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

[2026] SGIPOS 1

Trade Mark No. 40202401479U

IN THE MATTER OF A TRADE MARK APPLICATION

IN THE NAME OF

GENPULSE PTE LTD

… *Applicant*

AND AN OPPOSITION BY

COSMETIC WARRIORS LIMITED

… *Opponent*

GROUNDS OF DECISION

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Cosmetic Warriors Limited
v
Genpulse Pte Ltd

[2026] SGIPOS 1

Trade Mark No. 40202401479U
Principal Assistant Registrar See Tho Sok Yee
13 October 2025

13 January 2026

Principal Assistant Registrar See Tho Sok Yee:

Introduction

1 The conception and adoption of a trade mark as an indicator of trade origin is fraught with challenges. Fully invented words which do not contain any known dictionary words may encounter difficulty gaining resonance and recognition in the target market. Fully descriptive words would be immediately recognisable but, of course, encounter difficulty getting registered in Singapore due to their descriptive and non-distinctive nature. Businesses could resort to the use of allusion and evocation by coming up with fresh combinations of known words, but in an increasingly crowded space, such allusive word components may be in high demand by trade competitors. This could set them up for trade mark disputes if there is no agreement on whether they could peacefully co-exist on the trade mark register and in the market.

2 Genpulse Pte. Ltd. ("the Applicant") applied to register the following in Singapore ("the Application Mark"):

Trade Mark No.	40202401479U

Mark	
Class	44
Specification	Beauty information services; Consultancy and information services provided via the Internet relating to pharmaceutical products; Consultancy in the field of body and beauty care; Consultancy relating to skin care; Dermatological services for treating skin conditions; Dermatology services; Healthcare information services; Information relating to beauty care; Information services relating to health care; Medical analysis for diagnostic purposes; Medical analysis for the diagnosis and treatment of persons; Medical services for treatment of the skin; Online make-up consultation services; Providing health care information via a global computer network; Providing information including online, about medical services and veterinary services; Providing information, including online, about hygienic and beauty care for human beings or animals; Providing medical information in the field of dermatology; Skin care salon services; Telemedicine services; Rental of skin care equipment.
Application Date	22 January 2024

3 Cosmetic Warriors Limited ("the Opponent") opposed the registration of the Application Mark.

Background of parties

4 The Opponent and related entities form part of the "LUSH" Group, which was founded in 1995 and headquartered in Poole, Dorset, UK. Its speciality is in skincare, beauty and hair care products. The "LUSH" Group operates in over 50 countries with over 880 shops worldwide. Its main trade mark is, without surprise, the "LUSH" trade mark, which it first started to use in 1995.

5 The Applicant is a Singapore company in the business of delivering dermatological solutions powered by technology. In essence, the Applicant developed a proprietary skin and scalp diagnostic device which captures high-resolution images of the customer's skin and scalp. These images are then processed using proprietary software that apply AI-driven medical image recognition algorithms to analyse dermatological and trichological conditions. The Applicant then creates and offers personalised treatment plans for each customer.

6 The Applicant's goods and services under its "LUSHAIR" trade mark (speaking generally) are available in Singapore and globally through its website at www.lushair.ai and various e-commerce platforms including Shopee and Taobao.

7 This opposition deals specifically with the Application Mark, which is a "LUSHAIR" trade mark in the particular form represented at [2] above:

“ ”.

Grounds of opposition

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

Opponent’s evidence

9 The Opponent’s evidence comprises the following:

(a) a Statutory Declaration made by Gabriela Maria Felix Francisco, IP Lawyer of the Opponent, on 25 February 2025, in Poole, UK; and

(b) a Statutory Declaration in Reply made by the same Gabriela Maria Felix Francisco on 16 July 2025, in Poole, UK.

Applicant’s evidence

10 The Applicant’s evidence comprises a Statutory Declaration made by Bao Jiyuan, Director of the Applicant, on 16 May 2025 in Singapore (“the ASD”).

Applicable law and burden of proof

11 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.

Ground of opposition under section 8(2)(*b*)

12 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.

13 In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 ("*Staywell*") at [15], the Court of Appeal adopted the "*step-by-step*" approach under section 8(2)(*b*) of the Act. This may be summarised as follows:

(a) The first step is to assess whether the respective marks are similar.

(b) The second step is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected.

(c) The third step is to determine whether there exists a likelihood of confusion arising from the marks- and goods/services-similarities.

(d) "The first two elements are assessed individually before the final element which is assessed in the round". If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

Application of section 8(2)(*b*) to the facts

14 In the present case, the Opponent refers to the following earlier "LUSH" trade marks ("Earlier Marks") registered under its name in Singapore:

S/No.	Mark	Trade Mark No.	Class(es)	Application Date
1	LUSH	40202319469T	24	14 June 2023
2	LUSH	40202007420U	21	3 December 2019
3	LUSH	40202006489X	03, 04, 09, 16, 18, 25, 26, 35, 38, 41, 42, 44, 45	10 August 2018
4	LUSH	T1402223E	35, 44	14 February 2014
5	LUSH	T9611581Z	05	24 October 1996
6	LUSH	T9611580A	03	24 October 1996

For the purposes of this opposition, without dismissing the rest, I will focus on Trade Mark Nos. 40202006489X (S/No. 3) and T1402223E (S/No. 4) as they cover Class 44, which is the class of services to which the opposed Application Mark pertains.

Step 1: Marks-similarity

15 Under the three-step test in *Staywell*, I first consider marks-similarity; that is, whether the Application Mark and the Earlier Marks are similar.

Visual similarity

16 First, I consider the issue of distinctiveness. This is relevant as the Court of Appeal in *Staywell* made clear at [25] that "a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it." As an aside, the High Court in *V V Technology Pte Ltd v Twitter, Inc* [2023] 5 SLR 513 at [119(c)] held that "acquired technical distinctiveness should not be considered at the marks-similarity inquiry ... (but) at the likelihood of confusion stage of the inquiry to preserve conceptual clarity." In any case, the Opponent had not relied on acquired distinctiveness under this ground of opposition.

17 The Opponent submits that "LUSH" in the Earlier Marks is of an average level of inherent technical distinctiveness. The Applicant submits that "LUSH" is of a low or (at best) medium distinctiveness. There is an area of confluence of agreement between the parties, with which I agree. I am inclined to peg the Earlier Marks at an average, medium level of inherent technical distinctiveness visually. The Opponent's Earlier Marks therefore do not enjoy the correspondingly high threshold that marks which are highly distinctive technically enjoy before competing marks are considered dissimilar.

18 As for the Application Mark, visually, its distinctive and dominant

component is the mark " " as a unified whole, and not, selectively, only the seven letters "L-U-S-H-A-I-R", nor the four letters "L-U-S-H" incorporated within the invented word "LUSHAIR". The device of a

stylized letter "L", taking the shape of a strand of hair, encircled in an orb, visually takes up more than half the space of the Application Mark. It lies in stark relief colour-wise, with the stylized letter "L" in white contrasting with the black/dark background. There is unity of design between the visual device and the word element, in that the former is not a mere decorative feature, but is coherent with the first letter of the word "LUSHAIR" as well as drops a visual hint of a strand of hair (where the word "HAIR" appears in "LUSHAIR").

19 Structurally, the Earlier Marks comprise a plain word mark while the Application Mark is a composite mark comprising a device element and a word element. This is another fundamental visual difference that cannot be dismissed as the composite mark is distinctive as a whole here.

20 The lengths of the respective word elements also differ: "LUSH" comprises four letters and "LUSHAIR" comprises seven. The difference is significant as it visually informs the viewer that the Application Mark is a longer mark than the Earlier Marks.

21 I am mindful of the Court of Appeal's summary of the relevant, non-exhaustive principles in relation to the visual comparison of composite marks in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 ("*Hai Tong*") at [62]. The Opponent has relied on these principles to argue that the respective marks are visually similar. In brief, as the Opponent summarises in its written submissions[1], these include:

(a) The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components.

[1] [30] of the Opponent's written submissions.

(b) The textual component of a composite mark or sign could be the dominant component of the mark or sign in these circumstances:

(i) The two marks or signs in question each contain a similar device.

(ii) The textual component is large, and is in a prominent location in relation to the other components or stands out from the background of the mark or sign.

(iii) The textual component is in itself already widely known.

(iv) The composite mark or sign is applied to goods or services marketed or sold primarily through online trade channels.

(c) The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:

(i) The device is significant and large.

(ii) The accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component.

(iii) The device component is of a complicated nature.

(d) The device component is not usually found to be an equally significant, if not the dominant, component of a composite mark or sign where:

(i) The device is simple and will not evoke any particular concept for the average consumer.

(ii) The device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods.

(iii) The device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.

22 I think my foregoing analysis of the visual comparison of the marks is consistent with *Hai Tong*.

23 The Opponent has also pointed out that the Applicant does not even use the device by itself on its goods packaging. The inference which it would have me draw is that the device is therefore not the distinctive and dominant element of the Application Mark. However, as elaborated above, I find that it is the Application Mark as a unified, composite whole that is distinctive; not merely the word element, neither merely the device. Whether or not a device element is separately used does not detract from the overall visual impression of a composite mark (which itself can comprise a carefully curated combination of elements which in themselves are not necessarily of high distinctiveness). Further, as a trade mark can be filed on the basis of intent to use in the first place, there can surely be no adverse inference made against the Applicant for (in a twice-removed argument) not using one component (the device) of its composite mark on its goods packaging.

24 Overall, I am not persuaded by the Opponent that the Application Mark is visually similar to the Earlier Marks.

Aural similarity

25 The parties did not submit separately on the issue of aural distinctiveness but subsumed it under general submissions on distinctiveness at the start of their marks-similarity enquiry. Both parties' positions overlap in that the Earlier Marks are of an average, medium level of inherent technical distinctiveness – including aurally – I agree. There is no additional factor that uplifts the trade mark "LUSH" to a higher degree of inherent technical aural distinctiveness. As such, the Earlier Marks do not enjoy "a high threshold before a competing sign will be considered dissimilar to it", in this case, aurally: *Staywell* at [25].

26 At the hearing, much time was spent by both parties contending back and forth on the proper pronunciation of the Application Mark. The Opponent took a strong stand that it was intended – by the Applicant itself none less in its social media posts – to be pronounced "LUSH-HAIR". It also made the proposition that it could be pronounced "LUSH-AIR". The thrust of the Opponent's contention was that, in either of these pronunciations, "LUSH" was pronounced in both the Application Mark and Earlier Marks. As this common element appears at the front of the Application Mark, it is more significant. Hence, taking a qualitative approach to how the marks sound, they are aurally similar. On the other hand, the Applicant put forward three ways in which the Application Mark may be reasonably pronounced: (i) "LU-SHAIR"; (ii) "LUS-HAIR"; and (iii) "LUSH-AIR". It strongly contended that the strong ending of the Application Mark, whether "HAIR" or "AIR", balances the first syllable and prevents the latter from overwhelming the mark. Qualitatively, the Application Mark is pronounced as a whole and not artificially dissected by a dominant "LUSH" sound.

27 I consider that there are two possible tests for assessing aural similarity according to *Staywell* at [31] to [32]. First, the qualitative approach which considers the dominant and distinctive elements of the marks. Second, the quantitative approach which looks at whether the marks have more syllables in common than not.

28 I am also mindful of the case of *Seiko Kabushiki Kaisha (trading as Seiko Corporation) v Montres Rolex S.A.* [2004] SGIPOS 8 ("*Seiko*") at [30] where the hearing officer recognized that:

> When a person is faced with an unfamiliar word, there is a tendency for that person to reach within his own vocabulary of words and mentally look for words that have the same structure in the sense that the chronology of the alphabets is the same as the unfamiliar word.

Thus, according to this sensible, realistic practice, the average person would notice the English word "Lush" when reading "LUSHAIR" from left to right and would likely pronounce the first syllable as "Lush" rather than "Lus". This means that the Application Mark and the Earlier Marks have one syllable in common; but this is not the end of the inquiry as the former still incorporates the letters "-HAIR" or "-AIR", which are "hard" sounds not susceptible to slurring.

29 Using the qualitative approach, the aurally distinctive and dominant elements of each of the competing marks are the entirety of "LUSH" and "LUSHAIR" themselves, without dissection. Thus, qualitatively, it cannot be said that the competing marks here are aurally similar because of their identical start because the latter is not the aurally distinctive and dominant element of the Application Mark. Whether it is pronounced "LUSH-HAIR" (as a coalesced invented word combining "Lush" and "Hair") or "LUSH-AIR" (as a conjoined invented word combining "Lush" and "Air"), both pronunciations are

qualitatively dissimilar to the Earlier Marks' pronunciation. The aural endings are as important and significant as the beginnings in this case.

30 Using the quantitative approach, the marks are also not more aurally similar than dissimilar. The only syllable in common is the first sound, "Lush". The Application Mark is only 50% aurally in common with the Earlier Marks, where the latter are monosyllabic. Where short marks of one or two syllables are compared, 50% aural commonality on its own cannot tip the scales in favour of a finding of aural similarity as the public would be used to differentiating between such short marks. It would also unduly limit the market and unduly limit traders' choice of trade marks if monosyllabic marks are readily found aurally similar if they are incorporated in other longer marks.

31 The above takes into account my earlier finding that the Earlier Marks have an average, medium level of inherent technical distinctiveness, aurally speaking. There is therefore no "high threshold before a competing sign will be considered dissimilar to it" aurally. The Application Mark crosses this threshold.

32 Therefore, whether qualitatively or quantitatively, I am not persuaded that the competing marks are aurally similar.

Conceptual similarity

33 On the matter of conceptual distinctiveness, I am of the mind that the Earlier Marks – comprising the sole English dictionary word "Lush" – are at an average, medium level of inherent technical distinctiveness. The parties are also in large agreement when they made their distinctiveness submissions globally at the outset of their submissions on marks-similarity.

34 The Court of Appeal in *Staywell* at [35] opines that "the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole".

35 The Opponent's argument here hinges on the common element "Lush" and pegs all the perceived meaning of the respective marks onto this common element. It submits that the common concept of "Lush" alludes to attractiveness and luxury, citing dictionary extracts in support.

36 The Opponent also selectively cites dictionary extracts for "Air", including "a surrounding or pervading influence" and "manner or appearance". Combining these meanings with the notions of attractiveness and luxury, the Opponent says that consumers that perceive "LUSHAIR" as "LUSH-AIR" instead of "LUSH-HAIR" would still perceive the Application Mark as resonating closely with the Earlier Marks, as the Application Mark alludes to the air, atmosphere or aura of the distinctive word "Lush" in the Earlier Marks.

37 However, such an approach appears premature and contrived. Appraising the Application Mark as a whole, I appreciate that conceptually, it may be perceived as "LUSH-HAIR" (as a coalesced invented word combining "Lush" and "Hair") or "LUSH-AIR" (as a conjoined invented word combining "Lush" and "Air"). Either way, as with the examples given in *Staywell* at [15], the sum of the parts of a mark can qualitatively change the concept behind the mark.

38 The Applicant submits that the Application Mark has no inherent meaning when considered in its entirety. To the extent that there is no dictionary meaning, I agree with the Applicant. However, there are still "ideas that lie behind and inform the understanding of the mark as a whole" to be perceived.

In fact, in the Applicant's evidence[2], in describing the creation of the Application Mark, the Applicant's Director declared that "The term "LUSHAIR" was conceived to be read and pronounced as "LUS-HAIR", evoking the idea of hair that is full, healthy and luxuriant". At the hearing, the Applicant's counsel distinguished this concept from what the Opponent offered, highlighting that the Applicant's concept is specific to hair whereas the Opponent chose to focus on the concepts of attractiveness and luxury in general.

39 To its credit, the Opponent also included dictionary extracts reflecting other definitions of "LUSH", for example, from the online Merriam-Webster Dictionary: "Growing vigorously especially with luxuriant foliage" / "Lavishly productive" / "Opulent, sumptuous".

40 I can accept both parties' proffered concepts of their respective marks. The Earlier Marks evoke notions of attractiveness and luxury. To that I would add the concept of vigorous, healthy growth, especially in the field of botany (such as lush forest cover). The Application Mark, where the ending is comprehended as "HAIR", evokes "the idea of hair that is full, healthy and luxuriant". As the Court of Appeal observed in *Staywell* at [15], the sum of the parts of a mark can qualitatively change the concept behind the mark. In the present case, the Application Mark evokes thick, healthy hair. Even though the notion of vigorous growth is common to the competing marks, the common denominator is too low and overtaken by the more specific concept evoked in the Application Mark pertaining to hair.

41 I have found that the Earlier Marks have a medium level of conceptual inherent technical distinctiveness and there is no "high threshold" to be crossed

[2] [6] of the ASD.

before another mark is considered distinguishable from it. In light of the foregoing considerations of the conceptual angles of the competing marks, I accordingly find that they are conceptually dissimilar.

Conclusion on marks-similarity

42 Overall, I find that the Application Mark and the Earlier Marks are not similar, whether visually, aurally or conceptually.

43 This being the case, the Opponent has failed at the first step of the 3-step *Staywell* test. The similarity of marks and that of the corresponding goods or services have been described as "threshold questions" embodying "necessary but not sufficient conditions" under section 8(2)(b) (*Staywell* at [65]). As the "necessary" condition of marks-similarity has not been met, the inquiry effectively ends here and the Opponent fails under section 8(2)(*b*) of the Act.

44 There is therefore no necessity to conduct an analysis of the remaining two steps of the three-step *Staywell* test. I will, however, leave a few brief comments below before proceeding to the remaining grounds of opposition.

Step 2: Goods/services-similarity

45 At the hearing, the Applicant's counsel accepted that the respective Class 3 goods and Class 44 services claimed under the Earlier Marks and the Class 44 services claimed under the Application Mark are similar.

46 This must be correct, at least with respect to services where there is the most clear cut identity beyond similarity. As indicated earlier, among the Earlier Marks, I focus on Trade Mark Nos. 40202006489X and T1402223E as they cover Class 44, the same class of services claimed by the Application Mark. The particular services claimed by parties, such as beauty care and skin care

services, clearly overlap. Additionally, the Class 3 goods claimed under certain of the Earlier Marks, such as skin care, body care and hair care products, are likewise similar to the Applicant's claimed beauty care and skin care services.

47 As this element is not an issue in dispute, we move on to the final element of "likelihood of confusion" in Step 3 of the *Staywell* test.

Step 3: Likelihood of confusion

48 In relation to the third step of the *Staywell* test, I briefly comment on a factor relating to the impact of similarity of services only in *obiter*, seeing as the Opponent has not established marks-similarity as a threshold requirement.

49 For some context, the Court of Appeal in *Staywell* considered permissible and impermissible extraneous factors in [95] and [96]. It set out, at [96], a non-exhaustive list of factors which are admissible in the confusion inquiry in the third step of the 3-step test. These include the degree of similarity of the marks themselves, the reputation of the marks, the nature of the goods (without implicating any steps that are taken by the trader to differentiate the goods) – which in turn includes the circumstances under which consumer would purchase the goods; the price of the goods given their nature; among other factors.

Nature of the goods and services and circumstances under which they are normally purchased

50 As considered above under goods-similarity, the goods and services in common between the relevant specifications of the competing marks are Class 3 goods, such as skin care, body care and hair care products; and Class 44 services such as beauty care and skin care services. According to the guidance in *Staywell*, at [96(b)], one considers the nature of such goods and services,

including "the normal way in or the circumstances under which" they are purchased and "whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers".

51 The Applicant submits that consumers would be "highly mindful" of the origin and quality of what they apply to their skin, face or body. Consumers, according to the Applicant, would have preferences and exercise deliberate care in selecting their brands of such products. They would thus be attentive to labelling and brand identity, lowering the risk of confusion.

52 The Opponent understandably avoided representations along the above lines which tend towards the conclusion that the likelihood of confusion is low. Instead, it made representations to highlight similarities between the parties and/or between players in the beauty care and skin care industry.

53 First, it submits that the Opponent and Applicant both use technology in conjunction with the goods and services. The Opponent refers to its "Lush" mobile application, which, in 2025, had at least two daily active devices per day which used it; 31 active devices in a month which used it; and more than 2,500 app usage sessions. As described in the introduction, the Applicant uses proprietary software that apply AI-driven medical image recognition algorithms to analyse dermatological and trichological conditions from images of the customer's skin and scalp. The Opponent claims that consumers may reasonably expect something like the Applicant's AI-powered tool to be offered by the Opponent, thus leading to confusion.

54 Second, the Opponent submits that it is common commercial practice in the personal care industry to launch product variants using extensions of their

brand name. As such, consumers who encounter the Application Mark are likely to perceive it as a brand extension of "LUSH".

55 Third, the Opponent has often engaged in third party collaborations to release limited edition products, with partners and brands such as "Mario", "Barbie", "SpongeBob", "Shrek" and "Minecraft". Consumers would likely be confused that the Application Mark is used as part of such brand collaborations.

56 At the hearing, I asked the Opponent's counsel whether her first and third points above engage impermissible extraneous factors. To recapitulate, in *Staywell* at [95]:

> The impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps. In other words, factors which are not inherent in the goods, but are susceptible to changes that can be made by a trader from time to time, should not be permissible considerations. In particular, we are satisfied that it is unnecessary, unworkable and impermissible for the court to have regard to such issues as pricing differentials, packaging and other superficial marketing choices which could possibly be made by the trader. In contrast, extraneous factors that relate to the *purchasing practices* and *degree of care* paid by the consumer when acquiring goods of the sort in question, can be considered and assessed without descending into the details of particular differentiating steps which the trader might choose to take in relation to the goods and services falling within the specification.

57 The Opponent's counsel responded that the use of technology is part of the inherent circumstances in which the Opponent's consumers use its goods and services and should be allowed in consideration. Likewise, third party collaborations are the normal circumstances under which consumers buy its goods.

58 The fact that both parties use technology in conjunction with the respective goods and services; and the Opponent's specific third party

collaborations to release limited edition products such as "Mario Shower Gel", "Barbie Pink Shampoo", "Squidward Bubble Bar", "Get Outta My Swamp Shower Slime" and "Lava Block Bath Bomb" come across as prime examples of what the Court of Appeal in *Staywell* cautioned against taking into account. These features are "not inherent in the goods" nor services; they are incidental and related to the Opponent's marketing and promotional choices. Skin care, body care and hair care products; and beauty care and skin care services; as generally claimed in the parties' relevant specifications can just as well be marketed, selected, purchased or provided without the use of technology such as mobile apps and AI software; and without branding collaborations with third parties. These features should therefore not be factors in assessing the likelihood of confusion (and should not be relied on to argue for an increased likelihood of confusion).

59 On the Opponent's second point above on product variants and brand extensions, I asked for examples from the evidence to support this claim that it is common commercial practice. The Opponent's counsel acknowledged that she did not have the evidence on hand, but claimed that it was a general practice.

60 In the strategic context, I appreciate that by this second point, the Opponent would have me infer that consumers who encounter the Application Mark, "LUSHAIR", are likely to perceive it as a brand extension of "LUSH", which adds to the likelihood of confusion. However, I would be cautious about drawing conclusions without the support of evidence that this is indeed the case in the industry.

61 Even if the Opponent had adduced evidence of its own brand extension exercises, one business doth not an industry make, and I would be slow to count this as a factor towards a greater likelihood of confusion. I am also mindful

about overstepping the boundary of permissible extraneous factors into impermissible ones which usually entail specific marketing choices made by an opponent itself, and not traders generally in the industry arising from the nature of the goods and services themselves.

62 Having considered the parties' representations on the likelihood of confusion, I make just a few remarks on the relevant similar goods and services, e.g. skin care, body care and hair care products; and beauty care and skin care services.

63 There is a range of consumers who select and purchase such goods and services. They could be those who are not highly particular about the personal goods and services applied to their bodies as long as a minimum standard of safety and hygiene is met (and guaranteed by the trade mark in question functioning as a badge of origin). Alternatively, they could be among the class of more discerning consumers who research more deeply into different brands of goods and services, understand their different value propositions and their own personal needs, and assess whether the goods and services meet their specific wants and requirements. Wherever a consumer is along this spectrum, one can safely expect that the degree of care exercised in the selection and purchase would *on the whole* be significantly higher than that of someone in a hurry who is indifferent, or minimally mindful, to which brand is chosen. The range of prices also varies, from budget goods and services to costlier ones at the higher end of the industry. The selection process also varies in real life, as the products may be off-the-shelf items as found in supermarkets, convenience stores and drugstores; or sold at dedicated counters where consumers would be assisted by a knowledgeable salesperson and have the opportunity to be slowly exposed to a brand's differentiated features from other brands. The latter

scenarios would mitigate against a likelihood of confusion, *i.e.* the likelihood of confusion is more unlikely than likely.

Conclusion on likelihood of confusion

64 Thus, for a moment not considering that marks-similarity was not found at the first step of the *Staywell* test, the Opponent would still fail at the third step of the test because there is no reasonable likelihood of confusion.

65 The nature of the goods and services, such as skin care, body care and hair care products; and beauty care and skin care services; which are all personal, would tend to involve a degree of thought and care in the selection and purchase such that consumers are less likely to be confused than confused.

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

66 The Opponent has not established that the competing marks are more similar than dissimilar. Even if it had, it would not be able to establish a likelihood of confusion. The ground of opposition under section 8(2)(*b*) therefore fails.

Ground of opposition under section 8(4)

67 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.

Application of section 8(4) to the facts

68 Sections 8(2)(*b*), 8(4)(*b*)(i) and 8(4)(*b*)(ii) have in common the need for marks-similarity. *Bytedance Ltd* v *Dol Technology Pte Ltd* [2024] SGIPOS 5 ("*Bytedance*") at [31] summarises as follows:

> (c) However, in all cases, there is a threshold requirement that the Application Mark must be similar to the earlier trade mark relied on by the Opponent (see [28(b)] above): see Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA [2013] 1 SLR 531 ("Sarika") at [70]–[71].

69 The condition relating to marks-similarity in section 8(4) is worded as "the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark".

70 Having found under section 8(2)(*b*) that the Application Mark and the Earlier Marks are not similar (neither are they identical), I likewise find that "the whole or an essential part of" the Application Mark is not "identical with or similar to" the Earlier Marks.

Conclusion on opposition under section 8(4)

71 The requisite element of marks-similarity is not established. The ground of opposition under section 8(4) therefore fails.

Ground of opposition under section 8(7)(*a*)

72 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
>
> …

73 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 summarised, at [28], that:

> … the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty* at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712 ("*Nation Fittings*") at [148]).

74 It is clear from the above that misrepresentation is an essential element of the tort of passing off.

Application of section 8(7)(*a*) to the facts

75 Under section 8(2)(*b*), I have found that the competing marks are not similar. Neither would there be a likelihood of confusion among the relevant consumers. Accordingly, because of these findings, the Opponent would also not establish the element of misrepresentation under section 8(7)(*a*).

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

76 The ground of opposition under section 8(7)(*a*) necessarily fails.

Overall conclusion

77 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails under all grounds. The Application Mark may proceed to registration.

78 Having considered the parties' submissions and HMD Circular 6.1 at Part F, I award costs to the Applicant as follows:

(a) Party and party costs: $6,690.00

(b) Disbursements: $1,360.00

The Applicant had claimed $700.00 as disbursements for official fees to request for the grounds of decision. This appears to be in respect of Form HC5 "Request for grounds of decision", which only applies under Trade Marks Rules 24(6)(*a*) or 67A(8)(*a*) and not in the present case. This item of disbursement is therefore not approved. For the avoidance of doubt, the Applicant had not in fact paid $700.00 in official fees to request for the grounds of decision. Instead, it paid and is now awarded costs for $360.00 for filing Form HC6 "Counter-statement" and $1,000.00 for filing Form HC1 "Hearing and decision". The total assessed costs to be paid by the Opponent to the Applicant are $8,050.00.

See Tho Sok Yee
Principal Assistant Registrar

Foo Maw Jiun, Ng Ah Sock, Angie (Huang Ashu) and Ryan Teo Rui-An (Rodyk IP) for the Applicant;
Tony Yeo and Yuen Kit Kuan (Drew & Napier LLC) for the Opponent.