

Google LLC v Green Radar (Singapore) Pte Ltd [2024] SGIPOS 1

Case Number : Trade Mark No. 40202109944T

Decision Date : 08 February 2024

Tribunal/Court : Intellectual Property Office of Singapore

Coram : Cheng Pei Feng

Counsel Name(s) : Jon Chan Wenqiang, Edwin Neo and Maria Xenia Robles Lafiguera (Ravindran Associates LLP – Instructed Counsel) and Juliana Yap (Wilder Law Corporation) for the applicant; Regina Quek, Genevieve Chia and Ang Yu Ann (One Legal LLC) for the opponent.


Parties : Google LLC — Green Radar (Singapore) Pte Ltd



IP Adjudicator Cheng Pei Feng:

Introduction

1 A well-established business that has built up a reputation and name for itself would naturally be protective of its associated marks and fly its banner of opposition against perceived copycats seeking to ride off its coat-tails and take advantage of its renown. When a big name in Big Tech flexes, how far should the protection extend to prevent another in the same industry from using a mark that may bear some similarity to its own?

2 This is an opposition to the following trade mark application:

| Trade Mark No. | Mark (“the Application Mark”) | Class | Specification |
|----------------|---|-------|--|
| 40202109944T |  | 42 | Electronic monitoring services being IT security services in the nature of protection and recovery of computer data. |
| | | 45 | Security services for the protection of property and individuals. |

3 Green Radar (Singapore) Pte. Ltd. (“the Applicant”) applied to register the Application Mark  under Trade Mark No. 40202109944T on 29 April 2021 in Classes 42 and 45. 

4 Google LLC (“the Opponent”) filed its Notice of Opposition to oppose the registration of the Application Mark

on 9 November 2021.

Grounds of opposition

5 The Opponent relies on ss 7(6), 8(2)(b), 8(4) and 8(7)(a) of the Trade Marks Act 1998 (“the Act”) in this opposition.

Opponent’s evidence

6 The Opponent’s evidence comprises the following:

(a) a Statutory Declaration made by Andrew Abrams, Senior Trademark Counsel of the Opponent, on 21 October 2022 in California, the United States of America;

(b) a Statutory Declaration in Reply made by the same Andrew Abrams on 14 March 2023 in California, the United States of America; and

(c) a Statutory Declaration in Reply made by Yvette Kan Yi Suan, Product Marketing Manager, Brand & Reputation, of Google Asia Pacific Pte Ltd, a related corporation to the Opponent, on 19 September 2023 in Singapore.

Applicant’s evidence

7 The Applicant’s evidence comprises a Statutory Declaration made by Yui Ting Raymond Liu, Director of the Applicant, on 9 February 2023 in Hong Kong.

Applicable law and burden of proof

8 There is no overall onus on the Applicant before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Background facts

9 The Applicant is a Singapore incorporated company that is a member of the Edvance International Holdings Limited (“Edvance”) group of companies. Edvance is an investment holding company listed on the Hong Kong Stock Exchange and is principally engaged in the distribution of IT security products and the provision of IT security services^[note: 1].

10 The Applicant’s evidence is that the Application Mark was conceived and created by Edvance in 2018 and the Applicant was established around that time to own and manage the Application Mark in Singapore.

11 At the Applicant’s business website, <https://www.greenradar.com/>, grMail is described as “a next generation cloud-based email security platform with artificial intelligence capability, to discover any unprecedented email threats”. Using a proprietary artificial intelligence engine named “aidar”, grMail provides “comprehensive, multi-layered email security solutions” to defend against “bulk spams, virus, malware, spoofing emails, phishing, CEO fraud and other email-borne threats”^[note: 2].

12 It appears undisputed that the Applicant’s grMail service is not an email service and that the Applicant does not provide any email service, nor does it store any email contents^[note: 3]. Instead, the enterprise email security service offered by the Applicant “sits on top of email service providers” and works with any email service the consumer may utilise and does not replace any of the email functions which may be provided by the

email service provider. Thus, grMail is an additional service providing security solutions for email and it is meant to be used with a separate and distinct email service provider. The user of grMail is notified through a grMail notification of a Quarantine Report setting out the emails received by the user which has been screened by grMail for security threats^[note: 4].

13 The Opponent is a globally established technology company with more than 120 offices in over 52 countries, including Singapore which serves as the hub for its Southeast Asian operations. The Opponent's business has also been listed on the Nasdaq Global Select Market since 2004. The Opponent runs one of the most popular search engines, www.google.com, in the world and is also known for its various other IT products, including video-streaming service YouTube and email service Gmail^[note: 5].

14 The Opponent is the owner of the trade mark registration for "GMAIL" in Class 38 for "telecommunication services; electronic mail services; all included in Class 38" ("the Opponent's Mark", or "the Opponent's GMAIL mark"), which registration since 2005 remains valid and subsisting. Apart from Singapore, the Opponent owns the trade mark registration and applications for "GMAIL" in numerous listed countries^[note: 6].

15 The Gmail email service was launched to the public in April 2004 and has since been well-ranked as an email service provider by various magazine and ranking platforms^[note: 7]. The Gmail email service is offered by the Opponent as part of Google Workspace, which allegedly has over 3 billion users across the world, while the Gmail mobile application used by mobile users has been downloaded over 10 billion times from the Google "Play Store", a digital app distribution service also developed and operated by the Opponent^[note: 8].

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

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

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

...

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

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

Decision on Section 8(2)(b)

17 The "confusing similarity of marks" ground under s 8(2)(b) is a common ground for opposing the registration of a trade mark and the three key elements to be met are well-settled in law and not in dispute. The Opponent is required to show (a) similarity of marks; (b) similarity of goods or services; and (c) likelihood of confusion arising from the two similarities: see Court of Appeal decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 ("*Staywell*") at [15].

Similarity of marks

18 In assessing the marks and making a comparison of similarity, the evaluation considers the visual, aural and conceptual similarities. These are of course not meant to be considered formulaically but rather, act as signposts to determining the similarity between the marks in consideration and it is not a requirement that all three aspects must be made out before a mark can be found to be similar: see *Staywell* at [17] and [18].

19 The Opponent correctly points out in its submissions the further nuances the Court should take into consideration when conducting this analysis. The analysis of the marks should be perceived in the eyes of the average consumer of the good or services in question, who would exercise some care and a measure of good sense in making the purchases, while at the same time would have “imperfect recollection” and makes comparison from memory removed in time and space from the marks: see *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941, at [40] and [62].

20 A further relevant consideration when assessing the similarity of marks is the technical distinctiveness of the marks in question. This has been explained by the Court of Appeal in *Staywell*, at [24] to [25], to refer to the capacity of a mark to function 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. Following the more recent High Court decision in *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293, at [61] and [119], even more specifically, the enquiry at this stage of the *Staywell* test would focus on “inherent technical distinctiveness” as opposed to “acquired technical distinctiveness”.

21 In considering the similarity between the marks, it is useful to set out the marks in question for reference:

| The Application Mark | The Opponent’s Mark |
|---|---|
|  |  |

22 Both marks contain the word “mail” and also the letter “g”. With both marks comprising mostly similar letters arranged in the same order, there is certainly visual similarity between the two marks. Yet, at the same time, a visual comparison of the marks may not give that overwhelming impression. There are some key visual differences due to the Application Mark using only the letter “M” in capital letters while the Opponent’s Mark is made up entirely of capital letters; and the intervening “r” in the Application Mark creating a slightly modified look. My assessment is that there is a moderate level of visual similarity.

23 From an aural perspective, the Applicant asserts that the Application Mark is pronounced as a three-text mark “g”, “r”, “Mail”^[note: 9]. While there is no prescribed pronunciation or guide on how the Application Mark should be read, the Opponent also accepts that the average Singaporean consumer is likely to pronounce the Application Mark as “Gee-Arh-Mail”, in the same manner as claimed by the Applicant^[note: 10]. The Opponent’s Mark, on the other hand, is pronounced as “Gee-Mail”.

24 The Opponent submits that there is aural similarity given that the beginning and ending consonants are the same. Similar to the visual appearance, this is a natural consequence when the letter “g” and the word “mail” are used in both marks. However, there is a clear distinction between both marks with the “ARH” sound for the letter “r” used in the Application Mark, that is interspersed between the common sounds between the two marks. While it is a single tone, the significance of it cannot necessarily be discounted and in my view, the aural similarity becomes much lower as a result.

25 In terms of conceptual similarity, each have derived their marks from their respective names – for the Opponent’s Mark, the “g” would be derived from “Google”, while for the Applicant, “gr” can be seen as derived from its name “Green Radar”^[note: 11]. That said, both have chosen to use the word “mail” because each of their service has some relation to email. The Opponent uses its mark for its email service, while the Applicant uses the Application Mark for its email security service. To that extent, there is a moderate degree of conceptual similarity over the adoption of the word “mail” into the mark.

26 The Opponent submits that the distinctiveness of its mark resides in the mark as a whole, "GMAIL", and not just its letter "G" and the whole mark "GMAIL" should be considered a dominant component. Even if that is accepted, the argument does not hold as the Application Mark does not replicate that Opponent's asserted dominant component unchanged, but instead has an interspersed "r" in between "g" and "Mail". For this particular case, in consideration of the descriptive nature of the word "mail" and the generic nature of using a letter "g", I did not find the Opponent's Mark to have a high level of inherent technical distinctiveness.

27 In *Staywell*, at [26], the Court of Appeal had observed that it has been consistently stated in cases that the "visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components". As mentioned earlier, the three factors are only "signposts" when assessing similar marks and there is no fixed formula or "percentage of similarity" in the comparison process beyond which the balance must be said to be tipped. Each case requires its own mark-for-mark comparison and a consideration of what an average consumer of the goods or services, exercising some care and good sense, would consider.

28 Having reviewed the two marks as wholes and taking into consideration the elements of visual, aural and conceptual similarity, I am ultimately of the view that this case is moderately balanced. There are points of similarity between the two marks, yet the overall impression given to an average consumer may be that there are also certain key differences that are sufficient to easily distinguish between the two. If the balance had to be tipped, I would find that it went slightly in favour of there being more similarity than not.

Similarity of goods or services

29 The factors to be considered in determining similarity of goods and services are also well-settled: see *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 and *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika*") at [49]. These are:

- (a) the respective uses of the goods/ services;
- (b) the respective users of the good/ services;
- (c) the respective trade channels through which the goods/services reach the market;
- (d) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or likely to be found on the same or different shelves (not applicable in this case); and
- (e) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies put the goods/services in the same or different sectors.

30 The respective parties' services are set out for context.

| | |
|-----------------------------|----------------------------|
| Applicant's Services | Opponent's Services |
|-----------------------------|----------------------------|

| | |
|--|--|
| <p><u>Class 42:</u></p> <p>Electronic monitoring services being IT security services in the nature of protection and recovery of computer data.</p> <p><u>Class 45:</u></p> <p>Security services for the protection of property and individuals.</p> | <p><u>Class 38:</u></p> <p>Telecommunication services; electronic mail services; all included in Class 38.</p> |
|--|--|

31 As is apparent, the classes to which each mark is applied to are different. That alone does not mean that the goods or services cannot be similar and there are many instances in which the goods or services are found to be similar despite being registered in different classes. The investigation into the issue of similarity of goods or services will require an objective consideration of the evidence on the other relevant factors.

32 In terms of the respective uses of the services, as outlined earlier at [12] above, the Application Mark is used on its security service for emails where the security service works in conjunction with and does not replace the existing email service provided. While the Applicant has also applied to register its mark in Class 45 for "security services for protection of property and individuals" which go beyond IT-based security services, the evidence put forward by the Applicant did not suggest that it had used the Application Mark on services other than email security services. At the hearing, it was submitted by the Applicant that the current product services (i.e. email security services) offered by the Applicant was not conclusive of everything that the Applicant may offer in the future, suggesting that the intended use of the Application Mark may later extend to physical security services covered by Class 45. This itself is not an obstacle to the trade mark application which can be filed on the basis of future intended use, although a trade mark proprietor should always bear in mind the risk of the trade mark registration being revoked if it is shown that the trade mark was not put to genuine continuous use in Singapore within an uninterrupted period of 5 years after the completion of the registration procedure.

33 The Opponent, on the other hand, offers an email service for its users. Its main contention lies in the fact that the Opponent's email service is also bundled with security features which it asserts goes beyond just basic functions as it also offers the "Advance Protection Program" and "Threat Analysis Group", which are able to safeguard users from a broad range of cyber threats^[note: 12].

34 On the respective users of the service, the Applicant's submission is that its email security service is targeted at enterprise email service providers and marketed in particular to information technology departments, whereas the Opponent's Gmail email service packaged under the Google Workspace (formerly known as G Suite) is targeted at businesses while the general free Gmail email service is targeted at general users. As such, the Applicant asserts that both parties are serving different target markets.

35 The distinction drawn by the Applicant on the users of each party's services appears somewhat artificial. Ultimately, there is no difference in the users of the service since both services are rooted in and related to emails and so the users of both services are consumers who use an email service. While a consumer who wants additional cyber security features for his emails may then look to services such as the Applicant's, the starting point is not different and he would still be a consumer who wants to send and receive emails.

36 Here, I found the trade channels for both services to be similar as both services are mainly marketed and provided online on each party's respective websites or online platforms.

37 As for the extent to which the respective services are competitive, due to the nature of each party's services, I did not think that the specific services of each competed with each other. The Opponent's Gmail email service would be considered and compared with other email services, for example, Microsoft Outlook, Yahoo! Mail, Apple's iCloud Mail, which are some of the web-based free email services that come with built-in security functions such as anti-phishing and spam folders. On the other hand, the Applicant would be compared with similar service providers competing in the market which offer targeted and sophisticated email security solutions, whether using Secure Email Gateway, Application Programming Interface or Inline email security implementation models, that are designed to work together with the consumer's existing email services.

38 Finally, when considering these various factors with regard to the Applicant's Class 45 specification, which applies to non-IT security services, as compared to the Opponent's Class 38 specification, it would appear that there are little to no similarities in each factor as the respective uses, users and trade channels would be envisaged to be quite different and the respective services would not likely be competing with each other.

39 Having reviewed the various factors on the issue of similarity of services, the balance of the factors pointed to more differences than similarities and the conclusion reached is therefore that there is no similarity in the services.

40 At this second step of the three-step *Staywell* test, the Opponent has not established that the respective services are similar. The enquiry effectively ends here, but for completeness, I set out my thoughts below on the final step in the *Staywell* test.

Likelihood of confusion

41 Moving on to the final factor to be considered under this ground of opposition, the question of likelihood of confusion requires an assessment of the earlier two factors of similarity of marks and similarity of goods or services and how given these, the relevant segment of the public will be confused: see *Staywell* at [55] and *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR ("*Caesarstone*") at [56]. In *Caesarstone*, the Court of Appeal reaffirms the approach in *Staywell*, to set out the factors considered in opposition proceedings:

(a) Factors relating to the impact of marks-similarity on consumer perception: (i) the degree of similarity of the marks themselves; (ii) the reputation of the marks; (iii) the impression given by the marks; and (iv) the possibility of imperfect recollection of the marks.

(b) Factors relating to the impact of goods/service-similarity on consumer perception: (i) the normal way in or the circumstances under which consumers would purchase goods of that type; (ii) whether the products are expensive or inexpensive items; (iii) the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and (iv) 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.

42 The test to be adopted in determining likelihood of confusion is whether a substantial portion of the relevant public will be confused. The question of confusion involves two elements: first, whether one mark is mistaken for another; and second, even if the relevant segment of the public may perceive the competing marks as different, whether they may nonetheless be confused as to the origin which each mark signifies and may perceive that goods/services bearing the two marks emanate from the same source or from sources that are economically linked or associated: *Caesarstone*, at [57].

43 For the reasons I will explain, even though the earlier analysis may have found similarity in the marks, I do not think that the likelihood of confusion on the part of the relevant segment of the public will arise here.

44 A key consideration is in the nature of the product offered by each. As already earlier touched on, the Application Mark is used on its purpose-built security service that provides cyber-security functions for email security. It is not disputed that the Applicant does *not* offer any email service and its mark is not used in relation to any email service. Indeed, the Applicant's email security service works only in conjunction with and does not replace the existing email service provided.

45 The Opponent's Gmail product is a pure email service. It does not offer any separate and distinct email security services, *viz* without the email service, as a standalone product. A user of the Gmail email service alone gets to enjoy only the cyber security features that are incorporated as part of the Gmail email service or the overall Google Workspace, of which Gmail is an integrated part. On this note, it may be noted that based on the Opponent's evidence, it appeared that the specific security services offered under the Google "Advance Protection Program" and "Threat Analysis Group" are security features offered under the broader Google brand umbrella and not specific to Gmail, as the material put forward by the Opponent did not show such features to be designated or tied to Gmail alone^[note: 13].

46 Thus, a consumer who wants an email service will not look to the Applicant as it does not offer such a service. While a consumer with an existing email service who wishes to seek additional email security solutions beyond what is integrated in the email service would not look to the Opponent's Gmail email service – if the consumer is already using the Gmail email service, it needs to look for other services if it needs additional safeguards beyond what Gmail and Google already offer; whereas if the consumer is not using the Gmail email service, it would then look for a standalone product which can ride on top of the existing email service that it is using. As already touched on in the earlier analysis, the services of each party do not actually compete with each other as they serve different objectives and purposes.

47 The likelihood of confusion on the part of *the public* does not necessarily mean the general public at large. In *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 ("*City Chain*"), the Court of Appeal noted that the nature of the member of the public is a relevant consideration and that "the average consumer is not an unthinking person in a hurry but someone who would exercise some care and good sense in making his purchases" and in that case, it was noted that this was even more so where it involved high-end luxury products, see *City Chain* at [56]. This would apply similarly to the present case.

48 Most known free email service providers offer some degree of built in security features, such as a spam folder with anti-phishing alerts. This is not unusual and while the exact security features incorporated within an email service may vary from each other, many consumers using a free email service for personal reasons may be content with the extent of the security features co-offered with the email service. There would be others who prefer or require more sophisticated technology to safeguard their emails, whether for business enterprise or other reasons. Here, the relevant public is the consumer who is considering more advanced security options for its email service. Such a consumer would likely pay greater attention to the specific features of the services offered since it would be purchasing and paying more for a standalone product that adds on security features for email protection, over and above what the existing email service may already provide. This would tend to command a greater degree of fastidiousness and thought into the purchasing process by the consumer.

49 The above analysis considers and compares the actual uses of the parties' respective marks. In opposition proceedings, the inquiry is not confined to only actual use as the inquiry needs to take into account the full range of the monopoly rights which the registered proprietor already enjoys as compared against the full range of rights sought by the applicant – this requires consideration of the notional fair uses to which the proprietor has or might fairly put the registered trade mark and the notional fair uses to which the applicant may put the mark, if registration is granted, see *Staywell* at [57]–[62]. Applying this to the present case, the notional uses to which the Opponent may apply the Opponent's Mark within the registered Class 38 would be all telecommunication services, which may not necessarily be confined to pure email services but would not extend to telecommunications technology consultancy services or IT security services covered by Class 42^[note: 14], nor the security services for the protection of property and individuals covered by Class 45. Similarly, the notional uses by the Applicant would extend to all the possible uses covered by Class 42 and Class 45.

50 At the hearing, the Applicant had submitted that the strong reputation of the Opponent also meant that there would be a lower likelihood of confusion. For this, the Applicant tendered the case of *Apple Inc. v Xiaomi Singapore Pte Ltd* [2017] SGIPOS 10 ("*Xiaomi*"), where the Principal Assistant Registrar had referred to the Court of Appeal's decision in *Staywell* (at [96(a)]) for the holding that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect. In *Xiaomi*, it was held that the reputation of the "IPAD" mark in that case was likely to have an effect contrary to a likelihood of confusion as the reputation of the "IPAD" mark was "inextricably linked" to the well known fact that Apple used an I-prefix family of marks and the fact that the application mark there, "MI PAD", did not have an I-prefix reduced the likelihood of confusion, see *Xiaomi* at [78].

51 Similar to many other global brands with an international reach, I think it would be difficult to dispute the reputation of the Google brand. The Opponent's Gmail email service is one of the multiple products under the Google brand that is offered through the various Google online platforms, whether on the Internet or the mobile Google Play Store. As mentioned before, the Applicant's service is offered via its website www.greenradar.com. At the Applicant's website, there is no reference or link at the Applicant's website to Google or its suite of products. Each party's online platforms appear to be distinctively different, with differing colour schemes and overall look.

52 It appears highly unlikely that the average consumer, especially one who is exercising a greater degree of fastidiousness and thought in considering a standalone product that offers cybersecurity services for emails, would on viewing the Applicant's grMail product, be unable to differentiate it from the Opponent's Gmail, or be confused as to the origin of the Applicant's product and mistakenly believe that grMail is a product that is being offered by the Opponent or is otherwise economically linked.

53 The absence of any evidence suggesting that actual confusion between the two marks had in fact taken place also supports the conclusion that it is unlikely that there would be any confusion here.

54 After considering the various relevant factors, I was not persuaded that the requirements for a finding of likelihood of confusion have been met, over and above my earlier finding that the respective services are not similar.

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

55 The ground of opposition under s 8(2)(b) therefore fails.

Ground of opposition under Section 8(4)

56 Section 8(4) of the Act reads:

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if –

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered –

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark;

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

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

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

Decision on Section 8(4)

57 There are two distinct bases of opposition under s 8(4), as set out in ss 8(4)(b)(i) and 8(4)(b)(ii) respectively. The Opponent has relied on both bases in its opposition.

Section 8(4)(b)(i) – Damaging connection

58 The first basis set out in s 8(4)(b)(i) requires showing a “damaging connection”. There are several elements that must all be established by the Opponent before the ground of opposition under s 8(4)(b)(i) of the Act is made out:

(a) First, it needs to be shown that the whole or essential part of the Application Mark is identical with or similar to the Opponent’s Mark.

(b) Second, the Opponent’s Mark is an earlier trade mark that is well known in Singapore.

(c) Third, the use of the Application Mark in relation to the services claimed would indicate a connection with the Opponent and such connection is likely to damage the interests of the Opponent.

59 It has been held by the Court of Appeal in *Sarika* that the third element on the “connection” that is “likely to damage” the Opponent’s interest would be satisfied if there is a likelihood of confusion – see [76]–[77]. This was subsequently also applied by the same court in *Staywell* – see [120].

60 As the earlier analysis for s 8(2)(b) had already established that there is no likelihood of confusion between the Application Mark and the Opponent’s Mark, this effectively disposes of this basis and it is therefore not necessary to consider the other elements. It follows that the ground under s 8(4)(b)(i) cannot succeed.

Section 8(4)(b)(ii) – Dilution in unfair manner or unfair advantage taken of distinctive character

61 The second and alternative basis for opposition under s 8(4)(b)(ii) also requires several distinct elements to be established by the Opponent:

(a) The whole or essential part of the Application Mark is identical with or similar to the Opponent’s Mark.

(b) The Opponent’s Mark is well known to the public at large in Singapore.

(c) Either:

(i) The use of the Application Mark in relation to the services applied for would cause dilution in an unfair manner of the distinctive character of the Opponent’s Mark; or

(ii) The use of the Application Mark in relation to the services applied for would take unfair advantage of the distinctive character of the Opponent's Mark.

62 On the first element of mark similarity, this exercise was already conducted when considering the ground of opposition under s 8(2)(b) (see above [28]) and the balance was found to have tipped slightly in favour of the two competing marks being similar, rather than dissimilar.

63 As for the phrase "well known to the public at large", this is not defined in the Act. In *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 ("*Ferrero*"), at [153], the High Court referred to the decision in *City Chain* where the Court of Appeal had emphasised that the test "well known to the public at large in Singapore" must mean more than just "well known in Singapore"; and to come within the former test, the trade mark must necessarily enjoy a much higher degree of recognition, further noting that it "must be recognised by most sectors of the public" though it need not be all sectors of the public.

64 In proving this element, an issue arose in relation to the evidence tendered by the Opponent. The Applicant had asserted that the Opponent did not adduce any evidence that linked the use of the Opponent's GMAIL mark to Singapore and that the information and figures related more to the global renown of Google, as opposed to Gmail and how well known Google was in Singapore. The Applicant submitted that the evidence was not sufficient to show that the Opponent's GMAIL mark was well known to the public at large in Singapore.

65 Under r 81B of the Trade Marks Rules, the Registrar has powers to direct, at any stage of proceeding before the Registrar, the applicant or any party to produce or file, within such period as the Registrar may specify, any document, information or evidence which the Registrar may reasonably require. At the hearing, I gave directions to allow the Opponent an opportunity to put in further evidence, which it did so by way of a further Statutory Declaration in Reply made by one Yvette Kan Yi Suan, the Product Marketing Manager, Brand & Reputation, of Google Asia Pacific Pte Ltd, which is a related corporation to the Opponent. The Applicant was also given an opportunity to address the Opponent's further evidence by way of further response submissions.

66 I should highlight that generally, further evidence cannot be tendered without permission after the evidence had been filed earlier: r 35 of the Trade Marks Rules. Parties should not be freely permitted to put in new evidence at a later time when they had the proper opportunity to do so earlier but failed to. That said, a distinction should be drawn between a situation where a party seeks to tender the further evidence belatedly on its own accord, as opposed to being invited by the Registrar to do so. The Registrar is empowered and should be free to call for relevant evidence in a matter to be adduced. Whilst each party bears the responsibility of ensuring that it has tendered sufficient evidence to substantiate its case, it is also important, especially when a matter is being adjudicated at the first instance, to ensure that relevant evidence to resolving the issues in dispute is placed before the tribunal. Other considerations, though not exhaustive, could include whether the further evidence would cause undue prejudice to the other party, giving the other party an opportunity to respond, and whether the evidence could potentially help to avoid a finding based on a technicality instead of the substantive merit.

67 In addition, the test as to whether the further evidence should be permitted should also not be based on the considerations that may be applied by an appellate court considering the matter, which should take a stricter approach when the matters have already been adjudicated at first instance and the decision is being appealed against.

68 For the present case, the further evidence adduced went towards showing a sample of the variety of consumers in Singapore which used the Opponent's Gmail email service and these included a broad range of companies in Singapore^[note: 15]. While there may not be specific data on the exact number of employees in each of the mentioned Singapore entities which used Gmail, it is clear that the usage of Gmail in Singapore is extensive. Indeed, even the Applicant's own evidence on the "Log In Prompt" on its browser^[note: 16] makes a reference to signing into the Green Radar account with the user's existing Microsoft 365 or G Suite account. The reference to "G Suite" (now known as Google Workspace) is an indirect acknowledgement of the usage of

Gmail, which is an integral part of every Google Workspace package plan that is offered by Google. There is therefore no merit in the Applicant's argument that the Opponent's evidence on Google Workspace does not relate to Gmail specifically, as it ignores the fact that Gmail is a part of Google Workspace.

69 At this juncture, I would add that where a case involves a well known mark, the proprietor of the mark would do well to remember that it must still prove this on evidence. Even for internationally famous brands, it should not be taken for granted that the reputation and renown of the mark would speak for itself such that "judicial notice" may be taken that a mark is well known in Singapore without requiring further proof. This was not the case here, although perhaps the supplementary evidence would not have been called for had the Opponent put in more complete evidence on this issue right from the outset. To be fair, the evidence was not bare and it was certainly not a situation where the Opponent had not tendered any evidence at all on the issue and was only belatedly attempting to do so. In the earlier Statutory Declaration in Reply filed by Andrew Abrams, evidence was submitted in the form of a Google Economic Income Report which Google had commissioned AlphaBeta to prepare in 2015. The said report indicated that there were approximately 2 million Singaporeans which communicate via Gmail and the estimate was computed by AlphaBeta based on data from its consumer survey and reporting on techcrunch.com and the Email Statistics Report, 2014-2018 by the Radicati Group^[note: 17].

70 The Applicant did not produce contrary evidence to dispute this but sought to discredit the AlphaBeta report by asserting that it was hearsay evidence and it did not properly meet the standards for conduct of survey evidence. On these points, it is not clear that the rules on hearsay or the Evidence Act 1893 applies to the present proceedings. Section 2 of the Evidence Act makes it clear that Parts I, II and III of the Act applies to "judicial proceedings in or before any court, but not to affidavits presented to any court...". The Evidence Act would therefore not extend to a tribunal hearing at the IPOS where all the evidence is adduced through statutory declarations. That is not to say that the rules on evidence would have no relevance at all in IPOS proceedings. Certainly, where oral evidence needs to be considered, there would be circumstances where principles to ensure the veracity of the evidence would be appropriately considered and applied. There is no oral evidence being used in the present proceedings and therefore, this particular issue does not arise and I do not propose to state any specific rule beyond what has been necessary for this case.

71 As for the point on the standards for conduct of survey evidence, I did not think the issue of methodology arises here. The survey, for the purposes of the AlphaBeta report, was not in the context of comparison between the two marks in question here and unlike a classic case of surveying whether the likelihood confusion has arisen between the marks. Therefore, I did not see any reason to disregard the evidence put forward in the AlphaBeta report. Nonetheless, it was in response to this point that the evidence in the AlphaBeta report may not have been direct, that I had asked the Opponent to put in the supplementary evidence in the form of primary or more direct evidence, so that the resolution of this query would not be left in doubt or be defeated on a technical basis.

72 I was of the view that the further evidence tendered by the Opponent did not cause any undue prejudice to the Applicant, who was given an equal opportunity to respond and submit on it. The further evidence tendered corroborated the earlier evidence put forward by the Opponent to establish that its GMAIL mark was well known to the public at large in Singapore. As mentioned, while the Opponent could possibly have better prepared its evidence more fully without presuming the evident nature of the renown of its mark, I do not think the costs arising from such further evidence and the supplementary submissions it gave rise to, need to be separately decided and it can follow the overall outcome and decision on the case.

73 Having established that the Opponent's mark is well known to the public at large in Singapore, I move on to consider the remaining elements set out in s 8(4)(b)(ii). There are two alternative limbs here, the first of which requires showing that the "use of the Application Mark in relation to the services applied for would cause dilution in an unfair manner of the distinctive character of the Opponent's mark".

Dilution in an unfair manner

74 The term "dilution" is defined at s 2(1) of the Act as follows:

"dilution", in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is —

- (a) any competition between the proprietor of the trade mark and any other party; or
- (b) any likelihood of confusion on the part of the public.

75 The definition of the term makes it clear that "dilution" can occur even if there is no likelihood of confusion or competition between the proprietor of the trade mark and any other party. There is also no requirement that the parties' goods or services are identical or similar, see *Sarika* at [87]. That said, in *Law of Intellectual Property of Singapore* (Sweet & Maxwell, Revised 3rd Edition, 2022), Professor Ng-Loy Wee Loon had opined, at [21.5.52], that "the marks, if not identical, must be sufficiently similar such that the public will make a mental association between the two marks, i.e. the perception of the later mark must call to mind the memory of the special well known trade mark".

76 In *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 ("*Amanresorts*"), the Court of Appeal made it clear that "dilution" in the context of the Act refers to both dilution by blurring and dilution by tarnishment, see [225]. In the present case, the Opponent pursued the head of dilution by blurring and it is to this that I direct my mind, below.

77 In *Sarika*, the Court of Appeal noted that the "essence of dilution is the weakening of the mark's ability to identify goods" and "what the dilution action protects is the well known trade mark's distinctiveness or uniqueness from being eroded, thereby protecting its 'selling power' and 'commercial magnetism'". The Court went on to hold that it "must be shown in a dilution by blurring claim that the relevant public makes a connection or establishes a link between the sign and the trade mark" and "a link implies that the consumer will 'call to mind' the proprietor's well known mark after seeing the other party's sign used in relation to that party's goods", see at [96], [98] and [99].

78 From the decision in *Sarika*, it is clear that whether there is dilution by blurring can be established through two elements of: (a) whether a link is established; and (b) whether there is consequently a real and serious likelihood of damage to the distinctive character of the mark, without having to actually show proof of actual or immediate damage, see [94] and [99].

79 As was acknowledged in *Seiko Holdings Kabushiki Kaisha (Trading as Seiko Holdings Corporation) v Choice Fortune Holdings Limited* [2014] SGIPOS 8 ("*Seiko*"), at [117], the application of the test on whether there is dilution by blurring involves a considerable degree of subjectivity. The Principal Assistant Registrar in *Seiko* had adopted the approach applied by the Court of Appeal in *Sarika*, which had in turn considered five factors before making a finding of dilution by blurring, namely: (a) the degree of recognition of the earlier trade mark; (b) the distinctive quality of the earlier trade mark given the invented nature of the word; (c) the close similarity between the marks increasing the likelihood that the public will make a mental connection between them; (d) the admission of the applicants (in *Sarika*) that the sign "NUTELLO" was derived from the "NUTELLA" mark and the intention was to inform consumers that the applicants' "NUTELLO" product was a mixture of espresso and "Nutella" chocolate cream spread; and (e) the similarity of the parties' respective goods increasing the likelihood that consumers would draw a mental link between the sign "NUTELLO" and the "NUTELLA" mark.

80 Applying the test to the present case, while I find that the degree of recognition of the Opponent's GMAIL mark to be relatively high, given that it has been shown to be well known to the public at large in Singapore, I did not consider the Opponent's Mark to be particularly distinctive (see above [26]). The similarity between the two marks was also found to be only moderate (see above [28]). Nonetheless, as both marks use the words "mail" and contain the letter "g", I accept that there is likelihood that some mental connection between the two marks may be made by the public.

81 There was, however, no admission of any intended association by the Applicant with the Opponent here. Indeed, there appeared to be a logical explanation by the Applicant that the letters "gr" were directly derived from the Applicant's name, Green Radar, and the word "mail" was used as the product related to security services specific only to email services and not to other online or IT products. While the nature of the products both related to email, it does not mean that just because the two competing marks are used in the same type of goods or services, then this must lead to a natural conclusion that there will be dilution by blurring. The totality of the circumstances must still be considered. Here, the question lies in whether consumers would draw a mental link between the Application Mark and the Opponent's Mark leading to a real and serious likelihood of damage to the distinctive character of the Opponent's Mark.

82 I was not convinced on the facts that any mental link drawn between the two marks would lead to any real and serious likelihood of damage to any distinctive character of the Opponent's Mark. While likelihood of confusion is not a necessary element here, the lack of such likelihood and evidence on the same should not be entirely disregarded and it remains a relevant factor that should be considered in the analysis. Taken together with the findings that the similarity and inherent technical distinctiveness of the Opponent's Mark are not high, I was not persuaded that the use of the Application Mark over an extended time on the Applicant's email security services would create a real and serious likelihood that any distinctive character of the Opponent's GMAIL mark may be weakened or lost over time, or that there would be a diminished ability on the part of the GMAIL mark to identify the service which it is registered for and that it may no longer have or have only a reduced capacity to conjure immediate association with the Opponent's email services.

83 The mental linkage and risk of dilution is even more remote in relation to the use of the Application Mark on any non-IT security services (in Class 45 which the Applicant has also claimed registration for) as the nature of such products would be even more removed and unrelated to any telecommunication services which the Opponent's Mark may be applied to.

84 Accordingly, I do not find any dilution by blurring under s 8(4)(b)(i).

Unfair advantage taken of distinctive character

85 There remains the ground of opposition under s 8(4)(b)(ii) on whether the use of the Application Mark in relation to the services applied for would take unfair advantage of the distinctive character of the Opponent's Mark.

86 Unlike dilution by blurring, this ground protects against exploitation and free riding on the reputation of the earlier well known mark, see *Sarika* at [90]. At the High Court level, in *Ferrero*, which the Opponent had relied on in its submissions, the court had elaborated on the concept of "unfair advantage" and explained, "the defendant's mark freely rides on the coat-tails of the well known mark in order to benefit from its power of attraction, its reputation and its prestige and to exploit the marketing effort of the proprietor without any financial compensation", see [180]. The court continued, at [181], to hold that, "the mere taking of advantage is insufficient – there must be *unfair* advantage taken", that it is not sufficient to show that the alleged infringer had obtained an advantage and there must be an added factor of some kind for that advantage to be categorised as unfair.

87 In *Ferrero*, the High Court further sets out four factors which were considered for this particular ground of opposition: (a) the strength of the well known mark's reputation and the degree of distinctive character of that mark; (b) the degree of similarity between the marks at issue; (c) the nature and degree of proximity of the goods or services concerned; and (d) the immediacy and strength with which the earlier well known mark is brought to mind by the later "offending" mark, see [182] to [186].

88 None of these factors are determinative and in the final analysis, which requires a global assessment of all the factors, what needs to be shown is that the Applicant had drawn some unfair advantage from using a similar mark. The Court in *Ferrero* noted, with reference to the finding by the English Court of Appeal in *Whirlpool Corporation & Ors v Kenwood Ltd* [2010] RPC 2, that it is possible to find that the alleged infringer

had no need to ride on the coat-tails of the proprietor of the earlier mark and that there was insufficient proof that the association of the earlier mark would enhance the performance of the later mark, even despite the products being very similar (even identical) and that the well known mark was distinctive (although not strongly so in that case) – see *Ferrero* at [182] and [187].

89 In *Ferrero* itself, even though the court had found the earlier well known mark “Nutella” to be distinctive, that the competing “Nutello” mark was similar visually, aurally and conceptually, that there was similarity in the goods represented by “Nutello” and the products for which the “Nutella” mark is registered, and that there was clear evidence that the “Nutello” sign was derived from “Nutella”, yet the court went on to conclude that there was insufficient proof that the “Nutella” mark has been unfairly taken advantage of. This specific finding was not disturbed when the case went on appeal.

90 The earlier analysis had already covered the consideration of some of the factors to be considered. Ultimately, even if some of the factors were made out, the scales of the overall analysis did not tip in favour of the Opponent. It was difficult to conclude that this ground of opposition had been satisfied as there was simply no evidence to prove on a balance of probabilities that the Applicant had or would gain any *unfair* advantage from using the Application Mark. While the Opponent had attempted to assert as much, there was insufficient evidence to support the bare allegation and nothing showed that the Application Mark gained any commercial advantage from any perceived similarity with the Opponent’s Mark. As such, I do not find s 8(4)(b)(ii) to be made out on the facts.

Conclusion on opposition under Section 8(4)

91 Having considered the various limbs under this provision, the conclusion is that the ground of opposition under s 8(4) therefore fails.

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

92 Section 8(7)(a) of the Act reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

Decision on Section 8(7)(a)

93 The law on passing off is well settled and the three elements that must be established to prove a claim in passing off are: goodwill, misrepresentation and damage. All three elements must be made out and the failure to prove any of the elements would mean that the ground cannot succeed: *Amanresorts*, at [37].

94 This ground of opposition can be quickly dealt with as the earlier analysis had already established that there is no “likelihood of confusion” under s 8(2)(b) of the Act nor any “confusing connection” under s 8(4)(b) (i) of the Act. In *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216, the High Court had applied the same test under s 8(4)(b)(i) for the analysis on misrepresentation under s 8(7)(a) of the Act, see [191]–[193]. In view of the earlier findings, it is clear that the element of misrepresentation is also not made out here and this suffices to dispose of this ground without having to further investigate the other elements.

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

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

Ground of opposition under Section 7(6)

96 I will finally deal with the absolute ground for refusal of registration under s 7(6).

97 Section 7(6) of the Act reads:

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

Decision on Section 7(6)

98 The evidence for this ground is fairly straightforward. The Opponent asserted that knowledge of an earlier trade mark at the time of application is relevant when considering whether an application is made in bad faith. Given that the Applicant's website itself has direct references to the Opponent's services, Gmail, the Applicant clearly knew of the Opponent's Mark^[note: 18]. Despite such knowledge, the Applicant took no steps to distinguish its services from the Opponent's, and instead incorporated the word "GMAIL" into the Application Mark, which is a departure from market practice and falls short of the standards of acceptable commercial behaviour. The Opponent asserted that if the Applicant had been genuine in distinguishing its services, it should have used the words "Green Radar mail" instead. The Opponent therefore submitted that on an objective basis, the registration was made in bad faith.

99 The Applicant's response is simply that the ground must fail as it is a bare allegation lacking in particulars and therefore non-compliant with the IPOS Hearings and Mediation Group (HMG) Circular No. 2/2015 dated 25 May 2015 on "Particulars to be Specified in Bad Faith, Fraud and Misrepresentation Allegations"^[note: 19].

100 The case of *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 ("*Valentino*") had summarised the established law in this area. In that case, the Court of Appeal had made it clear that whether there is bad faith is to be judged according to the combined test which contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think); and that a charge of bad faith is a serious and grave claim that must be sufficiently supported by evidence: see *Valentino* at [29] and [30].

101 Applying the test to the present case, it seems quite clear to me that the threshold has not been met by the Opponent. As submitted by the Applicant, the evidence put forward by the Opponent is gravely lacking. Mere knowledge of a prior exclusive proprietary right, even if shown to be a well known one, cannot in and of itself mean that registration of a similar mark (if so established at all) was done in bad faith. Something more in the circumstances would need to be shown to demonstrate why such knowledge, if possessed by an ordinary person in those circumstances, would then render the registration of the Application Mark a departure from market practice that falls short of the standards of acceptable commercial behaviour. There was no such evidence put forward by the Opponent, who bears the onus of proving the bad faith: see *Valentino* at [36].

102 Here, as previously discussed, while it has been established that there is moderate similarity between the marks, no risk of confusion nor misrepresentation has been established. A bare assertion by the Opponent, without more, would not suffice to meet the elements of this serious ground.

Conclusion on opposition under Section 7(6)

103 For the abovementioned reasons, the ground of opposition under s 7(6) therefore fails.

Overall conclusion

104 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the opposition fails on all the grounds submitted by the Opponent. The application will proceed to registration. The Applicant is also entitled to costs as follows:

Party and party costs: \$9,386.50

Disbursements: \$2,750.00

The total assessed costs to be paid by the Opponent to the Applicant are \$12,136.50.

[note: 1] Raymond Liu's SD at [6].

[note: 2] Raymond Liu's SD at [8] and Exhibit C.

[note: 3] Raymond Liu's SD at [10] and [11].

[note: 4] Raymond Liu's SD at [11], [13] and Exhibit D.

[note: 5] Andrew Abrams' SD at [5] to [14] and exhibits referred to therein.

[note: 6] Andrew Abrams' SD at [15] and [19]; read with the Statement of Grounds of Opposition (Amendment No. 1) at [6].

[note: 7] Andrew Abrams' SD at [22] to [28].

[note: 8] Andrew Abrams' SD at [21] and [32].

[note: 9] Andrew Abrams' SD at [15], read with the Applicant's Amended Counter-Statement at [3].

[note: 10] Opponent's written submissions at [30].

[note: 11] Applicant's Amended Counter-Statement at [3].

[note: 12] Andrew Abrams' SD in Reply at [11], [15] and Exhibits [2A], [2B] and [5].

[note: 13] Andrew Abrams' SD in Reply at [11] and Exhibits [2A] and [2B].

[note: 14] WIPO Nice Classification Explanatory Note for Class 38.

[note: 15] Yvette Kan's SD in reply at [10] to [12] and Exhibits [1] to [2].

[note: 16] Raymond Liu's SD at [6] and Exhibit [D].

[note: 17] Andrew Abrams' SD in Reply at [14] and Exhibit [4] and Yvette Kan's SD in reply at [5] to [6].

[note: 18] Andrew Abrams' SD at [35] and [36].

[note: 19] Now known as the Hearings and Mediation Department (HMD) Circular 1.7.

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