

## TRADE MARK INFRINGEMENT AND THE INTERNET

### *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914

JOEL KO\*

In *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd*, the Singapore Court of Appeal addressed trade mark infringement in the context of Google advertisements and online search advertising. The Court of Appeal reaffirmed Singapore’s use-centric threshold of “trade mark use” under s 27 of the Trade Marks Act 1998 (2020 Rev Ed), declining to adopt the EU’s effect-centric “functions” approach. In addition, the decision also contained *obiter* on whether websites may feature in the confusion analysis for trade mark infringement, appearing to take a more expansive view towards extraneous considerations in infringement cases, in contrast to the prior decision of *Staywell Hospitality Group v Starwood Hotels*. This comment examines the implications of this decision especially in light of Singapore’s shared TRIPS obligations, and the possibility of future development of trade mark law in the digital marketplace.

#### I. INTRODUCTION

At its core, trade mark law serves a dual-function: first, as a means of consumer protection by serving as identifiers to prevent confusion and deception when locating goods or services,<sup>1</sup> and second, as a means of protection for traders against unfair competition.<sup>2</sup> In practice, trade marks feature strongly as part of advertising and branding for firms.<sup>3</sup> However, with the rise of internet commerce and digital advertising, the boundaries of trade mark protection have been blurred, particularly in relation to online advertising and keyword use.

In this context, the recent Singapore Court of Appeal decision of *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 (“*East Coast Podiatry*”) provides valuable guidance regarding trade mark infringement

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\* LLB ’25, Singapore Management University, Yong Pung How School of Law. I thank the reviewers for their very helpful comments, all errors and omissions are entirely my own.

<sup>1</sup> See: *Mobil Petroleum Co Inc v Hyundai Mobis* [2010] 1 SLR 512 at [33] (CA) [*Mobil Petroleum*].

<sup>2</sup> See: Clarisa Long, “Trademarks and Unfair Competition” in Francesco Parisi, ed. *The Oxford Handbook of Law and Economics: Volume 2: Private and Commercial Law* (Oxford: Oxford University Press, 2017) 220 at 223 [Long, “Trademarks and Unfair Competition”]; Jeanne C Fromer, “Trade Mark Ownfringement” [2023] Sing JLS 342 at 345 [Fromer, “Trade Mark Ownfringement”].

<sup>3</sup> Long, “Trademarks and Unfair Competition”, *supra* note 2 at 221; David Tan, “Differentiating between Brand and Trade Mark” [2010] Sing JLS 202 at 202; Danielle Lisbon, “The ‘Use as a Trade Mark’ Requirement in Keyword Search Advertising” (2018) 2 Western Australian Student Law Review 33 at 37.

in the context of Google advertisements and online search advertising. The judgment reaffirms Singapore's use-centric approach towards trade mark infringement,<sup>4</sup> specifically of "trade mark use" under section 27 of the Trade Marks Act 1998 ("TMA"),<sup>5</sup> while expressly declining to adopt the EU's effect-centric approach which originated in *Google France SARL and another v Louis Vuitton Malletier SA* [2011] All ER (EC) 411 ("*Google France*").<sup>6</sup>

It also addressed, in *obiter*, the contentious question of whether a defendant's website may be considered in the confusion analysis for internet advertising, acknowledging the interactive nature of online advertisements but leaving the issue open for a future case. Against the backdrop of similar statutory wording and shared TRIPS commitments, the decision suggests a substantive divergence between Singapore and the approach in the EU and the UK, with practical consequences for trade mark infringement disputes in the online context. This comment first provides an outline of the facts and holdings, before providing a comparative analysis as to the competing approaches between Singapore and the EU/UK, and evaluates the potential future implications for trade mark law in the online sphere.

## II. CASE FACTS

*East Coast Podiatry* involved an alleged trademark infringement process via the use of Google advertising services.<sup>7</sup> The Appellant, East Coast Podiatry Centre Pte Ltd, was a registered proprietor of the composite mark "East Coast Podiatry".<sup>8</sup> The Appellant alleged that their registered trade mark was infringed by the Respondent, Family Podiatry Centre Pte Ltd, through internet advertisements which contained similar words as their composite mark.<sup>9</sup>

In the internet advertisements in question, the Respondent relied on the words "east coast podiatry", "Podiatry East Coast" and "Podiatrist East Coast" within its Google search advertisement hyperlink. This meant that any searches of "east coast podiatry" would cause the Respondent's advertisement to appear. However, despite the presence of these terms within the advertisement hyperlink, these terms were not found within the Respondent's website.<sup>10</sup>

The Appellant thus commenced a trade mark infringement lawsuit against the Respondent pursuant to sections 27(1) and/or 27(2)(b) of the TMA as well as seeking damages under the tort of passing off.<sup>11</sup>

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<sup>4</sup> *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 1 SLR 914 at [79] (CA) [ECP CA].

<sup>5</sup> 2020 Rev Ed [TMA].

<sup>6</sup> *Google France SARL and another v Louis Vuitton Malletier SA*; *Google France SARL v Viaticum SA and another*; *Google France SARL v Centre National de Recherche en Relations Humaines (CNRRH) SARL and others* [2011] All ER (EC) 411 [*Google France*].

<sup>7</sup> ECP CA, *supra* note 4 at [1].

<sup>8</sup> *Ibid* at [2].

<sup>9</sup> *Ibid* at [4].

<sup>10</sup> *Ibid* at [5].

<sup>11</sup> *Ibid* at [7].

### III. HIGH COURT DECISION

In the High Court, it was held that there was no trade mark infringement.<sup>12</sup> The SGHC first addressed the alleged infringement under section 27(1) of the TMA, which has two requirements:

- (a) the person uses in the course of trade a sign which is identical with the trade mark; and
- (b) is in relation to goods or services which are identical with those for which it is registered.<sup>13</sup>

The court rejected the claim on the basis that there is no identity between the signs in the Google advertisement and the registered composite mark by the applicant, as the presence of the small white cross over a green square background sufficed to show a visual difference between the composite mark and the Google advertisement.<sup>14</sup>

The SGHC then addressed the alleged infringement under section 27(2)(b) of the TMA. There are three requirements for a claim to be made out under section 27(2)(b):

- (a) The person uses in the course of trade *a sign that is similar to the trade mark*;
- (b) The sign is *used in relation to goods or services identical with or similar to those for which the trade mark is registered*; and
- (c) There exists a *likelihood of confusion* on the part of the public.

The court did not conduct an extensive examination of the first two requirements, as the defence did not make any submissions disputing the similarity of the signs, and the services provided by both companies, being podiatry services and foot-related healthcare, fell firmly within Class 44 of the International Classification of Goods and Services.<sup>15</sup>

However, the SGHC provided a detailed explanation on the likelihood of confusion requirement. The test was to be focused on “how the relevant segment of the public is likely to perceive the origin of the goods or services bearing the contesting marks”,<sup>16</sup> and will be fulfilled if a substantial portion of the relevant public will be confused<sup>17</sup> — the relevant public being the actual or potential purchasers of the goods or services in question.<sup>18</sup>

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<sup>12</sup> *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2025] 4 SLR 784 at [94] [*ECP HC*].

<sup>13</sup> TMA, *supra* note 5, s 27(1).

<sup>14</sup> *ECP HC*, *supra* note 12 at [49].

<sup>15</sup> *Ibid* at [52].

<sup>16</sup> *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [76] (CA) [*Hai Tong*], cited in *ECP HC*, *supra* note 12 at [53].

<sup>17</sup> *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 at [57] (CA), cited in *ECP HC*, *supra* note 12 at [53].

<sup>18</sup> Ng-Loy Wee Loon SC, *Law of Intellectual Property of Singapore*, 3d ed (Singapore: Sweet & Maxwell, 2021) at 21.5.27, cited in *ECP HC*, *supra* note 12 at [53].

The SGHC first established the ambit of “relevant public”, which was held to consist of the general public who used Google’s search engine, specifically those who were “actual or potential consumers of podiatry services”.<sup>19</sup>

Turning next to the confusion analysis, the SGHC made clear that actual confusion was not necessary, and a likelihood of confusion sufficed, which could arise directly or indirectly.<sup>20</sup> Direct confusion being where “the mark(s) and the sign(s) are mistaken for each other by the average consumer” and indirect confusion being where “the similarities lead the average consumer to form the mistaken view that they originate from the same or linked undertakings”.<sup>21</sup>

The SGHC held that the issue of confusion should not be restricted to the sponsored links but extends to the advertiser’s website (as an intrinsic part of the advertisements) and accepted that the defendant’s website Uniform Resource Locator (“URL”) and features of its website would dispel any confusion.<sup>22</sup> The SGHC held on this basis that there was no confusion and thus no infringement without addressing whether physical arrival would dispel any remaining confusion.<sup>23</sup>

#### IV. COURT OF APPEAL DECISION

Before the Court of Appeal, the Appellant argued that the SGHC’s use of the Respondent’s website in the likelihood of confusion analysis was misguided,<sup>24</sup> on the basis that the website and its details are a marketing choice rather than reflecting the nature of goods that would impact consumer perception regarding the similarities between the two marks.<sup>25</sup>

The Appellant further argued that even if the website could be considered, relevant members of the public who viewed the Respondent’s advertisements and website would reasonably believe that the Appellant and Respondent were economically linked.<sup>26</sup>

##### A. *The Ambit of Google Search and the Potential Effect of Technology*

Before going substantively into the Appellant’s submissions, the SGCA provided a brief explanation as to the ambit of Google search engine advertisements, which were said to consist of three elements: (a) an underlined heading which functions as a hyperlink to the advertiser’s website; (b) a short commercial message or

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<sup>19</sup> *ECP HC*, *supra* note 12 at [54].

<sup>20</sup> *Ibid* at [55].

<sup>21</sup> *Hai Tong*, *supra* note 16 at [73]; *Dr Who Waterworks Pte Ltd and others v Dr Who (M) Sdn Bhd and others* [2023] SGHC 156 at [101], cited in *ECP HC*, *supra* note 12 at [55].

<sup>22</sup> *ECP HC*, *supra* note 12 at [69], [81].

<sup>23</sup> *Ibid* at [62], [83].

<sup>24</sup> *ECP CA*, *supra* note 4 at [12].

<sup>25</sup> *Ibid*.

<sup>26</sup> *Ibid* at [13].

advertisement; and (c) the URL of the advertiser's website.<sup>27</sup> The SGCA then caveated these elements by noting that the evolution of technology may mean that these elements would change in the future, which suggests that the ruling on the issue is confined to how Google search engine advertisements are perceived today.<sup>28</sup>

### B. Law on Trade Mark Use

Under section 27 of the TMA, the applicant must first show that there has been an unauthorised use of a sign which is identical or similar to their registered trade mark.<sup>29</sup> It should be noted that the ambit of unauthorised use does not extend to include descriptive or decorative use.<sup>30</sup>

In determining the threshold issue of "trade mark use", the SGCA relied on an objective assessment of several non-exhaustive factors:

- (a) The objective circumstances surrounding the defendant's use of the signs. This will necessarily entail a consideration of the interaction between the defendant's signs and the resulting advertisement. The defendant's subjective intentions may also be a relevant, but not necessarily decisive, factor;
- (b) The inherent distinctiveness of the signs used by the defendant. Greater latitude is afforded to a defendant who uses words or ideas of a generic nature, bearing in mind the reality that internet users would typically employ a wide range of generic search terms when conducting an [i]nternet search; and
- (c) The website which an internet user is redirected to upon clicking on the defendant's advertisement. This factor is aimed at helping the court to assess the apparent purpose for which the signs were used, particularly where the advertisement itself contains few details.<sup>31</sup>

### C. Application to the Facts

#### 1. Trade mark use

In dealing with the threshold issue of trade mark use to the facts, the SGCA rejected the Applicant's arguments that:

- (a) the [s]igns were not descriptive of the Respondent's services because the Respondent did not have any clinics in the east of Singapore at the material time;

<sup>27</sup> *Interflora Inc and another v Marks and Spencer plc* [2015] IP & T 109 at [15] (Eng, HC) [*Interflora*], cited in *ECP CA*, *supra* note 4 at [19].

<sup>28</sup> *ECP CA*, *supra* note 4 at [20].

<sup>29</sup> TMA, *supra* note 5, s 27.

<sup>30</sup> *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [36] (CA) [*City Chain*]; *Hai Tong*, *supra* note 16 at [17]; *Burberry Ltd v Megastar Shipping Pte Ltd and another* [2019] 1 SLR 536 at [32] (CA) [*Burberry*], cited in *ECP CA*, *supra* note 4 at [25].

<sup>31</sup> *ECP CA*, *supra* note 4 at [79].

- (b) the combined phrases “east coast”, “podiatry” and “podiatrist” used by the Respondent do not make grammatical sense or convey any sensible meaning. The resulting terms are distinctive and capable of being used as a badge of origin; and
- (c) the manner in which the relevant signs were presented suggests that they were used as a badge of origin given that they were prominently displayed in the Respondent’s advertisements.<sup>32</sup>

The SGCA held that the use of the signs was descriptive in nature. First, the term “east coast” refers to a geographical area which would include Joo Chiat Road, and thus the use of “east coast” is an accurate description of the Respondent’s branch location.<sup>33</sup>

Second, the relevant signs were presented in a way consistent with how sponsored links appear on the Google search engine, thus, the words used in the headlines of the advertisement cannot be said to be a badge of origin.<sup>34</sup>

Lastly, the SGCA suggested that if the Respondent had an intention to confuse prospective clients looking for the Appellant’s services, this might suffice to fulfil the threshold requirement of trade mark use.<sup>35</sup> However, this argument was rejected due to the lack of evidence. Hence, the appeal was dismissed on the basis that there was no unauthorised use shown by the Appellant.

## 2. *Likelihood of confusion*

Notwithstanding the Appellant’s failure to show trade mark use, the SGCA addressed in *obiter* the likelihood of confusion inquiry, specifically whether a defendant’s website ought to be considered as part of the confusion inquiry in the context of internet advertising. The Appellant relied on two decisions in support of its argument that the Respondent’s website should not be considered as part of the confusion inquiry: *Staywell Hospitality Group v Starwood Hotels* [2014] 1 SLR 911 (“*Staywell*”) and *E-Accounting Solutions v Global Infosys* [2023] EWHC 2038 (Ch) (“*E-Accounting*”).

In *Staywell*, the SGCA held that the permissible extraneous factors in the inquiry are those which (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.<sup>36</sup> On the other hand, factors that are not inherent in the goods, which could potentially have been created by a trader’s differentiating steps, are impermissible factors.<sup>37</sup> Thus, the Appellant argued that the Respondent’s website was an impermissible factor.

<sup>32</sup> *Ibid* at [81]–[82].

<sup>33</sup> *Ibid* at [82].

<sup>34</sup> *Ibid* at [83]–[84].

<sup>35</sup> *Ibid* at [86].

<sup>36</sup> *Ibid* at [99], citing *Staywell Hospitality Group v Starwood Hotels* [2014] 1 SLR 911 at [95] (CA) [*Staywell* CA].

<sup>37</sup> *Ibid* at [99].

This was also supported by the English decision of *E-Accounting*, where Tindal J confined the analysis to the advertisement itself and declined to consider the landing page.<sup>38</sup> The rationale of the Appellant was that to permit reliance on the contents of the website would be the online equivalent of allowing a trader to avoid confusion by means of disclaimers or later differentiating steps.<sup>39</sup>

There were two points made by the SGCA. First, the SGCA noted that extraneous considerations cannot negate any likelihood of confusion which is established based on the similarity in marks and goods or services and the characteristics of the likely consumer.<sup>40</sup> Otherwise, this would allow advertisers to advertise similar or identical goods yet avoid liability by using an express disclaimer to then argue that there was no likelihood of confusion.<sup>41</sup>

Second, the SGCA noted that the situation in *Staywell* and that in *East Coast Podiatry* concerned two different types of proceedings. The former involved opposition proceedings whereas the latter involved infringement proceedings in the internet context.<sup>42</sup> Thus, where infringement proceedings are concerned, there may be room to argue that a more liberal view towards extraneous factors should be permitted, as it would better reflect the actual circumstances in which the infringing signs were deployed.<sup>43</sup> However, the SGCA chose not to take a decided view on this matter.

The SGCA further considered in *obiter* the similarity of the competing marks and noted that the Appellant's registered mark and the Respondent's signs were dissimilar.<sup>44</sup> Ordinarily, marks similarity is assessed with reference to its distinctive and dominant components.<sup>45</sup> For composite marks, it may be possible to confine the comparison to the dominant component where that component is capable of functioning as a badge of origin.<sup>46</sup> However, such an inquiry was not applicable to this case. Both components of the Appellant's registered mark – the words and the device – were not sufficiently distinctive to serve as a badge of origin.<sup>47</sup> The words "East Coast Podiatry" were merely descriptive of podiatry services offered in a certain region and the device (a simple green cross) is commonly used in healthcare.<sup>48</sup> Hence, marks similarity had to be done with reference to the composite mark entirely.<sup>49</sup> Accordingly, since the Respondent's signs did not contain the device, which was a crucial element of the registered mark, the marks were dissimilar.<sup>50</sup>

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<sup>38</sup> *Ibid* at [100], citing *E-Accounting Solutions v Global Infosys* [2023] EWHC 2038 (Ch).

<sup>39</sup> *Ibid* at [100].

<sup>40</sup> *Ibid* at [102].

<sup>41</sup> *Ibid* at [102].

<sup>42</sup> *Ibid* at [103]. See also: *Staywell CA*, *supra* note 36 at [84].

<sup>43</sup> *Ibid* at [103].

<sup>44</sup> *Ibid* at [95].

<sup>45</sup> *Ibid* at [92].

<sup>46</sup> *Ibid* at [92].

<sup>47</sup> *Ibid* at [94].

<sup>48</sup> *Ibid* at [94].

<sup>49</sup> *Ibid* at [94].

<sup>50</sup> *Ibid* at [95].

## V. ANALYSIS

### A. *Google France and the Effect-centric Approach*

The SGCA in *East Coast Podiatry* chose to adopt a threshold test of “trade mark use” rather than the effect-centric test developed by the CJEU in *Google France*, which looks at whether the impugned use is “liable to affect the functions of the [registered] trade mark”.<sup>51</sup> The *Google France* test places an emphasis on the effect that the alleged infringing use has on the advertising function of the trade mark rather than focusing on “trade mark use” as a prerequisite.<sup>52</sup>

Interestingly, the diversion in approaches comes about notwithstanding both Singapore and the EU being signatories to the TRIPS Agreement.<sup>53</sup> Article 16 of the TRIPS Agreement provides that:

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

While the TRIPS Agreement appears to seek a uniform standard of protection across signatory countries within the IP sphere,<sup>54</sup> Article 1(1) of the TRIPS Agreement preserves state autonomy, and provides states with liberty to implement more extensive protection than what is provided for within the TRIPS Agreement.<sup>55</sup>

The EU position in *Google France* was in relation to trade mark infringement pursuant to Article 5(1)(b) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks. Article 5(1) states:

1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:
  - (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;

<sup>51</sup> *Arsenal Football Club Plc v Reed* [2003] Ch 454 (ECJ Case C-206/01) at [51]; *Google France*, *supra* note 6 at [49], [75].

<sup>52</sup> *ECP CA*, *supra* note 4 at [45], [51], [54].

<sup>53</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights (opened for signature Apr 15, 1994), Annex 1C Marrakesh Agreement Establishing the World Trade Organization, preamble (1 Jan 1995 [accession by Singapore Jan 1 1995]), 1869 UNTS 299 [TRIPS Agreement].

<sup>54</sup> *Ibid*; Thomas Cottier, “Working together towards TRIPS” in Jayashree Watal, Antony Taubman, eds. *The Making of the TRIPS Agreement – Personal insights from the Uruguay Round negotiations* (Geneva: World Trade Organisation, 2015) 79 at 80.

<sup>55</sup> TRIPS Agreement, *supra* note 53, Article 1(1).

- (b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.<sup>56</sup>

Based on the CJEU's approach towards Article 5, it is not a precondition to show "trade mark use" before infringement can be made out. Rather, the question before the court is whether the advertisement "does not enable normally informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to in the advertisement originate from the trade mark proprietor or an undertaking economically connected to it, or on the contrary, originate from a third party".<sup>57</sup> This formulation is one that is effect-centric, with an emphasis on consumer perception.

In contrast, the Singapore position, which is grounded in section 27 of the TMA, has a threshold requirement of "trade mark use" before a claim in trade mark infringement can succeed. Section 27 states:

27.—(1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign where because —

- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public.

The SGCA rejected the effect-centric test used in the EU for the following reasons:

- (a) it would impose a new likelihood of confusion requirement which is inconsistent with section 27(1) of the TMA; and
- (b) it would widen the scope of infringing uses to include decorative or descriptive uses which are excluded under it would widen the scope of infringing uses to include decorative or descriptive uses which are excluded under the TMA.<sup>58</sup>

<sup>56</sup> First Council Directive to approximate the laws of the Member States relating to trade marks, EC Council Directive 89/104/EEC Art 5(1), 1988, OJ L 040/1 at 4.

<sup>57</sup> *ECP CA*, *supra* note 4 at [54].

<sup>58</sup> *Ibid* at [79]. See also: *City Chain*, *supra* note 30 at [36]; *Hai Tong*, *supra* note 16 at [17]; *Burberry*, *supra* note 30 at [32].

These concerns echo Arnold J's critique in *Datacard Corp'n v Eagle Technologies Ltd* [2012] Bus LR 160, in relation to the *Google France* test being statutorily inconsistent between Articles 5(1)(a) (involving identical signs) and 5(2) (involving similar signs) of the EU Directive,<sup>59</sup> though these concerns were later rejected by the English Court of Appeal in *Interflora CA*, where the *Google France* effect-centric approach was upheld — that despite the absolute nature of protections in Article 5(1)(a) of the EU Directive, infringement arises only where the impugned use adversely affects, or is liable adversely to affect, one of the trade mark's functions.<sup>60</sup>

Despite similar statutory wording between the TMA and the EU Directive, the EU requires the proprietor to show an adverse effect on a function of the mark before infringement is made out.<sup>61</sup> In Singapore, the proprietor must preliminarily show that there was "trade mark use" of the sign, with adverse effect weaved into the confusion analysis at a later stage.<sup>62</sup>

This divergence between the two regimes reflects deeper policy choices. Singapore's narrower conception appears consistent with the legislative intent of the TMA and Article 16(1) of the TRIPS Agreement. This aims to prevent over-extension of monopoly rights into descriptive or generic language. The EU's effect-centric approach, on the other hand, reflects its principles of free competition.<sup>63</sup>

There is nevertheless an argument that there should be convergence in the law. Online advertising is inherently transnational, where the same Google advertisements may appear both in Singapore and in London. Divergent approaches towards trade mark infringement create uncertainty for businesses and raise compliance costs, which is contrary to TRIPS' objective of harmonisation. Notwithstanding its role as a "minimum standard", one could argue for greater consistency in assessing infringement in the digital environment.

### B. Trade Mark Infringement in the Realm of Internet Advertising

In the digital marketplace, the intersection between trade mark protection and internet advertising has become increasingly complex. Search engines and social media have changed the way consumers view brands and the functionality of trade marks in practice.<sup>64</sup> As compared to the typical physical encounters with brands from the past, upon which trade mark laws were formulated,<sup>65</sup> today, consumers often encounter brands online, whether through targeted advertisements or within

<sup>59</sup> *Datacard Corp'n v Eagle Technologies Ltd* [2012] Bus LR 160 at [266] (Eng, HC), cited in *ECP CA*, *supra* note 4 at [56].

<sup>60</sup> *Interflora*, *supra* note 27 at [148], cited in *ECP CA*, *supra* note 4 at [56].

<sup>61</sup> Council Regulation on the Community trade mark, EC Council Regulation No 40/94 Art 9(1)(a), 1993, OJ L 011/1 at 5; *Google France*, *supra* note 6 at [74], [79].

<sup>62</sup> *ECP CA*, *supra* note 4 at [23], [25]–[26].

<sup>63</sup> See: *Adidas AG and adidas Benelux BV v Marca Mode CV* Case C-102/07 [2008] ECR I-02439 at [45].

<sup>64</sup> David J Franklyn & David A Hyman, "Trademarks as Search Engine Keywords: Much ado about something?" (2013) 26(2) *Harv JL & Tech* 481 at 485–488; Abigail Dagher, "The Influencers and the Influenced: Effects of Social Media Influencers on Enforcement of Trademark Law in the U.S. and Europe" (2023) 37 *Emory Intl L Rev* 741 at 773.

<sup>65</sup> Sai Swetha E & Sai Darshini SK, "Trademark Infringement and Online Environment: Challenges and Legal Remedies" (2024) 6(6) *International Journal of Legal Science and Innovation* 214 at 215,

search engine results.<sup>66</sup> The availability of complex algorithms and meta-keywords allow brands to increase visibility even through capitalising on competitor brands.<sup>67</sup> Thus, given these realities, the test for trade mark infringement must adapt to the internet age.

Before delving into the SGCA's *obiter* in *East Coast Podiatry*, it would be useful to note the position in *Staywell* which touched on two core issues: First, that extraneous considerations are not permissible once the court determines that there has been a likelihood of confusion.<sup>68</sup> Second, *Staywell* was also notable for the rejection of "initial interest confusion", an American concept whereby the confusion threshold is still met even if it was subsequently dispelled.<sup>69</sup> In justifying this decision, the SGCA emphasised the purpose of the confusion analysis under section 8(2) of the TMA, which is concerned with the origin and source of goods rather than its reputation.<sup>70</sup>

Against this backdrop, the SGCA's *obiter* in *East Coast Podiatry* hints at potential developments under trade mark law when considering internet advertisements. While reaffirming the limitations of extraneous factors in the confusion analysis expounded in *Staywell*, the SGCA left open the question of whether the contents of websites can be relied upon in assessing the likelihood of confusion and consumer perception.<sup>71</sup>

The argument advanced by the Appellant and the Independent Counsel Professor Llewelyn is that the confusion inquiry should be limited to the internet advertisement and not the website, to prevent a defendant from taking differentiating steps on the website *after* the confusion has arose.<sup>72</sup> While excluding these differentiating steps is coherent with *Staywell*, it does not appear to account for the reality of online consumer transactions where advertised links are mere gateways for consumers to access websites before proceeding with the transaction.<sup>73</sup>

Perhaps the takeaway is not for a complete re-formulation of the law, rather that the *Staywell* approach towards extraneous factors may require flexibility in the internet advertising context. Importantly, this is still consistent with the rejection of the "initial interest confusion" doctrine — the focus is still on whether consumers are misled at the relevant point of purchase. The difference is a more expansive approach towards the "point of purchase" for online transactions that goes beyond the search engine results and includes other constituent elements such as the website.

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explaining how the Indian Trade Marks Act of 1999, enacted at a similar time to the Singapore Trade Marks Act 1998, did not contemplate digital commerce.

<sup>66</sup> See: Martin Senftleben, "Trademark Law, AI-driven Behavioural Advertising and the Digital Services Act – Towards Source and Parameter Transparency for Consumers, Brand Owners and Competitors" in Ryan Abbott ed, *Research Handbook on Intellectual Property and Artificial Intelligence* (Cheltenham: Edward Elgar, 2022) 309 at 309–310.

<sup>67</sup> See: *Reed Executive v Reed Business International* [2004] EWCA Civ 159 (CA) at [148].

<sup>68</sup> *Staywell CA*, *supra* note 36 at [86].

<sup>69</sup> *Ibid* at [105].

<sup>70</sup> *Ibid* at [113].

<sup>71</sup> *ECP CA*, *supra* note 4 at [102]–[103].

<sup>72</sup> *Ibid* at [100]–[101].

<sup>73</sup> *Ibid* at [103].

## VI. CONCLUDING THOUGHTS

The decision of *East Coast Podiatry* reflects the Singapore position to preserve a narrower, use-centric framework for trade mark infringement, resisting the adoption of EU's effect-centric test. By reaffirming "trade mark use" as a threshold inquiry, the court ensures that descriptive and decorative uses remain outside the ambit of infringement, which limits the risk of over-expansion of monopoly rights.

At the same time, the court's *obiter* on whether websites may be considered in the confusion inquiry reflects an awareness of the realities of digital advertising, where consumer perception is shaped in a myriad of ways beyond physical experiences to include business websites and search engine tools.<sup>74</sup>

Ultimately, *East Coast Podiatry* shows the delicate balance that trade mark law has to consider: the interests of traders to ensure fair competition, and the interests of consumers to prevent any confusion or deception.<sup>75</sup> While the Court of Appeal did not take a definitive position in relation to internet advertising, the door has been left open for the law to adapt to changes in the real-world digital marketplace.

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<sup>74</sup> Nieharika Sharma & Archana Aggarwal, "Consumer Perception & Protection of Well-Known Trademarks: A Comparative Study" (2024) 7(2) International Journal of Law Management & Humanities 2943 at 2961.

<sup>75</sup> *Mobil Petroleum*, *supra* note 1; Long, "Trademarks and Unfair Competition", *supra* note 2; Fromer, "Trade Mark Ownfringement", *supra* note 2.