

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF THE
INTELLECTUAL PROPERTY OFFICE OF SINGAPORE**

[2025] SGIPOS 3

Trade Mark No. 40202003904X-02

**IN THE MATTER OF A TRADE MARK APPLICATION
IN THE NAME OF
SKINS IP LIMITED**

... Applicant

AND

**AN OPPOSITION BY
SYMPHONY HOLDINGS LIMITED**

... Opponent

GROUNDS OF DECISION

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Symphony Holdings Limited
v
Skins IP Limited

[2025] SGIPOS 3

Trade Mark No. 40202003904X-02
Principal Assistant Registrar Tan Mei Lin
10 February 2025

9 May 2025

Principal Assistant Registrar Tan Mei Lin:

Introduction

1 This is an opposition by Symphony Holdings Limited (the “Opponent”) against an application by Skins IP Limited (the “Applicant”) to register the following trade mark (the “Subject Mark”) in Singapore.

Trade Mark	SKINS
TM No.	40202003904X-02
Filing Date	21 February 2020
Class	24
Goods	Textiles; bed and table covers; towels; bath towels; beach towels; hand towels; face towels, tea towels, flannels; bed linen including duvet covers, pillow cases, sheets, blankets; handkerchiefs; table linen; table cloths; napkins; place-mats; curtains, textile materials for use in the manufacture of blinds; pennants; banners;

	flags; textile wall hangings; table mats; cushion covers; throws (textile articles).
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2 There was no oral hearing for this case as parties agreed to have the dispute decided on the papers. Although there was no physical hearing, 10 February 2025 was designated as the hearing date for administrative purposes.

Background of parties

3 The Opponent is a company incorporated in Hong Kong and is principally engaged in sports branding and retailing businesses. It is the proprietor of the following trade mark in Singapore (the “Earlier Mark”):

Trade Mark	
TM No.	T0913773I
Date of registration	26 November 2009
Goods	<u>Class 10</u> Surgical and medical garments; pressure garments and devices; compression garments and devices; therapeutic compression garments; stockings for medical and therapeutic use; elastic supports, including elastic supports for stabilising injured areas of the body; all being goods in Class 10. <u>Class 18</u> Bags, including bags of leather and imitation leather; athletic bags; beach bags; backpacks; handbags; backpacks incorporating hydration packs; knapsacks; luggage; purses; wallets; key cases; satchels; shoulder bags; sports bags [other than adapted (shaped) to contain specific sport apparatus]; ball bags [other than adapted to contain specific sports apparatus]; bottle bags; boot bags; cricket bags [other than adapted to

	contain specific sports apparatus]; duffle bags; draw-string bags; football bags [other than adapted to contain specific sports apparatus]; gear bags [other than adapted to contain specific sports apparatus]; gym bags; holdalls; sports kit bags [other than adapted to contain specific sports apparatus] and team bags; travelling bags. <u>Class 25</u> Clothing, footwear, headgear; including clothing for men, women, children and babies; clothing for sports including football, gymnastics, cycling, golf and skiing; clothing for motorists and travellers; underwear including compression underwear; outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, T-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes; swimwear including bathing trunks and bathing suits; thermal clothing; wetsuits; waterproof clothing; sweatbands for the wrist; shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots; socks, stockings, tights; bandannas and headbands. <u>Class 28</u> Bags adapted for sporting articles, golf bags.
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4 The Earlier Mark was previously owned by a Swiss company, Skins International Trading AG (“SITAG”). Upon SITAG’s bankruptcy, the Opponent acquired the Earlier Mark by way of a purchase agreement dated 31 July 2019.

5 The Applicant, a company based in the United Kingdom, was incorporated on 21 August 2019 and is in the business of leasing of intellectual property.

6 On 26 August 2019, the Applicant applied before this tribunal to revoke the registration of the Earlier Mark on the grounds of non-use (see *Skins IP*

Limited v Symphony Holdings Limited [2022] SGIPOS 16). Unhappy with the learned IP Adjudicator's decision to revoke the registration partially, the Opponent appealed to the High Court (HC/TA 11/2022). No written grounds of decision were issued by the High Court, but the Opponent partially succeeded in its appeal. The list of goods shown in the table at [3] takes into account the outcome of the High Court proceedings.

Opponent's evidence

7 The Opponent's evidence comprises the following:

- (a) a statutory declaration made by Benjamin Fitzmaurice, Chief Operating Officer of the SKINS division of the Opponent, dated 30 May 2023;
- (b) a statutory declaration made by Lu Cher Hsiam, Director of Fit N' Fab Pte Ltd, a Singapore-based company appointed by the Opponent to distribute SKINS products, dated 30 May 2023; and
- (c) a statutory declaration in reply made by the same Benjamin Fitzmaurice dated 17 November 2023.

Applicant's evidence

8 The Applicant's evidence comprises the following:

- (a) a statutory declaration made by Matthew McAleer, the Applicant's trade mark attorney in the UK, dated 28 September 2023; and
- (b) a supplementary statutory declaration made by the same Matthew McAleer dated 16 April 2024.

Grounds of opposition

9 The Opponent relies on s 7(6), s 8(2)(b), s 8(4)(b)(i) and s 8(7)(a) of the Trade Marks Act 1998 (the “Act”) in this opposition.

Applicable law and burden of proof

10 The applicable law is the Act. There is no overall onus on the Applicant before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

Ground of opposition under s 7(6)

11 Section 7(6) of the Act reads:

A trade mark must not be registered if or to the extent that the application is made in bad faith.

12 The fundamental legal principles underlying the law on bad faith are set out in the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”):

(a) The term “bad faith” embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark (*Valentino* at [28]).

(b) The test for determining bad faith contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Bad faith as a concept is context-dependent. In the final analysis,

whether bad faith exists or not hinges on the specific factual matrix of each case (*Valentino* at [29]).

(c) Once a *prima facie* case of bad faith is made out by the alleging party, the burden of disproving any element of bad faith on the part of the responding party would arise (*Valentino* at [36]).

(d) An allegation of bad faith is a serious claim to make and must be sufficiently supported by evidence. It must be fully and properly pleaded and should not be upheld unless it is distinctly proved, and this will rarely be possible by a process of inference (*Valentino* at [30]).

(e) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion (*Valentino* at [20]).

Decision on s 7(6)

13 Whether bad faith exists or not hinges on the specific factual matrix of each case.

The Opponent's evidence

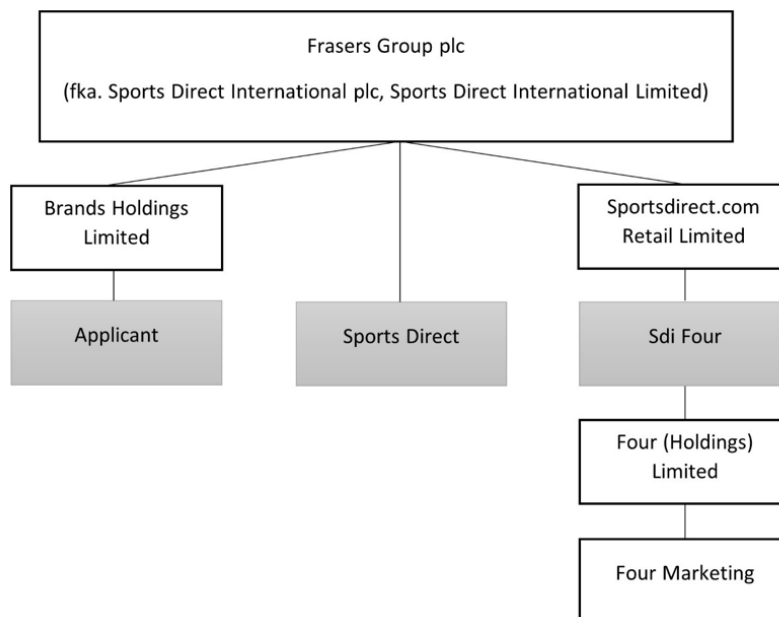
14 The Opponent's evidence, given through Benjamin Fitzmaurice, who was also SITAG's General Counsel and Human Resource Director from 2009 to 2017 and SITAG's Chief Operating Officer from 2017 to 2019 is as follows.

15 Since sometime in 2011, when the Earlier Mark was still under the ownership of SITAG, goods bearing the Earlier Mark were distributed in the UK, Ireland and Europe through a British retailer, Sports Direct Holdings Limited ("Sports Direct"). Both the Applicant and Sports Direct are ultimately

owned by the same entity, Frasers Group plc (“Frasers Group”) (formerly known as Sports Direct International plc and Sports Direct International Limited). The directors of the Applicant are also directors of Sports Direct.

16 Further, upon SITAG’s bankruptcy in 2019, other than the Opponent, another company, Four Marketing Limited (“Four Marketing”), also participated in the bidding for SITAG’s IP portfolio but failed in its bid. Four Marketing is owned by Four (Holdings) Limited, which in turn is owned by Sdi Four. Sdi Four is owned by Sportsdirect.com Retail Limited and Sportsdirect.com Retail Limited is in turn owed by Frasers Groups plc.

17 The relationship among the above companies can be summarised in the following figure, with each box representing a corporate entity, the entity appearing above the connecting line having significant control over the entity appearing below, and the shaded box indicating that these are entities that have the same directors and the same office address.



18 By virtue of the above, the Applicant knew or must have known of the Opponent’s ownership of the Earlier Mark.

19 Within three weeks following Four Marketing’s unsuccessful bid for the purchase of SITAG’s IP portfolio, on 21 August 2019, the Applicant was incorporated. On the same date, the Applicant applied to the European Union Intellectual Property Office (“EUIPO”) to register “SKINS” as a trade mark. Subsequently, applications were made to the following countries: Australia, Canada, India, New Zealand, Norway, Singapore, Switzerland, Taiwan, Turkey, United Kingdom, United States and Vietnam relying on the EUIPO application as priority.

20 On 26 August 2019, the Applicant applied before this tribunal to revoke the registration of the Earlier Mark on the grounds of non-use. On 21 February 2020, the Applicant applied to register the Subject Mark.

21 The statutory Companies House account filings of the Applicant show that it has been completely dormant since the Applicant’s incorporation date. This shows, according to the Opponent, that the Applicant has not traded or taken any step in trade and commerce legitimising, creating or establishing any lawful right to seek registration of the Subject Mark.

The Applicant’s evidence

22 Although the Applicant filed evidence through its attorney, it did not rebut any of the Opponent’s evidence and neither did it explain why it believed it was entitled to apply to register the Subject Mark or explain how its actions were compatible with accepted standards of ethical behaviour or honest commercial and business practices.

Evaluation

23 It is helpful to begin by looking at the case of *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”). In that case, the appellant was the proprietor of trade marks which are variations of “FESTINA and device”. The appellant opposed the respondent’s application to register “J.ESTINA and device” as a trade mark. The court considered that the respondent’s brand story for the name “J.ESTINA” (the letter “J” was said to have been derived from “Jovanna” who was an Italian princess and Bulgarian queen) appeared to be extremely contrived. In any event, the alleged use of Princess Jovanna’s name did not explain how and why the meaningless word “ESTINA” came into being. The respondent’s failure to furnish a credible explanation in respect of the derivation of “ESTINA” was especially pertinent since six out of seven letters were identical in sequence between the two competing marks, which led to the irresistible conclusion that “ESTINA” was blatantly copied from “FESTINA”. The High Court held, at [122] - [124], that “[s]uch outright copying of the Appellant’s mark [was] an act that falls short of the acceptable commercial behaviour observed by reasonable and experienced men in the relevant trade” and that the respondent’s application was undoubtedly made in bad faith.

24 The court observed at [114] - [116]:

114 ... the numerous attempts in drawing the parameters of “bad faith” by various courts are vivid illustrations of the inherently abstract nature of this concept. The concept of bad faith is extremely wide in the sense that the courts can infer instances of bad faith and decide according to the justice of individual cases. Naturally, the court should also be cautious in not over-extending this concept lest it becomes a weapon of terror against competitors of trade mark proprietors.

115 The categorisation by *Bently & Sherman* ([38] *supra*) as seen above hints that despite the broad nature of the notion of bad faith, one must show *some sort of nexus* between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in vacuum. A clear-cut example of such a nexus would

be an outright copying of the proprietor's mark such that the two competing marks are practically identical. However, the nexus may be in the guise of something more subtle. In finding a nexus between the parties, a parallel may be drawn between ss 8(2)(b) and 7(6) TMA. For example, there may be cases where although there is some similarity of marks or of the goods or services, it falls short of confusing similarity (*ie*, no likelihood of confusion) within the meaning of s 8(2)(b) TMA. Nevertheless, the evidence of this similarity may be taken into account and considered against the background facts from which bad faith may be inferred. In other words, while the finding of bad faith is largely, if not invariably, based on circumstantial evidence, the party alleging bad faith needs to show some link between the parties, perhaps by way of a preexisting relationship or some acts of association with the proprietor or some nexus between the two competing marks.

116 There may be a fine line between being inspired by another's trade mark as opposed to blatant copying or copying with some modifications made to the mark. The former would not attract punitive measures whereas the latter would lead to the mark being rejected. Where the dividing line between "inspiration" and "infringement" should be drawn is a matter best left to the facts peculiar to any case.

25 There is a nexus between the parties in the present case. Sports Direct was a distributor of goods bearing the Earlier Mark and Four Marketing was involved in the bid for SITAG's IP portfolio. The Applicant, Sports Direct and Four Marketing are all companies under Frasers Group. Given the Applicant's relationship within the Frasers Group it is reasonable to assume that the Applicant must have known of the Earlier Mark and/or the Opponent's ownership of the Earlier Mark. The Applicant did not deny knowledge of this in its statutory declaration either. The subjective element in the test for bad faith (*i.e.* what the Applicant in this case knows) is therefore satisfied.

26 I move on to consider the objective element in the test for bad faith. Would the Applicant's dealings be considered to be commercially unacceptable by reasonable experienced persons in the particular trade? What would ordinary persons adopting proper standards think?

27 In the present case, the marks concerned are:

Earlier Mark	Subject Mark
	

28 The similarities in the parties' marks are obvious. The Applicant has taken the entire word element of the Earlier Mark and applied to register it in plain ordinary font.

29 A relevant factor when determining whether there was bad faith is whether there has been a failure by the trade mark applicant to address the allegation of bad faith (see *PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2010] 2 SLR 109 at [90] for an example of a case where this factor, *inter alia*, was taken into account).

30 In the present case, the Applicant made no attempt to offer any explanation at all as to why it chose to use the word "SKINS" as its company name and trade mark. If the Applicant had nothing to hide surely it would have come forward to respond to the allegations that were levelled at it.

31 Having considered all the circumstances, I find that reasonable and experienced men in the relevant trade would take umbrage with the Applicant's dealings. As noted in *Festina*, "... copying with some modifications made to the mark ... would lead to the mark being rejected." Further, in *Weir Warman Ltd v Research & Development Pty Ltd* [2007] SGHC 59 at [44], it was held that:

... where it can be shown that the applicant knew of an *exclusive* proprietary right of *another* in relation to the trade mark it seeks

to furtively register, then any such registration would, almost invariably, quite clearly fall short of the relevant standards ...

32 For the avoidance of doubt, I am aware that the Subject Mark is applied for in Class 24 whereas the Earlier Mark is registered in Classes 10, 18, 25 and 28. However, as alluded to above, once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion.

Conclusion on opposition under s 7(6)

33 The ground of opposition under s 7(6) succeeds.

Other grounds of opposition

34 The Opponent only needs to succeed on one ground of opposition for the Subject Mark to be refused registration. My decision above in relation to the bad faith ground is sufficient to dispose of the matter and it is not necessary for me to decide on the remaining grounds. However, in case I am wrong in my finding of bad faith, I am setting out my preliminary views on the other grounds of opposition very briefly below.

Ground of opposition under s (8)(2)(b)

35 The law governing s 8(2)(b) is well-settled. The courts give effect to this provision by applying a step-by-step approach under which the three requirements of (a) similarity of marks; (b) similarity of goods or services; and (c) likelihood of confusion arising from the two similarities, are to be assessed systematically. The first two elements are assessed individually. The final element is assessed in the round (*Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”) at [15]). If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

36 My preliminary view is that the second step of the inquiry (similarity of goods) might pose a problem for the Opponent.

37 The Opponent’s case on goods-similarity was that its goods in Class 25 (the “Opponent’s Goods”) are similar to the Applicant’s goods in Class 24 (the “Applicant’s Goods”) as they may be manufactured by the same undertakings, sold via the same trade channels (whether online or in brick-and-mortar stores), and viewed and chosen for purchase by the same customers on the same occasion. It also relied on a case of this tribunal, *Calvin Klein Trademark Trust v IDM Apparel Pte Ltd* [2011] SGIPOS 12 (“*Calvin Klein*”), where the comparison was undertaken between the goods in Class 24 and Class 25, and they were found to be similar. It was reasoned at [34] of *Calvin Klein* that:

... Class 24 [concerns the] general category of bedding goods [while] Class 25 goods ... are essentially clothing items. The goods in both Class 24 and Class 25 are goods generally made of fabric or cotton and therefore have a similar physical nature. The trade channels are also the same, being generally, departmental stores. ... it is not an uncommon practice for traders to expand their fashion lines from clothing to home fashion...

38 At [67] of the Opponent’s written submissions, it submitted:

By adopting the same reasoning [as *Calvin Klein*], the Applicant’s Goods (which are essentially textile materials, bedding goods, towels, tablecloths, etc in Class 24) are similar to the Opponent’s Goods in Class 25 (which are clothing items) at the very least...

39 In my view, the fact that goods are made of the same material in and of itself is not enough to justify a finding of similarity in all cases. It is also necessary to consider the other factors listed down in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”). In the present case, the parties’ goods serve completely different purposes: *clothing* is meant to be

worn by people, or serves as a fashion article, whereas *textile goods* are mainly for household purposes and interior decoration. Therefore, their method of use is different. Moreover, the distribution channels and sales outlets of *textile goods* and *clothing* are different, and the relevant public will not think that they originate from the same undertaking.

40 In a department store, the Applicant's Goods would be found in the household/bedding and bath sections of the store whereas clothing would be displayed in a different section or often on a different level of the store. They are not sold side-by-side. The Applicant's Goods are also not competing goods nor complementary in nature to clothing.

41 The Opponent referred to *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 ("*Festina*") where the High Court said:

71 ...there is a growing phenomenon of brands expanding into goods of various kinds in recent years. Sometimes, the crossing-over takes place between goods that one does not commonly associate with each other, for instance, cigarettes and clothing. The idea of licensing out one's trade mark or engaging in a sister brand or diffusion line has inevitably led to the same trade mark being found on a multitude of goods available in the market. In this regard, there is force in the Appellant's submissions that there is a sense of "relatedness" between goods such as necklaces and clothing and a broad classification of these items as "fashion accessories" or "lifestyle goods" may be justified.

72 Applying the *British Sugar* ([66] *supra*) test to the present facts, it would be reasonable in the modern context to regard the goods in Classes 9, 14, 18 (trunks and suitcases and, in some instances, even umbrellas and parasols) and 25 as complementary in nature and are likely to be of similar uses, targeting almost identical end users and employing similar if not identical trade channels by which the goods reach the market. Thus, there is *some* similarity between "necklaces, rings, bracelets, earrings, medals and brooches" in the Respondent's application and the goods for which the

Appellant's other marks are registered in Classes 9, 18 (the items specified above) and 25.

42 The Opponent submitted, based on *Festina* that there is a “relatedness” between the Applicant’s Goods and the Opponent’s Goods in that it is common for clothing companies to branch out into home fashion. However, the Opponent provided no evidence to substantiate its claim for such alleged common practice. Even if it is true that some clothing stores nowadays also sell textile goods for the home under their marks, this does not appear to me to be the norm in the clothing industry. This may be true of extremely large undertakings but they may not necessarily reflect what is typical in the clothing industry.

Ground of opposition under s (8)(7)(a) and s (8)(4)(b)(i)

43 Both s 8(7)(a) (which relates to passing off) and s (8)(4)(b)(i) (which protects earlier trade marks that are well known in Singapore) require the Opponent to establish a likelihood of confusion. In the former, likelihood of confusion is intertwined with a finding of misrepresentation: the second element of the tort of passing off (see *Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR(R) 216 at [77]). As for s 8(4)(b)(i), the case law is clear: the requirement of likelihood of confusion is embedded within the word “connection” (see *Staywell* at [120]).

44 My preliminary finding above that the parties’ goods are dissimilar and that the parties’ are not in mutual competition means that it is more difficult for the Opponent to show that confusion is likely to arise. For the avoidance of doubt, this does not mean that confusion cannot arise.

45 Further, showing a likelihood of confusion is not the only hurdle that the Opponent would have to cross. Even before it proves likelihood of confusion, under s 8(7)(a) the Opponent needs to establish that it enjoys goodwill in

Singapore. Similarly for s 8(4)(b)(i) before reaching the issue of confusing “connection”, it must be first shown that the Earlier Mark is well known to the relevant sector of the public in Singapore.

46 My preliminary view is that the Opponent’s evidence on both these issues is weak. Due to SITAG’s bankruptcy and the loss of historical records concerning SITAG’s use of the Earlier Mark, the Opponent was unable to produce evidence of sales revenue, promotional figures, invoices, marketing materials, partnership and distribution agreements pertaining to the Singapore market. Without such evidence, a finding that SITAG had goodwill in Singapore from its business pertaining to the Earlier Mark as at 21 February 2020 and that the Earlier Mark was used to such an extent that it is well known to the relevant sector of the public in Singapore, would be uphill.

Conclusion

47 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the opposition succeeds on the ground of bad faith. The application shall therefore be refused.

48 I have considered the parties’ submissions on costs and, having regard to all the circumstances, award the Opponent the sum of S\$10,889.00 (inclusive of disbursements).

Tan Mei Lin
Principal Assistant Registrar

Christopher Woo and Emma Qing (Quahe Woo & Palmer
LLC) for the Opponent;
Francine Tan and Ng Yi Xun (Francine Tan Law Corporation)
for the Applicant.