

THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2022] SGHC 78

Tribunal Appeal No 22 of 2021

Between

Combe International Ltd

... Plaintiff

And

Dr. August Wolff GmbH &
Co. KG Arzneimittel

... Defendant

JUDGMENT

[Intellectual Property — Trademarks — Opposition]

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Combe International Ltd
v
Dr August Wolff GmbH & Co KG Arzneimittel

[2022] SGHC 78

General Division of the High Court — Tribunal Appeal No 22 of 2021
Lee Siu Kin J
4 February 2022

7 April 2022

Lee Siu Kin J:

Introduction

1 When you try your best, but you don't succeed, try, and try again. This was what the defendant¹ in the present case did. They first registered the mark "VAGISAN" in Class 3 ("Soaps, perfumery, essential oils, cosmetics, hair lotions") and Class 5 ("Pharmaceutical products, sanitary products for medical purposes; dietetic substances for medical purposes") on 19 March 2012. At that time, the plaintiff was the registered owner of four "VAGISIL" marks T9804752H, T9804751Z, T0813410H, and T1112897J (the "VAGISIL Marks"), three of which claimed goods in either Class 3 or Class 5. The plaintiff successfully applied to the Principal Assistant Registrar ("PAR") to invalidate the defendant's "VAGISAN" mark. The defendant's appeal against the PAR's

¹ The plaintiff is the appellant before me. To avoid confusion in this judgment, I shall continue to refer to the appellant as plaintiff and the respondent as defendant.

decision was dismissed by Hoo Sheau Peng J (“Hoo J”) in *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626 (“*Combe International Ltd*”).

2 After their initial unsuccessful attempt to keep their “VAGISAN” mark on the register, the defendant revised the mark by adding the words “Dr. Wolff’s”, and reapplied to have the marks registered in both Class 3 and Class 5. The plaintiff, once again, opposed the defendant’s application to register their mark. But this time, the defendant prevailed before the IP Adjudicator (“IPA”), Mr Sheik Umar Bin Mohamed Bagushair, who allowed the registration: *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] SGIPOS 10 (“IPOS Decision”).


3 The plaintiff now appeals against the decision of the IPA. Having heard and considered the submissions of both parties, I dismiss the appeal. These are my reasons.

Background

4 The background to this dispute has been canvassed by Hoo J in *Combe International Ltd* at [2] – [3], but I provide a brief summary here. The plaintiff was founded in 1949 by Ivan Combe. It has a number of in-house brands which it has developed and markets, amongst which are its “VAGISIL” products for feminine care.

5 The defendant is part of Dr. Wolff Group, a family business founded in 1905 and named after its founder, Dr August Wolff. Their business involves the research, manufacture and marketing of dermatological, medicinal and cosmetic products which are distributed in many countries. The name “VAGISAN”, which was conceived by the defendant in 1994, is a portmanteau of the English

word “vagina” and the Latin word “*sanitas*”, which translates to “health”. The defendant sells intimate care products for women under the “VAGISAN” mark in a number of countries such as Austria, Malaysia and the United Kingdom.²

6 There are several ongoing disputes between the plaintiff and defendant, both in Singapore and elsewhere, arising out of objections by the plaintiff to the defendant’s use of the “VAGISAN” mark. As mentioned, the plaintiff was successful in its invalidation action against the defendant’s registration of “VAGISAN” in *Combe International Ltd*. In an attempt to avoid further litigation with the plaintiff, the defendant decided to add “Dr Wolff’s” which was both the founder’s surname and an existing trade mark in Singapore,³ and filed their application to register the mark:  (the “Application Mark”) on 25 May 2018.⁴ Their application was accepted and published by IPOS for opposition purposes on 7 December 2018.⁵

7 On 8 April 2019, the plaintiff filed an opposition to the registration of the Application Mark, in reliance on ss 8(2)(b), 8(4)(b)(i), 8(4)(b)(ii) and 8(7)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”). The IPA found that the opposition failed on all four grounds.

8 In relation to the first ground of opposition relied upon, *ie*, s 8(2)(b) of the TMA, the IPA found that the Application Mark and the defendant’s “VAGISIL” Marks were dissimilar.⁶ As for the second and third grounds of

² Defendant’s Submissions at [9].

³ Defendant’s Submissions at [5].

⁴ Plaintiff’s Bundle Vol 1, p 5.

⁵ Plaintiff’s Bundle Vol 1, p 6.

⁶ Plaintiff’s Bundle Vol 5, p 248 at [79].

opposition, *ie*, ss 8(4)(b)(i) and 8(4)(b)(ii) of the TMA, the IPA held that the plaintiff’s “VAGISIL” Marks were, as of 19 March 2012, not well known to a relevant sector of the public, and that the evidence, in the form of inconsistent sales figures, instead showed that the “VAGISIL” Marks had not become well known since that date. As to the last ground of opposition, *ie*, s 8(7)(a) of the TMA, the IPA held that it failed on the basis that there was unlikely to be passing off as misrepresentation was not established.⁷

9 The plaintiff appealed against the IPA’s decision on the following grounds:

- (a) In relation to s 8(2)(b) of the TMA, that the IPA erred in finding that:
 - (i) The element “Dr. Wolff’s” in the Application Mark is distinctive and is at least of equal distinctiveness with the element “VAGISAN”;
 - (ii) The dominant element in the Application Mark “Dr. Wolff’s VAGISAN” is not “VAGISAN”;
 - (iii) The Application Mark is visually dissimilar to the plaintiff’s “VAGISIL” Marks;
 - (iv) The Application Mark is aurally dissimilar to the plaintiff’s “VAGISIL” Marks;
 - (v) The Application Mark and the plaintiff’s “VAGISIL” Marks are conceptually dissimilar; and

⁷ Plaintiff’s Bundle Vol 5, p 254 at [102].

(vi) The Application Mark and the plaintiff’s “VAGISIL” Marks are dissimilar.⁸

(b) In relation to s 8(7)(a) of the TMA, that the element of misrepresentation was not established.

10 The plaintiff did not appeal against the IPA’s decision with regard to the second and third grounds of opposition under ss 8(4)(b)(i) and 8(4)(b)(ii) of the TMA.

Threshold for appellate intervention in appeals

11 As this is an appeal from the IPA’s decision, O 87 r 4(2) of the Rules of Court (Cap 322, 2006 Rev Ed) provides that an appeal to the court from the decision of the Registrar shall be by way of rehearing. There is therefore no threshold requirement for a material error of fact or law to be shown before appellate intervention is warranted.

12 As was noted by the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Ceramiche Caesar*”) at [15], which usefully clarified any doubts raised by the prior decision in *Future Enterprises Pte Ltd v McDonald’s Corp* [2007] 2 SLR(R) 845, the phrase “shall be by way of rehearing in O 87 r 4(2) of the ROC directs the appellate court to hear the matter afresh”. As such, there is no requirement that a “material error of principle” be shown before an appellate court can intervene in such an appeal: *Ceramiche Caesar* at [15].

⁸ Plaintiff’s Submissions at [2].

13 The court in *Ceramiche Caesar* (at [17] – [23]) gave two other reasons as to why there was no such threshold. First, trade mark opposition proceedings do not involve the exercise of discretion, but rather, involve the question of legal correctness and entitlement: *Ceramiche Caesar* at [17]. This is because once it is shown, for example, that the marks are similar, the goods or services are similar or identical, and that there is a likelihood of confusion arising from the two similarities, the opposition must be allowed. There is no room for discretion. Second, because there is no trial or oral evidence given at trade mark opposition hearings, the appellate court is in as good a position as the trial court in evaluating the facts: *Ceramiche Caesar* at [23] citing *Ho Soo Fong v Standard Chartered Bank* [2007] 2 SLR(R) 181 at [20]; see also Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* Vol 1 at [6.219]. There is therefore no threshold requirement that there be a “material error of fact or law” before appellate intervention is warranted in appeals from the Trade Marks Registry: *Ceramiche Caesar* at [24], *Courts (Singapore) Pte Ltd v Big Box Corp Pte Ltd* [2018] 5 SLR 312 at [15].

14 Finally, I note that the introduction of the new Rules of Court 2021 does not appear to, in any way, affect the principles relating to appellate intervention in appeals from the Trade Marks Registry: see O 70 r 4(2) of the Rules of Court 2021.

Section 8(2)(b) Trade Marks Act

15 The court adopts a step-by-step approach in applying s 8(2)(b) of the TMA: *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 (“*The Polo/Lauren (CA)*”) at [8] and [15]. This means that the court first considers the threshold question of whether the marks, as well as the goods and services in question are similar before proceeding to consider whether there

is a likelihood of confusion on the part of the public: *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“*Staywell*”) at [15]; *Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd* [2006] 1 SLR(R) 401 (“*Richemont*”) at [22]; see Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* Vol 1 at [8.042] – [8.056].

16 In the present case, there was no dispute between the parties as to whether the goods and services in question were similar.⁹ Therefore, I first consider the question of whether the Application Mark was similar to the “VAGISIL” Marks before turning to the question of whether there is a likelihood of confusion on the part of the public.

Similarity of the marks

17 The court’s assessment of marks is directed towards substantive similarity, and comprises of three aspects – visual, aural and conceptual similarities: *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(a)]; *Digi International v Teraoka Seiko Co, Ltd* [2021] SGHC 165 (“*Digi International*”) at [86]. These three aspects guide the court’s inquiry in assessing the similarity of the competing marks but are not meant to be a checkbox exercise: *Staywell* at [17].

18 Further, in determining the similarity of the marks, the distinctiveness of the earlier mark is an integral factor. As the court in *Staywell* noted (at [30]):

...distinctiveness (in both its technical and nontechnical senses) is a factor *integrated into* the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry...

⁹ Plaintiff’s Bundle of Documents Vol 3, p 578 at [108].

19 Where trade marks are concerned, there are two aspects to distinctiveness. First, distinctiveness in the ordinary and non-technical sense simply refers to what is outstanding and memorable about the mark. The court is entitled to consider the distinctive components of a mark in assessing similarity because it is this distinctive component that stands out in the consumer’s imperfect recollection: *Staywell* at [23].

20 Second, distinctiveness in the technical sense refers to a trade mark’s ability to function as a badge of origin. For a mark with greater technical distinctiveness, a higher threshold must be crossed before a competing sign will be considered dissimilar to it. A mark must be assessed as a whole in order to assess its ability to function as a badge of origin – the individual components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness: *Staywell* at [25] citing *Hai Tong* at [35].

21 Where the marks have a common denominator, the question is whether the common element of both competing marks were so dominant such that it rendered the different elements ineffective in obscuring the similarity between the marks: *Staywell* at [27] citing *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 at [25] and *Richemont* at [12].

Distinctiveness of the Application Mark

22 I am mindful that the assessment of distinctiveness is not a separate step in assessing the similarity of the marks. However, in oral submissions before me, it was clear to me that one key issue was whether “Dr. Wolff’s” could be considered as a distinctive component of the Application Mark. This was because the main contention between parties was whether the addition of “Dr. Wolff’s” by the defendant rendered the Application Mark sufficiently dissimilar from the plaintiff’s VAGISIL Marks such that there was no likelihood

of confusion. Further, the question of distinctiveness is a common thread in assessing the visual, aural and conceptual similarities of the marks: *Digi International* at [88]. As such, I begin with this analysis before turning to comparing the visual, aural and conceptual aspects of the competing marks.

23 The plaintiff first argues that the distinctive and dominant component of the Application Mark is “VAGISAN”, and that the IPA erred in finding that “Dr. Wolff’s” was at least as distinctive as “VAGISAN” and that the dominant element in the Application Mark was not “VAGISAN”.¹⁰

24 I deal first with the plaintiff’s contention that “VAGISAN” is the distinctive (*ie*, in the ordinary and non-technical sense) component in the Application Mark because of the difference in font size between “Dr. Wolff’s” and “VAGISAN”.¹¹ The plaintiff points out that the difference in font size is meant to draw the consumer’s attention to the word “VAGISAN”, and it is this difference in font size that makes “VAGISAN” the more distinctive element as it draws and captures the consumer’s attention.

25 For ease of comparison, I set out an enlarged version of the Application Mark, and a smaller version which is what consumers are likely to see on the product’s packaging.

¹⁰ Plaintiff’s Submissions at [10].

¹¹ Plaintiff’s Submissions at [12].

	
<p>Enlarged Version</p>	<p>Smaller Version</p>

26 Although the IPA found that “the difference [was] not significant especially when printed in smaller sizes on the packaging of the products” (IPOS Decision at [46]), it is clear from the side-by-side comparison above that there is a difference, in that the size difference between “Dr. Wolff’s” and “VAGISAN” is somewhat less apparent in the enlarged version, as opposed to the smaller version.

27 That said, even though there is a discernible difference between the font size of “Dr. Wolff’s” and “VAGISAN” when considering a smaller version of the Application Mark that is likely to appear on consumer packaging, I am of the view that this difference is insufficient to render “VAGISAN” the distinctive component of the Application Mark even when one looks at the smaller version. This is because the words “Dr. Wolff’s”, while slightly smaller than “VAGISAN”, are still clearly visible. Indeed, the smaller font size for “Dr. Wolff’s” serves to accentuate those words in the context of the entire mark. In my opinion, the average consumer, when viewing the Application Mark, is therefore likely to register in her mind the words “Dr. Wolff’s” and

“VAGISAN”. This makes both components equally distinctive as they both capture and draw the consumer’s attention.

28 I deal next, with the plaintiff’s contention that the IPA erred in considering that the Application Mark would be printed in smaller sizes on the packaging of the products as this is external matter or circumstances that cannot be taken into account when assessing the similarity of the marks.¹²

29 In comparing the similarity of the marks, the court must consider them as a whole without taking into account any external added matter or circumstances, as the comparison is to be made mark for mark: *Hai Tong* at [40(b)]. In contrast, when considering the likelihood of confusion, the court is entitled to take into account factors such as: the degree of similarity of the marks, the reputation of the marks, and the circumstances in which consumers purchase the goods of the type the mark is used for: *Staywell* at [96].

30 That said, this mark-to-mark comparison is undertaken from the average consumer’s point of view, *ie*, someone who would exercise some care and measure of good sense in making his or her purchases, not that of an unthinking person in a hurry: *Hai Tong* at [40(c)]. The marks should not be examined side by side in close proximity so as to account for the “imperfect recollection” of the consumer: *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [18]; *Hai Tong* at [40(d)]. It may well be that in undertaking this exercise, the size of the marks being compared does matter. Smaller details may well become more pronounced in a larger version of the mark, as opposed to a smaller one, and thus more likely to stand out in one’s memory. However, in the present case, this has no bearing on my decision because I find, for the

¹² Plaintiff’s Submissions at [13].

same reason at [27] above, that the slight difference in font size between “Dr. Wolff’s” and “VAGISAN” is sufficient to render both components distinctive, regardless of whether one looks at an enlarged or smaller version of the Application Mark.

31 Having dealt with distinctiveness in the non-technical sense, I turn now to consider the plaintiff’s argument that “VAGISAN” is the more distinctive (*ie*, in the technical sense) component in the Application Mark as opposed to “Dr. Wolff’s”.¹³

32 There are two aspects to distinctiveness in the technical sense: *Staywell* at [24]; *Digi International* at [91] – [119]. The first is inherent distinctiveness where words comprising the mark are meaningless and say nothing about the goods or services. The second is acquired distinctiveness, where the words have acquired the capacity to act as a badge of origin through long-standing or widespread use even though the words may have a meaning or describe the goods or services.

33 Where inherent distinctiveness is concerned, the plaintiff argues that “VAGISAN” has a higher level of distinctiveness as compared to “Dr. Wolff’s”. This is because “VAGISAN” is an invented word whereas “Dr. Wolff’s” bears the meaning of referring to a doctor.¹⁴ The plaintiff further argues that courts and tribunals have recognised that the use of “Dr – Formative” marks tend to be less distinctive as they are intended to establish the credibility of the goods with reference to a doctor or medical professional or by alluding to the health-related

¹³ Plaintiff’s submissions at [15].

¹⁴ Plaintiff’s Submissions at [15].

properties of the goods.¹⁵ In support of this proposition, the plaintiff cites the following cases of *Combe International LLC and Others v Dr August Wolff GmbH & Co KG Arzneimittel and others* [2021] EWHC 3347 (Ch) (“*Combe (UK HC)*”), *Dr. Grandel GmbH v S.A. SPA Monopole* Case No. R 91/2003-4 (“*SPA Monopole*”) and *Dr. Grandel GmbH v Gowoonseesang Cosmetics Co. Ltd.* Opposition No B 3 051 772 (“*Gowoonseesang*”). I now discuss them in turn.

34 As alluded to previously at [6] above, parties have been locked in litigation around the world in relation to the use of the “VAGISAN” mark and “VAGISIL” Marks, of which *Combe (UK HC)* was but one instalment in their legal tussle over use of the marks. In that case, the same plaintiff in the present suit had sued the same defendant for trade mark infringement. During the course of oral submissions, the plaintiff there cited the following passage for the proposition that “Dr – Formative” marks had lower distinctiveness (*Combe (UK HC)* at [289(iii)]):

As Ms Want pointed out in her witness statement for trial, it is common for pharmaceutical and cosmetic brands to use “Dr” followed by a name as the “house” brand for a range of sub-products (she gave a number of examples.) In such cases, it seems to me, the use of “Dr” followed by a name is intended to seek to establish the credibility of the product – since it gives the impression it has the imprimatur of someone who is medically qualified. It is therefore not, it seems to me, likely to be understood as a signifier of trade origin, but rather an indicator of the authenticity and likely effectiveness of the product which is then described. That conclusion, it seems to me, is reinforced by the evidence of Mr Bowman (see above at [277]), to the effect that he still refers to the Defendants’ Moist Cream product as VAGISAN despite the rebranding. It seems quite natural to me that he should do so.

35 In response, the defendant sought to distinguish *Combe (UK HC)* on the basis that it was decided along different principles. That much is apparent from

¹⁵ Plaintiff’s Submissions at [20].

Adam Johnson J’s comments where he stated that “whether there is a risk of confusion must involve comparing the competing signs, and the carrying out of a global assessment taking account of all the relevant factors”: *Combe (UK HC)* at [288]. In Singapore, however, as the defendant correctly observes, it is the step-by-step approach, rather than the global assessment method, that applies: *The Polo/Lauren (CA)* at [8] and [15].



36 In any case, while that decision is not binding on me, I make one observation. In *Combe (UK HC)* at [289(iii)], the witness, Ms Want, had testified that pharmaceutical and cosmetic brands commonly used “Dr” followed by a name as the “house brand” for a range of sub-products. Adam Johnson J took the view that, based on her statement, the use of “Dr” followed by a name was not likely to be understood as a signifier of trade origin, but rather as an indicator of authenticity and effectiveness of the product. It is clear that Adam Johnson J’s decision was premised on his evaluation of the evidence before him, rather than it being an established principle of trade mark law.

37 In *SPA Monopole*, the proprietor of the mark “SPA” took out opposition proceedings against the applicant’s attempt to register the mark “Dr. Grandel Spa”. The Fourth Board of Appeal took the view (at [31]) that “SPA” had, due to the well-known character of the town of the same name and its mineral waters, an enhanced distinctive character. Therefore, when compared to “Dr. Grandel”, which was simply the surname of an otherwise unknown doctor, from the perspective of the average Benelux consumer, the word “SPA” of the applicant’s mark was more distinctive. The Board further found that where cosmetics, and beauty and wellness products are concerned, because manufacturers market several product lines under a specific sub-brand, consumers will consider that “Dr. Grandel Spa” goods would be marketed under

the control of the manufacturer of identical or highly similar goods bearing the “SPA” trade mark.

38 The plaintiff relies on this to argue that the IPA, in holding that “Dr. Wolff’s” was as distinctive as “VAGISAN” overlooked the fact that “Dr. Wolff’s” was likely to be perceived as the name of an otherwise unknown doctor, as was the case in *SPA Monopole*, especially given the vast number of “DR-formative” trade marks used on Class 3 and 5 goods in the local market.¹⁶

39 I reject this argument for two reasons. First, in *SPA Monopole*, the reason why the Board found that “Dr. Grandel” was less distinctive was because “SPA” had enhanced distinctive character. This says nothing as to the distinctive character of “Dr. Grandel”, and indeed, as to the distinctive character of “DR-formative” trade marks in general. Second, I do not think that it would be appropriate, at the mark similarity stage of the analysis, to take into account the fact that there are a vast number of “DR-formative” trade marks for Class 3 and 5 goods. This amounts to external material, which simply cannot be taken into account for the purposes of comparing mark similarity: *Staywell* at [20]; *Sarika* at [17]; *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 (“*Mediacorp*”) at [33].

40 Finally, in *Gowoonsesang*, the case concerned an opposition against the European Union trade mark for the figurative mark . The opposition was based on the earlier registered European trade mark . The Opposition Division was of the view that the relevant public would, in trying to read the combination of letters in such a way that it has meaning for them, understand

¹⁶ Plaintiff’s Submissions at [21].

the earlier trade mark as “Dr. G”. To that end, “Dr.” would be understood as a common abbreviation for “doctor” throughout the EU, and given that the relevant goods are cosmetics with health-related qualities, the element “Dr.” would be understood as alluding to the health-related properties of the goods, and thus have a lower-than-average degree of distinctiveness. The Opposition Division however, found that the letter “G” was of normal distinctiveness as it had no meaning in relation to the relevant goods.

41 In my view, this case does not take the plaintiff’s case very far. Here, I would draw a distinction between the meaning a word carries, and what it may allude to. In *Beats Electronics, LLC v LG Electronics Inc.* [2016] SGIPOS 8 at [22], Professor David Llewelyn (“Prof Llewelyn”), sitting as the IPA, held that the mark in question, “QuadBeat”, was an invented word and thus had a considerable degree of distinctiveness as it was meaningless. However, Prof Llewelyn observed that while the “QuadBeat” mark had no meaning, it did have “allusive impact” when used in relation to audio electronic products.

42 Similarly, in the present case, while “Dr. Wolff’s” may allude to the fact that the product in question is perhaps one that has been endorsed by a medical professional, on its own, “Dr. Wolff’s” carries no meaning. Therefore, in my view, where technical distinctiveness is concerned, “Dr Wolff’s” is as distinctive as “VAGISAN”.

43 Having found that “Dr. Wolff’s” is as distinctive, in both the technical and non-technical senses of the word, as “VAGISAN”, I now turn to the analysis of visual, aural and conceptual similarity.

Visual similarity

44 In assessing the visual similarity of the marks, the court does so with the “imperfect recollection of the average consumer”: *Hai Tong* at [62(a)]. Both marks should not be compared side by side or examined in detail as the average consumer would compare the marks from memory, removed in time and space from the marks: *Mediacorp* at [33]. Further, the distinctive and dominant components of the marks must be taken into account, and where other components of a complex mark or sign are of negligible significance, the comparison can be made solely on the basis of any dominant elements: *Hai Tong* at [62(b)].

45 The IPA, in arriving at the conclusion that the marks were visually dissimilar, relied on the following factors (IPOS Decision at [56] – [62]):

- (a) The Application Mark had 15 letters whilst the plaintiff’s “VAGISIL” Marks had 7 letters;
- (b) Consumers with an imperfect recollection would nevertheless remember that the Application Mark has two additional words;
- (c) The Application Mark and the plaintiff’s “VAGISIL” Marks only have 5 letters in common; and
- (d) None of the words in the Application Mark are identical with the plaintiff’s “VAGISIL” Marks.

46 The plaintiff argues that the IPA erred in reaching the findings above because the cases he relied on were all distinguishable. Their argument essentially hinges on the point that the difference in size between “VAGISAN” and “Dr. Wolff’s” means that “VAGISAN”, being the more distinctive and

dominant element of the Application Mark, would thus more likely be remembered by the average consumer.

47 However, having found above that “Dr. Wolff’s” and “VAGISAN” were of equal distinctiveness, I do not think that the average consumer would only have a recollection of “VAGISAN” and not “Dr. Wolff’s”. While “Dr. Wolff’s” does appear to be slightly smaller than “VAGISAN”, it is not so small to the point that the average consumer would gloss over it.

48 I make one observation in relation to the case of *Louis Vuitton Malletier v Human Horizons Holding (Shanghai) Co., Ltd* [2021] SGIPOS 13 which the plaintiff cited for the proposition that word marks with a common component can be visually similar.¹⁷ In that case, the IPA reached the conclusion that the

application mark, **HUMAN HORIZONS** and the earlier mark, **HORIZON** were of low visual similarity. The IPA’s reasons were that, first, the application mark contained the entirety of the earlier mark, notwithstanding the difference between plural and singular forms, and second, both elements of the application mark (*ie*, “HUMAN” and “HORIZONS”) were equally prominent.

49 The present case however, is quite different. For one, the Application Mark here does not contain the entirety of the plaintiff’s “VAGISIL” Marks, notwithstanding Hoo J’s earlier finding that the “VAGISIL” and “VAGISAN” marks were visually similar. Second, the IPA had found that “HUMAN” and

¹⁷ Plaintiff’s Submissions at [38].

“HORIZONS” were equally prominent. But, to my mind, that is different from saying that both components are of equal distinctiveness.

50 Ultimately, as I noted in *Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 at [17], visual similarity is assessed by reference to the overall impressions created by the mark or signs, bearing in mind their distinctive and dominant components. Taking into account the fact that the Application Mark has an added distinctive component in “Dr. Wolff’s”, and the length and structure of the marks, I am of the view that both marks are visually dissimilar.

Aural similarity

51 In assessing the aural similarity of the marks, there are two applicable approaches. The first considers the common dominant and distinctive elements of the marks in question to determine if they are aurally similar (the “Dominant Approach”): *Staywell* at [31]. The second involves a quantitative assessment as to whether both marks have more syllables in common than not (the “Quantitative Approach”): *Staywell* at [32]; *Sarika* at [28].

52 Before the IPA, parties accepted that the Dominant Approach was applicable: IPOS Decision at [63] – [64]. In finding that the marks were aurally dissimilar, the IPA relied on the following findings (IPOS Decision at [66]):

- (a) The element “Dr. Wolff’s in the Application Mark is distinctive and is at least of equal distinctiveness with the element “VAGISAN”;
- (b) The plaintiff’s “VAGISIL” Marks, while distinctive, only possess a normal degree of distinctiveness;

- (c) The plaintiff’s “VAGISIL” Marks have not acquired a high level of distinctiveness through use;
- (d) “VAGI” is of weak distinctive character, and
- (e) The dominant element in the Application Mark is not “VAGISAN”.

53 The plaintiff argues that the IPA erred in considering that the average consumer would pronounce the mark as “Dr. Wolff’s VAGISAN”.¹⁸ They say that the average consumer is likely to recall and pronounce the dominant component of the Application Mark, which is “VAGISAN”.¹⁹ I disagree. In examining aural similarity, it is permissible for the court to examine the distinctive components of the competing marks in both the technical and non-technical senses: *Staywell* at [31]. Given my finding above that “Dr. Wolff’s” is of equal distinctiveness with “VAGISAN”, I am of the view that the average consumer would likely pronounce the Application Mark as “Dr. Wolff’s VAGISAN”.

54 Where the Quantitative Approach is concerned, doubt has been raised as to the applicability of this approach in cases involving composite marks with different elements of widely varying degrees of distinctiveness: *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 (“*Guccio Gucci*”). The reason for this is that it would allow a party to distinguish a later mark from another party’s distinctive earlier mark incorporated in it by adding sufficient

¹⁸ Plaintiff’s Submissions at [42].

¹⁹ Plaintiff’s Submissions at [46].

matter of a descriptive nature to overwhelm the distinctive element that comprises the distinctive earlier mark: *Guccio Gucci* at [27].

55 These concerns, however, do not apply in the present case. As I have found, “Dr. Wolff’s” is of equal distinctiveness with “VAGISAN”. This is not a case where the applicant has added words of a descriptive nature to overwhelm the distinctive element of an earlier registered mark incorporated in the later mark.

56 In applying the quantitative assessment, it is clear that both marks are aurally dissimilar. Both marks do not have more syllables in common than not because of the defendant’s addition of “Dr. Wolff’s”.

Conceptual similarity

57 In the earlier invalidation proceedings, the PAR had found that the Application Mark and “VAGISIL” Marks were conceptually neutral. This finding was not challenged on appeal as parties agreed that they were conceptually neutral: *Combe International Ltd* at [44]. The plaintiff argues that the addition of “Dr. Wolff’s” in the Application Mark does not render it conceptually distinguishable and dissimilar from the Plaintiff’s “VAGISIL” Marks.²⁰ This is because the effect of adding “Dr. Wolff’s” to “VAGISAN” merely suggests that “VAGISAN” belongs to Dr Wolff, whoever he or she may be.²¹ It does not add or convey any new or alternate meaning.²²

²⁰ Plaintiff’s Submissions at [48].

²¹ Plaintiff’s Submissions at [48].

²² Plaintiff’s Submissions at [48].

58 In that vein, the plaintiff says that the IPA erred in finding that the Application Mark was conceptually dissimilar as it suggested a product owned or created by a Dr. Wolff: IPOS Decision at [72]. They say that the IPA’s reasoning ignores the fact that “VAGISAN” is an invented word that has no meaning. The plaintiff further argues that if the IPA’s reasoning is taken *ad absurdum*, traders would be able to circumvent any finding that a mark is conceptually similar to an earlier mark by simply adding a possessive identifier.²³

59 Where conceptual similarity is concerned, the inquiry is directed at the idea behind, or informing the understanding of, the mark: *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [38]. For example, in *Sarika*, the Court of Appeal found at [34] that the words “Nutello” and “Nutella” were invented and meaningless, with no particular idea underlying each of them.

60 However, where a composite word mark is concerned, greater care is needed in considering what the conceptually dominant component of a composite mark is as the idea connoted by each component may be very different from the sum of its parts: *Staywell* at [35].

61 Considering the Application Mark as a whole, I was of the opinion that it was conceptually dissimilar from the “VAGISIL” Marks. This was because the idea behind the Application Mark was that there was a medical professional, viz, a Dr. Wolff, who either created, owned or endorsed the product named “VAGISAN”. The addition of “Dr. Wolff” gave rise to the idea that the product in question was developed with the expertise of medical professionals.

²³ Plaintiff’s Submissions at [48].

62 As for the plaintiff’s contention that such reasoning would enable traders to circumvent an earlier finding that the marks were conceptually similar by adding a possessive identifier, I was of the view that such concerns were unfounded. The whole point of a trade mark is to serve as a badge of origin, or as some modern observers would point out, as an indicator of quality: see *Scandecor Developments AB v Scandecor Marketing AV* [2001] 2 CMLR 30 at [12] – [13]. To that end, it stands to reason that the trade mark register should not contain similar trade marks as that might confuse the average consumer as to either the origin or quality of the goods: see *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [41]; Neil J. Wilkof & Daniel Burkitt, *Trade Mark Licensing* (Sweet & Maxwell, Second Ed, 2005) at [2-20] – [2-22]. But this does not mean that once a court or tribunal has invalidated a mark on grounds that they were similar with an earlier mark, or refused the registration of a mark on the same grounds, that the proprietor of that mark cannot make changes to that mark in order to better distinguish it from any other mark on the register, and attempt to have it registered again. The court would then have to assess the modified mark and determine whether its registration should be refused, or whether the changes have rendered it sufficiently dissimilar from the earlier mark, such that there is no likelihood of confusion.

63 Having found that the Application Mark is visually, aurally, and conceptually dissimilar to the plaintiff’s VAGISIL Marks, I turn now to examine the likelihood of confusion between the marks.

Likelihood of confusion

64 The similarity of marks inquiry is one that must be satisfied before the court proceeds to consider whether there is a likelihood of confusion: *Staywell* at [15]. Although this threshold requirement is not fulfilled in the present case,

I proceed to analyse whether there is a likelihood of confusion given that the factors considered here may also be considered in whether there has been misrepresentation, where the tort of passing off is concerned: see [82] below. Because the similarity of goods was not an issue in the present case, I only need to consider the impact of mark-similarity on consumer perception.

65 In determining whether there is a likelihood of confusion, the test is whether a substantial portion of the relevant public will be confused: *Sarika* at [57]; *Digi International* at [172]. The relevant public comprises of the actual or potential purchasers of the goods or services of the plaintiff and defendant, and those who deal with these goods: *Digi International* at [174] citing Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) at para 21.5.27.

66 Who the actual or potential purchasers of the goods are does have a bearing on whether there is a likelihood of confusion. In *Mediacorp*, I noted at [50] that the average consumer in respect of Class 35 services (which generally dealt with consultancy and advisory services relating to businesses) would be business organisations and not ordinary or retail customers. Such business enterprises were discerning in making their choices and would be careful especially when choosing their service provider for services relating to publicity and/or business-related information. It was therefore unlikely that these consumers would confuse the trade source of one mark for the other.

67 This is also the case where health-related products are concerned. In *Miragan* [2001] UKIPO O/414/01, opposition proceedings were taken out against the trade mark “MIRAGAN” which was sought to be registered in respect of Class 5 (“Pharmaceutical preparations for the treatment of glaucoma”). The Hearing Officer at [17], in assessing the likelihood of

confusion, opined that such pharmaceuticals could only be available on a doctor's prescription or through a pharmacist, and that such professionals would be more observant and circumspect than others. However, the Hearing Officer proceeded on the basis that the products were made directly available to the general public as there was no evidence that a prescription was required to obtain the products.

68 The average consumer in the present case would obviously be women given that the products in question are intimate feminine care products. Here, I respectfully agree with Hoo J's finding at [54] of *Combe International Ltd* that the following two factors would militate against a finding of a likelihood of confusion:

...First, while the relevant goods are relatively inexpensive, I was mindful that the nature of the goods would tend to command a greater degree of fastidiousness and attention on the part of prospective purchasers. The goods in question are highly personal self-care products for women, which require greater care in selection: *Consolidated Artists BV v THEFACESHOP Co Ltd* [2017] SGIPOS 7 ("THEFACESHOP") at [123]. In concluding that there was no likelihood of confusion, the Registrar at [120] observed that, while the goods in Class 3 for body and face care were not very expensive and were purchased off the shelf, consumers "will be cautious about what they are purchasing". Furthermore, such a purchasing decision would not be made "lightly" as it was a "choice with possible adverse consequences if the wrong products are used, e.g. allergies or acne breakouts": see [120]. Similarly, the Federal Court of Australia in *August Wolff (AU)* ([9] *supra*) opined at [68] that "[t]he proposition that a woman is likely to pay little attention to the particulars of any product that she might put in her vagina or on her vaginal area inherently lacks credibility". Female consumers in Singapore would likely pay at least a medium level of attention before or during the purchase of the products in question. Accordingly, I agreed with the PAR (at [65] of the GD) that the relevant segment of the public would not simply purchase the goods in question in a hurry without putting in some care and attention into the purchase process.

Second, while a portion of consumers would purchase the relevant products online, it seemed to me that, at present,

consumers still normally purchase these goods in brick-and-mortar shops. In THEFACESHOP, the Registrar held at [123] that although the facial and body care products were self-service items, “specialists abound to assist in the purchase, having regard to the deeply personal nature of the same”. Furthermore, the Registrar held at [122] that “consumers will be more particular about the origin or marks of such goods, as they are likely to trust certain brands more than others” [emphasis in original]. This applies with equal if not greater force to purchases of intimate care products. Notwithstanding that intimate care products may be self-service items, when purchased from shops, decisions to buy these items are likely to be made with the assistance of specialists...

69 The plaintiff however, argues that there is a likelihood of confusion because of the following factors:²⁴

- (a) The Application Mark is similar to the plaintiff’s “VAGISIL” Marks to, at least, an average degree.
- (b) The plaintiff’s “VAGISIL” Marks have a respectable degree of reputation.
- (c) The Application Mark is sought to be registered in respect of goods that are similar or identical to the goods for which the plaintiff’s “VAGISIL” Marks are registered.
- (d) The relevant segment of the market for goods covered by the Application Mark and “VAGISIL” Marks are the same.
- (e) Taking into consideration the imperfect recollection of the consumer, the fact that the consumer has done prior research into the product does not negate the likelihood of confusion.

²⁴ Plaintiff’s Submissions at [56].

(f) The goods in question are relatively inexpensive and thus the consumer will not pay much attention when purchasing the products. Further, consumers may be embarrassed in purchasing the product given the condition it treats, and thus will not linger when selecting the product.

70 I have found that the marks are dissimilar. But even if I were - wrong on that point, I would hold that there is a low degree of similarity between the marks because of the addition of the element “Dr Wolff’s”.

71 As for the reputation of the plaintiff’s “VAGISIL” Marks, the greater its exposure and use, the greater its reputation is likely to be, and therefore the greater the protection that should be afforded to it: *The Polo/Lauren (CA)* at [34]. The IPA had found that the “VAGISIL” Marks did not have a strong reputation because they were not well known. He based his conclusion on the fact that the sales of “VAGISIL” products peaked in 2012, declined thereafter, and have not recovered since: IPOS Decision at [85] – [86]. The plaintiff, in their statutory declaration, relies on two examples of third-party references to “VAGISIL” to demonstrate the strong reputation of the mark.²⁵ The first was an article published in June 2010 titled, “Questions About Vaginal Health Answered” at the following link: www.herworld.com/mensex/questions-about-vaginal-health-answered. The article is in a question-and-answer format with a Dr Douglas Ong and a Dr Christopher Ng. While both doctors answered questions related to vaginal health in the article, they made no reference to, nor do they recommend the plaintiff’s “VAGISIL” products. The only reference to

²⁵ Plaintiff’s Statutory Declaration at [17].

“VAGISIL” comes at the end of the article in the form of what appears to be an advertisement:

Q: What is the biggest warning sign that a woman can have in terms of vaginal health that tells her she should get checked out by a doctor?

Dr Ong: No one sign is superior to another. In terms of signs: abnormal vaginal bleeding, bleeding after sex, bleeding after menopause or recurrent vaginal infections should warrant a visit to your gynae. Lifestyle is another important but overlooked factor that women must consider – if you smoke, have had multiple sexual partners, casual sex with strangers or if your partner has had multiple partners, you may also be at risk of STDs and genital cancer.



If you suspect you're suffering from a vaginal infection but don't want to spend money to see a gynae, then try out the Vagisil Screening Kit. By measuring your vaginal pH, it can let you know whether you've got a vaginal infection that can be treatable by over-the-counter products or if you need to see a gynae for more serious conditions. Available at pharmacies.

72 Given how “VAGISIL” was referred to in this article, it is clear to me that it was indeed in the form of an advertisement, and thus did not necessarily demonstrate that the “VAGISIL” Marks enjoyed a strong reputation in Singapore.

73 The second was an article published in April 2010, “Vigil over V-Spot” in The New Paper and subsequently reposted on the National University Hospital’s website. This article reported that Singaporean women were more informed about vaginal infections, and contained short quotes from various doctors, along with the following reference to “VAGISIL”:

Available over the counter

...Vagisil claims the kit is the first of its kind that is available over the counter. The kit is easy to use and can show users the results quickly. (See report, right) But doctors said that women who come to them with symptoms of vaginal infections are usually made to go for laboratory tests which take some time. They do not issue vaginal infection self-screening kits and caution against relying too much on such kits. Dr Chew fears that women who use the kit may end up self-medicating and delay proper treatment as a result. He added that the results

may not necessarily point the user to the exact type of vaginal infection she has...

...Dr Chew said he would **“evaluate the kit” before allowing his patients to use it**. Ms Cheryl Soh, marketing manager of Corlison which distributes the Vagisil Screening Kit for Vaginal Infections, explained that the kit actually “prevents self-medicating”...[emphasis added]

74 I did not think this article lent support to the plaintiff’s assertion that the “VAGISIL” Marks enjoyed a strong reputation in Singapore. The context in which “VAGISIL” is mentioned in the article suggests that this too was possibly another attempt to market a “VAGISIL” product. Apart from Dr Chew, none of the other doctors quoted made reference to “VAGISIL”.

75 I further note that both articles were published in 2010. The plaintiff has not adduced any more recent evidence, *ie*, in the form of consumer surveys or otherwise, to demonstrate that the “VAGISIL” Marks enjoys a strong reputation in Singapore. I thus agree with the conclusion that the IPA reached, that the reputation of the “VAGISIL” products is a neutral factor in considering the likelihood of confusion. It is clear from the declining sales figures that the “VAGISIL” Marks may not enjoy a strong reputation in Singapore. After all, if the “VAGISIL” Marks did have such a strong reputation, one would expect to see strong sales year after year.

76 I turn now to deal with the rest of the plaintiff’s contentions. While factors listed by the plaintiff do lean towards a finding of the likelihood of confusion, *viz*, similarity of the goods and that the market for the products are the same, I am of the view that the nature of the products are such that the consumer would be more careful in making their purchases, notwithstanding the fact that the products in question are cheap, such that there is no likelihood of confusion.

77 The plaintiff attempted to adduce evidence in the form of a survey, conducted in conjunction with the plaintiff's #BlogHer18 Health event held in New York in January 2018 to show that because women were too embarrassed to discuss vaginal issues even with their doctors,²⁶ they would therefore hastily purchase intimate health products without paying much attention to the associated trade mark which increases the likelihood of confusion. However, I was not persuaded by this. In interpreting statistical data, it is important to understand what the data actually represents. For one, the sample size of the survey is rather small, with only 1,276 responses being received, out of which 553 were complete responses.²⁷ Even if one accepts that the sample size is sufficiently large to be statistically significant, and reflects the viewpoint of the average Singaporean woman, all it says is that 45% of women are too embarrassed or ashamed to discuss vaginal issues even with their doctor.²⁸ It is therefore clear that the survey results did not reflect consumer attitudes towards purchasing intimate care products.

78 Even accepting the survey results, which showed that women were uncomfortable talking about vaginal issues, the inference drawn is that when confronted with such issues, women may be more likely to self-medicate than see a doctor. But this means that it is more likely that they would take the time to research the various available products so that they could make an informed decision before making their purchase. Or they may be drawn towards purchasing the product online so as to avoid the risk of being seen purchasing such products in a brick-and-mortar shop. In any case, absent evidence demonstrating consumer habits when it came to purchasing intimate care

²⁶ Plaintiff's Statutory Declaration at [27].

²⁷ Plaintiff's Bundle of Documents, Vol 1 at p 291.

²⁸ Plaintiff's Bundle of Documents, Vol 1 at p 291.

products, it seemed eminently logical, and indeed, even common sensical to me that women would pay more attention when purchasing such products.

79 Accordingly, for the reasons given above, I find that there is no likelihood of confusion.

Section 8(7)(a) Trade Marks Act

80 Section 8(7)(a) of the TMA provides that a trade mark should not be registered if, or to the extent that, its use in Singapore is liable to be prevented by any rule of law, which in this case, is the law of passing off. The three elements of passing off are: goodwill, misrepresentation and damage to goodwill: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [37].

81 It is not disputed that the plaintiff has acquired goodwill in its business in Singapore under the VAGISIL Marks in respect of the goods in question.²⁹ The plaintiff, however, argues that the IPA erred in finding that, because the use of the Application Mark was unlikely to result in consumers being deceived or confused into thinking that the Applicant’s goods are, or emanate from a source that is linked to the “VAGISIL” Marks, there was no misrepresentation: IPOS Decision at [101] – [102].

82 As the IPA rightly noted (IPOS Decision at [91]), the test for misrepresentation under the tort of passing off is substantially the same as the “likelihood of confusion” under s 8(2)(b) of the TMA. As noted in *Hai Tong* (at [115]), in an action for passing off the court is not constrained in the same way

²⁹ Plaintiff’s Submissions at [59].

that it would in a trade mark infringement action (and similarly, in trade mark opposition proceedings) in identifying the factors it may take into account.

83 For example, in *Amanresorts*, the court pointed out (at [83]) that it would have been a relevant consideration in increasing the likelihood of confusion if the appellant had been found to have had fraudulent intentions in using the “Amanusa” name for its project (*ie*, if the appellant had set out to deceive those with goodwill towards the “Aman” names). This is not a factor which the court can, or should take into account where opposition proceedings are concerned.

84 The rationale for the difference in the sort of factors that the court can take into account when considering whether there has been misrepresentation under passing off, and whether there is a likelihood of confusion, is readily apparent when one examines the respective interests protected by passing off and trade marks. On the one hand, passing off protects the plaintiff against damage caused to the goodwill attached to its business, goods or services by the defendant’s misrepresentation: *Amanresorts* at [94]. In that vein, misrepresentation is the gist of passing off, and while the defendant’s state of mind in making the misrepresentation is generally irrelevant, “evidence of a dishonest or deliberate attempt to misappropriate another’s goodwill is always relevant, for the court will not be astute to say that he cannot succeed in doing that which he is straining every nerve to do”: Gary Chan, *The Law of Torts in Singapore* (Academy Publishing, 2nd Ed, 2016) at [14.081] citing *Slazenger & Sons v Feltham & Co* [1889] 6 RPC 531, 538.

85 On the other hand, trade mark law mainly protects consumers by allowing them to differentiate between goods and services sold: *Mediacorp* at [50], Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* Vol 1 at [2.004]. This inquiry here focusses on the similarity of the marks, the

similarity of the goods or services, and whether there is a likelihood of confusion on the part of the consumer.

86 Given that I have found that there is no likelihood of confusion, it therefore follows, for the same reasons at [64] – [79] above, that the element of misrepresentation is not established. I therefore find that the grounds of opposition under s 8(7)(a) of the TMA are not made out.

Conclusion

87 For the reasons given above, I dismiss the appeal with costs to the defendant.

Lee Siu Kin
Judge of the High Court

Goh En-Ci Gloria, Soon Jia Ling Amanda, Lim Yong Sheng (Allen &
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