

# PRACTICAL IMPLICATIONS ARISING FROM THE PROHIBITION OF PARTIAL TRADE MARK OPPOSITION

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Yvonne **TANG**

*LLB (Hons) (National University of Singapore);  
Advocate and Solicitor (Singapore); Solicitor (England and Wales);  
Director, Drew & Napier LLC.*

Edsmond **CHEONG**

*LLB (University of Sheffield);  
Advocate and Solicitor (Singapore);  
Associate, Drew & Napier LLC.*

## I. Introduction

1 It has been more than five years since the Hearings and Mediation Department of the Intellectual Property Office of Singapore (“IPOS”) first scrutinised the issue of whether the relevant legislative provisions permit partial oppositions in the context of trade mark oppositions – that is, where grounds of opposition exist only in respect of some of the goods or services for which a trade mark application covers, whether IPOS is empowered to find that opposition succeeds only for those goods or services, and to allow the remaining goods or services to proceed to registration.

2 Five years on, and after multiple occasions during which the issue of partial oppositions was examined (but only in *obiter*), *Damiani International BV v Dhamani Jewels DMCC*<sup>1</sup> (“*Damiani*”) finally brought about the opportunity for IPOS to adjudicate on the issue. This article reviews the analysis and findings made by the hearing officer in *Damiani*, and explores the implications

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1 [2020] SGIPOS 11.

of prohibiting partial oppositions for trade mark applicants and practitioners.

## II. ***Damiani International BV v Dhamani Jewels DMCC***

3 The case of *Damiani* concerned a trade mark opposition launched by Damiani International BV (“Opponent”) against Dhamani Jewels DMCC’s (“Applicant”) application for “**DHAMANI**” in classes 14 and 35. In so far as class 14 was concerned, the Applicant conceded that various items in the specification were identical with or similar to the goods listed under the Opponent’s mark, while the rest were not. In the premises, the Applicant argued that the latter group of items, being dissimilar, should be allowed to proceed to registration.

4 The hearing officer disagreed, for various reasons.

### A. ***Interpretation of legislative provisions***

5 The hearing officer rejected the argument that s 12(3) of the Trade Marks Act<sup>2</sup> (“Act”), which states that “[i]f it appears to the Registrar that *the requirements for registration are not met* or that additional information or evidence is required to meet those requirements, the Registrar shall inform the applicant *and give him an opportunity*, within such period as may be prescribed, to make representations, *to amend the application* or to furnish the additional or any other information or evidence” [emphasis in original], mandates the Registrar to give an applicant the opportunity to delete offending items in the specification after opposition proceedings. He reasoned that, based on a reading of the relevant heading and sub-headings of the Act, s 12(3) of the Act<sup>3</sup> was strictly confined to the examination stage. The hearing officer was also of the view that a similar provision would have been provided for under s 13 of the Act,<sup>4</sup> had it been the legislative

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2 Cap 332, 2005 Rev Ed.

3 With the sub-heading “Examination of application”.

4 With the sub-heading “Publication and opposition proceedings”.

intent to permit amendment of an application pursuant to an opposition.<sup>5</sup>

6 The differences in the language used in the Act for trade mark opposition, revocation, and invalidation provisions further reinforced the hearing officer's finding. While ss 22(6) and 23(9) of the Act expressly permitted partial revocation and partial invalidation, respectively, such language was not mirrored in the provisions for opposition. Indeed, this observation was echoed in the earlier decisions of *Christie Manson & Woods Ltd v Chrित्रs Auction Pte Ltd*<sup>6</sup> and *Monster Energy Co v Tencent Holdings Ltd*<sup>7</sup> ("Tencent").

7 However, the extent to which partial oppositions were disallowed has not been congruent in the cases. *Obiter* observations were made in *Tencent*<sup>8</sup> and *Abbott Laboratories v Société Des Produits Nestlé SA*.<sup>9</sup> that it was uncontroversial for partial oppositions to be allowed in multi-class applications. The hearing officer in *Damiani* took a different view. While ss 22(6) and 23(9) of the Act applied irrespective of whether the applications were single-class or multi-class, he found that partial oppositions were disallowed for either scenario, since there was no express legislative provision to that effect.<sup>10</sup>

## **B. Policy reasons**

8 The hearing officer in *Damiani* also considered policy reasons advanced by the parties. The Applicant argued that if partial oppositions were not allowed, an opposition would succeed against all the items in the specification claimed, merely because of an overlap of some but not all of the items. It submitted that this would place an applicant in a worse-off position than if it had deleted or amended the specification of its application prior to the opposition proceedings. In response, the hearing officer expressed that this would, on the contrary, encourage parties

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5 *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [72].

6 [2016] SGIPOS 1 at [107].

7 [2018] SGIPOS 9 at [83].

8 *Monster Energy Co v Tencent Holdings Ltd* [2018] SGIPOS 9 at [79].

9 [2019] SGIPOS 11 at [73(c)].

10 *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [75]–[76].

to reach an out-of-court settlement. Where the specifications are not amended or where the application is not divided prior to the opposition hearing, the applicant should be taken to have accepted the risk that its entire application will be rejected.<sup>11</sup> The hearing officer in *Tencent* shared the same view.<sup>12</sup>

9 The Applicant also argued that partial oppositions should be allowed, as international registrations could not be divided. However, the Trade Marks (International Registration) Rules<sup>13</sup> have since been amended to allow the division of international registrations designating Singapore with effect from 1 April 2019. There was therefore no room to contend that the prohibition of partial oppositions would unduly prejudice proprietors of international registrations.<sup>14</sup>

10 For the above reasons, the hearing officer found that IPOS did not have the authority to grant partial oppositions in trade mark opposition proceedings, absent express legislative power.

### III. Observations

11 The current position as reflected in the recent ruling may prompt trade mark practitioners and applicants to:

(a) Revisit issues such as the value of conducting pre-filing searches, the assessment of the level of risk of opposition to an application, and whether to file applications in a broad or narrow manner in the class. As it stands, applications with broad specifications run a higher risk of the entire application being rejected pursuant to an opposition challenge.

(b) Consider division of applications more rigorously, moving forward. This is especially where an entire application is being opposed, and it is assessed that one

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11 *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [78].

12 *Monster Energy Co v Tencent Holdings Ltd* [2018] SGIPOS 9 at [91(d)].

13 Cap 322, R 3, 2002 Rev Ed.

14 *Damiani International BV v Dhamani Jewels DMCC* [2020] SGIPOS 11 at [79]–[81].

or some of the classes or specifications are not *prima facie* objectionable.

(c) As alluded to in *Damiani*, focus on key specifications in the course of negotiations, so as to avoid the situation in which negotiations fall apart, resulting in the entire application being rejected pursuant to an opposition challenge.

#### **IV. Concluding remarks**

12 A determination on partial oppositions is a long time coming. It is worth noting that the partial opposition issue in *Damiani* was discussed in the context of the opposition under s 8(2)(b) of the Act.<sup>15</sup> As the hearing officer in *Tencent* propounded, because of the words “or to the extent that” in s 8(7) of the Act,<sup>16</sup> the position of partial oppositions in the context of an opposition that is based on s 8(7) of the Act may be less clear. It also remains to be seen, should partial oppositions be allowed, the manner in which amendments to specifications will be carried out, such as whether words of limitation may be inserted, if specifications may be “rewritten”, and/or if only deletions from the list of words used will be allowed.

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15 Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) states:

A trade mark shall not be registered if because —

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

16 Section 8(7) of the Trade Marks Act (Cap 332, 2005 Rev Ed) states:

A trade mark shall not be registered if, *or to the extent that*, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

[emphasis added]