

A Whovian trade mark tussle through time

Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd [2023] SGHC

What amounts to use of a trade mark? In *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC, Justice Dedar Singh Gill examined this question, specifically considering when a sign is used in a trade mark sense, how consumers would perceive domain names and meta-titles, and how that all ties in to trademark infringement.

Background

This case centred around a trade mark infringement claim between two parties previously in a commercial partnership. The first plaintiff, Dr. Who Waterworks Pte Ltd., is a Singaporean company that successfully registered the mark in 2004 under Class 32 for goods and Class 39 for services in Singapore. The first plaintiff was jointly operated by Mr Koh Tiong Gee, his wife, Ms Tan Kim Peng (together, “**the Kohs**”), and Mr Benji Ng Ser Kwei.

The first defendant, Dr. Who (M) Sdn Bhd, is a Malaysian company and the shareholders of the first defendant are Mr Oo Tim Wee and Mdm Low Siew Eng (together, “**the Oos**”), who are the second and third defendant respectively. Subsequently, the DR. WHO quatrefoil device mark, **DR.WHO**[®] was developed in 2012.

Due to the deterioration in commercial partnership, the Kohs and the Oos ultimately agreed to divide the shareholding, directorships and intellectual property between themselves. The Kohs would be entitled to own and use the mark “DR.WHO” in Singapore, and the same for the Oos in Malaysia.

In 2019, the second and third defendants incorporated Dr. Who (S) Pte Ltd in Singapore, the fourth defendant.

Acting on information from one of the Dr. Who Group’s customers, the first plaintiff engaged private investigators to conduct surveillance on the first defendant’s activities in Singapore. The plaintiffs subsequently commenced an action against the defendants on 3 July 2020, asserting that the defendants were liable for, amongst other claims, trade mark infringement and passing off.

Whether the Defendants infringed the plaintiff’s registered trade marks

Section 27(2) of the Trade Marks Act (the “**Act**”) provides that an act would amount to infringement of a registered trade mark if there is: (i) use of an infringing sign within Singapore’s territory; (ii) in the course of trade; (iii) in a trade mark sense; (iv) without the consent of the proprietor; (v) a sign which is identical or similar to the registered mark; (vi) in relation to goods or services identical or similar to those for which the mark is registered; and (vii) a likelihood of confusion on the part of the public.



The plaintiffs relied on five instances of alleged trade mark infringement:

- 1) Use of the DR. WHO quatrefoil device sign on commercial vehicles and the polo shirt of the driver and the use of the “www.drwho.com.my” sign and the “www.drwho.com” sign on the vehicles
- 2) The use of the “www.drwho.asia” sign on the cartons displayed for sale at IKEA Alexandra and IKEA Tampines stores.
- 3) The use of the DR. WHO quatrefoil device sign, the copyright notice “© DR. WHO (S) PTE LTD” (“**the Copyright Notice**”), the meta-title “DR. WHO (M) SDN. BHD.” on the “www.drwho.com.my” website 122 and the meta-title “DR. WHO (S) PTE LTD” on the “www.drwho.asia” website
- 4) The use of the DR. WHO quatrefoil device sign and the “Dr Who Malaysia” sign on the DR. WHO (M) Facebook page; and
- 5) The use of the corporate name “DR. WHO (S) Pte Ltd” by the fourth defendant.

Use of the sign in the trade mark sense

The Court made the following observations in relation to the use of a sign in the trade mark sense:

- Evidence of the use of a sign outside of Singapore does not amount to an infringement under the Trade Marks Act (“**TMA**”)
- Use of signs in an incomprehensible manner or in a manner not visible to the members of the public does not amount to use in the trade mark sense the sign used on the polo shirt was placed on the back of Driver A’s Attire and would not be visible to members of the public viewing Vehicle A while the truck was moving on the road
- A copyright notice “©” does not constitute use of the sign in a trade mark sense as it does not denote the trade origin of any goods. It simply declares that ownership over the copyright in the websites’ content belongs to the entity indicated.
- While the use of a company name solely to identify a company is not use of a sign in the trade mark sense, the fourth defendant’s name was used in relation to the cartons of water offered to IKEA and this amounted to use in the trade mark sense. The use of the corporate name in the contract would also have constituted the sale of goods under the sign “DR. WHO (S) PTE LTD” pursuant to s 27(4)(b) of the TMA.
- Evidence of the existence of the websites featuring allegedly infringing signs or mere access of the websites by consumers in Singapore will be insufficient to show that consumers in Singapore have been targeted by the websites. However, direct encouragement or advertisement would constitute “use” of the sign in a trade mark sense.
 - Despite the top-level domain (“**TLD**”) of “.my” which may indicate that the websites targeted Malaysian consumers, the content of the home pages of websites made reference to clientele in Singapore as it explicitly stated that the Defendant was “providing OEM solutions for clientele around Malaysia and Singapore”.
 - The TLD of “.asia” would also suggests that the defendants operated in both Singapore and Malaysia and would be willing to provide their goods and services to Singaporean consumers.
 - Unlike the “www.drwho.asia” website and the “www.drwho.com.my” website, there was no evidence that the DR. WHO (M) Facebook page targeted consumers in Singapore as only references to Malaysia were made. Similarly, there was no evidence that consumers in Singapore were being directed to this Facebook page. As such, the use of signs on the DR. WHO (M) Facebook page did not amount to infringement.

- Meta-titles serve as the titles of websites and are displayed on the Internet browser's "tab". As they denote the trade origin of the goods or services provided by the website, this amounts to use in the trade mark sense.
 - The customers would have also seen the DR. WHO quatrefoil device sign headlining the home page when accessing the websites. Together, the DR. WHO quatrefoil device sign and the meta-titles would have been understood by the consumer as indicating the source of the goods offered on those websites, and thus constitutes use of the signs in a trade mark sense.

Identity/Similarity of the signs used

1) **DR. WHO** against www.drwho.com.my and www.drwho.asia

How the average consumer perceives a website address depends on the TLD and second-level domain ("SLD"). Here, the dominant component of the "www.drwho.com.my" sign is its SLD, "drwho". The SLD identifies the "specific and unique administrative owner" associated with the address. Here, the Court found that the SLD is visually similar to the DR. WHO goods mark.

In terms of aural similarity, the SLD is aurally identical to the DR. WHO goods mark. While the TLD does add an aural component, it was not a significant difference and thus the sign is aurally similar to the DR.WHO goods mark. On conceptual similarity, the SLD and the DR.WHO goods mark share the conceptual feature of the prefix "DR" which evokes the concepts of medical doctors or healthcare and thus are conceptually similar.

2) **DR. WHO** against **DR.WHO[®]**

The Court found that "DR.WHO" is a purely inventive term and thus distinctive. While there were slight differences in terms of font as well as the presence of the quatrefoil-droplet device, such differences did not prevent a finding of similarity given that the dominant components of both the registered mark and the sign comprised of the term "DR.WHO" in block letters. As such, the DR. WHO quatrefoil device sign and the DR. WHO goods mark are similar.

3) **DR. WHO** against the meta-titles "DR. WHO (M) SDN. BHD." and "DR. WHO (S) PTE LTD"

The dominant component of the sign ("DR. WHO") is aurally and conceptually identical to the DR. WHO goods mark. As such, the presence of "(S) PTE LTD" and "(M) SDN. BHD." did not detract from a finding of similarity.

Identity/Similarity of the goods

The goods reflected on the website were identical to the goods for which the DR. WHO goods mark is registered in Class 32. As the average consumer would have been exposed to some degree of transit advertising, they would understand that the placement of a website alongside a sign directs consumers to access the website in order to gain information on the goods offered under the sign.

Likelihood of confusion

Given the similarity of the sign and the mark and the identity of the goods, the Court found that a substantial portion of the relevant public would have confused the plaintiff with the defendants and/or believed that they were related entities.

The fact that the home page of the “www.drwho.com.my” website also indicates that the defendants’ entity serves clientele in both Singapore and Malaysia would also lead to the relevant public being under the impression that the goods originate from the Malaysian branch instead of the Singaporean branch.

While the Court did acknowledge that traders are likely to pay a higher degree of attention and care towards their purchasers as compared to the potential end users of the goods, this did not affect the outcome in this case, as the average consumer would not likely be familiar with the full corporate name of the company, much less be aware of whether that company is the registered proprietor of the trade mark in Singapore.

Key Takeaways

Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd [2023] SGHC is one of the few cases in Singapore, where the Court had comprehensively canvassed the plaintiff’s claims against every single element pursuant to section 27(2) of the Act. The Court examined how the average consumer would perceive the various parts of a website address and whether meta-titles amount to use of a sign in a trade mark sense.

In brief, while copyright notices do not denote the trade origin of any goods as they simply declare that ownership over the copyright in the websites’ content belongs to the indicated entity, meta-titles may be an infringement risk as the meta-title would be displayed to and viewed by the consumers accessing the websites, indicating the source of the goods offered on the website.

Additionally, how consumers perceive website URLs depend on the TLD and SLD. The SLD identifies the “specific and unique administrative owner” associated with the address and is thus likely to be the dominant component of the website URL. The Court also noted that differences arising due to the functionality of the website address are insufficient to render a sign comprising a website address dissimilar to a registered mark if the SLD is similar to the mark.

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