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20. INTELLECTUAL PROPERTY LAW

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I. Copyright

A. Formation of contract – Burden of proof of existence of licence

20.1 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd*[1] is a High Court (General Division) decision handed down in February 2024. The claimant, Tiger Pictures Entertainment Ltd ("Tiger Pictures"), was a company incorporated in the People's Republic of China, engaged in the business of selling and distributing films around the world. The defendant, Encore Films Pte Ltd ("Encore Films"), was a company incorporated in Singapore that distributed films in Singapore and other countries in Southeast Asia.

20.2 The claimant was earlier held to be the exclusive licensee of the distribution, reproduction and publicity rights to a Chinese film titled "Moon Man".[2] That decision essentially affirmed the principle that a statutory exclusive licensee cannot itself grant a statutory exclusive licence by way of a sublicence that would confer on that third party standing to sue for copyright infringement.

1 [2024] 5 SLR 316.

2 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268. For a summary of the earlier decision, see David Tan, Susanna H S Leong & Bryan Tan Zhi Yang, "Intellectual Property Law" (2023) 24 SAL Ann Rev 584 at paras 20.28–20.36.

20.3 The parties had a prior commercial relationship in respect of a Chinese film titled "Hi! Mom". They then entered into negotiations for a distribution agreement for "Moon Man" in Singapore over WeChat and e-mail correspondence (the "WeChat and E-mail Negotiations").

20.4 Tiger Pictures had provided Encore Films with the link to access an encrypted file containing the digital cinema package ("DCP") for "Moon Man" and the master password to decrypt the "Moon Man" DCP file, known as the distribution key delivery message. Thereafter, Encore Films sent the first draft of the written distribution agreement for "Moon Man" to the claimant, which the claimant did not accept. The claimant later sent a revised draft to the defendant, and the defendant followed up with a further revised draft.

20.5 Encore Films assumed that the parties had already agreed upon the basic financial terms of a binding distribution agreement through their WeChat and E-mail Negotiations. It informed Tiger Pictures that "sneak" preview sessions for "Moon Man" ("Sneak Sessions") were planned from 9 to 11 September 2022 in Singapore. The claimant disputed this but nonetheless granted the defendant the rights to organise and exhibit "Moon Man" solely for the purposes of these Sneak Sessions.

20.6 The parties continued to exchange further drafts of the distribution agreement but could not reach an agreement on a number of terms. On 13 September 2022, the defendant informed Tiger Pictures that if the claimant failed to respond by 5pm that day, the defendant would assume the claimant had no objections to the theatrical release of "Moon Man". Even though the claimant disputed the existence of a valid distribution agreement between the parties by the stipulated time, the defendant proceeded with the theatrical release of "Moon Man" between 15 September 2022 and 26 October 2022.

20.7 Tiger Pictures subsequently brought a claim against the defendant for infringing its copyright in "Moon Man". The defendant argued that there was no copyright infringement as there was a valid distribution agreement for "Moon Man" between the parties, by way of the WeChat and E-mail Negotiations.

20.8 Dedar Singh Gill J allowed the claim and held that in a copyright infringement claim, the claimant bore the burden of proving that there was no licence given to the defendant under s 146(1)(*b*) of the Copyright Act 2021.[3] The claimant needs to prove *both* existence of ownership of

3 2020 Rev Ed. *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 5 SLR 316 at [30].

copyright *and* lack of a copyright licence when seeking to bring an action for copyright infringement. Such a position was said to be supported by case law in the UK and Australia, as well as academic opinions.[4]

20.9 Comparing the parties' prior dealings in respect of formalities when establishing a distribution agreement for an earlier movie "Hi! Mom", and their present conduct regarding the negotiation of a distribution agreement for "Moon Man",[5] the court concluded that the parties did not have an intention to create legal relations through their WeChat and E-mail Negotiations. Hence, there was no distribution agreement between the parties, and accordingly, the defendant had infringed copyright in "Moon Man" with the theatrical release.

20.10 Gill J commented that there was an interplay between the contractual formation requirements of an intention to create legal relations and certainty. Where parties entered into a signed agreement which adequately set out the essential terms of the transaction, the court would be reluctant to infer that the parties had not intended to be bound. Conversely, the existence of uncertain and incomplete terms led to the likely inference that there was a lack of contractual intent.[6]

20.11 The court granted, *inter alia*, an order for an injunction to restrain Encore Films from infringing the copyright in "Moon Man", for the delivery up and forfeiture or destruction of the infringing copies of "Moon Man" in the defendant's possession, and an inquiry as to the damages, or at the claimant's election, an account of profits in respect of the copyright infringement in "Moon Man".[7]

B. Remedies and nominal damages for copyright infringement

20.12 In *Syed Suhail bin Syed Zin v Attorney-General*,[8] the Court of Appeal unanimously held that the nominal damages of $10 was sufficient and declined to grant a declaration in respect of copyright infringement to the appellants.

4 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 5 SLR 316 at [31]–[34].
5 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 5 SLR 316 at [66]–[77] (citing, *inter alia*, *China Coal Solution (Singapore) Pte Ltd v Avra Commodities Pte Ltd* [2020] 2 SLR 984 at [26]).
6 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 5 SLR 316 at [38]–[39] and [50].
7 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 5 SLR 316 at [128].
8 [2024] 2 SLR 588.

20.13 The primary claim relates to breach of confidence and is analysed in detail elsewhere.[9] With regard to that claim, the court granted declarations that the Attorney-General's Chambers ("AGC") and the Singapore Prison Services ("SPS") had acted unlawfully and in breach of confidence by, respectively, requesting and disclosing the appellants' correspondence.

20.14 Thirteen appellants who had at all material times been prisoners in Changi Prison, after having been convicted on various charges, complained that the AGC and SPS had breached the appellants' right to confidentiality under civil law and that the appellants were entitled to various remedies. At various points in time, SPS had forwarded copies of documents that the appellants' families had passed to them in prison to the AGC, as well as copies of the prisoners' letters to their families to the AGC. It was undisputed in these proceedings that correspondence belonging to the appellants (totalling 68 individual documents) had been disclosed by the SPS to the AGC. The correspondence falls into various categories as follows: (a) correspondence with various public or governmental agencies (*eg*, letters to the Supreme Court Registry, the Singapore Police Force, and the President of Singapore); (b) correspondence with other organisations such as the Law Society of Singapore and the Malaysian High Commission; (c) correspondence between the appellants and their counsel; and (d) letters from Syed Suhail bin Syed Zin to his uncle.[10]

20.15 Judith Prakash SJ, delivering the judgment of the court, held that the lower court did not err in ordering that nominal damages of $10 ought to be payable to three of the appellants, and no declaration of infringement of copyright be granted.[11]

20.16 Three of the appellants sought a declaration of copyright infringement relating to four sets of correspondence which were sent/copied prior to 1 September 2017 when reg 127A of the Prisons Regulations[12] (which expressly provides that copies may be made of letters sent to or by prisoners) came into effect. The Court of Appeal agreed with the lower court's refusal to exercise its discretion in favour of granting a declaration "because doing so would not have secured the Appellants any real relief from any liability, disadvantage or difficulty".[13] In Prakash SJ's view, it would be obvious from the award of nominal

9 Benjamin Wong, "Confidential Information and Data Protection" (2024) 25 SAL Ann Rev.

10 *Syed Suhail bin Syed Zin v Attorney-General* [2024] 2 SLR 588 at [5].

11 *Syed Suhail bin Syed Zin v Attorney-General* [2024] 2 SLR 588 at [83].

12 2002 Rev Ed.

13 *Syed Suhail bin Syed Zin v Attorney-General* [2024] 2 SLR 588 at [85].

damages itself that there had been a technical infringement of copyright, thus making any declaration "superfluous".[14]

20.17 The court also held that there was no basis on which the appellants may seek additional damages, whether in the form of exemplary damages or statutory damages under the Copyright Act 2021, or for an inquiry into the extent of damage suffered by each appellant to be conducted. Specifically, on the facts of the case:[15]

> There was no evidence, nor any suggestion in the Appellants' submissions or affidavits, that there was any monetary loss directly flowing from a breach of copyright. The only loss in relation to copyright suggested by the Appellants related to the possible advantage that the AGC would have gained in court proceedings by virtue of having advance notice of the Appellants' intended arguments.

20.18 Moreover, Prakash SJ was of the view that the figure of $10 awarded by the lower court was neither arbitrary nor unprincipled, and distinguished the facts here from the factual matrix in *Anwar Patrick Adrian v Ng Chong & Hue LLC*.[16]

II. Geographical indications

A. Translations of geographical indication under ss 46(1)(b) and 46(2)(b) *of Geographical Indications Act 2014*

20.19 In *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano*[17] ("*Fonterra*"), the Court of Appeal considered questions relating to the qualification of rights process under s 46(1)(*b*) read with s 46(2)(*b*) of the Geographical Indications Act 2014[18] ("GIA"). The unanimous judgment was delivered by Prakash SJ (with whom Tay Yong Kwang JCA and Belinda Ang Saw Ean JCA agreed).

20.20 The appellant, Fonterra Brands (Singapore) Pte Ltd, was a wholly owned subsidiary of a New Zealand-based co-operative company owned by 10,000 dairy farmers, and was involved in the collection, manufacture and sale of milk and milk-derived products. These products included cheese sold by the appellant under the "Perfect Italiano" trade mark in

14 *Syed Suhail bin Syed Zin v Attorney-General* [2024] 2 SLR 588 at [85].
15 *Syed Suhail bin Syed Zin v Attorney-General* [2024] 2 SLR 588 at [91].
16 [2014] SGHC 234. *Syed Suhail bin Syed Zin v Attorney-General* [2024] 2 SLR 588 at [92], referring to *Anwar Patrick Adrian v Ng Chong & Hue LLC* [2015] 5 SLR 1071 at [38].
17 [2024] 2 SLR 624.
18 Act 19 of 2014.

Singapore, which was produced in Australia and marketed as "traditional style parmesan".

20.21 The respondent, Consorzio del Formaggio Parmigiano Reggiano, was a voluntary consortium of producers of "Parmigiano Reggiano" cheese, tasked by the Italian Ministry of Agricultural Food and Forestry Policies with the protection, promotion, enhancement, consumer information and general care of the interests relating to Parmigiano Reggiano cheese.

20.22 In Singapore, the respondent had registered the geographical indication ("GI") for "Parmigiano Reggiano" for cheese originating from a specified region of Italy. Shortly after the respondent's successful registration, the appellant filed a request under s 46(1)(*b*) read with s 46(2)(*b*) of the GIA to qualify the respondent's rights in respect of the GI on the basis that the term "Parmesan" is not a translation of "Parmigiano Reggiano" ("Request"). The Registrar of Geographical Indications ("Registrar") proposed to allow the Request and published the proposed qualification of rights in the Geographical Indications Journal for opposition purposes. The respondent filed an opposition to the Request ("Opposition").

20.23 The principal assistant registrar ("PAR") heard the Opposition and allowed it. On appeal to the General Division of the High Court, Gill J upheld the PAR's findings and dismissed the appeal.[19] The appellant then appealed against the whole of Gill J's decision. Before the Court of Appeal, three issues arose for determination:

> (a) Which party bore the burden of proof where a proposed qualification of rights was opposed?
>
> (b) What was the proper approach to the meaning of a "translation" under s 46(1)(*b*) read with s 46(2)(*b*) of the GIA?
>
> (c) Applying this approach, whether "Parmesan" was a translation of "Parmigiano Reggiano".

20.24 Prakash SJ first set out the statutory context of the qualification of rights process. The protection of GIs under the GIA serves to safeguard the interests of Singapore's consumers by providing greater assurance that food products truly carry the characteristics they are known for, and which are attributable to their geographical origin. Consumers must

19 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77. This decision was discussed in David Tan, Susanna H S Leong & Bryan Tan Zhi Yang, "Intellectual Property Law" (2023) 24 SAL Ann Rev 584 at paras 20.70–20.81.

be able to rely on GIs as *indications* used in trade to identify goods as originating from a certain place. However, the registration of a GI should not prevent fair and established competition from products of a similar nature originating from outside the registered geographical area.[20]

20.25 Under the GIA, translations of a GI can be protected by *default*. In the case of GIs identifying agricultural products (other than wines and spirits), the protection of translations, as provided for in s 4(6) of the GIA, is available to registered GIs.[21] Registrants do not need to specify all the translations sought to be protected at the time of registration. Rather, the determination of whether a term is a translation of a GI is undertaken on a case-by-case basis, either through infringement proceedings under s 4 of the GIA or upon a request for a qualification of rights of a registered GI under s 46 of the GIA.[22]

(1) Which party bore burden of proof where proposed qualification of rights opposed?

20.26 The qualification of rights process provides an avenue for interested persons, such as third-party traders, to request that there should be a *carve-out* to the rights conferred by the GIA in relation to certain elements of the GI. This allows both registrants and interested third parties to achieve clarity on whether specific terms will be available for use by third parties.[23]

20.27 Both the PAR and Gill J had held that the legal burden of proof where a proposed qualification of rights was opposed should lie on the party opposing the qualification of rights.[24] On appeal, Prakash SJ examined the prescribed procedure of the qualification of rights process set out in r 40 of the Geographical Indications Rules 2019 ("GIR") as well as the nature and function of the qualification of rights system. Prakash SJ reversed Gill J's finding on this question, concluding instead that the burden lay on the *party making a request* ("Requestor") to satisfy two thresholds before the requested qualification would be allowed.[25]

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20 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [1].

21 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [3].

22 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [5].

23 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [24]–[25].

24 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [13] and [16].

25 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [32]–[33].

20.28 First, under r 40(4) of the GIR, the Registrar must be satisfied that the Requestor's request discloses a *prima facie* case before the Registrar is obliged to publish the proposed qualification for opposition purposes. This threshold reduces wastage of court resources by sieving out cases that do not even disclose a *prima facie* case.[26]

20.29 Second, after publication, the Requestor must further satisfy the Registrar on a *balance of probabilities* that at least one of the grounds in s 46(2) of the GIA is made out, and only then will the Registrar be obliged to enter the qualification of rights in the register.[27] Prakash SJ found support for this interpretation in the wording of r 40(5) of the GIR:[28]

> Where no notice of opposition has been filed within the period mentioned in rule 41(1), *and the Registrar is satisfied* that either or both of the grounds in section 46(2) of the Act is or are made out, the Registrar must (subject to section 46(6) of the Act) enter the qualification of rights in the register. [emphasis in original]

20.30 The learned judge held that the phrase "and the Registrar is satisfied" implied that at the time the Registrar proposed to allow a request under r 40(4) of the GIR, he did not yet need to be satisfied on a balance of probabilities that at least one of the grounds in s 46(2) of the GIA was made out.[29] By way of contrast, the procedure for *cancellation* proceedings under r 65 of the GIR is worded and structured such that at the time the Registrar publishes the proposed cancellation, he must *already* be satisfied on a balance of probabilities that at least one of the grounds for cancellation is made out.[30]

20.31 According to the Court of Appeal, this holding also agrees with the nature and function of the qualification of rights process. The purpose of publication under r 40(4) of the GIR is to advertise the proposed qualification of rights to, and evoke a response from, the registrant of the GI, whose views the Registrar would then have the benefit of considering. As such, no conclusive determination would have been made at this stage. Crucially, since the Requestor is the one who seeks a carve-out of the

26 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [34]–[35].

27 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [32].

28 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [34].

29 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [36].

30 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [38]–[39].

rights accorded to the registered or soon-to-be-registered GI, the burden ultimately lies on this party to prove that the carve-out should be made.[31]

20.32 Prakash SJ rejected the appellant's attempt to analogise qualification of rights proceedings with the opposition proceedings in *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc*[32] ("*Prosecco*"), in which the Court of Appeal had held that the party opposing an application for registration of a GI bears the burden of proof.[33] According to Prakash SJ, the holding in *Prosecco* should be understood in the context of the procedure for opposition proceedings under s 45 of the GIA, which requires the Registrar to determine whether the requirements for registration have been met *before* accepting an application and causing it to be published for opposition purposes.[34]

20.33 In conclusion, the Requestor bears the burden of proof where a proposed qualification of rights is opposed. In the case before the court, the appellant therefore had to demonstrate that the ground under s 46(1)(*b*) read with s 46(2)(*b*) of the GIA was made out.[35]

(2) What was proper approach to meaning of "translation" under s 46(1)(b) *read with s 46(2)*(b) *of GIA?*

20.34 Next, the Court of Appeal considered the test for determining if a term was a "translation" of the GI in question under s 46(1)(*b*) read with s 46(2)(*b*) of the GIA. Gill J had ruled that a "faithful" approach that captured the meaning of the words in question should be adopted, as opposed to a "strict literal" or word-for-word approach to translation. Gill J had also held that consumer perception was generally irrelevant, save to the extent that such perception was reflected in extracts from reputable dictionaries.[36]

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31 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [43].

32 [2023] 2 SLR 509. This decision was discussed in David Tan, Susanna H S Leong & Bryan Tan Zhi Yang, "Intellectual Property Law" (2023) 24 SAL Ann Rev 584 at paras 20.53–20.69.

33 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc* [2023] 2 SLR 509 at [62]–[64].

34 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [41]–[42].

35 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [45].

36 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [17].

20.35 The Court of Appeal agreed that in general, a literal translation would be a faithful translation of the term in question. In cases where the two diverge, the GIA requires a faithful translation that captures the essence of the word or phrase. Further, where the registered GI comprises more than one word, what is required is a translation of the registered GI as a whole.[37]

20.36 In the Court of Appeal's view, however, a "translation" under the GIA must be a translation *known* to the average consumer in Singapore, and how a translated term was known and used locally could have an impact on the inquiry. As the function of GIs is to indicate the geographical origin of products to consumers, a translation that is not known or used by the average Singapore consumer does not fulfil this function in respect of the product it describes.[38]

20.37 Prakash SJ opined that this position also accorded with the overarching legislative purpose of consumer protection. The protection of registered GIs and their translations seeks to address the unfair trade practice of using the GI on a product which may mislead the public into believing that the product originated from a particular geographical location. Merchants cannot circumvent the scheme by using another language. In addition, the protection of translations makes GIs more accessible to people who speak a different language. Conversely, however, a term in a language not known to the average consumer in Singapore – such as a language hardly heard or used in Singapore – is unlikely to convey any meaning to the average consumer and therefore should not be a "translation" protected under the GIA.[39]

20.38 Turning to the notional average Singapore consumer, Prakash SJ adopted the definition laid down in *Prosecco*, albeit in the context of s 41(1)(*f*) of the GIA – "Singapore citizens and residents and not those who are merely passing through".[40] In the context of the dispute before the court, the average consumer did not need to have specialist knowledge

37 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [46].

38 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [49].

39 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [49]–[51].

40 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [52] (citing *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc* [2023] 2 SLR 509 at [49]).

of cheese, nor did he need to be a member of the expatriate or Italian community in Singapore.[41]

20.39 In assessing whether a translated term is known to the average consumer in Singapore, the court will consider credible and relevant evidence, which may come from a variety of sources. Although English dictionaries are a helpful starting point for ascertaining the ordinary meanings of words, they are not determinative of the inquiry, since they do not accurately capture the changes in the meaning of words over time and the meaning which the local population would ascribe to those words. Other than dictionaries, evidence of usage may come from credible tomes on the product in question as well as consumer surveys.[42] However, the probative value of consumer surveys varies according to the fairness of the survey methodology.[43]

20.40 Thus, a "translation" for the purposes of s 46(1)(*b*) read with s 46(2)(*b*) of the GIA must be a translation known to the average consumer in Singapore, which is to be assessed at the time the request for the qualification of rights is filed. In the case before the court, the appellant was therefore required to show that at least by 16 September 2019, "Parmesan" was not a translation known to the average consumer in Singapore of the term "Parmigiano Reggiano".[44]

(3) Was "Parmesan" a translation of "Parmigiano Reggiano?

20.41 Finally, Prakash SJ considered the evidence given by parties on the issue of whether "Parmesan" was a translation of "Parmigiano Reggiano". The learned judge first examined the dictionary evidence placed before the court. Prakash SJ rejected the respondent's reliance on an Italian-French dictionary extract that translated the registered GI into its French equivalent, "Parmesan", as this presupposed that the average consumer in Singapore was familiar with the term in the *French* language.[45] English and Italian-English dictionary extracts submitted by the respondent were

41 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [52].

42 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [53]–[57].

43 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [53] (citing *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc* [2023] 2 SLR 509 at [69]).

44 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [57].

45 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [59]–[60].

also inconclusive, as both dictionaries were "not written in (and were not designed to reflect) the vernacular used by locals in Singapore".[46]

20.42 The learned judge then assessed evidence on consumer perception provided by the appellant, which fell into two categories: evidence of advertising material showing how traders marketed and sold "Parmesan" cheese to consumers in Singapore, and evidence of how "Parmesan" cheese was catalogued by online retailers.

20.43 In relation to the first category, Prakash SJ emphasised that the purpose of considering advertising material was to determine the effect of marketing information on consumer perception:[47]

> In this regard, it bears reiterating that the average consumer is a *literate* consumer. Quite plainly, he or she would take some notice of the manner in which a food product has been marketed or advertised. He or she may not, depending on the individual priorities and concerns of the consumer in question, ordinarily take notice of the product's precise ingredient list or its production methods. We also do not go so far as to say that the average consumer would *always* take notice of where a food product originates from. However, information relating to the country of origin is typically a selling point … [emphasis in original]

20.44 After analysing the product listings and packaging of various "Parmesan" and "Parmigiano Reggiano" products, Prakash SJ found significant differences in their overall visual cues. Products marketed under one term were typically sold without mention of the other term, and *vice versa*.[48] Furthermore, most "Parmesan" products displayed their respective countries of origin or production – being countries outside Italy – conspicuously on the marketing material.[49] Therefore, as a result of the manner in which "Parmesan" cheese products had been marketed and sold to consumers in Singapore, the average Singapore consumer would have been influenced to believe that "Parmigiano Reggiano" cheese must originate from a specified region in Italy, whereas "Parmesan" was not identical and could originate from countries outside Italy.[50]

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46 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [64].

47 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [75].

48 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [67]–[71].

49 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [72]–[74].

50 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [76].

20.45 The second type of evidence relied on by the appellant demonstrated that online catalogues of cheese stores, groceries and e-retailers in Singapore categorised the two cheese products *separately*. For instance, searches on the Amazon Singapore online store for "Parmesan" products did not display any "Parmigiano Reggiano" products, and *vice versa*. Prakash SJ was satisfied that consumers who shopped on these websites were likely to perceive "Parmesan" and "Parmigiano Reggiano" cheese as referring to two different types of cheese products.[51]

20.46 Prakash SJ therefore concluded that "Parmesan" was not a translation of "Parmigiano Reggiano". The learned judge allowed the appeal, dismissed the Opposition, and ordered the requested qualification of rights to be entered into the register.[52]

20.47 The learned judge also observed that this dispute related to the GIA in force as of 16 September 2019 before it was amended by the Geographical Indications (Amendment) Act 2020,[53] which replaced the post-registration qualification of rights regime with a new limitation of scope regime.[54] However, Prakash SJ noted that the key difference in the new regime related to which body would hear post-registration applications for qualification of rights, while the grounds for seeking a qualification of rights remained unchanged.[55]

20.48 Being only the second decision from Singapore's apex court on the law on geographical indications in Singapore, *Fonterra* further clarifies the role of consumer perception *vis-à-vis* the geographical indications regime. In the Court of Appeal's view, the notional average Singapore consumer was not only relevant to the provisions of the GIA that specifically required consideration of the consumer's perspective,[56] but should also be central to the process of interpreting the GIA. Therefore, where appropriate, courts may have regard to the overarching

51 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [77]–[79].

52 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [82]–[83].

53 Act 5 of 2020.

54 See s 48A of the Geographical Indications Act 2014 (2020 Rev Ed).

55 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624 at [30]–[31] (comparing s 46 of the Geographical Indications Act 2014 (Act 19 of 2014) with s 48A of the Geographical Indications Act 2014 (2020 Rev Ed)).

56 See *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc* [2023] 2 SLR 509 at [27]–[61] (laying down the applicable test for s 41(1)(*f*) of the Geographical Indications Act 2014 (Act 19 of 2014)).

legislative aim of consumer protection when interpreting and applying the provisions of the GIA.

III. Patents

A. Remedies: assessment of damages

20.49 No substantive patents decisions were handed down in 2024. *TOWA Corp v ASMPT Singapore Pte Ltd*,[57] heard by Lee Seiu Kin SJ in the General Division of the High Court, concerned clarifications on the computation of damages awarded to the plaintiff by the first defendant for the infringement of a patent owned by the former.

20.50 The plaintiff was in the business of providing semiconductor packaging solutions and sold various products, including its YPS machine. The first defendant manufactured and sold moulding machines known as the IDEALmould machine. The first defendant was found to have infringed the plaintiff's patent. The plaintiff elected for damages that accrued during the period of infringement ("Claim Period") to be paid to it by the first defendant.[58]

20.51 In *Towa Corp v ASM Technology Singapore Pte Ltd*[59] ("*Towa v ASM*"), Lee SJ had held that the plaintiff was entitled to recover the loss of profits from its lost sales of its auto mould machines ("Lost Initial Sales") as well as its lost sales of additional parts and aftersales products and services arising from the Lost Initial Sales ("Lost Additional Sales"). The parties subsequently sought clarifications from Lee SJ on various issues relating to the computation of damages to be awarded to the plaintiff.[60]

20.52 This review will cover the court's clarifications on the calculation of loss of profits from the Lost Initial Sales and the Lost Additional Sales; the court's discussion on interest and cost is beyond the scope of this review.[61]

20.53 The first category of clarifications related to the parameters for calculating the loss of profits from the Lost Initial Sales. To calculate the Lost Initial Sales, it was necessary to determine the maximum hypothetical number of sales the plaintiff could have made but for the

57 [2024] 6 SLR 355.
58 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [4].
59 [2023] 5 SLR 870.
60 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [5]–[10].
61 The interested reader is referred to *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [96]–[108].

first defendant's infringing acts, adjusted to reflect the plaintiff's market share ("But-for Sales"). The number of infringing machines sold by the first defendant during the Claim Period and the plaintiff's market share therefore formed the key components in this calculation.[62]

20.54 On the basis of the evidence before the court, Lee SJ determined the correct number of But-for Sales and accepted that the Hong Kong market should be subsumed under the market labelled "China" instead of "Asia (Others)".[63] Further, Lee SJ held that the plaintiff's hypothetical machine sales in each national or regional market and year should be calculated to one decimal place, as this would result in a more reliable estimate of the Lost Initial Sales for which the plaintiff was entitled to be compensated.[64]

20.55 In respect of the plaintiff's market share, Lee SJ held that the plaintiff's market share for YPS machines – and not the plaintiff's overall market share for moulding machines – was to be used. Although the But-for Sales could, in principle, have comprised the sales of both YPS and non-YPS machines, the plaintiff had premised its claim on the YPS machine alone and did not provide any evidence on whether any loss of profit arose from the sale of its non-YPS machines due to the first defendant's infringement. Since the plaintiff was confined to claiming for loss of profits arising from lost sales of YPS machines, the only relevant market share figure was the plaintiff's market share for YPS machines.[65]

20.56 Lee SJ held that the use of market share figures in industry market share data was to be preferred to the use of sales figures, as parties had conducted the trial on that basis.[66] In years where no industry market share data was available, the learned judge considered that an average of the plaintiff's respective regional market shares during the years for which data was available would be representative and was to be used.[67] The market share percentages were also to be expressed to one decimal place to ensure consistency with the approach taken to determining the plaintiff's hypothetical number of machine sales.[68]

20.57 Lee SJ also clarified that three categories of costs of sales – unclassified development costs, unclassified disposal costs and unclassified valuation loss of the costs of sales that were unable to be

62 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [13].
63 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [14]–[22].
64 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [23]–[28].
65 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [29]–[40].
66 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [44]–[45].
67 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [46]–[53].
68 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [54]–[55].

attributed to any specific category of equipment ("Contested Unclassified Costs") – were to be excluded in the calculation of the loss of profits from the Lost Initial Sales.[69]

20.58 The second category of clarifications related to the parameters for calculating the loss of profits from the Lost Additional Sales. First, Lee SJ clarified that he had not held in *Towa v ASM* that the plaintiff did not capture any But-for Sales in its loss-making years, but only that the plaintiff could not claim loss of profits arising from the lost sales of YPS machines in those years. This implied that even though no profits were to be awarded for the loss of those initial sales, the plaintiff was still entitled to recover its loss of profits from the future sales of additional parts in respect of the YPS machines it would have sold during the loss-making years.[70]

20.59 Next, Lee SJ held that in the years where no actual data relating to the sales of additional parts was available, an average of the sales and costs of sales in the period for which the data was available was to be used, as the sales for each year in this period were relatively stable.[71] Further, in years where the sales of additional parts attracted a loss, such losses were to be zeroed, so as to ensure consistency with the approach applied in respect of the loss of profit arising from the Lost Initial Sales in the loss-making years.[72]

20.60 The learned judge confirmed that the plaintiff was entitled to claim for loss of profits from the lost provision of aftersales services in Japan only, as the evidence established that the plaintiff's subsidiary only provided such services in the Japanese market. Accordingly, the computation of this component of the plaintiff's loss of profits was to take into account the actual sales and the But-for Sales that the plaintiff would have captured in the Japanese market alone.[73]

20.61 Lastly, Lee SJ affirmed his holding in *Towa v ASM* that a discount rate of 10% applied to the loss of profits arising from the Lost Additional Sales from the date of the judgment of the assessment and not the date of his decision on the first defendant's liability.[74]

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69 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [56]–[64].
70 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [66]–[70].
71 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [71]–[78].
72 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [79]–[82].
73 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [84]–[91].
74 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 6 SLR 355 at [92]–[95] (referring to *Towa Corp v ASM Technology Singapore Pte Ltd* [2023] 5 SLR 870 at [110] and [120(c)]).

20.62 On appeal by the parties, the Court of Appeal unanimously affirmed the entirety of Lee SJ's decision, with the exception of his finding on the Contested Unclassified Costs. In respect of this issue, the Court of Appeal held that the Contested Unclassified Costs, being unclassified costs which applied to the whole of the plaintiff's product range and which would increase with more sales of the YPS machines, were to be proportionately attributed to the YPS machines and not excluded from the calculation.[75]

IV. Trade marks

20.63 This review covers two trade mark decisions delivered in 2024. One of the decisions was delivered by the Singapore High Court (General Division) and the other by the Appellate Division of the Singapore High Court.

A. Infringement under ss 27(1) and 27(2) of Trade Marks Act 1998 and passing off

(1) Facts and background

20.64 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd*[76] ("*East Coast Podiatry*") was a case decided by Gill J in the General Division of the High Court on trade mark infringement and passing off in respect of the claimant's registered trade marks which contained the words "East Coast Podiatry".

(2) Parties

20.65 The claimant was East Coast Podiatry Centre Pte Ltd, a Singapore-registered private company in the business of providing podiatry services. The claimant operated four podiatry centres in Singapore. These were located in the Kembangan, Orchard, Novena and Bukit Timah regions. The claimant's sole director and shareholder was Jevon Tay. The claimant was the registered proprietor of three trade marks which contained the words "East Coast Podiatry" ("ECPC Marks") in Classes 5, 10, 25 and 44.

20.66 The defendant was Family Podiatry Centre Pte Ltd, a Singapore-registered private company also in the business of providing podiatry services. The defendant operated two branches in Singapore. These were

75 *TOWA Corp v ASMPT Singapore Pte Ltd* [2024] 2 SLR 580 at [7]–[15].
76 [2024] SGHC 102.

located in Bukit Timah and Joo Chiat. The defendant's sole director and shareholder was Mark Brenden Reyneker.

20.67 The claimant submitted that the defendant had infringed its ECPC Marks. On three separate occasions, the defendant used Google's advertising service ("Google Ads") to display advertisements containing the words "east coast podiatry", "Podiatry East Coast" and "Podiatrist East Coast", respectively the "First Incident Advertisements", "Second Incident Advertisements" and "Third Incident Advertisements". The claimant alleged that the First Incident Advertisements constituted infringements under s 27(1) of the Trade Marks Act 1998[77] ("TMA") or, alternatively, under s 27(2)(*b*) of the TMA. For both the Second and Third Incident Advertisements, the claimant brought its claim under s 27(2)(*b*) of the TMA. The defendant argued that the requirements for an infringement under s 27 of the TMA were not fulfilled and, even if they were, its use satisfied the defence under s 28(1)(*b*)(i) of the TMA.

20.68 Separately, the claimant also argued that the defendant was liable for the tort of passing off for using the terms "east coast podiatry", "Podiatry East Coast" and "Podiatrist East Coast" in the title of its Google Advertisements. The defendant disagreed.

(3) Issues

20.69 Gill J, in considering whether the First, Second and Third Incident Advertisements (collectively, "Advertisements") infringed the claimant's ECPC Marks, restricted his analysis to the Second Mark in the claimant's ECPC Marks as the Second Mark contained the least additional elements to the words "East Coast Podiatry" and therefore had the greatest likelihood of similarity to the defendant's Advertisements. If the claimant failed in its claim in so far as the Second Mark was concerned, it w also not succeed in relation to the First and Third Marks in the claimant's ECPC Marks.

20.70 The issues before the High Court were:

(a) Whether the Advertisements infringed the Second Mark under s 27 of the TMA.

(b) Whether the claimant had proven the requisite elements of an action for passing off.

77 2020 Rev Ed.

(4) Verdict of High Court

20.71 Gill J concluded the Advertisements did *not* infringe the Second Mark under s 27 of the TMA and the claimant had *not* proven the requisite elements of an action for passing off. Given this conclusion, there was no necessity for the court to consider the defence proffered by the defendant that its Advertisements were descriptive under s 28(1)(*b*)(i) of the TMA.

(5) Reasons and analyses

(a) Google Advertisements and nature of Google Advertisements

20.72 In the court's determination of whether the defendant's Advertisements infringed the claimant's Second Mark under the TMA, Gill J was of the view that a proper understanding of how Google Ads work was particularly useful. In this connection, Gill J made several observations in respect of Google's search engine and Google Ads.[78]

20.73 Gill J noted that there had been a surge in the use of the Internet as a business and advertising platform in recent years. Consequently, he took the view that the current level of Internet literary of the general public and the rampancy of the use of search engines such as Google had led courts to accept that expert evidence would not be necessary for the court to conclude how an average consumer might perceive Google Ads.[79]

20.74 It is common knowledge that Internet search engines such as Google returns two types of search results: (a) natural results, which are ranked according to their relevance by way of automatic algorithms underlying the search engine program; and (b) sponsored links, which are advertisements created under Google's advertising system.

20.75 In both the natural results and the sponsored links, Internet users are presented with a hyperlink which comprises of a "headline", the Uniform Resource Locator (the "URL") of the corresponding website and a short commercial message or description. To differentiate the sponsored links from the natural results, these have generally been headed with words "Sponsored Links" or "Ads" or variations of them. The keywords chosen by the advertisers to create these sponsored links do not always appear within the "headline" or the commercial message.

78 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [32]–[41].

79 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [38].

(b) Whether defendant's Advertisements constituted infringement under s 27 of TMA

20.76 In respect of Internet advertisers using keywords which are identical or similar to a registered trade mark and whether such a use constitutes trade mark infringement under the law, Gill J was of the view that the policy considerations and principles expounded by courts elsewhere were equally relevant in Singapore.[80] It is not the purpose of trade mark laws to protect trade mark proprietors from fair competition as the aim of Internet advertising using keywords which are identical to trade marks is, in general, to offer Internet users alternatives to the goods or services of trade mark proprietors.[81] Having said that, the law however also expects Internet advertisers to ensure transparency in the display of advertisements on the Internet. Failure to enable the average internet users to ascertain whether the goods or services originated from the trade mark proprietor or an unconnected third party may render the Internet advertiser liable for trade mark infringement.[82]

20.77 To succeed under s 27(1) or 27(2) of the TMA, the claimant must prove the use of the trade mark by the defendant:[83]

(a) within Singapore's territory;

(b) the course of trade;

(c) in a trade mark sense; and

(d) without the consent of the claimant.

20.78 There was no dispute that the alleged infringing signs in the defendant's Advertisements had been used in the course of trade. At the same time, the defendant had also not disputed seriously that there was trade mark use of the alleged infringing signs. Considering these findings, the High Court proceeded with the rest of the analysis on the basis that nature of the *use* of the alleged infringing signs as required under s 27 of the TMA was established.

(6) Infringement under s 27(1) of TMA

20.79 Infringement under s 27(1) of the TMA is established only where the court finds the presence of double identities – (a) identity between

80 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [44].

81 *Interflora Inc v Marks and Spencer plc (No 2)* [2013] 2 All ER 663 at [98].

82 *Interflora Inc v Marks and Spencer plc (No 2)* [2013] 2 All ER 663 at [143].

83 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [46].

the alleged infringing sign and the mark; and (b) identity between the goods or services for which the alleged infringing sign is used and for which the mark is registered.

20.80 The appropriate test of whether a sign is "identical" with a mark "entails a strict interpretation",[84] and "[m]inor differences would take the case outside the definition of identical".[85] The Second Mark was a composite mark which included a small white cross over a green square background (the "device"). Hence, it was visually different from the signs in the defendant's First Incident Advertisements. Consequently, the High Court found there was *no identity* between the signs and the Second Mark, and the defendant did *not* infringe the Second Mark under s 27(1) of the TMA.

*(7) Infringement under s 27(2)(*b*) of TMA*

20.81 In the alternative, the claimant averred that the Advertisements infringed its ECPC Marks pursuant to s 27(2)(*b*) of the TMA.

20.82 Since the defendant had not made any substantive submissions disputing the similarities of the claimant's Second Mark and the signs in the defendant's Advertisements, Gill J thus assumed, without deciding, that they were *similar*. The judge also found the parties' services *identical*. This was because the relevant classification before the court was Class 44 and the claimant's Second Mark was registered in Class 44 (although it was also registered in Classes 5,10 and 25) for, *inter alia*, the "medical care of feet". In the court's judgment, the claimant's services for medical care of feet were *identical* to the defendant's podiatry services (which means "foot-related healthcare").[86]

20.83 Having found similarities in the registered mark and alleged infringing sign, and identities in the claimant's and the defendant's services, the judge proceeded to determine if there existed a likelihood of confusion on the part of the public.

20.84 In the present case, the High Court accepted that the relevant public comprised the general public in Singapore who used Google's search engine.[87] The target consumers would include actual or potential consumers of podiatry services who "would exercise some care and

84 *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [39].
85 *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 at [39].
86 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [52].
87 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [54].

a measure of good sense in making his or her purchases"[88] and are "reasonably well-informed, reasonably observant and circumspect".[89]

20.85 Gill J reviewed the relevant case law including relevant cases from the European Court of Justice ("ECJ") and concluded that in the context of keyword advertising, the text formulated by the ECJ in *Google France SARL v Louis Vuitton Malletier SA*; *Google France SARL v Viaticum SA*; *Google France SARL v Centre National de Recherche en Relations Humaines (CNRRH) SARL*[90] for determining whether an alleged infringing use has adversely affected, or is liable to adversely affect, the origin function of a trade mark was a useful test in the context of double identities trade mark infringement in s 27(1) of the TMA and equally applicable to determine confusion under s 27(2) of the TMA.[91]

20.86 This test was summarised by the English Court of Appeal in *Interflora Inc v Marks and Spencer plc (No 2)*[92] ("*Interflora*") as follows:

> First, *the critical question to be answered in such a case 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 proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party.*
>
> Second, the trade mark proprietor is entitled to prevent the display of third party advertisements which such internet users may erroneously perceive as emanating from that proprietor or which suggest that there is a material link in the course of trade between the goods or services in question and the proprietor.
>
> Third, if the advertisement, though not suggesting an economic link, is vague as to the origin of the goods or services in question so that such internet users are unable to determine, on the basis of the advertising link and the commercial message attaching to it, whether the advertiser is a third party or,

88 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [54].

89 See *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [82], citing *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [40(c)] and *Calvin Klein, Inc v HS International Pte Ltd* [2016] 5 SLR 1183 at [50(b)]. See also *Cosmetics Warriors Ltd v amazon.co.uk Ltd* [2014] IP & T 497 (at [34]) that for Internet advertising, the perspective to be adopted is that of "the reasonably well informed and reasonably observant internet user interested in the products in question".

90 [2011] All ER (EC) 411.

91 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [56].

92 [2013] 2 ALL ER 663 at [75]–[77].

> on the contrary, is economically linked to the proprietor, then this will have an adverse effect on the origin function of the trade mark.
>
> [emphasis added]

20.87 The claimant submitted that there existed a "high likelihood of confusion" on the part of the general public. In substantiating its position, the claimant relied on the factors set out in *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd*:[93]

> (a) Factors relating to the impact of mark-similarity on consumer perception:
>
> (i) degree of similarity of the mark themselves;
>
> (ii) the reputation of the marks;
>
> (iii) the impression given by the marks; and
>
> (iv) the possibility of imperfect recollection of the marks.
>
> (b) Factors relating to the impact of goods/services-similarity on consumer perception:
>
> (i) the normal way in or the circumstances under which consumers would purchase goods/services of that type;
>
> (ii) the price of the goods/services (as opposed to the price disparity between the competing goods);
>
> (iii) the nature of the goods/services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and
>
> (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

20.88 The Singapore Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc*[94] ("*Staywell*") has endorsed the admissibility of this non-exhaustive list of factors in the confusion inquiry under s 27(2) of the TMA.[95] At the same time, it was made clear in *Staywell* that not all external factors may be considered in determining whether a sufficient likelihood of confusion exists. In particular, "the permissible factors are those which (a) are intrinsic to the very nature of the goods and/or (b) affect the impact that the similarity of

93 [2023] SGHC 156 at [102].
94 [2014] 1 SLR 911.
95 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [96].

marks and goods has on the consumer".[96] The Court of Appeal in *Staywell* was explicit in their guidance that the "impermissible factors are those differences between the competing marks and goods which are created by a trader's differentiating steps"[97] since these factors are not inherent in the goods "but are susceptible to changes that can be made by a trader from time to time".[98]

20.89 A key issue before the High Court in this case was whether the three grounds relied upon by the defendant to substantiate its position that there was no likelihood of confusion were permissible factors to be considered in the confusion inquiry. These three grounds were:

> (a) that the allegedly infringing Advertisements displayed the defendant's URL indicating the Advertisements' origin and as such, serve to dispel any likelihood of confusion;
>
> (b) that the infringing Advertisements were ultimately linked to the defendant's website which featured its own trading name and was visually distinct from the claimant's website; and
>
> (c) that any confusion which the relevant public could have after visiting the defendant's website would be dispelled upon physical arrival at the defendant's clinic.

(8) Admissibility of defendant's URL and website in confusion inquiry

20.90 The High Court ruled that the defendant's URL was an admissible consideration. Gill J distinguished *Staywell* from the present case because the facts of *Staywell* did not contemplate the issue of the admissibility of a party's URL in the confusion inquiry as was in the present case. One important difference between *Staywell* and the present case was that the application mark "PARK REGIS" in *Staywell* was intended to be used and was in fact being used on a physical hotel, and the argument by the applicant that there could be no confusion between Park Regis Singapore hotel and the St Regis Singapore hotel was because of the differentiating steps taken by the applicant which included the use of the applicant's mark in the website. On the contrary and in the present case, the complaint of the claimant *only* pertained to the use by the defendant of "east coast podiatry" in its Internet advertising whereas the physical podiatry clinics

96 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [95].

97 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [95].

98 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [95].

of the claimant and the defendant were "East Coast Podiatry Centre" and Family Podiatry Centre" respectively.

20.91 Gill J held that the correct approach was to compare the claimant's Second Mark against the defendant's Advertisements as a whole and, on that basis, determine if there was a likelihood of confusion.[99] More importantly, regard must be had to the use of the signs within Google advertisements, the objective of which is for the relevant consumer to click on the sponsored link within the advertisement and be automatically redirected to the advertiser's website.[100] Considered in this manner, the advertiser's website is therefore intrinsically linked to the sponsored link in which the signs are used. As such, the advertiser's website constitutes part of the actual use of the signs and not an extraneous factor. Gill J also opined that such an approach "accord[ed] better with the purchasing practices of the relevant consumers when faced with sponsored links".[101]

20.92 Applying the law to the facts, the High Court concluded that there was no infringement under s 27(2)(*b*) of the TMA.

20.93 First, the High Court noted that the defendant's sponsored links did not specifically advertise the defendant's Joo Chiat clinic. Next, the High Court rejected the submissions of the claimant (a) that it "enjoyed recognition as the most well-known podiatry brand in Singapore"; (b) that the average consumer would not recognise the "minor differences" between the Second Mark and the defendant's Advertisements due to their imperfect recollection; (c) that various factors served to affect the similarity of the parties' services on consumer perception, such as how consumers would normally purchase the claimant's services and the claimant's average charges for its services; and (d) that a large proportion of the relevant public consisted of new customers who could be "window shopping" and not fastidious or pay particular attention to the different podiatry brands.[102]

20.94 An important consideration for the High Court was the finding that the relevant public would be automatically redirected to the defendant's website upon clicking on the defendant's Advertisements. The presence of the defendant's website served to dispel any confusion

99 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [81].

100 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [82].

101 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [82].

102 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [85].

that might have arisen at the first instance as the defendant's website made no mention of the phrase "east coast podiatry" or "east coast". As such, the High Court concluded that the relevant public would, upon clicking on the defendant's Advertisements, be immediately aware that the defendant's website was not associated with the claimant.[103]

20.95 The High Court also rejected the claimant's submission that consumers would rely on the phrase "east coast podiatry" in the sponsored link and then proceed to make an appointment via the quick link which bypassed the defendant's website. This was because the High Court considered that a typical reasonably well-informed and reasonably observant Internet user was unlikely to make purchases of goods or services online in such a manner.[104]

20.96 Lastly, the High Court concluded that the relevant public was also unlikely to perceive the defendant to be a linked undertaking of the claimant. This was because in the present case, the claimant did not operate a "network" of clinics under different trade marks which was unlike *Staywell* and *Interflora*.[105]

20.97 Considering all the above, the High Court held that the claimant failed to discharge its burden of proof in relation to a likelihood of confusion on the part of the relevant public.

(9) Passing off

20.98 To succeed in a claim for passing off, the claimant must prove the classical trinity of: (a) goodwill; (b) misrepresentation; and (c) damage.[106]

20.99 In respect of the first element of goodwill, the High Court concluded that the requisite goodwill was established. The goodwill inquiry in a claim for passing off involves consideration of two essential characteristics: (a) the "power of attraction which draws customers to buy the trader's goods";[107] and (b) the relevant goodwill must be in connection

103 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [86]–[88].

104 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [89]–[90].

105 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [91]–[93].

106 *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 at [37]; *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 at [27]–[28].

107 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [97].

to a business.[108] In the present case, the High Court, having considered all the evidence before it, in particular, information on marketing and promotion, the use of social media, the claimant's revenue figures, *etc*, arrived at the conclusion that there was no dispute as to the power of attraction of the business and that the relevant goodwill was connected to a business.

20.100 In establishing the second element of "misrepresentation", the claimant must show that there was a false representation, giving rise to actual confusion or a likelihood of confusion on the part of the relevant public.[109] The relevant public is the actual and potential customer of the claimant.[110] The relevant time of confusion is at the time of purchase.[111]

20.101 The threshold inquiry involves determining whether the claimant's trade mark is distinctive (*viz,* whether the relevant public recognises or associates the mark exclusively with the claimant's goods or services). Where this is fulfilled, the claimant has to satisfy the court that there was a misrepresentation by the defendant and that the misrepresentation gave rise to actual confusion or a likelihood of confusion.[112]

20.102 In this regard, the High Court found the claimant's ECPC Marks distinctive. The phrase "East Coast" is generally taken to refer to the geographical region in the east of Singapore, while the word "podiatry" has the ordinary meaning of foot-related healthcare. Taken together, the phrase "East Coast Podiatry" would suggest a podiatry-related business located in the East Coast region of Singapore. Thus, the claimant's ECPC Marks had a descriptive connotation when used in relation to podiatry services in the East Coast region of Singapore. However, where the ECPC Marks were used for podiatry services in other geographical locations in Singapore, they could not be considered descriptive in any way. As the claimant operated three other clinics in other regions of Singapore with same mark containing the words "East Coast Podiatry", the High Court found the ECPC Marks sufficiently distinctive.[113]

108 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [97].

109 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [175] and [177].

110 *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 at [71]–[76].

111 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [116].

112 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [106].

113 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [107]–[108].

20.103 The determination of whether misrepresentation has occurred is to be assessed considering the surrounding circumstances. The court was not constrained, in the same way as it would be in a trade mark infringement action, in the factors it could consider and allowed a consideration of extraneous factors. However, such misrepresentation "must have the effect of giving rise to actual confusion or a likelihood of confusion".[114]

20.104 As the High Court had concluded that there was no likelihood of confusion arising from the defendant's Advertisements in the trade mark infringement analysis, the High Court found that the claimant had not sufficiently proven that the defendant's Advertisements gave rise to actual confusion or a likelihood of confusion in the claim for passing off. Consequently, the second element of misrepresentation was not satisfied, and the claim for passing off had not been made out.

B. Infringement under ss 27(1) and 27(2): passing off

(1) Background

20.105 *Nalli Pte Ltd v Nalli Kuppuswami Chetti and Nalli Ramanathan*[115] involved a long-standing dispute between two branches of the Nalli family over the use of the name "NALLI" in their respective businesses selling sarees and other Indian clothing. The appellants were Nalli Pte Ltd ("NPL") and its directors, Dasarathan Madhavan ("Mr Madhavan") and Alluri Mahalakshmi Madhavan ("Mrs Madhavan"). The respondents were Nalli Kuppuswami Chetti and Nalli Ramanathan (trading as Nalli Chinnasami Chetty) and Nalli Chinnasami Chetty Pte Ltd ("NCCPL").

20.106 The dispute arose from competing uses of the name "NALLI" in Singapore, with both parties operating businesses under similar names. The respondents were registered owners of a stylised "NALLI" mark Nalli in Classes 24, 25 and 35. By virtue of a deed of settlement ("DS1"), the appellant NPL could register and use the mark "NALLI" only in the form of a composite mark bearing a woman's face. The "NALLI" sign used in the composite mark comprised the word "NALLI" with a candle motif instead of the letter "I", Nalli. The respondents claimed the appellants had infringed its trade mark by using the sign on NPL's signage, carrier bags, saree boxes, price cards and display cases.

114 *East Coast Podiatry Centre Pte Ltd v Family Podiatry Centre Pte Ltd* [2024] SGHC 102 at [109].

115 [2024] SGHC(A) 18.

20.107 The case centred on the interpretation of two deeds of settlement ("DS1" and "DS2") entered into by the parties in 1997, which were intended to resolve earlier disputes and provide a way for both parties to coexist in Singapore by allowing both parties to use the name NALLI in their respective businesses, and for the parties to register their respective trade marks.

20.108 The key issues before the Appellate Division of the High Court ("Appellate Division") were:

(a) Breach of the deeds of settlement: Whether NPL breached the terms of the deeds of settlement by using the name "Nalli" in a manner that is inconsistent with the agreements.

(b) Trade mark infringement: Whether NPL infringed NCCPL's registered trade marks by using a similar sign (*ie*, the stylised "Nalli" sign with a candle motif).

(c) Passing off: Whether NPL misrepresented itself as being associated with NCCPL, causing confusion among customers.

(d) Malicious falsehood: Whether NPL made false statements implying that NCCPL's products were not genuine.

(e) Personal liability: Whether the directors of NPL (*ie*, Mr Madhavan and Mrs Madhavan) were personally liable for the alleged torts.

(2) Decision of trial court

20.109 The trial judge ruled in favour of the respondents NCCPL in respect of *all* their claims against the appellants NPL and dismissed all the appellants' NPL counterclaims.[116]

(3) Appellate Division's decision

20.110 The Appellate Division reversed the trial judge's decision and held in favour of the appellants NPL. The appeal was largely allowed. The Appellate Division set aside the injunctions and orders made against NPL at the trial level.

116 The written judgment of the trial judge is found in *Nalli Kuppuswami Chetti and Nalli Ramanathan v Nalli Pte Ltd* [2022] SGHC 109.

(4) Interpretation of DS1 and DS2

20.111 Central to the Appellate Division's judgment in this case is the interpretation of the two deeds of settlements, DS1 and DS2. The main objective in the interpretation of a contractual agreement between parties is to objectively ascertain the expressed intentions of the parties. This is done by careful consideration by the courts of the interplay between the text and the relevant contextual points within which the agreement is entered into.[117] Applying this approach, the Appellate Division concluded that the text and the context together point against the conclusion reached by the trial judge and the arguments advanced by the respondents in the present appeal.

20.112 The Appellate Division found the wordings in the relevant clauses in DS2 to be clear. Clause 1 of DS2 captured a compromise between the parties, in that neither would have exclusive use of the word "NALLI", either as a trade mark or trade name. However, the breadth and latitude in cl 1 was then limited by the subsequent clauses in DS2. Specifically, cl 3 limited the respondent NCCPL to referring to itself as "Nalli Chinnasamy Chetty" and NCCPL could not describe itself merely as "NALLI". However, it is important to note that there was no such limitation or restriction imposed on the appellants NPL in DS2. The natural reading of DS2 was that each party was limited to using the trade and business names as expressly provided for in DS2 and not otherwise.

20.113 Consequently, the Appellate Division found that the appellant NPL did *not* breach the deeds of settlement. Clause 1 of DS2 allowed NPL to use "NALLI" as a trade name and trade mark, and there were no restrictions on how NALLI could be displayed as a trade name. The use of the candle motif sign in the word "NALLI" was not a breach, as it was decorative and not used as a trade mark on products or packaging.

(5) Infringement under s 27(1) of TMA

20.114 At first instance, the trial judge found the appellants' sign and the respondents' registered mark identical, as the visual differences were so insignificant that they would go unnoticed by the average consumer. The Appellate Division disagreed. Although it could be accepted that the two marks were aurally identical, there were however visual and conceptual differences. For example, the two marks were visually distinct in their forms, one () was thin and cursive, positioned at an angle and was black in colour whilst the other () was block face, in a thick bold

117 *Nalli Pte Ltd v Nalli Kuppuswami Chetti and Nalli Ramanathan* [2024] SGHC(A) 18 at [62].

font, horizontally placed and red, with the letter "I" taking the form of a candle and its flame. Also, the Appellate Division was of the view that the candle motif in the appellant's Nalli sign introduced a different concept. Considered from the perspective of the average consumer, all these differences could not be said to go unnoticed. Thus, the appellants' sign and the respondents' registered mark were *not* identical and the claim for trade mark infringement under s 27(1) of the TMA must fail.

(6) Infringement under s 27(2) of TMA

20.115 To succeed in a claim for trade mark infringement under s 27(2) of the TMA, a claimant must prove the following elements:[118]

(a) use by the defendant(s) of the sign within Singapore (or, in cases where the allegedly infringing signs are found on websites, that consumers within Singapore have been 'targeted' by those websites);

(b) in the course of trade;

(c) in a trade mark sense;

(d) without the consent of the plaintiff(s);

(e) a sign which is identical or similar to the registered mark;

(f) in relation to goods or services identical or similar to those for which the mark is registered; and

(g) a likelihood of confusion on the part of the public.

20.116 The key consideration before the Appellate Division was whether the appellant's sign, although found to be *not identical* to the respondent's trade mark, was however *similar* and was used in relation to goods or services identical with or similar to goods or services for which the marks/signs were registered/used, which gave rise to a likelihood of confusion on the part of the public.

20.117 At first instance, the trial judge found that the marks were, if not identical, at least similar. The Appellate Division disagreed. The marks-similarity inquiry begins with an assessment of the distinctiveness of the registered trade mark. On this issue, the Appellate Division concluded that the respondent's registered trade mark Nalli was *distinctive* on the grounds that (a) it had no meaning; and (b) it was not descriptive of the goods and services sold under the mark. As such, the threshold to find that the allegedly infringing sign, Nalli was *dissimilar* to the registered

118 *Nalli Pte Ltd v Nalli Kuppuswami Chetti and Nalli Ramanathan* [2024] SGHC(A) 18 at [104].

trade mark was *high*.[119] Considering the aural, visual and conceptual similarities between the marks, the Appellate Division concluded there was aural similarity between the sign and the registered trade mark as the aural characteristics of both marks were identical and they involved the same two-syllable word – "NALLI". As such, the pronunciations of both marks were also the same.

20.118 However, the Appellate Division found the overall visual impression of the two marks different, in terms of form, font and colour. Furthermore, the Appellate Division found the two marks conceptually different. The use of the candle motif in the appellant's Nalli sign conveyed a concept different from the respondent's Nalli mark. The choice of the candle, fire and light as well as the bright red font carry significance in Indian culture and the Indian community which was the target demographic for the appellant's products.

20.119 Considering all three aspects of similarity, the Appellate Division concluded the allegedly infringing sign *distinctive* from the respondent's trade mark. As the marks were *not similar*, the claim for trade mark infringement under s 27(2) of the TMA must also fail.

(7) Passing off

20.120 The Appellate Division found that NPL did not engage in passing off by (a) the usage of the word "branch" on the sign outside NPL's shop at 10 Buffalo Road; (b) the write-up on NPL's website; and (c) NPL's use of the song from the Tamil film "Remo". All in all, the Appellate Division found no actionable misrepresentation by NPL. The court's conclusion rested on the reputation of the two marks Nalli and Nalli, and that they were distinctive of the two businesses, as well as the existence of DS2 which represented an understanding and acceptance between the parties that there was no confusion between their marks, names and businesses. The coexistence of the two businesses for over 20 years reinforced the distinction between them.

(8) Malicious falsehood

20.121 The court ruled that the appellant was not liable for malicious falsehood. The statements made by NPL (*eg*, "Original Nalli Products") were not false or malicious but were intended to emphasise their own legitimacy in using the name "NALLI".

119 *Nalli Pte Ltd v Nalli Kuppuswami Chetti and Nalli Ramanathan* [2024] SGHC(A) 18 at [108].

(9) Personal liability

20.122 Since the appellants NPL were not found to be liable for any torts, the Appellate Division held that Mr and Mrs Madhavan were not personally liable.

20.123 This case highlights the importance of clear contractual terms in settlement agreements, especially in intellectual property disputes. This case also demonstrates that coexistence of similar trade names is possible if there is no likelihood of confusion among consumers. The decision underscores the need for businesses to act in good faith and avoid making false or misleading statements about their competitors. The Appellate Division urged both parties to work towards a compromise to avoid further disputes and focus on their respective businesses.
