

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

[2021] SGHC 293

Suit No 693 of 2020

Between

All India Supermart Pte Ltd

... Plaintiff

And

- (1) Indian Supermarket Pte Ltd
- (2) Duraikkannu Baskaran

... Defendants

Originating Summons No 477 of 2021

Between

All India Supermart Pte Ltd

... Applicant

And

- (1) Indian Supermarket Pte Ltd
- (2) Duraikkannu Baskaran

... Respondents

JUDGMENT

[Intellectual Property] — [Trade marks and trade names] — [Declaration of
invalidity]

[Intellectual Property] — [Trade marks and trade names] — [Infringement]

[Intellectual Property] — [Trade marks and trade names] — [Invalidity]

[Intellectual Property] — [Trade marks and trade names] — [Passing off]

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All India Supermart Pte Ltd
v
Indian Supermarket Pte Ltd and another

[2021] SGHC 293

General Division of the High Court — Suit No 693 of 2020 and Originating Summons No 477 of 2021

Valerie Thean J

21–24 September, 15 November 2021

31 December 2021

Judgment reserved.

Valerie Thean J:

Introduction

1 The plaintiff, All India Supermart Pte Ltd (“AISPL”), and the first defendant, Indian Supermarket Pte Ltd (“ISPL”), are Singapore-incorporated companies in the business of operating Indian supermarkets in Little India.¹ The second defendant, Mr Duraikkannu Baskaran (“Mr Baskaran”), is the sole director and 50% shareholder of ISPL.² I refer to ISPL and Mr Baskaran collectively as “the defendants”.

¹ Statement of Claim (Amendment No 1) dated 20 October 2020 (“SOC”) at paras 1, 5 and 7; Defence of the 1st and 2nd Defendants (Amendment No 2) dated 2 September 2021 (“Defence”) at paras 1, 5 and 7.

² SOC at para 6; Defence at para 6.

2 By this suit (“the Suit”), AISPL claims that the defendants are jointly liable for the common law tort of passing off and for infringing AISPL’s registered trade mark under s 27(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the TMA”). In addition, AISPL has filed an originating summons (“the OS”) seeking the invalidation of ISPL’s registered trade mark under s 23 of the TMA.³

Background

3 AISPL was incorporated in Singapore on 21 July 2015.⁴ Since November 2015, AISPL has operated an Indian supermarket under the trade mark and trade name “ALL INDIA SUPERMART”. AISPL’s supermarket is located in a four-storey building at 41 Norris Road selling various Indian provision goods, vegetables, fruits, and personal use and household items.⁵

4 From November 2015 to November 2019, AISPL was run by Mr Ayyakkannu Mathivanan (“Mr Mathivanan”) and Mr Rethinagumar s/o Pillai Velayudham (“Mr Rethinagumar”).⁶ Mr Kalai Meyyappan Ramalingam (“Mr Ramalingam”) purchased AISPL’s shares from Mr Rethinagumar in November 2019 and he is presently the sole director and sole shareholder of AISPL.⁷ Mr Ramalingam is also the managing director and shareholder of Sri Murugan Manufacturing Pte Ltd (“SMM”) and Sri Murugan Trading Pte Ltd (“SMT”). SMM is in the business of importing grocery goods from India,

³ HC/OS 477/2021, Prayer 1.

⁴ Affidavit of Evidence-in-Chief of Kalai Meyyappan Ramalingam affirmed on 29 July 2021 (“Mr Ramalingam’s AEIC”) at para 6; Agreed Bundle of Documents (“AB”) 1.

⁵ SOC at paras 1 and 3; Defence at paras 1 and 3.

⁶ Mr Ramalingam’s AEIC at paras 6 and 8.

⁷ Mr Ramalingam’s AEIC at paras 1 and 8; AB 2.

repacking them and supplying them to SMT,⁸ which then sells these and other goods in its own grocery stores in Singapore.⁹

5 Through a company known as SSR Tradings Pte Ltd (“SSR”), Mr Baskaran supplied Indian snack food to AISPL from around 2018 to 2020.¹⁰

6 ISPL was incorporated by Mr Baskaran on 26 February 2020.¹¹ Mr Baskaran is its sole director and owns 50% of its shares, with the remaining 50% being owned by his cousin, Ms Subbaraj Sankareswari.¹²

7 On 23 March 2020, AISPL became the registered proprietor of the following trade mark for services in Class 35, which included “supermarket retailing; retailing of goods by any means; retail store services; wholesale store services; wholesaling of goods by any means” (“AISPL’s Mark”):¹³

ALL INDIA SUPERMART

8 On 18 June 2020, ISPL became the registered proprietor of the following trade mark for goods in Class 29 (fish, seafood, dairy, *etc*, food products), Class 30 (carbohydrate-based preparations for foods, coffee and tea,

⁸ Mr Ramalingam’s AEIC at para 9.

⁹ Mr Ramalingam’s AEIC at para 10.

¹⁰ SOC at para 6; Defence at para 6; Affidavit of Evidence-in-Chief of Duraikkannu Baskaran affirmed on 3 August 2021 (“Mr Baskaran’s AEIC”) at para 24 (indicating that the supply of SSR’s products to AISPL ceased in March 2020).

¹¹ SOC at para 5; Defence at para 5; Mr Baskaran’s AEIC at para 21; AB 4.

¹² AB 5–6; Transcript, 23 September 2021 at p 54 lines 26–28.

¹³ SOC at para 11; Defence at para 12; AB 10–11.

condiments, bakery products, *etc*) and Class 31 (fresh fruits and vegetables) (“ISPL’s Mark”):¹⁴



As shown in the image above, ISPL’s Mark comprises both the words “INDIAN SUPERMARKET” and a pictorial device depicting a person pushing a trolley with the number “23” within it, within a yellow circle. I refer to this logo as the “Customer 23 Device”.

9 Sometime in July 2020, ISPL and Mr Baskaran opened an Indian supermarket under the name “INDIAN SUPERMARKET” at 60 Upper Weld Road.¹⁵

10 On 17 July 2020, AISPL’s solicitors sent a letter of demand to ISPL requesting it to cease using the mark and name “INDIAN SUPERMARKET” for its supermarket. ISPL did not do so.¹⁶

11 On 3 August 2020, AISPL commenced the Suit against ISPL and Mr Baskaran.¹⁷ In a further letter to ISPL’s solicitors on 1 October 2020,

¹⁴ Mr Baskaran’s AEIC at para 26; AB 20–21.

¹⁵ SOC at para 7; Defence at para 7.

¹⁶ SOC at para 15; Defence at para 17; AB 584–585.

¹⁷ Writ of Summons in HC/S 693/2020.

AISPL’s solicitors enclosed a copy of the registration certificate for AISPL’s Mark and reiterated its request for ISPL to cease using the mark and name “INDIAN SUPERMARKET”.¹⁸ On 9 October 2020, ISPL’s solicitors responded with a refusal to do so.¹⁹

12 On 17 May 2021, AISPL filed the OS seeking the invalidation of ISPL’s Mark under s 23 of the TMA.²⁰

13 While not directly in issue in the present proceedings, I note for completeness that on 19 May 2021, AISPL applied to register two further trade marks (see left and right below) for goods in Classes 29, 30 and 31:²¹



ALL INDIA SUPERMART

¹⁸ SOC at para 16; Defence at para 12; AB 586–587.

¹⁹ SOC at para 16; Defence at para 18.

²⁰ HC/OS 477/2021.

²¹ AB 12–13 and 15–16.

The parties' positions

AISPL's claim for passing off

14 First, AISPL claims that ISPL is liable in the tort of passing off. By reason of its long and extensive use of the trade mark and trade name “ALL INDIA SUPERMART” in respect of its Indian supermarket in Singapore since 2015, it has acquired substantial goodwill and reputation in the supermarket business under that trade mark and trade name, and that customers have come to recognise and associate the mark and name “ALL INDIA SUPERMART” with AISPL and none other.²² AISPL alleges that ISPL has misrepresented that its supermarket is economically associated or connected with AISPL’s by deliberately using the trade mark and trade name “INDIAN SUPERMARKET” for its supermarket, which is in close proximity with AISPL’s, and that this is likely to confuse or deceive customers because of the similarity between the two names.²³ These acts of misrepresentation have caused or are likely to cause loss and damage to AISPL’s goodwill and reputation in Singapore, in the form of diverted sales and possible reputational damage.²⁴ AISPL seeks to hold Mr Baskaran liable as a joint tortfeasor as the controlling mind or *alter ego* of ISPL who personally procured, authorised, directed, caused or assisted ISPL to commit these acts of passing off.²⁵

15 The defendants deny that ISPL committed any acts, calculated to pass off its business as that of AISPL’s supermarket, that are likely to deceive members of the public into believing that the two supermarkets are related or

²² SOC at para 4.

²³ SOC at para 8.

²⁴ SOC at para 9.

²⁵ SOC at para 10.

connected.²⁶ In particular, the words “INDIAN SUPERMARKET” are of a generic and descriptive nature and are not distinctive or peculiar to AISPL’s supermarket;²⁷ the words used in “INDIAN SUPERMARKET” and “ALL INDIA SUPERMART” are not similar;²⁸ the location, signage, premises and manner of operation of AISPL’s and ISPL’s supermarkets are sufficiently different;²⁹ the get-up of AISPL’s and ISPL’s supermarkets is generic or common to the trade;³⁰ and none of the items sold by ISPL can be identified to bear any mark or indication connected or related to AISPL’s supermarket, or any trade name or trade mark that allegedly belongs to AISPL.³¹ The defendants also deny that AISPL has suffered or will suffer any damage as a result of these matters.³²

16 In reply, AISPL argues that its trade name, “ALL INDIA SUPERMART”, is not generic or descriptive. Even if it is generic and descriptive, it has acquired a secondary significance and distinctiveness in the minds of the public as a badge of origin denoting only AISPL’s supermarket and services, by reason of its extensive use from 2015.³³ Further, even if ISPL’s trade name, “INDIAN SUPERMARKET”, is descriptive, it is still confusingly and deceptively similar to AISPL’s trade name, and this amounts to a misrepresentation.³⁴

²⁶ Defence at para 8.

²⁷ Defence at para 8(a).

²⁸ Defence at para 8(b).

²⁹ Defence at para 8(c).

³⁰ Defence at para 8(d).

³¹ Defence at para 8(e).

³² Defence at para 10.

³³ Reply (Amendment No 2) filed on 6 September 2021 (“Reply”) at para 3(i).

³⁴ Reply at para 3(ii).

AISPL’s claim for infringement of its registered trade mark

17 Second, AISPL claims that ISPL has infringed AISPL’s Mark under s 27(2)(b) of the TMA by using “INDIAN SUPERMARKET” as its trade mark for its supermarket (and therefore as a service mark), and by providing supermarket services identical or similar to AISPL’s registered services. ISPL has also used the “INDIAN SUPERMARKET” mark on its shop signage, receipts, carrier bags and marketing materials.³⁵ There exists a likelihood of confusion on the part of the public because ISPL’s “INDIAN SUPERMARKET” mark is a sign which is similar to AISPL’s Mark, and it is being used in relation to services identical or similar to AISPL’s registered services.³⁶ AISPL seeks to hold Mr Baskaran jointly liable because, as the controlling mind and *alter ego* of ISPL, he procured, authorised, directed, caused or assisted ISPL to commit these acts of trade mark infringement.³⁷ Notwithstanding AISPL’s solicitors’ requests on 17 July 2020 and 1 October 2020 for ISPL to cease using the mark and name “INDIAN SUPERMARKET”, the defendants have refused to do so. AISPL argues that it has therefore suffered, or is likely to suffer, loss and damage.³⁸

18 The defendants deny having infringed AISPL’s Mark and repeat their arguments in response to AISPL’s passing off claim above.³⁹ Further or in the alternative, the defendants make two arguments:

³⁵ SOC at para 12.

³⁶ SOC at para 13.

³⁷ SOC at para 14.

³⁸ SOC at para 17.

³⁹ Defence at para 14.

(a) First, they contend that ISPL is entitled to use its own name, “INDIAN SUPERMARKET”, as its trading name under s 28(1)(a) of the TMA.⁴⁰

(b) Second, they argue that ISPL uses the sign “INDIAN SUPERMARKET” as its trading name or part of its trade mark to indicate the kind, quality, intended purpose, geographical origin or other characteristic of the goods sold in Indian supermarkets. In particular, many of the goods and produce sold by ISPL at its supermarket are imported from India and/or are generally consumed or used by people of Indian origin, and many of the other products sold are commonly found in Indian supermarkets and grocery shops in Singapore.⁴¹

19 As these uses are in accordance with honest practices in industrial or commercial matters, and by virtue of ss 28(1)(a)(i) and 28(1)(b)(i) of the TMA, the defendants contend that ISPL has not infringed AISPL’s Mark.⁴²

20 In reply, AISPL argues that ISPL is not entitled to the ‘own name’ defence under s 28(1)(a)(i) of the TMA, and that ISPL’s alleged use of its own name is not in accordance with honest practices in industrial or commercial matters.⁴³ Further, AISPL argues that the defence in s 28(1)(b)(i) of the TMA is not available because the words “INDIAN SUPERMARKET” are used by ISPL as a trade mark, or otherwise not in accordance with honest practices in industrial or commercial matters.⁴⁴

⁴⁰ Defence at para 20.

⁴¹ Defence at para 21.

⁴² Defence at para 22.

⁴³ Reply at para 7.

⁴⁴ Reply at para 8.

AISPL's claim for invalidation of ISPL's Mark

21 Third, AISPL claims that ISPL's Mark should be declared invalid under s 23 of the TMA.

22 AISPL relies on the following *relative* grounds in s 8 of the TMA:

(a) First, by reason of the goodwill and reputation enjoyed by AISPL in Singapore in AISPL's Mark for both goods and services prior to the registration of ISPL's Mark, the registration of ISPL's Mark was liable to be prevented by the law of passing off, and the registration of ISPL's Mark was therefore in breach of s 8(7)(a) of the TMA and ought to be declared invalid under s 23(1) of the TMA.⁴⁵

(b) Second, ISPL's Mark is similar to AISPL's Mark, the goods for which ISPL's Mark is registered are similar to the services for which AISPL's Mark is registered, and there exists a likelihood of confusion on the part of the public. The registration of ISPL's Mark therefore ought to be invalidated under s 23(3)(a)(i) read with s 8(2)(b) of the TMA.⁴⁶

(c) Third, ISPL's Mark ought to be invalidated under s 23(3)(a)(iii) read with ss 8(4)(b)(i) and 8(4)(b)(ii) of the TMA because the whole or an essential part of ISPL's Mark (namely, the words "INDIAN" and "SUPERMARKET") is identical with or similar to AISPL's Mark; the latter is well known in Singapore; and the use of ISPL's Mark would indicate a connection between ISPL's goods and AISPL and is likely to damage AISPL's interests, or the use of ISPL's Mark would cause

⁴⁵ Statement of Grounds of Invalidity dated 17 May 2021 ("OS 477 Statement") at para 19.

⁴⁶ OS 477 Statement at para 20.

dilution in an unfair manner of the distinctive character of AISPL's Mark or would take unfair advantage of the distinctive character of AISPL's Mark.⁴⁷

23 AISPL also relies on the following *absolute* grounds in s 7 of the TMA:

(a) First, as the application to register ISPL's Mark was made in bad faith, the registration of ISPL's Mark was in breach of s 7(6) of the TMA and ought to be declared invalid under s 23(1) of the TMA.⁴⁸

(b) Second, ISPL's Mark does not satisfy the definition of a trade mark in s 2(1) of the TMA as the words "INDIAN SUPERMARKET" are not a sign capable of distinguishing ISPL's goods from the goods or services provided by AISPL under AISPL's Mark with the words "ALL INDIA SUPERMART". Therefore, its registration was in breach of s 7(1)(a) of the TMA and ought to be declared invalid under s 23(1) of the TMA.⁴⁹

(c) Third, ISPL's Mark is devoid of any distinctive character because the dominant element in the mark is the words "INDIAN SUPERMARKET", which are descriptive and not distinctive. Therefore, registration of ISPL's Mark ought to be invalidated under s 23(1) read with s 7(1)(b) of the TMA.⁵⁰

⁴⁷ OS 477 Statement at para 21.

⁴⁸ OS 477 Statement at para 22.

⁴⁹ OS 477 Statement at para 23.

⁵⁰ OS 477 Statement at para 24.

24 The defendants deny that these grounds are made out.⁵¹

Issues arising

25 I consider each of AISPL’s claims in turn:

- (a) First, have the defendants infringed AISPL’s Mark under s 27(2)(b) of the TMA?
- (b) Second, are the defendants liable in the tort of passing off?
- (c) Third, in relation to ISPL’s Mark, has AISPL succeeded in establishing that any of the grounds for invalidity of registration set out in s 23 of the TMA apply?

26 By consent of both parties, the trial was bifurcated on 9 October 2020, and I therefore consider only the issue of liability in these proceedings.⁵²

Infringement of AISPL’s registered trade mark

27 I consider first the allegation that ISPL has infringed AISPL’s Mark, because AISPL’s contention as to the similarity of AISPL’s and ISPL’s marks is an important aspect of its wider passing off claim.

28 Section 27(2)(b) of the TMA provides as follows:

Acts amounting to infringement of registered trade mark

27.— ... (2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because — ...

⁵¹ Defendant’s Written Submissions (“DWS”) at paras 80–94.

⁵² Correspondence from Registry dated 9 October 2020.

- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

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

29 Under the step-by-step approach to the analysis of infringement claims, the three requirements in s 27(2)(b) are assessed systematically (*The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 (“*Polo*”) at [8], endorsed in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 (“*Staywell*”) at [15]):

- (a) First, the alleged offending sign must be shown to be *similar to the registered mark*.
- (b) Second, both the sign and the mark must be used in relation to *similar goods or services*.
- (c) Third, there must exist a *likelihood of confusion* on the part of the public on account of the presence of the first two conditions.

Similarity of marks

30 I first consider whether ISPL has used, in the course of trade, a sign similar to AISPL’s Mark. A preliminary question that arises here is whether AISPL’s Mark should be compared with ISPL’s Mark (which includes the Customer 23 Device) or instead with the words “INDIAN SUPERMARKET”. Counsel for AISPL argues that the relevant comparison is between AISPL’s Mark and the words “INDIAN SUPERMARKET”, which was identified as the

infringing mark in AISPL's statement of claim.⁵³ As counsel for ISPL acknowledged during oral submissions, ISPL's pleaded defence similarly focused on arguing that the sign "INDIAN SUPERMARKET" did not infringe AISPL's Mark.⁵⁴ Counsel for ISPL sought to explain that this was because ISPL's Mark was not registered until some time after the commencement of the Suit.⁵⁵ However, ISPL's written submissions focused on comparing AISPL's Mark with ISPL's Mark.⁵⁶

31 In my view, the correct comparison is between AISPL's Mark and the words "INDIAN SUPERMARKET". AISPL's pleaded claim for trade mark infringement refers specifically to ISPL's use of the words "INDIAN SUPERMARKET" as the infringing mark. Similarly, ISPL's pleaded defences are framed with reference to "INDIAN SUPERMARKET", and are not premised on ISPL's Mark. It is on this basis that I assess mark similarity.

32 It is well established that the court will consider three aspects of similarity: visual, aural and conceptual (see *Sarika Connoisseur Café Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika*") at [16]). These criteria "do not invite a formulaic consideration", but rather "are signposts towards answering the question of whether the marks are similar" [emphasis in original omitted] (*Staywell* at [18]). The assessment of mark similarity is done mark-for-mark without consideration of any external matter (*Staywell* at [20]). In addition, the court will consider the general impression that will likely be left by the essential

⁵³ Transcript, 15 November 2021 at p 2 lines 8–32, p 5 lines 20–23 and p 41 lines 4–9; SOC at para 12(i).

⁵⁴ Transcript, 15 November 2021 at p 38 lines 16–24 and p 39 line 30 to p 40 line 1; Defence at paras 20–21.

⁵⁵ Transcript, 15 November 2021 at p 38 lines 16–24.

⁵⁶ DWS at paras 40–58.

or dominant features of the marks on the average consumer, who will be assumed to have imperfect recollection (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(d)]).

Visual similarity

33 I begin with visual similarity. AISPL’s Mark comprises the words “ALL INDIA SUPERMART”, whereas ISPL’s allegedly infringing mark comprises the words “INDIAN SUPERMARKET”. I find that there is little visual similarity between the marks. AISPL argues that there is a high degree of similarity between the two because there are “no major or discernible differences” and the word “ALL” in AISPL’s Mark does not diminish the substantial visual similarity.⁵⁷ I disagree. The marks have different lengths and structures, and do not share any common words. Taking into account the possibility of consumers’ imperfect recollection is taken into account (see *Sarika* at [23]), and that “SUPERMART” and “SUPERMARKET” might appear similar to the undiscerning eye, special regard should be paid to the distinctive or dominant components of a mark (*Staywell* at [23]). In this case, “ALL INDIA” is the memorable component of AISPL’s Mark which is likely to stand out in a consumer’s imperfect recollection, and this is visually dissimilar from “INDIAN”.

Aural similarity

34 I turn now to aural similarity. There is some aural similarity between the two marks because they share several common syllables. However, the degree of aural similarity is not high, as the first syllable of AISPL’s Mark – “ALL” –

⁵⁷ Plaintiff’s Written Submissions (“PWS”) at para 128.

is a dominant and distinctive component which would immediately set it apart from “INDIAN SUPERMARKET”. The first syllable of AISPL’s Mark would likely be emphasised in its pronunciation: see *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR(R) 1082 at [11] and *Sarika* at [29]. This aural dissimilarity is accentuated amongst Tamil-speaking customers. Mr Mathivanan, who formerly ran AISPL together with Mr Rethinagumar, gave evidence that they chose the name “All India”, which would be pronounced as “All Indee-Yah” by Tamil speakers.⁵⁸ Mr Ramalingam, giving evidence for AISPL, similarly stated that, in Tamil, “India” would be pronounced as “een-dee-yah”.⁵⁹

Conceptual similarity

35 As for conceptual similarity, this involves a consideration of the ideas that lie behind or inform each mark (*Sarika* at [34]). There is a relatively high degree of conceptual similarity between the two marks as both are descriptive. Both evoke the idea that the products sold are products which are from India, products which are related to Indian cuisine or culture, and/or products which are targeted at Indian consumers. Mr Rethinagumar, AISPL’s former director, gave evidence that the name “ALL INDIA SUPERMART” was chosen because it described the goods sold in AISPL’s supermarket as being from India.⁶⁰ This aspect of their similarity does not assist in AISPL’s case, as I explain below.

⁵⁸ Affidavit of Evidence-in-Chief of Ayyakkannu Mathivanan affirmed on 29 July 2021 at para 8; Transcript, 24 September 2021 at p 38 line 32.

⁵⁹ Transcript, 21 September 2021 at p 108 lines 1–3 and 22–24.

⁶⁰ Transcript, 22 September 2021 at p 18 lines 17–26.

Overall similarity of marks

36 Considered holistically, I find AISPL’s Mark and “INDIAN SUPERMARKET” to be more dissimilar than similar. Apart from the visual and aural dissimilarities, I also take into account the degree of distinctiveness of AISPL’s Mark. The less distinctive AISPL’s Mark, the less it is necessary to show sufficient alterations to or differences in “INDIAN SUPERMARKET” for it not to be held similar to AISPL’s Mark: see *Sarika* at [20] and [35]–[36]. Where a mark is descriptive, it will be harder for it to acquire distinctiveness (and the evidential burden on the plaintiff will be higher), and minor differences will be held to be sufficient to distinguish it from another mark: *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and another and another appeal* [2000] 2 SLR(R) 214 at [61] and [63]. Given the relatively low degree of inherent distinctiveness of “ALL INDIA SUPERMART”, there is a low bar for “INDIAN SUPERMARKET” to be considered dissimilar to it (see *Staywell* at [25]). In my view, the requisite similarity between the marks is not established.

Conclusion on AISPL’s trade mark infringement claim

37 AISPL’s claim for trade mark infringement may therefore be dismissed for lack of mark similarity. I add for completeness that, even if AISPL’s Mark and “INDIAN SUPERMARKET” are both used in relation to similar services (supermarket services), the third requirement of a likelihood of confusion is not made out. The only relevant type of confusion for the purpose of grounding an infringement action is that which *results from* the similarity between marks and goods or services: *Staywell* at [15] and [64]. As AISPL has not succeeded in establishing mark similarity, the requisite likelihood of confusion is not made out. As the Court of Appeal noted in *Polo* at [8], if either of the first two conditions in the step-by-step test is not satisfied, there will not be any need to

go into the third question of determining whether there exists a likelihood of confusion.

38 In light of my conclusion that ISPL is not liable for trade mark infringement, it is not necessary for me to decide whether any of the defences set out in s 28(1) of the TMA apply.

Passing off

39 It is common ground between the parties that the plaintiff must establish three essential elements for a passing off claim: goodwill in the plaintiff's business, misrepresentation and damage.

Misrepresentation

40 In my judgment, the head of claim for passing off fails for lack of any misrepresentation on ISPL's part. AISPL must establish that (a) ISPL has made a misrepresentation to the relevant sector of the public that its business is the same as or somehow connected with AISPL's business, thereby giving rise to confusion; and (b) such misrepresentation has resulted in or is likely to result in damage to AISPL's goodwill: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Novelty*") at [69] and [78]; *Tuitiongenius Pte Ltd v Toh Yew Keat and another* [2021] 1 SLR 231 ("*Tuitiongenius*") at [88].

Distinctiveness

41 A threshold question is first that of whether AISPL's goodwill is sufficiently associated with its name or mark, which in turn will be established if AISPL can show that its mark or name is *distinctive* of AISPL's business, such that the public views that mark as an indicator of origin: *The Singapore*

Professional Golfers’ Association v Chen Eng Waye and others [2013] 2 SLR 495 (“*SPGA*”) at [28]; *Tuitiongenius* at [79(b)] and [88].

42 AISPL submits that, while AISPL’s Mark is a collection of ordinary and descriptive words, it has acquired distinctiveness through extensive use, as evidenced by its substantial sales revenue and extensive promotion of its business, and has acquired a secondary significance in the minds of the relevant public that buys Indian groceries that denotes only AISPL and its business.⁶¹ ISPL denies that AISPL’s Mark is distinctive and argues that it is merely descriptive of the fact that AISPL’s supermarket is in the business of selling goods from all over India.⁶²

43 In my judgment, “ALL INDIA SUPERMART” has acquired distinctiveness through use, but the level of distinctiveness is not high. As pointed out by the Court of Appeal in *Staywell* at [24], distinctiveness in its technical sense usually stands in contradistinction to descriptiveness. The individual words used are descriptive words of general usage, over which the court will generally be reluctant to allow any person to obtain a legal monopoly: see *SPGA* at [30]–[31]. Even though the Court of Appeal in *SPGA* recognised the possibility of a collection of generic or descriptive words becoming distinctive when used in *combination* with one another, it found that the words “The Singapore Professional Golfers’ Association” were “in essence a straightforward description of an association for professional golfers”, and itself lacked any significant degree of distinctiveness (*SPGA* at [39]). Nevertheless, the Court of Appeal in *SPGA* at [40] went on to find, on the facts of *SPGA*, that the name “The Singapore Professional Golfers’ Association” (and its initials

⁶¹ PWS at paras 51–56.

⁶² DWS at para 32.

“SPGA”) had been used regularly since SPGA was established nearly 40 years earlier. The name and initials had come to be identified with the appellant, such that they were no longer merely descriptive of the appellant in a generic sense. Thus, although the name and initials might have lacked a high degree of distinctiveness in and of themselves, they had nonetheless acquired a secondary meaning by virtue of their clearly being identified with the appellant and with the activities that it organised and promoted (*SPGA* at [40]).

44 Applying the guidance of the Court of Appeal in *SPGA* in the present case, although the various components of “ALL INDIA SUPERMART” might be merely descriptive when read individually, I accept that when used in combination they have come to be associated with AISPL through extensive use. AISPL has substantial sales revenue and has actively advertised and promoted its services and goods under the “ALL INDIA SUPERMART” name. AISPL adduced undisputed evidence that its sales revenue was \$54.8m from November 2015 to June 2020 (before the commencement of the Suit), averaging about \$30,000 a day and \$1m a month.⁶³ AISPL also adduced evidence of extensive advertising and promotion of its services and goods under the name and mark “ALL INDIA SUPERMART”, for which it incurred \$395,263 from November 2015 to June 2020.⁶⁴ It can be inferred from this that the words “ALL INDIA SUPERMART” are likely to have acquired a secondary meaning denoting AISPL’s supermarket business. Nevertheless, notwithstanding that “ALL INDIA SUPERMART” has acquired a secondary meaning, the degree of protection conferred on AISPL is less than would be the case with purely “fancy” names (see *SPGA* at [35]).

⁶³ Mr Ramalingam’s AEIC at paras 13–14; AB 23–52; PWS at paras 16–17.

⁶⁴ Mr Ramalingam’s AEIC at para 36; Plaintiff’s Bundle of Documents at pp 1–14; PWS at para 35.

Assertions as to misrepresentation

45 The more fundamental issue in this case is whether ISPL made a misrepresentation to the relevant sector of the public (here, AISPL’s actual and potential customer base) that its supermarket business was the same as or connected with AISPL’s supermarket business, thereby giving rise to confusion. It is necessary to show that ISPL’s actions amount to a misrepresentation that is likely to deceive the relevant segment of the market. Confusion can be established by evidence of *actual* confusion between the business, goods or services of the plaintiff and those of the defendant, or by showing that the average reasonable person with characteristics reflective of the relevant section of the public is *likely* to be confused by the defendant’s misrepresentation: *Novelty* at [80]. In ascertaining whether the requisite misrepresentation is established, the court has regard to the entirety of the circumstances surrounding the alleged misrepresentation.

46 AISPL contends that the following constitute misrepresentation by ISPL: its name, its signage and its vegetable display.

47 AISPL’s contention in respect of ISPL’s name similarity has been dealt with in the context of mark similarity: see [30]–[36] above. AISPL submitted that “[t]he idea conveyed by ‘ALL INDIA SUPERMART’ and ‘INDIAN SUPERMARKET’ is that of an Indian supermarket.”⁶⁵ This submission reflects a key weakness in AISPL’s argument. An “Indian supermarket” is not a distinctive concept and it is not a sufficient premise to sustain an argument that ISPL has made a representation that deceives consumers into thinking its goods are AISPL’s.

⁶⁵ PWS at para 65.

48 AISPL further argues that there were similarities in the appearance of All India Supermart and Indian Supermarket which contributed to the misrepresentation: first, the green colour theme used for the signage and façade (including, in particular, the cash counter) of both supermarkets,⁶⁶ which AISPL argues cannot have been a coincidence;⁶⁷ and second, the similar vegetable display on green racks and baskets.⁶⁸

49 The fact that green was used for the cash counters of both supermarkets cannot be sufficient to establish a misrepresentation or cause confusion for the purposes of passing off. As for the vegetable displays used in each supermarket, the evidence of the similarities between AISPL’s and ISPL’s displays is scant. AISPL relies on only two photographs of its own shopfront which show green racks and baskets being used to display vegetables. The photographs of AISPL’s premises show that not all of the racks used by AISPL were green: red, yellow and blue racks were also used, as were white foam, wooden and metal racks.⁶⁹ When asked why different display racks were used, Mr Ramalingam explained that the green racks were AISPL’s “old rack[s]” and their “new racks”, which they began using around 2020 or 2021, were stainless steel, as recommended by the Singapore Food Agency.⁷⁰ Indeed, Indian Supermarket’s façade and displays appear to be more uniformly green than AISPL’s.⁷¹ Both

⁶⁶ AB 118 (AISPL), 463–474 (ISPL) and 478 (ISPL).

⁶⁷ PWS at para 87.

⁶⁸ AB 66–67 (AISPL), 472–473 (ISPL) and 477 (ISPL); PWS at paras 89 and 91.

⁶⁹ AB 58–59 and 64–67.

⁷⁰ Transcript, 21 September 2021 at p 132 lines 3–21.

⁷¹ AB 472–473.

Mr Ramalingam⁷² and Mr Rethinagumar⁷³ agreed that the majority of All India Supermart’s vegetable display racks were not green.

50 In any event, the use of racks to display vegetables outside a shop is not so unusual as to identify a supermarket as being AISPL’s All India Supermart. Mr Rethinagumar agreed in his cross-examination that most of the Indian provision shops along Serangoon Road in Little India display their vegetables in racks outside their shop, even small shops such as a few shops along Buffalo Road.⁷⁴ The display of vegetables outside a store therefore appears to be commonplace sight, and would not give rise to confusion between All India Supermart and Indian Supermarket.

Presence of differentials

51 In finding an absence of any misrepresentation made by ISPL to the relevant sector of the public that its business is the same as or connected with AISPL’s business, I take into consideration the many actions taken by Indian Supermarket to differentiate its products from All India Supermart.

52 First, the signage and façade of the two supermarkets are plainly different. All India Supermart is located in a multi-coloured four-storey building with the words “ALL INDIA SUPERMART” and “ALL INDIA” in green block letters on its exterior.⁷⁵ In contrast, Indian Supermarket is a one-storey supermarket located in a two-storey building, with the words “INDIAN

⁷² Transcript, 21 September 2021 at p 77 lines 29–31.

⁷³ Transcript, 22 September 2021 at p 25 lines 20–23 and p 26 lines 16–26.

⁷⁴ Transcript, 22 September 2021 at p 20 lines 17–30 and p 46 lines 2–27.

⁷⁵ AB 53–56.

SUPERMARKET” in white lettering on dark green signage.⁷⁶ The signage in front of ISPL’s supermarket also prominently displayed two logos together with the words “INDIAN SUPERMARKET”: a yellow circle with “23 Hours” in green text within,⁷⁷ and the Customer 23 Device (as shown at [8] above).⁷⁸ It is therefore entirely implausible that the colour themes, signage and façade of the respective supermarkets could have given rise to confusion among the relevant sector of the public.

53 Second, the shopping experience is different. Outside the shop, in the exterior vegetable area, All India Supermart uses yellow signs for pricing, whilst Indian Supermarket uses chalkboards.⁷⁹ Inside the shop, price tags are not affixed to the products sold in Indian Supermarket, contrary to the practice at All India Supermart. Consistent with the practice of many small Indian grocery shops in Singapore, customers would take the items to the cash counter to inquire about the price.⁸⁰ In contrast, the products in All India Supermart have price tags on them, and there are also bright yellow price labels on the shelves and in the shop interior.⁸¹ The use of price tags is a significant differential because of AISPL’s customer base. AISPL positions itself as offering very low prices to its customers. For example, one of its promotional videos, which was recorded in Tamil but translated for the court by the defendants’ counsel (with the translation confirmed by Mr Ramalingam during his cross-examination), stated that AISPL offered “[w]holesale prices at retail mart”, that prices were

⁷⁶ AB 463–467.

⁷⁷ AB 463, 467, 471–472 and 474.

⁷⁸ AB 465 and 469.

⁷⁹ AB 114 (AISPL) and 473 (ISPL).

⁸⁰ Mr Baskaran’s AEIC at para 46; AB 467–496.

⁸¹ Mr Baskaran’s AEIC at para 46; AB 88, 91–92, 94, 104, 112, 119; DWS at para 119.

“very low”, and that there was “no chance that [a customer] can get any price lower”.⁸² In view of this, AISPL’s customer base is more likely to be price-conscious and would notice if the prices of the products offered for sale were not clearly indicated.⁸³

54 Another aspect of the shopping experience is that the majority of the goods sold in Indian Supermarket are SSR-brand sweets and snacks.⁸⁴ Indian Supermarket was SSR’s first retail shop; previously Mr Baskaran supplied SSR products to other shops.⁸⁵ This would indicate to customers that Indian Supermarket is associated with SSR in some way.⁸⁶ In contrast, most of the products sold in All India Supermart are house-brand products or products from other brands.⁸⁷ Prior to the incorporation of ISPL, SSR was amongst the various brands it sold. In March 2020, when the parties’ relationship soured, AISPL refused to accept SSR products from Mr Baskaran.⁸⁸ The products sold would therefore provide a further indicator to customers that Indian Supermarket and All India Supermart are operated by distinct entities.

55 Lastly, the plastic carrier bags used for goods purchased carry the Customer 23 Device with the word “Hr” under the “23”:⁸⁹

⁸² AB, item 19; Transcript, 21 September 2021 at p 57 line 22 to p 59 line 13.

⁸³ DWS at para 120.

⁸⁴ Mr Baskaran’s AEIC at paras 45 and 49; DWS at para 18 and 118. See, *eg*, AB 497–555.

⁸⁵ Mr Baskaran’s AEIC at paras 13–15.

⁸⁶ Mr Baskaran’s AEIC at para 45.

⁸⁷ Mr Baskaran’s AEIC at paras 45 and 52–53.

⁸⁸ Mr Baskaran’s AEIC at para 24.

⁸⁹ AB 572–573.



In contrast, the plastic carrier bags used by AISPL are white and carry a device with the letters “AI” enclosed within a circle:⁹⁰



Evidence as to confusion

56 AISPL in arguing its case to the contrary, introduced evidence of confusion through a customer. Mr Prakash s/o Manikam (“Mr Prakash”) testified that sometime in February 2021, his wife had asked him to go to All India Supermart to buy groceries and vegetables, but he purchased the goods

⁹⁰ AB 233–235.

from Indian Supermarket instead.⁹¹ Mr Prakash had not been to AISPL before. His confusion arose mainly because “INDIAN SUPERMARKET” sounded and looked similar to “ALL INDIA SUPERMART”, his wife had told him about the arrangement of vegetables outside each supermarket, and the proximity of a car park, church and police station near both supermarkets.⁹² Mr Prakash also claimed that he had asked the Indian Supermarket staff whether it was All India Supermart and the staff replied in Tamil that they were “all the same”.⁹³

57 Mr Prakash’s evidence does not assist AISPL. He was not himself a customer of AISPL and his confusion was that of a person unfamiliar with AISPL. Further, Mr Prakash’s affidavit of evidence-in-chief (“AEIC”) indicates that he *did* notice the difference in name as he “thought maybe the name had been changed”. This led him to call his wife to check if he was at the correct supermarket, and to ask the staff at Indian Supermarket whether it was All India Supermart.⁹⁴ When the goods were unpacked, his wife also observed that the colours used in the plastic packaging were different.⁹⁵ His confusion arose from the fact that both All India Supermart and Indian Supermarket were located near a car park, church and police station, and vegetable displays were seen outside each supermarket. This was premised on his wife’s directions concerning All India Supermart. His wife was not called as a witness to confirm this or any of her instructions.⁹⁶ Moreover, Mr Prakash operated a club in Dalhousie Lane in

⁹¹ Affidavit of Evidence-in-Chief of Prakash s/o Manikam affirmed on 21 July 2021 (“Mr Prakash’s AEIC”) at paras 5–10.

⁹² Mr Prakash’s AEIC at paras 7 and 12; Transcript, 22 September 2021 at p 79 lines 20–23 and p 102 lines 23–24.

⁹³ Mr Prakash’s AEIC at para 8.

⁹⁴ Mr Prakash’s AEIC at paras 7–8.

⁹⁵ Mr Prakash’s AEIC at para 9.

⁹⁶ Transcript, 22 September 2021 at p 80 lines 9–25; DWS at para 133.

Little India and had also worked at another club in Dunlop Street.⁹⁷ These clubs were a 15-minute walk away from Norris Road, where All India Supermart is located.⁹⁸ Yet, he claimed that he had never been to Norris Road and did not know where it was.⁹⁹ His evidence is wholly implausible.

58 Initially two witnesses were intended on the point of confusion. Mr Thava Kumaran s/o Ramamutty (“Mr Kumaran”), affirmed an AEIC but did not attend trial for cross-examination. His AEIC was thus disregarded pursuant to O 38 r 2(1) of the Rules of Court (2014 Rev Ed). As was pointed out to Mr Prakash in his cross-examination, there were some uncanny similarities between the AEICs of Mr Prakash and Mr Kumaran.¹⁰⁰ Both claimed that, sometime in February 2021, their wives had given them directions to travel to All India Supermart, and they took a route which happened to pass by Indian Supermarket.¹⁰¹ Both witnesses referred to the same Google Maps map which showed the walking distance, and not the driving route, between All India Supermart and Indian Supermarket.¹⁰² Both also claimed to have been told by the staff at Indian Supermarket that All India Supermart and Indian Supermarket were the same.¹⁰³ Although this does not necessarily suggest that Mr Prakash

⁹⁷ Defendants’ Supplemental Bundle of Documents at pp 44–46; Transcript, 22 September 2021 at p 77 lines 6.

⁹⁸ Transcript, 22 September 2021 at p 77 lines 6–14.

⁹⁹ Transcript, 22 September 2021 at p 94 lines 21–26.

¹⁰⁰ DWS at para 134.

¹⁰¹ Mr Prakash’s AEIC at paras 5–7; Affidavit of Evidence-in-Chief of Thava Kumaran s/o Ramamutty affirmed on 30 July 2021 (“Mr Kumaran’s AEIC”) at paras 5–7; DWS at para 129.

¹⁰² Mr Prakash’s AEIC at para 6; Mr Kumaran’s AEIC at para 6; AB 583; DWS at para 130.

¹⁰³ Mr Prakash’s AEIC at para 8; Mr Kumaran’s AEIC at para 8.

colluded with Mr Kumaran, it diminishes the persuasiveness of Mr Prakash’s account.

59 It is appropriate to deal at this juncture with Mr Prakash’s assertion that the staff of Indian Supermarket informed him that Indian Supermarket was being operated by the “previous owners” of All India Supermart, and that Indian Supermarket and All India Supermart were the same or related entities.¹⁰⁴ Apart from Mr Prakash’s testimony, AISPL has not adduced any evidence of ISPL’s staff informing customers that Indian Supermarket and All India Supermart were the same. More fundamentally, even if the staff had told customers that Indian Supermarket was operated by the previous owners of All India Supermart, this was not a representation that ISPL’s business was the same as or connected with AISPL’s. On the contrary, this would have indicated that All India Supermart and Indian Supermarket were *different* entities.

60 Therefore, in my judgment, AISPL has not succeeded in proving the requisite misrepresentation, nor that any confusion has been caused. I dismiss AISPL’s claim in passing off on this basis.

Conclusion on the Suit

61 I therefore dismiss AISPL’s claims against ISPL.

62 The issue of Mr Baskaran’s liability follows therefrom. AISPL’s case against Mr Baskaran rests on his active involvement in the affairs of ISPL as a director: see *Gabriel Peter & Partners (suing as a firm) v Wee Chong Jin and others* [1997] 3 SLR(R) 649 at [35]; Tan Tee Jim, *Law of Trade Marks in Singapore* (Sweet & Maxwell, 4th Ed, 2021) (“*Tan Tee Jim*”) at paras 11.120

¹⁰⁴ SOC at para 8(vi); Mr Ramalingam’s AEIC at para 64.

and 19.346. This position was not seriously disputed, whether as a legal or a factual matter, by Mr Baskaran. He is the sole director and 50% shareholder of ISPL, with the remaining 50% being owned by his cousin.¹⁰⁵ On Mr Baskaran's own evidence, it was he who incorporated ISPL, chose the name "Indian Supermarket" and the design of ISPL's Mark (including the Customer 23 Device), and made key decisions on matters such as what products ISPL should sell.¹⁰⁶ Mr Baskaran also stated during his cross-examination that he was the controller of Indian Supermarket as regards its operation, as he was "the one who invested the money".¹⁰⁷ In these circumstances, it is clear that Mr Baskaran would be responsible for authorising and directing ISPL to commit the acts of passing off and trade mark infringement, if ISPL was itself liable for the same. However, as I have found that AISPL has not made out its case in either passing off or trade mark infringement against ISPL, AISPL has also failed to establish Mr Baskaran's personal liability.

Invalidity of ISPL's registered trade mark

63 I turn now to the OS, by which AISPL seeks to invalidate ISPL's Mark under s 23 of the TMA. AISPL relies on six grounds, which I deal with in turn.

Passing off

64 First, AISPL submits that the registration of ISPL's Mark is liable to be prevented by the law of passing off, and that its registration therefore breaches s 8(7)(a).¹⁰⁸ Section 8(7)(a) provides that a trade mark shall not be registered if

¹⁰⁵ Defence at para 11.

¹⁰⁶ Mr Baskaran's AEIC at paras 18–21 and 27.

¹⁰⁷ Transcript, 23 September 2021 at p 20 lines 13–15.

¹⁰⁸ OS 477 Statement at para 19; PWS at para 189.

(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.

65 I have found at [40]–[60] above that ISPL’s use of the trade mark and trade name “INDIAN SUPERMARKET”, as well as the surrounding circumstances, do not establish the requisite misrepresentation necessary for passing off. AISPL argues that, because of the similarity of the goods on which AISPL uses AISPL’s Mark and the goods for which ISPL has registered ISPL’s Mark (such as the goods in Class 31 (vegetables and fruits)), there is a likelihood of confusion or deception amounting to a misrepresentation.¹⁰⁹ In my view, this does not automatically follow. AISPL has not shown how ISPL’s Mark misrepresents to the relevant sector of the public that its business is the same as or connected with AISPL’s business, thereby giving rise to confusion.

66 The ground in s 23(3)(b) read with s 8(7)(a) and of the TMA therefore fails.

Similarity to earlier trade mark

67 Second, AISPL contends that ISPL’s Mark is similar to AISPL’s Mark, that it is to be registered for goods or services similar to those for which AISPL’s Mark is registered, and that there exists a likelihood of confusion on the part of the public. On this basis, its registration should be invalidated under s 23(3)(a)(i) read with s 8(2)(b) of the TMA.¹¹⁰

¹⁰⁹ PWS at paras 182 and 188.

¹¹⁰ OS 477 Statement at para 20.

68 Comparing AISPL's Mark with ISPL's Mark, I find that they are dissimilar. For ease of comparison, I set out both marks side by side below:



69 It is clear that the two marks are visually dissimilar. Apart from the visual differences between the text of each mark (which I have analysed at [33] above), ISPL's Mark is a *composite* mark which includes the Customer 23 Device.

70 In *Hai Tong* at [62], the Court of Appeal set out a detailed (albeit non-exhaustive) list of the relevant principles in relation to assessing the visual similarity of composite marks:

- (a) The court assesses the competing marks or signs with the imperfect recollection of the average consumer.
- (b) The visual similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components. When the other components of a complex mark or sign are of negligible significance, it is permissible to make the comparison solely on the basis of any dominant element(s).

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

(d) The textual component of a composite mark or sign could be the dominant component of the mark or sign. This might be the case in the following instances:

(i) where the two marks or signs each contain a similar device, but bear words which are entirely different from each other;

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

(iii) where the textual component is in itself already widely known; or

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

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

(i) the device is significant and large;

(ii) the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component, or of similar goods of a superior quality; or

- (iii) the device component is of a complicated nature.
- (f) However, the device component will usually *not* be the dominant component of a composite mark or sign where:
 - (i) the device is simple and will not evoke any particular concept for the average consumer;
 - (ii) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods; or
 - (iii) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.

71 The Customer 23 Device featured in ISPL’s Mark renders it markedly different from AISPL’s Mark. From the perspective of the average consumer with imperfect recollection, the distinctive and dominant component of ISPL’s Mark is the Customer 23 Device, particularly because it is large and positioned above the words “INDIAN SUPERMARKET”. The Customer 23 Device is therefore likely to dominate the overall impression of ISPL’s Mark. It is visually dissimilar to AISPL’s Mark, which contains only plain text.

72 The degree of aural similarity between AISPL’s Mark and ISPL’s Mark is even lower than that between AISPL’s Mark and “INDIAN SUPERMARKET” (as analysed at [34] above), given that ISPL’s Mark might be read as “23 Indian Supermarket” or “Indian Supermarket 23”.

73 When the Customer 23 Device is taken into account as part of ISPL’s Mark, the two marks are also conceptually dissimilar. Whereas “INDIAN SUPERMARKET” on its own might be conceptually similar to AISPL’s Mark in that both evoke the idea of products from India, products related to Indian cuisine or culture and/or products targeted at Indian consumers (see [35] above), the Customer 23 Device additionally draws attention to the number “23”. During his cross-examination, Mr Baskaran explained that the number “23” was chosen because it was his “lucky number” based on the Chaldean system of numerology, as well as because he initially intended for Indian Supermarket to be open for 23 hours a day (although this did not materialise because of the reduced business during the COVID pandemic).¹¹¹

74 I therefore find that AISPL has failed to establish the relative ground in s 23(3)(a)(i) read with s 8(2)(b) of the TMA.

Well known marks

75 The third ground relied on by AISPL is that in s 23(3)(a)(iii) read with ss 8(4)(b)(i) and 8(4)(b)(ii) of the TMA.¹¹²

76 As the two sub-sections of s 8(4) are conjunctive, this ground is premised on AISPL’s Mark being an earlier trade mark which is well known in Singapore (s 8(4)(a)). Under s 2(7) of the TMA, matters from which it may be inferred that a trade mark is well known include the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore (s 2(7)(a)), and the duration, extent and geographical area of any use or promotion of the trade mark (s 2(7)(b)). AISPL has adduced evidence of its

¹¹¹ Transcript, 23 September 2021 at p 11 line 29 to p 13 line 26.

¹¹² OS 477 Statement at para 21.

substantial sales revenue and the extensive advertising and promotion of its services and goods (see [43] above). Apart from its submission that AISPL’s substantial monthly sales are not sustainable because it was selling its goods at very low prices, and that therefore AISPL was not well known in Singapore “in the positive sense”, ISPL does not raise any other arguments or evidence to dispute that AISPL’s Mark was well known in Singapore.¹¹³ On the evidence before me, I accept that AISPL’s Mark is well known to the relevant sector of the public in Singapore. There is, however, no evidence of AISPL’s Mark being well known to the public *at large* in Singapore under s 8(4)(b)(ii) of the TMA.

77 In any event, the evidence does not show that the use of ISPL’s Mark would indicate a connection between ISPL’s goods and services and those of AISPL, and that this is likely to damage AISPL’s interests (as required under s 8(4)(b)(i)).

78 This ground is therefore not established.

Bad faith

79 The first absolute ground relied on by AISPL is that in s 23(1) read with s 7(6) of the TMA, which provides that a trade mark shall not be registered if or to the extent that the application for registration is made in bad faith.¹¹⁴

80 The general principles relating to bad faith under s 7(6) were set out by the High Court in *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 (“*Tomy*”) at [32], and include the following:

¹¹³ DWS at paras 81–82.

¹¹⁴ OS 477 Statement at para 22.

(a) Bad faith includes dishonesty and some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. This test contains both a subjective element (*ie*, what the particular applicant knows) and an objective element (*ie*, what ordinary persons adopting proper standards would think) (*Tomy* at [32(c)]).

(b) Bad faith requires a holistic assessment, and the court ought to take into account (i) whether the applicant knows or must know that a third party is using an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought; (ii) the applicant's intention to prevent that third party from continuing to use such a sign; and (iii) the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought (*Tomy* at [32(d)]).

(c) The legal burden of proof needed to substantiate an action for revocation and/or invalidation of the registration of a trade mark lies throughout on the plaintiff. Where allegations of bad faith are concerned, the standard of proof is on the balance of probabilities, but cogent evidence is required due to the seriousness of the allegation. Nevertheless, a conclusion of bad faith is largely, if not invariably, based on circumstantial evidence (*Tomy* at [32(f)]).

(d) The bad faith inquiry is a fact-sensitive one that demands careful examination of all the relevant circumstances. The nature of the parties' pre-existing relationship is a factor relevant to the determination of bad faith (*Tomy* at [32(g)]).

81 The basis on which AISPL alleges bad faith on the part of ISPL is that, prior to applying to register ISPL's Mark, ISPL was aware of AISPL's extensive use of AISPL's Mark on goods and supermarket services, and disregarded Mr Ramalingam's request in March 2020 not to use the "INDIAN SUPERMARKET" mark. According to AISPL, the facts disclose both subjective bad faith and objectively unacceptable commercial behaviour.¹¹⁵ However, AISPL's Statement of Grounds of Invalidity filed together with the OS contain no particulars of the alleged bad faith and merely asserted that "by reason of the matters pleaded above, the application to register [ISPL's Mark] was made in bad faith".¹¹⁶ In my view, AISPL has not adduced any cogent evidence to discharge its burden of proving the serious allegation of bad faith. There is no evidence of any subjective dishonesty on the part of ISPL or Mr Baskaran. Furthermore, I do not think ISPL's conduct falls short of the standards of acceptable commercial behaviour. Mr Baskaran did not dispute that Mr Ramalingam had contacted him on 28 February 2020 to request him to change the name of his supermarket, but he testified that Mr Ramalingam's request was initially just a friendly one and after that they "laughed about it" and "left it at that".¹¹⁷ By this point, Mr Baskaran had already incurred substantial costs in preparing the signage and carrier bags for Indian Supermarket.¹¹⁸ In these circumstances, I am unable to conclude that ISPL's disregarding of Mr Ramalingam's request, and its application to register ISPL's Mark, were acts done in bad faith.

¹¹⁵ PWS at paras 207 and 209–210.

¹¹⁶ OS 477 Statement at para 22; DWS at para 90.

¹¹⁷ Mr Baskaran's AEIC at para 22; read with Transcript, 23 September 2021 at p 50 lines 1–12 and p 51 lines 10–11 and 28–30.

¹¹⁸ Mr Baskaran's AEIC at paras 23; read with Transcript, 23 September 2021 at p 55 lines 5–27.

Failure to meet the definition of a trade mark

82 The second absolute ground relied on by AISPL is that ISPL’s Mark does not satisfy the definition of a trade mark in s 2(1) of the TMA, such that its registration was in breach of s 7(1)(a) and ought to be declared invalid under s 23(1). This is premised on AISPL’s argument that the dominant and identifying element in ISPL’s Mark is the textual element comprising the words “INDIAN SUPERMARKET”, rather than the Customer 23 Device, and that the words “INDIAN SUPERMARKET” cannot satisfy the definition of a trade mark as they are not capable of distinguishing ISPL’s Indian groceries from those of other traders selling Indian groceries.¹¹⁹

83 I disagree. The definition of a “trade mark” in s 2(1) of the TMA requires the sign in question to be “capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person”. ISPL’s Mark satisfies this definition. The textual element comprising the words “INDIAN SUPERMARKET” is not, in my view, the dominant and identifying element in ISPL’s Mark. To the contrary, the dominant and identifying element is the Customer 23 Device, which is more eye-catching. I therefore find that ISPL’s Mark is capable of distinguishing ISPL’s goods and services from those of other traders.

Non-distinctiveness

84 The third absolute ground relied on by AISPL is that ISPL’s Mark is devoid of any distinctive character because its dominant element is the words “INDIAN SUPERMARKET”, which are descriptive and not distinctive. On this

¹¹⁹ OS 477 Statement at para 23; PWS at paras 212–214.

basis, AISPL contends that the registration of ISPL’s Mark ought to be invalidated under s 23(1) read with s 7(1)(b) of the TMA.¹²⁰

85 In its written submissions, AISPL also relies on s 7(1)(c) of the TMA, which provides that trade marks which “consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, ... or other characteristics of goods or services” shall not be registered.¹²¹ In this regard, AISPL relies on the defendants’ pleading in their defence to AISPL’s trade mark infringement claim that ISPL uses the sign “INDIAN SUPERMARKET” to indicate the kind, quality, intended purpose, geographical origin or other characteristic of the goods sold in Indian supermarkets and grocery shops and/or purchased by people of Indian origin for their consumption or use, for the purposes of invoking the defence in s 28(1)(b)(i) of the TMA.¹²²

86 In my judgment, ISPL’s Mark is not devoid of distinctive character under s 7(1)(b). Viewed in isolation, the words “INDIAN SUPERMARKET” would indeed be purely descriptive and non-distinctive. However, in ISPL’s Mark, these words are used in tandem with the Customer 23 Device, which depicts a person pushing a trolley with the number “23” within. ISPL’s Mark therefore cannot be said to be purely descriptive. The Customer 23 Device bears no relation to the description of ISPL’s goods as being goods sold in Indian shops or purchased by people of Indian origin. On the contrary, I find that the Customer 23 Device gave ISPL’s Mark a significant degree of distinctiveness. For this reason, ISPL’s Mark is also not a trade mark which consists *exclusively*

¹²⁰ OS 477 Statement at para 24; PWS at para 215.

¹²¹ PWS at paras 216–218.

¹²² Defence at paras 21–22.

of signs designating the kind, geographical origin or other characteristics of its goods or services, and s 7(1)(c) therefore does not apply.

Conclusion on the OS

87 Thus, in my view, none of the grounds of invalidity relied on by AISPL are established in the present case. There is no basis for the registration of ISPL’s Mark to be invalidated under s 23 of the TMA.

Conclusion

88 I dismiss both the Suit and the OS. I shall hear counsel on costs.

Valerie Thean
Judge of the High Court

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