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

[2026] SGIPOS 16

Trade Mark No. 40202532404U

IN THE MATTER OF A TRADE MARK APPLICATION

IN THE NAME OF

REAL MADRID CLUB DE FUTBOL
AND
FUTBOL CLUB BARCELONA

… *Applicants*

AND

AN OPPOSITION BY

LIGA NACIONAL DE FÚTBOL PROFESIONAL

… *Opponent*

GROUNDS OF DECISION

TABLE OF CONTENTS

INTRODUCTION **1**

CHRONOLOGY OF PROCEEDINGS **2**

BACKGROUND OF PARTIES **9**

GROUNDS OF OPPOSITION **10**

ROLE OF REGISTRAR WHERE APPLICANT DOES NOT PARTICIPATE IN THE HEARING **10**

APPLICABLE LAW AND BURDEN OF PROOF **12**

GROUND OF OPPOSITION UNDER S 8(4)(B)(I) OF THE ACT **12**

ELEMENT 1: WHETHER THE OPPONENT'S EL CLÁSICO MARKS ARE WELL KNOWN IN SINGAPORE 13

ELEMENT 2: SIMILARITY OF MARKS 18

ELEMENT 3: CONNECTION 22

ELEMENT 4: LIKELIHOOD OF DAMAGE 23

CONCLUSION ON OPPOSITION UNDER S 8(4)(B)(I) OF THE ACT 24

GROUND OF OPPOSITION UNDER S 8(7)(A) OF THE ACT **24**

GROUND OF OPPOSITION UNDER S 7(6) OF THE ACT **26**

OVERALL CONCLUSION **26**

COSTS **27**

Liga Nacional de Fútbol Profesional
v
Real Madrid Club de Futbol and Futbol Club Barcelona

[2026] SGIPOS 16

Trade Mark No. 40202532404U
Principal Assistant Registrar Mark Lim Fung Chian
17 & 22 September 2026

20 November 2026

Principal Assistant Registrar Mark Lim Fung Chian:

Introduction

1 Earlier this year, Spain beat Argentina 1–0 after extra time to win the FIFA World Cup 2026. In the lead up to the finals, Spain defeated Saudi Arabia, Uruguay, Austria, Portugal, Belgium and France.

2 These opposition proceedings, however, do not set Spain against the rest of the world. Instead, they pit some of the best-known names in Spanish football against each other. On one side is Liga Nacional de Fútbol Profesional (the "Opponent"), which is the governing body for the Spanish football league. On the other are Real Madrid Club de Futbol (the "1st Applicant") and Futbol Club Barcelona (the "2nd Applicant") (together, the "Applicants"). On the pitch, the two clubs are fierce rivals. Here, they are on the same side, against the governing body for the league in which they play. What they are contesting is the name given to their own matches. The Opponent relies on what it says are its well known marks – "El Clásico", "EL CLASICO" and "ELCLASICO" (the "Opponent's El Clásico Marks") – to oppose the Applicants' application to

register 

(the "Application Mark") in Singapore.[1] The Applicants' main answer is that "El Clásico" has become a descriptive term for matches played between the Applicants, and that the Opponent should not be allowed to monopolise this term.[2]

3 In the lead-up to the hearing, for reasons not known to me, the Applicants chose not to defend their application. Their agent stopped acting for them, and they did not file any written submissions.

4 It is not the Registrar's role to develop arguments on behalf of the Applicants. I have considered their case as it stands in their Counter-Statement and evidence. On this basis, I find that the opposition succeeds. That conclusion determines this opposition. However, as explained at [35] and [48] below, because the findings were reached without the benefit of submissions from the Applicants, they should be approached with caution in other proceedings where the same issues may be fully argued.

5 I set out my reasons below.

Chronology of Proceedings

6 On 10 August 2022, the Applicants filed an international application for the Application Mark under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on 27

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1 See paragraphs [4] – [14] of the Notice of Opposition.

2 See paragraphs [7] – [12] of the Counter-Statement.

June 1989, as amended on 3 October 2006 and 12 November 2007 ("Madrid Protocol"). The international application was based on their Spanish Trade Mark Application No. 4170895 (the "Spanish Basic Application") and designated Singapore. It was recorded on the International Register, as International Registration No. 1699811. The corresponding designation in Singapore was accorded Trade Mark No. 40202265674Y:

Trade Mark	
TM No.	40202265674Y (later transformed to 40202532404U; see details below)
Date of International Registration	10 August 2022
Goods and Services	Class 9: Video game cartridges; virtual reality controllers; software for video games; video game accessories, namely, audio visual headsets for playing video games, battery chargers for home video game machines, cartridges for video games [software], earphones for consumer video game apparatus, electrical apparatus for use in testing video games, headsets for playing video games, magnetic media bearing data for video games, magnetic media for storing video games, program discs for video games, video game cartridges, video game cassettes; covers and cases for mobile telephones; video game programs for personal use; computer hardware for virtual reality games; virtual reality glasses; virtual reality headsets; mobile telephones; mobile telephone screen protectors; chargers, including mobile telephone and battery chargers; audio effects apparatus; cables (electric); downloadable ringtones for mobile

	telephones; cases for mobile telephones; covers for mobile telephones; protective films adapted for mobile telephone screens; parts, fittings and accessories for all the aforesaid goods; software platforms for social networks; software applications for social networking via the Internet; downloadable software; e-commerce and e-payment software; computer e-commerce software enabling users to carry out electronic commercial transactions via a computer network; software applications for mobile telephones; downloadable software enabling individuals, groups, companies, and brands to create and maintain an online presence and interact with online communities for marketing purposes; downloadable virtual reality software; downloadable augmented reality software; virtual reality game programs (software); virtual reality software for simulations; augmented reality game software; augmented reality software for simulation; interactive entertainment software; downloadable interactive entertainment software for video games; downloadable image files featuring avatars for use in virtual environments; augmented reality software for use on mobile devices for integrating electronic data in real world environments; virtual reality software for education; virtual reality game programs (software); game software; entertainment software; simulation software [entertainment]; game software; computer software for communications; communication software for connecting computer network users; software for creating and managing social network profiles and user accounts; software for creating, managing and accessing groups within virtual communities; interactive software; interactive software based on artificial intelligence; software for integration of artificial intelligence and machine learning in the field of big data; software relating to artificial intelligence and learning machines; virtual and augmented reality software; virtual reality software; virtual reality software for telecommunications; utility, security and cryptography software; application software for the Web and servers; content management software; instrumentation simulators; downloadable software for use as an electronic wallet; downloadable software for managing cryptocurrency transactions using blockchain

	technology, none of the foregoing relating to banking, insurance or financial matters.
	Class 25: Clothing, footwear and headwear; sportswear; clothing for gymnastics; headbands [clothing]; bath robes; bathing suits; bathing caps; underwear; sports footwear; studs for football boots; caps [headwear]; caps; gloves [clothing]; raincoats; stockings; socks; Ascots; scarves.
	Class 41: Education; training; entertainment services; sporting and cultural activities; photographic reporting; video editing services for events; services for special effects animation for film and video; photographic editing; production of animated films; production of sound and video recordings; production of video tapes; training video production; audio, video and photography production; audio and video editing services; services for the production of entertainment in the form of video; video production services; publishing, editing of reports and writing of texts; Education, entertainment and sporting activities; entertainment agency services; cultural activities; sports training with a coach; sporting activities; sports education; sports services, namely, sports education services, sports training, educational services relating to sports, providing of training and sporting activities, between others, summer camps for children and teenager; electronic publishing; publication services (including electronic publishing services); multimedia publishing; publication of web magazines; publication service for printed matter and publications; virtual reality amusement arcade services; virtual reality game services provided online from a computer network; online interactive entertainment; entertainment services, namely, providing virtual reality games, interactive entertainment, and virtual reality content and experiences; interactive entertainment services; providing online virtual reality entertainment services; organization and conducting of educational conferences; organization of conferences, exhibitions and competitions; organization and conducting of competitions and entertainment events; educational services; organization and conducting of conferences and seminars; publication

	services; supply of electronic publications online, which are not downloadable; providing consultable publications from a global computer network or the Internet; organization of exhibitions and events for cultural or educational purposes; gambling or betting services; educational and instructional services; video game services; providing video games online; ticket reservation services for activities and events for education, entertainment and sports.

7 An international registration under the Madrid Protocol enables an applicant to seek protection of a trade mark in designated contracting states through a single international application based on an application or registration in its office of origin. Both Singapore and Spain are party to the Madrid Protocol. For the first five years from the date of the international registration[3], the international registration remains dependent on that basic application or registration (in this case, the Spanish Basic Application).

8 The Application Mark was advertised for opposition purposes on 12 April 2024.

9 On 6 June 2024, the Opponent filed its Notice of Opposition, relying on the Opponent's El Clásico Marks.

10 On 15 October 2024, the Applicants filed their Counter-Statement setting out their grounds in support of the Application Mark.[4]

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[3] Once the international application is entered in the International Register, it is referred to as an "international registration". Despite its name, an international registration does not of itself confer registered protection in a designated contracting party. In Singapore, it is treated in substance as an application.

[4] The Applicants subsequently filed their Counter-Statement (Amendment No. 1) re-dated 29 October 2024 to reflect the correct class number and specification of goods

11 On 14 May 2025, the Opponent filed a Statutory Declaration of Liliana Pastor Saez, the legal counsel of the Opponent, dated 13 May 2025 in support of the Opposition (the "Opponent's SD").

12 IPOS subsequently received a notification of cancellation that was recorded on the International Register on 15 September 2025. The notification of cancellation informs that on 16 July 2025, the Spanish Basic Application ceased to have effect under Article 6(3) of the Madrid Protocol, following the Opponent's successful challenge to the Spanish Basic Application.[5] As this occurred within the five-year period referred to above, the protection resulting from the international registration correspondingly could no longer be invoked.

13 In such circumstances, Article 9quinquies of the Madrid Protocol permits the holder to preserve the rights of the international registration by "transforming" it into national applications or registrations in the designated contracting states. Provided the prescribed requirements are met, the resulting national application or registration retains the filing date of the international registration and, where applicable, its priority date. Accordingly, on 12 December 2025, the Applicants filed an application with IPOS to transform the international registration under Trade Mark Application No. 40202265674Y into a national application under rule 24 of the Trade Marks (International Registration) Rules. Pursuant to rule 25, the opposition proceedings were accordingly carried over to the transformed application, Trade Mark Application No. 40202532404U.

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for two of the 2nd Applicant's trade marks which are mentioned in the Counter-Statement.

5 See the Opponent's SD at [29].

14 On 15 December 2025, the Applicants filed their evidence in support of the Application Mark, comprising the following:

(a) the Statutory Declaration of Elena Naranjo Oramas, Deputy to the Director of Legal Services of the 1st Applicant, dated 12 December 2025 (the "1st Applicant's SD")[6]; and

(b) the Statutory Declaration of Marc Bruix, Global Director of Partnerships of the 2nd Applicant, dated 11 December 2025 (the "2nd Applicant's SD").

15 On 11 April 2026, the Opponent filed the Statutory Declaration in reply of Angela Flores Horgué, the legal counsel of the Opponent, dated 6 April 2026.

16 On 30 April 2026, a Pre-Hearing Review was conducted, and directions were given to both parties.

17 On 29 June 2026, the opposition was fixed for hearing on 17 September 2026.

18 On 5 August 2026, for reasons unknown to me, the Applicants' agents ceased to act for them. As at the date of these Grounds of Decision, the Applicants have not appointed another agent, and hence remain unrepresented.

19 On 17 August 2026, the Opponent filed its Written Submissions ("OWS") and Bundle of Authorities. The OWS included the Opponent's

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[6] On 13 February 2026, the Applicants filed a Supplementary Statutory Declaration of the same Elena Naranjo Oramas, dated 12 February 2026, to rectify a deficiency in the 1st Applicant's SD.

submissions on costs.

20 On 17 September 2026, the designated hearing date, contrary to the position it had taken during the Pre-Hearing Review, the Opponent elected to be heard "on paper" only, without oral submissions. As a result, the oral hearing was converted to a "paper hearing".

21 On the same day, the Registrar directed the Opponent to file revised submissions on costs since the Opponent did not attend any oral hearing.

22 On 22 September 2026, the Opponent filed its revised submissions on costs.

Background of parties

23 The Opponent is the governing body for the Spanish football league, founded on 26 July 1984. It is responsible for administering the two professional football leagues in Spain, the Primera Division and the Segunda Division.[7]

24 The 1st Applicant is a Spanish professional football club based in Madrid known as Real Madrid, founded in March 1902.[8]

25 The 2nd Applicant is a Spanish professional football club based in Barcelona commonly referred to as Barcelona, Barça, or Barca, founded in 1899.[9]

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7 Opponent's SD at [4]. "Primera Division" and "Segunda Division" are Spanish for "First Division" and "Second Division" respectively.

8 1st Applicant's SD at [4]. "Real" is Spanish for "Royal".

9 2nd Applicant's SD at [4].

26 Both Applicants enjoy widespread international renown and are consistently ranked among the most commercially valuable and widely supported football clubs in the world, with substantial global followings that extend to Singapore.[10]

Grounds of opposition

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

Role of Registrar where Applicant does not participate in the hearing

28 Given that the Applicants did not file written submissions and did not participate in the hearing, which was conducted "on paper", it is appropriate first to address the role of the Registrar in these circumstances before turning to the specific grounds of opposition.

29 Earlier this year, I considered this issue in some detail in *Rockwool A/S (Rockwool International A/S) v Saudi Rock Wool Factory* [2026] SGIPOS 6 ("*Rockwool*"). I briefly summarise my views below.

30 In *Rockwool*, I observed that the general pattern emerging from IPOS decisions over the preceding five years was that an unrepresented applicant who did not appear at the hearing would, in most cases, lose the opposition**.** This is not because the opposition succeeds by default, but is a practical consequence of the adversarial nature of opposition proceedings.

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[10] See 1st Applicant's SD at [4] – [16] and 2nd Applicant's SD at [4] – [15]. This is not disputed by the Opponent (see for example, the Opponent's SD at [20] and [33]).

31 Where an applicant has filed a counter-statement and evidence but subsequently does not file written submissions or appear at the hearing, its application is not, for that reason alone, treated as withdrawn. Under rule 37(4) and 37(5) of the Trade Marks Rules, the Registrar may proceed with the hearing in the applicant's absence, determine or dismiss the proceedings without proceeding with the hearing, or make such other order as the Registrar thinks fit. Under ordinary circumstances, the Registrar will proceed with the hearing notwithstanding the applicant's absence: *Rockwool* at [31] – [33].

32 The applicant's absence does not mean that the opposition necessarily succeeds. The opponent must still establish one of the grounds of opposition on which it relies. In *Monster Energy Company v Health and Happiness (H&H) Hong Kong Limited* [2021] SGIPOS 14, to which I referred in *Rockwool*, the applicant did not participate in the "paper hearing" but the opposition was nevertheless dismissed because the opponent failed on the merits. In that case, the relevant goods or services were so plainly dissimilar that the opposition could be disposed of without any meaningful assistance from the absent applicant.

33 The practical difficulty for an absent applicant is that the Registrar cannot step into the shoes of the applicant to make the case that it has chosen not to advance**.** The Registrar remains an independent and impartial adjudicator whose function is to determine the issues raised by the parties, rather than to formulate or advance arguments on behalf of an absent or unrepresented party: *Rockwool* at [45] – [47]. This is consistent with the approach in the UK as set out in *Adrenaline Trade Mark* BL O/440/99 at [11].

34 It follows that, although the opponent must still establish its case and the applicant's filed evidence remains part of the record to be weighed, where an issue admits of competing arguments or requires the evidence to be tested or balanced, the applicant bears the consequences of its decision not to put forward submissions or appear at the hearing. That consequence does not shift the burden of proof. Rather, the applicant's evidence is weighed as it stands, without the benefit of submissions explaining its significance, reconciling it with the opposing evidence, or challenging the opponent's evidence.

35 Finally, as I cautioned in *Rockwool* at [48], findings reached where one party has not participated fully in the proceedings should be approached with appropriate caution and should not constrain an adjudicator in future cases in which the same issue is fully argued by both sides.

Applicable law and burden of proof

36 The applicable law is the Act. There is no overall onus on the Applicants before the Registrar during examination or in opposition proceedings. The burden of proof in the present case falls on the Opponent. That burden is not displaced by the Applicants' non-participation. The Opponent must establish its grounds on the whole of the evidence before me, including the evidence filed by the Applicants.

Ground of opposition under s 8(4)(b)(i) of the Act

37 Section 8(4) of the Act, so far as relevant, 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;…

38 To succeed under this ground, the Opponent must establish each of the following elements:

(a) the Opponent's El Clásico Marks are well known in Singapore;

(b) the whole or an essential part of the Application Mark is identical with or similar to the Opponent's El Clásico Marks;

(c) use of the Application Mark in relation to the goods or services claimed would indicate a connection between those goods or services and the Opponent; and

(d) such use is likely to damage the interests of the Opponent.

39 The relevant date for the purposes of this ground is the filing date of the Application Mark, namely, 10 August 2022 (the "Relevant Date").

Element 1: Whether the Opponent's El Clásico Marks are well known in Singapore

40 As the Opponent's El Clásico Marks are not registered in Singapore, the Opponent must bring itself within limb (b) of the definition of "well known trade mark" in s 2(1) of the Act, namely, an unregistered trade mark that: (a) is well known in Singapore, and (b) belongs to a person who is a national of, or is

domiciled in or has a real and effective industrial or commercial establishment in, a Convention country. There is no dispute that the Opponent, a Spanish entity, satisfies the latter requirement.

41 Section 2(7) of the Act provides that, in deciding whether a trade mark is well known in Singapore, it is relevant to take into account any matter from which it may be inferred that the mark is well known, including: (a) the degree to which the mark is known to or recognised by any relevant sector of the public in Singapore; (b) the duration, extent and geographical area of any use or promotion of the mark; (c) any registration or application for registration of the mark in any country or territory in which it is used or recognised; (d) any successful enforcement of any right in the mark in any country or territory, and the extent to which the mark was recognised as well known there; and (e) any value associated with the mark. Under s 2(8), a mark that is well known to any relevant sector of the public in Singapore is deemed to be well known in Singapore. Section 2(9) provides that the "relevant sector of the public in Singapore" includes actual and potential consumers in Singapore of the goods or services to which the mark is applied, persons involved in their distribution, and businesses dealing in them.

42 The Opponent submits that the relevant public would comprise members of the general public as well as sports professionals.[11] The Opponent further submits that the evidence, viewed as a whole, establishes that the Opponent's "El Clásico" Marks were well known to the relevant sector of the Singapore public by the Relevant Date. It relies on substantial Singapore-specific evidence. In particular, the Opponent's Singapore viewership figures for

[11] OWS at [53].

matches promoted as "El Clásico" record 27,165 viewers for the 23 December 2017 match, 68,384 for the 28 October 2018 match, 56,361 for the 10 April 2021 match and 60,521 for the 24 October 2021 match, demonstrating substantial local audiences over several years. This exposure was reinforced by sustained Singapore-facing promotion, including: watch parties; the "Taste of El Clásico" campaign conducted with a Singapore restaurant; collaborations with Singapore entities Weston SG and Singtel; campaigns involving local football personalities and influencers; and the establishment of the Opponent's Singapore office in 2017 to expand the Opponent's regional presence. Taken together with the exceptional international profile of matches promoted as "El Clásico", the Opponent submits that these repeated and varied forms of exposure provide a strong basis for concluding that, by the Relevant Date, the Opponent's El Clásico Marks were well known among the relevant sector of the public in Singapore as denoting the celebrated LaLiga fixture between the Applicants.[12]

43 Significantly, the Applicants do not dispute that "El Clásico" is widely known in Singapore. Indeed, their case presupposes that it is. Their position is rather that "El Clásico" is a commonplace and descriptive shorthand, understood in Singapore and internationally, for any match between the Applicants, regardless of the competition in which it is played.[13] On this basis, they say that the expression identifies the contest between the Applicants and is incapable of indicating trade origin in the Opponent, and that the Opponent is

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12 OWS at [53] & [54], and the paragraphs and exhibits in the Opponent's SD referred to in OWS [53(1)-(32)].

13 Counter-Statement at [8] – [10], 1st Applicant's SD at [23] – [32], 2nd Applicant's SD at [22] – [33].

attempting to monopolise a term which merely describes the Applicants' rivalry.[14]

44 The issue under this element is therefore not whether "El Clásico" is recognised by the relevant public in Singapore, since all parties take the position that it plainly is. The issue is what the relevant public recognises it *as*. If "El Clásico" is understood only as a description of any match between the Applicants, it would not function as a trade mark at all, still less as a well known trade mark belonging to the Opponent. If, on the other hand, it is recognised as the name of a particular sporting and commercial property associated with the Opponent, the Opponent's case on this element is made out.

45 A similar question arose in *Rockwool*, where the applicant contended that "rockwool" was the generic name for a type of insulation material, while the opponent maintained that it was its trade mark and proprietary term. As in *Rockwool*, both parties have put forward voluminous evidence in support of their respective positions. Again, as in *Rockwool*, taken separately, each party's evidence is persuasive. To decide whose position to accept, it is necessary to carefully assess and evaluate each piece of evidence and weigh its persuasive value against all the other evidence before me (*Rockwool* at [50]). In this exercise, the critical question is how "El Clásico" is perceived by the relevant sector of the public in Singapore (s 2(7)(a) and s 2(8) of the Act). Evidence of how the term is used or understood elsewhere is relevant, but carries less weight unless it can be shown to reflect, or to have shaped, perception in Singapore.

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14 Counter-Statement at [10] – [12].

46 I have summarised some of the evidence relied on by the Opponent at [42] above. The Applicants' evidence, which I have also considered, seeks to show that "El Clásico" is used, in Singapore and internationally, as a commonplace shorthand for any match between the Applicants. Taken on its own, that evidence is capable of supporting the Applicants' position, and the evidence as a whole therefore admits of competing conclusions. However, almost all of the Applicants' evidence relates to use outside Singapore. Since the question is how "El Clásico" is perceived by the relevant sector of the public in Singapore, its probative value is necessarily limited. Having weighed it against the Opponent's evidence, I am not persuaded that it displaces the Opponent's Singapore-specific evidence of the sustained promotion and commercial exploitation of "El Clásico" summarised at [42] above. As discussed in [33] – [34] of the preceding section, I should not be arguing the Applicants' case on their behalf. Where the evidence admits of competing conclusions, the Applicants must bear the consequences of their decision not to participate in the "paper hearing" through filing written submissions.

47 Accordingly, having weighed the evidence of both parties, I am satisfied that the Opponent has discharged its burden on this issue. I find that the relevant Singapore public recognised "El Clásico" not merely as a description of a contest between the Applicants, but as the name of a commercially organised and promoted sporting property associated with the Opponent.

48 I emphasise that this finding is made on the evidence before me and the Opponent's submissions, without the benefit of any submissions from the Applicants challenging the Opponent's arguments or evidence. It should not preclude a different conclusion in future proceedings where the issue is fully contested.

49 Having regard to the factors in s 2(7) of the Act, I find that the Opponent's El Clásico Marks were well known to the relevant sector of the public in Singapore as at the Relevant Date. By virtue of s 2(8), they are deemed to be well known in Singapore. The Opponent has established this element.

Element 2: Similarity of marks

50 The test for marks-similarity under s 8(4) is the same as that under s 8(2)(b): *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 ("*Rovio*") at [142] – [146].

51 The well-established principles for assessing marks-similarity are set out in *V V Technology Pte Ltd v Twitter, Inc* [2023] 5 SLR 513 at [24] to [28], which I paraphrase and summarise as follows:

(a) First, the distinctiveness of the earlier mark is an integral factor in the marks-similarity inquiry. The greater the technical distinctiveness of the earlier mark, the more compelling the differences must be before the competing mark will be regarded as dissimilar. Highly distinctive marks enjoy stronger protection because they function more strongly as badges of origin.

(b) Second, marks are assessed for visual, aural and conceptual similarity, but these are signposts rather than a mechanical checklist. The ultimate question is whether, viewed as a whole, the marks are similar or dissimilar, assessed mark-for-mark without external circumstances; the relative importance of the different aspects is considered later when assessing likelihood of confusion.

(c) Third, similarity is assessed through the eyes of the average consumer, who exercises some care and good sense but has imperfect recollection. The marks should therefore not be subjected to detailed side-by-side comparison, since consumers typically encounter them at different times and rely on memory.

(d) Fourth, the comparison focuses on the overall impressions created by the marks, while taking account of their distinctive and dominant components. Where there is no dominant or distinctive component, the mark should be considered as a unitary whole, and in all cases the comparison remains mark-for-mark without regard to external matters or circumstances.

52 For ease of reference, the marks to be compared are reproduced below:

Application Mark	**Opponent's El Clásico Marks**
	El Clásico EL CLASICO ELCLASICO

53 The crest on the left-hand side of the Application Mark is the club crest of the 1st Applicant, while the crest on the right-hand side of the Application Mark is the club crest of the 2nd Applicant.

Visual Similarity

54 The Opponent submits that the term "EL CLĀSICO" is clearly the dominant element of the Application Mark.[15] I do not agree. As the Applicants point out, the club crests and the stylised "C" device occupy about two-thirds of the Application Mark.[16] While I accept that relative size is not decisive, I am of the view that this should not be disregarded. In my opinion, from a visual perspective, there is no single component in the Application Mark which is clearly dominant.

55 Notwithstanding, I note that the verbal expression common to each of the Opponent's El Clásico Marks is reproduced in the Application Mark. The Application Mark presents the expression as "EL CLĀSICO". This differs from each variant of the Opponent's El Clásico Marks as follows: (a) it differs from the Opponent's "EL CLASICO" only by the macron over the letter "A"; (b) it differs from the Opponent's "El Clásico" in case and in using a macron rather than an acute accent; and (c) it differs from the Opponent's "ELCLASICO" in spacing and by the macron. In my view, these differences in case, spacing and diacritic are minor. The average consumer, with imperfect recollection, is unlikely to notice or recall them, and they do not affect my analysis. Subject only to these insignificant differences, each of the Opponent's El Clásico Marks is incorporated in full in the Application Mark. Moreover, the words "EL CLĀSICO" are the sole textual component and are positioned in the centre of the Application Mark.

56 I find the marks visually similar to a moderate degree.

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15 OWS at [21].

16 Counter-Statement at [24].

Aural Similarity

57 The only words appearing in the Application Mark are "EL CLĀSICO". I agree with the Opponent that an average Singapore consumer is unlikely to understand the macron placed above the letter "A" in the Application Mark as requiring a different pronunciation from the acute accent placed above the letter "A" in the Opponent's "El Clásico" variant, or from the unaccented "A" in the Opponent's "EL CLASICO" and "ELCLASICO" variants.[17] I am also of the view that the absence of a space in the Opponent's "ELCLASICO" does not affect pronunciation.

58 I find that the Application Mark is aurally identical to each of the Opponent's El Clásico Marks.

Conceptual Similarity

59 The Opponent submits that the marks are conceptually neutral. As Spanish is not widely understood in Singapore, "EL CLĀSICO" would be meaningless to the average consumer in Singapore.[18]

60 Given that the Spanish words are spelled very similarly to their equivalent in English (i.e. "The Classic"), I am not sure if the Opponent is correct. Nevertheless, in the absence of evidence to the contrary and as my finding on conceptual similarity would not affect my overall conclusion on

17 OWS at [33].

18 OWS at [41].

marks similarity,[19] I am prepared to proceed on the basis that the marks are conceptually neutral.

Conclusion on Marks Similarity

61 I have found that the marks are visually moderately similar and aurally identical. I am prepared to accept that the marks are conceptually neutral. Considering the marks as a whole, I find that they are similar to a large extent.

Element 3: Connection

62 As explained in some detail in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [161] – [233], the "connection" requirement is satisfied where there is a likelihood of confusion under s 8(2)(b) of the Act. The relevant inquiry is whether the average consumer would be confused into thinking that the goods or services of the Applicants originate from, or are economically linked to, the Opponent (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [74]).

63 I agree with the Opponent that, at the very least, the average consumer would be confused into thinking that the goods or services of the Applicants are economically linked to the Opponent.[20] In my view, the average consumer, on encountering the Application Mark, is likely to perceive it not as an independently conceived mark, but as a particular event-specific manifestation

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19 In fact, a finding that the average consumer in Singapore would recognise (or at least have some idea) that the Spanish words mean "The Classic" would lead to a conclusion that the marks are conceptually similar to a large extent.

20 OWS at [89] – [93].

of the Opponent's El Clásico Marks. The Application Mark reproduces the expression that makes up each of the Opponent's El Clásico Marks. The only differences are the minor ones in case, spacing and diacritic noted at [55] above, namely the macron over the letter "A" in place of the acute accent in "El Clásico" or the unaccented "A" in "EL CLASICO" and "ELCLASICO", while the additional elements comprise the crests of the Applicants and a stylised "C" device. Although the club crests are distinctive in their own right, in this composite they do not displace the identity conveyed by "El Clásico". Rather, they serve naturally to identify the particular participants in the event to which the "El Clásico" designation relates. The overall impression is therefore consistent with a version of the Opponent's El Clásico Marks adapted for the specific fixture involving the 1st and 2nd Applicants. Against that background, I consider that the average consumer may reasonably understand the Application Mark as an official variant, co-branded version or event-specific extension of the Opponent's El Clásico Marks, rather than as indicating a commercially independent origin.

64 This element is therefore satisfied.

Element 4: Likelihood of damage

65 I accept the Opponent's submission that the use of the Application Mark would be likely to damage the Opponent's interests.[21] Such use is liable to suggest that the Applicants' goods and services are licensed, authorised or otherwise commercially connected with the Opponent, thereby impairing the Opponent's ability to control the commercial exploitation of the Opponent's El Clásico Marks and diminishing their brand value.

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21 OWS at [95].

Conclusion on opposition under s 8(4)(b)(i) of the Act

66 I have found that: (a) the Opponent's El Clásico Marks were well known in Singapore as at the Relevant Date; (b) the whole or an essential part of the Application Mark is similar to the Opponent's El Clásico Marks; (c) use of the Application Mark in relation to the goods and services claimed would indicate a connection with the Opponent; and (d) such use is likely to damage the Opponent's interests. The ground of opposition under s 8(4)(b)(i) therefore succeeds.

Ground of Opposition under s 8(7)(a) of the Act

67 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;
>
> …

68 Under this ground, the Opponent needs to establish three elements: (i) goodwill; (ii) misrepresentation; and (iii) damage: *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 ("*Singsung*") at [28].

69 The first element may be dealt with briefly. As the Court of Appeal explained in *Singsung* (at [34]), goodwill, in the context of passing off, is goodwill in the business as a whole, rather than specifically in its constituent elements, such as the mark, logo or get-up used by the business**.**

70 In the present case, I have no difficulty in finding that the Opponent has goodwill in its business in Singapore. The evidence of the long and extensive use of the Opponent's El Clásico Marks in Singapore, briefly summarised at [42] above, demonstrates that the Opponent has conducted business and attracted custom in Singapore.

71 The next element is misrepresentation. As explained in *Rovio* at [191] – [194], the inquiry into misrepresentation for the purposes of passing off under s 8(7)(a) of the Act substantially overlaps with the inquiry into likelihood of confusion under s 8(4)(b)(i). For the reasons given at [62] – [64] above, I have found that there is a likelihood of confusion. Those findings are sufficient in the present case to establish that use of the Application Mark would amount to a misrepresentation for the purposes of passing off.

72 It remains to consider damage. As explained in *Amanresorts* at [234], the likelihood of damage to the proprietor's interests under s 55(3)(a) is "substantively the same" as the requirement of damage under the law of passing off.[22] For the reasons discussed at [65] above, I am satisfied that the Opponent's goodwill is likely to suffer damage as a result of the misrepresentation. This element is therefore also established.

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22 The Court of Appeal's qualification in the same paragraph does not apply here. The Court of Appeal noted that, under s 55(3)(a), misrepresentation and damage concern the proprietor's *interests* rather than its *goodwill*. A mark may therefore be well known in Singapore even if its proprietor has no goodwill here. That distinction matters only where interests exist without goodwill. Here, the Opponent has goodwill in Singapore (see [70] above), and the damage identified at [65] above affects that goodwill as well as the Opponent's interests. My findings on damage under s 8(4)(b)(i) therefore also satisfy s 8(7)(a).

73 As the Opponent has established goodwill, misrepresentation and damage, the opposition under s 8(7)(a) succeeds.

Ground of Opposition under s 7(6) of the Act

74 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.

75 An allegation of bad faith is a serious one. It should not be made unless it can be fully and properly pleaded and sufficiently supported by evidence, and it must be distinctly proved: *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 at [30].

76 I have already found that the opposition succeeds on the other grounds considered above. Further, the Applicants did not file written submissions and were not represented at the hearing, which was conducted "on paper". In these circumstances, it is neither necessary nor appropriate for me to determine the allegation of bad faith. I therefore make no finding on the ground of opposition under s 7(6).

Overall conclusion

77 Having considered all the pleadings and evidence filed, the OWS and the Opponent's Bundle of Authorities, I allow the opposition under ss 8(4)(b)(i) and 8(7)(a) of the Act.

Costs

78 As noted at [20] above, the Opponent had initially opted to proceed with an oral hearing, but on the designated hearing date informed IPOS that it would be proceeding based on its written submissions only.

79 Since the Opponent's submissions on costs[23] were premised on there being an oral hearing, IPOS accordingly directed the Opponent to furnish its revised submissions on costs.[24] The Opponent did so on 22 September 2026.[25] Among other things, the Opponent removed its claim of costs for "Attendance at Hearing", though it maintained its claim of costs for "Preparing for hearing" on the basis that it had prepared written submissions and authorities, and had already made preparations for an oral hearing. However, the Opponent inadvertently omitted to remove its filing fees for attendance at the hearing, which it had not in fact incurred.

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23 OWS at [165] – [166].

24 IPOS letter to Opponent dated 17 September 2026.

25 Opponent's letter to IPOS dated 22 September 2026.

80 All things considered, taking into account the Opponent's submissions on costs, the Scale of Costs in the Fourth Schedule of the Trade Marks Rules and the guidance set out in IPOS HMD Circular 6.1, I award the Opponent the sum of $10,500 (inclusive of disbursements).

Mark Lim Fung Chian
Principal Assistant Registrar

Teresa O'Connor and Millicent Lui (Ghows LLC) for the Opponent;
The Applicants were not represented.