at [35]. See also ASD at [50] and Exhibit “LBK-17”.

<sup>34</sup> See ASD at [52] and Exhibit “LBK-18”.

43 In contrast, the Opponent asserts that the Opponent's Mark enjoys high inherent technical distinctiveness as it is arbitrary and meaningless in relation to the goods and services claimed under the mark.<sup>35</sup>

44 The Opponent further submits that the inherent distinctiveness of the Opponent's Mark is reinforced by its fanciful and inventive depiction of a bird. According to the Opponent, this depiction is based on complex geometry, namely 13 overlapping circles, whereby every part of the bird device can be defined with the portions of circular arcs of differing sizes:



---

<sup>35</sup> See OWS at [17].

The Opponent contends that this accentuates the inherent ability of the Opponent’s Mark to function as a badge of origin.<sup>36</sup>

45 At the same time, the Opponent asserts categorically that it “*is not claiming rights over all bird marks*” and only seeks to assert its rights against bird marks which mimic the same rounded, curvilinear features and design language of the Opponent’s Mark and are registered in respect of similar or identical goods and services.<sup>37</sup>

46 With regard to the other bird device marks highlighted by the Applicant which are registered or applied for in Singapore, the Opponent argues that the state of the register is generally irrelevant in the assessment of distinctiveness, citing *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S v BenQ Materials Corp.* [2018] SGIPOS 2 (“*Clarins*”) at [31] and *Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2020] SGIPOS 3 at [29].<sup>38</sup>

47 The Opponent further notes that the evidence of use adduced by the Applicant relates to only four marks, and comprises piecemeal, undated extracts of the websites of their respective proprietors.<sup>39</sup>

48 In any event, the Opponent asserts that these are “*vastly different in concept, shape, and design*” from the Opponent’s Mark.<sup>40</sup> As examples, the

---




<sup>36</sup> See OWS at [18]. The picture is taken from an article entitled “*How Twitter’s Bird Evolved to Become One of the Most Recognizable Logos Today*” published on Adweek dated 1 May 2017 (Exhibit OSD-3 of OSD, at p. 33).

<sup>37</sup> See OSDR at [23] and OWS-3 at [52].

<sup>38</sup> See OWS at [22]-[24]. See also OWS at [27].

<sup>39</sup> See OWS at [25].

<sup>40</sup> See OSDR at [24].

Opponent lists , ,  and .<sup>41</sup> Specifically, the Opponent stresses that none of the 37 cited marks feature a rounded, curvilinear bird in flight like the Opponent's Mark.<sup>42</sup>

49 To determine the inherent technical distinctiveness of the Opponent's Mark, it is first necessary to decide on what exactly we are assessing - is it the specific "bird" device for which registration has been obtained or any "bird" device? Since trade mark registration confers protection on a mark as registered, I am of the view that it must be the specific "bird" device represented by the Opponent's Mark that we consider.

50 It is also important to determine the relevance of the state of the register. In this regard, I note that *Clarins* (which is one of the cases relied on by the Opponent) cites *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 at 305 in support of the proposition that the state of the register is generally irrelevant in the assessment of distinctiveness. It is helpful to consider the relevant quote in context and in full<sup>43</sup>:

"On the question of factual distinctiveness I must also have regard to how the mark is used -- how it appears on the label. I think it is fairly ambiguous. What the customer sees is "Silver Spoon Treat". The suggestion is that the syrup from "Silver Spoon" will be a "treat". Other customers may accept the word as having a trade mark meaning in context. I take the latter possibility into account in my conclusion.

**"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would**

<sup>41</sup> See OWS at [27], footnote 26.

<sup>42</sup> See OWS-3 at [53].

<sup>43</sup> And indeed, *Clarins* does so.

**like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register.** It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg MADAME Trade Mark ([1996] RPC 541) and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

(emphasis added)

51 I agree with the Opponent that the state of the register does not shed light on the realities of the marketplace, and to that extent does not assist in the distinctiveness assessment. At the same time, in my view, the state of the register in this case does suggest that I should be wary about inadvertently conferring on the Opponent a monopoly to a bird device *per se*. I therefore reject the Opponent’s argument at [43] above that the Opponent’s Mark enjoys high inherent technical distinctiveness on the basis that a bird device is arbitrary and meaningless in relation to the goods and services claimed under the mark.

52 The Opponent also argues (at [44] above) that even if the state of the register is taken into account, the Opponent’s Mark still enjoys a high level of technical distinctiveness as its specific depiction of a bird is very different from the other bird devices on the register. The problem with this argument is that it tends towards extending protection to all (or a significant proportion of) bird devices. As mentioned at [38] above, a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (*Staywell* at [25]).

53 Indeed, the Opponent is clearly concerned about overplaying its hand. As noted at [45] above, it “*is not claiming rights over all bird marks.*” If it were,

that would be an extensive monopoly indeed, given the broad range of goods and services covered by the Opponent’s Mark (see [4] above).

54 Taking into account the parties’ respective arguments and the evidence before me, I am of the view that the Opponent’s Mark enjoys a normal level of inherent technical distinctiveness. Of course, this does not mean that the Opponent’s protection is limited to the specific “bird” device for which registration has been obtained, since protection extends to “similar” marks.

*Acquired technical distinctiveness (and whether it can be considered at the marks-similarity stage)*

55 On the issue of acquired technical distinctiveness, as alluded to at [39] above, it is not clear whether acquired distinctiveness can be considered at the marks-similarity assessment stage. The uncertainty arises from two apparently contradictory propositions of the Court of Appeal in *Staywell*. On the one hand, the Court of Appeal makes clear that the assessment of marks-similarity is “mark-for-mark without consideration of any external matter” (*Staywell* at [20]). On the other hand, technical distinctiveness “*is an integral factor in the marks-similarity inquiry*” (*Staywell* at [25]). In the case of technical distinctiveness acquired through use, how can this be established without reference to “external matter”?

56 Hearing officers at IPOS are not bound by each other’s decisions, and IPOS has issued decisions which diverge sharply in respect of this issue:

- (a) Acquired distinctiveness cannot be taken into account at the marks-similarity stage: *Clarins* at [25] (Principle Assistant Registrar Gabriel Ong); *Valentino S.p.A. v Matsuda & Co* [2020] SGIPOS 8 at footnote 1 (IP Adjudicator David Llewelyn); *Damiani International BV*

*v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [24] (IP Adjudicator Jason Chan); *GCIH Trademarks Limited v Hardwood Private Limited* [2021] SGIPOS 6 at [112] (Principle Assistant Registrar Gabriel Ong); *Louis Vuitton Malletier v Human Horizons Holding (Shanghai) Co., Ltd.* [2021] SGIPOS 13 at [31] (IP Adjudicator Adrian Tan); *Off-White LLC v S.C. Johnson & Son, Inc* [2021] SGIPOS 16 at [34] (IP Adjudicator David Llewelyn);

(b) Acquired distinctiveness can be taken into account at the mark-similarity stage: *Monster Energy Company v NBA Properties, Inc.* [2018] SGIPOS 16 at [41]–[48] (IP Adjudicator Burton Ong); *Swatch AG v Apple Inc.* [2019] SGIPOS 1 (Principal Assistant Registrar Sandy Widjaja); *Combe International Ltd. v Dr. August Wolff GmbH & Co. KG Arzneimittel* [2021] SGIPOS 10 at [30] (IP Adjudicator Sheik Umar Bin Mohamed Bagushair).

57 The High Court has not considered this issue explicitly so far. The Opponent points out that in the recent decision of *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165 (“*Teraoka*”), the High Court did take acquired distinctiveness into account at the marks-similarity stage. However, as noted by the Applicant, it appears that arguments on the propriety of doing so were never raised in that case, and hence was never in issue.<sup>44</sup> On the other hand, the issue was considered in *Polo* at [28], where the High Court opined that “*the effect of acquired distinctiveness should be left for the confusion stage of the inquiry.*” Nevertheless, the High Court went on to consider acquired distinctiveness at the marks-similarity stage as this approach was not challenged by the parties in that case. (*Polo* at [29])

---

<sup>44</sup> See AWS-2 at [10].

58 It is not necessary for me to take into account the acquired distinctiveness of the Opponent's Mark at this stage in order to find that the Application Mark is similar to the Opponent's Mark (see [63]-[105] below). I therefore decline to wade into the controversy.

59 I would, however, highlight two aspects which arise in this case, and which may be relevant in deciding how the issue should be decided.

60 First, as noted above, a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (*Staywell* at [25]). However, if acquired distinctiveness is only taken into account at the likelihood of confusion stage, the reputation of the Opponent's Mark may often make it less likely that consumers will be confused (discussed at [123]-[134] below).



61 Secondly, and conversely, there is overwhelming evidence that the Opponent's Mark has acquired distinctiveness in respect of microblogging and social networking services, but scant (if any) evidence of acquired distinctiveness in relation to the myriad other goods and services for which the Opponent's Mark is registered (see [4] above). Assuming that acquired distinctiveness can be taken into account at the marks-similarity stage, what would be the effect if the opposed mark is applied for in respect of goods or services for which the Opponent's Mark has not acquired distinctiveness?

62 The issue of whether acquired distinctiveness can be considered at the marks-similarity assessment stage frequently arises in IPOS cases. It is hoped that the High Court will provide much-needed clarity on the correct approach.

*Comparison between the Application Mark and the Opponent’s Mark*

63 I have found that the Opponent’s Mark possesses a *normal* degree of distinctiveness. I now proceed to compare the Application Mark with the Opponent’s Mark.

64 It is trite that the relevant marks should not be compared side-by side as it is assumed that the average consumer has “imperfect recollection” and views each mark separated in time and space. However, for ease of comparison, I reproduce the parties’ respective marks below. Further, I have reproduced the Opponent’s Mark in a similar shade of yellow as the Application Mark as it is not disputed that registration in black and white confers protection in all colours (*Fox Head, Inc. v Fox Street Wear Pte Ltd* [2018] SGIPOS 8 at [56] and *Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited* [2018] SGIPOS 5 at [59]).

Application Mark	Opponent’s Mark
	

65 As mentioned at [32(a)] above, there are three aspects of the marks-similarity evaluation, namely, visual, aural and conceptual similarities. There is no requirement that all three similarities need to be made out before the marks or signs being compared may be found to be similar. Trade-offs can be made between the three aspects of similarity. Ultimately, the question is whether the marks are similar or dissimilar overall. (*Hai Tong* at [40])

66 The parties agree that visual similarity will usually be the most important factor in the assessment of similarity in opposition proceedings concerning device-only marks (*MediaCorp* at [32]). However, they differ on the significance (if any) of aural and conceptual similarity.

67 I will proceed to examine visual, aural and conceptual similarity separately below. In my discussion of aural and conceptual similarity, I will also discuss the relevance (if any) of these aspects of similarity.

*Visual similarity*

68 The Opponent dismisses some of the alleged differences highlighted by the Applicant as “*pedantic stylistic dissimilarities*” which the average consumer in his/her imperfect recollection would not recall (*e.g.*, whether one mark has a larger or smaller head, whether one mark has more sharply pointed wings).<sup>45</sup> I agree with the Opponent. But by the same token, the average consumer would also not recall some of the alleged similarities between the competing marks mentioned by the Opponent, for example, that both marks depict a bird in flapping flight (as opposed to gliding flight).<sup>46</sup>

69 Case law is clear that in assessing visual similarity of the competing marks, what is relevant is the *general impression* that will likely be left by the essential or dominant features of the marks on the average consumer (*Hai Tong* at [40]).

70 According to the Applicant, the distinctive character of the Application Mark lies in the slender and angular depiction of a hummingbird. Its thin, V-

---

<sup>45</sup> See OWS-2 at [7]. See also OWS at [32]-[41] for an elaboration of this argument.

<sup>46</sup> See OWS at [30] (see also NO at [6] and OSD at [40(a)]).

shaped body and sharply pointed wings depicting “V V” (the Applicant’s initials) will stand out in the consumer’s visual recollection. On the other hand, the distinctive character of the Opponent’s Mark arises from the rounded and continuous curve from the bottom of the beak to the end of its tail feathers, thus constituting a more impressionistic depiction of “*a mountain bluebird with a dash of hummingbird thrown in*”.<sup>47</sup>

71 According to the Applicant, the general effect of these differences is that the Application Mark reflects a more realistic depiction of the underlying object which the device is modelled after, i.e. a hummingbird, as compared to the Opponent’s Mark which adopts a more impressionistic representation of a mountain bluebird, which is the Opponent’s “mascot”.<sup>48</sup>

72 The Opponent disputes that the average consumer would associate the Application Mark with a hummingbird.<sup>49</sup> In any event, the Opponent points out that it has been observed in articles, including a New York Times article (entitled “Who Made That Twitter Bird”) dated 8 August 2014, that the Opponent’s Mark is visibly influenced by the shape of a hummingbird.<sup>50</sup>

73 The Opponent argues that the assessment of marks-similarity for animal device marks ought to be conducted at a higher level of abstraction: so long as there is coincidence based on the *overall impression* of the animal marks, as defined by the *general* shape, movement, features, and composition of the

---

<sup>47</sup> See AWS at [41]-[42]. The description of the Opponent’s Mark as “*a mountain bluebird with a dash of hummingbird thrown in*” is extracted by the Applicant from an article reproduced in OSDR at page 129.

<sup>48</sup> See ASD at [56].

<sup>49</sup> See OWS at [43]-[45].

<sup>50</sup> See OSDR at [26(b)] and Exhibit OSD-27 (at page 129).

animal, precise differences in those elements should not negate a finding of marks-similarity. This is consistent with the trite position in trade mark law that marks-similarity must be assessed based on the average consumer's *imperfect* recollection, rather than on a side-by-side comparison, as the average consumer neither has the opportunity to scrutinize the marks in detail nor the ability to recall those marks in their entirety.<sup>51</sup>

74 In this regard, the Opponent asserts that:

- (a) The general shape of both parties' marks is of a two-dimensional, side profile of a bird with curvilinear features, swept back wing opening out and up behind the bird's head, a pointed tail curved outward, as well as a pointed beak.
- (b) The general movement of both birds, as claimed and undisputed by the parties, is a bird in flight.
- (c) The general features of both birds are abstract, heavily stylized, and devoid of perceptible details or design elements that would render either mark depicting a realistic portrait of a bird.
- (d) The general composition of both marks is again composed of identical elements, namely the side profile of a rounded, abstract bird with no other distinctive elements (indeed here, no other elements at all).<sup>52</sup>


75 The Opponent relies on three cases from the European Union. In relying on these cases, the Opponent highlights that while these cases apply the "global

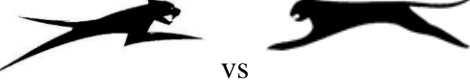
---


<sup>51</sup> See OWS-2 at [4].

<sup>52</sup> See OWS-2 at [6].

appreciation test” applicable in Europe, as opposed to the three-step test in *Staywell*, in none of these cases did the decision maker refer to external matters specifically when comparing the marks for similarity. The Opponent therefore submits that these cases accord with *Staywell*’s position that external matters cannot be considered at the mark comparison stage:<sup>53</sup>

(a) In *Puma SE* (  vs (among other prior marks)), the EUIPO First Board of Appeal held that, despite minor differences in design, the competing marks had an average degree of visual similarity, as they conveyed an overall visual impression of a black leaping animal resembling a feline.

(b) In *Arctic Cat* (  vs ), the EU General Court found that the competing marks were similar as the overall impression of both marks was dominated “by the black silhouette of a member of the cat family represented in profile, conveying an impression of movement, characterised by the position of the fore- and hind legs extending from the central part of the body and not supporting it”.

(c) In *Slazengers* (  vs ), the EUIPO Opposition Division found that the average consumer would remember predominantly the overall visual impression of a “leaping feline portrayed in a lateral perspective.”

---

<sup>53</sup> See OWS-2 at [5].

76 As observed in several cases, the assessment of mark similarity is often more a question of feel than science. The cases listed at [34] above illustrate how subjective this exercise can be.

77 Indeed, *Puma SE* (one of the three cases relied on principally by the Opponent) is a good example of this subjectivity. In that case, the opposition was initially rejected by the Opposition Division, whose decision was upheld by the Fifth Board of Appeal. Subsequently, the decision was annulled by the General Court on the ground, among other things, that the test for visual similarity had been misapplied. The case was remitted to the First Board of Appeal, which allowed the opposition. It is instructive to briefly look at the reasons given by the Tribunals and General Court (as summarised in *Puma SE*) for their respective findings on the issue of visual similarity:

(a) Opposition Division - The marks “*do not visually coincide in any element*” and are therefore dissimilar. The applicant’s mark represents “*two or more animals merged into one*” and that animal is, in fact, an “*unidentifiable creature*” since it has the tail of a whale, the nose of a dolphin, legs and horns on the head whereas the earlier mark is readily identifiable as a puma. (*Puma SE* at [5])

(b) Fifth Board of Appeal - From a visual point of view, the signs “*do not coincide in any element*” since: (i) they represent different animals, (ii) the animals leap in different directions, and (iii) the animal’s silhouette in the later mark is thicker than in the earlier mark. As a result, the marks are visually dissimilar. (*Puma SE* at [8])

(c) General Court - The conflicting marks do present similarities since they represent black-coloured images of animals in a similar leaping position, with their rear feet on the ground, their front feet under

their mouths, their tails lifted at a similar angle and the curve made by their backs and bellies being undeniably similar. (*Puma SE* at [10])

(d) First Board of Appeal – The visual similarities are that both marks: (i) represent a black animal on a white background, (ii) are not represented in detail but by means of their outlines, (iii) are presented from a lateral perspective, (iv) are shown in identical leaping positions, (v) have similar aspects for their back and belly, and (vi) are broadly shaped as a feline. The First Board of Appeal also identified dissimilarities such as: (i) the applicant’s mark is less realistic than the opponent’s mark, (ii) the representation of the tail, which is double-ended in the applicant’s mark, (iii) the longer ears in the applicant’s mark, (iv) the representation in the applicant’s mark of two pairs of front and rear legs (created by a white shadowy effect between each pair of legs), and (v) the direction of the leap. The similar elements largely outweigh the dissimilar elements, and the average consumer will retain the overall impression of a black leaping animal representing a feline for both marks. (*Puma SE* at [31]-[33])

78 As alluded to at [76] above, the assessment of marks-similarity is more a question of feel than science. However, in order to approach this issue in a systematic manner, the broad parameters suggested by the Opponent – namely, the general shape, movement, features and composition of the animals depicted in the competing marks – are useful guidelines. This process assists in reaching a more objective determination as to whether the marks are more similar or dissimilar overall.

79 On balance, I am of the view that the marks are visually similar overall, albeit only to a low extent. I reach this conclusion for the following reasons: (i)



both marks depict a bird in flight; (ii) both depict a side profile; (iii) both appear to depict a relatively small bird (as opposed to, say, an ostrich, a penguin or an eagle), and (iv) neither mark depicts features such as eyes.

80 I am also of the view that neither mark corresponds to an identifiable species of bird. In this regard, I disagree with the Applicant that the Application Mark depicts a humming bird; while some consumers may perhaps think the Application Mark is allusive of a humming bird, a substantial proportion of consumers would not.

81 It is also unclear to me how the Application Mark depicts the Applicant’s initials “V V”, as alleged by the Applicant.

82 I acknowledge that some may be discomfited by a finding of visual similarity in the present case. I postulate that one reason why consumers might find the Application Mark dissimilar to the Opponent’s Mark is that they are in fact familiar with the Opponent’s Mark, which moreover is normally represented in blue. Their recollection of the Opponent’s Mark may therefore be more than “imperfect”. The reputation of a mark (obtained through its acquired distinctiveness) should, however, not be a factor pointing away from marks-similarity. Assuming it can be taken into account at this stage, acquired distinctiveness is supposed to confer greater protection on a mark (see [38] above) and not make a finding of marks-similarity less likely.

83 In any event, I note that marks-similarity is only the first “gate” which an opponent must pass through to succeed in an opposition. The opponent still needs to establish identity/similarity of services, and that there is a likelihood of confusion. In *MediaCorp* (at [34], [35] and [50]), for example, the High Court found that there was some degree of visual similarity between the two marks in

question (  and  ), but ultimately found that there was no likelihood of confusion on the part of consumers.

#### *Aural similarity*

84 According to the Opponent, the marks are aurally identical. In the event a consumer wishes to refer to either the Application Mark or the Opponent's Mark aurally, it is likely that he/she will refer to each mark as "the bird mark" or "the bird logo". For example, in *Ng Wee Ping* at [29], it was found that the competing marks would both be verbalised by consumers as "*teddy bear*".<sup>54</sup>

85 However, there is a threshold question of whether aural similarity is of any relevance in the first place when comparing two device marks.

86 The High Court in *Polo* at [22] noted that "[t]o find aural similarity where no aural component exists seems to allow for visual or conceptual similarity to be accounted for within the assessment of aural similarity."

87 In *Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd* [2016] SGIPOS 6 at [112], the Principal Assistant Registrar was of the view that no aural comparison can be made between two device-only marks as these contain no aural component. Therefore, an aural comparison between the competing marks results in a neutral conclusion as regards substantive similarity.


---

<sup>54</sup> See OWS at [46]-[48].

88 I am of the view that aural similarity is at best of marginal relevance (if at all) when comparing two device-only marks. I say this for several reasons.

89 First, and most importantly, device-only marks by definition contain no aural component.

90 Secondly, in the real world, almost all device marks will be used in conjunction with a word mark. In such cases, the device mark will normally be referred to by the word mark that is used alongside it, and not by a word describing the device. Perhaps for this reason, in *MediaCorp* at [36], for the

purposes of an aural comparison, the High Court referred to  as “Channel NewsAsia” although these words do not actually form part of the mark.

91 Thirdly, where a device mark appears on its own, this is usually because the device mark is well-known to the public (e.g. McDonald’s “golden arches” or Nike’s “swoosh”). Here again, the device mark will generally be referred to by the word mark/brand with which the device is associated (e.g. “McDonald’s” instead of the “M” mark; or “Nike” instead of the “tick” or “swoosh” mark).

92 Fourthly, in present times where smart phones are ubiquitous, it is hard to imagine a situation where a device mark would be referred to using a verbal description. For example, it is unlikely that a person would ask someone to purchase a backpack (which is one of the goods of interest in *Ng Wee Ping* (see [1] of the grounds of decision)) with the “teddy bear” logo. It is more likely that he/she would show the other person a picture of the relevant “teddy bear” logo to avert the risk that the wrong product is purchased.

93 For these reasons, I am of the view that aural similarity is not relevant to the marks-similarity inquiry in the present case. However, I would hesitate before suggesting a categorical rule that aural similarity is never relevant when comparing two device marks. There may perhaps be situations not within my contemplation where aural similarity is of some relevance.

*Conceptual similarity*

94 Conceptual similarity is directed at the ideas that lie behind or inform the marks or sign in question (*Hai Tong* at [70]). These ideas must manifest in the look and feel of the mark, and not in something that is known only to the creator of the mark (*Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2015] 3 SLR 321 at [43]).

95 According to the Opponent, both marks are minimally evocative of an abstract bird or a flying bird, which is sufficient to render the marks conceptually similar.<sup>55</sup>

96 The Opponent further argues that animal device marks, in particular, embody a clear and recognizable concept in the minds of consumers. Consequently, the shared concept of the animal may dominate the average consumer's overall impression of the mark, thereby neutralizing the effect of any visual or aural differences between them.<sup>56</sup>

97 The Opponent relies on a number of cases from New Zealand - *Glenn Elliott, Red Bull IPONZ* and *Red Bull HCNZ* (see [34(06)] and [34(08)] above for depictions of the competing marks in these cases) - in support of the

---

<sup>55</sup> See OWS at [55].

<sup>56</sup> See OWS-2 at [9]-[12].

proposition that marks determined to be visually dissimilar may nonetheless be found to be similar overall as a result of their conceptual identity.<sup>57</sup>

98 The Applicant argued that the New Zealand cases conduct the analysis at too high a level of abstraction. Such an approach would result in the Opponent being conferred a monopoly over all bird devices.<sup>58</sup>

99 In *MediaCorp* at [39], the High Court was of the view that the competing marks were conceptually similar, but the learned judge caveated that he did “*not think that such conceptual similarity in the present case was a strong factor in the overall analysis of whether the two marks were similar.*”

100 The Opponent attempted to distinguish *MediaCorp* on the facts. According to the Opponent, it is understandable why visual similarity would assume greater importance in *MediaCorp* since the concept of an incomplete triangle or A-frame would not be particularly recognizable or distinctive and, hence, would not leave a memorable or lasting impression in the average consumer’s imperfect recollection. In the present case, however, the marks depict animals (birds), and thus convey a highly recognizable and distinctive concept which is easily crystallized in the average consumer’s imperfect recollection. For such marks, their concepts are likely to dominate the average consumer’s overall impression of the marks. Their conceptual similarity or identity will therefore assist in offsetting any visual differences arising from their specific features, especially when those marks visually share the same general shape and form.<sup>59</sup>

---

<sup>57</sup> See OWS-2 at [13]-[18].

<sup>58</sup> See AWS at [52] and AWS-2 at [20].

<sup>59</sup> See OWS-3 at [15]-[16].

101 I agree with the Opponent that the competing marks are conceptually similar (if not identical). Both marks convey the concept of a “bird in flight”. Further, as discussed at [80] above in the context of visual similarity, most consumers would not be able to identify either mark with a specific species of bird.

102 The key issue is the degree of relevance of conceptual similarity in the overall analysis of marks-similarity. As I have found that the Application Mark and the Opponent’s Mark are visually similar, albeit to a low degree (see [68]-[83] above), it is not necessary for me to analyse the New Zealand cases cited by the Opponent in detail. I will therefore just set out my observations on this issue briefly.

103 To give primacy to conceptual similarity would be tantamount to conferring very broad protection to the Opponent (in this case, to any device of a bird in flight). Thus, I am unable to agree with the Opponent that conceptual similarity or identity can offset visual dissimilarity. In other words, visual similarity would still be of greater importance than conceptual similarity in the overall assessment of marks-similarity.

104 At the same time, I agree with the Opponent that conceptual similarity would be of more than marginal relevance when the competing devices depict highly recognizable and distinctive concepts (such as animals or birds, which are arbitrary and meaningless in relation to the goods or services of interest). This is in contrast to cases where the devices in question depict simple concepts, such as an incomplete triangle or A-frame in *MediaCorp*, the letter “W” in *W Device* (see [34(09)] above for depictions of the competing marks), or a wireless signal in *GSMA* (see [34(10)] above for depictions of the competing marks).

*Conclusion on marks-similarity assessment*

105 I have found that the Opponent’s Mark is of an average level of distinctiveness. I have also found that the competing marks are marginally visually similar, aurally identical and conceptually identical. Even if aural similarity is to be disregarded when comparing two device marks, and conceptual similarity is of little relevance, it must still follow that the marks are similar overall.

*Similarity of Services*

106 I move on to the second “gate” which the Opponent must pass through, namely, that the services of the competing marks are identical or similar.

107 The Applicant submits that the parties’ respective goods and services have broadly different uses in practice notwithstanding that some of the services are identical / similar to some extent.<sup>60</sup> However, the proper comparison is not between the services for which the competing marks are actually used or intended to be used. Instead, the services to be compared are the services for which the Application Mark is applied for, and the services for which the Opponent’s Mark is registered. (*Staywell* at [40])

108 According to the Opponent, there are clear examples of similar specifications in the parties’ respective services of interest:

Application Mark’s Class 42 Services		Opponent’s Mark’s Goods and Services
1.	<i>Information services relating to information technology; providing</i>	Class 35: <ul style="list-style-type: none"> <li>• business consulting and <i>information services</i>;</li> <li>• <i>providing consumer product information and reviews via a website</i></li> </ul>

<sup>60</sup> See AWS at [65].

Application Mark's Class 42 Services	Opponent's Mark's Goods and Services
<p><i>information on computer technology and programming via a web site; provision of information relating to computer programming.</i></p>	<p>Class 41:</p> <ul style="list-style-type: none"> <li>• Online publication of journals or diaries (blog services), namely, blogs featuring personal information and opinions in the field of general interest;</li> <li>• <i>providing real-time information relating to the latest stories, ideas, opinions, news and to information of personal interest, all being in the fields of entertainment, sports, fashion, education, hobbies, recreation, training, celebrity, culture, current events (relating to the aforesaid fields) and blogging via the internet and other communications networks;</i></li> <li>• <i>providing information related to the latest stories, ideas, opinions, news and to information of personal interest via a website, all information being in the fields of entertainment, sports, fashion, education, hobbies, recreation, training, celebrity, culture and blogging;</i></li> <li>• <i>providing information relating to a wide variety of topics, namely in the fields of news, entertainment, sports, fashion, education, hobbies, recreation, training, celebrity, culture, and current events (relating to the aforesaid fields)</i></li> </ul> <p>Class 42:</p> <ul style="list-style-type: none"> <li>• hosting an interactive website and online non-downloadable software for real-time delivery of data, messages, location, photographs, links, text, audio, video and other data</li> <li>• hosting a platform for mobile device communications;</li> <li>• hosting online web facilities for others for conducting interactive discussions;</li> <li>• computer services, namely, hosting a platform featuring technology that enables internet users to post, upload, view, and share data, information and multimedia content;</li> <li>• computer services, namely, hosting an online community web platform for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services</li> <li>• hosting a website that allows users to review text, audio and video material and provide commentary</li> </ul>

Application Mark's Class 42 Services		Opponent's Mark's Goods and Services
		<ul style="list-style-type: none"> <li>computer services, namely, hosting an online community web platform for users to participate in discussions and engage in social networking</li> </ul>
2.	<i>Monitoring of computer systems by remote access</i>	Class 42: <ul style="list-style-type: none"> <li>Computer security services in the form of authentication and verification of identity of users, and <i>monitoring computer systems for security purposes.</i></li> </ul>
3.	Maintenance of computer software relating to computer security and prevention of computer risks; maintenance of software for internet access; preparation of reports relating to computer programs	Class 9: <ul style="list-style-type: none"> <li>computer software</li> </ul> Class 42: <ul style="list-style-type: none"> <li>Design and development of computer hardware and software;</li> <li>Scientific and technological services and research and design relating thereto;</li> <li>Computer security services in the form of authentication and verification of identity of users, and monitoring computer systems for security purposes.</li> </ul>

(Services highlighted in *italics* are examples provided by the Opponent of what it says are clear overlaps.)<sup>61</sup>

109 While it is certainly possible to quibble with the Opponent over some of the services which it has identified as being similar, I agree with the Opponent that there is clearly some overlap in these services. At the very least, some of the services are evidently very similar. Indeed, the Applicant does not dispute that some of the services are identical / similar to some extent.<sup>62</sup>

<sup>61</sup> Extracted from OWS at [58]. For the Opponent's submissions on this issue, see OWS at [56]-[67].

<sup>62</sup> As noted at [107] above, the Applicant's contention is that the parties' respective goods and services have broadly different uses in practice.

110 Accordingly, this requirement is met by the Opponent.

***Likelihood of confusion***

111 The final “gate” which the Opponent must pass through is that there exists a likelihood of confusion arising from the similarities in marks and in services.

112 The likelihood of confusion is not confined to consumers mistaking the Application Mark for the Opponent’s Mark. It can also be established by showing that consumers may perceive an economic link between the two marks. The Opponent’s submit that this could arise in two ways: (1) that the Application Mark is a new iteration of the Opponent’s Mark; and/or (2) that the Application Mark is a modified mark that the Opponent is using for new closely-related digital services which are extensions of the Opponent’s existing range of services.<sup>63</sup>

113 The legal position is well-established. The issue of likelihood of confusion directs the tribunal to consider: (1) how similar the marks are; (2) how similar the goods/services are; and (c) given the similarities, how likely the relevant public will be confused (*Staywell* at [55]). To this end, the following non-exhaustive list of extraneous factors may be considered (*Staywell* at [96]):

- (a) **Factors relating to impact of marks-similarity on consumer perception**, such as (1) the degree of similarity of the marks themselves; (2) the reputation of the marks; (3) the impression given by the marks; and (4) the possibility of imperfect recollection of the marks.

---

<sup>63</sup> See OWS at [8].

(b) **Factors relating to impact of services-similarity on consumer perception**, such as (1) the normal way in or the circumstances under which consumers would purchase the services of that type; (2) whether the services in question are expensive or inexpensive items; (3) the nature of the services, and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective consumers; and (4) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

114 The parties do not dispute these broad propositions of law. Their main areas of disagreement are in relation to: (a) the characteristics of the average consumer of the services in question; and (b) the effect of the reputation of the Opponent’s Mark on the likelihood of confusion. I will discuss these issues before coming back to the central question of whether there is a likelihood of confusion in this case.

*The characteristics of the average consumer of the relevant services*

115 This is an important issue. If the average consumer of the relevant services is a specialist who is not easily hoodwinked, or someone who is likely to pay greater attention before procuring the services, it is less likely that such a consumer would be confused. For example, in *MediaCorp* at [50], the High Court found that “*the average consumer(s) is not the general population at large, but are commercial enterprises seeking publicity services and/or business organisation services.*” Thus, even though the court found that the marks and services in that case were similar, the court was of the view that “*there is no real likelihood that these average consumers will be confused.*”

116 In the present case, the Application Mark is applied for in respect of “Information services relating to information technology; Maintenance of computer software relating to computer security and prevention of computer risks; Maintenance of software for internet access; Monitoring of computer systems by remote access; Preparation of reports relating to computer programs; Providing Information on Computer technology and programming via a web site; Provision of information relating to computer programming.”

117 According to the Applicant, the relevant segment of the public are general members of the public who use mobile applications. These “*users of either or both of the parties’ mobile applications will clearly be technologically literate, and indeed may be fairly described as ‘digital natives’.* This is especially the case for users in Singapore, which are known to be literate, educated, exposed to the world and unlikely to be easily deceived or hoodwinked.”<sup>64</sup>

118 The Opponent has two prongs to its argument. First, the Opponent notes that the competing specifications cover a wide range of IT and computer software-related services. Consequently, they cover a broad price range. In these circumstances, the Opponent submits that the relevant public likely comprises both specialist consumers and the general purchasing public. While specialist consumers are likely to make purchase decisions carefully, the general public is unlikely to pay much attention and care in the purchasing process, especially where the services in question are unsophisticated and inexpensive. For example, information services are likely to be provided at low or, indeed, no cost. Where such services are concerned, the relevant public is likely to pay a low or below-average degree of attention during the purchasing process and is

---

<sup>64</sup> See ASD at [89] and AWS at [74] and [87].

thus more likely to be confused. In support of its submissions, the Opponent relies on *Teraoka* at [185]-[186], where the High Court affirmed that computer and IT-related goods and services may, notionally, involve “*high-end and complex technology at one end of the spectrum and low-end and simple technology on the other*” and that the simpler and less expensive products would be “*more likely to be purchased by individuals who would generally have less specialised needs and knowledge and who would pay less attention in this distinction when selecting the products for purchase.*”<sup>65</sup>

119 Secondly, the Opponent argues that the claimed IT and software-related products and services are first and foremost purchased for their functions and capabilities to deliver a particular desired outcome. Accordingly, consumers are likely to focus predominantly on the *functional* attributes of the goods/services (*i.e.*, their presentation, ease of use and implementation, scalability, compatibility and reliability), rather than the particular trade marks used. Where consumers pay less attention or are indifferent to the marks, this supports a finding of consumer confusion: minor differences between the competing marks would likely go unnoticed in the average consumer’s imperfect recollection.<sup>66</sup> (*Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 at [79] and [81])

120 Both parties agree that the average consumer would include general members of the public. I am unable to agree with the Applicant that members of the public who use mobile applications are “digital natives”. While some may undoubtedly be more tech savvy, a substantial proportion would not. Indeed,

---

<sup>65</sup> See OWS at [74]-[78]. The IT-related goods and services in *Teraoka* are not the same as in the present case, but the sentiments expressed by the High Court still apply.

<sup>66</sup> See OWS at [79]-[85].

tech companies continually make their services more user-friendly, such that non-technically inclined members of the public would still be able to navigate these services easily.

121 I agree with the Opponent that some of the services of interest such as information services are likely to be provided at low or no cost. I also agree with the Opponent that it is probable that the average consumer is likely to pay a low or below-average degree of attention when procuring such services. To take the Applicant's example of mobile applications, there is no compelling reason why a member of the public would pay an enhanced level of attention before installing a mobile application which is available at no cost. If the wrong mobile application is installed, it is easy enough to delete it and install the correct one.

122 I am unable to agree with the Opponent's second argument that the claimed IT and software related products and services are purchased for their functional attributes, rather than the particular trade marks used. Taking the example of information services again, it would seem to me that the source of such information would be of importance to the average consumer of such services. However, this does not detract from my overall assessment that the average consumer of the relevant services is likely to pay a low or below-average degree of attention when procuring such services.

*Effect of Opponent's reputation in its mark*

123 There is no dispute that the Opponent's Mark enjoys considerable renown in respect of micro-blogging and social networking services.

124 The parties also agree that the exact effect which the reputation of a mark has as regards the likelihood of confusion inquiry is a fact specific inquiry

(*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [125]). The parties differ on the effect of such reputation in the present case.


125 According to the Applicant, the strong reputation in Singapore of the Opponent’s Mark militates against any likelihood of confusion between the competing marks because, based on the Opponent’s position, the average consumer would inevitably be exposed to and be familiar with the Opponent’s Mark and would therefore be able to detect the significant differences with the Application Mark at a glance (*McDonald’s Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 (SGCA) at [64] and *Discovery Communications, LLC v A-STAR-Education Discovery Camps Pte. Ltd.* [2020] SGIPOS 4 at [112]).<sup>67</sup>


126 On the other hand, the Opponent submits that the reputation of the Opponent’s Mark is a factor which *increases* the likelihood of confusion; when encountering a bird mark which shares a similar overall impression as the Opponent’s Mark and is used in proximate fields of business which the mark enjoys a reputation in, the average consumer assumes that both marks are the same because he *expects* to see only the Opponent’s Mark being used in relation to those goods and services.<sup>68</sup> In support of this proposition, the Opponent relies on *Kentucky Fried Chicken (Great Britain) Limited v Muhammad Sarmad* (O/227/04) (Appointed Person on appeal from decision of UK IP Office) (“KENNEDY FRIED CHICKEN” found to be similar to “KENTUCKY FRIED CHICKEN”); *Kimberly-Clark Worldwide, Inc. v Multibrands International Ltd*

---

<sup>67</sup> See AWS at [79]-[85].

<sup>68</sup> See OWS-2 at [22].

(BL O/543/16 (UK IP Office) ( found to be similar to “HUGGIES”); and *Johnson And Johnson v Laurence Nash Kalnin and Medical Industries Australia Pty. Limited* [1993] 114 ALR 215 (Federal Court of Australia)

( found to be similar to “BAND AID”).

127 I agree with the Applicant that, in the current case, the reputation in the Opponent’s Mark would tend to reduce the likelihood of confusion between the competing marks. This is not surprising since if consumers are more familiar with a mark, their recollection of that mark would be better than “imperfect” and they will be more astute to differences in another mark.


128 I am unable to accept the Opponent’s argument to the effect that consumers will see what they want to see. Taken on its own, such an approach would make it too easy to establish a likelihood of confusion. The decisions made in the cases cited by the Opponent in support of this proposition are likely due to the precise facts and evidence before the respective tribunals and court in those cases.

129 However, as noted at [112] above, a likelihood of confusion can also be established by showing that consumers may perceive an economic link between the two marks. According to the Opponent, this could arise in two ways: (1) that the Application Mark is a new iteration of the Opponent’s Mark; and/or (2) that the Application Mark is a modified mark that the Opponent is using for new closely-related digital services which are extensions of the Opponent’s existing range of services.

130 I am of the view that the reputation of the Opponent’s Mark increases the likelihood of these types of confusion.

131 With regard to the Opponent's argument that the Application Mark could be perceived by average consumers as a new iteration of the Opponent's Mark, one reason why consumers may think that a different (but similar) bird device is an iteration of the Opponent's Mark is because they associate a bird device with the Opponent in the first place.

132 I note that this is borne out by the evolution of the Opponent's bird logo (see [22]-[23] above). In the short period of time since the Opponent's incorporation, there have been several iterations of the Opponent's bird logo.

Some of these (such as the initial bird logo used by the Opponent (  )) are arguably less similar to the current incarnation (i.e. the Opponent's Mark) than the Application Mark.

133 Although we do not need to consider actual use of a mark in opposition proceedings under Section 8(2)(b) of the Act, this may act as a helpful reality check that putative uses are not fanciful. In any event, it is common for brand logos to be refreshed periodically to keep up with the times.

134 In relation to the second type of economic link postulated by the Opponent – namely, that the Application Mark is a modified mark that the Opponent is using for new closely-related digital services which are extensions of the Opponent's existing range of services – this is also not a fanciful hypothesis, although perhaps less likely than the first scenario.

#### *Overall Assessment of Likelihood of Confusion*

135 I have found that the Application Mark is similar to the Opponent's Mark to a low extent, and that there is an overlap in the services of interest.

136 I have also found that the average consumer of the relevant services would include general members of the public, many of whom would not be particularly tech savvy. Further, some of the services of interest are commonly provided at low or no cost, and the average consumer is likely to pay a low or below-average degree of attention when procuring such services.

137 In relation to the effect of the reputation of the Opponent’s Mark, I am of the view that this would reduce the likelihood that the average consumer would confuse the Application Mark with the Opponent’s Mark. However, I am of the view that consumers are more likely to perceive an economic link between the two marks – either that the Application Mark is a new iteration of the Opponent’s Mark, and/or that the Application Mark is a modified mark that the Opponent is using for new closely-related digital services which are extensions of the Opponent’s existing range of services.

138 Overall, I am satisfied that the Opponent has established a likelihood of confusion between the Application Mark and the Opponent’s Mark.

***Conclusion on opposition under Section 8(2)(b)***

139 As the Opponent has passed through all three “gates” – similarity of marks, identity or similarity of services, and likelihood of confusion arising from these similarities - this ground of opposition therefore succeeds.

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

140 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 —

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

141 The three elements of passing off are (a) goodwill, (b) misrepresentation, and (c) damage to goodwill: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 at [37]; affirmed in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [28].

142 On the issue of goodwill, the Applicant does not dispute that the Opponent has acquired goodwill in its business in Singapore.

143 The Applicant disputes the existence of any misrepresentation. The test for misrepresentation under passing off is substantially the same as that for “likelihood of confusion” under Section 8(2)(b) of the Act (*Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 at [76]-[77]).

144 The key difference is that in a passing off action, the likelihood of deception is to be assessed “*having regard to all the circumstances*”, and is not constrained only to factors which stem from the similarity between the contesting marks and goods/services (*Hai Tong* at [110]). Thus, for example, in the passing off inquiry, it is permissible to consider all the Opponent’s prior bird devices, including those which have not been registered as trade marks in Singapore (see [5] above). However, it is not necessary for me to do so in the present case, as there are no material circumstances which would change my conclusion.

145 I have found that there is a likelihood of confusion under Section 8(2)(b) of the Act. For the same reasons, I find that the Opponent has established the element of misrepresentation under passing off.

146 The element of damage requires proof that the Opponent has suffered or is likely to suffer damage because of the Applicant's misrepresentation. There is a real risk that the Applicant's misrepresentation would divert sales and custom away from the Opponent. Thus, this element is satisfied.

147 The ground of opposition under Section 8(7)(a) therefore succeeds.

### **Overall Conclusion**

148 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds under both Sections 8(2)(b) and 8(7)(a). The Opponent is also entitled to costs to be taxed, if not agreed.

149 It remains for me to thank counsel for both parties for their helpful submissions, both in writing as well as during the oral hearing.

Mark Lim  
Principal Assistant Registrar

Ms Meryl Koh and Mr Roi Tan (Drew & Napier LLC) for the  
Applicant;  
Mr Thng Aaron, Mr Marcus Hoh and Ms Christine Saw (Amica Law  
LLC) for the Opponent.

---