

Case Summary: East Coast Podiatry Pte Ltd v Family Podiatry Centre Pte Ltd [2025] SGCA 28:

Overview:

This case involved two companies in the Podiatric industry, and here the Singapore Court of Appeal (“**SGCA**”) dismissed the Appellant’s appeal and highlighted the importance of the element of “*trade mark use*” to meet the threshold requirement for a claim in trade mark infringement.

Specifically, in the context of online advertising, the SGCA’s decision emphasised the requirement that such “*trade mark use*” has to denote the trade origins of the goods or services advertised for it to then be considered trade mark infringement.

The SGCA, in adopting such an “*effect-centric*” approach, thus departed from the usual English and European views on the same matter.

Case facts:

East Coast Podiatry Centre Pte Ltd (the Appellant) is a Singapore-registered private company providing podiatry services, and which came into business in 2015.

Family Podiatry Centre Pte Ltd (the Respondent) is also a Singapore-registered private company providing podiatry services, and which came into business, approximately ten years earlier than the Appellant, in 2005.

The Appellant is the registered proprietor of the composite mark ¹ “ EAST COAST PODIATRY” (the “**East Coast Podiatry Mark**”), and which is registered in Classes 5, 10, 25, and 44 of the Nice Classification of Goods and Services.

Sometime in 2022, the Respondent sought to open a new branch office near the eastern coastline of Singapore and published some online advertisements, via Google Ads, to promote this endeavour. The online advertisements featured the words “*east coast podiatry*”, “*Podiatry East Coast*” and “*Podiatrist East Coast*” (referred to herein collectively as the “**Alleged Marks**”). Subsequently these advertisements were then discovered by the Appellant on three (3) separate occasions between April 2022 to July 2022.

As a result of these advertisements, the Appellant alleged that the Respondent infringed its registered East Coast Podiatry Mark. On the other hand, the Respondent argued that such words were used, on the advice of the Google consultant, merely as location-based keywords.

¹ A composite mark is a mark that contains both word and device elements.

Singapore High Court (“SGHC”) decision:

The Appellant commenced suit against the Respondent, claiming trade mark infringement pursuant to Sections 27(1) and/or 27(2)(b) of the Trade Marks Act 1998 (the “TMA”).

The Respondent denied the claim on the basis that the phrase “*East Coast Podiatry*” was descriptive of the geographical location of its new branch and that its use did not give rise to any likelihood of confusion.

The SGHC found in favour of the Respondent and dismissed the Appellant’s claims in *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 (the “**Judgment**”), and with the main findings summarised below:

- The East Coast Podiatry Mark was a composite mark and was visually different from the words used in the Respondent’s advertisements; and
- There was no trade mark infringement because the Respondent’s website, which the Google Ads linked directly to, would have dispelled any confusion that relevant members of the public might have initially had upon viewing such advertisements.

The Appeal:

The Appellant appealed against the SGHC’s Judgment, and specifically on the finding of the trade mark infringement under Section 27(2)(b) of the TMA.

The Appellant submitted two contentions:

- That the SGHC erred in considering the Respondent’s website when assessing the likelihood of confusion (the “**Confusion Inquiry**”), on the basis that the website was an extraneous factor; and
- That the relevant members of the public would believe that the Appellant and the Respondent are economically linked.

Regarding the specific context of online advertising, two (2) further questions arose:

- Whether it was permissible for the SGCA to consider the Respondent’s website as part of the Confusion Inquiry; and
- Whether the decisions of the Court of Justice of the European Union (the “**CJEU**”) and the English Courts are applicable to the inquiry under s 27(2) of the TMA.

a) Threshold issue: trade mark use

To constitute infringement under Section 27 of the TMA, a party must satisfy the threshold test, which requires that the “*trade mark use*” must denote the trade origins of the goods or services in question.

The position in Singapore

The SGCA in this case considered the previous decision of *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“**City Chain**”) to be narrower than the CJEU’s position (see *Arsenal Football Club PLC v Matthew Reed (C-206/01)*). In *City Chain* the decorative use of the alleged sign did not result in trade mark infringement, the view that only “*trade mark use*” constitutes trade mark infringement prevailed. Since then, the SGHC and SGCA have made similar decisions, which have entrenched in Singapore the requirement that “*trade mark use*” has the effect of identifying and/or referring to the trade origins of the goods and/or services in question.

Therefore, according to the SGCA in this case, a robust application of the threshold test involves these considerations:

- Whether the Alleged Marks were used as a badge of origin by considering the objective circumstances surrounding its use;
- The inherent distinctiveness of the alleged infringer’s mark with a greater latitude afforded to the alleged infringer who uses words or ideas of a generic nature; and
- The consideration of the website’s content by the Court in assessing whether there was trade mark use.

b) Application to the facts

In asserting that the Respondent had used the Alleged Marks in a trade mark sense, the Appellant made three (3) submissions:

- The Alleged Marks were not descriptive of the Respondent’s services because of the lack of clinics in the east of Singapore;
- Although the Alleged Marks were generic, the combined phrases used by the Respondent made them distinctive and capable of being used as a badge of origin and thus identifying the Appellant as the originator of the offered goods and/or services (i.e. podiatric-related goods and/or services);
- The way the Alleged Marks were presented suggested that they were used as a badge of origin (as argued above).

Ultimately, the SGCA disagreed with the Appellant's submissions, as above, and found that Alleged Marks were clearly used in a descriptive way. There was nothing improper in pre-empting the opening of a new branch. Moreover, the way the relevant mark was presented in the Respondent's Google Ads was "clearly a function of how sponsored links appear on the Search Engine Research Page" (See Paragraph [84]).

In reaching its decision, the SGCA also found that there was no credible evidence to support the Appellant's contention that the Respondent had used the Alleged Marks in a trade mark sense with the specific intention of confusing prospective customers who might have been looking for the Appellant's services instead.

c) *Distinctiveness of the East Coast Podiatry Mark and similarity of the same with the Alleged Marks used by the Respondent*

A trade mark can be inherently distinctive if it consists entirely of inventive words and has long-standing or widespread use.

The Appellant contended in this case that the amalgamation of the words "East Coast" and "Podiatry" created a unique textual juxtaposition that is distinctive and not descriptive of the relevant goods.

The SGCA disagreed because the East Coast Podiatry Mark's ability to function as a badge of origin is derived entirely from its use as a composite mark. On this basis, the East Coast Podiatry Mark and the Alleged Marks were also found to be clearly dissimilar.

d) *The Confusion Inquiry*

The SGCA also considered that extraneous factors may be helpful to the extent that it allows the Courts to determine the similarity of the Alleged Marks and the goods and/or services, and whether it would affect consumers' perception as to the source or origin of such goods and/or services.

For example, these would include extraneous factors which motivate the consumer to exercise care in the purchase of such goods and/or services, such as to ascertain the originator or source of such goods and/or services before making a purchase. Therefore, permissible extraneous factors are those that:

- Are intrinsic to the very nature of the goods and/or services; and/or
- Affect the impact that the similarity of Alleged Marks and goods and/or services has on the consumer.

Conclusion:

In the context of online advertisements, “*trade mark use*” needs to be proven in Singapore for trade mark infringement to be established.

The alleged infringement must therefore use the registered mark in a trade mark sense and thus denote the trade origins of goods and/or services as being those of the proprietor of the infringed trade mark.

Accordingly, the use of the registered trade mark cannot merely be descriptive, for example, as was in this case, to make reference to a geographical location in Singapore.

Another key take away from this case would be to ensure “*distinctiveness*” of a party’s registered trade mark, and which cannot merely be “*generic*” in nature. Hence, taking the right steps in creating and registering a trade mark from the onset is crucial.



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Should you have any queries as to how this update may affect you or your organisation or require further information, please do not hesitate to email us.

This article is intended to highlight key legal and practical considerations regarding the factors taken into account by the SGCA in determining trade mark use. It is not intended to be comprehensive, not should it be construed as legal advice. This article is updated as of 16 October 2025.

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