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

[2024] SGHC 102

Originating Claim No 33 of 2022

Between

East Coast Podiatry Centre Pte Ltd

… *Claimant*

And

Family Podiatry Centre Pte Ltd

… *Defendant*

JUDGMENT

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

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East Coast Podiatry Centre Pte Ltd
v
Family Podiatry Centre Pte Ltd

[2024] SGHC 102

General Division of the High Court — Originating Claim No 33 of 2022
Dedar Singh Gill J
2–3 November 2023, 19 January 2024

17 April 2024 Judgment reserved.

Dedar Singh Gill J:

1 The claimant is the registered proprietor of trade marks which contain the words "East Coast Podiatry". On three separate occasions, the defendant used Google's advertising service ("Google Ads") to display advertisements containing the words "east coast podiatry", "podiatry east coast" and "podiatrist east coast" respectively. The issues before me are whether the defendant's use is infringing use and whether its conduct gives rise to a claim in passing off. I conclude that it is not infringing use and there is no passing off.

Facts

The parties

2 The claimant is East Coast Podiatry Centre Pte Ltd, a Singapore-registered private company in the business of providing podiatry services.[1] The claimant operates four podiatry centres in Singapore. These are located in the Kembangan, Orchard, Novena and Bukit Timah regions.[2] The claimant's sole director and shareholder is Mr Jevon Tay ("Mr Tay").[3]

3 The defendant is Family Podiatry Centre Pte Ltd, a Singapore-registered private company also in the business of providing podiatry services.[4] The defendant operates two branches in Singapore. These are located in Bukit Timah and Joo Chiat.[5] The defendant's sole director and shareholder is Mr Mark Brenden Reyneker ("Mr Reyneker").[6]

Background to the dispute

4 The claimant began its business operations sometime in September 2015, and set up its first centre in the Kembangan area of Singapore, operating

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1 Statement of Claim (Amendment No.1) (dated 22 May 2023) ("SOC") at para 1; Claimant's Closing Written Submissions (dated 5 January 2024) ("CCS") at para 3; Defence & Counterclaim (Amendment No.1) (dated 30 May 2023) ("Defence") at para 1.

2 CCS at para 4; Defence at para 2.

3 CCS at para 6.

4 SOC at para 2.

5 Defendant's Closing Submissions (dated 5 January 2024) ("DCS") at para 3; Mark Brenden Reyneker's Affidavit of Evidence-in-Chief (dated 16 June 2023) ("Mr Reyneker's AEIC") at para 19; CCS at para 5.

6 CCS at para 6.

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under the name "East Coast Podiatry".[7] Two months thereafter, the claimant bought over a failing practice in Orchard which was named "Orchard Clinic".[8] Sometime in 2016, the claimant opened a third outlet in the Novena area also operating as "East Coast Podiatry".[9] Finally, in February 2022, the claimant opened a fourth outlet in the Bukit Timah area.[10] It was only in or around 2017 that the claimant consolidated the names of all its clinics, including the Novena outlet, as "East Coast Podiatry".[11]

5 The claimant is the registered proprietor of the following trade marks (collectively, the "ECPC Marks"):[12]

(a) Trade mark no. 40201807140R, registered on 17 April 2018 for goods and services in Classes 5, 10, 25 and 44 of the International Classification of Goods and Services ("ICGS") (the "First Mark"):[13]



7 Notes of Evidence ("NE") (2 November 2023) at page 10 line 12 to 14.

8 NE (2 November 2023) at page 40 line 27 to page 41 line 29.

9 NE (2 November 2023) at page 42 lines 4 to 10.

10 NE (2 November 2023) at page 42 lines 11 to 17.

11 NE (2 November 2023) at page 41 line 30 to page 42 line 3.

12 SOC at para 3; Defence at paras 3–4.

13 CCS at para 3(a).

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(b) Trade mark no. 40201808612Y, registered on 10 May 2018 for goods and services in Classes 5, 10, 25 and 44 (the "Second Mark"):[14]



(c) Trade mark no. 40201818910V, registered on 19 September 2018 for goods and services in Classes 10, 25 and 44 (the "Third Mark"):[15]



6 On 11 January 2022, Mr Reyneker instructed a property agent, Ms Wu Mei Yung (Anne Wu) ("Ms Wu"), to find a commercial space for the defendant's new branch. Mr Reyneker indicated that he was "looking for a heritage building or something unique and interesting" and that he had "River Valley in mind but [he was] open to other areas".[16] On 27 January 2022, Ms Wu informed Mr Reyneker that it did not seem promising to find a shophouse in the River Valley area due to a "shortage of supply".[17]

7 On 2 February 2022, Mr Reyneker informed Ms Wu that he could consider the East Coast region as another potential location.[18] In response, Ms Wu told Mr Reyneker that there were two conservation units in Joo Chiat.[19] On

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14 CCS at para 3(b).

15 CCS at para 3(c).

16 NE (2 November 2023) at page 119 lines 2 to 8; Wu Mei Yung (Anne Wu)'s Affidavit of Evidence-in-Chief (dated 15 June 2023) ("Ms Wu's AEIC") at paras 1, 7–11.

17 Agreed Bundle of Documents ("ABOD") 17.

18 NE (2 November 2023) at page 118 lines 2 to 28; page 119 lines 9 to 11.

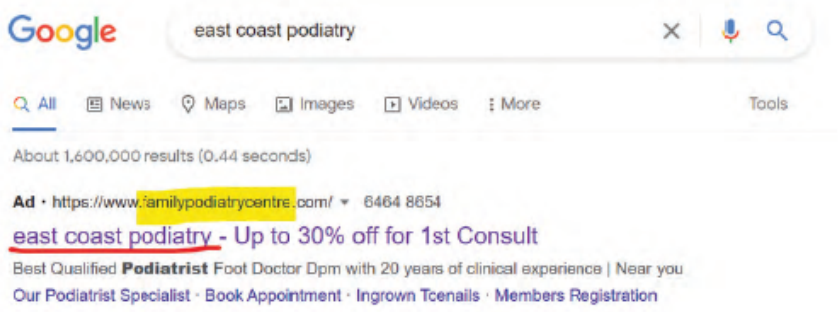
19 ABOD 18.

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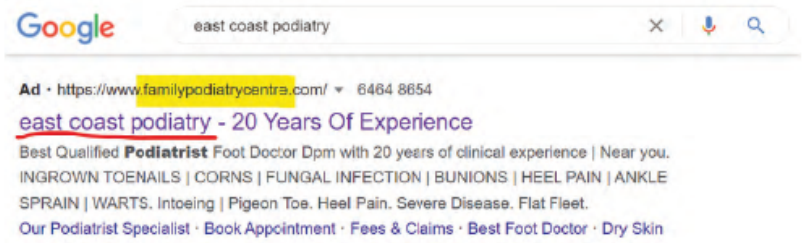
or around 7 April 2022, Mr Reyneker signed the Letter of Intent to rent the unit at 170 Joo Chiat Road.[20] Mr Reyneker subsequently signed the tenancy agreement for the unit on 22 April 2022.[21]

8 On 14 April 2022, Mr Tay discovered four of the defendant's advertisements on Google. The advertisements displayed the following headlines (collectively, the "First Incident Advertisements"):[22]

(a) "east coast podiatry – Up to 30% off for 1st Consult";



(b) "east coast podiatry – 20 Years of Experience";



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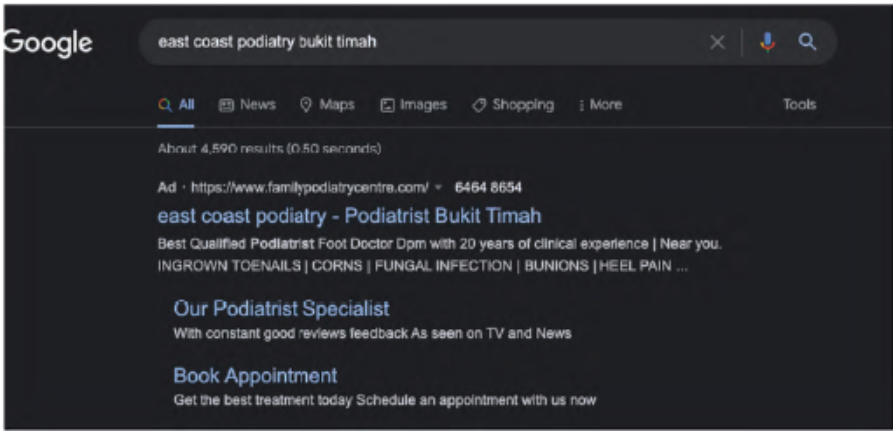
20 NE (2 November 2023), at page 118 lines 28 to page 119 line 1.

21 NE (2 November 2023), at page 118 lines 28 to page 119 line 1.

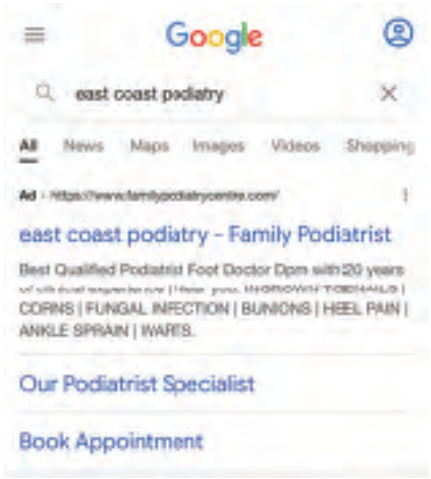
22 CCS at para 8.

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(c) "east coast podiatry – Podiatrist Bukit Timah"; and



(d) "east coast podiatry – Family Podiatrist".



9 On the same day, Mr Tay contacted Mr Reyneker over WhatsApp to inform him that the defendant's advertisements had infringed the claimant's trade marks.[23] Mr Tay included pictures of the alleged First Incident Advertisements, stating that: "[t]here's this trade mark infringement matter now

[23] CCS at para 9; Agreed Bundle of Documents ("ABOD") 43.

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that you may be unaware of. So I just want to check back with you if you know about this". In response, Mr Reyneker replied:[24]

> [14/4/22, 9:10:45 PM] Mark: Hi Jevon
>
> [14/4/22, 9:10:50 PM] Mark: This is from today?
>
> [14/4/22, 9:11:16 PM] Mark: Or have you seen this multiple times?
>
> [14/4/22, 9:16:57 PM] Mark: I can look into it but just an interesting thought – outside of this problem – can't other podiatrists in East Coast say East Coast podiatry? Don't think you can trademark and area and a profession. But you can trademark your logo and the way you write/draw East Coast Podiatry.

10 Although Mr Tay and Mr Reyneker exchanged messages thereafter, Mr Reyneker did not take down the defendant's First Incident Advertisements.[25]

11 The claimant therefore lodged a trade mark violation complaint with Google on 16 April 2022, and also wrote to Google on 10 May 2022, stating that the defendant's First Incident Advertisements "had infringed [the claimant's] ECPC Marks and or [the defendant had] passed itself off as the claimant".[26]

12 On 20 April 2022, the claimant's solicitors delivered a letter to the defendant demanding for the immediate removal of the term "East Coast Podiatry" from the First Incident Advertisements.[27]

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24 ABOD 40.

25 CCS at para 9.

26 CCS at para 10; SOC at para 1.

27 CCS at para 11.

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13 On 17 and 20 May 2022, Google's Legal Support Team informed the claimant that, after its investigations, it had restricted the First Incident Advertisements in accordance with the Google Ads Trademarks policy.[28]

14 On 6 May 2022, the claimant proceeded to file this claim against the defendant for infringement of the claimant's ECPC Marks under s 27 of the Trade Marks Act 1998 (2020 Rev Ed) (the "TMA") and for passing off.[29]

15 On 27 May 2022, the defendant filed its Defence and Counterclaim. In its Defence, the defendant alleged that its usage of the signs in the First Incident Advertisements was purely descriptive and there was no likelihood of confusion.[30] The defendant also brought a counterclaim that the claimant had made groundless threats of infringement pursuant to s 35(1)(a)–(c) of the TMA.[31]

16 On 3 July 2022, the claimant discovered two more of the defendant's Google advertisements. These advertisements had the following headlines (the "Second Incident Advertisements"):[32]

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28 CCS at para 12; ABOD 54–55.

29 SOC at paras 9–28.

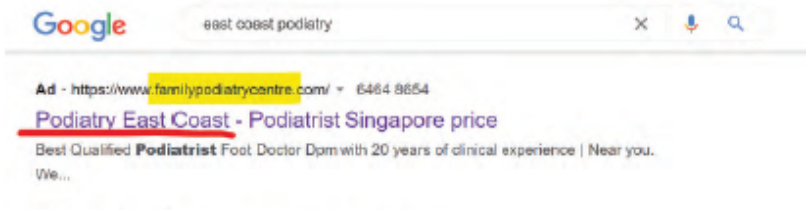
30 Defence at paras 22–23.

31 Counterclaim at paras 1–2.

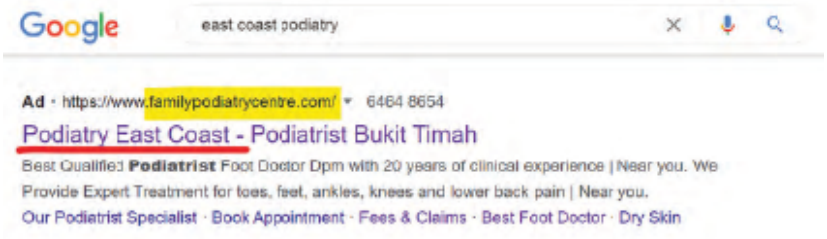
32 CCS at para 13.

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(a) "Podiatry East Coast – Podiatrist Singapore price"; and



(b) "Podiatry East Coast – Podiatrist Bukit Timah".



17 On the same day, the claimant lodged a complaint with Google that the defendant had used a variation of its ECPC Marks.[33] On 22 July 2022, the Google Legal Support Team responded and informed the claimant that the advertisements "should no longer display".[34]

18 On 28 July 2022, the claimant discovered three of the defendant's Google advertisements. These advertisements had the following headlines (the "Third Incident Advertisements"):[35]

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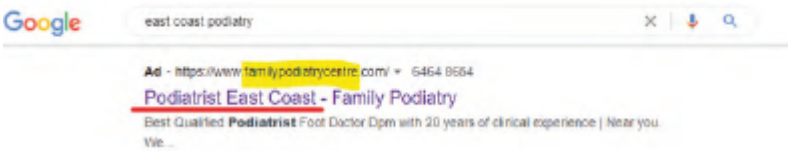
33 CCS at para 14.

34 CCS at para 14; ABOD 56.

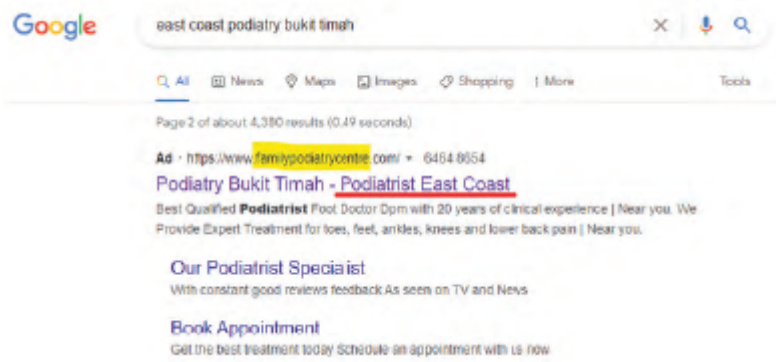
35 CCS at para 15.

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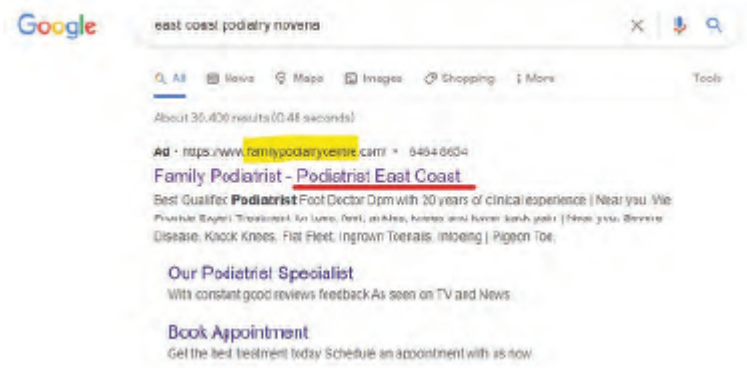
(a) "Podiatrist East Coast – Family Podiatry";



(b) "Podiatry Bukit Timah – Podiatrist East Coast"; and



(c) "Family Podiatrist – Podiatrist East Coast".



19 On the same day, the claimant lodged another complaint with Google that the defendant had used a variation of its ECPC Marks.[36] On 16 August 2022,

[36] CCS at para 16.

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the Google Legal Support Team wrote to inform the claimant that the advertisements "should no longer display".[37]

20 On 22 May 2023, the claimant amended its Statement of Claim to include its claims relating to the Second and Third Incident Advertisements. On 30 May 2023, the defendant also amended its Defence to include its position regarding the Second and Third Incident Advertisements.

21 Mr Tay explained in his Affidavit of Evidence-in-Chief ("AEIC") that the claimant's management team had chosen the name "East Coast Podiatry" for their Kembangan clinic as it resonated with them and was special to them.[38] This was because three members of the claimant's management team "had grown up in the east side of Singapore – all the way from nursery to secondary school to National Service".[39]

22 It is Mr Reyneker's testimony that he had inputted the words "east coast podiatry", "Podiatry East Coast" and "Podiatrist East Coast", in the First, Second and Third Incident Advertisements respectively, into the headlines of the defendant's Google advertisements.[40] According to Mr Reyneker, he had used the words "east coast podiatry", "Podiatry East Coast" and "Podiatrist East Coast" in the Advertisements as part of the defendant's "campaign to advertise the impending opening of its East Coast branch".[41] This was because he had

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37 CCS at para 16; ABOD 57.

38 Tay Jevon's Affidavit of Evidence-in-Chief (dated 16 June 2023) ("Mr Tay's AEIC") at para 9; NE (2 November 2023) at page 10 lines 17 to 28.

39 Mr Tay's AEIC at paras 6 and 9.

40 Mr Reyneker's AEIC at para 35; NE (3 November 2023) page 12 line 8 to page 13 line 23.

41 Mr Reyneker's AEIC at para 59.

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been advised by a Google consultant to use location-based keywords to improve the likelihood of Google search users finding the defendant's new East Coast clinic in their Google search results.[42]

23 Mr Tay initially took the view that the defendant's Joo Chiat clinic was a "mere facade" as it was "bare and sparsely furnished" and "ill-equipped to operate podiatry services".[43] Further, Mr Tay cast doubt on the defendant's intention to open a clinic in Joo Chiat, averring that "[t]he defendant did not have the manpower or resources to expan[d] to operate a second clinic".[44] Mr Tay subsequently abandoned this argument during his cross-examination.[45]

24 I make two observations. First, the reason the claimant proffers for its use of "East Coast" in its ECPC Marks may well be the reason why other traders may want to use the term "East Coast". It is a geographical area. Second, there are likely to be consumers who may view the term "East Coast Podiatry" as descriptive of podiatry services in the East Coast region. I do not need to grapple with the descriptive use issue, as this case can be decided on other grounds.

Procedural history

25 On 15 March 2023, the claimant filed a form electing for Part 2 of the Supreme Court of Judicature (Intellectual Property) Rules 2022 (the "SCJ(IP)R") to apply, and a form abandoning any claim for monetary relief in

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42 Mr Reyneker's AEIC at para 59.

43 Mr Tay's AEIC at paras 73–74.

44 Mr Tay's AEIC at para 74.

45 NE (2 November 2023) at page 37 lines 8 to 13; DCS at paras 36–37.

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excess of $500,000. This led to the application of the simplified process, pursuant to r 5(1) of the SCJ(IP)R.

26 On 15 March 2023, the defendant also filed a form electing for Part 2 of the SCJ(IP)R to apply and a form abandoning any claim for monetary relief in excess of $500,000 in respect of its counterclaim. As the defendant subsequently withdrew its counterclaim on 13 December 2023,[46] I do not need to consider the defendant's counterclaim in my judgment.

The parties' cases

27 The claimant submits that the defendant had infringed its ECPC Marks. The claimant alleges that the First Incident Advertisements constitute infringements under s 27(1) of the TMA or, alternatively, under s 27(2)(b) of the TMA.[47] For both the Second and Third Incident Advertisements, the claimant brings its claim under s 27(2)(b) of the TMA.[48] The defendant argues that the requirements for an infringement under s 27 of the TMA are not fulfilled and,[49] even if they are, its use satisfies the defence under s 28(1)(b)(i) of the TMA.[50]

28 The claimant also avers that the defendant is "liable for the tort of 'passing off' for using the terms 'east coast podiatry', 'Podiatry East Coast' and

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46 DCS at para 11.

47 CCS at para 20(a)–(b).

48 CCS at para 22(a).

49 DCS at paras 68–83.

50 DCS at paras 84–108.

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'Podiatrist East Coast' in the title of its Google Advertisements".[51] The defendant disputes this.[52]

Issues to be determined

29 In considering whether the First, Second and Third Incident Advertisements (collectively, the "Advertisements") infringe the claimant's ECPC Marks, I restrict my analysis to the Second Mark. The Second Mark contains the least additional elements to the words "East Coast Podiatry" and therefore has the greatest likelihood of similarity to the defendant's Advertisements. If the claimant does not succeed in its claim in so far as the Second Mark is concerned, it will also not succeed in relation to the First and Third Marks.

30 Therefore, the issues for my determination are as follows:

(a) First, whether the Advertisements infringe the Second Mark under s 27 of the TMA.

(b) Second, whether the claimant has proven the requisite elements of an action for passing off.

31 Although the defendant argues that its Advertisements are descriptive under s 28(1)(b)(i) of the TMA, I do not go on to consider the defence as I reach the conclusion that there is no infringement for the reasons that follow.

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51 Claimant's Opening Statement (dated 27 October 2023) ("COS") at para 18(d).

52 DCS at paras 62–67, 121–129; Defendant's Reply Closing Submissions (dated 19 January 2024) ("DRCS") at paras 20–22.

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Google Advertisements

32 There has been a surge in the use of the internet as a business and advertising platform. It has been acknowledged that the "[i]nternet's technological developments have … presented the courts and trade mark owners with other challenging issues that have no corollaries in the physical world" (Tan Tee Jim SC, *Law of Trade Marks in Singapore* (Sweet & Maxwell, 4th Ed, 2022) (*"Law of Trade Marks in Singapore"*) at para 20.033). It is in this context that the present case arises.

33 The dispute pertains to alleged trade mark infringements by way of Google Ads. It is useful to first discuss how Google Ads work.

34 The defendant takes issue with the claimant's witnesses, Mr Tay and Mr Cheow Yu Yuan ("Mr Cheow"), expressing their opinions on how Google Ads work. Mr Cheow is the Chief Executive Officer and co-founder of Oom Pte Ltd ("Oom"),[53] the web marketing agency which has been handling the claimant's Google marketing campaigns since 2016.[54] According to the defendant, although the claimant's witnesses are factual witnesses their evidence contains inadmissible "opinion evidence and speculation".[55]

35 I agree with the defendant that some parts of Mr Tay's and Mr Cheow's evidence constitute inadmissible opinion evidence. Under s 3(1) of the Evidence Act 1893 (2020 Rev Ed) (the "EA"), a "fact" is defined as "any thing, state of things, or relation of things, capable of being received by the senses;

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53 Cheow Yu Yuan's Affidavit of Evidence-in-Chief (dated 16 June 2023) ("Mr Cheow's AEIC") at para 4.

54 Mr Tay's AEIC at para 19.

55 DCS at para 18.

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and any mental condition of which any person is conscious". A witness would be giving evidence of a fact if "he merely testifies to the information he passively received" (Jeffrey Pinsler SC, *Evidence and the Litigation Process* (LexisNexis, 7th Ed, 2018) ("*Evidence and the Litigation Process*") at para 8.005). However, if a witness "goes beyond this by stating his inference, or offers an interpretation based on this information, he [would be] giving opinion evidence" (*Evidence and the Litigation Process* at para 8.005).

36 Mr Tay states in his AEIC that "[t]he URL section is not the 'promotional' portion of the advertisement and does not function as a badge of origin to an average viewer".[56] This is an inferred conclusion that goes beyond what is merely perceived. It is, therefore, a statement of opinion. Similarly, Mr Cheow's statement in his AEIC that "the increased [Cost-Per-Click ("CPC")] and decreased conversions in April 2022 can be directly correlated with the First Incident" is an inadmissible statement of opinion.[57] In so far as Mr Cheow also expresses his opinion on what the defendant may have done (*ie,* bidding for and purchasing "East Coast Podiatry" as a "keyword" and inserting the Claimant's business name "East Coast Podiatry" into the defendant's advertisement headlines), these are all speculative.[58]

37 Nonetheless, the claimant does not seriously rely on these assertions in its closing submissions. The claimant's position is simply that the court need not rely on any expert witness to come to its own conclusion on how such

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56 Mr Tay's AEIC at para 78.

57 Mr Cheow's AEIC at para 32.

58 Mr Cheow's AEIC at para 33.

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Google Ads operate.[59] No expert evidence was adduced before me as to how Google Ads work. In any case, this is not material to the present analysis given that Mr Reyneker has admitted that he had inputted the words "east coast podiatry", "Podiatry East Coast" and "Podiatrist East Coast", in the First, Second and Third Incident Advertisements respectively, into the headlines of the defendant's advertisements.[60]

38 Further, I take the view that given the current level of internet literacy of the general public, and the rampancy of the use of search engines such as Google, expert evidence would not be necessary for the court to conclude how an average consumer might perceive Google Ads. I find support for this view from *Interflora Inc and another v Marks and Spencer plc (No 2)* [2013] 2 All ER 663 ("*Interflora (CA) 1*") (at [59]) (see also *Cosmetics Warriors Ltd and another v amazon.co.uk Ltd and another* [2014] IP & T 497 ("*Cosmetics Warriors*") at [34]), which accepts that search engine results "fall within the general description of ordinary consumer services in relation to which the judge can make up his or her own mind without the need for expert evidence or the evidence of consumers".

39 The operations of Google's search engine and Google Ads have also been previously discussed in academic texts and foreign cases concerning trade mark infringement on the internet.

40 Upon entering words into Google's search engine (the "search words"), internet users are usually presented with a list of search results (the "search

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59 DCS at para 11.

60 Mr Reyneker's AEIC at para 35; NE (3 November 2023) page 12 line 8 to page 13 line 23.

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results"). Each search result includes a "headline", which functions as a hyper-link to a corresponding website, the Uniform Resource Locator (the "URL") of the corresponding website, and a short commercial message or description (*Interflora Inc and another v Marks and Spencer plc* [2015] IP & T 109 ("*Interflora (CA) 2*") at [15]; *Google France SARL and another v Louis Vuitton Malletier SA; Google France SARL v Viaticum SA and another; Google France SARL v Centre National de Recherche en Relations Humaines (CNRRH) SARL and others* [2011] All ER (EC) 411 ("*Google France*") at [10]). These search results would predominantly constitute natural results, which are ranked according to their relevance by way of automatic algorithms underlying the search engine program (*Google France* at [8]–[9]; *Law of Trade Marks in Singapore* at para 20.045).

41 Apart from the natural results, Google's search results also display "sponsored links" in response to the entry of similar search words by internet users *Google France* at [11]; *Law of Trade Marks in Singapore* at para 20.045; *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 16th Ed, 2018) at para 28–027). These sponsored links are advertisements created under Google's advertising system, Google Ads (*Interflora (CA) 2* at [14]). In creating these sponsored links, advertisers would have to "type in the keywords, draft the commercial message, and input the link to their site" (*Google France* at [12]). These sponsored links are "usually displayed in one or more parts of the [search engine results page]" and "over the years[,] the labelling of these sponsored links has varied, but they have generally been headed with the words 'Sponsored Links' or 'Ads' or variations of them" (*Interflora (CA) 2* at [14]). Similar to a natural search result, a sponsored link comprises of a "headline", a short commercial message, and the URL of the advertiser's website (*Interflora (CA) 2* at [15]). The keywords chosen by advertisers do not always appear

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within the "headline" or the commercial message (*Interflora (CA) 2* at [15]). In that situation, I consider them to be "invisible keywords".

Infringement under s 27 of the TMA

42 Section 27 of the TMA provides that:

> **27.**—(1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.
>
> (2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign where because —
>
> > (*a*) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
> >
> > (*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.
>
> …

43 Foreign case law is relevant in the following analysis. This is because the TMA is based on the Trade Marks Act 1994 (c 26) (UK) (the "UK Trade Marks Act"). One of the purposes of the UK Trade Marks Act was the implementation of the First Council Directive 89/104/EEC of 21 December 1995 to approximate the laws of Member States relating to trade marks (the "Directive") (*City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 ("*City Chain Stores*") at [15]). Although the courts in Singapore "are not bound by the rulings of the [European Court of Justice (the "ECJ")]", "the scheme of things set out in the Directive [are] relevant in interpreting s 27 of the Act" (*City Chain Stores* at [15]).

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44 The policy considerations and principles expounded by the English Court of Appeal in *Interflora (CA) 2* regarding internet advertising using keywords are equally relevant to the case before me. Kitchin LJ, giving the judgment of the court, stated (at [98]) that "internet advertising using keywords which are identical to trade marks is not an inherently objectionable practice". This is because:

> [The] aim [of internet advertising using keywords which are identical to trade marks] is, in general, to offer to internet users alternatives to the goods or services of trade mark proprietors and it is not the purpose of trade marks to protect their proprietors from fair competition.

45 Nonetheless, Kitchin LJ also recognised that "there are features of such advertising which may lead the consumer to mistake the origin of goods or services so advertised" and stressed the "importance of transparency in the display of advertisements on the internet" (*Interflora (CA) 2* at [143]). Accordingly, Kitchin LJ considered (at [143]) that a person who failed to "ensure that his advertisements … enable[d] average internet users to ascertain whether the goods or services originate[d] from the trade mark proprietor or an unconnected third party … may be found to have infringed the trade mark".

Infringing use under s 27 of the TMA

46 In *Dr Who Waterworks Pte Ltd and others v Dr Who (M) Sdn Bhd and others* [2023] SGHC 156 ("*Dr Who Waterworks*") (at [60]), I provided a summary of the elements for a trade mark infringement claim. Although the Appellate Division of the High Court overturned my findings in *Dr Who Waterworks* in relation to the breach of contract issue, it affirmed my findings on infringement and the tort of passing off (*Dr Who (M) Sdn Bhd and others v Dr Who Waterworks Pte Ltd and others* AD/CA 85/2023 (31 January 2024) at

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[9] and [17]). Regardless of whether a claim for trade mark infringement is brought under s 27(1) or s 27(2), the claimant must first prove that there was: (a) use by the defendant(s) within Singapore's territory; (b) in the course of trade; (c) in a trade mark sense; and (d) without the consent of the claimant(s) (*Dr Who Waterworks* at [60]).

47 The defendant does not dispute that it had used the signs in the Advertisements in the course of trade.[61] Under s 27(4)(e) of the TMA, "a person uses a sign if, in particular, the person uses the sign in advertising". The Advertisements clearly involved the defendant advertising its podiatry business via Google Ads.

48 Use "in a trade mark sense" or "trade mark use" refers to when the use complained of denotes the trade origin of the goods (*Dr Who Waterworks* at [78]). The defendant does not seriously dispute that there was "trade mark use" (although in its Reply Closing Submissions, it disagrees with the claimant's characterisation that it had utilised the signs in the "trade mark sense"),[62] but proffers a related argument that its use constitutes "descriptive use" under the defence in s 28(1)(b)(i) of the TMA. I will assume without deciding that it constitutes "use in a trade mark sense".

The defendant did not infringe the Second Mark under s 27(1) of the TMA

49 The claimant submits that the defendant's First Incident Advertisements constitute infringements under s 27(1) of the TMA.[63] Infringement under s 27(1)

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61 CCS at para 27(a)–(b); Defence at para 20.

62 DRCS at paras 12–17.

63 CCS at para 20(a).

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of the TMA is proven where there is identity between the alleged infringing sign and the mark; and between the respective goods or services (*Dr Who Waterworks* at [60]). The appropriate test of whether a sign is "identical" with a mark "entails a strict interpretation", and "[m]inor differences would take the case outside the definition of identical" (*City Chain Stores* at [39]). The Second Mark is a composite mark which includes a small white cross over a green square background (the "device"). Hence, it is visually different from the signs in the defendant's First Incident Advertisements. Consequently, there is no identity between the signs and the Second Mark.

The defendant did not infringe the Second Mark under s 27(2)(b) of the TMA

I assume that the Second Mark and the signs in the defendant's Advertisements are similar

50 Alternatively, the claimant avers that the Advertisements infringed its ECPC Marks pursuant to s 27(2)(b) of the TMA.[64] As indicated above at [29], I only consider this ground in relation to the Second Mark.

51 The defendant has not made any substantive submissions disputing the similarity of the claimant's Second Mark and the defendant's signs. It merely states that it "does not concede that the marks or signs used by [it] in the Incidents were similar to the ECPC Marks".[65] I assume, without deciding, that the signs are similar to the Second Mark.

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64 CCS at para 20(b).

65 DCS at para 68.

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The parties' services are identical

52 Although the Second Mark is registered in Classes 5, 10, 25 and 44 of the ICGS, the relevant classification on the facts before me is Class 44. The claimant's registration in Class 44 is for, *inter alia*, the "medical care of feet".[66] The defendant's Advertisements were in respect of its podiatry services (*ie,* "foot-related healthcare").[67] These services are identical to the "medical care of feet" services covered by the registration. Therefore, the parties' services are identical.

There is no likelihood of confusion

53 The likelihood of confusion inquiry involves an assessment of how the relevant segment of the public is likely to perceive the origin of the goods or services bearing the contesting marks (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 ("*Hai Tong*") at [76]). The test is whether a substantial portion of the relevant public will be confused (*Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 at [57]). This need not amount to a majority but must go beyond a *de minimis* level (*Hai Tong* at [78(e)], citing *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 ("*Sarika*") at [57]). The relevant public comprises the actual or potential purchasers of the goods or services in question and those who deal with such goods or services (Ng-Loy Wee Loon SC, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 3rd Ed, 2021) ("*Law of Intellectual Property of Singapore*") at para 21.5.27). The relevant public, depending on the specific facts, need not necessarily mean the general public

66 SOC at para 3.

67 DCS at para 62.

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(*Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 ("*Nation Fittings*") at [97]). Even where the relevant public is the general public, "the courts will still take the trouble to ascertain who, precisely, the target consumers are" (*City Chain Stores* at [59], citing *Nation Fittings* at [102]).

54 In the present case, I accept that the relevant public comprises the general public in Singapore who uses Google's search engine. The target consumers would include actual or potential consumers of podiatry services. The viewpoint to be adopted is that of the average consumer who "would exercise some care and a measure of good sense in making his or her purchases" and is "reasonably well-informed, reasonably observant and circumspect" (*Dr Who Waterworks* at [82], citing *Hai Tong* at [40(c)] and *Calvin Klein, Inc and another v HS International Pte Ltd and others* [2016] 5 SLR 1183 at [50(b)]). For internet advertising, it has been stated in *Cosmetics Warriors* (at [34]) (referring to *Interflora (CA) 2* at [130]) that the perspective to be adopted is that of "the reasonably well informed and reasonably observant internet user interested in the products in question".

55 Actual confusion is not necessary, it is sufficient for there to be a likelihood of confusion amongst the relevant public (*Law of Intellectual Property of Singapore* at para 21.5.25). Confusion can be either direct, "where the mark(s) and the sign(s) are mistaken for each other by the average consumer" or, indirect, "in which the similarities lead the average consumer to form the mistaken view that they originate from the same or linked undertakings" (*Hai Tong* at [73]; *Dr Who Waterworks* at [101]). Additionally, the initial interest confusion doctrine is not accepted in Singapore (*Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and*

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another and another appeal [2014] 1 SLR 911 ("*Staywell*") at [116]). The "material time at which th[e] confusion must exist in the mind of the relevant public is the time of purchase" (*Law of Intellectual Property of Singapore* at para 21.5.26).

56 Specific to the context of internet keyword advertising, the ECJ in *Google France* formulated a new test for determining whether the alleged infringing use has adversely affected, or is liable to adversely affect, the origin function of a trade mark (*Interflora (CA) 2* at [132]). This test was summarised by the English Court of Appeal in *Interflora (CA) 2* (at [75]–[77]) as follows:

> … First, *the critical question to be answered in such a case is whether the advertisement does not enable normally informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to in the advertisement originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party.*
>
> Second, the trade mark proprietor is entitled to prevent the display of third party advertisements which such internet users may erroneously perceive as emanating from that proprietor or which suggest that there is a material link in the course of trade between the goods or services in question and the proprietor.
>
> Third, if the advertisement, though not suggesting an economic link, is vague as to the origin of the goods or services in question so that such internet users are unable to determine, on the basis of the advertising link and the commercial message attaching to it, whether the advertiser is a third party or, on the contrary, is economically linked to the proprietor, then this will have an adverse effect on the origin function of the trade mark.
>
> [emphasis added]

57 The test was formulated in relation to Art 5(1)(a) of the Directive, which corresponds with s 27(1) of the TMA. I respectfully take the view that this is a useful test in the context of s 27(1) where, otherwise, confusion is not a requirement. It prevents s 27(1) from being applied in a mechanical manner

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once identity of marks and goods or services is established by looking at the underlying function of a trade mark as a badge of origin. Inasmuch as the test deals with confusion in the sphere of internet keyword advertising, I consider it to be equally applicable to determine confusion under s 27(2) of the TMA. It is also consistent with the propositions stated in [53]–[55] above. I also emphasise that the test does not alter the burden of proof. In *Interflora (CA) 2* (at [151]), the English Court of Appeal held that "the onus lies on the trade mark proprietor to establish [the requirements of the test]".

58 *Staywell* makes clear that there is a "limit to the range of external factors that may be taken into account" in determining whether a sufficient likelihood of confusion exists (*Staywell* at [95]):

> The permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumer. The impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps. In other words, factors which are not inherent in the goods, but are susceptible to changes that can be made by a trader from time to time, should not be permissible considerations.

59 The Court of Appeal in *Staywell* set out a non-exhaustive list of factors that are admissible in the confusion inquiry (at [96]), which was subsequently summarised in *Dr Who Waterworks* (at [102]):

> (a) Factors relating to the impact of mark-similarity on consumer perception:
>
> (i) degree of similarity of the mark themselves;
>
> (ii) the reputation of the marks;
>
> (iii) the impression given by the marks; and
>
> (iv) the possibility of imperfect recollection of the marks.

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> (b) Factors relating to the impact of goods/services-similarity on consumer perception:
>
> > (i) the normal way in or the circumstances under which consumers would purchase goods/services of that type;
> >
> > (ii) the price of the goods/services (as opposed to the price disparity between the competing goods);
> >
> > (iii) the nature of the goods/services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and
> >
> > (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

60 The claimant's position is that there is a "high likelihood of confusion".[68] In substantiating its view, the claimant relies on the factors set out in *Dr Who Waterworks* (at [102]). The defendant raises three grounds for its argument that there is no likelihood of confusion:

(a) First, the defendant contends that the Advertisements displayed the defendant's URL indicating the Advertisements' origin and dispelling any likelihood of confusion.[69]

(b) Second, the defendant relies on its website to establish a lack of likelihood of confusion. It avers that the Advertisements were ultimately linked to its website, which featured its own trading name "Family Podiatry Centre" and was visually distinct from the claimant's website.[70] In the defendant's view, this would dispel any potential confusion arising from the Advertisements.[71]

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68 CCS at para 64.

69 DCS at para 74(b).

70 DCS at para 74(a).

71 DCS at para 81.

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(c) Third, the defendant contends that even if the relevant public continued to be confused upon seeing the defendant's website and proceeded to make an appointment, any confusion would be dispelled upon physical arrival at the defendant's clinic.[72]

61 The claimant does not contest the admissibility of these grounds under the likelihood of confusion inquiry. Instead, it raises other contentions which I will address later at [85]–[95]. Regardless, it is necessary for me to be independently satisfied that these grounds are admissible considerations in the confusion inquiry.

(1) The defendant's URL

62 I am of the opinion that the defendant's URL is an admissible consideration. This is because, as mentioned above at [41], the URL is generally considered part of the sponsored link (*Interflora (CA) 2* at [15]). The ECJ in *Portakabin Ltd and Portakabin BV v Primakabin BV* Case C-558/08 (2010) ECR I-6963 ("*Portakabin*") (at [44]), in a preliminary ruling, stated in relation to Art 5(1)(a) of the Directive that the court is to "assess, *in light of how the ad[vertisement] is presented as a whole*, whether it enables the normally and reasonably attentive internet user to determine if the advertiser is a third party" [emphasis added]. Article 5(1)(a) of the Directive is the equivalent provision to s 27(1) of the TMA.

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72 DCS at para 81.

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(2) The defendant's website

63 An issue that arises is whether I can take into account the defendant's website or if it is an extraneous factor. Both parties have not made any detailed submissions on this issue.

64 There are arguably two possible approaches to this issue. The first approach is that the defendant's website is an inadmissible extraneous factor. This approach relies on the facts of *Staywell* by way of analogy. *Staywell* concerned an opposition to Staywell Hospitality Group Pty Ltd's ("Staywell") application to register the mark "PARK REGIS" in respect of, *inter alia,* hotel services. Staywell applied to register the "PARK REGIS" mark on 3 March 2008. Sheraton International, Inc ("Sheraton") was the registered proprietor of the "ST. REGIS" mark for, *inter alia,* hotel services. The "ST. REGIS" mark was registered well before 3 March 2008. Sheraton and Starwood Hotels & Resorts Worldwide, Inc (collectively, the "opponents") owned and operated the St. Regis Singapore hotel, which officially opened in April 2008. The opponents opposed the registration on 8 September 2008. Staywell's hotel, the Park Regis Singapore, opened for business in Singapore in November 2010 and had already begun operations by the time of the decision. The Principal Assistant Registrar ("PAR") allowed the opposition. Staywell appealed to the High Court.

65 In assessing the likelihood of confusion, the High Court took into account, amongst other things, the steps taken by Staywell to differentiate its services from the opponents'. These comprised the prominent display of the words "Staywell Hospitality Group" on Park Regis Singapore's website, the attempt to classify the Park Regis Singapore hotel as a four-star hotel in a different category from the St. Regis Singapore hotel, and the marketing of the hotel as a business rather than as a luxury hotel (*Staywell Hospitality Group Pty*

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Ltd v Starwood Hotels & Resorts Worldwide, Inc and another ("*Staywell (HC)*") at [47]). The court also acknowledged that upon checking-in, any potential confusion would be dispelled by the differing standards of hotel decor within the parties' hotel buildings and lobbies (*Staywell (HC)* at [42]–[43]). Consequently, the High Court concluded that there was no likelihood of confusion.

66 The Court of Appeal overturned the findings of the High Court and concluded that there was a likelihood of confusion as to the existence of an economic link between the two hotels in question (*Staywell* at [103]). In so doing, the court clarified the relevant considerations under the confusion inquiry as stated above at [58]–[59]. The various factors considered by the High Court, relating to the differences in the parties' marketing methods and channels, were held to be impermissible considerations in the confusion inquiry (*Staywell* at [102]). Further, as *Staywell* involved opposition proceedings, the court had to have regard to the range of notional fair uses of the marks. The court considered that the range of notional fair uses would "easily extend across the spectrum of 4- to 6-star hotel segments" (*Staywell* at [102]).

67 It is apparent from *Staywell* that the way the mark was displayed on Staywell's website, and the hotel decor were inadmissible extraneous factors in the confusion inquiry. Further, in the context of the internet, in so far as the parties' websites may be analogised to a "store front" or a "hotel lobby", it is arguable that the website would constitute an inadmissible extraneous factor.

68 The facts of *Staywell* appear analogous at first blush (as indicated at [67] above). However, on a deeper analysis, *Staywell* does not contemplate the issue in the present case. In *Staywell,* the application mark, "PARK REGIS", was

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intended to be used and was in fact being used on a physical hotel. The applicant's argument was that there could be no confusion between the Park Regis Singapore hotel and the St. Regis Singapore hotel because of the differentiating steps (including the website) it had taken. Here the physical podiatry clinics are "East Coast Podiatry Centre" and "Family Podiatry Centre". The complaint relates only to the use by the defendant of "east coast podiatry" in its internet advertising.

69 The second approach is not restricted to simply considering the sponsored links but involves going into the advertiser's website itself. Under this approach, the advertiser's website is considered an intrinsic part of the advertisement as a whole. Hence, the advertiser's website constitutes part of the actual use of the sign(s), *instead of an extraneous factor*.

70 This approach requires an understanding of how Google advertisements are intended to function. Determining the intended function of a Google advertisement would shed light on what the relevant consumer would perceive as its constituent elements and, accordingly, how the relevant consumer would perceive potentially infringing signs within sponsored links. It is generally accepted that sponsored links have the purpose of enticing internet users to click on them to be redirected to the advertiser's website. As suggested in *Law of Trade Marks in Singapore* (at para 20.060), "in practice, [i]nternet users would not necessarily conclude from a keyword advertisement that the advertiser is economically linked to the proprietor".

71 The intended function of Google advertisements has also been described in foreign case law. In *Google France*, it was observed (at [89]) that "[i]nternet users only decide on the origin of the goods or services offered on the sites by

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reading their description [on the search results] and, ultimately, by leaving Google and entering those sites". Further, "internet users will only make an assessment as to the origin of goods or services advertised on the basis of the content of the ad[vertisement] *and* by visiting the advertised sites" [emphasis added] (*Google France* at [91]). The decision of *Google France* was concerned with the issue of whether Google itself, by allowing the use of allegedly infringing keywords, had committed trade mark infringement. Nonetheless, these statements illustrate that the advertiser's websites are intrinsically linked to their sponsored links.

72 Similarly, in *Portakabin,* the court stated (at [41]) that it was a fact that "the advertiser … intend[ed] that internet users who enter[ed] that word as a search term should click on its advertising link in order to find out about its offers". Although this statement was made in the context of considering whether there was "use of the sign in relation to goods or services" (*Portakabin* at [42]), it still indicates that the purpose of a sponsored link is to provide a "connection" to the advertiser's website.

73 There are cases which, in my view, indicate that regard may be had to the parties' websites. In *32Red plc (a Gibraltar Company) v WHG (International) Ltd (a Gibraltar Company)* [2011] RPC 721 ("*32Red*") (at [145]), the English High Court reasoned that:

> Adwords are a familiar feature of life on the internet, and the reaction of the average consumer, when the sponsored link … came up on his screen, would I think be one of indifference or irritation, but not one of confusion. *If the consumer then clicked on the … site, its clear branding could have left no room for reasonable doubt about the identity of … whose services were on offer.* If the consumer did not click on the site, he will presumably have continued the search … and is most unlikely to have supposed that there was any business connection

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> between 32Red and the site which he originally sought to access …
>
> [emphasis added]

74 On appeal, the English Court of Appeal upheld the findings of the trial judge on this issue (*32Red Plc v WHG (International) Ltd* [2012] RPC 19). However, the context of the above quote in *32Red* was different. The court, in adopting this position, was specifically determining whether the plaintiff's registered marks should be revoked for being misleading on the basis of the equivalent provision of s 22(1)(d) of the TMA, and not the plaintiff's claim for infringement (*32Red* at [143]). While this passage attests to the general practice of internet users in approaching sponsored links, it admittedly does not go so far as to suggest that the advertiser's website can be considered under the likelihood of confusion inquiry for an infringement claim.

75 *Interflora Inc and another v Marks and Spencer plc and another* [2013] IP & T 931 ("*Interflora (HC)*") concerned the defendant's ("M & S") bid on invisible keywords containing the claimant's "Interflora" mark. Arnold J accepted that there could be consideration of the parties' websites in determining a likelihood of confusion under Art 5(1)(a) of the Directive (at [306]):

> Counsel for Interflora submitted that this did not detract from Interflora's case for two reasons. First, if there was initial confusion, it was probable that some consumers would remain confused after clicking through. Secondly, and in any event, such initial interest confusion was sufficient to establish Interflora's case under art 5(1)(a) … I accept both of these submissions.

76 Arnold J contemplated that even if there was initial interest confusion, there would still be a likelihood of confusion had consumers clicked on the advertisement and been redirected to the website. However, the Court of Appeal

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allowed the appeal and remitted the case for retrial (*Interflora (CA) 2* at [184]). The Court of Appeal first held that the doctrine of initial interest confusion should not be imported into EU trade mark law, "at least so far as it applie[d] to the use of a sign the same as or similar to a trade mark as a keyword in an internet referencing service" (*Interflora (CA) 2* at [155]). The court did not expressly take issue with Arnold J's consideration of the parties' websites in the confusion analysis.

77 *Cosmetics Warriors* concerned the claimants' ("Lush") claim that the defendants had infringed their "LUSH" mark. The defendants had bid on the Google keyword "lush", which triggered sponsored link advertisements on the Google search engine results page (*Cosmetics Warriors* at [7]). This grounded three classes of alleged infringements. Only the first class is relevant. The sponsored links in the first class of alleged infringements contained the LUSH mark, as illustrated below:


Lush Soap at Amazon.co.uk
www.amazon.co.uk/lush+soap
amazon.co.uk is **rated** *****

Low prices on **Lush** Soap

Free UK Delivery on Amazon Orders.

78 Upon clicking the relevant link in the advertisements, the consumer would be taken to the amazon.co.uk website and "presented with the opportunity to browse or purchase equivalent products" to the claimants' soap (*Cosmetics Warriors* at [8]–[9]). Referring to the first class of alleged infringements, the defendants argued that "if [the] user were at all interested in the ad[vertisement] he would click through and in a moment he would learn that

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the goods had nothing to do with [the claimants] at all" (*Cosmetics Warriors* at [40]).

79 The court adopted the test for internet keyword advertising cases in *Google France* (*Cosmetics Warriors* at [35]–[36]). The court, however, held that there was infringement under the first class of alleged infringements, because the average consumer would not, without difficulty, be able to ascertain that the goods in the advertisements were not goods of or connected with the claimants (*Cosmetics Warriors* at [42]). It reasoned (at [42]) that:

> … the average consumer seeing the ad … would expect to find Lush soap available on the Amazon site and would expect to find it at a competitive price. Moreover, I consider that it is likely that if he were looking for Lush soap and did not find it immediately on the Amazon site, then he would persevere somewhat before giving up. My reason is that the consumer is likely to think that Amazon is a reliable supplier of a very wide range of goods and he would not expect Amazon to be advertising Lush soap for purchase if it were not in fact available for purchase.

80 The court accepted that the defendants' website could be taken into account when determining whether there was a likelihood of confusion although, on the facts, it found that the website would not dispel any confusion caused by the presence of the "lush" word within the sponsored links. The court first observed that the website had shown "equivalent or similar products" to those sold by the claimant, and "[t]here [was] no overt message either within the advertisement or on the Amazon site that Lush Soap [was] not available for purchase on the Amazon website" (*Cosmetics Warriors* at [8]). However, the crux of the decision turned on the fact that the average consumer was likely to think that the defendant, Amazon, was a reliable supplier of a very wide range of goods and "would not expect Amazon to be advertising Lush soap for purchase if it were not in fact available for purchase" (*Cosmetics Warriors* at

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[42]). Therefore, a consumer looking for Lush soap who did not find it immediately on the Amazon site would "persevere somewhat before giving up" (*Cosmetics Warriors* at [42]).

81 I prefer the second approach. First, as alluded to above at [68], the decision in *Staywell* did not contemplate the exact factual situation before me. The complaint in the present case concerns the use of the signs on advertisements only. The defendant's services are provided from its physical clinic under the name "Family Podiatry Centre". The analysis should, therefore, compare the Second Mark against the defendant's Advertisements as a whole and, on that basis, determine if there is a likelihood of confusion. This is in line with the statement by the ECJ in *Portakabin* (at [44]) that the court must assess the likelihood of confusion "in light of how the ad[vertisement] is presented as a whole".

82 Second, and more importantly, the present case concerns the use of the signs within Google advertisements. As indicated by a survey of the relevant authorities above at [70]–[72], the intended function of a Google advertisement is for the relevant consumer to click on the sponsored link within the advertisement and be automatically redirected to the advertiser's website. The advertiser's website is, therefore, intrinsically linked to the sponsored link in which the sign is used. The relevant consumer, being "familiar with sponsored ad[vertisements] and … used to seeing such ad[vertisements] from competing suppliers" (*Cosmetics Warriors* at [45]), is likely to make an assessment *in totality* as to the origin of the goods or services offered, before purchasing the good(s) or service(s). The second approach accords better with the purchasing practices of the relevant consumers when faced with sponsored links. In this context, the first approach which establishes a likelihood of confusion by

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considering the similarity of the mark(s) and sign(s) and the similarity of the parties' services alone, would also veer too close to applying the initial interest confusion doctrine. The second approach is also supported by the willingness of the English High Court in *Cosmetics Warriors* to consider the defendant's website as part of the confusion inquiry. In my judgment, in the specific context of Google advertisements, the advertiser's website is *not* an extraneous factor.

83 Finally, the defendant argues that even if the average consumer remains confused after viewing the defendant's website, any remaining confusion will be dispelled by the defendant's physical clinic.[73] As I accept that the website is an integral part of the defendant's Advertisements and, on that basis, decide that there is no likelihood of confusion, I do not need to go further to consider this argument.

(3) Application to the facts: no infringement under s 27(2)(b)

84 I conclude that there is no infringement under s 27(2)(b) of the TMA.

85 On their face, the defendant's sponsored links do not specifically advertise the defendant's Joo Chiat clinic. The claimant also raises a few factors in the confusion inquiry. First, the claimant suggests that it "enjoyed recognition as the most well-known podiatry brand in Singapore".[74] Second, the claimant avers that the average consumer would not recognise the "minor differences" in the Second Mark and the defendant's advertisements due to their imperfect recollection.[75] Third, the claimant suggests various factors that would affect the

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73 DCS at para 81.

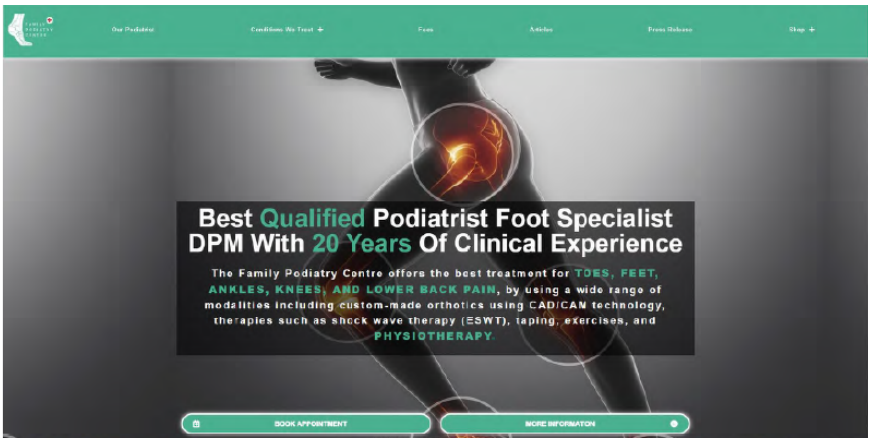
74 CCS at para 62(b).

75 CCS at para 62(c).

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similarity of the parties' services on consumer perception, such as how consumers would normally purchase the claimant's services and the claimant's average charges for its services.[76] The claimant also alleges that a large proportion of the relevant public consists of new customers who may be "window shopping" and not fastidious or pay particular attention to the different podiatry brands.[77]

86 The claimant's submissions do not advance its case. This is because the relevant public would be automatically redirected to the defendant's website upon clicking on the defendant's Advertisements. The defendant's website would dispel any confusion that might have arisen at first instance. I reproduce the "home page" of the defendant's website below:[78]



87 The top left corner of the defendant's website displays the defendant's registered trade mark no. 40202253026X (the "defendant's registered trade

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76 CCS at paras 63(a)–(b).

77 CCS at para 63(c).

78 ABOD 165.

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mark"), which is vastly different from the Second Mark. It has two devices: (a) an image of a foot; and (b) a small red insignia with a white circle background, along with the defendant's trade name "Family Podiatry Centre".[79]



The centre text of the defendant's home page includes the defendant's trade name in the description: "[t]he Family Podiatry Centre offers the best treatment".[80] There is nothing that would cause the relevant public to think that the podiatry services offered originate from the claimant. The defendant's website makes no mention of the phrase "east coast podiatry" or "east coast".

88 For the above reasons, I conclude that the relevant public would, upon clicking on the defendant's Advertisements, be immediately aware that the defendant's website is not associated with the claimant.

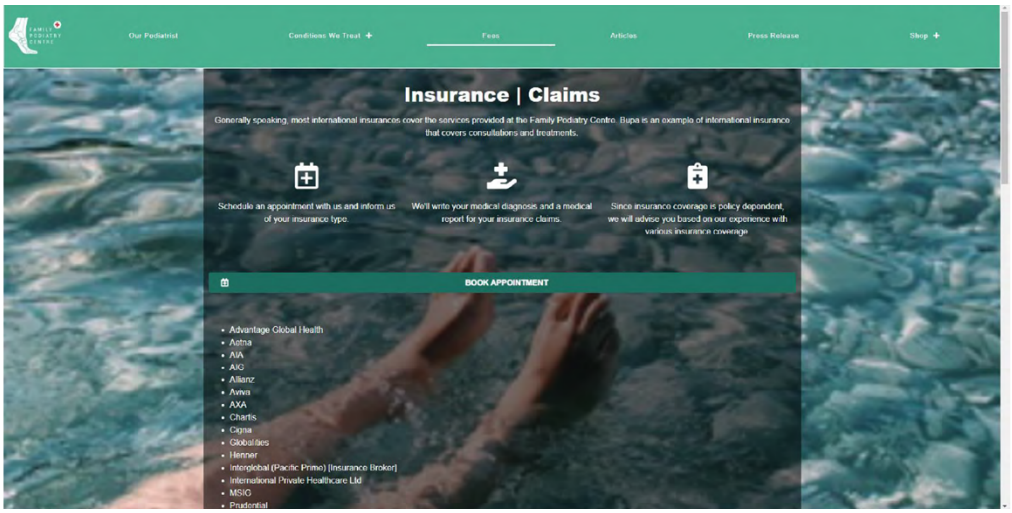
89 The claimant finally submits that "a new customer may use the quick link [titled "Book Appointment" in the defendant's advertisement] to book an appointment" and bypass the home page of the defendant's website and be

[79] ABOD 175.

[80] ABOD 165.

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immediately redirected to the "fees" page of the defendant's website:[81]



90 There is no evidence that this is what the relevant public would do. I reject this submission on the basis that the typical reasonably well informed and reasonably observant internet user is unlikely to book an appointment by simply looking at the sponsored link and clicking on the quick link, without considering the advertiser's website.

91 The relevant public is also unlikely to perceive the defendant to be a linked undertaking of the claimant. In *Staywell*, the court held that the public was likely to be induced into believing that there was an economic link between the parties because it was "common for large hotel chains to operate differently branded hotels carrying different logos, united only by use of a common denominator in their names" (*Staywell* at [102]). Similarly, in *Interflora (CA) 2*, Interflora had operated a flower delivery network, and the florists within the network traded not only "under their own brand names but also under the trade mark Interflora" (*Interflora (CA) 2* at [10]). Hence, a significant proportion of

[81] CCS at paras 66(b) and 67(b); ABOD 167.

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the consumers who searched for "Interflora" and then clicked on M & S's advertisements displayed in response to those searches, would not appreciate that M & S were not members of that network (*Interflora (HC)* at [318]). It was for this reason that Arnold J, in *Interflora (HC)*, held that there was trade mark infringement although the offending advertisement only made reference to 'M & S Flowers Online' and not to the plaintiff's 'Interflora' mark (*Cosmetics Warriors* at [47]). In comparison, the claimant in the present case does not operate a "network" of clinics under different trade marks. In fact, it is the claimant's case that it had consolidated the names of its four clinics as "East Coast Podiatry" in 2017. It is, therefore, unlikely that the average consumer, upon seeing the First Incident Advertisements, would conclude that there was an economic link between the defendant and the claimant.

92 The defendant only offers its own podiatry services under the name "Family Podiatry Centre" on its website and from its physical clinic. This is contrasted with Amazon (in *Cosmetics Warriors*) which was an online shopping retailer that sold both its own goods and the goods of third parties via its website (*Cosmetics Warriors* at [2]). For this reason, John Baldwin QC held in *Cosmetics Warriors* (at [42]) that:

> In my judgment, Lush establishes infringement with respect to this class of case. I consider that the average consumer seeing the ad … would expect to find Lush soap available on the Amazon site and would expect to find it at a competitive price. Moreover, I consider that it is likely that if he were looking for Lush soap and did not find it immediately on the Amazon site, then he would persevere somewhat before giving up. My reason is that the consumer is likely to think that Amazon is a reliable supplier of a very wide range of goods and he would not expect Amazon to be advertising Lush soap for purchase if it were not in fact available for purchase. Thus, *on the facts of this case,* I reject [Amazon's] argument to the effect that the average consumer would, without difficulty, ascertain that the goods referred to by the ad were not the goods of or connected with Lush, the claimants.

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[emphasis added]

93 Amazon had the reputation of being a "reliable supplier of a very wide range of goods". Therefore, an average consumer would not expect Amazon to be advertising Lush soap for purchase if it were not in fact available for purchase. And if the consumer did not find it immediately, he would persevere before giving up. It was on these facts that John Baldwin QC said that he rejected Amazon's argument that the average consumer would, without difficulty, be able to ascertain that the goods referred to by the advertisements were not the goods of or connected with the claimants. In the present case, unlike *Cosmetics Warriors*, there would be no difficulty for normally informed and reasonably attentive internet users to ascertain that the podiatry services referred to in the Advertisements, viewed as a whole to include the defendant's website, do not originate from the claimant. Accordingly, the claimant fails to discharge its burden of proof in relation to a likelihood of confusion.

94 In my judgment, the claimant's action for trade mark infringement under s 27(2)(b) of the TMA fails. It is, therefore, unnecessary for me to consider the defence under s 28(1)(b)(i) of the TMA.

95 As I have concluded that the defendant's Advertisements do not infringe the Second Mark, I also find that there is no infringement of the First and Third Marks.

The claimant's action for passing off

96 A claim for passing off requires proof of three core elements, namely, goodwill, misrepresentation and damage (*Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [37]; *Singsung Pte Ltd v*

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LG 26 Electronics Pte Ltd (trading as L S Electrical Trading) [2016] 4 SLR 86 ("*Singsung*") at [27]–[28]).

There is goodwill in the claimant's business

97 The common law action of passing off "seeks to protect the goodwill of the plaintiff's business as a whole, rather than an invasion of the mark(s) used" (*Dr Who Waterworks* at [168], citing *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 ("*CDL Hotels*") at [45]). Prior cases have identified two essential characteristics of goodwill (*Law of Intellectual Property of Singapore* at para 17.1.3): (a) that it is the "power of attraction which draws customers to buy the trader's goods" (*The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [81]); and (b) that the relevant goodwill must be in connection to a business (*Singsung* at [67]). Goodwill can also be limited to specific sectors of the public, as long as these sectors are not negligible (*Amanresorts* at [44]).

98 The relevant date to determine the existence of goodwill is the date on which the defendant's alleged infringing conduct commenced (*CDL Hotels* at [34]). In the present case, I take the relevant date to be 14 April 2022 as that is the earliest date of the defendant's First Incident Advertisements.

99 In my opinion, the requisite goodwill is established. In considering the first characteristic of goodwill, the reputation of the claimant's business, the analysis considers the claimant's business as a whole, and not with reference to a particular mark (*Singsung* at [34]). The evidence adduced to prove reputation

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is thus not restricted to the promotion of the mark alone. Relevant factors may include (*Law of Intellectual Property of Singapore* at para 17.2.1):

> … the length of time the [claimant's] goods or services have been available in the Singapore market; the extent of advertising and media coverage of the [claimant's] goods or services in Singapore and the sales volume achieved in Singapore.

100 Firstly, the claimant has been operating in Singapore since 2015, albeit only consolidating its business under the trade name "East Coast Podiatry" in 2017.[82]

101 Secondly, the claimant has engaged in various advertising and marketing efforts which contribute to a finding of goodwill:

(a) Since early 2016, the claimant has engaged the web marketing agency, Oom, to handle its Google marketing campaigns.[83] Between 2016 to 2017, the claimant paid Oom a monthly average of $2,250 in marketing agency fees and $15,000 for Google Ads.[84] Between 2018 to 2022, the amount increased to around $3,500 to $5,000 in marketing agency fees and $32,000 to $50,000 for Google Ads monthly.[85]

(b) Since or around 2017 or 2018, the claimant engaged social media "influencers" (*ie,* individuals with a high following count on

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82 NE (2 November 2023) at page 41 line 30 to page 42 line 25.

83 Mr Tay's AEIC at para 19; Mr Cheow's AEIC at para 16.

84 CCS at para 73(b); Mr Cheow's AEIC at para 23.

85 CCS at para 73(b); Mr Cheow's AEIC at para 23.

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social media) to promote its business on social media sites such as YouTube, Facebook and Instagram.[86]

(c) The claimant also maintained an in-house marketing and production team to promote itself on social media sites such as YouTube, Facebook, Instagram and LinkedIn.[87] According to Mr Tay's testimony at trial, this marketing team consisted of ten employees.[88]

(d) The claimant had also printed and published merchandise relating to its business.[89]

102 The claimant has also raised three separate instances of being featured in the traditional media.[90] In these instances, the claimant was allegedly invited by the media outlets to be featured.[91] Although the claimant's feature in the traditional media was not extensive, I find that this would reinforce the finding of goodwill in the claimant's business.

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86 CCS at para 73(c); ABOD 101–105; NE (2 November 2023) at page 16 line 17 to page 17 line 8.

87 CCS at para 73(d); NE (2 November 2023) at page 20 line 25 to page 21 line 2.

88 NE (2 November 2023) at page 18 line 22 to page 19 line 3.

89 NE (2 November 2023) at page 20 line 32 to page 21 line 2; ABOD 112–113.

90 ABOD 106–111.

91 NE (2 November 2023) at page 17 lines 14 to 22.

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103 Thirdly, the claimant's revenue figures for the financial years ended 2019 to 2022 are significant, further evidencing the existence of goodwill. The revenue figures are as follows:[92]

Financial Year ended	Revenue ($)
2019	5,779,449
2020	6,000,512
2021	8,426,742
2022	9,120,764

104 There is no dispute as to the business presence of the claimant in Singapore at the relevant date (*Singsung* at [67]). This is rightly so, as the claimant was operating four podiatry centres in Singapore as of 14 April 2022. The second characteristic of goodwill is therefore also proven.

No misrepresentation giving rise to a likelihood of confusion

105 In establishing "misrepresentation", the claimant must show that there was a false representation, giving rise to actual confusion or a likelihood of confusion on the part of the relevant public (*Dr Who Waterworks* at [175] and [177]). The relevant public is the actual and potential customer of the claimant (*Amanresorts* at [71]–[76]). The relevant time of confusion is at the time of purchase (*Staywell* at [116]).

106 The threshold inquiry involves determining whether the claimant's trade mark is distinctive (*viz,* whether the relevant public recognises or associates the mark exclusively with the claimant's goods or services) (*Singsung* at [38]).

92 Exhibit C1 tendered during trial (dated 2 November 2023)

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Where this is fulfilled, the claimant has to satisfy the court that there was a misrepresentation by the defendant and that the misrepresentation gave rise to actual confusion or a likelihood of confusion (*Amanresorts* at [77]–[78]; *Singsung* at [40]).

The claimant's ECPC Marks are distinctive

107 A mark which is *prima facie* descriptive will only be protected if it can be shown to have acquired a secondary meaning (*viz,* it has become distinctive of the claimant's business) (*Lifestyle 1.99 Pte Ltd v S$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 ("*Lifestyle 1.99*") at [27]).

108 The words "East Coast" are generally taken to refer to the geographical region in the East of Singapore, while the word "podiatry" has the ordinary meaning of foot-related healthcare.[93] Taken together, the phrase "East Coast Podiatry" would bring to mind a podiatry related business located in the East Coast region of Singapore. Thus, the claimant's ECPC Marks have a descriptive connotation when used in relation to podiatry services in the East Coast region of Singapore. However, where the ECPC Marks are used for podiatry services in other geographical locations in Singapore, they cannot be considered to be descriptive in any way. As the claimant operates three other clinics in other regions in Singapore with same mark containing the words "East Coast Podiatry", I find that the ECPC Marks are sufficiently distinctive.

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93 DCS at para 62.

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No misrepresentation giving rise to confusion or a likelihood of confusion

109 The determination of whether misrepresentation has occurred is to be assessed in light of the surrounding circumstances (*Singsung* at [40]). The court is not constrained, in the same way as it would be in a trade mark infringement action, in the factors it may take into account (*Hai Tong* at [115]; *Allergan, Inc and another v Ferlandz Nutra Pte Ltd* [2016] 4 SLR 919 at [184]). The inquiry allows a consideration of extraneous factors (see *Law of Intellectual Property of Singapore* at para 23.1.16). Such misrepresentation "must have the effect of giving rise to actual confusion or a likelihood of confusion" (*Amanresorts* at [77]).

110 For the same reasons above at [84]–[95], there is no likelihood of confusion arising from the defendant's Advertisements. In my judgment, the claimant has not sufficiently proven that the defendant's Advertisements resulted in confusion or a likelihood of confusion.

Conclusion

111 For all the foregoing reasons, the claims for trade mark infringement and for passing off fail. I emphasise that it is only on the facts of this case that I have decided as such. There is still a need to ensure that internet advertisements comply with the test stated above at [56]. Acknowledging the strong policy concerns in favour of protecting the value of trade marks as badges of origin (*Staywell* at [78]), there may well be cases of internet advertising where there is a finding of infringement.

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112 I will hear the parties on costs, separately.

Dedar Singh Gill
Judge of the High Court

Phipps Jonathan (LegalStandard LLP) for the claimant;
Mohamed Zikri Bin Mohamed Muzammil and Quay Wee Meng Andrew (Hin Tat Augustine & Partners) for the defendant.

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