

20. INTELLECTUAL PROPERTY LAW

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I. Patents

A. Validity and infringement of patent

20.1 In *Ng Say Keong v Jia Le Aluminium Pte Ltd*¹ (“Ng Say Keong”), the General Division of the High Court (“General Division”) ruled on issues of liability in respect of claims for patent infringement and passing off. The claimant, Ng Say Keong (“Ng”), was a sole proprietor in the business of inventing, manufacturing and selling innovative doors and door-related products in Singapore. His business was registered in Singapore as S & K Solid Wood Doors. Ng was the registered proprietor of a patent for a slide-and-swing door (“SK Patent”), which had become known to the public as the “SK Door”.

20.2 Both the first defendant, Jia Le Aluminium Pte Ltd, and the second defendant, 9 Power Aluminium & Glass Pte Ltd (“9 Power”), were Singapore-registered private limited companies engaged in the sale of aluminium products such as doors, window frames, and grilles. The defendants had the same registered office address, shareholders and directors. The two directors of the defendants were also directors and shareholders of Supreme Door Aluminium & Glass Sdn Bhd (“Supreme Door MY”), a Malaysia-registered company incorporated by a former

1 [2026] 3 SLR 562.

employee of S & K Solid Wood Doors. Supreme Door MY manufactured and exported slide-and-swing doors (“SD Doors”) according to a patent registered in Malaysia and Singapore. 9 Power imported the SD Doors from Supreme Door MY for sale and installation in Singapore. Jia Le Aluminium Pte Ltd only sold the SD Doors.²

20.3 Ng sued the defendants for infringing the SK Patent by, *inter alia*, making and importing SD Doors, as well as for passing off. The defendants counterclaimed, challenging the novelty and inventiveness of the SK Patent. The claim was bifurcated, with Ng Say Keong addressing issues of liability. This section covers the claim for patent infringement; the claim for passing off is covered in the section below.³

20.4 The issues for the General Division’s determination in respect of the claim for infringement were: (a) whether the SK Patent was valid; and (b) if so, whether the defendants infringed the SK Patent.

(1) *Was the SK Patent valid?*

20.5 Dedar Singh Gill J first addressed the preliminary issue of claim construction. Generally, claim construction identifies the invention in respect of which the monopoly is claimed and clarifies the scope of protection afforded by the patent.⁴ Where something in the invention “helps to solve a particular problem or answer a particular question in a new way, this will generally be regarded as an inventive contribution”.⁵ In the case of the SK Patent, its proposed slide-and-swing door sought to address problems faced by conventional hinged doors and conventional sliding doors by allowing “the sliding of one door panel and the swinging opening of the ‘juxtaposed’ doors, achieving ‘a widest door opening’ while ‘maximi[sing] the space available within a room or a hall’”.⁶

20.6 Gill J adopted the features of the claims of the SK Patent as identified by the parties’ joint neutral expert witness, Ron Awyong (“Awyong”). Claims 1 to 5 were the subject of dispute. Parties agreed

2 Ng Say Keong v Jia Le Aluminium Pte Ltd [2026] 3 SLR 562 at [4] and [6]–[8].

3 See paras 20.16–20.33 below.

4 Ng Say Keong v Jia Le Aluminium Pte Ltd [2026] 3 SLR 562 at [21] (citing *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [62]).

5 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] 2 SLR 940 at [63]–[64] (cited in *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [22]).

6 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [23].

that Claims 2 to 5, which referred to and incorporated Claim 1, were dependent on Claim 1.⁷

20.7 Claim construction and the assessment of validity are conducted from the perspective of the person skilled in the art, sometimes known as the person having ordinary skill in the art (PHOSITA). This is a notional person who possesses common general knowledge in the relevant art and has a practical interest in the subject matter.⁸ In this case, Gill J held that the person skilled in the art was a notional person working in the door industry possessing technical expertise in sliding doors, a common general knowledge of sliding doors and a practical interest in achieving the widest door opening in limited spaces.⁹

20.8 Turning to the substantive requirements of validity, Gill J cited the principles applicable to determining novelty and inventive step.¹⁰ In these proceedings, and in respect of both requirements, it was clear that the priority date was the date of the filing of the patent application. Further, it was agreed that the relevant prior art was one Japanese patent previously cited by the patent examiner of the SK Patent in his search report and written opinion (“Japanese Patent”). The defendants’ challenge of both requirements rested on the Japanese Patent.¹¹

20.9 The General Division analysed the validity of each of the identified claims of the SK Patent. In respect of Claim 1 of the SK Patent, the parties agreed that it was novel and inventive. In any case, Gill J arrived at the same position, finding that the Japanese Patent did not disclose two of the features in Claim 1 and that the person skilled in the art would not have been motivated to modify the Japanese Patent to arrive at the mechanism effected by those features.¹²

20.10 In respect of Claims 2 to 5, the defendants endorsed Awyong’s position that Claims 2, 4 and 5 were novel but not inventive, whereas Claim 3 was neither novel nor inventive. These arguments were rejected by the General Division. Gill J observed that each of Claims 2 to 5 incorporated all the features of Claim 1 and added a respective feature. In

7 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [26]–[27]. Dependent claims “refer back to the independent claim and incorporate all its features”: see *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 at [70], citing *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2018] 3 SLR 1334 at [104].

8 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [67] (cited in *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [28]).

9 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [28]–[29].

10 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [33]–[41].

11 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [15] and [42].

12 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [46]–[47].

Gill J's view, when each additional feature was "considered in conjunction with the novel and inventive Claim 1"¹³ to which it related and which it incorporated, it necessarily followed that Claims 2 to 5 were novel and inventive.¹⁴

20.11 Gill J therefore concluded that every claim in the SK Patent was valid. For completeness, the learned judge addressed an argument by counsel for Ng relating to the fact that the Japanese Patent had already been considered as part of the examination of the SK Patent. Where revocation applications are brought in the context of infringement proceedings, the court exercises its original jurisdiction to determine the validity of the patent in question and undertakes its own assessment based on the evidence before it.¹⁵ In doing so, the court may arrive at a different conclusion on the same prior art and is not bound by the findings of the patent examiner.¹⁶

(2) *Did defendants infringe the SK Patent?*

20.12 Next, the court considered whether the defendants had infringed the SK Patent under s 66(1) of the Patents Act 1994.¹⁷ For an allegedly infringing article to infringe a claim in a patent, the article must usurp each and every one of the essential elements of the claim.¹⁸

20.13 The defendants averred that the SD Door did not infringe the SK Patent as it lacked feature 1.4 of Claim 1. Feature 1.4 facilitated the sliding mechanism of the SK Door and required that:¹⁹

... both the first door panel and the second door panel are provided with a top horizontal bar and a bottom horizontal bar, wherein the base of the bottom horizontal bar of the two panels is provided with *elongated slot* and one end of

13 Ng Say Keong v Jia Le Aluminium Pte Ltd [2026] 3 SLR 562 at [50].

14 Ng Say Keong v Jia Le Aluminium Pte Ltd [2026] 3 SLR 562 at [49]–[50]. On the assessment of novelty for dependent claims, see *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2018] 3 SLR 1334 at [103]–[105] and [124]. In particular, see *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2018] 3 SLR 1334 at [104]: "[T]he enquiry which [the court] is tasked to undertake ... is whether the elements or features in the subsequent claim(s) taken together with the invention as set out in the preceding claim meet the requirements of novelty".

15 *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 at [64]–[67]. In contrast, original jurisdiction to hear revocation applications brought *independently* of infringement proceedings is vested exclusively in the Registrar of Patents: see *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 at [73]–[78].

16 Ng Say Keong v Jia Le Aluminium Pte Ltd [2026] 3 SLR 562 at [51]–[53].

17 2020 Rev Ed.

18 *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2018] 1 SLR 856 at [41(f)] (cited in *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [55]).

19 Ng Say Keong v Jia Le Aluminium Pte Ltd [2026] 3 SLR 562 at [56]–[57].

each of the base of the two door panels is extended to form an abutment which is slidable within the *slots* of each of the bottom bar[.] [emphasis added]

20.14 The General Division was first required to decide whether the defendants' interpretation of the terms "elongated slot" and "slots" as referring to the same opening was correct. After considering the evidence and arguments, Gill J held that the defendants' interpretation was correct and consistent with the purposive approach in claim construction. In Gill J's view, feature 1.4 intended for each door panel to have a bottom bar with slots in them, but possibly referred to "elongated slot" in the singular by mistake. This interpretation also accorded with the functionality of the door. On the basis of this interpretation, the SD Door lacked feature 1.4 as only one of its door panels had an elongated slot. In any case, Gill J held that there were other differences in the SD Door which placed it outside the scope of feature 1.4.²⁰

20.15 The General Division therefore found that the defendants had not infringed independent Claim 1 of the SK Patent. In light of this finding, it followed that the defendants also did not infringe dependent Claims 2 to 5, each of which incorporated all the features of Claim 1. As the conclusion was that there was no infringement, it was not necessary for the General Division to consider defences.²¹

II. Passing off

A. *Application of classical trinity*

20.16 The patent infringement claim in *Ng Say Keong* has been summarised above.²² This section reviews Ng's claim in passing off against the defendants.

20.17 Ng sold his slide-and-swing doors under various marks collectively referred to as the "SK Name". Sometime in July 2023, Ng was informed by a relative of his existing customer ("Relative") that the defendants' employees had purportedly introduced themselves as employees of "SK Doors" when installing the SD Doors in the Relative's home.²³ Ng then hired a private investigator, Seet Ju Yong Jeremy ("Seet"), who visited the defendants' combined office and showroom to

20 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [65]–[67].

21 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [68].

22 See paras 20.1–20.15 above.

23 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [9].

collect evidence of the defendants' alleged acts of passing off. Neither the SK Doors nor the SD Doors appeared to display their respective logos.²⁴

20.18 To succeed in an action for passing off, a claimant must prove the classical trinity of goodwill, misrepresentation and damage.²⁵ The General Division analysed each of these elements in turn.

(1) *Goodwill*

20.19 The Court of Appeal had previously stated that goodwill “is manifested in the custom that the [claimant's] business enjoys” and “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”.²⁶

20.20 On the evidence before the General Division, Ng succeeded in establishing goodwill in his business relating to SK Doors. According to Ng, he had used the SK Name continuously and extensively for nearly two decades to promote his products – in particular, his slide-and-swing doors – through his business's website and marketing brochures. Further, he demonstrated that his business enjoyed substantial sales volume and had sufficient market presence. In any event, the defendants did not dispute the element of goodwill.²⁷

(2) *Misrepresentation*

20.21 The element of misrepresentation requires a false representation giving rise to actual confusion or a likelihood of confusion on the part of the relevant public (*ie*, the claimant's actual and potential customers).²⁸

20.22 The distinctiveness of the claimant's mark or get-up is a threshold inquiry in the misrepresentation analysis. Principles derived from the trade mark context, including the general policy against allowing the monopolisation of commonly used terms, are relevant to this inquiry. Accordingly, marks composed of common letter combinations or

24 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [69].

25 See, eg, *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216; *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911; *Han's (F&B) Pte Ltd v Gustimmo World Pte Ltd* [2015] 2 SLR 825; *Singsung Pte Ltd v LG Electronics Pte Ltd* [2016] 4 SLR 86; *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156; and *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 4 SLR 784.

26 *Singsung Pte Ltd v LG Electronics Pte Ltd* [2016] 4 SLR 86 at [34].

27 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [73]–[74].

28 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [83].

elements (such as common surnames) typically possess a low level of inherent distinctiveness.²⁹ However, such marks may still be protected if they are shown to have acquired distinctiveness through their use in the claimant's business.³⁰

20.23 The General Division held that the common two-letter combination "SK" in the SK Name was not inherently distinctive. Nevertheless, the SK Name had acquired distinctiveness in the Singapore door industry. In view of Ng's extensive use of the SK Name and the commercial success of his business, the General Division was satisfied that the SK Name had become exclusively associated with the doors of S & K Solid Wood Doors.³¹

20.24 The alleged misrepresentation must result in actual confusion or a likelihood of confusion, assessed from the perspective of the notional customer with imperfect recollection. This is a fact-sensitive inquiry. In contrast to a trade mark infringement action, the court may consider extraneous factors, such as the steps taken by a trader to differentiate his goods or marks from those of the claimant. Further, a finding that the defendant intended to deceive consumers makes it easier to establish a likelihood of confusion.³²

20.25 Central to Ng's case was his contention that the defendants installed an SK Door in their showroom office for use as a sample, thereby misleading customers into thinking the SD Doors were from or associated with S & K Solid Wood Doors. The defendants claimed that the installed door was merely a toilet door. After assessing all the evidence, Gill J accepted Ng's explanation. Crucially, the learned judge inferred that the defendants *intended* to mislead customers into thinking that the doors they sold were SK Doors. This conclusion was reinforced by the defendants' inability to explain why they wrote "SK" on multiple occasions in the order documents given to customers.³³

20.26 Additionally, the defendants did not take any steps to differentiate their doors from the SK Doors. The defendants did not put any distinctive logo on their SD Doors and failed to substantiate their assertion that their usual practice was to provide customers with SD Door brochures. Further, Gill J inferred that the defendants' use of "SD" in their business was a deliberate reference to Ng's slide-and-swing doors which had been

29 *The Registrar of Trade Marks v W & G Du Cros Ltd* [1913] AC 624; *Han's (F&B) Pte Ltd v Gustimmo World Pte Ltd* [2015] 2 SLR 825.

30 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [77]–[80].

31 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [78] and [81].

32 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [83]–[86].

33 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [87]–[93].

prefixed with “SD” in their product codes for many years before the incorporation of Supreme Door MY.³⁴

20.27 However, in Gill J’s view, the defendants’ catalogue was not so similar to the S & K Solid Wood Doors catalogue as to be likely to confuse, as the layout, font styles and icons in the S & K Solid Wood Doors catalogue were generic.³⁵

20.28 The learned judge dismissed the defendants’ arguments that there was no proof of reliance or inducement by Seet, the Relative, any of Ng’s customers or any member of the public, since the purpose of the evidence was to determine the likelihood of confusion and the lack of evidence of actual confusion should not be accorded undue weight. In any event, the court disregarded the alleged incident relating to the Relative, which was hearsay and untested at trial.³⁶

20.29 In the circumstances, the General Division concluded that there was a likelihood of confusion among the relevant public. Further, this likelihood of confusion was attributable to both defendants’ conduct. Although the representations in issue were made by a 9 Power employee, the defendants and their employees regarded the defendants as a single entity and conducted their affairs on that basis. The representations could therefore be treated as having been made on the defendants’ joint behalf.³⁷

(3) *Damage*

20.30 To establish damage, the claimant only needs to show a real tangible risk of substantial damage, which may also take the form of blurring or tarnishment. If the goods in question are in direct competition, the courts will readily infer a likelihood of damage to the plaintiff’s goodwill.³⁸

20.31 The General Division held that the damage element was satisfied as the fact that the defendants sold substitute products within the same market and directly competed with Ng gave rise to a likelihood of diversion of sales.³⁹ However, Ng failed to establish damage in the form

34 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [94]–[99].

35 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [104].

36 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [100]–[103].

37 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [105].

38 *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] 1 SLR(R) 903 at [31].

39 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [109], citing Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 3rd Ed, 2014) at para 19.280.

of tarnishment as the authenticity of the evidence adduced could not be verified.⁴⁰

(4) *Reliefs*

20.32 The General Division therefore found the defendants liable for passing off. As the claim was bifurcated by consent and proceeded on liability only, the prayers for damages and/or account of profits were to be separately assessed. Gill J granted Ng the injunction prayed for to restrain the defendants from further acts of passing off.⁴¹

20.33 The patent infringement and passing off principles engaged in *Ng Say Keong* were relatively straightforward, with the General Division applying settled law to the defendants' use of similar branding and technology. Nonetheless, this case is notable for illustrating how "trap purchase"⁴² evidence can be instrumental in establishing the element of misrepresentation in passing off.

B. *Scope of goodwill*

20.34 The General Division in *Yang Qiang v Gallop APAC Pte Ltd*⁴³ ("Yang Qiang") had the opportunity to revisit the scope of the goodwill element in passing off. The dispute in *Yang Qiang* centred on the beneficial ownership of certain shares held by the second defendant, Lew Kwang Ping ("Lew"), in the first defendant, Gallop APAC Pte Ltd ("Gallop APAC"). In a judgment delivered by the General Division on 30 September 2025, Andre Maniam J also set out the grounds for his decision on parties' claims in contract and tort. This chapter only covers Maniam J's ruling on the passing off claim.

20.35 The first claimant, Yang Qiang, ("Yang") was a Chinese businessman and the ultimate owner of a Chinese group of companies known as the Shaanxi Tianju Investment Group ("STIG"). Part of STIG's business was the provision of air transportation services. In 2021, Yang and STIG incorporated the second claimant, GallopAir Pte Ltd ("GallopAir"), in Singapore as a vehicle for expanding STIG's aviation business in Singapore and Brunei.

20.36 In 2022, Lew learnt of Yang and STIG's plans to expand into Brunei. The General Division found that shortly thereafter, Yang (and/or

40 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [112]–[113].

41 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [114]–[117].

42 *Ng Say Keong v Jia Le Aluminium Pte Ltd* [2026] 3 SLR 562 at [110].

43 [2025] SGHC 187.

GallopAir) and Lew entered into an oral agreement, pursuant to which Gallop APAC was incorporated. It was contemplated that GallopAir would work with the newly-incorporated company and allow it to use the names “Gallop” and “GallopAir”.⁴⁴ Lew was registered as the holder of 90% of the shares in Gallop APAC.

20.37 The parties’ commercial relationship broke down in December 2022. The claimants alleged that Gallop APAC continued to use the GallopAir name and brand even after STIG formally announced the termination of the parties’ business relationship on 1 December 2022. However, Gallop APAC quickly changed its trade name to “KISAir”. The claimants applied for injunctive relief on 22 December 2022 and were granted an interlocutory injunction on 10 February 2023 to (among other things) restrain the defendants from using the names or marks complained of.

20.38 The trial of the claimants’ claims was bifurcated as between liability and quantum.⁴⁵ *Yang Qiang* sets out Maniam J’s findings on issues of liability, including in respect of GallopAir’s claim against Gallop APAC in passing off.

20.39 It is trite law that the tort of passing off ultimately seeks to protect the claimant’s goodwill. Goodwill is “the attractive force which brings in custom”⁴⁶ and “is the integral feature of the relationship between a trader and his customers”.⁴⁷

20.40 At trial, GallopAir failed to establish that it had customers within the jurisdiction, as the General Division had found that the evidence adduced was not credible. In its closing submissions, GallopAir curiously sought to argue that it had “goodwill” with its *service providers*, ie, it was an attractive customer to its service providers and there were parties who wanted to sell goods or services to GallopAir.

20.41 Central to GallopAir’s argument was the seminal decision of *The Singapore Professional Golfers’ Association v Chen Eng Waye*⁴⁸ (“SPGA”), in which the Court of Appeal held that the tort of passing off could extend beyond commercial traders to protect non-commercial organisations, such as associations of members. For such associations, goodwill takes

44 *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [22]–[23].

45 *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [133].

46 *The Singapore Professional Golfers’ Association v Chen Eng Waye* [2013] 2 SLR 495 at [21] (cited in *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [117]).

47 *The Singapore Professional Golfers’ Association v Chen Eng Waye* [2013] 2 SLR 495 at [21] (cited in *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [117]).

48 [2013] 2 SLR 495.

the form of voluntary membership, subscriptions, donations or support reflecting the magnetic force of the particular association in question.⁴⁹

20.42 The General Division considered the concept of goodwill established in *SPGA* and firmly rejected GallopAir's attempted extension of the concept, opining that:⁵⁰

The tort of passing off thus protects not only commercial traders, but also non-commercial associations that are *attractive to members* because of the *goods or services* the association offers to members. That is no basis for extending the concept of goodwill to a party that has no attraction to customers *or* members, but instead claims that it is seen as an *attractive customer* by those seeking to sell goods and services. [emphasis in original]

20.43 In Maniam J's view, this extension was unwarranted and would conflate goodwill with reputation. In this respect, the court in *SPGA* had explained that reputation can exist without a supporting business relationship, whereas goodwill attaches to a business in the jurisdiction and is reflected in the custom enjoyed by that business.⁵¹

20.44 Accordingly, GallopAir's passing off claim failed for lack of goodwill. Further, Maniam J held that even if "goodwill" were accepted to subsist in GallopAir's attractiveness to service providers, GallopAir had failed to prove damage or a likelihood of damage to such "goodwill". There was no evidence that Gallop APAC's acts would have caused GallopAir's service providers to sell their goods or services to GallopAir on less favourable terms, particularly given the brief period during which the conduct occurred.⁵²

20.45 The General Division dismissed GallopAir's claim in passing off and, consequently, GallopAir's conspiracy claim against Lew and the third to sixth defendants for conspiring to cause or assist Gallop APAC to commit passing off.⁵³

20.46 The analysis and outcome discussed above align with established principles. *Yang Qiang* reaffirms the scope of the goodwill element in, and the axiomatic objective of, the law of passing off.

49 *The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] 2 SLR 495 at [23].

50 *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [121].

51 *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [121], citing *The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] 2 SLR 495 at [22].

52 *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [122]–[124].

53 *Yang Qiang v Gallop APAC Pte Ltd* [2025] SGHC 187 at [125]–[129].

20.47 Separately, *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International*⁵⁴ (“*Sunrise v Sunrider*”) discussed and applied the classical trinity in the context of s 8(7)(a) of the Trade Marks Act 1998⁵⁵ (“TMA”). The interested reader is referred to the analysis in paras 20.112–20.115 below.

III. Trade marks

20.48 This review of Singapore’s trade marks cases in 2025 covers two decisions: (a) *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd*⁵⁶ (“*East Coast Podiatry*”); and (b) *Sunrise v Sunrider*. The former is a decision from the Court of Appeal whilst the latter is a decision from the General Division.

A. Trade mark infringement – “Use as a trade mark” – Google Ads – Extraneous factors

20.49 In *East Coast Podiatry*, the appellant, East Coast Podiatry Centre Pte Ltd, sued the respondent, Family Podiatry Centre Pte Ltd, for trade mark infringement on the grounds that the respondent, when using Google’s advertising services, displayed Internet advertisements that contained words that were allegedly so similar to the appellant’s registered trade mark that such use constituted an infringement of the appellant’s exclusive right as a trade mark owner.

20.50 The General Division found in favour of the respondent and dismissed the appellant’s claims for trade mark infringement and for passing off. The appellant appealed against the judgment of the General Division, specifically taking issue with the judge’s decision on its claim for trade mark infringement under s 27(2)(b) of the TMA.

20.51 The appellant’s contentions were twofold:

- (a) That the judge was wrong to have considered the respondent’s website when assessing the likelihood of confusion because a website, being a “superficial marketing choice”,⁵⁷ was *not* a factor intrinsic to the very nature of the goods and/or that affected the impact that the similarity (between the allegedly infringing sign and the registered mark) had on consumers.

54 [2025] 3 SLR 1700.

55 2020 Rev Ed.

56 [2025] 1 SLR 914.

57 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [12].

As such, according to the jurisprudence in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc*⁵⁸ (“*Staywell*”), the respondent’s website was an extraneous factor that could not be considered in the inquiry of whether there was confusion as to the origin of the service in question (“Confusion Inquiry”).

(b) Even if the judge was right to have considered the respondent’s website in the Confusion Inquiry, he was wrong to have concluded that the relevant segment of the public would be able to ascertain that the services referred to in the respondent’s Internet advertisements did not originate from the appellant. Quite to the contrary, the appellant contended that the relevant segment of the public, having viewed the respondent’s advertisements and website, would believe or would reasonably believe that the respondent and the appellant were economically linked, consequently resulting in confusion.

20.52 The respondent submitted that the judge neither deviated from the jurisprudence in *Staywell* nor erred in his findings. *Staywell* was a decision delivered in the context of trade mark opposition proceedings in which the court must consider all actual and notional fair uses by the parties of the registered and applicant marks. In contrast, the dispute at hand concerned trade mark infringement proceedings specifically in the context of Internet advertising. The judge was right to have considered the respondent’s website in the Confusion Inquiry as it was inextricably connected to the respondent’s advertisement which was the basis of the appellant’s claim for trade mark infringement.

20.53 The Court of Appeal dismissed the appellant’s appeal.

20.54 *East Coast Podiatry* is Singapore’s first decision in relation to an alleged trade mark infringement in the context of Internet advertising. Several novel and interesting issues were raised by the parties in this case. The Singapore Court of Appeal’s judgment, in particular the analysis of these issues, provides important guidance to both registered trade mark owners and Internet users.

20.55 The appellant claimed that the respondent’s use of the words “east coast podiatry”, “Podiatry East Coast” and/or “Podiatrist East Coast” (collectively, “Signs”) in its internet advertisements constituted trade mark infringement under the TMA due to the similarity between the Signs and the appellant’s registered trade mark,  EAST COAST PODIATRY ,

58 [2014] 1 SLR 911.

which is a composite mark comprising the device and the words “EAST COAST PODIATRY”. To determine whether the respondent’s use of the Signs in its internet advertisements constituted trade mark infringement under the TMA, it was necessary for the Court of Appeal to address the following issues:⁵⁹

- (a) whether it was *permissible* for the court to consider the respondent’s website as part of the Confusion Inquiry in such circumstances; and
- (b) whether the decisions of the Court of Justice of the European Union (“CJEU”) and the English courts were *applicable* in Singapore under s 27(2) of the TMA.

(1) *Google’s advertising services*

20.56 A comprehensive explanation of how Google’s advertising services (“Google Ads”) functioned as an Internet advertising service was provided in the Court of Appeal’s judgment.⁶⁰ This sets the context in which the appellant based its claims that the use by the respondent of signs that were so similar to the appellant’s registered trade mark constituted trade mark infringement under the TMA.

20.57 Broadly speaking, in the context of the Google Ads, a defendant’s use of a sign (that is so similar to the plaintiff’s mark as to constitute trade mark infringement) may fall into two distinct categories: (a) the keyword use cases; and (b) the ad text use cases. In the former, the plaintiff who is a registered trade mark owner may complain that the defendant has used a sign (that is so similar to the plaintiff’s mark) as a keyword that triggers the display of an advertisement which may not necessarily include or contain the sign in question. In the latter, the alleged use concerns the defendant’s use of the plaintiff’s mark within the text of the resulting advertisement such as in the headlines, commercial message or the Uniform Resource Locator (“URL”). In the present case, the appellant alleged that the respondent had used the appellant’s registered trade mark in the latter category (*ie*, within the text of the resulting advertisement), and the Court of Appeal proceeded to consider the appeal in this context.

59 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [15].

60 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [17]–[21].

(2) *The law – section 27(2)(b) of Trade Marks Act 1998*

20.58 To establish trade mark infringement under s 27(2)(b) of the TMA, the following three requirements must be satisfied conjunctively:⁶¹

- (a) The defendant's sign is similar to the plaintiff's registered trade mark ("Mark/Sign Similarity Inquiry").
- (b) The sign must be used in relation to goods or services identical with or similar to those for which the trade mark is registered ("Goods/Services Similarity Inquiry").
- (c) As a consequence of fulfilling the requirements in (a) and (b) above, there must exist a likelihood of confusion on the part of the public (*ie*, the Confusion Inquiry).

20.59 It is important to note that the Court of Appeal, in earlier decisions,⁶² has observed that it is imperative for the likelihood of confusion on the part of the public to emanate from the similarities between the mark and sign, and the similarities between the goods or services for which the mark and sign were used. If the confusion was brought about by some factors other than the similarities in the mark and sign and similarities in the goods or services for which they were used, there can be *no* trade mark infringement under s 27(2)(b) of the TMA.

- (a) Trade mark use inquiry: A threshold issue and Singapore's approach

20.60 It is a requirement in s 27 of the TMA, albeit implicitly, that the use in question be "in relation to goods or services" thereby establishing the link between the signs and the goods or services concerned to identify the *trade origin* of the goods or services.⁶³ Thus, it is well established in Singapore law that to constitute infringement under s 27 of the TMA, a claimant must satisfy a *threshold issue* that the use of the alleged infringing sign constitutes a trade mark use in denoting the trade origins of the goods or services in question, as opposed to non-origin-related uses (*eg*, descriptive use or decorative use)⁶⁴ ("Trade Mark Use Inquiry").

61 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [23].

62 See *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 at [8]; and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941.

63 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [25].

64 *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [36]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [17]; *Burberry Ltd v Megastar Shipping Pte Ltd* [2019] 1 SLR 536 at [32].

The parties in *East Coast Podiatry* also did not dispute the applicability of this requirement in the present case.

20.61 Nevertheless, the Court of Appeal took the opportunity to clarify Singapore's approach to this threshold issue of trade mark use, as there is a material difference between Singapore's approach and the approach taken by the English courts and the CJEU. The Court of Appeal was of the respectful view that in the Confusion Inquiry under Singapore law, it is *not* appropriate to apply principles derived from the English and CJEU jurisprudence which were developed in the context of the threshold trade mark use issue.⁶⁵

(i) The requirement of trade mark use: Developments in English and European jurisprudence

20.62 In the European Union, there has been a marked shift in approach with respect to trade mark use as a threshold requirement for finding trade mark infringement as the CJEU has shown a growing acceptance of the broader “effect-centric”⁶⁶ approach. This approach centres on the inquiry into “whether the infringing use was liable to affect the functions of the registered trade mark” with a particular focus on the “ultimate impact on the proprietor's interests in the registered mark”⁶⁷ instead of “whether the use in question was ‘descriptive use’ or ‘trade mark use’ from the perspective of the alleged infringer”.⁶⁸

20.63 The CJEU first adopted the “effect-centric” approach in *L’Oreal SA v Bellure NV*⁶⁹ (“*L’Oreal (CJEU)*”), where it was made clear by the court that a trade mark proprietor was entitled to ensure that third parties did not adversely impact the *non-origin related* functions of his registered trade mark, eg, those of communication, investment or advertising.⁷⁰

65 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [26].

66 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [45].

67 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [45].

68 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [45].

69 [2010] Bus LR 303; [2009] IP & T 783 at [58] and [65].

70 The “effect-centric” approach propounded by *L’Oreal SA v Bellure NV* [2010] Bus LR 303; [2009] IP & T 783 was met with reservations when the case resumed in the Court of Appeal of England and Wales. See the judgment of Jacob LJ in *L’Oreal SA v Bellure NV (No 2)* [2010] Bus LR 1579; [2010] IP & T 1094 at [30], where it was said that:

... I have real difficulty with these functions when divorced from the origin function ... Conceptually they are vague and ill-defined. Take for instance the
(cont'd on the next page)

Post-*L'Oreal* (CJEU), the scope of infringing uses in the European Union widened to include not only those that impact the conventional function of a registered trade mark in denoting trade origin but also possibly other non-origin related uses.

20.64 Very soon after the decision in *L'Oreal* (CJEU), the CJEU was given the opportunity to consider whether the monopoly conferred on a registered trade mark extended to uses in the context of an Internet advertising service offered by a search engine. In *Google France SARL v Louis Vuitton Malletier SA*⁷¹ (“*Google France*”), the plaintiffs alleged trade mark infringement on the basis that Google (*ie*, Google France SARL and Google Inc) had allowed third parties to use as keywords, words which were identical to the registered marks owned by the plaintiffs, in Google Ads. In considering whether the use in question adversely affected any of the functions of the registered trade marks, the CJEU held that:⁷²

The function of indicating the origin of the mark is adversely affected if the ad does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party ...

20.65 The *Google France* test (which was developed as a general test to be applied under Art 5(1)(a) of the First Council Directive 89/104/EEC⁷³ (“*Directive*”) in considering the impact of keyword advertising on the origin function of the a trade mark) was subsequently applied by the CJEU for the assessment of the likelihood of confusion in the context of Art 5(1)(b) of the Directive⁷⁴ in the cases of *Die BergSpechte Outdoor*

advertising and investment functions. Trade mark owners of famous marks will have spent a lot of money creating them and need to continue to spend to maintain them. *But all advertisements for rival products will impinge on the owner's efforts and affect the advertising and investment function of the brand in question.* No one would say such jostling for fame and image in the market should be stopped. *Similarly all comparative advertising ... is likely to affect the value of the trade mark owner's investment.* [emphasis added]

71 [2011] Bus LR 1; [2010] IP & T 992.

72 *Google France SARL v Louis Vuitton Malletier SA* [2011] Bus LR 1; [2010] IP & T 992 at [84].

73 First Council Directive to Approximate the Laws of the Member States Relating to Trade Marks, EC Council Directive 89/104/EEC, [1989] OJ L 40/1.

74 This is equivalent to s 27(2)(b) of the Trade Marks Act 1998 (2020 Rev Ed), which concerns the use of *similar* as opposed to identical signs.

*Reisen und Alpenschule Edi Koblmüller GmbH v Günther Guni*⁷⁵ as well as *Portakabin Ltd v Primakabin BV*.⁷⁶

20.66 These developments in the European jurisprudence were received with caution and concerns by the English courts.⁷⁷ In summary, the English courts recognised that the *Google France* test is effect-centric in nature as the focus is on the effect that the resulting advertisement has on the relevant public's ability to assess the origin of the goods or services offered in the advertisement, but it should also be noted that this was a new test developed specifically in the context of keyword advertising cases, and not in the context of the threshold Trade Mark Use Inquiry or under the Confusion Inquiry. Thus, the application of the *Google France* test to assess whether the use in question affects or is liable to affect the origin function in a claim under Art 5(1)(a) of the Directive, and the likelihood of confusion in a claim under Art 5(1)(b) of the Directive may be problematic. First, applying the same test may potentially be inconsistent with the statutory framework because it would impermissibly introduce a requirement for the trade mark proprietor to prove something akin to a likelihood of confusion in the context of cases falling within Art 5(1)(a) of the Directive.⁷⁸ Second, the threshold Trade Mark Use Inquiry (under Art 5(1)(a) of the Directive) and the Confusion Inquiry (under Art 5(1)(b) of the Directive) are analytically different and arguably require different tests.⁷⁹

20.67 Nevertheless, the *Google France* test appears to have found its way into the analytical framework of European and English trade mark laws,⁸⁰ and it would have a bearing on future European and English jurisprudential developments in this area.

20.68 For clarity, it is necessary and useful for the Court of Appeal in *East Coast Podiatry* to examine the applicability of the effect-centric *Google France* test in ss 27(1) and 27(2) of the TMA, and if it is found to be *inapplicable*, what Singapore's approach to the threshold Trade Mark Use Inquiry would be, particularly in the context of infringement claims involving Internet keyword advertising.

75 Case C-278/08, [2010] ECR I-2517; [2010] ETMR 33.

76 [2011] Bus LR 1339.

77 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [53]–[62].

78 See *DataCard Corp v Eagle Technologies Ltd* [2012] Bus LR 160, per Arnold J at [266]. See also *Interflora Inc v Marks and Spencer plc* [2013] IP & T 931 at [238]–[239].

79 See *E-Accounting Solutions Ltd v Global Infosys Ltd* [2023] EWHC 2038 (Ch), per HHJ Tindal at [75(iii)].

80 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [58]–[62].

(ii) Singapore's approach

20.69 The Court of Appeal recognises the effect-centric nature of the *Google France* test and that it intends to be a “new test” in the context of keyword advertising cases to determine whether the use complained of “has adversely affected, or is liable to adversely affect, the origin function of a trade mark”.⁸¹ Since the Court of Appeal in previous decisions⁸² eschewed the broader approach to the threshold issue in Singapore's trade mark laws, it would not be appropriate to rely on the *Google France* test unless the court decides to depart from its earlier decision on account of the unique challenges arising from the use of Internet advertisements. This departure has not been undertaken. Instead, the Court of Appeal has confirmed that the threshold requirement of trade mark use remains good law in Singapore, even in the context of Internet advertisements. The threshold Trade Mark Use Inquiry is consistent with the fundamental purpose of Singapore's trade mark law, which is to give protection to trade mark proprietors against the use of identical or similar marks by third parties *for the purpose of distinguishing their goods and services*. At this threshold stage of the analysis, the focus of the inquiry is on the *nature of the defendant's use of the signs* and not the *effect of such use on the claimant's registered mark*.⁸³

20.70 Given the effect-centric nature of the *Google France* test and how it was formulated in the context of Internet keyword advertising, the Court of Appeal has taken the position that this approach is inconsistent with Singapore's statutory framework. This is because the *Google France* test introduces some, perhaps diluted, version of the requirement for a likelihood of confusion for trade mark infringement claims under s 27(1) of the TMA when there is no such requirement⁸⁴ as the likelihood of confusion is *presumed*.⁸⁵ Furthermore, the court recognises that there are possible uses of a sign, like purely decorative use or the use of generic words for purely descriptive purposes, which are not trade mark uses (*ie*, the sign is *not* used as a badge of origin) but may nevertheless potentially affect the origin function of a registered mark.⁸⁶ From a policy

81 *Interflora Inc v Marks & Spencer plc* (No 5) [2015] Bus LR 492; [2015] IP & T 109 at [132].

82 See *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [28]–[29] and [33]–[34].

83 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [66].

84 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [67]–[68].

85 See Art 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (15 April 1994), 1869 UNTS 299 (entered into force 1 January 1995).

86 See *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [29] and *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* (cont'd on the next page)

perspective, the introduction of an effect-centric approach may have the unintended effect of widening the scope of infringing uses under Singapore trade mark law and potentially encroaching into the realm of fair competition, a development which the court does not consider generally appropriate to support at this point.⁸⁷

20.71 In respect of the approach to be taken to determine infringing uses in the context of Internet keyword advertising, the Court of Appeal prescribed a robust application of the threshold Trade Mark Use Inquiry that must necessarily involve the following elements:⁸⁸

- (i) The objective circumstances surrounding the defendant's use of the signs. This will necessarily entail a consideration of the interaction between the defendant's signs and the resulting advertisement. The defendant's subjective intentions may also be a relevant, but not necessarily decisive, factor ...
- (ii) The inherent distinctiveness of the signs used by the defendant. Greater latitude is afforded to a defendant who uses words or ideas of a generic nature, bearing in mind the reality that Internet users would typically employ a wide range of generic search terms when conducting an Internet search ...
- (iii) The website which an Internet user is redirected to upon clicking on the defendant's advertisement. This factor is aimed at helping the court to assess the apparent purpose for which the signs were used, particularly where the advertisement itself contains few details ...

20.72 In the court's view, such an approach which sought to prevent third parties from using the trade mark as a badge of origin in their Internet advertisements (whether as keywords or as part of the advertisements' text) without the consent of the proprietor is adequate to address peculiar risks associated with Internet keyword advertising.

(iii) Application of law to facts in *East Coast Podiatry*

20.73 The Court of Appeal held that the use of the Signs by the respondent was clearly descriptive in nature and not in a trade mark sense.

20.74 First, the court considered the inherent distinctiveness of the Signs used by the respondent. In the present case, the term "east coast" in the respondent's Signs was a generic reference to a geographical area and the court considered it a commonly used term in Singapore to refer

[2025] 1 SLR 914 at [69].

87 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [69].

88 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [79].

to a district or area that includes Joo Chiat Road. As such, when it is used together with the other terms in the Signs, such as “podiatry” or “podiatrist”, the resulting combination is a descriptor of podiatry services offered in the east coast region of Singapore. The Court of Appeal highlighted an important point in that, because the Signs were inherently descriptive, the appellant bore the burden of showing a “more compelling degree” of trade mark use, which the appellant failed to do.⁸⁹

20.75 Next, the court considered the objective circumstances surrounding the respondent’s use of the Signs, in particular the subjective intentions of the respondent, and concluded that the respondent’s purpose was descriptive and not source indicating. This conclusion was supported by evidence that (a) the respondent was preparing to open a new clinic at 170 Joo Chiat Road, an East Coast location; and (b) a Google consultant had advised the respondent to use location-based keywords to improve search visibility.

20.76 The court also found that the manner in which the relevant Signs were presented in the respondent’s advertisements as well as on the website further supported the conclusion that the respondent was not seeking to portray its services as originating from the appellant. Instead, it was clear from the URL as well as the placement of the respondent’s own branding on the website that it was offering its services under its own name.

20.77 Finally, the court rejected the appellant’s arguments that the respondent had used the Signs with the specific intention (stemming from some history of bad blood between the parties) of confusing prospective clients who might have been looking for the appellant’s services. In the present case, the court found that the respondent had used the Signs to pre-empt the launch of the respondent’s new branch in Joo Chiat. This was to be distinguished from the situation in *Interflora Inc v Marks and Spencer plc (No 3)*⁹⁰ where the English court found that the infringer had accepted that it used the sign by arranging for the display of its advertisement whenever an Internet user searched for “Interflora”, regardless of the precise keyword that the infringer had chosen to bid on.⁹¹

20.78 Consequently, the appellant failed to show that the respondent had used the Signs in a trade mark sense. Since the appellant’s claim

89 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [85].

90 [2013] IP & T 1023.

91 *Interflora Inc v Marks and Spencer plc (No 3)* [2013] IP & T 1023 at [8] and [11].

failed at the threshold, the appeal should be dismissed. There was thus no need to go on to the next three stages of the analysis of the Mark/Sign Similarity Inquiry, Goods/Services Similarity Inquiry and Confusion Inquiry.

(b) Mark/Sign Similarity Inquiry

20.79 Nevertheless, the Court of Appeal was of the view that even if the appellant were able to meet the threshold, the appellant had failed to show that the mark and Signs were so similar as to satisfy the requirements in s 27(2)(b) of the TMA.

20.80 In the Mark/Sign Similarity Inquiry, the court looks at three aspects: visual, aural and conceptual similarities. These are signposting factors in aid of the court's assessment and the comparison is done mark-for-mark without consideration of any external matter. It is firmly established that the Mark/Sign Similarity Inquiry is a question of fact and degree to be determined by the court as whole. The distinctiveness of a mark is an integral part of the Mark/Sign Similarity Inquiry.⁹² In this analysis, the court considers the spectrum of distinctiveness in marks ranging from those with inherent distinctiveness at the one end to those that are generic or descriptive at the other end, bearing in mind there are also marks which may have acquired distinctiveness through long-standing or widespread use.⁹³ The greater the inherent distinctiveness of a mark, the higher the threshold it enjoys before a competing sign will be deemed as dissimilar to it. Greater latitude is given to a defendant in using generic or descriptive words or signs even if these may be found as parts of a registered mark. The essence of the Mark/Sign Similarity Inquiry is a determination of whether the registered mark's ability to function as a badge of origin has been compromised by the defendant's use of the signs, and this must be assessed by looking at the mark as a whole, bearing in mind its distinctive and dominant component.⁹⁴

20.81 In *East Coast Podiatry*, the appellant's mark was a composite mark comprising the device and the words "East Coast Podiatry" in block letters. The Court of Appeal held that the mark's ability to function as a badge of origin was derived entirely from its use as a composite mark. Without the device, the words "East Coast Podiatry" were simply

92 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [90]–[91].

93 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [91].

94 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [92].

not capable of functioning as a badge of origin.⁹⁵ Thus, the Mark/Sign Similarity Inquiry must necessarily be made with reference to the composite mark. In other words, the *only* component that was distinctive in the appellant's mark was the device, and since the respondent's Signs did not contain this crucial element, the Court of Appeal found that the mark and the Signs were clearly dissimilar and the requirements of trade mark infringement in s 27(2)(b) of the TMA were not established.⁹⁶

(c) Confusion Inquiry

20.82 On the issue of whether it would be permissible to consider the respondent's website in the Confusion Inquiry in the light of the Court of Appeal's earlier decision in *Staywell*, the court in *East Coast Podiatry* offered some preliminary views. It has been established in *Staywell* that in the Confusion Inquiry, it is permissible to consider factors which: "(a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumer".⁹⁷ These include:⁹⁸

... factors that *motivate* the consumer to exercise care in the purchase in question directed at, among other things, the forming of a judgment over the source of the product, and factors that *enable* the consumer to exercise such care ... [emphasis in original]

20.83 It is, however, impermissible to consider factors that relate to the differences which were created by a trader's differentiating steps. These are factors which are not inherent in the goods but are susceptible to changes that can be made by a trader from time to time.⁹⁹

20.84 The Court of Appeal in *East Coast Podiatry* accepted that:¹⁰⁰

Where the court has already found that there is similarity in the marks and the goods or services, such that having regard to the characteristics of the

95 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [94].

96 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [95].

97 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [99], referring to *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [95].

98 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [99], referring to *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [93].

99 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [99].

100 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [102].

likely consumer, there would be a likelihood of confusion, then it would *not* be permissible to have regard to further extraneous considerations that might have the effect of diminishing the likelihood of confusion ... [emphasis added]

20.85 A defendant is not permitted to use signs in Internet advertisements that are very similar to a registered mark and yet rely on information found in its Internet advertisements, such as an express disclaimer or other means like using cheaper materials and selling at a much lower price, to avoid liability by using the argument that because of these steps, there is no likelihood of confusion even when there is a high degree of similarity or even identity between the mark and signs.¹⁰¹

20.86 Having said that, the Court of Appeal noted that in infringement proceedings, especially in the context of infringement through use in Internet advertising, it would be permissible to consider the actual circumstances in which the allegedly infringing signs were deployed. This is because it is potentially relevant to consider the interactive nature of Internet advertisements, bearing in mind that the purpose of Internet advertisements is generally to entice users to click through to the relevant website.¹⁰² In turn, this impacts consumer perception of marks similarity and goods similarity. The Court of Appeal did not give a definitive view on this issue, preferring to leave it open for possible consideration in future cases.¹⁰³

B. Trade mark registration – Opposition – Relative ground for refusal – Sections 8(2)(b) and 8(7)(a) of Trade Marks Act 1998

20.87 In *Sunrise v Sunrider*, the General Division heard 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.

20.88 The appellant had applied to register the composite mark  in Classes 5, 29, 30 and 35. The respondent opposed the applications under ss 8(2)(b) (*ie*, “Earlier Registered Mark Ground”) and 8(7)(a) (*ie*, Passing Off Ground) of the TMA. The earlier registered

101 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [102].

102 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [103].

103 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [103]. For a critique of the rigidity of the approach in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911, see David Tan & Benjamin Foo, “The Extraneous Factors Rule in Trademark Law: Avoiding Confusion or Simply Confusing?” [2016] Sing JLS 118.

mark relied upon by the respondent (“Earlier Mark”) was the word mark “SUNRISE” registered in Class 5 for “Herbal drinks”¹⁰⁴ [emphasis in original omitted].

20.89 In relation to the appellant’s applications in Class 5 and in the Class 35 portion of the multi-classes 29, 30 and 35, the PAR allowed the respondent’s opposition under ss 8(2)(b) and 8(7)(a) of the TMA. Since there is no partial opposition whether within or in multi-class applications, the PAR held that the appellant’s trade marks, as a whole, could not proceed to registration.

20.90 The General Division was called upon to decide whether the appellant’s trade mark applications in Class 5 and in Class 35 fell foul of either s 8(2)(b) or s 8(7)(a), or both.

(1) *Earlier Registered Mark Ground: section 8(2)(b) of Trade Marks Act 1998*

20.91 To succeed in s 8(2)(b) of the TMA, the Court of Appeal in *Staywell* had prescribed the step-by-step approach:¹⁰⁵

... 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.

20.92 There was no dispute between the parties on the first requirement of similarity of marks. As such, the appeal before the General Division centred on the second and third requirements of similarity of goods or services and a likelihood of confusion within the meaning of s 8(2)(b) of the TMA.

(a) Similarity of goods and services inquiry

20.93 When assessing similarity of goods and services, the court considers the following list of factors (first propounded by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd*¹⁰⁶ (“*British Sugar*”) and subsequently, endorsed by the Singapore Court of Appeal in *Staywell*):¹⁰⁷

104 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [3].

105 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [15].

106 [1996] RPC 281.

107 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [11], referring to *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 296.

... (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 ...

(i) Class 5

20.94 In relation to the appellant's trade mark application in Class 5, the relevant inquiry for the court was whether the appellant's goods, which were "a nutritional and dietary supplement", were similar to "Herbal drinks included in Class 5", in which the respondent's Earlier Mark had been registered.¹⁰⁸ As the appellant had focused its submissions and arguments on the first two factors in *British Sugar* (ie, (a) the respective uses of the goods/services; and (b) the respective users of the goods/services) in the appeal before the General Division, this article shall discuss the court's analysis of and decision on these two factors.

Respective uses of the goods/services

20.95 Considering the respective uses of the goods, was "nutritional and dietary supplement" in the appellant's application similar to "Herbal drinks included in Class 5", in which the respondent's Earlier Mark had been registered?

20.96 In its analysis, the General Division emphasised the important guiding principle provided by the Court of Appeal in *Staywell*, that while:¹⁰⁹

... 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]

20.97 Thus, consideration should be given to the *ordinary and natural meaning* of "nutritional and dietary supplement" and "herbal drinks" to identify the notional uses of the goods. In doing so, the court accepted that it is indisputable that dictionary meanings assist to illuminate the

108 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [32].

109 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [41].

ordinary and natural meaning of the phrases and words used in the specification of trade mark applications.

20.98 Considered from this perspective, the court agreed with the PAR and found that the definitions of “nutrition” and “nutritional supplements” reinforced the wider definitions of “dietary supplements”, and as such, the ordinary and natural meaning of “nutritional and dietary supplement” was not as narrow as to only include supplements that provided vitamins and minerals. As for the phrase “herbal drinks”, the court found that the ordinary and natural meaning was drinks that consist of or are made from herbs. There was also no dispute that “herbal drinks” would minimally have health benefits. Therefore, there was an overlap between the meanings of “nutritional and dietary supplement” and “herbal drinks” and, accordingly, their respective uses.¹¹⁰

20.99 It could not be said that herbal drinks did not provide vitamins and minerals, and to accept the argument that the uses of “nutritional and dietary supplement” and “Herbal drinks included in Class 5” were not similar simply because the herbal drinks allegedly did not provide vitamins and minerals would be unnaturally and unjustifiably straining the language of “nutritional and dietary supplement”.¹¹¹ Thus, the General Division held that on the ordinary and natural meaning of the phrases, the uses of “nutritional and dietary supplement” were similar to the uses of “Herbal drinks included in Class 5”.¹¹²

Respective users of goods and whether goods were competitive

20.100 On this factor, the General Division agreed with the PAR’s observation that depending on the type of consumer, *ie*, whether they are sensitive to sources of the products, the goods “nutritional and dietary supplement” and “Herbal drinks included in Class 5” could be complementary or competitive. Therefore, this factor in the *British Sugar* framework is a neutral one.¹¹³

110 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [39]–[44].

111 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [48].

112 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [48].

113 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [50].

20.101 In conclusion, the court found there was similarity of goods between the respondent's Earlier Mark and the appellant's application mark in Class 5.¹¹⁴

(ii) Class 35

20.102 In respect of the inquiry into whether there could be similarity between goods and services where the respondent's Earlier Mark was registered for goods and the appellant's application mark was for services in Class 35, the General Division applied the principle in *Guccio Gucci SpA v Guccitech Industries (Pte Ltd)*¹¹⁵ ("*Guccitech*"). Although *Guccitech* relates to a case where the earlier mark was registered for retail services of certain goods and the mark applied for was registered for those goods, the General Division in *Sunrise v Sunrider* found, by an extension of the logic in *Guccitech*, that the principle applied even in the *vice versa* situation.¹¹⁶

20.103 The General Division rejected the appellant's submissions that the principle in *Guccitech* did not apply in the present case because the Respondent's mark was only for one type of product, and not a whole slew of different health products in Class 5. There was no such limitation stipulated in *Guccitech*, and there was no good reason for making such a distinction since the earlier mark was registered in relation to a class of goods in Class 5 and not a singular product.¹¹⁷ Similarly, there is also no requirement that the principle in *Guccitech* only applies where the retail store has same brand as the goods. There were no principled reasons why the court should maintain such a limitation. More importantly, the Nice classification for Class 35 certainly does not contain such limitations, as its specifications includes "Retail services", "Distribution services" and "Promotion services" generally.¹¹⁸

20.104 The court thus found that there was similarity of goods and services between the appellant's application marks in Class 35 and the respondent's Earlier Mark.¹¹⁹

114 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [51].

115 [2018] SGIPOS 1.

116 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [55].

117 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [57].

118 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [57].

119 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [58].

(b) Likelihood of confusion inquiry

20.105 As the court found similarity of goods and services between the appellant's application marks in Classes 5 and 35 and the respondent's Earlier Mark, the final inquiry under s 8(2)(b) of the TMA was whether the requirement of likelihood of confusion was satisfied.

(i) Impact of mark similarity

20.106 The appellant submitted that little weight should be accorded to the similarity between the respondent's Earlier Mark and the appellant's application mark as "Sunrise" was not an invented term but rather a common English word that symbolised new beginnings, optimism and renewal. There was low distinctiveness in the term "Sunrise" and a commonality of brands in Singapore markets with the prefix "Sun". The General Division rejected the appellant's submissions and held that the distinctiveness of a phrase had to be assessed within its particular class and market context.¹²⁰ There was no conclusive evidence which showed the term "Sunrise" to be low in distinctiveness.

20.107 In assessing the impact of mark similarity, the court also considered the reputation of the marks as well as the impression given by the marks and the possibility of imperfect recollection. In respect of the former, the court found that the appellant's assertion – that its mark was associated with the sports business and, following that, consumers would associate a mark for the sports business with health foods – was not supported by evidence or logic.¹²¹ In respect of the latter factor, the court agreed with the PAR that:¹²²

[G]iven 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 ...

20.108 In conclusion, the court found that the marks were visually and conceptually similar to a large extent and aurally identical, and as such, there was a high degree of similarity between them.¹²³

120 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [76]–[79].

121 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [80]–[82].

122 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [82].

123 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [83].

(ii) Impact of goods and services similarity

20.109 The appellant argued that the impact of the goods and services similarity in the present case was low as:

- (a) The degree of similarity of the goods and services was low.
- (b) Consumers would not find the respondent's goods in the form of herbal drinks to be substitutes of the appellant's nutritional and dietary supplements.
- (c) The ways in which the respondent's and the appellant's goods were distributed ensured there was no likelihood of confusion as the respondent's goods were sold through direct sellers in a multi-level marketing model.

20.110 The General Division considered all the factors and found that:¹²⁴

- (a) The degree of similarity of the goods and services was not low as there was substantial overlap between the meanings of the respondent's "Herbal Drinks in Class 5" and the appellant's "nutritional and dietary supplement" and, accordingly, their respective uses.
- (b) Depending on the type of consumer, *ie*, whether they are sensitive to sources of the products, the goods "nutritional and dietary supplement" and "Herbal drinks included in Class 5" can be complementary or competitive. This is thus a neutral factor in the overall analysis.
- (c) Given the similarity of marks, it was not apparent that a likelihood of confusion would be ruled out simply because the respondent's trade channel involved direct sellers, as there might be entities which focused only on natural-based health products and those which focused on health products from both natural and synthetic sources. In any case, there was no evidence adduced in support of the contentions made and as such, the court found this factor on trade channels to be a neutral one.

20.111 Overall, the court found that there was a high degree of similarity of goods and services. Taking into account the high degree of similarity of marks, the General Division was satisfied that there existed a likelihood

124 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [85]–[90].

of confusion on the part of the public,¹²⁵ and accordingly, the appellant's appeal in respect of s 8(2)(b) of the TMA for its application for trade marks in Class 5 and Class 35 was unsuccessful.

(2) *Passing Off Ground: section 8(7)(a) of Trade Marks Act 1998*

20.112 Under s 8(7)(a) of the TMA, a trade mark must not be registered if, or to the extent that, its use in Singapore is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade. To succeed in an action for passing off, it is established law that the three requirements of (a) goodwill; (b) misrepresentation; and (c) damage must be satisfied.¹²⁶

20.113 On the requirement of goodwill, the General Division found that whilst the respondent had manufacturing operations in Singapore, this did not in itself establish goodwill in the product (*ie*, the herbal drinks). It is important to bear in mind the “distinction between the goodwill that may be attached to the corporation ... which carries on manufacturing business in Singapore and the goodwill attached to the product”.¹²⁷ The requirement of goodwill in an action for 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. Although this fact 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, the court concluded that the respondent had *not* provided such evidence of sales or expenses on the relevant date, which was the date on which the conduct complained commenced.¹²⁸ In this case, this date would at the very least be on 16 August 2018, but the evidence adduced by the respondent to show goodwill was all past the relevant date.

20.114 On the element of misrepresentation, the General Division affirmed the material distinction between the test of “likelihood of misrepresentation” in a passing off action and the test of “likelihood of confusion” under s 8(2)(b) of the TMA.¹²⁹ In the former, the test concerns the proprietor’s “goodwill”, whilst the latter concerns the confusion as to

125 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [91].

126 See n 25 above.

127 *Future Enterprises Pte Ltd v Tong Seng Produce Pte Ltd* [1997] 3 SLR(R) 797 at [32].

128 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [108].

129 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [111].

the origin of the parties' goods and not their goodwill.¹³⁰ Since the court found that the respondent had not established goodwill, it could not be said that there existed a likelihood of misrepresentation in this particular case. This must be correct, and the similarities of the tests of likelihood of misrepresentation and likelihood of confusion/connection under the TMA should not have a bearing on the court's conclusion, as pointed out by Kwek Mean Luck J.¹³¹

20.115 Accordingly, the appellant succeeded in its appeal in respect of the Passing Off Ground under s 8(7)(a) of the TMA for its applications in Classes 5 and 35. However, as the General Division dismissed the appellant's appeal against the Earlier Registered Mark Ground under s 8(2)(b) of the TMA, the appellant's applications in Classes 5 and 35 would not proceed to registration.

130 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [111].

131 *Sunrise Plus (Pte) Ltd v The Sunrider Corporation dba Sunrider International* [2025] 3 SLR 1700 at [111].