Trade mark infringement in the age of internet advertising
East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd
[2025] 1 SLR 914; [2025] SGCA 28

I. Executive Summary

East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd [2025] SGCA 28 clarifies Singapore's approach to trade mark infringement, particularly in the context of internet advertising.

This dispute arose when Family Podiatry Centre Pte Ltd ("Family Podiatry") used Google's advertising services ("Google Ads") to display internet advertisements featuring the words "east coast podiatry", "Podiatry East Coast" and/or "Podiatrist East Coast" (collectively, the "Signs").

East Coast Podiatry Centre Pte Ltd ("East Coast Podiatry"), a competing business and proprietor of the composite mark 

(the "Mark"), alleged that Family Podiatry's use of the Signs amounted to trade mark infringement under sections 27(1) and/or 27(2)(*b*) of the Trade Marks Act 1998 (2020 Rev Ed) ("TMA").

The General Division of the High Court ("HC") rejected East Coast Podiatry's claims. While the HC assumed that the threshold test of trade mark use (i.e., that the alleged use of the Signs denoted the trade origin of the relevant goods or services) had been met, it held that the Signs were not identical to the Mark, and therefore section 27(1) of the TMA did not apply. Further, even if the Signs and the Mark were considered similar, there was no likelihood of confusion, as required under section 27(2)(*b*) of the TMA. In interpreting sections 27(1) and (2)(*b*) of the TMA, the HC applied *Google France SARL and another v Louis Vuitton Malletier SA and other cases* [2010] IP & T 992 ("*Google France*") from the Court of Justice of the European Union ("CJEU").

On appeal to the Court of Appeal ("CA"), East Coast Podiatry sought only to challenge the HC's decision on its claim for trade mark infringement under section 27(2)(*b*) of the TMA. The CA dismissed the appeal. However, the CA held that the threshold test of "trade mark use" had not been satisfied in the first place, as Family Podiatry did not use the Signs as a badge of origin. Instead, its use of the Signs was purely descriptive in nature. Additionally, the CA rejected the use of *Google France* in Singapore's context.

II. Material Facts

Both parties were in the business of providing podiatry services. East Coast Podiatry operated four podiatry centres across Singapore, in the Kembangan, Orchard, Novena and Bukit Timah areas, and was the registered proprietor of the Mark. Family Podiatry operated two podiatry centres in Singapore, located in the Bukit Timah and Joo Chiat areas.

Between April 2022 and July 2022, East Coast Podiatry discovered on three separate occasions that Family Podiatry had used the Signs in internet advertisements that Family Podiatry had created using Google Ads.

These advertisements essentially advertised Family Podiatry's services in a few words with a hyperlink, such that when an internet user clicked on the advertisement, he or she would be

redirected to the "home page" of Family Podiatry's website, which contained no reference to the Mark, the words "east coast podiatry", or any of its variants.
The director of Family Podiatry Mr Mark Reyneker ("Mr Reyneker") stated that he had included the Signs in the advertisements as part of Family Podiatry's campaign to advertise the impending opening of its newest branch office in Joo Chiat. He had been advised by a Google consultant to use location-based keywords to improve the likelihood of Google search users finding Family Podiatry's new branch office in their Google search results.

East Coast Podiatry subsequently sued Family Podiatry for trade mark infringement pursuant to sections 27(1) and/or 27(2)(*b*) of the TMA, as well as damages for the tort of passing off. After the HC dismissed both claims, East Coast Podiatry appealed to the CA in respect of decision on trade mark infringement under section 27(2)(*b*) of the TMA.

III. Issues on Appeal

For the use of a sign to constitute infringement under section 27 of the TMA, a claimant must first satisfy the threshold requirement of "trade mark use": that the use complained denotes the trade origins of the goods or services in question (rather than descriptive or decorative use). If so, the next question hinges in part on whether the alleged offending sign is identical or similar to the registered mark under sections 27(1) or 27(2)(*b*) of the TMA, respectively.

Specifically, section 27(1) of the TMA requires the following:

(a) the alleged offending sign must be identical to the registered mark; and
(b) both the sign and the mark must be used in relation to identical goods or services.

Section 27(2)(*b*) of the TMA requires the following:

(a) the alleged offending sign must be similar to the registered mark;
(b) both the sign and the mark must be used in relation to similar goods or services; and
(c) there must be a likelihood of confusion on the part of the public.

The central issue on appeal was whether the HC erred in dismissing the claim for trade mark infringement under section 27(2)(*b*) of the TMA. East Coast Podiatry's primary argument was that the HC erred in considering Family Podiatry's website in assessing the likelihood of confusion under section 27(2)(*b*) of the TMA (the "Confusion Inquiry").

However, to determine this matter, the CA first discussed the following:

A. Whether the threshold requirement of "trade mark use" remained good law in Singapore, including in the context of internet advertisements; and
B. Whether Family Podiatry's use of the Signs indeed amounted to such trade mark use.

The CA held that East Coast Podiatry failed to satisfy the threshold requirement of trade mark use, i.e. that Family Podiatry had used the Signs in a trade mark sense. The claim thus failed.

Nonetheless, the CA also considered the following:

C. Whether the Mark and Signs were similar within the meaning of section 27(2)(*b*) of the TMA; and
D. Whether it was permissible to consider Family Podiatry's website in the Confusion Inquiry.

A. Whether the threshold requirement of "trade mark use" remained good law in Singapore, including in the context of internet advertisements

To satisfy the threshold requirement of "trade mark use", the claimant must show that the alleged use denotes the trade origins of the relevant goods or services, as opposed to non-origin related uses such as descriptive or decorative use. "Use" requires the establishment of a link between the signs and the goods or services concerned to identify the trade origin of the goods or services.

The CA noted that as part of its decision, the HC had relied on principles derived from English and European case law (including *Google France*), which affected its conclusions on the Confusion Inquiry. However, the CA considered that there was a material difference between Singapore's approach to this issue, and that of the English and CJEU courts. As such, the CA disagreed with the HC's approach, although that did not affect the outcome of the case.

The TMA is modelled after the Trade Marks Act 1994 (c 26) (UK) ("UK TMA"), which in turn implements the European Community's First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (the "Directive"). The CJEU favours a broader "effect-centric" approach based on "whether the infringing use was liable to affect the functions of the registered trade mark", in particular its essential function of guaranteeing to consumers the origin of the goods. Its focus is on the "ultimate impact on the proprietor's interests in the registered mark" rather than whether the use was "descriptive use" or "trade mark use" from the perspective of the alleged infringer.

The CJEU applied this broader approach in *Google France*, which considered the issue of infringement in the context of internet keyword advertising. Specifically, *Google France* held that the function of indicating the mark's origin is adversely affected if the advertisement does not enable (or enables only with difficulty) normally informed and reasonably attentive internet users to ascertain whether the goods or services referred to by the advertisement originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party.

In deciding this case, the HC had considered the *Google France* test to be useful regarding section 27(1) of the TMA, because that would prevent section 27(1) from being applied in a mechanical manner once identity of marks and goods or services was established by looking at the underlying function of a trade mark as a badge of origin. The HC also considered the *Google France* test to be equally applicable to section 27(2) of the TMA, to determine the likelihood of confusion in the sphere of internet keyword advertising.

However, the CA noted that Singapore had already decided on a narrower approach: that the infringing use had to be "use as a trade mark" and as a "badge of origin". This was also consistent with the fundamental purpose of Singapore's trade mark law, which concerns itself primarily with protecting trade mark proprietors from the use of identical or similar marks by third parties for the purpose of distinguishing their goods and services. Thus, the focus at this threshold stage should be on the *nature* of the defendant's use of the signs, rather than the *effect* of such use on the claimant's registered mark. This approach was well entrenched in Singapore, and would apply as a threshold inquiry when assessing various forms of allegedly infringing use, including (as here) use in advertising, and on websites which offered goods or services for sale.

In this regard, the CA stressed that the *Google France* test was not developed in the context of the threshold test of trade mark use or under the Confusion Inquiry. Rather, it was intended as a *new test* in the context of keyword advertising cases, to determine whether the use complained

of "has adversely affected, or is liable to adversely affect, the origin function of a trade mark". Thus, reliance on the *Google France* test presupposed an acceptance of the broader approach to the threshold issue, which Singapore had already eschewed.

The CA declined to depart from Singapore's settled approach, despite unique challenges arising from the use of internet advertisements. The effect-centric approach, especially as formulated in *Google France* in the context of internet keyword advertising, contained a significant degree of overlap with the analysis conducted under the Confusion Inquiry. For instance, while the *Google France* test was concerned with whether the normally informed and reasonably observant internet user was able to ascertain the origin of the goods or services referred to in the advertisement, this appeared to be another way of asking whether the relevant public was likely to be confused as to the origin of the goods or services in question. As such, there was some force in the claim that for trade mark infringement claims made under section 27(1) of the TMA, the *Google France* test introduced some version of a requirement for a likelihood of confusion.

Nonetheless, the CA held that such an approach was inconsistent with the TMA statutory framework. Section 27(1) of the TMA deals with the situation where a trader uses a sign identical to the proprietor's mark on goods or services that are identical to the proprietor's goods or services. But there is no requirement to prove a likelihood of confusion there; indeed, a likelihood of confusion is presumed.

Further, the effect-centric approach could unintentionally widen the scope of infringing uses to include purely decorative or descriptive use, even though the sign was not used as a badge of origin. Such acts would appear to fall within the realm of fair competition, and the courts do not proscribe such conduct.

Though there are risks associated with internet keyword advertising, the CA considered that such risks could be adequately addressed by a robust application of the threshold test, involving at least the following three considerations.

- First, in assessing whether a sign was used as a badge of origin, the court will consider the objective circumstances surrounding its use. This includes how the advertisement is presented to the consumers, the prominence and purpose of the signs, and whether other signs are used. The CA noted that keyword use cases can amount to infringement even if the resulting advertisement does not display the impugned signs. Further, the defendant's intentions may also be a relevant, but not necessarily decisive, factor.
- Second, the inherent distinctiveness of the defendant's sign would also play a significant role in determining whether the sign (putatively identical or similar to the claimant's mark) was used as a badge of origin. Greater latitude must be afforded to a defendant who uses words or ideas of a generic nature, even if these have some similarity to what is found in the registered mark: the reality is that internet users would typically employ a wide range of generic search terms when conducting an internet search. In contradistinction to "trade mark use", an advertiser who uses as a keyword words or phrases of a generic nature would be more likely to be found to have used those terms in a descriptive sense rather than as a badge of origin, and this might be so regardless of whether the use pertained to keyword use or advertisement text use.
- Third, in assessing whether there was trade mark use, it is permissible for the court to consider the content of the website to which an internet user is redirected to, upon clicking on the defendant's advertisement. This is particularly when what is at issue are words or concepts that are of a generic nature (and thus where it may be vague on the

face of the advertisement as to whether the defendant had used the signs as a badge of origin). Under our caselaw, the court is entitled to look at the wider context of the allegedly infringing use to determine if there was trade mark use, for example, by considering how the sign is situated within the packaging of the products offered for sale. With regard to internet advertisements, the website forms part of the context of the advertisement as a whole, given that internet advertisements are *interactive* in nature, and are intended to entice users to click on them to be redirected to the advertiser's website.

B. Whether Family Podiatry's use of the Signs constituted trade mark use

The CA held that Family Podiatry's use of the Signs did not constitute trade mark use (i.e., as a badge of origin).

First, the CA held that Family Podiatry's use of the Signs was clearly descriptive in nature. The term "east coast" refers to a geographical area, and in Singapore, it commonly refers to a district or area that includes Joo Chiat Road. When used in conjunction with the terms "podiatry" or "podiatrist", the resulting phrase would be descriptive of podiatry services offered in the east coast region of Singapore. The CA also accepted Mr Reyneker's evidence that the Signs were reflected in Family Podiatry's Google Ads as part of its campaign to advertise the impending opening of its Joo Chiat branch, and further that this was done so after a consultant from Google advised him to use "location-based keywords". This was consistent with the evidence that Family Podiatry intended to and did in fact open a new branch in the east coast region of Singapore shortly after its advertising campaign.

Second, when Family Podiatry's Google Ads and website were viewed in context, they did not appear to suggest that Family Podiatry was seeking to portray its services as originating from an entity known as or related to "East Coast Podiatry". Instead, it was clear from the URL as well as the placement of Family Podiatry's own branding on the website that it was offering its services under its own name.

Lastly, that there was no credible evidence to suggest (as East Coast Podiatry alleged) that the Signs were used with the specific intention of confusing prospective clients who might have been looking for East Coast Podiatry's services.

C. Whether the Mark and Signs were similar under section 27(2)(b) of the TMA

The CA also held that the Mark was dissimilar to the Signs under section 27(2)(*b*). The CA reiterated that the similarity of two competing marks is considered by looking at the two signs as a whole, having regard to their visual, aural and conceptual similarities. Crucially, the distinctiveness of a mark plays an integral role in the marks-similarity inquiry. A mark can be inherently distinctive because it consists entirely of inventive words without any meaning or is used in a way that is completely arbitrary in relation to the goods and services in question. A mark which has greater inherent distinctiveness will enjoy a high threshold before a competing sign will be considered dissimilar to it; however, greater latitude is afforded to a defendant in using words or ideas of a generic nature, even if these have some similarity to what is found in the registered mark.

Ultimately, the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole, bearing in mind its distinctive and dominant components. Where composite marks are concerned, the overall impression conveyed to the public may, in certain circumstances, be dominated by one or more of its components.

Here, the Mark is a composite mark comprising a small white cross over a green square background (the "Device"), and the words "East Coast Podiatry" in block letters. The CA held that, individually, each component lacked inherent distinctiveness. The words were descriptive of podiatry services offered in a region near an eastern coastline, whereas the Device (a simple green cross) was a simple and commonly used symbol in the healthcare industry. Without the Device, the words were not capable of functioning as a badge of origin (and vice versa). Therefore, the marks-similarity inquiry must be made with reference to the composite mark.

On this basis, the CA held that the Mark and the Signs were clearly dissimilar. The Signs did not contain a crucial element of what made the mark distinctive, namely the Device.

D. Whether it was permissible to consider Family Podiatry's website in assessing the likelihood of confusion under section 27(2)(b) of the TMA

Though the CA concluded that trade mark infringement was not made out, it nonetheless expressed its preliminary views on whether it would be permissible to consider Family Podiatry's website in assessing the likelihood of confusion under section 27(2)(*b*).

Generally, extraneous factors may only be considered to the extent that they inform the court as to how the similarity of the marks and goods will likely affect the consumer's perception as to the source or origin of the goods. These would include factors that a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of marks and goods has on the consumer. On the other hand, differences which are created by a trader's differentiating steps (i.e. factors which are not inherent in the goods but are susceptible to changes that can be made by a trader from time to time) may not be considered.

In the context of internet advertisements, the CA recognised that where the court has already found similarity under section 27(2)(*b*), such that having regard to the characteristics of the likely consumer, there would be a likelihood of confusion, then it would not be permissible to have regard to further extraneous considerations that might have the effect of diminishing the likelihood of confusion. Otherwise, an advertiser would be able to use signs in internet advertisements that are very similar to a registered mark, for the purposes of advertising similar if not identical goods, and yet avoid liability through an express disclaimer, or by using cheaper materials and selling his goods at a lower price and saying that because of these steps, there is no likelihood of confusion. The basic consideration relates to the abstract risk of confusing the two identifying marks.

However, the CA qualified its observation by noting that, in infringement proceedings, it would be permissible to consider the actual circumstances in which the purportedly infringing signs were used. In the case of alleged infringement through use in internet advertising, it is potentially relevant to take into account the interactive nature of internet advertisements, and the fact that the purpose of internet advertisements is generally to entice users to click into the relevant website, in so far as it relates to the impact of marks-similarity and goods-similarity on consumer perception. The CA ultimately left the issue open for future consideration.

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