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20. INTELLECTUAL PROPERTY LAW

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I. Copyright

A. The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd – *Ownership of Copyright in Photographs – Implied Licence – Copyright Infringement*

20.1 The decision in *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd*[2] was handed down in March 2022 by Mavis Chionh Sze Chyi J. Between 1995 and 2008, the plaintiffs ("Wave") provided branding, design and marketing services to the hotels and resorts managed by the defendant companies ("GHM") and were involved in taking and editing photographs of these hotels and resorts. Wave claimed that:[3]

> … some years after the termination of their working relationship with these hotels and with the defendants, they discovered that these photographs were featured in multiple online issues of the defendants' magazine. In the absence of a formal copyright agreement between the parties, the parties sought the court's determination as to whether ownership of the copyright in these photographs had been vested in the plaintiffs or in the hotels, and whether the defendants were permitted to continue using these photographs after the termination of the working relationship with the plaintiffs.

1 The authors would like to thank Bryan Tan Zhi Yang for his valuable research assistance in the writing of this Ann Rev chapter. The authors remain solely responsible for all omissions, inaccuracies and errors in this review.
2 [2022] SGHC 142.
3 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [2].

The court ruled in favour of Wave, granting, *inter alia*, declaratory relief on the ownership of copyright, injunction against GHM and their officers, employees *etc* in respect of further copyright infringements, damages and orders for delivery up of all infringing copies.

20.2 GHM manages, operates and promotes luxury hotels and resorts all over the world; and the various Wave entities, including The Wave Studio Pte Ltd and The Wave Studio LLC, all set up by an entrepreneurial artist and creative designer Lee Kar Yin – also named as a plaintiff – provided their services to a number of these hotels and resorts.

20.3 Lee – as well as the Wave entities – were engaged by GHM to provide an array of services to the hotels which included the production of marketing, branding and promotional materials ("marketing collaterals") for the hotels.[4] Lee was involved in planning, styling and directing the hotel photoshoots, although she did not take the photographs herself. The raw images which underwent this editing process were referred to by parties as "the Final Photographs"; whereas the term "Hotel Photographs" was used to refer collectively to the raw images and the Final Photographs. After this editing process, CD-ROMs containing the Final Photographs would be delivered to the defendants and the relevant hotels.[5]

20.4 According to Lee, sometime in 2012, she discovered that:[6]

> … some of the Hotel Photographs had appeared on the websites of several online travel agencies. Subsequently, between 18 January 2013 and 30 June 2013, she discovered that the Hotel Photographs had appeared on 242 instances in Issues 1 to 12 of GHM's in-house production, 'The Magazine', which she found she could access and download on GHM's website.

20.5 The issues before the court were as follows:[7]

> (a) Whether the plaintiffs owned the copyright in the Hotel Photographs;
>
> (b) Whether the defendants had an implied licence to use the Hotel Photographs for general branding, marketing and advertising purposes;
>
> (c) Whether the defendants had infringed the copyright in the Hotel Photographs; and

4 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [10].

5 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [13].

6 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [16].

7 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [27].

(d) Whether the defences of laches, acquiescence and estoppel by convention were available to the defendants.

(1) Ownership of copyright

20.6 Chionh J held that the subject matter of this dispute – photographs – falls into the category of "artistic works" as *per* s 7 of the Copyright Act.[8] Where copyright arises in artistic works, s 26(1)(*b*) of the Copyright Act:[9]

> … confers the exclusive right to reproduce the work in a material form, to publish the work (if it is unpublished) in Singapore or in any country in relation to which the Act applies and/or to communicate the work to the public.
>
> Under the Copyright Act, the default rule for copyright ownership in an artistic work such as a photograph is that the author of the work shall be entitled to any copyright subsisting in the work[10] …

20.7 The Wave entities had engaged two photographers to take the hotel photographs in 2007. Pursuant to s 7(1) of the Copyright Act, the author of a photograph is "the person who took the photograph", and Chionh J was satisfied that Masano Kawana and Lim See Kong – as the persons who had taken the photographs at the hotel photo-shoots – were the authors of the raw images.

20.8 According to s 30(2) of the Copyright Act, the first owner of the copyright in an artistic work such as a photograph is the author of that work – but this position is subject to ss 30(5) and 30(6), which allow for copyright ownership to pass to another subject to a specific agreement under which the work is made, such as an employment agreement.

20.9 Regarding the photographs taken by Lim, the court found that the evidence was sufficient to establish that Lim had taken the photographs in pursuance of the terms of his employment by Wave under a contract of service. Accordingly, applying s 30(6) of the Copyright Act, Wave was the owner of the copyright in the raw images taken by Lim.[11]

20.10 Regarding the raw images taken by Kawana, the evidence showed that he was engaged by Wave as the photographer for the various hotel photoshoots over the years; all estimates and invoices were made

8 Cap 63, 2006 Rev Ed.

9 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [30]–[31].

10 Copyright Act (Cap 63, 2006 Rev Ed) s 30(2).

11 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [40].

out to Wave, payments were effected by Wave, and the defendants never received any invoices from Kawana. Chionh J reiterated that:[12]

> … [t]he law is clear that where no direct contractual relationship exists between the alleged commissioning party and the person who takes the photographs, the former does not in such a situation acquire the copyright in the photographs under s 30(5) of the Copyright Act.

Based on the evidence adduced, it was clear that it was Wave who had commissioned Kawana to take the raw images at the hotel photoshoots; hence, under s 30(5) of the Copyright Act, Wave owned the copyright in the raw images taken by Kawana.

20.11 Regarding the issue of ownership of the copyright in the Final Photographs:[13]

> … [i]t was not seriously disputed that the process of curation and editing constituted a sufficiently material alteration of the Raw Images such that Ms Lee (or Ms Lee and the other Wave employees who worked with her on the Final Photographs) would be considered the author of the Final Photographs.

20.12 In sum, the plaintiff asserted that "the Wave entities owned the copyright in 2381 Final Photographs taken in 29 photoshoots from the period of December 2000 to October 2007".[14] But the defendants argued that:[15]

> … while Ms Lee was the author of the Final Photographs, s 30(5) of the Copyright Act applied so as to vest in the Hotels ownership of the copyright in the Final Photographs … because it was the Hotels who had commissioned the plaintiffs to produce the photographs.

In finding for the plaintiff, Chionh J held that the agreement between Wave and the hotels was not an agreement for the taking of photographs.

20.13 Critically, "in order for s 30(5) of the Copyright Act to apply in the case of photographs, the party purporting to rely on it (the alleged commissioning party) must have made an agreement for valuable

12 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [43], citing *Wang Choong Li v Wong Wan Chin* [2015] 4 SLR 41 at [61]–[64].

13 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [46].

14 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [48].

15 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [49].

consideration with the photographer 'for the taking of a photograph'".[16] In the present case, having examined the evidence, Chionh J:[17]

> … agreed with the plaintiffs that the agreement between Wave and the Hotels was not an agreement for the taking of photographs. Rather, it was an agreement for Wave to operate as a 'one-stop shop' for the Hotels, providing branding, design and marketing services of which photography constituted but one supporting function.

20.14 The evidence also showed that the Final Photographs were produced for *use in the marketing and promotional materials created by Wave* for the hotels, and "photography was not what Wave was hired to do".[18] Lee gave evidence to this effect, and her evidence was corroborated not only by the plaintiffs' other witnesses, but also by the defendants' witnesses. Thus, copyright remained with Wave.

20.15 The plaintiffs also argued in the alternative that:[19]

> … s 30(5) had no application in this case because the Final Photographs did not constitute 'photographs' within the definition given by s 7 of the Copyright Act. According to the plaintiffs, the Final Photographs – having been created as a result of extensive editing and manipulation of the Raw Images – could no longer be regarded as 'photographs' insofar as a photograph was understood to involve the 'capturing or recording of light on a particular medium'.

But given the findings the court had made in respect of the agreement between Wave and the hotels, Chionh J did not find it necessary to make any ruling on this issue.

20.16 Chionh J added that "even assuming the agreement between Wave and the Hotels was an agreement for the taking of photographs, … the operation of s 30(5) had been excluded by agreement between the parties *per* s 30(3) of the Copyright Act", because the defendants had accepted Wave's reservation of copyright in the Final Photographs;[20] a reservation clause was present in all of the production estimates issued

16 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [50].
17 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [50].
18 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [60].
19 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [61], citing *Singsung Pte Ltd v LG 26 Electronics Pte Ltd* [2016] 4 SLR 86 at [106].
20 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [62].

by Wave from the very outset when it started working with the hotels.[21] It did not appear to the court that the hotels would have found Wave's reservation of copyright in the Final Photographs to be commercially "unworkable" or "impossible".[22] Chionh J noted that:[23]

> … even if all the personnel from the Hotels and from GHM failed to read the Reservation Clause throughout the 13 years of their interaction with Wave, the law is clear that failure by a contracting party to read or to understand a term of a contract will not preclude such a party from being bound by the term.

20.17 Lastly, on the facts, the conclusion that Wave owned the copyright in the Final Photographs was bolstered by contemporaneous evidence of the parties' conduct which demonstrated members of the defendants' senior management team acknowledging on more than one occasion that the copyright resided with Wave and not with the hotels.[24]

20.18 In conclusion:[25]

> … the assignments of the Wave-S Copyright, the Wave PL Copyright and the Wave Studio Singapore Copyright to the third plaintiff [that is, The Wave Studio US] did include assignment of the right to sue for past infringements of these copyrights. In the premises, [the court] was satisfied that the third plaintiff was the present owner of the copyright in the Hotel Photographs.

Chionh J also rejected the defendants' submissions on an "implied assignment" of copyright to the owners of the hotel, commenting that "[t]o imply a term into the agreement whereby the copyright in the photographs was assigned to the Hotels would be directly to contradict this express reservation of copyright by Wave".[26] Borrowing the words of the Court of Appeal in *Sembcorp Marine Ltd v PPL Holdings Pte Ltd*[27] ("*Sembcorp Marine*"), the court noted that such a term would "necessarily fail the officious bystander test".[28]

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21 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [66].

22 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [76].

23 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [78], citing *Bintai Kindenko Pte Ltd v Samsung C&T Corp* [2019] 2 SLR 295 at [58]–[59].

24 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [83].

25 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [102].

26 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [107].

27 [2013] 4 SLR 193 at [98].

28 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [107].

(2) Implied licence to use the hotel photographs for general branding, marketing and advertising purposes

20.19 As an alternative to their case that the hotels owned the copyright in the hotel photographs, the defendants contended that the second defendant and/or the owners of the hotels had an implied licence granted by Wave to "use the Hotel Photographs for general branding, marketing and/or advertising purposes".[29] The court referred to the principles articulated in *Sembcorp Marine* for considering the implication of terms in a contract, as well as the principles laid down in the judgment of Lightman J in *Robin Ray v Classic FM plc*[30] ("*Robin Ray*").

20.20 Applying the principles established in *Sembcorp Marine* and *Robin Ray* to the present case, Chionh J held that there was "no basis for implying that the Hotel owners and/or the second defendant had a 'perpetual and unrestricted' implied licence from Wave to use the Hotel Photographs for general branding, marketing and/or advertising purposes".[31] In particular, as evident in the agreement between Wave and the hotels, "the parties' intention was clearly for Wave to use the Final Photographs it had created in the marketing and promotional materials it produced for the Hotels – and not for Wave to create the photographs for use by any vendor that the Hotels might choose to go to".[32] Her Honour also accepted that provision of the CD-ROMs to the hotels and GHM did not constitute an implied licence; it served a two-fold purpose as "proof of the work done during the photoshoots", and "as a catalogue of the photographs generated during a particular project by Wave, from which the Hotels and/or GHM could review the Hotel Photographs and select the photographs that they wanted to feature or incorporate into the design of the marketing collaterals".[33]

20.21 Regarding the permitted use by Lee of the photographs in a number of magazines – "Interior Design", "American Airlines" and "Conde Nast Traveler" – the court was satisfied that Wave had refrained from charging a licence fee because of the perceived "good advertising"

29 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [117].
30 [1988] ECC 488.
31 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [122].
32 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [124].
33 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [127].

value of having Wave's photographs featured in these publications.[34] These isolated uses did not prove that Wave had allowed the hotels and/or the second defendant to use the hotel photographs for their general branding, marketing and/or advertising purposes without obtaining Wave's consent and without paying a licence fee.[35]

(3) Copyright infringement

20.22 The defendants' case at trial focused on the issues of who owned the copyright in the photographs; and alternatively, whether the Hotels and/or the second defendant had an implied licence to use them. The allegedly infringing acts were not disputed, and since Chionh J had rejected the defendants' case on copyright ownership and implied licence, the court was satisfied that infringement of the plaintiffs' copyright was made out.

(4) Defences of laches, acquiescence and estoppel by convention

20.23 All the defences were dismissed by the court.

20.24 The court emphasised that the doctrine of laches is:[36]

> … properly invoked where essentially there has been a substantial lapse of time coupled with circumstances where it would be practically unjust to give a remedy either because the party has by his conduct done that which might fairly be regarded as equivalent to a waiver thereof; or where by his conduct and neglect he had, though perhaps not waiving that remedy, yet put the other party in a situation in which it would not be reasonable to place him, if the remedy were afterwards to be asserted.

In the present case, Chionh J found that the second defendant could not even cross the first hurdle of establishing inordinate delay by the plaintiffs.

20.25 As to the defence of acquiescence, Chionh J, citing precedent from the Court of Appeal and High Court, elaborated as follows:[37]

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34 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [137]–[138].

35 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [136]–[139].

36 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [167], citing *Cytec Industries Pte Ltd v APP Chemicals International (Mau) Ltd* [2009] 4 SLR(R) 769 at [46] and *Chng Weng Wah v Goh Bak Heng* [2016] 2 SLR 464 at [44].

37 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [184], citing *Tan Yong San v Neo Kok Eng* [2011] SGHC 30 at [112]. See also *Genelabs Pte Ltd v Institut Pasteur* [2000] 3 SLR(R) 530.

> The term acquiescence is … properly used where a person having a right and seeing another person about to commit, or in the course of committing an act infringing that right, stands by in such a manner as really to induce the person committing the act and who might otherwise have abstained from it, to believe that he consents to it being committed; a person so standing by cannot afterwards be heard to complain of the act. In that sense the doctrine of acquiescence may be defined as quiescence under such circumstances that assent may reasonably be inferred from it and is no more than an instance of the law of estoppel words or conduct.

However, on the facts, Chionh J rejected the defendants' argument that the enumerated incidents demonstrated the plaintiffs' knowledge of the hotel photographs being used and their failure to collect licence fees or otherwise to assert their copyright amounted to acquiescence.

20.26 As for estoppel by convention, Chionh J held that the law requires that for this defence to apply, "parties must have acted on an incorrect assumption of law or fact which both sides must have shared or acquiesced in; further, that the party seeking to rely on this defence must show that it is unjust or unconscionable to allow parties to go back on the said assumption".[38] While the defendants had pleaded in its defence that it and the plaintiffs had "acted on the assumption that the Hotel Photographs could be used by the 2nd Defendant for general branding, marketing and/or advertising purposes", Chionh J noted that, "[o]ddly, in their closing submissions, the defendants did not specifically address the defence of estoppel by convention".[39] In any event, the defence would have failed. At the time of writing, the case has gone on appeal.

II. Geographical indications

B. Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco – *Grounds for refusal of registration – Opposition to registration*

20.27 In *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco*,[40] the Consorzio di Tutela della Denominazione di Origine Controllata Prosecco ("the Consorzio")

38 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [187], citing *Independent State of Papua New Guinea v PNG Sustainable Development Program Ltd* [2020] 2 SLR 200 at [49].

39 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [189].

40 [2022] SGHC 33.

applied to register "Prosecco" as a geographical indication ("GI") denoting wines originating from a specified region in Northern Italy ("the Application GI") in respect of wines in Singapore. However, Australian Grape and Wine Incorporated ("AGWI"), which is the representative body for grape growers and winemakers in Australia, filed a notice of opposition against the registration of the Application GI.

20.28 AGWI relied on two grounds in its opposition to the registration:

(a) s 41(1)(*a*) of the Geographical Indications Act 2014[41] ("GIA"), that the Application GI did not fall within the meaning of "geographical indication" as defined in s 2(1) of the GIA; and

(b) s 41(1)(*f*) of the GIA, that the Application GI contained the name of a plant variety and was likely to mislead the consumer as to the true origin of the product.

20.29 In May 2021, the Principal Assistant Registrar ("PAR") dismissed AGWI's opposition and ordered that the Application GI should proceed to registration. AGWI appealed the PAR's decision, and the General Division of the High Court ("High Court (General Division)") allowed AGWI's appeal on the basis of s 41(1)(*f*) of the GIA but not s 41(1)(*a*) of the GIA.

20.30 Valerie Thean J first referred to the historical origins of wine regulation in France and how the tradition to mandate quality-related criteria, such as the controlled planting and cultivation of vines and their yields, eventually evolved into a basis for delimiting the products whose quality was attributable to their specific region of production.[42] Her Honour observed:[43]

> Not all geographical locations serve to indicate specific reputational characteristics of a product. Conversely, not all geographical indications need be names of geographical locations; non-geographical names may, through tradition, nevertheless function to identify a product's geographical source.

More importantly, within each jurisdiction, protection depends upon the specific legal framework in place, and "[w]hether a sign functions as a geographical indication is a matter of national law".[44]

41 Act 19 of 2014.

42 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [1].

43 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [1].

44 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [4].

20.31 The claimed geographical area for the production of "Prosecco" wines by the Consorzio was "the North East region of Italy, and include[d] the entire territory of Belluno, Gorizia, Padova, Pordenone, Treviso, Trieste, Udine, Venice and Vicenza"[45] ("the Specified Region").

(1) Section 41(1)(f) of the Geographical Indications Act

20.32 Section 41(1)(*f*) contains two conjunctive requirements, namely that the Application GI (a) contains the name of a plant variety; and (b) is likely to mislead the consumer as to the true origin of the product. Thean J held that the emphasis of the first limb is factual – whether the GI "*contains* the name of a plant variety or an animal breed" [emphasis in original] – and that the perspective of the Singapore consumer is relevant only to the second limb.[46] The court agreed with the Consorzio's submission that the phrase "the name of a plant variety or an animal breed" should bear the same meaning in both ss 41(1)(*f*) and 15(*b*) of the GIA, but rejected the Consorzio's assertion that it would inevitably "lead to incongruous and unreasonable outcomes if the first limb of s 41(1)(*f*) of the GIA were satisfied simply because a GI contained the name of a plant variety or animal breed in *some or any country*" [emphasis in original].[47]

20.33 Thean J emphasised that "[t]he object of the statutory scheme is to ensure that the registration of a GI is not misleading, not only at the point of registration but also post-registration"; hence, "s 15(*b*) of the GIA would permit any use of registered GIs in the course of trade *as a plant variety*, as such use would be appropriate use, and not misuse" [emphasis in original].[48] Even if "Prosecco" were registered as a GI, s 15(*b*) of the GIA would serve "to limit the Consorzio's ability to use the remedies provided for under Part II of the GIA where 'Prosecco' is used in the course of trade *as a plant variety*" [emphasis added].[49]

20.34 In summary, "whether the term 'Prosecco' was the name of a plant variety was simply a matter of objective fact",[50] and Thean J held that "the PAR was correct to find that 'Prosecco' was the name of a grape variety

45 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [6].
46 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [17].
47 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [19].
48 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [20].
49 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [20].
50 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [21].

as at the Relevant Date,[51] in view of the extensive evidence adduced by AGWI in support of this proposition".[52] Even though the grape variety was renamed from "Prosecco" to "Glera" in the European Union ("EU"), the court was satisfied that there was "a wealth of evidence which showed that 'Prosecco' *remained* the name of a grape variety outside the EU as at the Relevant Date" [emphasis in original].[53] Pertinently, wine merchants in Singapore also referred to "Prosecco" as a grape variety.[54] The court found that "AGWI had proven that 'Prosecco' was the name of a grape variety as at the Relevant Date, such that the Application GI contained the name of a plant variety for the purposes of the first limb of s 41(1)(*f*) of the GIA".[55]

20.35 Regarding the second limb, the relevant question was:[56]

> … whether the Application GI was likely to mislead consumers into thinking that 'Prosecco' wines *could only originate from the Specified Region*, when in fact their true origin could be other geographical locations where the 'Prosecco' grape variety was used to make wines. [emphasis in original]

Thean J noted that "this approach cohered with the 'essential function' of a GI, which was 'to guarantee to consumers the geographical origin of the goods and the specific qualities inherent in them'".[57] Moreover, such an approach would be consistent with the position adopted in EU law, which was relevant to the interpretation of the GIA since s 41(1)(*f*) of the GIA was adapted from, and is largely *in pari materia* with, Art 6(2) of EU Regulation 1151.[58]

20.36 The relevant question framed by s 41(1)(*f*) of the GIA was "whether, *if* the Application GI was not refused registration as a GI, the

51 The Relevant Date was 3 May 2019.

52 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [22].

53 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [24].

54 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [24].

55 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [26].

56 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [34].

57 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [34], citing *The Tea Board v European Union Intellectual Property Office (EUIPO)* [2018] Bus LR 1095 at [56].

58 Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs. See *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [35].

Application GI was likely to mislead the consumer as to the true origin *of any wine marked as 'Prosecco'*" [emphasis in original].[59] At the Relevant Date, as a finding of fact, "'Prosecco' grapes were being cultivated and 'Prosecco' wines were being produced in commercial quantities in countries such as Australia".[60] Consumers were likely to be "misled by the Application GI into thinking that *all* 'Prosecco' wines originated from the Specified Region in Italy, when in fact *some* 'Prosecco' wines originated from Australia".[61] The Application GI was too broad, compared to the other registered GIs such as "Conegliano Valdobbiadene – Prosecco", "Conegliano – Prosecco" and "Valdobbiadene – Prosecco" which specified the particular towns in Italy as to the true origin of the products they were used to designate.[62] Thean J was of the view that "the 'product' as to whose true origin consumers might be misled under s 41(1)(*f*) of the GIA had to refer to the entire class of products to which the GI was to be applied, *ie*, all 'Prosecco' wines".[63]

*(2) Section 41(1)(*a*) of the Geographical Indications Act*

20.37 Section 41(1)(*a*) of the GIA provides that indications which do not fall within the meaning of "geographical indication" as defined in s 2(1) of the GIA shall not be registered. Thean J held that a plain reading of this first limb of s 2(1) of the GIA simply required that a GI be "*any* indication used in trade to identify goods as originating from a place" [emphasis in original].[64] On the available evidence, "'Prosecco' was an indication used in trade to identify wines originating from the Specified Region";[65] it was also valid as a GI in a range of other jurisdictions outside the EU, either through trade agreements or through national registration.

20.38 The critical issue before the court regarding s 41(1)(*a*) of the GIA was whether "a given quality, reputation or other characteristic of the goods is essentially attributable to that place", as required in limb (*b*) of

59 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [40].
60 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [37].
61 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [37].
62 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [38].
63 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [39].
64 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [51].
65 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [51].

the definition of a "geographical indication" in s 2(1) of the GIA.[66] Two assertions were open to challenge: "first, that the specified characteristics attach to the entirety of the Specified Region; and second, that the resulting product is not found elsewhere".[67]

20.39 In its opposition, AGWI pointed to the "lack of consistency in the terrain, climate and production methods in the Specified Region, and contended that the common factor to the product specified was solely attributable to the grape variety used".[68] AGWI also pointed generally to the "significant quantities of Australian 'Prosecco' exported to the Singapore market".[69] However, Thean J rejected these contentions as AGWI did not adduce "expert factual evidence" by wine experts; hence, AGWI failed on its opposition pursuant to s 41(1)(*a*) of the GIA.[70]

20.40 Nevertheless, since ss 41(1)(*f*) and 41(1)(*a*) of the GIA are "disjunctive and independent grounds for the refusal of registration",[71] Thean J allowed the appeal on the basis of s 41(1)(*f*) of the GIA.

III. Patents

C. Nippon Shinyaku Co, Ltd v Registrar of Patents – *Correction of error under rule 91(1) of Patents Rules* – Dukhovskoi *two-step test*

20.41 In *Nippon Shinyaku Co, Ltd v Registrar of Patents*,[72] the applicant of a patent ("the Applicant") appealed against the decision of the Registrar of Patents ("the Registrar") refusing a request to correct the specification of the patent application filed in Singapore.

20.42 The Applicant, a company incorporated in Japan, filed a patent application in Japan ("the Japanese patent application"). Sometime in 2019, the Applicant filed a Patent Cooperation Treaty ("PCT") application.

66 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [53].
67 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [54].
68 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [55].
69 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [55].
70 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [56].
71 *Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] SGHC 33 at [57].
72 [2022] SGHC 164.

Subsequently, in 2020, the PCT application entered the national phase in Singapore as a Singapore patent application ("the Singapore patent application"). The PCT application as well as the Singapore patent application claimed priority of the Japanese patent application. Having discovered an error in Table 7 of the verified translation of the PCT application filed with the Intellectual Property Office of Singapore ("IPOS"), the Applicant sought to correct the error under r 91(1) of the Patents Rules.[73] However, the request to correct the error was rejected by the IPOS, acting in its capacity as the Registrar.

20.43 Under the two-step test that was set out in *Dukhovskoi's Application*[74] ("*Dukhovskoi*"), the Applicant must show that (a) there was clearly an error; and, if so, (b) it is now unclear that what is now offered is not what was originally intended. IPOS found that the first step was satisfied as there were clearly errors in Table 7. However, the second step was not satisfied because it was not always the case that when an application claims priority from a foreign application, as in this case, one would expect the application to be *identical* to the priority application. Even if the skilled addressee would think it was more likely than not that the intention was for Table 7 of the Singapore patent application to be identical to the Japanese patent application, this alone was insufficient to meet the second step under the *Dukhovskoi* two-step test. As such, the requirements for a correction to be made under r 91(2) of the Patents Rules were not made out and the request to correct had to be denied. The Applicant appealed, seeking an order that the decision from the IPOS be reversed in part, specifically that the proposed correction to Table 7 of the Singapore patent application be allowed.

(1) Who was the proper party to be named as the respondent in the present appeal – The Intellectual Property Office of Singapore or the Registrar?

20.44 The Applicant contended that the IPOS was the proper party to be named as respondent because it is a body corporate; as such, it is capable of being sued in its own name and any relief sought can be granted by the IPOS acting in its official capacity as the Registrar. On the other hand, the respondent argued that it was the Registrar who was the proper party to be named as it is the Registrar who is conferred the power to correct patent applications by Parliament and had accordingly made the decision to deny the request to correct.

73 Cap 221, R 1, 2007 Rev Ed.
74 [1985] RPC 8.

20.45 On this procedural point, Lee Seiu Kin J held that the proper party to be named as respondent in the present appeal was the Registrar. The learned judge based his decision on the statutory provisions which draw a distinction between the IPOS and the Registrar,[75] and their respective different powers.[76] Since the Applicant in the present case was appealing against a decision of the Registrar that was made pursuant to s 107(1) of the Patents Act 1994,[77] which confers upon the Registrar the power to correct errors in patent applications (which the Registrar had refused to do), it followed that the Registrar who had made the decision to deny the request to correct the error had to also be the proper party to this present appeal.

(2) Should the Applicant's request to correct the error in the Singapore patent application be allowed?

20.46 The error in the Singapore patent application which the Applicant was seeking to correct involved the description of the invention which was part of the patent specification. The governing provisions in the Patents Act are found in s 107, which confers on the Registrar the power to grant a correction, and r 91 of the Patents Rules relating to formalities and substance conditions that must be fulfilled before a correct request may be granted. Specifically, r 91(2) mandates that "where such a request relates to a specification, no correction shall be made therein *unless the correction is obvious* in the sense that it is immediately evident that *nothing else would have been intended than what is offered* as the correction" [emphasis added].

20.47 Lee J took the opportunity to set out the relevant legal principles on the subject matter of correction of errors in the patent specifications and amendments to the patent specifications. First, a strict approach is to be taken to the correction of errors in patent specifications. Such an approach is necessary as the statutory provisions on correction of errors in the Patents Act do not impose a restriction not to add subject matter which may result in an extension to the patent protection conferred in such cases, quite unlike the case of an amendment of the patent specification where such limitations are explicitly set out in the statutory provisions. Second, the party asking for the Registrar to grant the correction request bears the burden of proof to show that the correction is justified. The

75 See ss 106, 2(1), 34(2), 34(3) of the Patents Act 1994 (2020 Rev Ed). See also ss 34(2) and 34(3) of the Intellectual Property of Singapore Act 2001 (2020 Rev Ed).
76 See ss 103(2) and 107 of the Patents Act 1994 (2020 Rev Ed).
77 2020 Rev Ed.

learned judge further held that the two-step test in *Dukhovskoi*[78] was applicable.[79]

20.48 A survey of authorities showed that, where the correction request involves the replacement of the *entire* specification, *no reference* can be made to the priority document to prove the second step.[80] This bar should not be extended to where the correction does *not* involve replacement of the entire specification. Where the error relates to *data that is included in the specification itself*, it is more likely to be the result of an error rather than a conscious act of judgment by the drafter. In contrast, if the error is in the substantive *content* of the specification (rather than instrumental analytical data), it may *not* be immediately obvious to a skilled observer that the proposed correction was what was initially intended.[81]

20.49 In the present case, it was common ground that the first step was satisfied and only the second step was in dispute. As the Applicant was not seeking to replace the entire specification, it was relevant to consider the priority documents. The present error related to data that was included in the specification. Having described the invention in detail, the patent specification then provided instrumental analytical data such as mass spectrometric and elemental data. Thus, the differences between the priority application and the present specification were more likely to be the result of an error rather than a conscious act of judgment by the drafter. As such, the court was satisfied it would have been immediately obvious to the skilled observer, looking at the priority document, that nothing else other than the proposed correction could have been intended. The wrong set of data had been copied over. The data that should have been in the specification was exactly that which was in the priority document. Accordingly, the court allowed the appeal for correction to be made to the PCT application.

IV. Trade marks

20.50 For trade marks, this edition of the review will cover four decisions from the High Court (one of which is delivered by the Appellate Division of the High Court ("High Court (Appellate Division)")) and one decision from the IPOS.

78 See para 20.43 above.
79 *Nippon Shinyaku Co, Ltd v Registrar of Patents* [2022] SGHC 164 at [32].
80 *Nippon Shinyaku Co, Ltd v Registrar of Patents* [2022] SGHC 164 at [37]–[43].
81 *Nippon Shinyaku Co, Ltd v Registrar of Patents* [2022] SGHC 164 at [50].

D. TMRG Pte Ltd v Caerus Holding Pte Ltd – *Trade mark infringement – Passing off*

20.51 In *TMRG Pte Ltd v Caerus Holding Pte Ltd*,[82] the dispute centred on the common use of the name "Luke's" for the parties' dining establishments. The appellants' establishment was known as "Luke's Oyster Bar & Chop House" whilst the respondents' was called "Luke's Lobster". In April 2018, the respondents applied to register their trade marks "Luke's Lobster" and were granted registration. The appellants did not file an opposition to the respondents' trade mark application. The appellants' action for trade mark infringement, passing off and invalidity of the respondents' marks failed before the High Court where Andre Maniam JC delivered the decision.[83] The appellants appealed and the High Court (Appellate Division), comprising Belinda Ang Saw Ean JAD, Woo Bih Li JAD and See Kee Oon J, heard the appeal. The High Court (Appellate Division) unanimously dismissed the appeal.

(1) Did the respondents infringe the appellants' trade marks under section 27(2) of the Trade Marks Act?

20.52 In the marks-similarity inquiry, it is settled law that a comparison is made "mark-for-mark without consideration of any external matter".[84] Applying the law to the case, the three-member High Court (Appellate Division) found no reason to disturb the High Court (General Division)'s reasoning.

20.53 Viewed as a whole, the competing marks were clearly differentiated in the visual, aural and conceptual sense. The High Court (Appellate Division) pointed out that the problem with the appellants' arguments on distinctiveness was that their registered trade mark was not "Luke's" *simpliciter*. Instead, it was a mark comprising nine words: "Luke's Oyster Bar Chop House Travis Masiero Restaurant Group". In fact, the appellants' nine-word registered trade mark was not used exclusively as they also used an unregistered seven-word logo without the last two words "Restaurant Group".

20.54 A substantial part of the appellants' arguments was premised on the principle of acquired distinctiveness and that the appellants' dining establishments were being known as "Luke's" *simpliciter*. However, the

82 [2022] SGHC(A) 4.

83 *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2021] SGHC 163. The analysis of this decision may be found at (2021) 22 SAL Ann Rev 567 at 587–595.

84 *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2022] SGHC(A) 4 at [4]. See *Han's (F & B) Pte Ltd v Gusttimo World Pte Ltd* [2015] 2 SLR 825 at [105] and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 at [105].

High Court (Appellate Division) found the appellants' arguments on acquired distinctiveness to be misplaced. This was because "Luke's" *simpliciter* was never used in the appellants' marketing or business material, and any limited use on their shopfront and their cutlery was also inconsistent. The High Court (Appellate Division) found that the inconsistent usage of "Luke's" *simpliciter*, the composite nine-word registered mark as well as the unregistered logo in various forms compromised the appellants' trade mark infringement claim.

20.55 It should be noted that even if distinctiveness was found in any dominant component of a mark, this "must ultimately be related back to the impression given by the mark as a whole".[85] Therefore, the string of words in the appellants' nine-word trade mark and the unregistered logo had to be read as a whole and considered in this way; they did not merely perform a purely descriptive function. The words in the composite mark constituted the appellants' brand and served to differentiate the appellants' brand of dining establishments from those of others bearing the same name.

20.56 Finally, the High Court (Appellate Division) made an important point on commonly used personal names and acquired distinctiveness. In general, commonly used personal names are not particularly distinctive.[86] In this case, "Luke" was not a distinctive or uncommon personal trading name. The fact of long user or substantial revenue did not, without more, advance the appellants' case on acquired distinctiveness.

20.57 In respect of the confusion inquiry, the right test is whether there is confusion at the point of purchase.[87] Once again, the appellants relied on the purported distinctiveness and the dominance of the "Luke's" *simpliciter* component in the registered composite mark and their unregistered logo. To further substantiate their arguments, the appellants adduced survey evidence which was rejected by the High Court. At the appeal, the court found that the appellants failed to address the problems raised in the High Court's analysis in terms of the reliability and methodology of their survey evidence. Although some e-mails and Facebook posts were potentially admissible, they did not assist the appellants. At best, they merely showed initial interest confusion. The appellants and respondents provided similar services but had different target customer bases, price ranges and menus. In fact, the High Court (Appellate Division) noted that lobster-related dishes only comprised 5% of the appellants' total revenue, suggesting the appellants had overstated the possibility of confusion.

85 *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2022] SGHC(A) 4 at [7].
86 *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2022] SGHC(A) 4 at [8].
87 *TMRG Pte Ltd v Caerus Holding Pte Ltd* [2022] SGHC(A) 4 at [11].

20.58 Further, the court noted that the appellants failed to file their opposition when the respondents first applied for trade mark registration, again suggesting that "Luke's" *simpliciter* was not as important to the appellants or distinctive in their branding as they had contended.

(2) Passing off

20.59 In respect of the passing off claim, the issues before the High Court (Appellate Division) were as follows:

(a) Did the Appellants have goodwill in its restaurant?

(b) Was there misrepresentation by the Respondents?

(c) Was there damage to the Appellants' goodwill?

(d) Were defences applicable?

The High Court (Appellate Division) of the High Court upheld the factual and legal findings of the High Court (General Division) on all elements of passing off.

20.60 On the first element of goodwill, the High Court (Appellate Division) found that "Luke's" *simpliciter* was not distinctive, and the appellants had no goodwill associated in the name. The appellants' goodwill was associated with their restaurants being known as oyster bars and chop houses. On the second element of misrepresentation, the High Court (Appellate Division) upheld the High Court (General Division)'s finding that initial interest confusion is insufficient for both passing off and trade mark infringement. On the third element of damage, the High Court (Appellate Division) upheld the High Court (General Division)'s reasons for rejecting the various alleged heads of damage, including direct loss of sales, blurring and tarnishment, restriction on expansion, and loss of exclusivity.

20.61 As in the court below, it was not necessary for the High Court (Appellate Division) to decide whether the "own name" defence operated in passing off; even if it did, the court accepted that the use of the respondents' name was an honest and *bona fide* practice. The respondents' name was used to trade in the US since 2009 and was not calculated to deceive customers.

E. Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel – *Trade mark registration – Opposition under sections 8(2)(*b*) and 8(7)(*a*) – Distinctiveness and marks-similarity assessment*

20.62 In *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel*,[88] the plaintiff (Combe International Ltd) and the defendant (Dr August Wolff Group) were competitors in the market for intimate care products. The defendant owns the "VAGISAN" mark[89] whilst the plaintiff is the owner of the "VAGISIL" trade marks.[90] In an earlier proceeding, the plaintiff successfully applied to the PAR to invalidate the defendant's "VAGISAN" mark. The defendant's appeal against the PAR's decision was dismissed by the High Court.[91]

20.63 After having its registration of the "VAGISAN" mark invalidated by the plaintiff, the defendant revised the mark by adding the words "Dr Wolff's" and reapplied for registration of that mark in both Classes 3 and 5. The plaintiff once again opposed the defendant's application, in reliance on ss 8(2)(*b*), 8(4)(*b*)(i), 8(4)(*b*)(ii) and 8(7)(*a*) of the Trade Marks Act[92] ("TMA"), but this time, the plaintiff failed before the Intellectual Property Adjudicator ("IPA").[93] The plaintiff appealed to the High Court (General Division) against the decision of the IPA on the grounds of opposition under ss 8(2)(*b*) and 8(7)(*a*) of the TMA but did not pursue the appeal on the other grounds of opposition under ss 8(4)(*b*)(i) and 8(4)(*b*)(ii) of the TMA. The appeal was dismissed by Lee Seiu Kin J, upholding the revised registration.

*(1) Opposition under section 8(2)(*b*) of the Trade Marks Act*

20.64 The assessment under s 8(2)(*b*) of the TMA involves a step-by-step approach that requires the courts to consider first the marks and goods or services similarity inquiries before proceeding to consider the likelihood of confusion inquiry. The High Court in this case only needed to undertake the marks-similarity inquiry before embarking on

88 [2022] 5 SLR 575.

89 The defendant first registered the mark "VAGISAN" in Class 3 ("Soaps, perfumery, essential oils, cosmetics, hair lotions") and Class 5 ("Pharmaceutical products, sanitary products for medical purposes; dietetic substances for medical purposes") on 19 March 2012.

90 The plaintiff is the registered owner of four "VAGISIL" marks, three of which claimed goods in either Class 3 or Class 5.

91 *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626.

92 Cap 332, 2005 Rev Ed.

93 *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] SGIPOS 10.

the likelihood of confusion inquiry as there was no dispute between the parties as to whether the goods and services in question were similar.

20.65 In the marks-similarity inquiry, the court looks at three aspects – visual, aural and conceptual similarities.[94] At the same time, the distinctiveness of the earlier mark is an integral factor in the assessment and not a separate step within the marks-similarity inquiry.[95] Distinctiveness in a trade mark comprises "ordinary and non-technical distinctiveness" and "technical distinctiveness". The former refers to "what is outstanding and memorable about the mark"[96] whilst the latter concerns whether a trade mark is "able to function as a badge of origin".[97] The more technically distinctive a mark is, the higher the threshold that must be crossed before a competing sign will be considered dissimilar to it.

20.66 Where a trade mark is made up of several components, technical distinctiveness or its ability to function as a badge of origin must be assessed holistically. Although the individual component of a mark may not be technically distinctive, it is still possible that the sum of these components is of sufficient technical distinctiveness. Furthermore, in cases where the competing marks have a common denominator, the marks-similarity assessment calls to question the dominance of the common element and whether it is so dominant that the other differing components between the competing marks are unable to obscure the similarities between them.[98]

20.67 Applying the law on the facts of this case, the High Court (General Division) upheld the decision of the IPA and ruled that the defendant's trade mark "Dr Wolff's VAGISAN" could be registered. On the question of distinctiveness, the High Court held that the components "Dr Wolff's" and "VAGISAN" were equally distinctive. The fact that the added component "Dr Wolff's" was smaller in font size did not alter the High Court's assessment because it was still clearly visible and as such was able to capture and draw the consumer's attention.[99] The High Court

94 *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [40(a)].
95 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 at [30].
96 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [19].
97 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [20].
98 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [19]–[21].
99 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [22]–[30].

also rejected the plaintiff's argument that "VAGISAN" was the more distinctive (in the technical sense) component of the defendant's mark because it was an invented word whilst "Dr Wolff's" bore reference to a doctor. The latter was less distinctive because such "Dr-Formative" marks are intended to lend weight to the credibility and health properties of the goods sold.

20.68 Having considered the authorities cited before him, the learned judge concluded that, although it was true that "Dr Wolff's" might allude to an endorsement of the product by a medical professional, considered on its own and without taking into account external materials, it carried no meaning. On this basis, "Dr Wolff's" was as distinctive as "VAGISAN" in terms of technical distinctiveness.[100]

20.69 Taking an integrated approach of the element of distinctiveness and the three aspects of visual, aural and conceptual similarities, the High Court (General Division) held that the competing marks were visually, aurally and conceptually dissimilar.

20.70 In terms of visual similarities, the court ruled that the assessment was premised upon the "imperfect recollection of the average consumer".[101] Having ruled that the two components "Dr Wolff's" and "VAGISAN" were equally distinctive, it was highly unlikely that an average consumer would only have a recollection of "VAGISAN" and not "Dr Wolff's". It was also an important consideration for the court that the defendant's mark did not contain in its entirety the plaintiff's "VAGISIL" mark. Viewed as a whole and taking into account the imperfect recollection of an average consumer of the distinctive and dominant components in the competing marks, which were "Dr Wolff's" and "VAGISAN" in the defendant's mark and "VAGISIL" in the plaintiff's mark, the court held that they were visually dissimilar.[102]

20.71 In terms of assessing aural similarity, the court may adopt the "Dominant Approach" and/or the "Quantitative Approach". Using the Dominant Approach, the High Court (General Division) found that, given the two components "Dr Wolff's" and "VAGISAN" were equally distinctive, the average consumer would be likely to pronounce the defendant's mark as "Dr Wolff's VAGISAN" and not simply "VAGISAN". As such, the defendant's mark was aurally dissimilar to the plaintiff's

100 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [31]–[42].

101 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [44].

102 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [44]–[50].

mark. Taking the Quantitative Approach, the court arrived at the same conclusion. This is because as the two components "Dr Wolff's" and "VAGISAN" were found to be equally distinctive. The present case must be distinguished from those where a trade mark applicant merely added words of a descriptive nature in an attempt to obscure the distinctiveness element of an earlier registered mark incorporated in the application mark. Considering this important finding, the court assessed the plaintiff's and the defendant's marks to be aurally dissimilar. Significantly, because of the addition of "Dr Wolff's" to the defendant's mark, the competing marks had more syllables that were *not* in common than they were common.[103]

20.72 Finally, in terms of the assessment of conceptual similarity, the court noted that in the earlier invalidation proceedings, the parties agreed that "VAGISAN" and "VAGISIL" were conceptually neutral and this finding was not challenged on appeal. The IPA had found that the defendant's "Dr Wolff's VAGISAN" mark was conceptually dissimilar to the plaintiff's as it suggested a product owned or created by one Dr Wolff. The High Court agreed. As for the plaintiff's argument that the IPA's ruling would allow traders to circumvent any finding that the competing marks were conceptually similar by adding a possessive identifier, the High Court opined that traders can make changes to their mark to better distinguish it from any other similar mark on the trade mark register. It is then for the court to assess the modified mark and ascertain whether registration ought to be allowed, in particular whether the changes made have rendered the mark sufficiently dissimilar from the earlier mark on the register such that there is no likelihood of confusion on the part of the public.[104]

20.73 Technically, as the threshold requirement of the marks-similarity inquiry had not been satisfied, there was no need for the court to proceed with the likelihood of confusion inquiry. However, the court went on with its analysis as the confusion assessment under s 8(2)(*b*) of the TMA is equally relevant to the opposition ground on passing off in s 8(7)(*a*) of the TMA.[105]

20.74 In the likelihood of confusion inquiry, the applicable test is whether a substantial portion of the relevant public would be confused.[106]

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103 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [51]–[56].

104 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [57]–[63].

105 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [64].

106 *Ferrero SpA v Sarika Connoisseur Café Ltd* [2011] SGHC 176 at [57].

The relevant public consists of actual or potential purchasers of the goods or services of the plaintiff and defendant, and those who deal with these goods.[107] Where the "average consumer" refers to business organisations and not ordinary or retail customers, they would be discerning and careful in making their choices; thus, it would be unlikely for them to confuse the trade sources of different marks.[108]

20.75 The High Court found, in relation to s 8(2)(*b*) of the TMA, that there was no likelihood of confusion. First, the goods here were highly personal self-care products for women that warranted greater care in selection. Furthermore, decisions to purchase such products in brick-and-mortar shops were likely to be made with the assistance of specialists.[109] Next, the marks were found to be dissimilar or, alternatively, there was a low degree of similarity due to the addition of the words "Dr Wolff's".[110] The plaintiff's examples of third-party articles did not demonstrate that they had a strong reputation in Singapore and were also rather outdated. The declining sales figures of the plaintiff's "VAGISIL" marks suggested a lack of strong reputation.[111] Factors leaning toward a finding of likelihood of confusion, such as the similarity of the goods and markets, were overcome by the fact that the nature of the product warranted greater care on the consumer's part. The High Court was sceptical about the statistical value of a survey that suggested that women would hastily purchase intimate health products. Even if the result were accepted, the inferences drawn did not support the plaintiff's case.[112]

(2) Opposition under section 8(7)(a) *of the Trade Marks Act*

20.76 The test for misrepresentation under passing off is substantially the same as the "likelihood of confusion" test under s 8(2)(*b*) of the TMA.[113] The court is not constrained with regard to the factors it may take into account, unlike in a trade mark infringement action. The rationale is

107 *Digi International v Teraoka Seiko Co, Ltd* [2021] SGHC 165 at [174].

108 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [66].

109 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [68], where Lee Seiu Kin J agreed with Hoo Sheau Peng J's finding in *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626 at [54].

110 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [70].

111 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [71]–[75].

112 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [76]–[77].

113 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [82].

justified by the different respective interests protected by passing off and trade marks – goodwill in the former, and protection of consumers in the latter.[114]

20.77 As there was no likelihood of confusion, the element of misrepresentation was not established. The ground of opposition under s 8(7)(*a*) of the TMA therefore also failed.

F. V V Technology Pte Ltd v Twitter, Inc – *Trade mark registration – Opposition under sections 8(2)(*b*) and 8(7)(*a*) – Distinctiveness under* Staywell

20.78 In *V V Technology Pte Ltd v Twitter, Inc*,[115] the applicant, V V Technology Pte Ltd, was a technology start-up seeking to apply for a trade mark ("Application Mark") that had a pictorial representation of the applicant's initials (V V) and a hummingbird. The Application Mark has been registered for a broad range of goods and services in Classes 3, 9, 21, 29, 30, 31, 32, 33, 35, 38, 39, 41 and 43. The respondent owns and operates the Twitter platform, which is a microblogging and social networking service. The well-known Twitter platform operates under the respondent's registered trade mark that is a device mark in the form of a bird logo ("Registered Mark"). Some of the goods and services registered under the Application Mark overlapped with the goods and services for which the Registered Mark has been registered in Classes 9, 35, 38 and 41. The respondent filed an opposition against the applicant's application under ss 8(2)(*b*) and 8(7)(*a*) of the TMA, relying on its Registered Mark, and succeeded before the PAR. The applicant appealed.

20.79 In relation to s 8(2)(*b*) of the TMA, the High Court (General Division) was asked to decide whether (a) the competing marks were similar overall; and (b) there was a likelihood of confusion. In relation to s 8(7)(*a*) of the TMA, the issue before the High Court (General Division) was whether misrepresentation and damage for the purposes of passing off were established.

(1) The marks-similarity inquiry – The law

20.80 Goh Yihan JC's judgment began with a restatement of the trite principles of the marks-similarity analysis.[116] Distinctiveness of the earlier trade mark is an integral factor. The greater the technical distinctiveness,

114 *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [84]–[85].

115 [2022] SGHC 293.

116 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [24].

the higher the threshold before a competing mark is considered dissimilar to it.[117] The three aspects of similarity, namely, visual, aural and conceptual, are not formulaic or mechanistic. Instead, they are meant as signposts to guide the court's inquiry. At this stage of the marks-similarity assessment, no external matters should be considered.[118] The two marks are assessed from the perspective of the average consumer exercising some care and sense, with imperfect recollection. They should not be compared side by side. Similarity should be assessed by reference to the overall impressions created, bearing in mind their distinctive and dominant components. Where a mark lacks such a component, it should be construed as a "unitary whole".[119]

20.81 The PAR's decision revealed two unsettled conceptual issues in relation to the "distinctiveness" concept: (a) whether distinctiveness is a separate step from the marks-similarity comparison or integrated into it; and (b) the relevance of non-technical distinctiveness.[120]

20.82 As a preliminary issue, the High Court (General Division) sought to clarify the meaning of "distinctiveness" in the case law. The distinction between "technical" and "non-technical" distinctiveness was first imported into Singapore trade mark law by *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide*[121] ("*Staywell*") ("the *Staywell* Distinction").[122] According to *Staywell*, "technical" distinctiveness refers to the mark's ability to perform its source-indicating function, whilst "non-technical" distinctiveness refers to what was outstanding or memorable from the consumer's point of view. Further, the sub-classification of "inherent" and "acquired" distinctiveness appears to apply only to "technical" distinctiveness.[123] Arguably, the pre-*Staywell* decisions had made a similar distinction, but under different labels. The pre-*Staywell* taxonomy was quite stable in describing two well-accepted concepts: (a) the dominant or memorable component of a mark that stands out to the average consumer with imperfect recollection; (what *Staywell* labelled as "non-technical" distinctiveness); and (b) the ability of a mark to distinguish the goods or services of one particular trader from those of another (what *Staywell* labelled as "technical" distinctiveness).[124]

117 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [25].
118 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [26].
119 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [27]–[28].
120 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [31]–[33].
121 [2014] 1 SLR 911.
122 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [35].
123 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [37]–[38].
124 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [40]–[43].

20.83 However, the *Staywell* Distinction created some uncertainty in the courts below, such as confusion between "technical" and "inherent" distinctiveness, confusion between the mark's dominant component and "technical" distinctiveness, or ignoring "non-technical" distinctiveness. Academics have also expressed different approaches to the issue, with some avoiding the *Staywell* taxonomy[125] or referring to it but not engaging it.[126]

20.84 The High Court (General Division) suggested that the *Staywell* Distinction be abandoned in favour of the earlier established taxonomical practice of using "dominant component" to refer to "non-technical distinctiveness" and "distinctiveness" to refer to "technical distinctiveness".[127] This would have been the High Court (General Division)'s preferred approach. However, being bound by the doctrine of *stare decisis*, the High Court (General Division) could only propose a more consistent use of "distinctiveness" to refer to three concepts: (a) inherent technical distinctiveness; (b) acquired technical distinctiveness; and (c) non-technical distinctiveness.[128] This sought to clarify that the sub-distinction of inherent distinctiveness and acquired distinctiveness does not apply to non-technical distinctiveness.

20.85 Pre-*Staywell*, several High Court cases such as *The Polo/Lauren Co LP v Shop In Department Store Pte Ltd*[129] and *Ferrero SpA v Sarika Connoisseur Café Ltd*[130] ("*Sarika*") treated distinctiveness as a threshold inquiry. Despite the Court of Appeal's clarification in *Sarika* and *Staywell* that distinctiveness is integrated into the marks-similarity analysis, several post-*Staywell* cases continued treating it as a threshold inquiry.[131] All these cases are usually caveated with the awareness of the guidance in *Staywell*, and those courts acknowledged that separating distinctiveness into a separate analysis was done as a matter of practicality.[132] Nevertheless, it seems substantively inconsistent to do so as reasons of practicality or convenience are insufficient to depart from higher authority. There are also good substantive reasons for not treating distinctiveness as a separate threshold inquiry. For one, it helps maintain conceptual certainty because the use of a threshold inquiry may allow for extraneous factors into the marks-similarity inquiry. Next, "technical" distinctiveness will be found

125 See *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 3rd Ed, 2021) at p 386.
126 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [55]–[57].
127 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [59]–[60].
128 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [61].
129 [2005] 4 SLR(R) 816.
130 [2011] SGHC 176.
131 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [70]–[73].
132 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [74]–[75].

in more than one of the steps in the step-by-step approach and takes on different meaning depending on the context in which it is applied. The single threshold approach risks obscuring this important context.[133]

20.86 In terms of the relevance of acquired technical distinctiveness in the marks-similarity test, in particular whether acquired technical distinctiveness should be considered at the marks-similarity stage or the likelihood of confusion stage, the High Court took into consideration that acquired technical distinctiveness requires consideration of external matter, which was expressly prohibited in the marks-similarity stage by the Court of Appeal in *Staywell*.[134] Having regard to the parties' arguments and given the court's finding on the two earlier conceptual issues, acquired technical distinctiveness should not be considered at the marks-similarity stage, for reasons of precedent, principle and policy.[135]

20.87 In terms of precedent, decisions at the Registry and High Court level were divided on the issue, providing no definitive view on the problem.[136] As for Court of Appeal authorities, decisions before *Staywell* had considered the issue *obiter*, and one post-*Staywell* decision, *Ceramiche Caesar SpA v Caesarstone SDot-Yam Ltd*,[137] did not need to decide on the issue. Although *Staywell* did not explicitly decide this issue too, on a closer reading, and considering the overall intention of the Court of Appeal, acquired technical distinctiveness should not be allowed at the marks-similarity inquiry.[138]

20.88 In terms of principle, the High Court (General Division) distinguished between truly general knowledge, which permits the context for interpretation in the marks-similarity inquiry, and knowledge that was specific to the marks in question, for which evidence must be adduced.[139] The rationale for prohibiting external matters in the marks-similarity stage is to distinguish between the issue of resemblance (of the marks) and the effect of such resemblance. However, this does not mean all contextual evidence is inadmissible.

20.89 The exception is general contextual evidence that is independent of the trader's public activities.[140] The same factual bases and evidence that show acquired technical distinctiveness usually can also prove a mark's

133 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [76]–[78].
134 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [80]–[82].
135 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [90].
136 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [94].
137 [2017] 2 SLR 308.
138 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [107]–[109].
139 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [111]–[114].
140 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [115].

reputation (in the likelihood of confusion stage), and this is done to avoid having to re-evaluate the same evidence at both stages.

20.90 In terms of policy, this is to prevent adducing irrelevant evidence with cost consequences. Although general knowledge of the average consumer is permissible at this stage, since it can only go towards resemblance (and not effect of resemblance), it is usually commonly assumed to exist with no adjudication on admissibility required.[141]

20.91 The two immediate consequences of the above conclusions are that "distinctiveness" is not a threshold inquiry, and that acquired technical distinctiveness is not to be considered at the marks-similarity inquiry at all.[142]

*(2) Opposition under section 8(2)(*b*) of the Trade Marks Act – Were the Registered Mark and the Application Mark similar?*

(a) Visual similarity

20.92 Considering both technical and non-technical distinctiveness, the Registered Mark had a normal level of distinctiveness, and correspondingly enjoyed only a normal threshold before a competing sign would be considered dissimilar to it.[143] The Registered Mark had considerable inherent technical distinctiveness, as it was meaningless or had no discernible correlation to the respondent's product or service. It was irrelevant whether there were many monochromatic, simplified, abstract or animal logos bombarding the average general consumer today. As far as the High Court (General Division) was concerned, this was impermissible evidence about the effect of the Registered Mark.[144] The Registered Mark did not have high non-technical distinctiveness. It was a simple logo with simple geometry and that was not disputed by the respondent. The marks were visually similar based on a general examination of the marks, as well as on the basis of case law. The applicant's attempt to differentiate the marks on the basis of general movement and on general features was problematic and unprincipled.[145]

141 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [118].
142 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [119]–[121].
143 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [129].
144 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [127].
145 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [148]–[152] and [153]–[156].

(b) Aural similarity

20.93 The PAR's finding that aural similarity was not relevant in the present case was not challenged on appeal and so the court made no finding on this.[146]

(c) Conceptual similarity

20.94 The marks were conceptually similar. The PAR's analysis was not at an overly high level of abstraction. It was appropriate to consider them as depicting birds in flight. Such analysis would not allow the respondent to claim a right in the concept as conceptual similarity was only one aspect in the marks-similarity analysis. In the present case, the marks were arbitrary or meaningless in relation to the services.[147] There is no immutable rule on the relative weight of each type of similarity as they must be assessed separately and then considered in the round at the end.[148] The applicant's arguments on the characteristics evoked by each bird mark such as swiftness and agility *versus* playfulness were rejected.[149]

20.95 As the applicant did not dispute the PAR's finding that the parties' services were similar, the High Court did not deal with this point in detail.

(d) Likelihood of confusion

20.96 The three issues to consider are (a) how similar the marks are; (b) how similar the goods or services are; and, therefore, (c) how likely the relevant public will be confused. At this stage of the assessment, relevant extraneous factors include:[150]

> (a) factors relating to the impact of marks-similarity on consumer perception, such as:
>
> (i) degree of similarity of marks themselves;
>
> (ii) mark reputation;
>
> (iii) impression given by the marks; and
>
> (iv) possibility of imperfect recollection; and

146 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [157]–[159].
147 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [167]–[168].
148 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [172].
149 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [174]–[176].
150 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 at [96].

(b) factors relating to the impact of the goods or services-similarity on consumer perception, such as:

(i) the normal way the goods or services are purchased;

(ii) cost of the items;

(iii) whether their nature demands greater or lesser attention by prospective consumers; and

(iv) likely characteristics of the relevant consumers, for example, whether they would apply care or have specialist knowledge.

20.97 The marks had a fair degree of similarity and the services for which they were registered were also similar. Given the similarities, the High Court (General Division) had to consider what the likelihood of confusion would be on the relevant public. In this case, the relevant public would include both specialist consumers and the general purchasing public.[151]

20.98 The High Court (General Division) agreed with the respondent and found that a significant proportion of relevant public was likely to be confused. The general purchasing public was unlikely to pay much attention and care to purchasing goods or services that were unsophisticated and inexpensive. In this case, the competing specifications covered a broad price range of information technology and computer software-related goods or services. For cheaper services or products that are more likely to be purchased by individuals with less specialised needs and knowledge, they would pay considerably less attention to the purchasing and selection process.[152]

20.99 The effect of the Registered Mark's reputation on this analysis appeared to be equivocal and highly fact dependent.[153] A further issue was whether consumers might perceive an *economic link* between the competing marks.[154] The PAR was not wrong to find that the public might perceive a similar mark to be a new iteration of the Registered Mark.[155]

20.100 Indirect confusion also arose from the closely proximate notional fair uses of the marks, and the public could perceive the Application

151 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [182]–[183].
152 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [186]–[188].
153 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [190].
154 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [192]–[193].
155 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [197]–[198].

Mark to be a modified version for an extension of the respondent's digital services.[156]

(3) Opposition under s 8(7)(a) *of the Trade Marks Act*

20.101 The success of an opposition under s 8(2)(*b*) of the TMA does not necessarily imply that an opposition under s 8(7)(*a*) of the TMA is equally successful, and *vice versa*.[157] The threshold question for misrepresentation is whether the incumbent mark is distinctive of the proprietor's goods or services.

20.102 The applicant erroneously relied on the respondent's brand guidelines, which were addressed to third parties. The respondent was not itself restricted in the ways it could use its own mark, including modifying or using it in any colour. Since the competing marks were similar and the relevant public was likely to be confused in light of the fair and notional uses of the respondent's mark under s 8(2)(*b*) of the TMA, this sufficed for a misrepresentation under s 8(7)(*a*) of the TMA.[158]

20.103 The parties operated in the same fields of business activity and their respective products provided similar services. They were thus in direct competition with each other. There was therefore a real risk that the misrepresentation could divert sales and customers away from the respondent.[159]

20.104 The appeal was dismissed, and the respondent succeeded in opposing the Application Mark under both ss 8(2)(*b*) and 8(7)(*a*) of the TMA.

G. Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd – *Trade mark infringement – Registration in bad faith under section 7(6) – Invalidation – Groundless threats*

20.105 In *Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd*,[160] the defendant, a Singapore company incorporated in 2013, was in the business of selling fans and sold fans under the "FANCO" registered trade mark. The plaintiff, a Singapore company incorporated in 2019, was also in the business of selling fans. It was the registered owner of the "COFAN" trade mark and sold fans under the "COFAN" trade

156 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [201].
157 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [207].
158 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [210]–[211].
159 *V V Technology Pte Ltd v Twitter, Inc* [2022] SGHC 293 at [212]–[213].
160 [2022] SGHC 226.

mark. The plaintiff was owned by one Phua Kian Chey Colin, a former employee of the defendant. Sometime in August 2019, the defendant launched a new line of fans under the "CO-FAN" mark. The plaintiff commenced infringement proceedings under s 27(2)(*b*) of the TMA against the defendant for its use of the "CO-FAN" mark. The defendant counterclaimed for invalidation of the "COFAN" mark on grounds of bad faith (s 7(6) read with s 23(1) of the TMA) and groundless threats of infringement by the plaintiff.

20.106 The issues before Dedar Singh Gill J at the High Court (General Division) were as follows:

(a) Was the plaintiff's mark registered in bad faith under s 7(6) of the TMA and if so, should it be invalidated under s 23(1) of the TMA?

(b) Did the plaintiff make groundless threats of trade mark infringement against the defendant?

(1) Bad faith

20.107 A satisfactory definition of "bad faith" has often eluded the courts.[161] However, the words of the statute and the surrounding circumstances usually serve as useful guidance.[162] The court summarised the contours of bad faith laid down in *Tomy Inc v Dentsply Sirona Inc*.[163] Bad faith is one exception to the "first-to-file system". It is determined as at the date of application. Matters occurring after the application date which may assist in determining the applicant's state of mind as at the date of application can be taken into consideration. Bad faith includes dishonesty and also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined".[164] The test contains both a subjective element (what the particular applicant knows) and an objective element (what ordinary persons adopting proper standards would think).[165] Bad faith requires a holistic assessment, in which the court takes into account:[166]

161 Lionel Bently & Brad Sherman, *Intellectual Property Law* (Oxford University Press, 5th Ed, 2018) at p 1017.

162 *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367.

163 [2020] 5 SLR 424.

164 *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at [379].

165 *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 at [105].

166 Lionel Bently & Brad Sherman, *Intellectual Property Law* (Oxford University Press, 5th Ed, 2018) at p 1019.

(a) whether the applicant knows or must know that a third party is using an identical/similar sign for an identical/similar product capable of being confused with the sign for which registration is sought;

(b) the applicant's intention to prevent that third party from continuing to use such a sign; and

(c) the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought.

20.108 Bad faith has moral overtones, which appear to make it possible for such a finding to be made in the absence of any legal breach by the applicant. The legal burden of proof lies on the plaintiff, on a balance of probabilities, although usually on the basis of circumstantial evidence. The inquiry is fact sensitive, demanding careful examination of all relevant circumstances. The nature of the parties' pre-existing relationship is a relevant factor, such as where the applicant seeks to register the trade mark of a competitor, ex-employer, supplier, licensor, or anyone with whom he had a contractual or pre-contractual relationship.[167] A likelihood of confusion is not necessary for a finding of bad faith.[168]

20.109 There was insufficient objective evidence proving that Phua gained knowledge of the defendant's plans to use the "CO-FAN" mark. However, the plaintiff clearly intended to *capitalise on the defendant's goodwill* by applying for a similar mark. Phua's prior employment with the defendant and the similarities between the marks formed a clear nexus between the parties. The marks, though not *confusingly* similar, bore some similarity, which formed part of the basis for the inference of bad faith. The High Court (General Division) found Phua's explanation of independent, original creation and his supposed ignorance of the marks' similarity to be unbelievable. The plaintiff's claim that the defendant adopted the "CO-FAN" mark only after hearing of the plaintiff's plans to do so was rejected.

20.110 Furthermore, subsequent to application, the plaintiff launched its own "COFAN HALI"-marked fan line, which had strikingly similar brochures, packaging, price and name to the defendant's "CO-FAN HELI" fans. The plaintiff did so shortly after demanding that the defendant cease the use of the "CO-FAN" mark. The plaintiff then sought to undercut the defendant by selling its fans for one dollar cheaper. All this suggested that the plaintiff lacked *bona fides* at the time of application.

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167 Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 3rd Ed, 2014) at para 7.178.

168 *Rothmans of Pall Mall Ltd v Maycolson International Ltd* [2006] 2 SLR(R) 551.

20.111 The subjective element in the test for bad faith was satisfied as the plaintiff knew of the similarities of the "COFAN" and "FANCO" marks at the point of application and was aware of the defendant's goodwill in the "FANCO" mark. At the same time, the objective element of the test was also satisfied in that the plaintiff's subsequent conduct clearly fell afoul of the standards of acceptable commercial behaviour observed by reasonable and experienced men.

20.112 The defendant succeeded in its counterclaim for invalidation of the plaintiff's registered "COFAN" mark and, accordingly, the plaintiff's "COFAN" mark was invalidated. The plaintiff's infringement action therefore fell away.

(2) Groundless threats of trade mark infringement

20.113 The applicable test to make out a claim for groundless threats of trade mark infringement under s 35 of the TMA is as follows:[169]

> (a) **The defendant makes a threat to sue for trade mark infringement.** This is assessed by reference to what a reasonable person, in the recipient's position and with knowledge of all relevant circumstances at the time, would understand the writer to have intended.[170]
>
> (b) **The threat did not relate to acts of infringement that fall within ss 35(1)(*a*)–35(1)(*c*) of the TMA.** Any aggrieved person may bring a threats action when threatened with proceedings in relation to acts other than those listed in ss 35(1)(*a*)–35(1)(*c*) of the TMA. A natural reading of the provisions suggests that the exclusion does not extend to further acts such as the sale and/or advertising of goods bearing the impugned mark. However, this literal reading leads to the absurd result that the threat made to acts of primary infringement are not actionable, but threats made to acts of secondary infringement by the same alleged infringer are. The UK position has been legislatively amended to reflect the commercial reality that manufacturers or importers are likely to be involved in both the application of the mark and the sale of the infringing goods. However, the High Court (General Division) was of the view that until the TMA in Singapore undergoes similar development, this provision should be given its natural meaning.

169 *Dr Babor GmbH & Co KG v Sante De Beaute Pte Ltd* [2018] 5 SLR 928 at [30].
170 *Best Buy Co Inc v Worldwide Sales Corp Espana SL* [2011] FSR 742.

(c) **The meaning of an aggrieved person within the meaning of s 35(1) of the TMA.** The claimant under s 35(1) of the TMA is not "aggrieved" if he is unable to demonstrate that (i) he has suffered any loss because of the defendant's threats; or (ii) it is appropriate for the court to intervene by granting a declaration or injunction, even if the defendant's threats were found to be groundless.

20.114 The High Court (General Division) found the language in the plaintiff's letters similar to that in the cease and desist letter in *Tech 21 UK v Logitech Europe SA*.[171] Thus, the first element of a threat to sue was satisfied.

20.115 The plaintiff's allegations clearly went beyond the mere affixation of the mark to the defendant's goods. In particular, the plaintiff alleged the defendant continued to market its products under the "CO-FAN" mark and that the defendant advertised its brand on online shopping platforms. Thus, the second element of a threat to sue was also satisfied as the threats were not limited to acts that fell within s 35(1)(*a*) of the TMA.[172]

20.116 With regard to the third element of whether the defendant was an "aggrieved person" for the purpose of s 35 of the TMA, the High Court (General Division) found that the defendant had not shown that it was "aggrieved" in the sense that it had suffered loss as a result of the threats contained in the April 2021 letters.[173] The defendant claimed that after receiving the letters, several distributors called, stating they had been informed by the plaintiff over phone that the plaintiff was suing the defendant, and they subsequently cancelled their orders for the defendant's fans. However, these cancellations arose from the plaintiff's alleged phone call threats to the distributors, not from the threats in the letters. In any case, the defendant did not show a causal link between the phone calls and the cancellations.[174]

20.117 Turning to the defendant's claim for declaratory and injunctive relief, the court held that there was no evidence suggesting the plaintiff would persist in making further threats of infringement proceedings. Declaratory relief was unnecessary as the plaintiff's infringement claim was rejected.[175]

171 [2015] Bus LR 1276.
172 *Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd* [2022] SGHC 226 at [72].
173 *Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd* [2022] SGHC 226 at [75].
174 *Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd* [2022] SGHC 226 at [76]–[77].
175 *Triple D Trading Pte Ltd v Fanco Fan Marketing Pte Ltd* [2022] SGHC 226 at [78].

20.118 The plaintiff's claim was dismissed entirely, while the defendant succeeded in its counterclaim for invalidation only.

H. In the matter of a Trade Mark Application by Aranguru UG (haftungsbeschrankt) – *Registration of slogan as a trade mark – Distinctiveness under section 7(1)(*b*)*

20.119 The applicant sought to register the slogan "Party like Gatsby" as a trade mark ("Application Mark") in Classes 41 and 43 in *In the matter of a Trade Mark Application by Aranguru UG (haftungsbeschrankt)*.[176] The examiner found it was devoid of distinctive character under s 7(1)(*b*) of the TMA. The applicant sought an *ex parte* hearing.

20.120 The issues before the IPA were as follows:

(a) What is the law relating to distinctiveness of slogans in Singapore?

(b) Did the Application Mark have distinctiveness?

(1) The applicable law

20.121 The critical question in relation to distinctiveness in s 7(1)(*b*) of the TMA is whether the average consumer would appreciate the indication of origin significance of the mark in question without first being educated of such purpose.[177] Slogans are a category of marks for which distinctiveness is often more difficult to establish, as they are usually laudatory about some aspect or quality of the goods or services in question.[178] There is a dearth of local cases on slogans, which warrants a look at EU jurisprudence.

20.122 As a rule, the presence of particular characteristics is likely to endow the mark with distinctive character.[179] Slogans expressing objective messages can still serve the origin-indicating function if they are not descriptive and possess a "certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process"[180] in the public's minds. Existence of multiple meanings, a play on words or being perceived as "imaginative, surprising and unexpected

176 [2022] SGIPOS 8.

177 *Société de Produits Nestlé SA v Petra Foods Ltd* [2017] 1 SLR 35 at [33].

178 *In the matter of a Trade Mark Application by Aranguru UG (haftungsbeschrankt)* [2022] SGIPOS 8 at [13].

179 *Audi AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-398/08, EU:C:2010:29.

180 *Audi AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-398/08, EU:C:2010:29 at para 57.

and [thus] easily remembered" are relevant but not strictly necessary characteristics.[181] Widely known slogans in use for a while may be more easily linked to the goods or services in question by the public. If the public perceives the mark as a source indicator, it is irrelevant that the mark is at the same time (primarily) understood as a promotional formula.[182]

20.123 The assessment in s 7(1)(*b*) of the TMA is answered from the perspective of the average, reasonably well-informed, reasonably observant and circumspect consumer.[183] The fact that a mark triggers a cognitive process in the average consumer's mind is *per se* insufficient to endow distinctive character. The "cognitive process" must follow from the originality or resonance of the trade mark in question. In any case, the ultimate question is whether the consumer can immediately perceive the mark as a badge of origin.

20.124 In appropriate cases, narrowing the scope of the application's specification may overcome objections. However, the same general ground of refusal may apply in other categories of goods or services that are interlinked in a sufficiently direct and specific way, so as to form a sufficiently homogeneous category of goods or services.[184] This is a common-sense approach that should be adopted when considering interlinked services.[185]

(2) Did the Application Mark have distinctiveness?

20.125 The relevant public in this case was the average discerning man or woman on the Mass Rapid Transit.[186] The average discerning consumer in Singapore would have a general sense of what "The Great Gatsby" novel or movie was about, that is, parties from the 1920s. However, he would *not* be *so acquainted* with the storyline to know about the "loneliness, broodiness and aloofness" of Jay Gatsby.[187] As a whole, the Application Mark was *not* inherently distinctive as an indication of trade origin. It was

181 *Audi AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-398/08, EU:C:2010:29 at para 47.

182 *Audi AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-398/08, EU:C:2010:29 at para 45.

183 *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 at [33].

184 *Intercontinental Exchange Holdings, Inc v European Union Intellectual Property Office* T-430/16, EU:T:2017:198 at para 37.

185 *Intercontinental Exchange Holdings, Inc v Chicago Mercantile Exchange Inc* [2018] SGIPOS 20 at [37].

186 *In the matter of a Trade Mark Application by Aranguru UG (haftungsbeschrankt)* [2022] SGIPOS 8 at [22].

187 *In the matter of a Trade Mark Application by Aranguru UG (haftungsbeschrankt)* [2022] SGIPOS 8 at [28].

not imaginative, surprising or unexpected. The average consumer would not appreciate the contrast between the fun and enjoyment of a party and Jay Gatsby's "loneliness". It was purely promotional in that the Application Mark would be understood as a call to action (that is, an invitation to be part of some type of party), as opposed to *both* a promotional statement and a badge of origin.[188] It was insufficient that the Application Mark triggered a "cognitive process" if it was not immediately perceived by the relevant public to be a badge of origin.

20.126 The applicant's proposed amendments to the services specifications to omit party-planning services failed to overcome the objection under s 7(1)(*b*) of the TMA. The services filed for were generally related to entertaining or hosting, planning parties and events. The objection under s 7(1)(*b*) of the TMA therefore applied to *all* these services as a *sufficiently homogeneous* group. The objection under s 7(1)(*b*) of the TMA was therefore maintained against the Application Mark.

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188 *In the matter of a Trade Mark Application by Aranguru UG (haftungsbeschrankt)* [2022] SGIPOS 8 at [30].