



BIRDS OF A FEATHER – SINGAPORE COURT CLARIFIES “DISTINCTIVNESS” IN TWITTER CASE

Introduction and brief facts

1. The recent High Court case of *V V Technology Pte. Ltd. v Twitter, Inc.* [2022] SGHC 293 features a battle between the social media giant, Twitter Inc. (“**Twitter**”), and a technology start up, V V Technology Pte Ltd. (“**VV**”).
2. A key issue in the case is whether there is confusing similarity between VV’s  mark (the “**Application Mark**”) and Twitter’s  mark (the “**Registered Mark**”).

The Applicant - V V Technology Pte. Ltd.

3. VV is a technology start-up incorporated in Singapore, which leveraged on advancements in artificial intelligence, blockchain technologies, cloud computing and big data to drive the world’s transition to smart commerce. VV has been developing a mobile application called “V V Life” (the “**App**”), which is meant to serve as a user’s smart personal concierge by hosting a broad range of products and services on a single platform that cater to a user’s personal lifestyle needs.
4. VV intended for the Application Mark to be prominently featured at the bottom of the user’s handphone screen when the App is being used.

The Respondent – Twitter Inc.

5. Twitter is a social media company incorporated in the USA that owns and operates the Twitter platform, a microblogging and social networking service provider where registered users can communicate and stay connected with other users through messages known as “Tweets”.

The Suit

6. In September 2018, VV applied to register the Application Mark in relation to services which overlapped with those of the Registered Mark. Twitter successfully challenged the application at the first instance, preventing the Application Mark from proceeding to registration. VV appealed to the High Court.

10 January 2023

For any queries relating to this article, please contact:

Tan Tee Jim, S.C.

tanteejim@leenlee.com.sg

Jasper Lim

jasperlim@leenlee.com.sg

Authors:

Tan Tee Jim, S.C.

Jasper Lim

Mary Tan

Lee & Lee

25 North Bridge Road

Level 7

Singapore 179104

Tel: +65 6220 0666

For more legal updates, please visit the News & Publication Section of Lee & Lee’s website at www.leenlee.com.sg, or follow Lee & Lee’s Facebook page at www.facebook.com/leenlee.com.sg/ and Lee & Lee’s LinkedIn page at <https://lnkd.in/g6bNfv8G>.

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7. On appeal, the VV argued, amongst others, that the first instance decision finding confusing similarity between the marks should be overturned. The High Court disagreed and VV's appeal was dismissed.
8. In this article, we will focus on two key takeaways from the case for businesses.

Clarity on the meaning of the word “distinctiveness” in trade mark law

9. Under our Trade Marks Act, the distinctiveness of a mark is an important element in obtaining registration of the mark as well as in preventing registration of a rival similar mark. In particular, a mark may be registered as a trade mark if it is “distinctive” and in determining whether it is similar to the rival mark so as to prevent registration of a rival similar mark, the distinctiveness of the registered mark is an “integral factor” in the determination.
10. According to the High Court, there was taxonomic uncertainty regarding the meaning of this word “distinctiveness” as a result of the Court of Appeal case of *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 (“**Staywell**”). In that case, the Court of Appeal noted the distinction between “technical distinctiveness” (which refers to the ability of a mark to distinguish the goods or services of a trader from those of another) and “non-technical distinctiveness” (which refers to a mark being outstanding and memorable and therefore easy to recognise and remember). Previously, the courts had been using the expression “distinctive and dominant components” of a mark to refer to a mark which is outstanding and memorable. The High Court wondered if there was any difference between the term “non-technical distinctiveness” and the expression “distinctive and dominant components” and whether the term was intended to replace the expression.
11. The confusion was compounded by the fact that the terms “inherent distinctiveness” and “acquired distinctiveness” have also been used and there was no clarity as to whether they were applicable to “technical distinctiveness” or “non-technical distinctiveness”.
12. After extensively surveying case law and academic literature, the High Court concluded that the term “distinctiveness” should refer to (1) inherent technical distinctiveness; (2) acquired technical distinctiveness; and (3) non-technical distinctiveness, and that inherent technical distinctiveness and acquired technical distinctiveness are distinctions that are to apply only to technical distinctiveness.

Clarity on the role of the word “distinctiveness” in trade mark law

13. As mentioned, the distinctiveness of a registered trade mark is an “integral factor” in determining whether it is similar to a rival mark such as to prevent the registration of that mark. The greater the registered mark's technical distinctiveness, the higher the threshold the rival mark has to overcome in order to be considered to be similar. Inventive, fanciful and meaningless marks as well as words which do not describe and have no relation to the goods or services concerned generally have strong inherent ability to distinguish the goods or services of a trader from those of another and thus have great technical distinctiveness.

14. What if the ability of a mark to distinguish the goods or services of a trader from those of another is acquired as a result of extensive use over several years? Should such acquired distinctiveness of the mark be considered in determining whether it is similar to the rival mark so as to prevent the registration of the rival mark? There were conflicting decisions and academic commentary on this issue.
15. In the event, the High Court decided that acquired distinctiveness should not be considered in the determination of the similarity of the marks concerned. This was principally because, in *Staywell*, the Court of Appeal had held that the determination is to be based on a mark-for-mark comparison, without taking into account any external matter. If acquired distinctiveness were to be considered, it would require the court to consider external matter such as the length and extent of use of the registered mark. That was not permissible, according to *Staywell*.
16. In the circumstances, your business will benefit by:
 - (a) Filing and using marks with a high level of inherent technical distinctiveness, such as inventive, fanciful and meaningless marks as well as words which do not describe and have no relation to the goods or services concerned.
 - (b) Adopting practices which document the acquired technical distinctiveness of your marks. In practice, this means systematically collating documentation as regards the use of your marks in trade, to establish brand recognition.
 - (c) Filing and using marks with a high level of non-technical distinctiveness. In layman terms, this means adopting marks with a memorable and dominant component which differs from the marks of your competitors.
17. Please do not hesitate to contact us if you have any queries relating to this case update, or require any advice in relation to trade mark matters.

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The following partners lead our departments:

Kwa Kim Li
Managing Partner

kwakimli@leenlee.com.sg

Quek Mong Hua
Litigation & Dispute Resolution

quekmonghua@leenlee.com.sg

Owyong Thian Soo
Real Estate

owyongthiansoo@leenlee.com.sg

Tan Tee Jim, S.C.

Adrian Chan

Louise Tan

CASE UPDATE



Intellectual Property

tanteejim@leenlee.com.sg

Corporate

adrianchan@leenlee.com.sg

Banking

louisetan@leenlee.com.sg