

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

[2026] SGIPOS 12

Trade Mark Nos. 40202208778V and 40202208779S

IN THE MATTER OF REGISTERED TRADE MARKS

IN THE NAME OF

NEXTEVO HOLDINGS PTE LTD

... Proprietor

**AND APPLICATIONS FOR A DECLARATION OF
INVALIDITY BY**

NEXT HOLDINGS LIMITED

... Applicant

GROUND OF DECISION

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NEXT Holdings Limited
v
NEXTEVO Holdings Pte Ltd

[2026] SGIPOS 12

Trade Mark Nos. 40202208778V and 40202208779S

Principal Assistant Registrar Tan Mei Lin

26 February 2026, 23 June 2026

23 September 2026

Principal Assistant Registrar Tan Mei Lin:

Introduction

1 NEXTEVO Holdings Pte. Ltd. (“the Proprietor”) registered the following trade marks in Singapore (collectively, “the Registered Marks”):

Trade Mark No.	40202208778V
Mark	NEXTEVO
Classes	23, 24
Specification	<u>Class 23</u> Carded threads in natural fibres for textile use; Carded yarns of hemp for textile use; Carded yarns in natural fibres for textile use; Chemical fiber base mixed thread and yarn; Chemical-fiber threads and yarns for textile use; Coir thread and yarn; Combed yarns made of natural fibres; Cotton thread and yarn; Elastic thread and yarn for textile use; Heat-stable yarns and threads; Hemp thread and yarn; Jute thread and yarn; Linen thread and yarn; Mixed spun threads and yarns; Natural yarns; Regenerated fiber thread and yarn for textile use; Semi-

	synthetic fiber thread and yarn for textile use; Semi-synthetic fiber thread and yarn [chemically treated natural fiber yarn]; Synthetic fiber thread and yarn for textile use; Textile filaments [threads]; Threads and yarns for textile use. <u>Class 24</u> Bedroom textile fabrics; Coated textiles; Coated woven textile materials; Composite textile materials; Disposable bedding of textile; Disposable tablecloths of textile; Elastic fabrics for clothing; Fabrics being textile piece goods; Fabrics being textile goods in roll form; Fabrics for textile use; Furnishing fabrics being textile piece goods; Furniture coverings of textile; Gift wrap of textile; Hand towels of textile; Heat resistant fabrics, other than for insulation; Household textile piece goods; Kitchen towels [textile]; Labels made of textile materials; Linings [textile]; Non-woven fabrics of natural fibres; Non-woven textile fabrics; Reinforced fabrics [textile]; Sheets [textile]; Synthetic textile piece goods; Textile fabrics for making into linens; Textile fabrics for making into clothing; Textile fabrics for making up into household textile articles; Textile fabrics for use in the manufacture of towels; Textile fabrics for use in the manufacture of curtains; Textile fabrics for use in the manufacture of furniture; Textile fabrics for use in the manufacture of sportswear; Textile fabrics for use in the manufacture of wall coverings; Textile piece goods; Textiles and substitutes for textiles; Waterproof textile fabrics; Woven fabrics for making up into articles of clothing.
Application Date	18 April 2022

Trade Mark No.	40202208779S
Mark	NEXTEVO 
Classes	23, 24
Specification	<u>Class 23</u> Carded yarns of hemp for textile use; Carded yarns in natural fibres for textile use; Carded threads in natural fibres for textile use; Chemical fiber base mixed thread and yarn; Chemical-fiber threads and yarns for textile use; Coir thread and yarn; Combed yarns made of natural fibres; Cotton thread and yarn; Elastic thread and yarn for textile use; Heat-stable yarns and threads; Hemp thread and yarn; Jute thread and yarn; Linen thread and yarn; Mixed spun threads and yarns; Natural yarns; Regenerated fiber thread and yarn for textile use; Semi-synthetic fiber thread and yarn [chemically treated natural fiber yarn]; Semi-synthetic fiber thread and yarn for textile use; Textile filaments [threads]; Synthetic fiber thread and yarn for textile use; Threads and yarns for textile use. <u>Class 24</u> Bedroom textile fabrics; Coated textiles; Coated woven textile materials; Composite textile materials; Disposable bedding of textile; Disposable tablecloths of textile; Elastic fabrics for clothing; Fabrics being textile goods in roll form; Fabrics being textile piece goods; Fabrics for textile use; Furnishing fabrics being textile piece goods; Furniture coverings of textile; Gift wrap of textile; Hand towels of textile; Heat resistant fabrics, other than for insulation; Household textile piece goods; Kitchen towels [textile]; Labels made of textile

	materials; Linings [textile]; Non-woven fabrics of natural fibres; Non-woven textile fabrics; Reinforced fabrics [textile]; Sheets [textile]; Synthetic textile piece goods; Textile fabrics for making into linens; Textile fabrics for making into clothing; Textile fabrics for making up into household textile articles; Textile fabrics for use in the manufacture of towels; Textile fabrics for use in the manufacture of curtains; Textile fabrics for use in the manufacture of furniture; Textile fabrics for use in the manufacture of sportswear; Textile fabrics for use in the manufacture of wall coverings; Textile piece goods; Textiles and substitutes for textiles; Waterproof textile fabrics; Woven fabrics for making up into articles of clothing.
Application Date	18 April 2022

2 NEXT Holdings Limited (“the Applicant”) filed applications for a declaration of invalidity against the Registered Marks. The proceedings were consolidated into one invalidation action.

3 This matter was heard by the late Principal Assistant Registrar, See Tho Sok Yee (“the late PAR”) on 26 February 2026. Regrettably, she passed away before she was able to render her grounds of decision.

4 The Trade Marks Rules (“the Rules”) do not stipulate how the Registrar should proceed in such a situation. However, rule 81A(1) empowers the Registrar to direct the parties to attend a case management conference “in order that the Registrar may make such order or give such direction as he thinks fit for the just, expeditious and economical disposal of the matter” at any stage of proceedings, and rule 81A(9) further provides that such a case management conference be held “in an asynchronous manner”.

5 In the present situation, the Registrar has drawn guidance from the following:

(a) Order 15 rule 14 of the Rules of Court 2021, which provides:

(1) Where a judge or a Registrar who has heard a matter has not given his or her decision, or who has heard part of a matter, passes away or becomes incapable of giving his or her decision or continuing with the hearing for any reason, another Judge or Registrar may take over and give his or her decision based on the earlier hearing or continue with the hearing, if all the parties consent.

(2) The Judge or Registrar who takes over the matter may recall any witness to give evidence and also order the parties to make further submissions.

(3) If the parties do not consent under paragraph (1), the matter must be heard anew by another Judge or Registrar.

(b) Order 20 rule 16 of the Singapore International Commercial Court Rules 2021, which provides:

(1) Where a Judge or Registrar who has heard a matter has not given his or her decision or who has heard part of a matter passes away or becomes incapable of giving his or her decision or continuing with the hearing for any reason, another Judge or Registrar may take over and give his or her decision based on the earlier hearing or continue with the hearing, if all the parties consent.

(2) The Judge or Registrar who takes over the matter may recall any witness to give evidence and also order the parties to make further submissions.

(3) If the parties do not consent under paragraph (1), the matter must be heard anew by another Judge or Registrar.

6 While neither of the above provisions applies directly to proceedings before this tribunal, the Registrar may look to them as persuasive guidance in determining the appropriate procedure where the Rules are silent, provided that doing so is consistent with the Trade Marks Act 1998 (“the Act”) and the Rules

and with the principles of fairness and natural justice.

7 On 20 May 2026, the Registrar wrote to the parties setting out the following options:

(a) If parties consent, another hearing officer may take over the matter and render a decision based on the earlier oral hearing. In doing so, the hearing officer will have regard to all documents previously filed, as well as any notes of hearing that were taken. If the hearing officer considers it necessary, he or she may invite the parties to make further submissions.

(b) If the parties do not consent to option (a), a fresh oral hearing will be fixed before another hearing officer. The written submissions and bundles of authorities already filed will remain part of the record, and parties will have the option of filing further written submissions if they wish to do so.

8 Both parties agreed to proceed with option (a) – the Proprietor on 28 May 2026 and the Applicant on 2 June 2026. On 9 June 2026, parties were informed that I would be taking over the matter and were invited to file any additional submissions and any additional bundle of authorities. The Applicant filed further submissions on 23 June 2026.

Background of parties

9 The Applicant is a British retailer founded in 1864¹. It claims to have grown to be one of the largest, if not the largest, retailers of fashion products (including clothing and footwear) and household and home-related products

¹ [5] of the Applicant's statutory declaration.

(including home decors, home textiles, furniture covers) in the world². To date, the Applicant has approximately 450 stores in the United Kingdom and more than 180 franchised stores in other countries, including in Asia, Europe and the Middle East. It also operates online through “NEXT Online”, which is wholly owned by the Applicant.

10 The Applicant claims that its “NEXT” marks were first used in Singapore around 2012³. Consumers in Singapore can buy the Applicant’s products bearing “NEXT” marks in SGD currency at <https://www.next.sg/en> . They can also do so on Zalora Singapore, a major e-commerce platform in Singapore⁴.

11 The Proprietor is a Singapore company in the business of transforming agricultural waste into environmentally friendly materials and products. For instance, the Proprietor works with pineapple leaves for textile applications and with coconut husks for soil amendment applications, geotextiles and animal bedding. The Proprietor also works with other plant-based non-conventional fibres with a view to using them for textile-based applications in future⁵.

12 The Proprietor claims to use the “NEXTEVO” mark in respect of its materials, and not in respect of finished products. It provides its materials to commercial partners such as fashion brands, textile mills and manufacturers for further processing⁶. It has established a robust business presence in Southeast

² [11] of the Applicant’s statutory declaration.

³ [10] of the Applicant’s statutory declaration.

⁴ [12] of the Applicant’s statutory declaration.

⁵ [1] of the Proprietor’s counter-statement.

⁶ [9] of the Proprietor’s statutory declaration.

Asia, with operations located in Singapore, Indonesia and Thailand⁷.

13 The derivation of “NEXTEVO” will be discussed in my analysis of conceptual similarity between the competing marks.

Grounds of invalidation

14 The Applicant relies on the following grounds of invalidation in the Act:

- (a) Section 23(3)(a)(i) read with s 8(2)(b)
- (b) Section 23(3)(a)(iii) read with s 8(4)(b)
- (c) Section 23(3)(b) read with s 8(7)(a)
- (d) Section 23(1) read with s 7(6).

Applicant’s evidence

15 The Applicant’s evidence comprises the following:

- (a) a Statutory Declaration made by Ian Blackwell, Legal and Compliance Director for the Applicant, on 18 December 2024, in Leicester, UK (“the ASD”); and
- (b) a Statutory Declaration in Reply made by the same Ian Blackwell on 22 October 2025, in Leicester, UK (“the ASDR”).

⁷ [10] of the Proprietor’s statutory declaration.

Proprietor's evidence

16 The Proprietor's evidence comprises a Statutory Declaration made by Harold Koh, founder, Chief Executive Officer, Director, and shareholder of the Proprietor, on 25 June 2025 in Singapore ("the PSD").

Burden of proof and relevant date

17 There is no overall onus on the Proprietor before the Registrar during examination and in invalidation proceedings. The undisputed burden of proof in the present case falls on the Applicant.

18 The relevant date to assess the requisite elements of the grounds of invalidation is 18 April 2022, which is the application date of the Registered Marks ("the Relevant Date").

Ground of invalidation under s 23(3)(a)(i) read with s 8(2)(b)

19 Section 23(3)(a)(i) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in section 8(1) or (2) apply...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

20 Section 8(2)(b) of the Act reads:

(2) A trade mark must not be registered if because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

21 In *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”) at [15], the Court of Appeal adopted the “*step-by-step*” approach under s 8(2)(b) of the Act. This may be summarised as follows:

- (a) The first step is to assess whether the respective marks are similar.
- (b) The second step is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected.
- (c) The third step is to determine whether there exists a likelihood of confusion arising from the marks- and goods/services-similarities.
- (d) “The first two elements are assessed individually before the final element which is assessed in the round”. If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

Application of s 8(2)(b) to the facts

22 The Applicant refers to the following earlier “NEXT” trade marks (“Earlier Marks”) registered in Singapore:

S/No.	Mark	Trade Mark No.	Class(es)	Application Date
1	NEXT	T1200458B	14, 18, 25, 35	12 January 2012
2	NEXT	T9807605F	24	28 July 1998

S/No.	Mark	Trade Mark No.	Class(es)	Application Date
3	NEXT	T9807604H	20	28 July 1998
4	NEXT	T9807603Z	11	28 July 1998

It bears saying for the record that the Earlier Marks above pre-date the application date of the Registered Marks, 18 April 2022, and as such, fulfil the definition of an “earlier trade mark” under s 2(1) of the Act. This condition precedent for s 8(2)(b) to operate is therefore established.

Step 1: Marks-similarity

23 I first consider marks-similarity in the three-step test in *Staywell* and assess whether the Registered Marks and the Earlier Marks are similar.

24 The general principles are summarized by the learned Goh Yihan JC in *V V Technology Pte Ltd v Twitter, Inc* [2023] 5 SLR 513 (“*Twitter*”) at [24] to [28]:

24 The general principles for the evaluation of marks-similarity are not disputed. These have been set out in several Court of Appeal decisions, such as *Staywell* and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 (“*Hai Tong*”). In this regard, I adopt the PAR’s succinct summary of these principles with the appropriate modifications (see the GD at [32]).

25 First, the distinctiveness of the earlier trade mark is an integral factor in the marks-similarity inquiry. More specifically, the greater the earlier mark’s technical distinctiveness, the higher the threshold before a competing mark is considered dissimilar to it (see *Staywell* at [25]). This is because highly distinctive marks, unlike descriptive or laudatory marks, are strong badges of origins of the goods or services in question. These marks therefore deserve stronger protection to protect their strong source denoting ability. The outcome is that, to overcome an opposition based on a highly distinctive mark, an

applicant will need to prove “to a more compelling degree that his mark or sign is indeed dissimilar from the registered mark” (see *Hai Tong* at [30]).

26 Second, there are three aspects of the evaluation of marks-similarity, namely, visual, aural and conceptual similarities. However, there is no requirement that all three similarities need to be made out before the marks or signs that are being compared may be found to be similar. Indeed, the Court of Appeal in *Staywell* (at [18]) held that a formulaic approach should not be adopted, and the similarity of marks is ultimately a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise (at [17]). Rather, the task is to “ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar” and that the three aspects of similarity are meant to work as signposts to guide the court’s inquiry rather than as a “checkbox exercise in which a tick, however faint it might be, in any one box must compel the court to find that the marks are similar when a sensible appraisal of the marks as a whole would show otherwise” (at [17]). At the marks-similarity stage, the assessment is mark-for-mark (without consideration of any external matter), and thus the relative weight and importance of each aspect of similarity having regard to the goods/services should not be considered there. However, the court does not ignore the reality that the relative importance of each aspect of similarity might vary from case to case, and such considerations are properly reserved at the stage when the court evaluates whether there is a likelihood of confusion as that is when the court is called upon to assess the *effect* of the similarity between the marks on the perception of consumers (see *Staywell* at [20], citing *Hai Tong* at [40(b)]).

27 Third, the court assesses the two contesting marks or signs from the lens of the average consumer who would exercise some care and good sense in making purchases, and not that of an unthinking person in a hurry. However, at the same time, this average consumer has “imperfect recollection”. The two contesting marks or signs should not be compared side-by-side or examined in detail for the sake of isolating particular points of difference because “the person who is confused often makes comparison from memory removed in time and space from the marks” (see *Hai Tong* at [62(a)], citing the High Court decision of *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 (“*MediaCorp*”) at [33]).

28 Fourth, the similarity of two contesting marks or signs must normally be assessed by reference to the overall impressions created by the marks or signs, bearing in mind their distinctive and dominant components (see *Staywell* at [26]). As such, the test for marks-similarity is not one of substantial reproduction

such as in copyright law (see the High Court decision of *Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 (“*Polo/Lauren Co*”) at [17]). Further, where a mark lacks a dominant or distinctive component, it should be construed as a “unitary whole rather than just focus on one part of it” (see the High Court decision of *Monster Energy Company v Glamco Co, Ltd* [2021] 3 SLR 319 (“*Monster Energy*”) at [58]). In this respect, it bears reiterating that the assessment of marks-similarity is “mark-for-mark without consideration of any external matter” (see *Staywell* at [20]), and without regard to “any external added matter or circumstances” (see *Hai Tong* at [40(b)]).

Visual similarity

25 First, I consider the issue of distinctiveness. This is relevant as the Court of Appeal in *Staywell* made clear at [25] that “a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it.” As an aside, it was held in *Twitter* at [119(c)] that “acquired technical distinctiveness should not be considered at the marks-similarity inquiry ... (but) at the likelihood of confusion stage of the inquiry to preserve conceptual clarity.” In any case, the Applicant has not relied on acquired distinctiveness under this ground of invalidation.

26 In its written submissions, the Applicant had taken the position that “Next” bears “high technical distinctiveness”. However, at the hearing, upon the late PAR’s query and with reference to its own reply submissions with case law from the UK and EU, where the mark “Next” was held to be inherently distinctive but only to a normal or medium extent, the Applicant’s counsel acknowledged that the Earlier Marks, “Next”, were of a medium level of distinctiveness.

27 I agree that the Earlier Marks are of a medium level of inherent technical distinctiveness visually. The Earlier Marks therefore do not enjoy the

correspondingly high threshold that marks which are highly distinctive technically enjoy before competing marks are considered dissimilar.

28 As for the Registered Marks, visually, they are distinctive as a unified whole, and not only distinctive, selectively, in the first four letters “NEXT-”, incorporated within the invented word “NEXTEVO”.

29 Structurally, the Earlier Marks each comprise a plain word mark. On the other hand, the first of the Registered Marks, TM No. 40202208778V, is a plain

NEXTEVO

word mark , while the second, TM No.

40202208779S, is a composite mark **NEXTEVO**  (“NEXTEVO Composite Mark”), comprising a word element in plain font and a dual leaf device at the last letter, “O”.

30 Observing the word elements of the competing marks, the Earlier Marks comprise one word, “NEXT”, as do the Registered Marks, “NEXTEVO”. However, where these single word elements differ is their length. Each of the Earlier Marks contains four letters in a single word, and each of the Registered Marks contains seven letters in a single word. The Registered Marks are significantly longer than the Earlier Marks.

31 The endings of the Registered Marks are also significantly different from the endings of the Earlier Marks. The letters “-EVO” add to the visual distinction between the competing marks in their looks and length.

32 The Applicant would have me conclude that the marks are visually similar because of the distinctive common element “NEXT” and because the

additional letters “-EVO” in the Registered Marks are not visually significant. It devoted a fair bit of its submissions to the meaning of “-EVO” in support of its contention, but I would save these considerations for the analysis of conceptual similarity to follow.

33 For this part of the assessment of marks-similarity, I would be inclined

NEXTEVO

to find that TM No. 40202208778V, , is not visually similar to the Earlier Marks, “NEXT”. Comparing the marks as wholes, they are clearly distinguishable in their respective length and endings, and ultimately in their visual impression.

NEXTEVO 

34 As for TM No. 40202208779S, , the Court of Appeal has summarised the principles in relation to the visual comparison of composite marks in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 (“*Hai Tong*”) at [62]:

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

(b) The textual component of a composite mark or sign could be the dominant component of the mark or sign in these circumstances:

(i) The two marks or signs in question each contain a similar device.

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

- (iii) The textual component is in itself already widely known.
- (c) The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:
 - (i) The device is significant and large.
 - (ii) The accompanying word(s) are devoid of any distinctive character or are purely descriptive of the device component.
 - (iii) The device component is of a complicated nature.
- (d) The device component is not usually found to be an equally significant, if not the dominant, component of a composite mark or sign where:
 - (i) The device is simple and will not evoke any particular concept for the average consumer.
 - (ii) The device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods.
 - (iii) The device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin.

35 Here, the Proprietor would have me conclude that the dual leaf device in the NEXTEVO Composite Mark visually distinguishes it from the Earlier Marks: “The “” device features a simple, yet dynamic, brush-like swirling loop embellished with two stylised leaves extending from the top right.

Strategically positioned at the end of the NEXTEVO Composite Mark, this contrast between text and a graphic component creates a visual focal point within the NEXTEVO Composite Mark that is instantly noticeable.”⁸ The Applicant, on the other hand, refers to the “” device as “a simple embellishment or stylization to a small part of the letter ‘O’” which is “unlikely sufficient to differentiate the competing marks”.⁹

36 I apply the principles enunciated in *Hai Tong*, and observe that the textual components in the Registered Marks and the NEXTEVO Composite Mark are larger than the device component in the latter. The dual leaf device is relatively simple and more likely to be seen as a decorative feature than an element indicating commercial origin. This is in contrast to the textual components, “NEXT” and “NEXTEVO”, which are of medium distinctiveness (and not purely descriptive of the device component). This is an instance where the device is neither equally significant to the textual component, nor the dominant part of the composite mark.

37 As such, the device in the composite mark does not add to the visual differentiation of the competing marks in a trade mark sense. Nonetheless, as I

NEXTEVO

have found that TM No. 40202208778V, , is not visually similar to the Earlier Marks, “NEXT”, by the same token, I also find

NEXTEVO 

that TM No. 40202208779S, , is not visually similar to the Earlier Marks.

⁸ [27] of the Proprietor’s written submissions.

⁹ [66] of the Applicant’s written submissions.

38 Overall, I find that the Registered Marks are not visually similar to the Earlier Marks.

Aural similarity

39 The parties did not specifically submit on the issue of aural distinctiveness and relied on general submissions on distinctiveness at the start of their marks-similarity enquiry.

40 Aurally, to my mind, the Earlier Marks comprising the one-syllable word “NEXT” are of an average, medium level of inherent technical distinctiveness. They therefore do not enjoy the correspondingly high threshold that highly distinctive marks enjoy before competing marks are considered dissimilar.

41 There are two possible tests for assessing aural similarity according to *Staywell* at [31] to [32]. First, the qualitative approach which considers the dominant and distinctive elements of the competing marks. Second, the quantitative approach which looks at whether the marks have more syllables in common than not.

42 I am also mindful of the case of *Montres Rolex S.A. v Seiko Kabushiki Kaisha (trading as Seiko Corporation)* [2004] SGIPOS 8 at [30] where the hearing officer recognized that:

When a person is faced with an unfamiliar word, there is a tendency for that person to reach within his own vocabulary of words and mentally look for words that have the same structure in the sense that the chronology of the alphabets is the same as the unfamiliar word.

43 Thus, the Proprietor submits that in ordinary English enunciation, where a consonant cluster such as “-xt” appears within a longer word and is

immediately followed by further syllables, speakers tend to adopt a continuous, flowing pronunciation, rather than enforcing a hard stop to preserve a standalone word embedded within the longer expression.¹⁰ By way of example, it points out that “textile” is pronounced “teks-tile” and not “text-ile”; “mixture” is pronounced “mikst-cher” and not “mix-ture”. The differences in pronunciation are nuanced but the thrust of the Proprietor’s argument is that speakers do not pause mid-word to preserve word components (which themselves are complete words) such as “text” and “mix” (within “textile” and “mixture”) in speech. Instead, such words are pronounced in a “single continuous utterance”. By the same token, the Registered Marks would naturally be pronounced “nek-stee-vo”.¹¹

44 Using the qualitative approach, the aurally distinctive and dominant elements of each of the competing marks are the entirety of “NEXT” and “NEXTEVO” themselves, without dissection. The Applicant contends that the distinctive and dominant aural component in the Registered Marks is “NEXT”, being the prefix and first whole word in the marks. The Applicant submits that “-EVO” is descriptive and lacks distinctiveness (there will be more analysis on this under the subsequent comparison of the marks conceptually), and thus “it is more plausible than not that it may be dropped in speech by the average consumers”¹². However, I am more inclined towards the Proprietor’s suggestion of how the Registered Marks would generally be pronounced by the Singapore public as a whole, as described in the preceding paragraph.

¹⁰ [34] of the Proprietor’s written submissions.

¹¹ [35] of the Proprietor’s written submissions.

¹² [75] of the Applicant’s written submissions.

45 Thus, qualitatively, it cannot be said that the competing marks here are aurally similar. Their identical start, “NEXT”, is not the standalone, aurally distinctive and dominant element of the Registered Marks. The aural ending, “stee-vo”, is as important and significant as the beginning, and is not susceptible to slurring.

46 Under the quantitative approach, the Applicant’s main argument is that the assessment cannot be reduced to a mechanical or quantitative exercise involving a mere comparison of the number of syllables. It cited *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 at [27] where the IP Adjudicator cautioned against relying on a simple syllable count when considering “a composite mark comprised of different elements of widely varying degrees of distinctiveness” to avoid the consequence that “a later mark could be differentiated sufficiently from a third party’s distinctive earlier mark incorporated in it merely by adding sufficient matter of a descriptive nature.” Based on this case authority, the Applicant would have me disregard, or at least give less weight to, the allegedly “descriptive” syllables “E-VO” in the Registered Marks when comparing the marks aurally. On the other hand, the Proprietor observes that the Registered Marks comprise three syllables, in contrast to the monosyllabic Earlier Marks.

47 The only syllable in common is the first sound, “Next”; the Registered Marks differ aurally in the last two syllables. Speaking quantitatively and mechanistically, the Registered Marks are only one third aurally similar to the Earlier Marks, which is to say that most of the Registered Marks is aurally dissimilar to the Earlier Marks. I do not generally prefer the quantitative test over the qualitative test when comparing marks aurally, because the relative importance of similar or dissimilar sounds is not factored into the overall weightage in the former test, unlike the latter test which considers the

dominance of the syllables upfront and its impact on consumers. Nonetheless, this simplistic conclusion using the quantitative approach accords with my finding under the qualitative approach, that the competing marks are not aurally similar.

48 As the Earlier Marks have an average, medium level of inherent technical distinctiveness, aurally speaking, there is no high threshold before a competing sign will be considered dissimilar to it aurally. The Registered Marks cross this threshold and are not aurally similar to the Earlier Marks.

Conceptual similarity

49 Conceptually, the Earlier Marks – comprising the sole English dictionary word “Next” – are at an average, medium level of inherent technical distinctiveness. There is no element (such as being an invented word) which propels them into a higher tier of inherent technical distinctiveness.

50 The Court of Appeal in *Staywell* at [35] opined that “the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole”.

51 The Applicant’s argument here hinges on the word “Next” in the Registered Marks carrying the lion’s share of the concept, while the addition of letters “E-V-O” in the Registered Marks is subsidiary and also complementary to the word “Next” in meaning. The Applicant explains that “-EVO” is generally understood as “evolution”, and the concept of the Registered Marks, “Next Evolution”, means that the relevant goods are evolutionary, progressive, developing, advancing or the like. “Next” and “Nextevo” share the concept of “Next”, and “Nextevo” means “evolution of ‘Next’”, an advanced version of “Next”: hence the competing marks are conceptually similar.

52 In support of its claim that “EVO” is a known and established abbreviation for “evolution”, the Applicant referred to an extract dated 8 August 2024 from the online dictionary, www.dictionary.com, filed in evidence¹³:

noun

- 1 (used in product names) evolution:
the EVO 4G smartphone; the Mitsubishi Evo.

Example Sentences

In 2010, the then-president showed off his moves in a friendly international
footie match with Bolivian counterpart Evo Morales.

53 However, what the above dictionary entry shows is “Evo” being used as part of the brand-and-model names of a smartphone and of a car. It does not unequivocally demonstrate that “Evo” means “Evolution”, in an abbreviated form, in standard English language. Even if the extract explained “(used in product names) evolution”, this is reasonably understood exactly as it says, that it has been observed that traders use this verbal component “Evo” in product names. Many marketing and stylistic considerations lie behind the decision on a product name, in order for it to look and sound memorable and attractive. There is still a significant gap between usage of “Evo” as part of product names and usage of “Evo” as an accepted abbreviation of “Evolution” in English conversation and writing. It says a lot that the example sentence in the above dictionary entry uses “Evo”, not to mean “evolution” in an abbreviated form, but as a first name, that of a Bolivian president.

¹³ Exhibit 8 of the ASD.

54 The Proprietor had also given evidence¹⁴ on the derivation of the Registered Marks, extracted below:

The components of the name – “Next” and “Evo” – are easily understood in terms of their etymology and significance. “Evo” refers to “evolution”, reflecting the company’s core vision: transforming agricultural waste, such as pineapple leaves, into high-value materials. This transformation – through processes like fibre extraction, treatment and blending – represents the material’s evolution from agricultural byproduct to usable textile input ... When combined, “NEXTEVO” can be interpreted as “Next Evolution”, signifying the progressive and sustainable development of waste materials into new, functional forms.

55 The Proprietor’s counter-statement¹⁵ states:

... the word “NEXTEVO” is an invented term. The word “NEXTEVO” was coined and derived from a telescoping of the word “NEXT” with the word “evolution”. Its significance lies in projecting the Registered Proprietor as being in the NEXT step in EVOLution of transforming agricultural waste into natural, environmentally friendly materials and products for use in value-added applications.

56 The Applicant submits that the Proprietor’s website had previously provided information to the same effect as above, before the text was subsequently amended after the Applicant filed its amended statement of grounds. It adduced evidence¹⁶ from the Proprietor’s website, pre-amendment, as follows:

About us

We are the **NEXT** step in the **EVOL**ution of transforming agricultural waste into natural, environmentally-friendly materials and products for use in value-added applications.

¹⁴ [15] of the PSD.

¹⁵ [13c] of the Proprietor’s counter-statement.

¹⁶ Exhibit 7 of the ASD.

57 From the above, the Applicant draws the conclusion that the Proprietor itself also emphasizes the words “Next” and “Evo” separately, to the extent that both words are intended to be viewed and read separately.

58 The Proprietor takes a different view. It puts forth the uncontroversial position that “Next” is a common dictionary word in the English language; and where its position differs is that the Registered Marks are invented words with no discernible dictionary meaning. The component “-EVO” is not found in the dictionary, nor is it a standard or universally recognised abbreviation for “evolution” (which the Applicant overstates as being so). The Proprietor points out that there is no support from reputable dictionaries that “-EVO” is short for “evolution”. Rather, if at all, “Evo” could mean “evening” in Australian slang, or “extra virgin olive”, but there is no single, accepted, defined concept at face value. The Applicant’s suggested reading of the Registered Marks as “Next Evolution” is awkward, unlike familiar phrases such as “Next Stage”, “Next Step”. “Nexteveo”, too, is unfamiliar to the public as a word, and is at best a marketing and branding device. The Proprietor concludes, on this point, that the Registered Marks are invented words with no meaning, or at most allusive of its vision explained on its website and in its evidence (as detailed above). Nonetheless, the Registered Marks are conceptually distinct from the Earlier Marks which comprise only the concept of “Next”.

59 At this point, it has become clear that the parties’ argumentation and this inquiry have gone on a scenic romp. The parties have taken much time in the course of the hearing contending whether or not “Evo” has an accepted, standard meaning in the English language. In fact, both parties are in agreement that the Registered Marks were derived from the known English words “Next” and “evolution”. When asked by the late PAR whether it mattered that the component “-EVO” in the Registered Marks alluded to evolution, as this was a

very common way for traders to come up with new, allusive trade marks which are not directly descriptive, counsel for the Applicant responded that adding the idea of “evolution” did not change the concept but rather only reinforced the idea of an evolved version of the Applicant’s “NEXT” brand and products. Regarding the Proprietor’s elaboration on the derivation of its Registered Marks, counsel for the Applicant also submitted that while the Proprietor transforms agricultural waste into environmentally friendly textiles, the public would not be aware of this. Rather, the competing marks share the concept of “Next”, and “Nextevo” just means “an advanced version of ‘Next’”.

60 The question whether “evo” is an accepted abbreviation of “evolution” is a red herring. The real issue is whether the concept of “Nextevo” and the concept of “Next” are similar. There is no dispute that “Nextevo” is formed by the conjoining of “Next”, and “evo”, the latter of which is an allusion to “evolution”. Where the parties disagree is what to make of this. The Applicant canvasses the argument that the concept of “evolution” is subsidiary to, and describes, “Next”, and thus, the distinctive and dominant component of the Registered Marks is “Next”, which is conceptually similar to the Earlier Marks. On the other hand, the Proprietor emphasizes that “Nextevo” is an invented word with no dictionary meaning, and contains, at most, an allusion to transformation by evolution. (The Proprietor need not have been overly chary, at the hearing, of admitting that “-EVO” in its marks was derived from “evolution”, as already stated in its counter-statement and evidence.) Either way, the Proprietor takes the position that the marks are conceptually distinguishable.

61 It is trite that marks are perceived as wholes. Especially in the case of an invented word like “Nextevo”, it would be contrived to first sever it into two parts conceptually where not all verbal components are known English words,

and, second, to then contend that “Next” dominates the concept while “evo” merely reinforces the idea of “Next” as an evolved version. I agree with the Proprietor that “Nextevo” would not be familiar to the public as a word and would be perceived as meaningless. If the public subsequently learns about the vision and work of the Proprietor, it may then come to appreciate the choice behind the mark “Nextevo”, but that is a different thing from answering whether the competing marks are conceptually similar without extraneous, subjective input. Even if part of the public perceives the Registered Marks conceptually as “Next evolution” on the face of things (which is not established), I nonetheless do not agree with the Applicant that the idea of “evolution” does not affect the concept and character of “Next” and is only subsumed under the idea of an evolved version of the Applicant’s “NEXT” brand and products. If indeed “-EVO” is perceived as “evolution”, its impact on the Registered Marks would be significant and would take them much further conceptually from the mere meaning of “Next”.

62 As assessed above, the Earlier Marks have a medium level of conceptual inherent technical distinctiveness and there is no “high threshold” to be crossed before another mark is considered distinguishable from it. After considering the conceptual angles of the competing marks, where the Earlier Marks bear the well-established, universally accepted meaning of the known English word “Next”, and the Registered Marks are invented and meaningless, I find that the Registered Marks are conceptually dissimilar from the Earlier Marks.

Conclusion on marks-similarity

63 Overall, I find that the Registered Marks and the Earlier Marks are not similar, whether visually, aurally or conceptually.

64 This being so, the Applicant’s case has failed at the first step of the 3-step *Staywell* test. The similarity of marks and that of the corresponding goods have been described as “threshold questions” embodying “necessary but not sufficient conditions” under s 8(2)(b) (*Staywell* at [65]). Since the competing marks have not been found similar, the inquiry effectively ends here and the applications for a declaration of invalidity cannot succeed under s 8(2)(b) of the Act.

65 There is therefore no necessity to conduct an analysis of the remaining two steps of the three-step *Staywell* test. I will, however, make a few brief comments below before proceeding to discuss the remaining grounds of invalidation.

Step 2: Goods-similarity

66 As set out at [1] above, the Registered Marks are registered in Classes 23 and 24.

67 Of the Earlier Marks, the most relevant would be T9807605F in Class 24. The specification is:

Textiles; plastic material as a substitute for fabric; bed and table covers; bed linen; table linen; household linen; wall hangings; blankets; quilts; duvets; and duvet covers; sheets; pillow cases; bed valances; bed-covers; table cloths; table mats; napkins; linen fabric; fabric wall coverings; curtains; curtain tie-backs of textile; cushion covers; pelmets; blinds; covers for chairs and sofas; towels and face cloths.

(underline added)

68 The Applicant points out that it has registered its mark in respect of the broad specification item “Textiles” (underlined in the specification above). The Proprietor’s claimed items in its Class 24 specification would fall under this

umbrella term and be identical with or similar to “Textiles”. Examples of the Proprietor’s such claimed items are “Bedroom textile fabrics”, “Fabrics being textile piece goods”, “Sheets [textile]”, “Textiles”, and “Waterproof textile fabrics”.

69 As for the Proprietor’s specification of goods in Class 23, which includes threads and yarns for textile use, while the Applicant does not have a registration under the same class, it submits that the Proprietor’s Class 23 goods are still similar to the Applicant’s goods, such as “textiles”, “bed linen”, “household linen”, “linen fabric”, “curtains”, and “towels and face cloths” claimed in Class 24, among others.

70 The Proprietor accepted that there was some overlap between the respective Class 24 specifications of the competing marks, but none with reference to Class 23. For the goods items which are identical or similar, the declaration of invalidity, if any, should only extend partially to such goods and not to goods which are not similar.

71 As I have not found the competing marks were similar under the first step of the three-step *Staywell* test, my comments here will be brief and merely in passing. The parties’ Class 24 goods overlap to a large degree, perhaps even fully, if the factors in *British Sugar plc v James Robertsons & Sons Ltd* [1996] RPC 281 (“*British Sugar*”) were applied. There is, however, no necessity for me to apply the test and each of its factors to the facts of this case here and now. The Proprietor’s Class 23 goods and the Applicant’s Class 24 goods also overlap with similar goods items from a quick review on the face of the specifications, and a number of the goods items would likely pass the test in *British Sugar* and also be found similar.

Step 3: Likelihood of confusion

72 In relation to the third step of the *Staywell* test, I again only make brief comments on some permissible extraneous factors, and only in *obiter*, seeing as the Applicant has not established marks-similarity as a threshold requirement.

73 For some context, the Court of Appeal in *Staywell* considered permissible and impermissible extraneous factors in [95] and [96]. It set out at [96], a non-exhaustive list of factors which are admissible in the confusion inquiry in the third step of the 3-step test. These include the degree of similarity of the marks themselves, the reputation of the marks, the impression given by the marks, the possibility of imperfect recollection of the marks, the nature of the goods (without implicating any steps that are taken by the trader to differentiate the goods) – which in turn includes the circumstances under which consumers would purchase the goods; the price of the goods given their nature; among other factors.

Degree of similarity of the marks, their impression, and imperfect recollection

74 Earlier on, I have found that the marks were more dissimilar than similar. For the purposes of this exercise, under the third step of the *Staywell* test, even if the marks were found marginally more similar than dissimilar, the degree of similarity would be low enough for this factor to weigh in the Proprietor's favour when considering the likelihood of confusion. This observation is connected to two other factors: the impression given by the marks and the possibility of imperfect recollection.

75 The Earlier Marks comprise a single, four-letter word. It is monosyllabic. In contrast, the Registered Marks comprise a longer, seven-letter word with three syllables. The Earlier Marks comprise a known, and simple,

straightforward, word in the English language. On the other hand, the Registered Marks comprise an invented word with no discernible meaning on the face of things. The holistic impression given by the competing marks is significantly different, and with the possibility of imperfect recollection taken into account, all the more, if it be argued that it may be especially difficult to remember the Registered Marks given that they are an invented word, the Earlier Marks would not even be called to mind as confusingly similar.

Nature of the goods, pricing and circumstances under which they are normally purchased

76 According to the guidance in *Staywell*, at [96(b)], one considers the nature of the goods, including “the normal way in or the circumstances under which” they are purchased and “whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers”. In considering the nature of the goods (without implicating any steps that are taken by the trader to differentiate the goods) – one engages how they are selected and purchased; and takes into account the price of the goods.

77 The closest goods between the competing marks are the textiles and textile-related goods specified in Class 24 (it is recalled that both parties have registered their marks in this class). The Registered Marks are also registered in Class 23 principally in respect of fibres, threads, yarns, which are generally for use in textiles.

78 The Proprietor submits that for textiles (Class 24) and fibres, threads and yarns (Class 23), the relevant public comprises persons in the trade, such as manufacturers, designers, suppliers and trade purchasers. The goods are selected for manufacturing, commercial and professional use, based on specific technical and functional criteria. The procurement process is meticulous and

entails a high degree of attention and care to purchase what is needed from the most suitable source, thus lowering the likelihood of confusion. For example, a purchaser who prioritises the sustainability narrative would be attentive to the brand at hand (such as the Proprietor’s “NEXTEVO”) in the selection and purchase of material. The goods are not fast moving consumer products bought casually by the general public, with a lower degree of fastidiousness.

79 The Applicant, however, submits that the Proprietor’s Class 24 specification includes finished consumer products¹⁷. Such goods include “furniture coverings of textile”, “hand towels of textile”, “household textile piece goods” and “sheets [textile]”. To this, the Proprietor submits that the nature of these goods in fact supports, rather than undermines, a finding of heightened consumer attention. Household textile items such as bedsheets, bedding, towels, and furnishing fabrics are used in close and prolonged contact with the body and within the home. Purchases of such goods are therefore not typically made on impulse but with care and attention.

80 Both parties have made apposite points. The relevant public for the Class 24 goods comprises both specialists in the trade (who select and purchase textiles as manufacturing inputs) and the general public (who select and purchase finished products such as bedsheets, towels and furniture coverings). Both groups are expected to exercise a higher than average degree of care and attention when making such purchases. Trade specialists, purchasing textiles as commercial inputs, would scrutinise factors such as quality, material composition and specifications with considerable care, given the downstream implications for their manufacturing processes. The general public, while less technically informed, would nonetheless approach purchases of finished textile

¹⁷ [13] of the ASDR.

products such as bedsheets and towels with some deliberation, as these are considered goods involving meaningful assessments of quality, material and price rather than impulse purchases.

81 The relevant public in respect of the Class 23 goods, principally fibres, threads and yarns, also includes both trade and professional consumers (such as textile manufacturers and procurement professionals who purchase threads and yarns as inputs for industrial or commercial production) and general public consumers (such as home sewers, crafters, and hobbyists who purchase threads and yarns for everyday sewing and craft purposes). Trade and professional consumers are expected to exercise a higher than average degree of care and attention given the technical and commercial nature of their purchases, while general public consumers are expected to exercise a moderate degree of care and attention. While threads and yarns are not high-value items, they are not entirely impulse purchases either — consumers typically select them with a specific purpose in mind, such as matching a particular colour, fibre type, or weight for a sewing or craft project. This purposive nature of the purchase naturally encourages a degree of deliberation.

82 The Applicant further points out that the Proprietor has collaborated with clothing retailer Bershka on a line of denim jackets and jeans made from pineapple-based yarn¹⁸. Its consumers, therefore, are the purchasers of these finished, end-user products. The Proprietor has also participated in fashion-related trade shows¹⁹. The Applicant contends that this indicates the Proprietor's goods in Classes 23 and 24 are connected to the Applicant's Class 25 clothing goods.

¹⁸ [11] and Exhibit 1 of the ASDR.

¹⁹ [11] and Exhibit HK-03 of the PSD.

83 Here, I am wary of veering off track in this invalidation dispute. The Registered Marks are registered under Class 24 (textiles) and Class 23 (fibres, threads and yarns), not Class 25. The collaboration with Bershka resulted in a new line of clothing which is classified under Class 25. It is not clear that this is a permissible extraneous factor to be taken into account when the challenge is against the Registered Marks *in Classes 23 and 24*. What the Court of Appeal in *Staywell* termed “factors relating to the impact of *goods*-similarity on consumer perception” was directed at the goods in issue, see [95]:

In contrast, extraneous factors that relate to the *purchasing practices* and *degree of care* paid by the consumer when acquiring goods of the sort in question, can be considered and assessed ...

(underline added for emphasis)

84 Consequently, nothing turns on this collaboration.

85 As for the fashion-related trade show, the name of the event was Asia-Pacific Textile and Apparel Supply Chain Expo & Summit (APT EXPO 2024). One can appreciate that this is directed at persons in the trade rather than the general public and general consumers. The Proprietor points out that trade shows are not akin to goods being sold off the shelf in a shopping context; booths will prominently display vendors and their specialized goods. This is consistent with what I observe in the exhibit of the Proprietor’s evidence: story boards recount the history and vision of the company, supplemented by photos of pineapples and pineapple leaf fibres as well as samples of textiles and clothing made from such agricultural waste. It is a typical set up, and the Proprietor’s participation is reasonable. It does not, as the Applicant contends, show that the Proprietor’s claimed goods in Classes 23 and 24 are related to the Applicant’s clothing goods in Class 25 such that likelihood of confusion is increased.

86 Finally, the Applicant also contends that the prices of the goods are not high, unlike prices of cars and houses. The nature of the relevant goods therefore commands a relatively low degree of attention, which increases the likelihood of confusion. For example, one of the Proprietor's invoices showed that the unit cost of "Ready-to-Spin Fibre" was as low as US\$1/kg²⁰. The Proprietor counters that this was simplistic because even low unit costs can entail high transaction value because of bulk buying.

87 I accept the Proprietor's point, and further observe, from a perusal of the exhibited invoices, that most other goods had a higher unit cost, and the transacted quantities were higher. For example, in another invoice, the unit cost of "Dried PALF"²¹ was US\$25/kg, the transacted quantity was 1200kg and the total cost was US\$30,000.00²². In contrast, the invoice cited above by the Applicant involved a "sample only" with "no commercial value". I conclude that the prices of the relevant goods in Classes 23 and 24 are sufficiently high for purchasers to exercise care and attention in their selection and purchase.

Conclusion on likelihood of confusion

88 Thus, for a moment not considering that marks-similarity was not found at the first step of the *Staywell* test, the Applicant would still fail at the third step of the test because there is no reasonable likelihood of confusion.

Conclusion on invalidation under s 23(3)(a)(i) read with s 8(2)(b)

89 The Applicant has not established that the competing marks are more similar than dissimilar. Even if it had, it would not be able to establish a

²⁰ Exhibit HK-02 of the PSD at page 51.

²¹ "PALF" stands for "pineapple leaf fibre", see [6] of the PSD.

²² Exhibit HK-02 of the PSD at page 37.

likelihood of confusion. The ground of invalidation under s 23(3)(a)(i) read with s 8(2)(b) therefore fails.

Ground of invalidation under s 23(3)(a)(iii) read with s 8(4)(b)

90 Section 23(3)(a)(iii) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which

—

...

(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1 July 2004 — the conditions set out in section 8(4) apply; or

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

91 Section 8(4) of the Act reads:

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1 July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark must not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark;

(ii) if the earlier trade mark is well known to the public at large in Singapore —

- (A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
- (B) would take unfair advantage of the distinctive character of the earlier trade mark.

Application of s 8(4) to the facts

92 Sections 8(2)(b), 8(4)(b)(i) and 8(4)(b)(ii) have in common the need for marks-similarity. *Bytedance Ltd v Dol Technology Pte Ltd* [2024] SGIPOS 5 (“*Bytedance*”) at [31] summarises as follows:

(c) However, in all cases, there is a threshold requirement that the Application Mark must be similar to the earlier trade mark relied on by the Opponent (see [28(b)] above): see *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [70]–[71].

93 The condition relating to marks-similarity in s 8(4) is worded as “the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark”.

94 Having found under s 8(2)(b) that the Registered Marks and the Earlier Marks are not similar, I likewise find that “the whole or an essential part of” the Registered Marks is not “identical with or similar to” the Earlier Marks.

Conclusion on invalidation under s 23(3)(a)(iii) read with s 8(4)(b)

95 The requisite element of marks-similarity is not established. The ground of invalidation under s 23(3)(a)(iii) read with s 8(4)(b) therefore fails.

Ground of invalidation under s 23(3)(b) read with s 8(7)(a)

96 Section 23(3)(b) of the Act reads:

(3) The registration of a trade mark may be declared invalid on the ground –

...

(b) that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

97 Section 8(7)(a) of the Act reads:

(7) A trade mark must not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade

...

98 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 summarised, at [28], that:

... the main elements of the tort of passing off are encapsulated in the classical trinity of goodwill, misrepresentation and damage (see for example, *Novelty*²³ at [37] and *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712 (“*Nation Fittings*”) at [148]).

(footnote added)

99 The element of misrepresentation is essential to the tort of passing off.

Application of s 8(7)(a) to the facts

100 Under s 8(2)(b), I have found that the competing marks are not similar. Neither would there be a likelihood of confusion among the relevant consumers. Accordingly, because of these findings, the Applicant would also not establish the element of misrepresentation under s 8(7)(a).

²³ *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216.

Conclusion on invalidation under s 23(3)(b) read with s 8(7)(a)

101 The ground of invalidation under s 23(3)(b) read with s 8(7)(a) necessarily fails.

Ground of invalidation under s 23(1) read with s 7(6)

102 Section 23(1) of the Act reads:

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

103 Section 7(6) of the Act reads:

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

104 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]).

Application of s 7(6) to the facts

105 The Applicant claims to have first used the “NEXT” mark in Singapore in 2012²⁴. The Proprietor was incorporated in 2019²⁵ and filed applications to register the Registered Marks in 2022²⁶. The Applicant submits that, the Earlier Marks having been used earlier in time, and extensively such that they have become well known, the Proprietor ought to have known of the existence of the Earlier Marks worldwide and in Singapore.

106 The Proprietor submits that the Applicant must show something more than knowledge of the earlier “Next” marks to demonstrate how that knowledge

²⁴ [10] of the ASD.

²⁵ [5] of the PSD.

²⁶ [14] of the PSD.

renders the filing of applications to register the “Nextevo” marks a departure from standard commercial practice. It cited *Google LLC v Green Radar (Singapore) Pte Ltd* [2024] SGIPOS 1 at [101] in support:

Mere knowledge of a prior exclusive proprietary right, even if shown to be a well known one, cannot in and of itself mean that registration of a similar mark (if so established at all) was done in bad faith. Something more in the circumstances would need to be shown to demonstrate why such knowledge, if possessed by an ordinary person in those circumstances, would then render the registration of the Application Mark a departure from market practice that falls short of the standards of acceptable commercial behaviour.

107 However, the Applicant adduced no such evidence. Its argument rests on allegations that the choice of the Registered Marks is deceptive and engenders confusion that the Proprietor is the Applicant or is part of the Applicant’s corporate group. In conceiving the “Nextevo” marks, the Proprietor is alleged to ride on the goodwill and reputation attached to the Earlier Marks. These claims have not been established. I have also analysed and compared the competing marks earlier on, concluding that they are more dissimilar than similar. The Registered Marks comprise an invented word. There is also no reasonable likelihood of confusion. The fact that they contain the letters “NEXT-” is incidental because the Registered Marks are perceived as wholes, and are distinctive as a whole. This does not offend the sensibilities of “ordinary persons adopting proper standards”.

108 The Applicant also pointed out that despite the Proprietor’s evidence under oath that it “does not sell finished goods to consumers, nor does it maintain a retail presence”²⁷, the Proprietor had in fact collaborated with fashion brands to develop clothing, which are finished products for consumers²⁸. The

²⁷ [23] of the PSD.

²⁸ [10] to [12] of the ASDR.

Applicant alleges that the Proprietor is attempting to create a false impression that its business focus and its goods are entirely different from the Applicant's. Thus, the Applicant argues, the applications to register the "Nextevo" marks were made in bad faith.

109 As set out in the legislative provision above, s 7(6) is directed at bad faith relating to the filing of applications to register trade marks, and not to other areas such as that described in the immediately preceding paragraph. It is the Proprietor's prerogative to file applications in its classes of choice with the actual specifications. Here, the Proprietor has filed applications in Classes 23 and 24, not Class 25 (to which clothing, as finished goods, belong), to protect its key goods: fibres, threads, yarns, and textiles. I cannot see the bad faith in doing so.

Conclusion on invalidation under s 23(1) read with s 7(6)

110 The Applicant has not discharged its burden of proving that the Proprietor filed applications to register the Registered Marks in bad faith. The ground of invalidation under s 23(1) read with s 7(6) therefore fails.

Overall conclusion

111 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the applications for a declaration of invalidity fail under all grounds. The Registered Marks remain registered.

112 I have considered the parties' submissions on costs and, having regard to all the circumstances, I award the Proprietor the sum of \$14,450 (inclusive of disbursements).

Tan Mei Lin
Principal Assistant Registrar

Millicent Lui (Ghows LLC) for the Proprietor;
Kwok Tat Wai and Kimberly Chen (Marks & Clerk Singapore LLP)
for the Applicant.
