

**IN THE GENERAL DIVISION OF
THE HIGH COURT OF THE REPUBLIC OF SINGAPORE**

[2025] SGHC 51

Tribunal Appeal No 1 of 2025

In the matter of Singapore Trade Mark
Application No. 40201816175S-02 and
40201816175S-01 in Class 5, 29, 30 and 35 in the
name of Sunrise Plus (Pte) Ltd

And

In the matter of an opposition thereto by The
Sunrider Corporation dba Sunrider International

Between

Sunrise Plus (Pte) Ltd

... Appellant

And

The Sunrider Corporation dba
Sunrider International

... Respondent

JUDGMENT

[Intellectual Property — Trade mark and trade names — Relative ground for refusal — Similarity to earlier registered trade mark]
[Intellectual Property — Trade mark and trade names — Relative ground for refusal — Passing off]

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Sunrise Plus (Pte) Ltd
v
The Sunrider Corp dba Sunrider International

[2025] SGHC 51

General Division of the High Court — Tribunal Appeal No 1 of 2025
Kwek Mean Luck J
13 March 2025

26 March 2025

Judgment reserved.

Kwek Mean Luck J:

Introduction

1 This is an appeal against the decision of the Principal Assistant Registrar (“PAR”) of the Intellectual Property Office of Singapore to allow the Respondent’s opposition to two of the Appellant’s trade mark applications. The PAR’s decision is published at *Sunrider Corporation dba Sunrider International v Sunrise Plus (Pte) Ltd* [2024] SGIPOS 9.

Background

2 The Appellant had applied to register trade marks in Class 5, 29, 30 and 35 as set out below:

Application Mark	Specifications
	Class 5: Nutritional supplements for humans; Nutritional supplement energy bars; Dietary and nutritional

40201816175S-02	supplements; Powdered nutritional supplement drink mixes; Powdered nutritional supplement energy drink mixes; Dietetic substances adapted for medical use, dietetic foods and beverages; dietary supplements; functional foods and supplemental foods in this class; nutritional supplements; nutritional additives and supplements; vitamins and vitamin formulations for human consumption; minerals and mineral formulations for human consumption; casein dietary supplements; milk protein; casein; proteins; protein bars; excluding liquid herb concentrates and <i>none of the foregoing being in the nature of herbal drinks included in Class 5.</i> (emphasis added)
 40201816175S-01	Class 29: Dairy products; protein products for human consumption, namely, protein milk; protein soybased bars; yoghurt, drinking yoghurt and yoghurt preparations; preserved food products of vegetables; preserved food products of fruits; preserved, dried or cooked fruits and vegetables; whey Class 30: Chocolate; Chocolate products and chocolate-based products; Dairy chocolates; Chocolate coated nuts or fruits; Chocolate coated fruits; Chocolate coated nuts; Dark chocolate; White chocolate; Milk chocolate; Filled chocolate; Filled chocolates; Chocolate confections; Chocolate candies; Chocolate powder; Chocolate sauce; Chocolate-based spreads with or without nuts; Chocolate confectionery containing pralines; Pralines made of chocolate; Chocolates with mint flavoured centres; Chocolate confectionery having a praline flavour; Chocolates in the form of pralines; Cocoa; Cocoa products; Cocoa mixes; Cocoa spreads; Cocoa powder; Instant cocoa powder; Coffee; coffee flavorings; Flavouring syrups for use in coffee espresso and/or cappuccino; Chocolate-covered coffee beans; Chocolate bark containing ground coffee beans; Chocolate bars; Chocolate-based bars; Chocolate coated nougat bars; Chocolate-based meal replacement Bars; Foodstuffs containing principally of chocolate; Chocolate-based ready to-eat food bars; high-protein cereal bars; high-energy cereal bars; coffee or cocoa-based beverages with or without milk; tea; coffee-based beverages; chocolate based beverages; beverages made from chocolate;

	chocolate drink preparations; chocolate beverages with milk; Spices; Powdered spices; Mixed spices; Marinades containing spices.
	Class 35: Promotional Services; Online market place services; Retail services; Distribution services, namely, wholesale services; Distribution services, namely, wholesale services featuring a wide variety of consumer goods including sports related goods, sporting equipments, sporting articles, footwears, foodstuffs, clothing, bags, exercise equipments, health supplements and health foods, including through means of the Internet and the world wide web; Promotion of goods and services through sponsorship of events and competitions; Promotion of sports competitions and events; Promotions of sports personalities, sports goods and other consumer goods; Advertising and marketing including promotion of products and services of third parties through sponsorship arrangements and license agreements relating to a wide variety of consumer goods, sports events and sports goods; Retail and wholesale services in respect of dietetic foods, health food products, nutritional additives and supplements, vitamins and vitamin formulations for human consumption, minerals and mineral formulations for human consumption, herbal supplements and formulations for human consumption, spreads, proteins and protein products for human consumption, probiotic products, casein, including the retailing and wholesaling of such goods via the Internet and the world wide web; information, consultancy and advice in relation to the aforesaid services.

3 The applications were opposed by the Respondent. The earlier mark relied on by the Respondent was:

Trade Mark	Reg No.	Specification of Goods
S U N R I S E	T9300374C ("Respondent's Earlier Mark")	<u>Class 5</u> "Herbal drinks included in Class 5". ("Respondent's Goods")

4 The PAR allowed the Respondent's opposition against:

(a) the Appellant’s trade mark Application No. 40201816175S-02 in Class 5 under ss 8(2)(b) and 8(7)(a) of the Trade Marks Act 1998 (the “Act”);

(b) the Appellant’s trade mark Application No. 40201816175S-01 in the Class 35 portion of multi-classes 29, 30 and 35 on grounds of ss 8(2)(b) and 8(7)(a) of the Act.

5 The PAR found no similarity for the Appellant’s trade mark applications in relation to Class 29 and 30. However, as there is no partial opposition whether within or in multi-class applications (*Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [75]¹), the PAR held that the Application Mark 40201816175S-01, as a whole, cannot proceed to registration.

Main issue on appeal

6 There are two main issues in this appeal:

(a) Whether the Appellant’s applications in Class 5 and 35 fall foul of s 8(2)(b) of the Act (the “Earlier Registered Mark ground”); and

(b) Whether the Appellant’s applications in Class 5 and 35 fall foul of s 8(7)(a) of the Act (the “Passing Off ground”).

Section 8(2)(b): Earlier Registered Mark ground

7 I will first address the Appellant’s submissions on the first main issue, regarding the ground under s 8(2)(b) of the Act. This provides that:

¹ This dealt with an edition of the Trade Marks Act 1998 which is materially the same as the one in force at the time of the Appellant’s application of their marks (*ie*, 16 August 2018).

(2) A trade mark must 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.

8 It is undisputed that the applicable test for this statutory provision is that set down by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”). Under this approach:

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

9 The Appellant does not contest the PAR’s decision in respect of the first requirement of similarity of marks but submits that the PAR erred in finding: (a) similarity of goods or services and (b) a likelihood of confusion.

Similarity of goods and services

10 I will first address the similarity of goods and services.

11 In *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”), Jacob J set out a list of factors to be taken into account, as a matter of general guidance, when assessing similarity of goods / services. These factors have been endorsed in *Staywell* at [43] and [82]. The factors are: (a) the respective uses of the goods / services; (b) the respective users of the goods / services; (c) the physical nature of the goods / acts of service; (d) the respective trade channels through which the goods / services reach the market; (e) 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; (f) the extent to which the goods / services are competitive; *British Sugar* at 296.

PAR's decision

12 In respect of the Appellant's application in relation to Class 5, the PAR found the following of the Appellant's notional goods of interest under Class 5 to be arguably similar to the Respondent's Goods under the Respondent's Earlier Mark:

Respondent's Earlier Mark	Application Mark
	40201816175S-02
Class 5 Herbal drinks included in Class 5	Class 5: <i>Nutritional supplements for humans; Dietary and nutritional supplements; dietary supplements; nutritional supplements; nutritional additives and supplements; vitamins and vitamin formulations for human consumption; minerals and mineral formulations for human consumption...</i>

13 The PAR found that applying the *British Sugar* factors, the uses and physical nature of the goods are similar, while the users and nature of the goods (whether they are complimentary or competitive), as well as the trade channels, including the shelves on which the goods are displayed in the supermarket, are neutral factors. I elaborate below.

14 Respective uses of the goods: The Appellant submitted before the PAR that the main objective of dietary supplements is to fill gaps in an individual's

nutritional intake. While the Respondent's good has medicinal or therapeutic benefits, they are not intended to replace or augment the daily intake of vitamins and minerals. They are not dietary supplements. The PAR disagreed and found that the meaning of "dietary supplement" is not as narrow as submitted by the Appellant. The dictionary meaning is "a product containing one or more vitamins, minerals or other substances that the body needs to be healthy". Britannica defines "dietary supplement" as "any vitamin, mineral, herbal product, or other ingestible preparation that is added to the diet to benefit health". The Health Sciences Authority ("HSA") defines a "health supplement" as "a product that is used to supplement a diet and to support or maintain, enhance, and improve the healthy functions of the human body". While the HSA definition relates to "health supplement" rather than "dietary supplement", the PAR was of the view that they are in principle similar. It is artificial to draw a distinction between supplementing nutritional intake versus offering medical benefits, and between natural versus synthetic sources. The PAR hence found that there is an overlap in relation to uses and the physical nature of the goods.

15 Respective users of the goods and whether the goods are competitive: The Appellant had submitted that consumers who seek out herbal products are typically more inclined towards natural, plant-based remedies and are often concerned with avoiding synthetic chemicals or pharmaceutical ingredients. The PAR was of the view that this is only one segment of the consumers of the Respondent's product, and that this *British Sugar* factor is neutral. Similarly, depending on the type of consumer (whether they are sensitive to sources of the products), the goods can be complementary or competitive.

16 Respective trade channels: The PAR was of the view that the "trade channel" is a neutral factor. The PAR noted that the Respondent operates pursuant to an exception under the Multi-Level Marketing and Pyramid Selling

(Prohibition) Act 1973. There will be entities which focus only on natural-based health products while there will be others which produce health preparations both from natural and synthetic sources. The good can also be found in supermarkets. While not on the same shelves, they are likely to be found in the same aisle.

17 In respect of the Appellant’s application in relation to Class 35, the PAR found that the Appellant’s services of interest are arguably similar to the goods for the Respondent’s Earlier Mark is registered for. The notional services found by the PAR to be arguably similar were:

Retail...services in respect of dietetic foods, health food products, nutritional additives and supplements, vitamins and vitamin formulations for human consumption, minerals and mineral formulations for human consumption, herbal supplements and formulations for human consumption [...] including the retailing [...] of such goods via the Internet and the world wide web.

18 The PAR found support for this in *Guccio Gucci S.p.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“*Guccitech*”). This decision cites Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* (3rd ed, 2014) (“*Law of Trade Marks and Passing Off in Singapore*”), where the learned author stated at [8.115], that goods and services can be similar to each other, in the instance “where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such”.

Appellant’s case

19 Respective uses of the goods: The Appellant submits that if broadening the scope of “Treat” to include spreads was not permissible in *British Sugar*, then a similarly restrictive approach must be taken when considering whether

the Respondent's "Herbal drinks included in Class 5" extends to include other goods not properly within this category.

20 From a natural and ordinary reading of the Respondent's Goods, the goods are characterised as follows: (a) the predominant ingredient must be that of medicinal herbs; (b) while the ingredient has medicinal properties, its main purpose of use is to improve mental and physical performance; and (c) the nature of delivery must be in a ready-to-drink format.

21 Herbal medicinal drinks cannot be said to be a kind of dietary or nutritional supplement, because one cannot be said to lack herbs in the human body. This is unlike cases where people lack Vitamin D or other essential elements found naturally in foods ingested by humans.

22 The Respondent's Goods are akin to Chinese medicinal herbs, used to restore balance to the body's energy and to treat conditions of weakness and disharmony found in the system. They are in a separate category when compared with dietary supplements such as vitamins and minerals. A consumer familiar with the Respondent's Goods would not regard other types of dietary or nutritional supplements as being substitutable.

23 In *The Sunrider Corporation v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-221/12) it was held that "the main purpose of consuming 'herbal nutritional supplements' in Class 5 is not to quench thirst or to form part of standard human nutrition, but rather in order to prevent or remedy medical problems in the broad sense of the term or to balance nutritional deficiencies".

24 The PAR should not have analysed herbal medicinal drinks as having the purpose of “improving health” and then finding an overlap in relation to the uses of the goods in the class. In *British Sugar*, it was not in dispute that a spread could also be used as a dessert sauce. However, the court held that someone looking for a syrup for ice-cream would specifically look for that and would not regard a spread as being substitutable.

25 Respective users of the goods and whether the goods are competitive: Someone looking for vitamins would not be looking at medicinal herbal drinks as a potential substitute. Nutritional supplements are often used for targeted health objectives. As such, users are looking for specific products and not just anything that can improve their health. Even in cases where consumers encounter these products without a predetermined intent to purchase, their decision-making process remains highly specific. They do not indiscriminately substitute one health-related product for another. Purchasers of the Respondent’s Goods ostensibly seek a boost of energy. In contrast, the Appellant’s goods in Class 5 are for the purpose of steady supplementation of the diet.

26 As to the Class 35 objection, the Appellant submits that the goods in Class 5 and services in Class 35 are not similar. It is possible for goods and services in Class 35 to be ruled as being similar. The normal situation where this can be found concerns a trade mark registered for clothing in Class 25 or cosmetic products in Class 3. The present case is in stark contrast. This is because the Respondent’s mark is only for one type of product, and not a whole slew of different health products in Class 5.

Respondent's case

27 The Respondent agree with the PAR that to narrow the meaning of “dietary supplement”, as suggested by the Appellant, would be unnecessarily restrictive.

28 Further, the Respondent substantially agree with the PAR’s finding that the *British Sugar* factor of users of goods is neutral. Depending on the type of consumer (whether they are sensitive as to the sources of the products), the goods can be competitive or complementary. There is a degree of overlap between the respective users of the goods under the Respondent’s Earlier Mark and those under the Appellant’s application in Class 5. Both target health-conscious consumers who are looking to improve their well-being through natural or nutritional products.

29 With respect to the Appellant’s application in Class 35, the Respondent agree with the PAR’s reliance on the case of *Guccitech*, and further raise that *Guccitech* was also cited with approval in *Daidoh Limited v New Yorker S.H.K. Jeans GmbH & Co. KG* [2018] SGIPOS 18 (“*Daidoh Limited*”) at [32].

Decision

30 The Appellant’s submissions on its application in Class 5 centre around two of the *British Sugar* factors, namely: (a) the respective uses of the goods / services and (b) the respective users of the goods / services.

31 Respective uses of the goods: While the Appellant relies on the distinction made in *British Sugar* between spreads and syrup, that does not assist the Appellant. That examination was in relation to the market conditions, consumer perceptions and trade practices specific to the goods in question in

British Sugar. The goods to be differentiated here are substantially different and lead to a different inquiry.

32 At the hearing, I invited counsel for the Appellant to frame the relevant inquiry. She submitted, and I accept, that it is whether the Appellant’s goods, which are a nutritional and dietary supplement, are similar to “Herbal drinks included in Class 5”, which the Respondent’s Earlier Mark had been registered.

33 On this, the Appellant submits that dietary or nutritional supplements must mean supplements which provide some type of essential element found naturally in foods ingested by humans, such as vitamins or minerals. Since herbs are not lacking in the human body, herbal medicinal drinks cannot be said to be used as dietary or nutritional supplements.

34 The Court of Appeal in *Staywell* provided the following guiding principle at [41]:

41 ... We adopt the view that while “trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise ... **[w]here words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question**”. [emphasis added]

35 At the hearing, parties agreed that following *Staywell*, consideration should be given to the ordinary and natural meaning of “nutritional or dietary supplement” and “herbal drinks”, to identify the notional uses of the goods.

36 The PAR, in determining the uses of the goods, took into account the dictionary meaning and the Britannica definition of dietary supplement, as well the HSA’s definition of health supplement; see [14] above. These provided

wider definitions than what the Appellant had submitted below and reiterates at this appeal. The PAR then concluded that it is artificial to draw a distinction between supplementing nutritional intake versus offering medical benefits, and between natural versus synthetic sources.

37 A further examination of the ordinary and natural meaning of the relevant phrases reinforces the PAR’s conclusion. The Oxford English dictionary defines “nutrition” as the “action of supplying, or receiving, nourishment or food”.² The Cambridge dictionary defines “nutrition” as “the substances that you take into your body as food and the way that they influence your health”.³ None of these definitions suggests that “nutrition” is limited to the provision of vitamins or minerals to the body, which is the Appellant’s case. The Medical Dictionary defines “Nutritional Supplements” as including “vitamins, minerals, herbs, meal supplements, sports nutrition products, natural food supplements, and other related products used to boost the nutritional content of the diet”.⁴

38 When the above dictionary definitions of “nutrition” were highlighted to counsel for the Appellant at the hearing for her views, she initially submitted that nutritional supplements could indeed include health foods, but only if used in a loose sense. When queried whether it is used in a loose sense if it is a dictionary meaning, she then submitted that dictionary meanings should not dictate what the meanings are.

² Oxford English Dictionary, “Nutrition” <oed.com> (13 March 2025).

³ Cambridge Dictionary, “Nutrition” <dictionary.cambridge.org> (13 March 2025).

⁴ Medical Dictionary, “Nutrition” <medical-dictionary.thefreedictionary.com> (17 March 2025).

39 I accept that dictionary meanings should not dictate what the meaning of the relevant phrases are, but *Staywell* at [41] has emphasised consideration of the “ordinary and natural meaning”, and it is undisputable that dictionary meanings do help to illuminate what is the “ordinary and natural meaning” of the phrases. All the more so when the Appellant is unable to point to any other source from which it draws its narrower definitions.

40 In summary, a scan of the definitions of “nutrition” and “nutritional supplements” reinforces the wider definitions of “dietary supplements” identified by the PAR. They indicate that the ordinary and natural meaning of “nutritional and dietary supplements” are not as narrow as the Appellant submits, to only include supplements that provide vitamins and minerals.

41 Counsels had not submitted on the ordinary and natural meaning of “herbal drink”, but I also explored this with them at the hearing. The Oxford English dictionary defines “herbal” as “consisting of, or made from herbs”.⁵ The Cambridge dictionary similarly defines “herbal” as “relating to or made from herbs”.⁶ A herbal drink would hence be a drink consisting of or made from herbs.

42 Counsel for the Appellant submitted that since the Respondent’s Earlier Mark is registered in Class 5, the herbal drink must also have medicinal / therapeutic properties. I accept that for present purposes, the herbal drink must be related to the properties in Class 5. However, it is not apparent from the Nice classification that the specifications in Class 5 are those containing only medical / therapeutic properties. Certainly, the Appellant does not take the position that

⁵ Oxford English Dictionary, “Herbal” <oed.com> (13 March 2025).

⁶ Cambridge Dictionary, “Herbal” <dictionary.cambridge.org> (13 March 2025).

their goods, which are sought to be registered in Class 5, contain medical / therapeutic properties. There is no dispute that the “Herbal drinks in Class 5” would minimally have health benefits. In this respect, there is an overlap between definition, and hence uses, of “nutritional and dietary supplements” and “Herbal drinks in Class 5”.

43 I further note that even if I accept that “Herbal drinks in Class 5” must contain medical / therapeutic properties, counsel for the Appellant accepted at the hearing, that “medical properties” are not limited to supplementing of vitamins or minerals, but includes effects on the biochemical process of the body in a positive manner.

44 Thus, even on this narrower understanding of “Herbal drinks in Class 5” (as including medical properties), the uses, as derived from the ordinary and natural meaning of “nutritional supplements” would also overlap with “Herbal drinks in Class 5”, since both relate to the intake of substances that influence the health of the body.

45 I go further to note that even if I accept the Appellant’s case that “nutritional supplements” are limited to only those that provide vitamins and minerals, that would still not exclude “Herbal drinks in Class 5”. It is the Appellant’s case that herbal drinks do not contain vitamins. However, as set out above, the ordinary and natural meaning of “herbal drinks” are drinks that consist of or are made from herbs. As shared with counsels at the hearing, the website of the Michigan State University indicates there are a variety of herbs

that provides vitamins, such as vitamins A, C and K.⁷ Checks on other sources indicates this to be a consistent view.

46 Counsel for the Appellant pointed out that the Respondent’s good does not appear to contain ingredients that provide vitamins or minerals. However, the Respondent highlighted that in an advertisement in 2015 for one of the products under the “Sunrise” mark, it is claimed that the product “delivers a wealth of vitamins and antioxidants”.⁸ The registered product would also fall within the Appellant’s narrower definition of nutritional or dietary supplement.

47 In any event, the proper inquiry is not whether the Respondent’s good in particular is a nutritional and dietary supplement, but as counsel for the Appellant had framed it, whether a nutritional and dietary supplement is similar to “Herbal drinks included in Class 5”, such that their uses are similar. In this respect, it would be useful to recall the observations made by the Court of Appeal in *Staywell* at [58]:

58 ... once the applicant has registered his trade mark, he acquires the exclusive right to use the mark not only for the goods and services which he might have actually contemplated at the time registration was granted, but for the whole spectrum of goods and services within the specification for which the mark is registered. The proprietor is entitled to sue for infringement if anyone uses an identical or similar sign on goods which are identical or similar to goods or services falling within the specification for which his mark is registered, even if he does not actually supply that good or service at the material time

48 I hence find that, on the ordinary and natural meaning of the phrases, the uses of “nutritional and dietary supplements” are similar to the uses of “Herbal

⁷ Sarah Rautio & Michigan State University Extension, “Increase intake of fresh herbs for everyday health” <www.canr.msu.edu> (13 March 2025).

⁸ Bundle of Documents (“BOD”) at p 281.

drinks included in Class 5”. To say that the uses of “Herbal drinks included in Class 5” are not similar, simply because they allegedly do not provide vitamins and minerals, would be straining the language of “nutritional and dietary supplements” unnaturally and unjustified. In any event, it also does not appear that it could be said that herbal drinks do not provide vitamins and minerals.

49 I turn next to the other *British Sugar* factor that the Appellant submitted on in respect of the similarity of goods and services, namely the respective users of the goods.

50 Respective users of the goods and whether the goods are competitive: At the appeal, the Appellant reiterates the submission it made before the PAR, that consumers who look for nutritional supplements look for specific products and would not consider medical herbal drinks a potential substitute. Even consumers without a predetermined intent to purchase would be highly specific in making their decisions. The PAR had addressed this by noting that the consumer segment referred to by the Appellant is only one segment of the consumers of the Respondent’s product. Depending on the type of consumer (whether they are sensitive to sources of the products), the goods can be complementary or competitive. The PAR hence found this *British Sugar* factor to be neutral. This is a valid observation, and one which the Appellant has not shown to be wrong.

51 In summary, I find that there is similarity of goods between the Respondent’s Earlier Mark and the Appellant’s application mark in Class 5.

52 In relation to the Appellant’s application in Class 35, the principle which the PAR relied on, citing *Guccitech*, is that that goods and services can be similar to each other, in the case where the earlier mark is registered for retail

services of certain goods and the mark applied for is registered for those goods as such.

53 In *Guccitech*, the learned Professor David Llewelyn (sitting as IP Adjudicator) held at [35]:

35 As far as the specification of services in T1319783Z is concerned, the Opponent cites Tan, *Law of Trade Marks and Passing Off in Singapore* (3rd ed, 2014) at [8.115] that:

“goods and services can also be regarded as similar to each other. This will, for instance, be the case where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods as such, and vice versa”.

I would respectfully agree with the general view expressed by the learned author Mr Tan Tee Jim SC, although I consider that the example given is the only circumstance where goods could be found to be similar to the retail services in a specification (it cannot be the case that a general retail services specification that does not refer to any particular goods must be regarded as similar to any goods that may be sold in a retail outlet.)

54 It was also observed in *Daidoh Limited* at [33] that the above proposition finds support in *British Sugar* at 297, where Jacob J remarked: “I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance).”

55 *Guccitech* relates to a case where the earlier mark is registered for retail services of certain goods and the mark applied for is registered for those goods, whereas in this instance, the earlier mark is registered for a certain goods and the mark application for is for the retail services of certain goods. However, it follows as an extension of the logic in *Guccitech*, that the principle applies even in the vice-versa situation. This was also the analysis in *Daidoh Limited* at [31]–[32].

56 The Appellant does not challenge this principle, but submits that it does not apply here because the Respondent’s mark is only for one type of product, and not a whole slew of different health products in Class 5. However, there was no such limitation in *Guccitech*. It is also not apparent as a matter of principle why such a distinction would make a difference, since the earlier mark was registered in relation to a class of goods in Class 5, and not a singular product.

57 At the hearing, the Appellant advanced a different argument, that *Guccitech* only applies where the retail store has the same brand as the goods. However, neither *Guccitech* nor the *Law of Trade Marks and Passing Off in Singapore* which *Guccitech* cited contain such limitations. Neither did the Appellant provide any principled reason why there should be such a limitation. The Nice classification for Class 35 certainly does not contain such limitations, as its specifications includes “Retail services”, “Distribution services” and “Promotion services” generally.

58 I hence find that there is similarity of goods and services between the Appellant’s application marks in Class 35 and the Respondent’s Earlier Mark.

59 In summary, I find that there is similarity of goods and services between the Appellant’s application marks in Class 5 and 35 and the Respondent’s Earlier Mark.

Likelihood of confusion

60 I turn next to the issue of likelihood of confusion, which is the third element of the test in s 8(2)(b) of the Act.

PAR's decision

61 When assessing the element of similarity of marks, the PAR held that the marks are visually and conceptually similar to a large extent and aurally identical, such that the marks are overall more similar than dissimilar. The Appellant did not appeal against the PAR's decision on this element.

62 With respect to the likelihood of confusion, the PAR found that as the marks pertain to goods which are sold via retail, it is the visual and conceptual aspects which take precedence. In *Twitter, Inc v VV Technology Pte Ltd* [2022] SGIPOS 4 ("*Twitter*") the PAR there had commented that consumers may perceive an economic link between the two marks, either as a new iteration or as a modified mark that is used for closely related goods which are extensions of the existing range of good. The PAR was of the view that the same two types of confusion can occur here, given the extent of similarities between the marks.

63 The PAR found that the Respondent has not discharged its burden of proof to show that the Respondent's Earlier Mark enjoys reputation on the local market. However, as most of the evidence filed by the Appellant pertain to sporting goods, the Appellant also has not shown reputation relevant to the goods / services.

64 Taking into account the overall impression as well as possibility of imperfect recollection, the PAR found that the respective marks are similar to a large extent. This leans towards a finding that there is a likelihood of confusion. The PAR agreed with the Appellant that consumers are more likely to be cautious when purchasing goods from Class 5, but was of the view that the high degree of similarity of the marks and the goods / services are such that it is not

sufficient to dispel confusion. This analysis also applies to Class 35. The PAR thus found that there is a likelihood of confusion.

Appellant's case

65 The Appellant submits that the degree of similarity between the respective goods is very low.

66 In *Staywell*, the Court of Appeal set out at [96] the following non-exhaustive extraneous factors when assessing similarity:

(a) *Factors that affect the impact of mark similarity on the consumer*: the degree of similarity of the marks themselves, the reputation of the marks, the impression given by the marks and the possibility of imperfect recollection;

(b) *Factors that affect the impact of goods similarity on the consumer*: these include the normal way in or the circumstances under which consumers would purchase goods of that type, whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of attention on the part of the purchaser, and the likely characteristics of the relevant consumer and whether the relevant consumers would or would not tend to apply care or have specialist knowledge in making the purchase.

(1) Factors relating to the impact of mark similarity

67 Degree of the similarity of the marks: The Appellant submits that while the word “Sunrise” appears in both marks, undue weight should not be given in the mark similarity analysis, as the word “Sunrise” possesses a low level of

distinctiveness. “Sunrise” is a common English word that symbolises new beginnings, optimism, and renewal. The sign “Sunrise” is not highly original and striking. Consumers in Singapore are accustomed to seeing various brands and marks which utilise the prefix “Sun”. For example, “Sunshine” for bread, “Sunkist” for oranges, “Sun-maid” for raisins, “Sunfresh” for orange juice and “Sunlight” for soap.

68 Reputation of the marks: The Appellant submits that it is associated with this mark in the sports business, where they have been present locally since the late 1950. It is possible that consumers are familiar with the “Sunrise” company, which has been representing YONEX and MIKASA in Singapore for decades. Consumers will likely associate a range of nutritional and dietary goods with the Appellant, since health foods are closely related to sports merchandise.

69 Impression given by the marks and the possibility of imperfect recollection: Although the dominant element is still the word “Sunrise”, this possesses a low to at best an average level of distinctiveness. The consumer will notice the Sun in Splendour device, which adds another layer of caution in the consumer’s mind.

(2) Factors relating to impact of goods-similarity

70 Degree of similarity of the goods: The Appellant submits that the degree of similarity of goods is low. In Singapore, tonics and medicinal teas are predominantly sold in dedicated herbal tea outlets. In general pharmacies, supermarket aisles or health food stores, one may not even find any herbal medicinal drinks.

71 Nature of the goods and services / Characteristics of the relevant consumer perceiving the relevant goods and services: Herbal medicinal drinks

occupy a different compartment in the consumer’s mind. Consumers of herbal drinks value holistic wellness, often opting for natural remedies over pharmaceuticals. They exercise higher level of scrutiny. Consumers would not regard dietary or nutritional supplement as substitutable. The recollection and association of the consumer in this case is enhanced in that the Respondent’s Goods are only a single type of product i.e. a herbal medicinal drink.

72 Normal way in which goods and services are distributed to the consumer: The Respondent operates under a multi-level marketing model and distributes its goods through independent business owners who act as sales representatives. This relationship-driven sales approach ensures no likelihood of confusion. It is also common practice to use a distinct trade mark for each category or even individual product in the health products industry. The Respondent’s SD for Trade Mark Application No. 40201816175S-02 lists various trade marks for different types of products regarding “Sunbar” herbal food bar, “SunFit Protein Plus” smoothie, and “SunnyDew” herbal sweetener.

73 The Appellant’s case is that as there is no similarity between the Respondent’s Goods and the various Class 35 services, there is no need to go into the third enquiry as to likelihood of confusion for this class.

Respondent’s case

74 The Respondent agrees with the PAR that given the large similarities between the marks (and the goods and services), confusion can arise. The Application Marks could be seen as a new iteration or a modification of the Respondent’s Earlier Mark, that the Respondent is using for new goods which are extensions of the Respondent’s existing range of goods.

Decision

75 The proper approach to an inquiry in the likelihood of confusion was set out by the Court of Appeal in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 (“*Hai Tong*”) at [78]:

78 ... The likelihood of confusion required is that which is to be expected amongst a *substantial portion of the relevant segment* of the public. While not amounting to a majority, the relevant segment of the public must go beyond a “*de minimis*” level

(emphasis in original)

(1) Factors relating to the impact of mark similarity

76 Degree of the similarity of the marks: The PAR had considered the Appellant’s argument, reiterated in this appeal, that undue weight should not be given to “Sunrise”, as it is a common word. The Appellant had supported its submission below, by relying on *Monster Energy Company v Glamco Co, Ltd* [2021] 3 SLR 319 (“*Monster*”). There, the High Court held that the word “Monster” has a laudatory effect as to the effectiveness of the beverage in boosting energy. The PAR was of the view that the word “Sunrise” in relation to health-related goods in Class 5 can be distinguished from the word “Monster” in energy drinks. The Appellant also supported its submission below by referring to the state of the register which it claimed showed the low distinctiveness of the word “Sunrise”. The PAR noted that this was not adduced through evidence. In any event based on the Appellant’s table, the word “Sunrise” only appeared once in Class 5. This does not show low distinctiveness.

77 At the appeal, the Appellant did not submit that the PAR erred in distinguishing *Monster* or in finding that the state of the register did not support the Appellant’s claim. Instead, the Appellant relied on *Fair Isaac Corporation v LAC Co., Ltd.* [2022] SGIPOS 19 (“*Fair Isaac*”), where it was found that the

word “Falcon” which describes a bird which is very fast, has sharp eyesight and is highly intelligent, has laudatory connotations for goods and services relating to the prevention of fraud. The Appellant submits that this reasoning extends to the present case, where “Sunrise” is not an invented term but rather a common English word that symbolises new beginnings, optimism, and renewal.

78 I did not find that reliance on *Fair Isaac* and the word “Falcon” advances the Appellant’s case. The distinctiveness of a word is particular to that word and the relevant class of goods and services. Just as the word “Sunrise” in relation to health-related goods in Class 5 can be distinguished from the word “Monster” in energy drinks, similarly, it is distinguished from the word “Falcon” in prevention of fraud services.

79 The Appellant’s other argument is about the commonality of brands in Singapore markets with the pre-fix “Sun”. However, this does not mean that any brand starting with the pre-fix “Sun” is generic or that the word “Sunrise” has low distinctiveness in Class 5, since the brands that the Appellant refers to involve goods in different classes and mainly different words. The distinctiveness of a phrase has to be assessed within its particular class and market context. It is not apparent that consumer would be confused by the use of the pre-fix “Sun”, for example in relation to “Sunshine” for bread or “Sunkist” for orange juice, which are different products in different classes. As the PAR pointed out, the word “Sunrise” only appeared once in Class 5 in the state of register collated by the Appellant. This does not show low distinctiveness.

80 Reputation of the marks: The Appellant’s submission on the reputation of the marks is that its mark is associated with the sports business since the late 1950s and consumers will likely associate a range of nutritional and dietary goods with the Appellant, since health foods are closely related to sports

merchandise. However, this assertion that the Appellant's mark is associated with the sports business is not supported by any evidence. Neither is there any evidence to suggest that consumer would associate a mark for the sports business with health foods. In any event, as a matter of logic, it is also not clear that consumers would necessarily associate sports business with health foods.

81 Impression given by the marks and the possibility of imperfect recollection: The Appellant submits that the consumer will notice the distinctiveness of the Sun in Splendour device. The PAR had considered this and found in assessing visual similarity, that the Sun in Splendour device occupies at most a third of the Application mark. The overall component of the mark is still the word "Sunrise". This is not disputed by the Appellant.

82 The PAR had also held that given the extent of similarities between the marks, consumers may perceive an economic link between the two marks, either as a new iteration or as a modified mark that is used for closely related goods which are extensions of the existing range of good, relying on the decision in *Twitter*. The Appellant has not made any submission in rebuttal of this.

83 On the whole, I agree with the PAR's assessment that the marks are visually and conceptually similar to a large extent and aurally identical, and find that there is a high degree of similarity between the marks.

84 I turn next to consider the factors relating to the impact of goods and services similarity on the likelihood of confusion.

(2) Factors relating to impact of goods and services similarity

85 Degree of similarity of the goods: The Appellant submits that the degree of similarity of goods is low. This is because in Singapore, medicinal teas are

predominantly sold in dedicated herbal tea outlets. In general pharmacies, supermarket aisles or health food stores, one may not even find any herbal medicinal drinks. As noted above, the Respondent's Earlier Mark is in relation to "herbal drink in Class 5", and not herbal medical drinks. The comparison with herbal medicinal drink is hence not an appropriate one. In any event, even taking the Appellant's case as submitted here, this claim is not backed up by any evidence from the Appellant.

86 Nature of the goods and services / Characteristics of the relevant consumer perceiving the relevant goods and services: The Appellant submits that herbal medicinal drinks occupy a different compartment in the consumer's mind. The PAR had addressed this when this was raised. She acknowledged that a certain portion of consumers would not find the products substitutable, but there would also be a certain portion of consumers who are indifferent and are simply seeking health products. While the Appellant reiterates this submission at the appeal, it has not addressed the point made by the PAR, which is a valid one. I would thus assess this factor as a neutral factor.

87 Normal way in which goods and services are distributed to the consumer: The Appellant submits that the Respondent's multi-level marketing model ensures no likelihood of confusion. This is because the trade channels of direct sellers are removed from where consumers may go. I accept that the trade channels of selling through supermarket aisles and through direct sellers are different.

88 However, given the similarity of marks, it is not apparent that a likelihood of confusion would be ruled out simply because the Respondent's trade channel involves direct sellers. The PAR had also noted that while the Respondent adopts a multi-level marketing model, there may be entities which

focus only on natural-based health products and those which focus on health products from both natural and synthetic sources. The Appellant did not make any submissions regarding this point.

89 The Appellant’s other argument on this factor is that it is a common practice to use a distinct trade mark for each category or individual product in the health products industry. However, counsel for the Appellant acknowledged at the hearing, that the Appellant did not have any evidence that this is indeed a common practice.

90 In view of the above, I would consider this factor on trade channels to be neutral.

91 After considering all the relevant factors, I find that there is a high degree of similarity of goods / services. Taken together with the high degree of similarity of marks, I am, like the PAR, satisfied that there exists a likelihood of confusion on the part of the public.

92 I would add that in *Future Enterprises Pte Ltd v McDonald’s Corp* [2006] 4 SLR(R) 629, the High Court at [22] cited the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 (“*Kaisha*”) for the proposition that a lesser degree of similarity between the goods or services in question may be offset by a greater degree of similarity between the marks and *vice versa*. The Appellant had submitted that if the Court is not prepared to find that the goods are dissimilar, it can also find that there is medium similarity or low degree of similarity; Appellant’s Written Submissions at para 27. Following the principle in *Kaisha*, given the high degree of similarity of the mark, a medium level of similarity of goods, which the Appellant was prepared to accept, would still have, in my view, led to a likelihood of confusion.

93 I therefore find that the Appellant fails in its appeal in respect of s 8(2)(b) of the Act for its application for trade marks in Class 5 and Class 35.

Section 8(7)(a) – Passing Off ground

94 The Appellant’s second main ground of appeal is that the PAR erred in allowing the Respondent’s opposition to the Appellant’s application for trade marks in Class 5 and 35, on the ground of s 8(7)(a) of the Act.

PAR’s decision

95 The PAR held that while the Respondent’s Earlier Mark does not enjoy reputation in Singapore, there was goodwill for purposes of this ground. Goodwill is concerned with the “business as whole”. The Respondent has manufacturing operations in Singapore. The Respondent is not a “foreign trader who does not conduct any business in Singapore”. As there was a likelihood of confusion, the PAR was of the view that for the same reasons, there is a likelihood of misrepresentation. As misrepresentation has been made out and given the extent of similarity of marks and goods / services, there is also a likelihood of damage via blurring or diversion of sales. The PAR thus found that opposition under s 8(7)(a) of the Act succeeds.

Appellant’s case

96 The Appellant submits that the Respondent’s evidence that it has a manufacturing facility in Singapore is insufficient to establish goodwill. In *Future Enterprises Pte Ltd v Tong Seng Produce Pte Ltd* [1997] 3 SLR(R) 797 (“*Future Enterprises*”), the plaintiff’s business lay in markets outside of Singapore whilst the products were manufactured in Singapore. It was held at [32] that it was not enough for the plaintiff to establish that it manufactures coffee products in Singapore, unless it could be shown that those coffee

products are available in the local market and have a local reputation. The fact that the Respondent has a manufacturing plant in Singapore is not sufficient in itself to demonstrate that “Sunrise” products are sold in the local market. Evidence from the Respondent’s own statutory declarations indicates that goods are primarily produced for export.

97 There can be no misrepresentation if the earlier mark did not become distinctive of the Respondent through evidence of use. In addition, without reliable evidence of sales and marketing activities in Singapore, it is difficult to conclude that the mark “Sunrise” has become distinctive of herbal drink products manufactured by the Respondent in Singapore. This impacts the issue of misrepresentation.

98 In *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [87], the court held that the issue is whether by using identifiers that suggest a connection with the plaintiff, the defendant is misrepresenting the position and, in the process, damaging the plaintiff’s goodwill. In this case, the Respondent is unable to establish that the “Sunrise” mark is associated exclusively with the Respondent, and no other.

Respondent’s case

99 The Respondent submits that the evidence it tendered, including evidence of manufacturing operations in Singapore, is sufficient to establish the Respondent’s goodwill in its business. As the PAR rightly highlighted, “goodwill is concerned with the “business as a whole””.

100 In assessing misrepresentation, the PAR rightly took into account the Respondent’s Unregistered Marks besides the Respondent’s Earlier Mark. *Hai Tong* highlighted at [110] that in a passing off action, the likelihood of

misrepresentation is to be assessed “having regard to all the circumstances”. It is not constrained only to factors which stem from the similarity between the contesting marks and goods / services. There is visual, aural and conceptual similarity between the Respondent’s Unregistered Marks and the Application Marks, for similar reasons as the Respondent’s Earlier Mark.

Respondent’s Unregistered Marks	Application Mark
	
	
	

101 The High Court in *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165 at [209] affirmed the Court of Appeal’s holding in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [77] that the test for a misrepresentation which creates a likelihood of confusion is substantially the same as that for “likelihood of confusion” under s 8(2)(b) of the Act. The PAR correctly concluded that for the same reasons that there is a likelihood of confusion under s 8(2)(b) of the Act, there is a likelihood of misrepresentation.

Decision

102 Section 8(7)(a) of the Act states:

(7) A trade mark must 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.

103 It is trite law that for the Respondent to succeed in an action for passing off, the “classical trinity” requirements of goodwill, misrepresentation and damage must be established: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [69], *Staywell* at [130].

104 The High Court in *Future Enterprises* at [32] held clearly that the fact that the plaintiff there had a manufacturing plant in Singapore, did not in itself establish goodwill in the product:

32 ... [i]t is not enough for the plaintiff to establish ... that it is incorporated in Singapore and makes the MacCoffee here. **The plaintiff as a company may have earned some goodwill simply by virtue of existing here and carrying on a manufacturing business but that goodwill would attach to the plaintiff's own name and not to the name of its products unless those products are also available in the local market and have a local reputation.** I therefore draw a distinction between the goodwill that may be attached to the corporation Futures Enterprises Pte Ltd which carries on manufacturing business in Singapore and the goodwill attached to the product “MacCoffee”. **Just because the plaintiff has some general goodwill in Singapore does not mean it also has a specific goodwill relating to MacCoffee which it can enforce as a property right.**

[emphasis added]

105 The Respondent does not disagree with *Future Enterprises*, but submits that the PAR was nevertheless correct in finding that there was goodwill with the “business as a whole”. This phrase is found in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) at [34]:

34 In our judgment, **goodwill, in the context of passing off, is concerned with goodwill in the business as a whole, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses** ... Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys ... **Goodwill may be proved by evidence of sales or of expenses incurred**

in promoting the goods and services in association with the mark, brand or get-up which they bear ...

[emphasis in original in italics; emphasis added in bold]

106 The Court of Appeal in *Singsung* was making a distinction between the business as a whole and the constituent elements such as the mark, logo or get-up it uses. In so far as goodwill in the business as a whole is concerned, the court added that goodwill may be provided by evidence of sales or expenses incurred in promotion of the goods and services in association with the mark. This is wholly consistent with *Future Enterprises*, which held that there is a distinction between goodwill that may be attached to a company that carries on manufacturing business in Singapore and the goodwill attached to a particular product.

107 The Respondent did not disagree with the above reading of *Future Enterprises* and *Singsung*, but submitted that it has provided sufficient evidence of sales or express incurred in promoting the goods and services in association with their marks. This is the table enclosed in the statutory declaration of Kevin Chang.⁹ This sets out the approximate global sales and Singapore sales from 2005 to 2021 for the Respondent's products, for those relating to the Respondent's Earlier Mark as well as the Respondent's unregistered marks. This is, however, a self-compiled document. There are no supporting documents such as invoices, purchase orders or any other business document.

108 The Respondent also referred to a picture of website selling its goods¹⁰ and a brick-and-mortar shop.¹¹ However, it is an undisputed principle that the

⁹ BOD at pp 322 and 519.

¹⁰ BOD at p 524.

¹¹ BOD at pp 49 and 75–76.

relevant date for the purposes of assessing a claim of passing off is the date on which the conduct complained commences; *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [34]. In this case, this would minimally be 16 August 2018, when the Appellant filed its applications for the relevant marks. The evidence on the online sales is from a Facebook post made around April 2021, while the document shows the opening of a showroom around July 2022. Such evidence are past the relevant date.

109 As the Respondent has not provided evidence of sales or expenses incurred in promoting the goods and services in association with their marks, I find that the Respondent has not established goodwill as required under s 8(7)(a) of the Act.

110 I am also of the view that the Respondent has not established the element of misrepresentation. The PAR held that since she had found that there is a “likelihood of confusion” under s 8(2)(b) of the Act, there is a likelihood of misrepresentation. The Respondent submits that this is supported by the High Court decision of *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165, which affirmed the holding of the Court of Appeal in *Sarika* at [77], that the test for connection between the goods or services and the proprietor under s 55(3) of the Act is similar in substance to the test for the misrepresentation requirement in passing off.

111 However, the court in *Sarika* also highlighted a distinction. The test of “likelihood of misrepresentation” in passing off concerns the proprietor’s “goodwill”, while the test for the “connection” concerns the “interests” of the well-known trade mark proprietor; following the Court of Appeal’s decision in *Amanresorts* at [234]; *Sarika* at [76]–[77]. Likewise, the test of “likelihood of

confusion” concerns the confusion as to the origin of the parties’ goods and *not* their goodwill; *Hai Tong* at [73].

112 This distinction is material here since, as I have found, the Respondent has not established goodwill. That being the case, it cannot be said, even though there are similarities of tests, that there is also misrepresentation here.

113 As the Respondent has not established the elements of goodwill and misrepresentation, the Appellant succeeds in its appeal in respect of the ground under s 8(7)(a) of the Act, for its applications in Class 5 and 35.

Conclusion

114 For the above reasons, I allow the Appellant’s appeal in respect of the ground under s 8(7)(a) of the Act. However, I dismiss the Appellant’s appeal against the ground under s 8(2)(b) of the Act. Accordingly, Trade Mark Application No. 40201816175S-02 and 40201816175S-01 in Class 5 and 35 shall not proceed to registration.

115 If parties are unable to agree on the issue of costs, they are to provide their written submissions on costs, of not more than seven pages, within a week of this Judgment.

Kwek Mean Luck
Judge of the High Court

O’Connor Pauline Teresa, Millicent Lui Qiao Xin and Teh Ri Xing
Ruth (Ghows LLC) for the Appellant;
Suhaimi Bin Lazim, Sukumar Karuppiah and Dinesh Kumar
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