

20. INTELLECTUAL PROPERTY LAW

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I. Copyright

A. **General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd – Ownership of copyright in photographs – Implied licence – Offer to settle**

20.1 The Appellate Division of the High Court (“Appellate Division”) in *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd*¹ in April 2023 affirmed the decision of Mavis Chionh J on the finding of copyright ownership and infringement.² Steven Chong JCA delivered the unanimous joint judgment (with whom Woo Bih Li JAD and Aedit Abdullah J agreed).

20.2 Between 1995 and 2008, the respondents (who were the plaintiffs in the original General Division of the High Court (“General Division”) case) (“Wave”) provided branding, design and marketing services to the hotels and resorts managed by the appellant companies (“GHM”) (who were the defendants in the original General Division case) and were involved in taking and editing photographs of these hotels and resorts. Wave claimed that some years after the termination of their working relationship with these hotels and with the appellants, they discovered

1 [2023] 1 SLR 1317.

2 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142. This decision was discussed in David Tan & Susanna H S Leong, “Intellectual Property Law” (2022) 23 SAL Ann Rev 577 at paras 20.1–20.26.

that these photographs were featured in multiple online issues of one of the appellant’s magazines. In the absence of a formal copyright agreement between the parties, the parties had sought the court’s determination as to whether ownership of the copyright in these photographs had been vested in the respondents or in the hotels, and whether the appellants were permitted to continue using these photographs after the termination of the working relationship with Wave. The court below 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.

20.3 The central issue on appeal concerned the proper interpretation of s 30(2) of the Copyright Act³ in relation to the commissioning of the photographs. Section 30(2) of the Copyright Act provides the default position that the copyright should belong to the “author”, which, in the context of photographs, is the photographer. However, that default position can be displaced by s 30(5), which provides that the copyright belongs to the client when the client makes, for valuable consideration, an agreement with another person for the taking of the photographs.

20.4 In the court below, Chionh J held that for the default position to be displaced, the agreement must be made with the *actual photographer* and the agreement must *solely* be for the taking of photographs.⁴ The Appellate Division disagreed on this point, but ultimately dismissed the appeal as the operation of s 30(5) of the Copyright Act can be excluded by agreement. This was the case here, in the light of a validly incorporated provision in the agreement between the parties which reserved the copyright of the photographs to the company engaged for the photoshoot, *ie*, Wave.

20.5 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 entrepreneurial artist and creative designer Lee Kar Yin (“Ms Lee”) – also named as a plaintiff – provided their services to a number of these hotels and resorts. Wave provided design, branding and marketing services. Through a series of assignments effected from 2008 to 2013, the third respondent, The Wave Studio LLC, had the eventual ownership of the intellectual property rights to Wave’s literary and artistic works.

3 Cap 63, 2006 Rev Ed. The Act has since been repealed. For the new provisions, see Copyright Act 2021 (2020 Rev Ed) s 133.

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

20.6 Wave was appointed by GHM to provide exclusive “one-stop shop” services, which included comprehensive branding and marketing designs (“marketing collaterals”) for the hotels that GHM were managing. GHM never entered into any formal written contract of service or commissioning contract with Ms Lee.⁵

20.7 From the outset of Wave’s working relationship with the appellants, as part of its standard procedure, Wave would provide a document referred to as a “Production Estimate” to GHM and the hotels for its work in respect of the marketing collaterals. Crucial to this appeal was the fact that the Production Estimates contained a clause confirming that any “intellectual property copyright” which arose from Wave’s work on the project would be owned by Wave (the “Reservation Clause”). The exact wording of this clause varied over time, though the essence of the clause remained the same. No objections were raised to the Reservation Clause over the 13 years that Wave worked with GHM and the hotels.

20.8 Ms 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.

20.9 The Wave entities had engaged two photographers, Masano Kawana (“Mr Kawana”) and Lim See Kong (“Mr Lim”), to take the Hotel Photographs in 2007. While Mr Kawana and Mr Lim took the raw images, Ms Lee was present at each photoshoot and was actively involved in the planning, composition and styling of the photoshoots.

20.10 According to Ms Lee, sometime in 2012 after the parties’ working relationship had ended, she discovered that 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.

20.11 On 31 December 2013, the third respondent (The Wave Studio LLC) commenced an action against the second appellant and other third parties in the United States District Court for copyright infringement of

5 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [9].

the Hotel Photographs. The United States District Court dismissed the third respondent's claims against the second appellant on the grounds of *forum non conveniens* and held that Singapore was the natural forum to determine the ownership of the copyright in the Hotel Photographs. Thereafter, on 19 February 2018, the respondents commenced the copyright infringement action HC/S 175/2018 (“S 175”) against the appellants in Singapore. On 5 January 2021, the respondents served on the appellants an offer to settle (“OTS”) which was not accepted. The trial took place over several days and Chionh J rendered her decision on 16 June 2022.

20.12 In the lower court, Chionh J held that the ownership of the copyright in the Hotel Photographs belonged to the relevant Wave entity. In order for s 30(5) of the Copyright Act to apply to photographs, the party purporting to rely on it must have made an agreement for valuable consideration *with the photographer for the taking of the photograph*. Furthermore, the agreement between Wave and the hotels was not an agreement for the taking of photographs, but was an agreement for Wave to operate as a “one-stop shop” for the hotels’ branding, design and marketing needs, of which photography was only one function.⁶ Chionh J also found that the operation of s 30(5) was nevertheless excluded by agreement between the parties *per s 30(3)* of the Copyright Act, as the hotels had accepted Wave’s reservation of the copyright in the Hotel Photographs by accepting the Reservation Clause in the Production Estimates.⁷ Chionh J also held that there was no implied term assigning the copyright in the Hotel Photographs to the Hotels, since the Reservation Clause – an express term of the agreement – had been accepted by the hotels and was incorporated into the agreement between the parties.⁸ The court therefore granted a range of remedies such as declaratory relief, injunction and delivery up.⁹

(1) *Whether Reservation Clause excluded operation of section 30(5) Copyright Act*

20.13 Under s 30(2) of the old Copyright Act, the default position is that the owner of the copyright is the “author”. In the context of photographs, this would be the photographer as defined in s 7 of the Copyright Act.

6 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [50].

7 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [51].

8 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [107]–[122].

9 *The Wave Studio Pte Ltd v General Hotel Management (Singapore) Pte Ltd* [2022] SGHC 142 at [206]–[207].

This default position can be displaced under s 30(5) of the Copyright Act where a person (the client) makes, for valuable consideration, an agreement with *another person* for the taking of the photographs. It should immediately be noted that s 30(5) does not make any reference to “author”. Instead, it refers to “another person”. The operation of s 30(5) can, however, be excluded by agreement under s 30(3).

20.14 On appeal, the appellants raised arguments in relation to the proper *interpretation* of the Reservation Clause that was strikingly different from their case at the trial. In the court below, it was the appellants’ case that the Reservation Clause was not validly *incorporated* into the contract, but Chionh J found otherwise. There was no appeal against this finding before the Appellate Division. However, leave of court was required under O 57 r 9A(4) of the Rules of Court¹⁰ (“ROC”) to pursue these new arguments on the proper interpretation of the Reservation Clause on appeal.

20.15 First, the Appellate Division noted that the appellants were advancing a new defence in relation to the *interpretation* of the Reservation Clause which was tantamount to attempting to advance a new case on appeal and that such conduct can amount to an abuse of the appeal process.¹¹ Chong JCA commented that given that the court below made no findings in relation to the interpretation of the Reservation Clause, the appellants’ appeal on this point thus could not have arisen from any dissatisfaction from the judge’s decision.¹² Hence, the appellants’ new argument as to the proper interpretation of the Reservation Clause cannot be considered. Chong JCA emphasised: “an appellate court should not be treated like a second trial court, as this would be an abuse of the appeal process”.¹³

20.16 Second, leave of court is required under O 57 r 9A(4) of the ROC to advance any new arguments on appeal. It is trite law that leave will typically be granted if the new arguments pertain to a question of law where no fresh evidence or amendment to the pleadings on either side is required.¹⁴ The Appellate Division observed that not only were the

10 2014 Rev Ed.

11 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [31] (citing *JWR Pte Ltd v Edmond Pereira Law Corp* [2020] 2 SLR 744).

12 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [33].

13 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [33].

14 *Grace Electrical Engineering Pte Ltd v Te Deum Engineering Pte Ltd* [2018] 1 SLR 76 at [36]–[37]; *Feoso (Singapore) Pte Ltd v Faith Marine Co Ltd* [2003] 3 SLR(R) 556 at [34].

arguments on the interpretation of the Reservation Clause not pleaded, the appellants' new positive case on appeal was also contradicted by their own evidence below, and "advancing such new arguments would amount to an abuse of process".¹⁵ It was significant that the appellants did not dispute the clear meaning of the Reservation Clause in the court below. In any case, the Appellate Division was convinced that "even on a consideration of the appellants' new arguments and adopting an objective interpretation of the Reservation Clause, its meaning was clear"¹⁶ that Wave was not waiving or was reserving whatever intellectual property rights they possessed or would ordinarily come to possess at law.

20.17 Furthermore, Chong JCA found that it was "common ground" between the parties that the various agreements were all subject to the terms set out in the various Production Estimates, one of which was the Reservation Clause, and that they all had legal effect.¹⁷ Chong JCA was of the view that the appellants' strained interpretation would have the "practical effect of *nullifying* the contractual force of the Reservation Clause which, on a plain reading, was clear that the respondents own the works that they were commissioned to create" [emphasis in original].¹⁸ The Appellate Division held that leave should not be granted to the appellants to advance their new points on appeal. In any case, even if leave had been granted, the Appellate Division concluded that the appellants' arguments in relation to the interpretation of the Reservation Clause would not have succeeded.

20.18 Since the Appellate Division had determined that there was no issue with the proper interpretation and incorporation of the Reservation Clause, the operation of s 30(5) of the Copyright Act was thus effectively excluded by agreement, but the court proceeded to comment on the proper interpretation of s 30(5).

15 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [39].

16 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [41].

17 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [42].

18 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [43].

20.19 Section 30(5) of the Copyright Act states:¹⁹

(5) Subject to subsection (4), where —

(a) a person makes, for valuable consideration, an agreement with another person for the taking of a photograph, the painting or drawing of a portrait or the making of an engraving by the other person; and

(b) the work is made in pursuance of the agreement,

the first-mentioned person shall be entitled to any copyright subsisting in the work by virtue of this Part, except that if the work is required for any particular purpose, that purpose shall be communicated to that other person and that other person shall be entitled to restrain the doing, otherwise than for that particular purpose, of any act comprised in the copyright in the work.

20.20 In the court below, Chionh J was of the view that for s 30(5) of the Copyright Act to apply in favour of the appellants, the agreement must be made with the actual photographer, *ie*, the “author” who took the raw images, and that the agreement between the parties was not an agreement for the taking of photographs within the meaning of s 30(5) of the Copyright Act, but was an agreement for a “one-stop shop” service for the branding, design and marketing needs of the appellants. The Appellate Division disagreed with this finding. Chong JA held that under s 30(5) of the Copyright Act there was no need for privity of contract between the client and the author, and the agreement did not have to be *exclusively* for photography, as long as photography was a component of the agreement.²⁰ Specifically, while “another person” in s 30(5)(a) is broad enough to encompass the “author”, “another person” could also refer to a third party to the agreement. As such, the relevant inquiry is to examine whether there was an agreement with another person for the taking of photographs.

20.21 The Appellate Division observed that it is common practice for photographers to be subcontracted to create works (as Mr Kawana was, in the present case), such that there is no direct contractual relationship between the photographer and the client. If “another person” in s 30(5)(a) was read restrictively as the author, *ie*, the photographer, this would deprive the party who commissioned the taking of the photographs of the copyright in the work that they paid for should the commissioned party unilaterally decide to subcontract the photoshoot to a freelance

19 Copyright Act (Cap 63, 2006 Rev Ed) s 30(5).

20 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [54]–[55].

photographer. A restrictive reading of “another person” would therefore effectively deprive s 30(5) of its intended legal effect.²¹

20.22 On the facts of the case, the arrangement with Wave in itself did not deprive the appellants of the ownership of the copyright under s 30(5) of the Copyright Act, as there was no statutory requirement for a direct contractual relationship between the appellants and the photographer. The Appellate Division was also of the view that reading s 30(5) in the context of the surrounding provisions, what is essential is that valuable consideration was paid for the taking of photographs. Hence, the agreement need not be solely for photography services; so long as some part of the agreement entailed the taking of photographs, the copyright in the photographs should vest in the commissioning parties.²²

20.23 It should be noted that the statutory provisions governing the rights of the first owner are couched in simpler terms under the Copyright Act 2021²³ for works created after the new legislation has entered into force. Section 133 states:

- (1) Subject to the provisions of this Act, the first owner of copyright in a work is —
 - (a) in the case of an authorial work — subject to subsection (2), the author;
 - ...
- (3) Subsections (1) and (2) are subject to any contrary intention in —
 - (a) any written agreement made on or after the appointed day by the person who would otherwise be the first owner of a copyright under those subsections; or
 - (b) any agreement before the appointed day by the person who would otherwise be the first owner of a copyright under those subsections.

20.24 Regarding the submission by the appellants that Chionh J had also erred in finding that the reproduction of the Hotel Photographs amounted to an infringement of copyright, as there was an implied licence/consent permitting the reproduction of the Hotel Photographs

21 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [57].

22 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [67].

23 2020 Rev Ed.

for the general purpose of marketing, the Appellate Division dismissed this argument.²⁴

(2) *Whether lower court erred in ordering costs against appellant on indemnity basis*

20.25 The Appellate Division concluded that the lower court erred in ordering costs against the appellants on an indemnity basis as the judgment obtained below was less favourable than the OTS.

20.26 It was undisputed that on 5 January 2021, the respondents served on the appellants an OTS which required the parties to agree to a draft consent judgment (the “Consent Judgment”) that required the appellants to agree to a number of terms. Chong JCA held that since the appellants did not accept the respondents’ OTS, the general rule on costs under O 22A r 9(1) of the ROC would apply if two conditions were satisfied: (a) the OTS must not have been withdrawn or the time limit for acceptance must not have expired before the disposal of the claim in respect of which the offer to settle was made; and (b) the judgment obtained was not less favourable than the terms of the OTS.²⁵

20.27 In the present case, there was no dispute that the OTS was not subject to an expiry date and had not been withdrawn by the respondents at any point. The Appellate Division was satisfied that the OTS made by the respondents was for the purpose of facilitating a genuine settlement between the parties, and not just to secure indemnity costs; thus the OTS was a serious and genuine one.²⁶ In determining whether the judgment obtained was less favourable than the terms of the OTS, it was held that the court should consider all the terms of the OTS, and not only the settlement sum.²⁷ Chong JCA opined that para 6 of the OTS had an extremely broad effect, as it essentially required the appellants to admit that they and *other entities*, including their managers and agents, did not have any defences to the infringement. While the court below granted an injunction to restrain the appellants and other entities under their

24 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [71]–[79] (affirming the application of the three-step test in *Sembcorp Marine Ltd v PPL Holdings Pte Ltd* [2013] 4 SLR 193 at [101]).

25 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [88] (citing *Ong & Ong Pte Ltd v Fairview Developments Pte Ltd* [2015] 2 SLR 470 at [19(f)]).

26 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [93] (distinguishing *Colliers International (Singapore) Pte Ltd v Senkee Logistics Pte Ltd* [2007] 2 SLR(R) 230).

27 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [94] (citing *NTUC Foodfare Co-operative Ltd v SIA Engineering Co Ltd* [2018] 2 SLR 1043 at [21]–[22]).

control from using the photographs moving forward, this was clearly distinct from para 6 of the OTS requiring the appellants to admit that they and other entities, including their managers and agents, had no defences to any prior infringement. Viewed in this manner, it was clear that the judgment obtained by the respondents was indeed less favourable than the OTS, and Chong JCA held that costs should have been ordered on a standard basis. The costs order was thus revised downwards from \$300,000 plus disbursements to \$200,000 plus disbursements.²⁸

B. Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd – Standing to sue for infringement – Section 153(1) Copyright Act 2021 – Exclusive licensee

20.28 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd*²⁹ is a High Court decision handed down in September 2023. The claimant, Tiger Pictures Entertainment Ltd, is a company incorporated in the People’s Republic of China. It is engaged in the business of selling and distributing films around the world. The defendant, Encore Films Pte Ltd, is a company incorporated in Singapore that distributes films in Singapore and other countries in Southeast Asia. This decision essentially affirms the principle set out in an earlier decision that a statutory exclusive licensee cannot itself grant a statutory exclusive licence by way of a sublicense that would confer on that third party standing to sue for copyright infringement.

20.29 The owner of the copyright in the film “Moon Man” is a Chinese company, Kaixin Mahua (“Kaixin”), that had entered into a licence agreement with the claimant on 19 August 2022 that would last until August 2033 (“19 August Agreement”). Under this 19 August Agreement, the claimant was the exclusive licensee in respect of the relevant rights to “Moon Man” in all jurisdictions worldwide except for the People’s Republic of China and the Republic of Korea.

20.30 Pursuant to cl 2.6 of the 19 August Agreement, the claimant was granted the right to sublicense the copyright in “Moon Man” without exceeding the scope permitted by the 19 August Agreement. According to the claimant, on 20 August 2022, it granted an exclusive licence to its related entity in Hong Kong, also known as Tiger Pictures Entertainment Ltd (“HK Tiger”), in respect of the relevant rights to “Moon Man” (“20 August Agreement”). The claimant brought a claim for copyright infringement against the defendant.

28 *General Hotel Management (Singapore) Pte Ltd v The Wave Studio Pte Ltd* [2023] 1 SLR 1317 at [98]–[101].

29 [2024] 3 SLR 1268.

20.31 The defendant submitted that the claimant did not fulfil the requirements under s 153(1) of the Copyright Act 2021, and therefore had no standing to sue. Specifically, the defendant alleged that at the time of the alleged copyright infringement, the claimant was not the exclusive licensee of the copyright in “Moon Man” because it had wholly licensed its exclusive right of distribution, as well as other rights to the film, to its related entity HK Tiger, pursuant to the 20 August Agreement.

20.32 Section 153(1) of the Copyright Act 2021 states that:³⁰

153.—(1) ... an action against a person for an infringement of copyright may be brought in the Court by —

(a) the copyright owner; or

(b) if an exclusive licence of the copyright is in force at the time of the infringement — the exclusive licensee.

It was established in an earlier decision, *Alliance Entertainment Singapore Pte Ltd v Sim Kay Teck*³¹ (“*Alliance Entertainment*”), albeit in relation to the old Copyright Act,³² that a claim for copyright infringement can only be made by the copyright owner or the exclusive licensee of the copyright. In *Composers and Authors Society of Singapore Ltd v Fox Networks Group Singapore Pte Ltd*,³³ it was also held that the plaintiff COMPASS lacked standing to bring claims for primary infringement because it was only licensed the right of authorisation by the Performing Right Society Ltd and Australian Performing Right Association Ltd, and was *not* the exclusive licensee of the right to communicate the disputed musical works to the public or to perform these works in public.³⁴ Furthermore, pursuant to s 103(1)(a) of the Copyright Act 2021, an “exclusive licence”, in relation to a copyright, is a licence that is granted by the owner or prospective owner of the copyright.

20.33 Dedar Singh Gill J held that the claimant was a statutory exclusive licensee within the meaning of s 103 of the Copyright Act 2021 and had standing to maintain the present action; the defendant’s application to strike out the action was accordingly dismissed.³⁵

20.34 Pursuant to the 20 August Agreement, HK Tiger’s licence was granted by the claimant, and *not* the owner of the copyright, *ie*, Kaixin.

30 Copyright Act 2021 (2020 Rev Ed) s 153(1).

31 [2007] 2 SLR(R) 869.

32 Cap 63, 2006 Rev Ed.

33 [2022] 3 SLR 1099.

34 See David Tan & Susanna HS Leong, “Intellectual Property Law” (2021) 22 SAL Ann Rev 567 at 568–570.

35 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268 at [20].

This would mean that under s 103(1)(a), HK Tiger did not satisfy the statutory requirements of being an exclusive licensee and the claimant remained the statutory exclusive licensee.

20.35 Notwithstanding that the formality requirements for an exclusive licence are now set out in a separate provision in s 142 of the Copyright Act 2021, the position in Singapore law has not changed: “A statutory exclusive licensee cannot himself grant a statutory exclusive licence by way of sublicence.”³⁶ Gill J cited with approval the judgment of Sundaresh Menon JC in *Alliance Entertainment*, that “[w]hen an exclusive licensee grants a sublicence, he is acting on his own behalf and not as agent or on behalf of the copyright owner”.³⁷ In the present case, the claimant could not grant a statutory exclusive licence to HK Tiger by way of sublicensing its rights in “Moon Man” pursuant to the 20 August Agreement; at best, the licence granted to HK Tiger was a contractual sublicence. Moreover, there was no suggestion at all that the consideration paid or payable by HK Tiger to the claimant was payable to Kaixin, the copyright owner, *ie*, there was nothing to show that the claimant had acted *on behalf of* Kaixin to grant the licence to HK Tiger.³⁸

20.36 Lastly, Gill J found the reasoning of a patent decision by the High Court of England and Wales in *Dendron GmbH v Regents of the University of California*³⁹ (“*Dendron*”) to be inapplicable. Section 130(1) of the UK Patents Act 1977⁴⁰ appears to contemplate that a patent proprietor is able to confer a statutory exclusive licence on a licensee who is then entitled to confer a statutory exclusive licence on a sublicensee. By contrast, as the particular statutory language does not appear in s 103(1) of the Copyright Act 2021, the reasoning in *Dendron* was held to be simply irrelevant to our local copyright regime.⁴¹ This point is reinforced by the authors of *Laddie, Prescott and Vitoria: The Modern Law of Copyright*,⁴² who observed that the definition of “exclusive licensee” is different under the UK Patents Act 1977 compared to the UK Copyright, Designs and Patents Act 1988.⁴³

36 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268 at [27].

37 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268 at [27] (citing *Alliance Entertainment Singapore Pte Ltd v Sim Kay Teck* [2007] 2 SLR(R) 869 at [11]).

38 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268 at [28].

39 [2004] FSR 43.

40 c 37 (UK).

41 *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268 at [35].

42 Adrian Speck *et al*, *Laddie, Prescott and Vitoria: The Modern Law of Copyright* vol 1 (LexisNexis Butterworths, 5th Ed, 2018) at p 1173.

43 c 48 (UK). *Tiger Pictures Entertainment Ltd v Encore Films Pte Ltd* [2024] 3 SLR 1268 at [36].

C. Siemens Industry Software Inc v Inzign Pte Ltd – Primary liability and vicarious liability for copyright infringement

20.37 In *Siemens Industry Software Inc v Inzign Pte Ltd*,⁴⁴ the General Division, in a decision by Gill J, confirmed that the doctrine of vicarious liability in tort law extended to copyright infringement.⁴⁵

20.38 The plaintiff Siemens was a company which owned the copyright in a software designed for industrial and commercial use (the “NX Software”). This software possessed computer-aided design, manufacturing and engineering capabilities. The defendant Inzign Pte Ltd was a company engaged in the business of manufacturing medical disposables and surgical supplies. It owned licences for three modules of the NX Software, each of which could only be used by a single user at any one time. In 2020, Paing Win (“Mr Win”), an employee of the defendant, installed an unauthorised version of the NX software onto a laptop at his workplace. He used certain modules in this software for several months before his misconduct was discovered and pursued by the plaintiff.

20.39 Mr Win was initially employed as a machinist, a role which involves the operation of computer numerical control machines in fabricating industrial workpieces; his role in Inzign was subsequently expanded in 2020 to include programming responsibilities, which required him to use the NX Software. According to Mr Win, work had slowed down in 2020 due to the pandemic. In the resultant free time, he decided to familiarise himself with the NX Software by watching tutorials on YouTube which demonstrated different techniques and shortcuts. He tried to install the NX Software on his personal computer, but it would not support the program; he tried again on one of the defendant’s computers but was unsuccessful as he could not bypass the administrative controls. Mr Win then found an unused Lenovo laptop (the “Lenovo Laptop”) in the toolroom at the defendant’s premises, discovered that there were no administrative controls, downloaded and installed the infringing NX Software on it. He used the NX Software on at least 15 different occasions between December 2020 and April 2021.

20.40 In March 2021, an employee of the plaintiff discovered the unauthorised use of the plaintiff’s NX Software through an automatic reporting function built into the software. When attempts at an amicable

44 [2023] 4 SLR 1681.

45 See also a more detailed commentary in Jevon Louis, Tan Jing Han Alvin & Chong Kar Yee Cristel, “Employer’s Liability for Copyright Infringement and the Assessment of Damages: *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] SGHC 50” [2023] SAL Prac 15.

settlement were unsuccessful, Siemens sued Inzign for being primarily liable and vicariously liable for Mr Win's acts of copyright infringement.

(1) *Primary liability for copyright infringement*

20.41 The starting point of the analysis is s 31(1) of the old Copyright Act.⁴⁶ Gill J was of the view that the relevant question here was whether these acts may be attributed to the defendant such that it is taken to have committed them itself. This depended on whether Mr Win was acting in the course of his duties as an agent of Inzign⁴⁷ or in the exercise of specific powers found in Inzign's constitution or in general company law.⁴⁸ But, on the facts, there was no evidence that Mr Win's infringing acts could be attributed to the defendant.

20.42 Regarding authorisation liability under s 31(1) of the Copyright Act, Gill J opined that "authorisation" has been interpreted to refer to "the sanctioning, approving, or countenancing of the infringing use" and it is the "grant or the purported grant, which may be express or implied, of the right to do the act complained of".⁴⁹ Gill J referred to four factors articulated by the Court of Appeal in *RecordTV Pte Ltd v MediaCorp TV Singapore Pte Ltd*⁵⁰ which the courts ought to take into account in determining if authorisation liability should be imposed:⁵¹

- (a) whether the alleged authoriser had control over the means by which copyright infringement was committed and, hence, a power to prevent such infringement ('the first authorisation liability factor');
- (b) the nature of the relationship (if any) between the alleged authoriser and the actual infringer ('the second authorisation liability factor');
- (c) whether the alleged authoriser took reasonable steps to prevent or avoid copyright infringement ('the third authorisation liability factor'); and
- (d) whether the alleged authoriser had actual or constructive knowledge of the occurrence of copyright infringement and/or the likelihood of such infringement occurring ('the fourth authorisation liability factor').

46 Copyright Act (Cap 63, 2006 Rev Ed) s 31(1).

47 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [21] (citing *MCA Records Inc v Charly Records Ltd* [2000] EMLR 743 at [10]–[11]).

48 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [21] (citing *Red Star Marine Consultants Pte Ltd v Personal Representatives of Satwant Kaur d/o Sardara Singh, deceased* [2020] 1 SLR 115 at [35]).

49 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [23] (referring to *Ong Seow Pheng v Lotus Development Corp* [1997] 2 SLR(R) 113 at [29]).

50 [2011] 1 SLR 830.

51 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [23] (citing *RecordTV Pte Ltd v MediaCorp TV Singapore Pte Ltd* [2011] 1 SLR 830 at [50]).

20.43 The court was satisfied that there was no authorisation liability on the part of Inzign.⁵² On the first factor, the defendant did not have the power to prevent Mr Win’s acts of infringement as it did not have any control over what Mr Win did on the Lenovo Laptop. On the second factor, the defendant and Mr Win were in a contractual relationship of employment. On the third factor, the defendant was found to have failed to take reasonable steps in preventing Mr Win’s acts of copyright infringement; in particular, Inzign was careless in its management of the Lenovo Laptop, which was left unsecured. On the fourth factor, Gill J was of the opinion that the defendant did not have knowledge, either actual or constructive, of the occurrence of copyright infringement or the likelihood of such infringement occurring.

(2) *Vicarious liability for copyright infringement*

20.44 Vicarious liability has been recognised for centuries as a rule of responsibility which obliges the defendant to be liable for the torts committed by another party even though the defendant is not personally at fault. Despite “the dearth of local case law on this point”, Gill J held that the doctrine of vicarious liability is applicable to the statutory tort of copyright infringement,⁵³ and that this conclusion was consistent with the position in other leading common law jurisdictions.⁵⁴ Citing the Court of Appeal’s five-member full bench unanimous decision in *Ng Huat Seng v Munib Mohammad Madni*⁵⁵ (“*Ng Huat Seng*”), Gill J commented that “vicarious liability is a form of secondary liability which holds a defendant liable for the wrongful acts of another even if the defendant has not been negligent at all”.⁵⁶

20.45 The rationales for vicarious liability include internalisation of enterprise risk,⁵⁷ victim compensation and deterrence.⁵⁸ In 2011,

52 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [24]–[30].

53 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [32]. Recently, the Supreme Court of the United Kingdom have held that an employer may be vicariously liable for an employee’s breach of duty of confidence.

54 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [33]–[34].
55 [2017] 2 SLR 1074.

56 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [32] (referring to *Ng Huat Seng v Munib Mohammad Madni* [2017] 2 SLR 1074 at [41]).

57 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [32] (referring to *Skandinaviska Enskilda Banken AB (Publ), Singapore Branch v Asia Pacific Breweries (Singapore) Pte Ltd* [2011] 3 SLR 540 at [70]).

58 For a comprehensive analysis of the doctrine of vicarious liability in Singapore, see David Tan, “Enterprise Risk and Vicarious Liability in Singapore” in *Vicarious Liability in the Common Law World* (Paula Giliker ed) (Hart Publishing, 2022) at p 121; David Tan, “Taking Two Bites at the Cherry: Vicarious Liability and Non-Delegable Duty” (2018) 134 *Law Quarterly Review* 193; and David Tan, (cont’d on the next page)

Chan Sek Keong CJ, delivering the judgment for the Court of Appeal in *Skandinaviska Enskilda Banken AB (Publ), Singapore Branch v Asia Pacific Breweries (Singapore) Pte Ltd*⁵⁹ (“*Skandinaviska*”), endorsed the approach taken by the Supreme Court of Canada where McLachlin CJ restated the rationale of vicarious liability as follows:⁶⁰

Vicarious liability is based on the rationale that the person who puts a risky enterprise into the community may fairly be held responsible when those risks emerge and cause loss or injury to members of the public. Effective compensation is a goal. Deterrence is also a consideration. The hope is that holding the employer or principal liable will encourage such persons to take steps to reduce the risk of harm in the future.

20.46 The applicable test to determine whether vicarious liability should be imposed is a two-stage inquiry as established in *Ng Huat Seng*:

- (a) There must be a special relationship between the tortfeasor and the defendant (“the First Inquiry” or “Stage 1”).
- (b) There must be a sufficient connection between the defendant and the tortfeasor on the one hand, and the commission of the tort on the other (“the Second Inquiry” or “Stage 2”).

20.47 It should be noted that *Ng Huat Seng* was concerned with Stage 1 of the test,⁶¹ and *Skandinaviska* was a case concerned with Stage 2 and the ambit of the close connection test. Stage 2 determines the scope of the employer’s or deemed employer’s liability, and requires that the wrongful act be committed in the course of employment.

20.48 In *Skandinaviska*, Chan CJ unequivocally approved of a two-pronged approach in Stage 2 to examining whether a close connection existed for the purposes of imposing vicarious liability on an employer for the intentional wrongdoing of an employee: first, the court should consider the factual matrix by applying the five factors proposed by McLachlin J in *Bazley v Curry*⁶² (“*Bazley*”); and second, policy considerations of effective victim compensation and deterrence of future harm in the light of better management of enterprise risks should guide

“Internalising Externalities’: An Enterprise Risk Approach to Vicarious Liability in the 21st Century” (2015) 27 SAcLJ 822.

59 [2011] 3 SLR 540.

60 *Skandinaviska Enskilda Banken AB (Publ), Singapore Branch v Asia Pacific Breweries (Singapore) Pte Ltd* [2011] 3 SLR 540 at [70] (citing *Roman Catholic Episcopal Corporation of St George’s v John Doe and John Doe* [2004] 1 SCR 436 at [20]).

61 See also *BNM v National University of Singapore* [2014] 4 SLR 931 at [31]–[32].

62 *Skandinaviska Enskilda Banken AB (Publ), Singapore Branch v Asia Pacific Breweries (Singapore) Pte Ltd* [2011] 3 SLR 540 at [87]–[88] and [95] (referring to *Bazley v Curry* [1999] 2 SCR 534).

the court's determination of whether it would ultimately be fair and just to impose vicarious liability.⁶³

20.49 The *Bazley* factors,⁶⁴ relevant in determining whether the requisite degree of connection exists in a particular case, include: (a) the opportunity that the enterprise afforded the employee to abuse his or her power; (b) the extent to which the wrongful act may have furthered the employer's aims (and hence be more likely to have been committed by the employee); (c) the extent to which the wrongful act was related to friction, confrontation or intimacy inherent in the employer's enterprise; (d) the extent of power conferred on the employee in relation to the victim; and (e) the vulnerability of potential victims to wrongful exercise of the employee's power. Gill J highlighted factors (a), (b) and (e) to be relevant to the case at hand.

20.50 Regarding the First Inquiry, it was satisfied as Mr Win and Inzign were indisputably in an employer-employee contractual relationship. Regarding the Second Inquiry, Gill J held that there existed a sufficient connection between the employment relationship between Mr Win and the defendant and the infringing acts which occurred. In particular, the infringing acts were committed in the context of Mr Win's employment for the defendant's benefit even though the NX Software was not used in relation to the defendant's official projects or jobs. Pertinently, Mr Win did not install the infringing software in furtherance of his personal interests (sometimes described as the tortfeasor "going on a frolic of his own"⁶⁵); he testified that he wanted to become more skilful in using the NX Software by obtaining more practice which evinces the ultimate objective behind Mr Win's acts of infringement – to improve his performance *at work* which would translate into an increase in productivity that would benefit the defendant.⁶⁶ Gill J emphasised that the finding that Mr Win's infringing acts were carried out in the *context* of his employment did not mean that they were committed within the *authorised scope* of his employment, but this would nonetheless satisfy the modern test for vicarious liability under Stage 2.⁶⁷ Lastly, this conclusion was supported

63 *Skandinaviska Enskilda Banken AB (Publ), Singapore Branch v Asia Pacific Breweries (Singapore) Pte Ltd* [2011] 3 SLR 540 at [77]–[83] and [92]–[93].

64 *Bazley v Curry* [1999] 2 SCR 534 at [41].

65 *WM Morrison Supermarkets plc v Various Claimants* [2020] UKSC 12 at [37] (citing *Joel v Morison* (1834) 6 C & P 501 at 503).

66 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [40]. See also *Mohamud v WM Morrison Supermarkets plc* [2016] UKSC 11.

67 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [40]. Mr Win's conduct here stands in stark contrast to that of the employee who intentionally disclosed the personal data of 98,998 employees of Morrisons specifically to harm his employer: *WM Morrison Supermarkets plc v Various Claimants* [2020] UKSC 12
(*cont'd on the next page*)

by a consideration of the two policy considerations highlighted in *Skandinaviska* of ensuring the effective compensation of the victim and the deterrence of future harm.

(3) *Assessment of damages*

20.51 Gill J held that the “Hypothetical Bargain Approach” should be adopted, *ie*:⁶⁸

... where it is not possible to prove a normal rate of profit or an established licence royalty, the appropriate measure of damages is the price which, although no price was actually quoted, the plaintiff could have reasonably charged for the infringer to have used the copyright in a hypothetical bargain.

It was relevant that the plaintiff had adduced no evidence with respect to the profit it gained from the sale of each module by its distributor or reseller to an end-user, and also had not provided evidence on the prices of any actual licences granted by itself, its distributors or resellers. Gill J commented that the Hypothetical Bargain Approach is founded upon the “user principle”, which is the principle that a person who has made wrongful use of another person’s property may be held liable to pay a reasonable sum of damages for this use.⁶⁹

20.52 The court found the plaintiff’s measure of damages at \$259,511 to be excessive, especially when at all material times, the defendant had legally licensed the use of three modules from the plaintiff. Gill J concluded that the appropriate measure of damages should be \$30,574 (being the cost of perpetual node-locked licences for two of the modules which were used by Mr Win). A permanent injunction was also granted, restraining the defendant from further infringements of the plaintiff’s copyright subsisting in the NX Software.

(such conduct failed the close connection test in Stage 2 of the vicarious liability analysis).

68 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [53] (citing *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] 1 WLR 819 at 824–826).

69 *Siemens Industry Software Inc v Inzign Pte Ltd* [2023] 4 SLR 1681 at [55].

II. Geographical indications

A. **Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc – Section 41(1)(f) Geographical Indications Act 2014 – Opposition to registration**

20.53 The Court of Appeal considered for the first time the law on geographical indications in Singapore. In *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Inc*⁷⁰ (“Prosecco GI”), the Consorzio di Tutela della Denominazione di Origine Controllata Prosecco (the “Consorzio”) 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. The Consorzio is a trade body established and organised under the laws of Italy and is responsible in Italy for protecting, promoting, marketing and generally overseeing the use of the term “Prosecco”. However, the Australian Grape and Wine Inc (“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.

20.54 On 3 May 2019, the Consorzio applied to register “Prosecco” as a GI in respect of wines in Singapore. The claimed geographical area for the production of “Prosecco” wines by the Consorzio was the North-East region of Italy, and included the entire territory of Belluno, Gorizia, Padova, Pordenone, Treviso, Trieste, Udine, Venice and Vicenza (the “Specified Region”). The Application GI was accepted and published in the Geographical Indications Journal under Geographical Indication No 50201900088S on 21 June 2019. On 9 September 2019, AGWI filed a notice of opposition against the registration of the Application GI.

20.55 AGWI relied on two grounds in its opposition to the registration: (a) s 41(1)(a) of the Geographical Indications Act 2014⁷¹ (“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. 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 in a decision by Valerie Thean J allowed AGWI’s appeal on the

70 [2023] 2 SLR 509.

71 2020 Rev Ed.

basis of s 41(1)(f) of the GIA but not s 41(1)(a) of the GIA.⁷² Thean J noted that the Application GI would be likely to mislead the consumer if “Prosecco” grapes and “Prosecco” wines had been cultivated or produced in significant quantities outside the Specified Region, and given the evidence that “Prosecco” wines were being produced in commercial quantities in countries such as Australia, Thean J concluded that the Application GI was likely to mislead the consumer in Singapore.

20.56 On appeal to the Court of Appeal against the General Division’s decision in relation only to the ground of opposition under s 41(1)(f) of the GIA, the unanimous full bench of five judges allowed the Consorzio’s appeal with the result that the Application GI must be allowed to proceed to registration. This appeal is the first time the Court of Appeal has had to consider the operation and interpretation of various provisions under GIA which came into force on 1 April 2019. Judith Prakash JCA delivered the judgment of the Court of Appeal (with whom Tay Yong Kwang JCA, Steven Chong JCA, Belinda Ang JCA and Woo Bih Li JAD agreed).

20.57 The Court of Appeal noted that there are two main approaches to the notion of GI. The first is what is known as the *terroir* approach which refers to the objectively verifiable causal connection between a product’s qualities and its region of origin.⁷³ The second is connected to unfair competition where “the paramount consideration is whether a valuable reputation exists in the marketplace for a regional product”.⁷⁴ The court commented that:⁷⁵

GIs are signs or marks used, in relation to goods, to identify that the goods originate from a particular region or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin.

In tracing the history of GI protection in Singapore, the Court of Appeal observed that in particular, ss 4(2)(c) and 4(2)(d) of the GIA set out the

72 *Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2022] 2 SLR 509. This decision was discussed in David Tan & Susanna H S Leong, “Intellectual Property Law” (2022) 23 SAL Ann Rev 577 at paras 20.1–20.26.

73 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [2]–[4].

74 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [5].

75 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [42] (citing Ng-Loy Wee Loon, *Law of Intellectual Property in Singapore* (Sweet & Maxwell, 3rd Ed, 2021) at para 28.0.1).

“special non-confusion based protection reserved for GIs identifying wines or spirits”⁷⁶

20.58 The Court of Appeal reiterated that when an objection is raised to the registration of a GI under s 41(1)(f) of the GIA, the threshold requirement is that the proposed GI contains the name of a plant variety or an animal breed, before one moves on to consider whether the Application GI was likely to mislead the consumer as to the true origin of the product.⁷⁷ Prakash JCA emphasised that the principles relating to the interpretation of Art 6(2) of the Regulation on Quality Schemes for Agricultural Products and Foodstuffs⁷⁸ are not useful in arriving at the proper interpretation of s 41(1)(f) of the GIA, as “there are marked differences between the Singapore model of GI protection and the EU model”;⁷⁹ what is more relevant and pertinent to statutory interpretation here is the parliamentary intention in Singapore behind s 41(1)(f).⁸⁰

20.59 In discerning parliamentary intention, all the relevant materials surrounding the promulgation of s 41(1)(f) should be considered. As Singapore implemented the GIA to comply with its obligations under the EU-Singapore Free Trade Agreement (“EUSFTA”), the provisions of the EUSFTA would be useful in the interpretation of s 41(1)(f). Significantly, the side letter of the EUSFTA which recorded the following agreement reached between Singapore and the EU on the registration of plant varieties as a GI states:⁸¹

Parties agree that Kalamata, and Valencia, as plant varieties, shall not prevent the eligibility for registration of Elias Kalamatas and Citricos Valencianos as geographical indications, provided it will not prevent the use of the said varieties.
[emphasis in original]

20.60 This agreement in the side letter is reflected in s 15(b) of the GIA which allows the registration of GIs that contain the name of a plant variety, provided that such registration shall not prevent the use of the

76 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [25] (citing Ng-Loy Wee Loon, *Law of Intellectual Property in Singapore* (Sweet & Maxwell, 3rd Ed, 2021) at para 28.3.5).

77 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [30].

78 EU Council Regulation No 1151/2012, [2012] OJ L 343/1 (EU) Art 6(2).

79 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [33].

80 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [34]. See also *Attorney-General v Ting Choon Meng* [2017] 1 SLR 373 at [18].

81 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [36].

name as a plant variety.⁸² What this means is that “the recognition of the need to protect the use of such names in the course of trade indicates that the query as to whether the name is one of a plant variety or an animal breed must be an objective one, not connected with the subjective beliefs of consumers”.⁸³

20.61 Prakash JCA pointed out that when one reads s 15(b) and s 41(1)(f) of the GIA, in the context of what was agreed in the side letter to the EUSFTA, it is essentially “the confusion requirement that serves as gatekeeper when it comes to the registration of GIs that contain the name of plant varieties or animal breeds”.⁸⁴ The consumer may be misled as to the true origin of the GI-denominated goods if the plant variety or animal breed is cultivated in large quantities outside of the defined area for which the GI is registered. However, due to the fundamentally different protection rationales between GIs and trade marks, the Court of Appeal cautioned against importing principles of trade mark law into the law of GIs as both are “distinct species of intellectual property”.⁸⁵

20.62 Thus, it follows that the principles governing the refusal of registration of a trade mark under s 7 of the Trade Marks Act 1998⁸⁶ (“TMA”) cannot be wholly imported into the GIA. In so far as the analysis of s 41(1)(f) of the GIA is concerned, this provision ought to be examined within the context of the GIA and not the TMA, especially given the specific policy considerations raised by use of the names of plant varieties or animal breeds as GIs as discerned from the side letter of the EUSFTA.

20.63 The Court of Appeal emphasised that all references to “the consumer” in s 41(1)(f) of the GIA are plainly references to the consumer in Singapore which is defined as Singapore citizens and residents and not those who are merely passing through.⁸⁷ In respect of the argument raised by AGWI that an EU Commission Regulation had renamed the grape variety “Prosecco” as “Glera”, the Court of Appeal opined that the change in the scientific or legal name may not affect consumers’ perceptions; an *objective* determination could nonetheless hold that “a GI containing

82 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [35]–[37].

83 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [38].

84 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [39].

85 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [42]–[47].

86 2020 Rev Ed.

87 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [49].

the old name would be a GI containing the name of a plant variety or an animal breed notwithstanding the change in nomenclature by any particular country or producer”.⁸⁸ Adopting a rather liberal approach, the Court of Appeal held:⁸⁹

All that would need to be shown to demonstrate that the GI sought to be registered contains the name of a plant variety or an animal breed, is that the name in question is indeed recognised as the name of a plant variety or an animal breed by a not insignificant population of people. Evidence of this could come from sources such as reputable scientific journals, or legal registers of plant varieties or from the general usage of the term as denoting a plant variety or an animal breed among a body of consumers or producers.

20.64 Regarding the second limb in s 41(1)(f) of the GIA of whether the consumer in Singapore is likely to be misled by the GI that is sought to be registered, the Court of Appeal held that the focus of the inquiry is “whether the Singapore consumer is likely to be misled, by the GI sought to be registered, as to the *true geographical origin* of the goods” [emphasis in original].⁹⁰ On the facts of the case, the relevant question would be whether the Application GI is likely to mislead consumers into thinking that “Prosecco” wine could only originate from the Specified Region when, in fact, their true origin could be other geographical locations where the “Prosecco” grape variety is used to make wine.

20.65 Noting that it is the party opposing the registration of the Application GI who bears the burden of proof, Prakash JCA observed that there are at least three factors that must be taken into account in determining whether such a GI is likely to mislead the Singapore consumer as to the true geographical origin of the product: (a) whether the average consumer in Singapore is even aware that the name in question is indeed the name of a plant variety or an animal breed; (b) whether the Singapore consumer is aware that the plant variety or animal breed in question is involved in the production of the product over which GI protection is sought; and (c) what is the message conveyed to the Singapore consumer by the GI.⁹¹

20.66 In the Court of Appeal’s view, AGWI had crossed the threshold of showing that “Prosecco” is, objectively, the name of a plant variety,

88 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [50].

89 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [51].

90 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [55].

91 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [56]–[60].

but the evidence which AGWI had adduced failed to establish that the Singapore consumer was likely to be misled by the Application GI at that time. In particular, the Court of Appeal noted that “AGWI did not produce any evidence of consumer surveys and instead chose to rely on advertising materials as well as statistics showing the increase in the volume of Australian ‘Prosecco’ imported into Singapore”.⁹²

20.67 Even if consumer surveys were produced, Prakash JCA cautioned that adducing such surveys showing that the consumer is likely to be deceived is not, in and of itself, determinative of the issue. To enhance the probative value of such surveys, Prakash JCA advised that “it would be relevant to provide evidence of what questions were asked in the surveys, the demographics of those surveyed and how the survey was conducted”.⁹³ Essentially advertising materials and sales figures of goods originating from another region may be useful only to show that a product has been marketed to consumers in Singapore, but consumer surveys ought to be used as a more direct means to prove that the Singapore consumer is likely to be misled when opposing a GI registration.

20.68 The Court of Appeal also disagreed with Thean J’s finding, concluding that figures showing an increase in the volume of Australian “Prosecco” imported into Singapore show, at best, that local wine sellers are managing to sell *more* Australian “Prosecco” than previously but does not sufficiently inform the “material inquiry” that Singapore consumers might be aware that “Prosecco” is also the name of a grape variety used to make wine of the same name.⁹⁴

20.69 In summary, as AGWI has failed to establish that the Application GI is likely to mislead the Singapore consumer as to the true geographical origin of “Prosecco”, the Application GI by the Consorzio therefore must be allowed to proceed to registration.

92 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [68].

93 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [69].

94 *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] 2 SLR 509 at [70].

B. Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano – Sections 41(1)(b) and 42(2)(b) of Geographical Indications Act 2014 – English translation of foreign name

20.70 The GIA accords protection to all registered geographical indications, including the GI “Parmigiano Reggiano” owned by Consorzio del Formaggio Parmigiano Reggiano (the respondent) for cheese. This protection extends to any unauthorised use of a geographical indication in translation. Third parties may, however, submit a request to qualify the scope of such protection from extending to specific terms on the basis that such terms are *not* translations of the geographical indication in question.

20.71 Fonterra Brands (Singapore) Pte Ltd (the appellant) asserted that the term “Parmesan” is not a translation of “Parmigiano Reggiano”; the respondent opposed the request. PAR Sandy Widjaja, who heard this matter, found in favour of the respondent, *ie*, that “Parmesan” is a translation of “Parmigiano Reggiano” and should therefore be accorded protection under the GIA. The decision was appealed to the High Court.

20.72 The appellant is a wholly-owned subsidiary of Fonterra Co-operative Group Ltd, a New Zealand-based multinational co-operative company owned by 10,000 dairy farmers, involved in the collection, manufacture and sale of milk and milk-derived products. These products include cheese sold by the appellant under the “Perfect Italiano” trade mark, which is produced in Australia, and is marketed as “traditional style parmesan”, adopting the colours of the Italian national flag on its packaging.

20.73 “Parmigiano Reggiano” cheese was first produced in the 1200s in monasteries located in Parma and Reggio Emilia. Over the centuries, this cheese has become associated with the term “Parmigiano Reggiano”, with the words “Parmigiano” and “Reggiano” meaning “of Parma” and “of Reggio Emilia” respectively. As production of “Parmigiano Reggiano” expanded in the 1900s, dairy farmers created the respondent as a vehicle to manage competition from cheaper imitation products.

20.74 On 23 April 2019, the respondent filed an application with the Intellectual Property Office of Singapore (“IPOS”) to register “Parmigiano Reggiano” as a GI in respect of cheese originating from Italy, and the application successfully proceeded to registration on 22 June 2019. On 16 September 2019, the appellant filed a request to qualify the rights conferred on the geographical indication “Parmigiano Reggiano” under s 46(1)(b) read with s 46(2)(b) of the GIA on the basis that “Parmesan” is not a translation of the registered GI “Parmigiano Reggiano”, seeking

to limit the protection accorded to the geographical indication from encompassing the use of the term “Parmesan” (the “Request”). On 12 November 2019, the Registrar of Geographical Indications (the “Registrar”) proposed to allow the Request.⁹⁵ The respondent filed an opposition to the Request which was heard on 15 March 2022 by the PAR who allowed the opposition.

20.75 In the General Division, Gill J upheld the PAR’s findings and dismissed the appeal. There were three issues for determination: (a) whether the Appellant’s pleaded case prevents it from appealing the PAR’s decision that “Parmesan” is a translation of “Parmigiano Reggiano”; (b) who bears the burden of proof where a proposed qualification of rights is opposed; and (c) whether “Parmesan” is a translation of “Parmigiano Reggiano”.

20.76 Regarding the first issue, Gill J found that the appellant has adequately pleaded the material fact that “Parmesan” is not a translation of “Parmigiano Reggiano” which was stated not only in Pt 5 of Form GI2 (as observed by the PAR), but also in the second paragraph of the Statement of Grounds accompanying the appellant’s counter-statement.⁹⁶ Moreover, the appellant stated in its Statement of Grounds accompanying the Request that it was applying for the qualification of rights under s 46(2)(b) of the GIA, which in turn refers to the ground on which a term is not a translation of the *geographical indication*. This would have indicated to the respondent that the appellant’s case is that “Parmesan” is not a translation of the *entire* GI “Parmigiano Reggiano”. In summary, Gill J was satisfied that the respondent was not prejudiced by the inconsistencies within the appellant’s forms and documents.

20.77 Regarding the second issue, Gill J agreed with the PAR that:⁹⁷

... when an owner of a registered geographical indication seeks to *extend* the protection of its geographical indication to a purported translation, whether by way of enforcement proceedings or by opposing a third party’s request for the qualification of rights, the owner must bear the burden of proof pursuant to s 103(1) of the [Evidence Act 1893]. [emphasis in original]

Gill J explained that if applicants of GIs do not indicate the specific translations which they seek protection for at the outset, it would be

95 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [10].

96 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [34].

97 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [39].

difficult to see how there can exist default protection for any and all purported translations of these GIs. If that were the case, the scope of the rights pertaining to the geographical indication would necessarily be amorphous from the point of registration. Taking the view that translations are not automatically protected upon registration, Gill J held that an application of s 103(1) of the Evidence Act⁹⁸ indicates that the burden should lie on the party opposing the qualification of rights, as it is this party which seeks to persuade the court that his rights ought to be extended.⁹⁹

20.78 Regarding the third issue, Gill J made a number of preliminary comments. Gill J noted that the present case was unique in so far as it concerns the translation of the two-word term “Parmigiano Reggiano” instead of a GI consisting only of a single word; generally, disputes concerning the translation of single-word GIs may lend themselves more easily to the courts’ determination than the present case.¹⁰⁰ Furthermore, the appellant’s pleading was *not* that the term “Parmesan” has become the generic or common name for “Parmigiano Reggiano”. Instead, it was relying *solely* on the ground in s 46(2)(b) read with s 46(1)(b) of the GIA – that “Parmesan” is *not* a translation of “Parmigiano Reggiano”, *ie*, the scope of the appeal was confined to the translation inquiry.¹⁰¹ Gill J concurred with the definition of “translation” adopted by the PAR that its plain meaning is the “action of converting from one language to another” or the “rendering from one language to another”.¹⁰² However, the parties disagreed on whether a faithful or a strict literal approach to translation should be taken. Gill J also agreed with the PAR that “it is altogether sensible for a faithful translation to be adopted for the purposes of the GIA”.¹⁰³

20.79 Gill J opined that since GIs serve to establish a link between the quality of a product and its geographical origin, a faithful translation will ensure that the meanings within these GIs – which allow them to fulfil their function – is retained within the purported translations. This, in turn, justifies the protection accorded to these translations. A faithful

98 Cap 97, 1997 Rev Ed.

99 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [40].

100 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [53].

101 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [52].

102 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [54].

103 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [59].

translation expresses the “historic, cultural, legal and economic reality that attaches to the registered name and to the product covered by that registration”.¹⁰⁴ On the other hand, an insistence on word-for-word translations may result in inaccuracies in meaning, which may “either allow protection to be extended in an unprincipled manner or unjustifiably restrict protection altogether”.¹⁰⁵ In the present case, Gill J was persuaded that expert evidence was not a necessary condition for the court to make a finding on whether “Parmesan” is a translation of “Parmigiano Reggiano”. The Hearings & Mediation Department Circular 4.2 issued by the Hearings & Mediation Department of the Intellectual Property Office of Singapore clearly permits the Trade Mark Registry to decide on matters of translation *without* the assistance of certified translations and also states that dictionary extracts may be taken into account where the content to be translated is “short”.¹⁰⁶

20.80 For the purposes of the translation inquiry, Gill J took the position that consumer perception, as evinced through marketplace evidence, is generally irrelevant,¹⁰⁷ and its exclusion will minimise uncertainty.¹⁰⁸ Gill J agreed with the PAR’s suggestion that only such consumer perception as captured in dictionary entries should be relevant since “[s]ignificant changes in meaning will logically be reflected in the entries of reputable dictionaries, as these entries will be the layperson’s first port of call in ascertaining the proper meaning of particular words”.¹⁰⁹ Finally, Gill J rejected the European doctrine of evocation on the basis that it “is neither statutorily provided for in the GIA nor recognised under Singapore law”.¹¹⁰

20.81 In conclusion, Gill J was of the view that although “Parmigiano Reggiano” is an Italian term, English dictionaries may nevertheless be useful in establishing the meaning of this term in English because

104 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [59] (citing *R v Re Criminal Proceedings against Bigi* [2002] 3 CMLR 3 at [A50]).

105 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [59].

106 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [65].

107 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [72].

108 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [75].

109 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [74].

110 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [76] (referring to *Scotch Whisky Association v Isetan Mitsukoshi Ltd* [2020] 3 SLR 725 at [39]).

“Parmigiano Reggiano” has, through decades of usage, entered into the English vernacular.¹¹¹ In particular, the Collins Dictionary extract was persuasive in establishing the unity of meaning between the English word “Parmesan” and the Italian term “Parmigiano Reggiano”. The Larousse Italian-French Dictionary and the Cambridge Italian-English Dictionary also showed that the word “Parmesan” bore the same meaning as “Parmigiano Reggiano”. The respondent Consorzio del Formaggio Parmigiano Reggiano had therefore met its burden of proving that “Parmesan” is a translation of “Parmigiano Reggiano”.

III. Trade marks

20.82 This review covers three trade mark decisions delivered in 2023. Two of the decisions were delivered by the Singapore High Court and one by the Trade Mark Registry.

A. Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd

(1) Facts and background

20.83 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd*¹¹² (“*Dr Who*”) was a case decided by Gill J in the General Division that involved a multiplicity of claims and counterclaims. Parties’ claims centered on trade mark infringements, passing off, breach of contract, unlawful conspiracy and wrongful detention.

20.84 It was not disputed that the core business of the plaintiffs, Dr Who Waterworks Pte Ltd, was in the supply of five-gallon bottled water and the leasing and placement of water dispensers in Singapore. It was also not disputed that in the early years of the commercial relationship between the fourth and fifth defendants in counterclaim (the “Kohs”) and the second and third defendants (the “Oos”), and for a significant period from 2002 to 2011, the bottled water sold by the plaintiffs was manufactured and supplied by a company owned and operated by the Oos. The defendants, Dr Who (M) Sdn Bhd, were incorporated in Malaysia in 2007 to undertake the business of dealing in mineral water and aerated water as well as the provision of integrated logistics services. In fact, the defendants were to operate as the manufacturing arm of the plaintiffs with the intent of distancing the supply of the bottled water from the Oos. The plaintiffs subsequently expanded their business to

111 *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2023] SGHC 77 at [80].

112 [2023] SGHC 156.

include the provision of bottled water with customised label design and personalised branding of their clients.

20.85 In 2004, the plaintiffs registered the mark “DR. WHO” in Classes 39 (delivery of bottled water to homes and offices; water supply services) and 32 (bottled water [not for medical purposes]; oxygenated water; drinking water; aerated water; waters [beverages] other than for medical purposes) in Singapore. In 2007, a trade mark which bore the words DR. WHO with two decorative “swooshes” at the bottom-right corner of the words was registered in Malaysia in the Oos’ name. As a result of a branding exercise in 2012, the plaintiffs registered a mark which comprised the term DR. WHO with four water droplets in a quatrefoil shape at its top-right corner (the “DR. WHO quatrefoil mark”) in Classes 11 (water treatment units) and 40 (treatment of water). In 2013, the business relationship between the Kohs and the Oos began breaking down which finally resulted in a parting of ways. In 2016, the Kohs and the Oos were embroiled in legal suits in Malaysia. Three days after the commencement of the suits in Malaysia, the Oos registered in Malaysia a mark containing the words DR. WHO with the quatrefoil water droplet design element affixed at the top-right hand corner (the “Malaysian DR. WHO quatrefoil mark”).

20.86 By a deed of settlement in 2017 (the “Deed”), the parties agreed on the shareholdings and directorships of the Singaporean and Malaysian companies once jointly owned by the parties. The Kohs became the sole shareholders of the plaintiffs in Singapore whilst the Oos took over the shareholding of the defendants in Malaysia.

20.87 The Deed also governed the intellectual property, in particular the DR. WHO trade marks, held by the parties. Clause 2.3 of the Deed on the “Exclusive Rights of ownership of DR. WHO marks in Singapore, Malaysia and in other jurisdictions and Mutual Co-existence of Rights” was pertinent. It was important to note that after the conclusion of the Deed, the plaintiffs continued to place orders for bottled water bearing customised label design and personalised branding from the defendants in Malaysia. In 2018, two trade marks that comprised the words DR. WHO in Classes 16 and 35 were registered respectively by the Oos in Malaysia.

20.88 Sometime in 2018, it came to the knowledge of the Kohs that the defendants were supplying bottled water bearing customised label design and personalised branding to a competitor of the plaintiffs. The Kohs began investigations and found that the defendants were indeed selling bottled water bearing the customers’ mark to several companies. The Oos maintained that the defendants were entitled to do so under the Deed provided they did not use the DR. WHO mark. It was undisputed that none of the bottles supplied to companies in Singapore by the defendants

bore the mark DR. WHO or any of the marks in issue. In 2019, the Oos had incorporated a company named DR. WHO (S) Pte Ltd in Singapore.

(2) *The parties' claims*

20.89 The plaintiffs claimed trade mark infringement of the DR. WHO word marks and the DR. WHO quatrefoil device mark (collectively the “DR. WHO marks”) under s 27(2) of the TMA in respect of the use of identical or similar signs on goods or services identical with or similar to those which the DR. WHO marks are registered for and there existed a likelihood of confusion on the part of the public. The alleged infringing acts comprised the use of the DR. WHO marks on:

- (a) the defendants’ commercial vehicles and on “Driver A’s Attire”;
- (b) the display of the “www.drwho.asia” website on the cartons on sale at IKEA Alexandra and IKEA Tampines;
- (c) the content of the defendants’ websites;
- (d) the content of the DR. WHO (M) Facebook page; and
- (e) the incorporation of an entity named DR. WHO (S) Pte Ltd in Singapore with a name identical with or similar to the plaintiffs’ DR. WHO marks.

20.90 The plaintiffs also claimed against the defendants for passing off in relation to the various acts. In addition, the plaintiffs claimed a breach of cll 2.3(2) and 2.3(3) of the Deed by virtue of the alleged acts of passing off, an unlawful conspiracy to injure the plaintiffs by the incorporation of the entity DR. WHO (S) Pte Ltd in Singapore in 2019 and by passing off this entity’s goods and services as connected to the plaintiffs’ business, and that the defendants had wrongfully detained certain labels belonging to the plaintiffs.

20.91 The defendants counterclaimed for trade mark infringement in relation to the plaintiffs’ use of the Malaysian DR. WHO quatrefoil and word marks in Malaysia through the procuring of bottled water and the manufacture/printing of labels and boxes for bottled water, and that the acts constituted a breach of cl 2.3 of the Deed. The defendants also claimed unlawful conspiracy on the part of the plaintiffs and the Kohs to injure the defendants by using the DR. WHO word marks and the DR. WHO quatrefoil device mark in Malaysia in breach of the Deed. The defendants further claimed the plaintiffs and the Kohs had wrongfully interfered with the defendant’s business with IKEA, and that the plaintiffs owed an outstanding amount of S\$143,665.80 for the supply of bottled water from January to May 2020.

(3) *Trade mark infringement claims in relation to DR. WHO quatrefoil device mark*

20.92 It should be noted that the DR. WHO quatrefoil device mark was registered in respect of “water treatment units” in Class 11 and “the treatment of water” in Class 40. However, the court did not find any evidence to show that the defendants had used the DR. WHO quatrefoil device mark in relation to the supply of “water treatment units”, “the treatment of water” or any other similar goods or services.¹¹³ Since the plaintiffs failed to discharge their burden of proof in relation to the similarity of goods or services registered under the DR. WHO quatrefoil device mark, the trade mark infringement claims made against the DR. WHO quatrefoil device mark were dismissed in their entirety.

(4) *Trade mark infringement claim in relation to DR. WHO services mark*

20.93 The plaintiffs’ DR. WHO services mark was registered in respect of the “delivery of bottled water to homes and offices” and “water supply services” in Class 39. Again, the court found no evidence that showed the defendants were offering such delivery services or any other similar services to the public in Singapore under the DR. WHO services mark or similar signs.¹¹⁴ The mere sightings of vehicles (loaded with empty bottles) at the plaintiffs’ office premises could not be considered delivery of bottled water by these vehicles under the signs. This is because these deliveries of the bottled water were made pursuant to the longstanding commercial arrangement between the parties.¹¹⁵ Therefore, the plaintiffs failed to prove that the allegedly infringing signs had been used in relation to identical or similar services as the specification which the DR. WHO services mark was registered for.

(5) *Proper interpretation of clause 2.3 of Deed and whether plaintiffs consented to use of various signs*

20.94 Central to the defendants’ argument that they were not liable for trade mark infringement in relation to the use of the various signs was that the Deed *only* prohibited the supply of bottled water in Singapore using the word marks DR. WHO. In other words, the defendants asserted that the plaintiffs had consented to the use of certain signs, such as the “www.drwho.asia” sign and the name DR. WHO (S) Pte Ltd (an entity

113 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [64].

114 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [66].

115 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [67].

incorporated by the Oos) on the cartons sold in IKEA since such use was not expressly prohibited by the Deed.

20.95 Although there could be two interpretations of cl 2.3 of the Deed, the court concluded that regardless of which interpretation was taken, the plaintiffs had not provided any form of consent (expressly or impliedly) to the (alleged infringing) use of the various signs by the defendants.¹¹⁶ Therefore, liability for trade mark infringement under s 27(2) of the TMA was not excluded and the lawfulness of these acts on the part of the defendants must be assessed in accordance with the laws in Singapore.

- (6) *Trade mark infringement claims in relation to DR. WHO goods marks*
- (a) Use of DR. WHO quatrefoil device sign on defendants' commercial vehicles and on Driver A's Attire; use of "www.drwho.com.my" sign on defendants' commercial vehicles; use of "www.drwho.com" sign on defendants' vehicle

20.96 To succeed in a claim for trade mark infringement under s 27(2) of the TMA, the plaintiffs must first establish the *use* of an infringing sign within Singapore's territory in the course of trade and in a trade mark sense, without the consent of the plaintiff.¹¹⁷ Next, it must be proved that the alleged infringing signs are identical or similar to the plaintiffs' registered trade marks, that they are used in relation to identical or similar goods or services for which the plaintiffs' trade marks are registered, and that there exists a likelihood of confusion on the part of the public. It was the plaintiffs' contention that collective use of the signs (DR. WHO quatrefoil device sign; the "www.drwho.com.my" sign; the "www.drwho.com" sign) on the defendants' commercial vehicles and on Driver A's Attire amounted to use by the defendants in "advertising" under s 27(4)(e) of the TMA. Having assessed the evidence brought before the court, Gill J concluded that the allegedly infringing signs were used in advertising only on *one* vehicle (Vehicle A) in Singapore.¹¹⁸ Vehicle A would have been visible to the public as it travelled on the roads between Singapore and Malaysia. The court found the placement of the signs on this vehicle served to advertise the goods which the signs were used in relation to, which were displayed on the website reflected in the "www.drwho.com.my" sign. As such, the signs were clearly used in the trade mark sense since they served to denote the trade origin of the goods, and

116 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [69].

117 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [72].

118 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [78].

they have been used in advertising in the course of trade.¹¹⁹ On the other hand, the court did not find that the sign on Driver A's Attire was used in Singapore for advertising because the sign was placed on the back of Driver A's Attire and would not be visible to members of the public.¹²⁰

20.97 On the issue of identity and similarity of the signs used, the court applied the general principles laid down by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc*¹²¹ ("*Staywell*") and *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd*¹²² ("*Hai Tong*") to the facts of this case. The comparison is made between the mark as registered and the alleged infringing sign(s) without consideration of any external matter.¹²³ Three aspects of similarity are relevant: visual, aural and conceptual, and similarity between the mark and the allegedly infringing sign may be made out even if *not* all three aspects of similarity are satisfied.¹²⁴ The mark/sign similarity inquiry is undertaken from the perspective of a well-informed, reasonably observant and circumspect average consumer¹²⁵ who will exercise some care and a measure of good sense in making his or her purchases.¹²⁶

20.98 Gill J was satisfied that the term "DR. WHO" in the DR. WHO goods mark was purely inventive which was made up and devoid of meaning. Therefore, the DR. WHO goods mark was distinctive in so far as it was capable in effectively distinguishing the origin of the goods in question and consequently, the threshold to find that an allegedly infringing sign was *dissimilar* to the DR. WHO goods mark was high.¹²⁷

20.99 Considering the allegedly infringing DR. WHO quatrefoil device sign and the DR. WHO goods mark, the court concluded that they were *similar* as the dominant components of the registered mark and the infringing sign comprised the term DR. WHO in block letters. The registered mark and the infringing sign were identical aurally and similar visually. The quatrefoil-droplet element present in the DR. WHO quatrefoil device sign also did not add or change the conceptual nature

119 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [78].

120 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [79].

121 [2014] 1 SLR 911.

122 [2013] 2 SLR 941.

123 *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911 at [20].

124 *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [40(a)].

125 *Calvin Klein, Inc v HS International Pte Ltd* [2016] 5 SLR 1183 at [50(b)].

126 *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [40(c)].

127 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [85].

of the sign and as such, there was conceptual similarity between the DR. WHO quatrefoil device sign and the DR. WHO goods mark.¹²⁸

20.100 In terms of the allegedly infringing “www.drwho.com.my” sign which was used on Vehicle A, the court was of the view that since the sign was related to a website address, it was useful to consider how the average consumer perceived the constituent parts of a website address, namely the top-level domains (“TLDs”) and second-level domains (“SLDs”), in the assessment of whether the registered mark and the infringing sign were similar.¹²⁹ The court found the dominant component of the “www.drwho.com.my” sign was the SLD, that is, “drwho”. Thus, the SLD was visually similar to the DR. WHO goods mark as they were made of the same letters. The lower-case letters in the SLD, the absence of the full-stop after the letters “dr” in the SLD and the lack of space between the letters “dr” and “who” in the SLD all did not make a material difference in displacing the visual similarity between the dominant components of the allegedly infringing sign and the registered mark. Similarly, the presence of the TLD in the sign did not alter the court’s conclusion on the issue of visual similarity. In terms of the aural aspect of the sign and the mark, the court found the SLD of the sign to be aurally identical to the DR. WHO goods mark as the five-letter term “drwho” could not be understood in any other reasonable manner except to refer to words DR. WHO which were identical to that in the DR. WHO goods mark. The presence of the TLD did not constitute a significant difference and the “www.drwho.com.my” sign was aurally similar with the DR. WHO goods mark. Finally, in terms of conceptual similarity, the dominant components in the alleged sign and the registered mark shared the conceptual feature DR. WHO, and as such, they were conceptually similar.

20.101 On the issue of identity and similarity of goods, the court noted that the placement of a website alongside a sign directed consumers to access the website in order to gain information on the particular goods offered under the sign.¹³⁰ The fact that the average consumer needed to take an additional step to access the website did not, in the opinion of the court, prevent the consumer from understanding that the signs placed on Vehicle A were used in relation to the goods found on the website.¹³¹ Examining the contents of the website, the court concluded that the goods as reflected on the website were identical to the goods in respect of which the DR. WHO goods mark was registered in Class 32 for bottled water, *etc*, because the “www.drwho.com.my” website indicated the defendants

128 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [86].

129 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [89]–[96].

130 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [99].

131 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [99].

were “a key player in the drinking water industry” and their “core business revolves around customised branding of PET bottles, Tetra Pak and aluminum [*sic*] cans based on individual clients’ requirements”.¹³²

20.102 The final part of the trade mark infringement analysis under s 27(2) of the TMA pertained to whether, as a result of the identities and/or similarities in the signs and the registered mark used in respect of identical and/or similar goods or services for which the mark was registered, there existed a likelihood of confusion on the part of the public. Applying the principles in *Staywell* and *Hai Tong*, Gill J concluded that given the high degree of similarity between the mark and the signs, as well as the identity of the respective goods, it was sufficient to conclude a likelihood of confusion.¹³³

20.103 The plaintiffs succeeded in their claim that the use of the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign on the defendants’ Vehicle A constituted infringement of the plaintiffs’ DR. WHO goods mark under s 27(2) of the TMA.

- (b) Use of “www.drwho.asia” sign at bottom of cartons sold at IKEA Alexandra and IKEA Tampines

20.104 To constitute trade mark infringement, the trade mark proprietor must establish: (a) use of the infringing sign within Singapore’s territory; (b) in the course of trade; (c) in a trade mark sense; and (d) without the consent of the proprietor.¹³⁴ The concept of use “in the course of trade” refers to the use of the allegedly infringing sign for commercial purposes as opposed to non-commercial purposes.¹³⁵ Furthermore, the use of the allegedly infringing sign to show a business connection with a foreign manufacturer entitled to use the mark in its own country only and not with the local owner of the mark did not absolve the defendants from liability. The evidence in *Dr Who* amply showed the sign was used in the course of trade as the sign was used to help identify the defendants as the distributor of the cartons and directed consumers to the website to obtain further information on its business. On the question of use in the trade mark sense, it should be noted that it did not matter that the “www.drwho.asia” sign had not been used as a primary identifier of the cartons as secondary or even third-level product identifiers can function as a trade mark if they indicate to the consumer that the product in question

132 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [100].

133 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [101]–[106].

134 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [60].

135 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [109]–[110].

originated from a particular undertaking.¹³⁶ Therefore, the presence of primary identifiers on the cartons in the form of “DRKICKSVATTEN” and the “IKEA” logo did not render the use of the “www.drwho.asia” sign *not* in the trade mark sense. Considered in the larger context of the use of the sign, the court was satisfied that the average consumer would have understood the source of the cartons to be the distributor, that is, the undertaking using the “www.drwho.asia” sign.¹³⁷

20.105 The rest of the court’s analysis on identity/similarity of the sign used and identity/similarity of goods, as well as the likelihood of confusion, was fairly straightforward and the reader is invited to refer to the relevant portions in the written judgment of *Dr Who*.¹³⁸ The plaintiffs were successful in respect of this trade mark infringement claim.

- (c) Use of DR. WHO quatrefoil device sign; Copyright Notice “© 2020 DR. WHO (S) Pte Ltd”; meta-title “DR. WHO (S) Pte Ltd” on “www.drwho.asia” website and use of meta-title “DR. WHO (M) SDN. BHD.” on “www.drwho.com.my” website

20.106 For this set of trade mark infringement claims, one important issue which required the court’s determination at the outset pertained to whether the use of the allegedly infringing signs on the websites was use of these signs *in Singapore*. Applying the principles laid down by the Court of Appeal in *Novelty Ptd Ltd v Amanresorts Ltd*,¹³⁹ Gill J considered whether there existed other evidence (beyond the mere existence of the websites featuring the allegedly infringing signs or mere access of the websites by consumers in Singapore) such as the geographical areas to which the proprietor of the website is willing to supply the goods, the nature and size of the trader’s business, the characteristics of the relevant goods or services, and the number of visits made to the website by consumers in the relevant jurisdiction (*ie*, Singapore), to show that the allegedly infringing signs on the websites have targeted consumers in Singapore in such a manner.¹⁴⁰ The evidence adduced before the court in this case, in particular the contents of the websites such as the company profile alluding to clientele in both *Singapore* and Malaysia, supported the plaintiffs’ contention that the two websites “www.drwho.asia” and “www.drwho.com.my” had indeed targeted consumers in Singapore.

136 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [112].

137 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [113].

138 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [114]–[122].

139 [2009] 2 SLR(R) 216.

140 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [125].

20.107 On the issue of whether the allegedly infringing signs have been used in the trade mark sense, it was clear to the court that the Copyright Notice did not constitute such use. The purpose of the Copyright Notice was to declare ownership over the copyright in the websites' content to the entity "DR. WHO (S) Pte Ltd". In the court's view, this alone did not speak to the trade origin of any goods as the work in which the copyright subsisted was distinct from the goods which the allegedly infringing signs were used in relation to.¹⁴¹ Accordingly, the court dismissed the plaintiffs' infringement claim in relation to the use of the Copyright Notice on both websites.

20.108 However, the use of the allegedly infringing signs "DR. WHO (S) Pte Ltd" and "DR. WHO (M) SDN. BHD." in the meta-titles of the two websites "www.drwho.asia" and "www.drwho.com.my" respectively must be treated differently. This is because meta-titles served as the titles of the two websites and were displayed on the internet browser's "tab". As such, they denoted the trade origins of the goods or services provided by the websites.¹⁴² Similarly, the court found the Dr. WHO quatrefoil device sign headlined the home pages of both websites within the webpages themselves. Collectively, it would have been understood by consumers accessing the websites that these signs were being used in relation to goods offered on the websites which were set out further down on the home pages.¹⁴³ Thus, the use of these signs *was* use in a trade mark sense since they denoted the source of the goods offered.

20.109 Once again, the court's analysis on identity/similarity of the sign used and identity/similarity of goods, as well as the likelihood of confusion, was fairly straightforward and the reader is invited to refer to the relevant portions in the written judgment of *Dr Who*.¹⁴⁴ The plaintiffs were successful in respect of their trade mark infringement claims for the use of the meta-title signs "DR. WHO (S) PTE LTD" and "DR. WHO (M) SDN. BHD.", and the DR. WHO quatrefoil device sign on the defendants' "www.drwho.com.my" and "www.drwho.asia" websites.

(d) Use of DR. WHO quatrefoil device sign and "Dr Who Malaysia" sign on DR. WHO (M) Facebook page

20.110 The plaintiffs' trade mark infringement claim regarding the use of the allegedly infringing signs on the DR. WHO (M) Facebook page was dismissed on the ground that the plaintiffs were unable to show that

141 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [131].

142 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [134].

143 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [134].

144 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [135]–[145].

the DR. WHO (M) Facebook page directly encouraged or advertised the defendants' goods to consumers in *Singapore*. In other words, there was no evidence of content on the DR. WHO (M) Facebook page targeting consumers in Singapore, quite unlike how the two websites "www.drwho.asia" and "www.drwho.com.my" had indeed targeted consumers in Singapore. The DR. WHO (M) Facebook page only made references to Malaysia. The presence of a link to the DR. WHO (M) Facebook page on the two websites did not equate to the Facebook page targeting consumers in Singapore.¹⁴⁵

20.111 As such, it could not be said that the use of the DR. WHO quatrefoil device sign and the "Dr Who Malaysia" sign on the DR. WHO (M) Facebook page constituted *use* of the registered mark under s 27(4)(e) of the TMA and the plaintiffs' trade mark infringement claim failed.

(e) Use of name "DR. WHO (S) Pte Ltd" in incorporation of entity DR. WHO (S) Pte Ltd (the "fourth defendant") in Singapore

20.112 It was the plaintiffs' contention that the very incorporation of the fourth defendant in Singapore under the name DR. WHO (S) Pte Ltd constituted an infringing act.

20.113 As a starting point, the court clarified that the use of a company name *solely* to identify a company is insufficient to amount to use in relation to goods or services. Instead, the requirement was the use of the company name in a manner which established a link between the company name and the goods or services offered by the company, as assessed from the perspective of the average consumer.¹⁴⁶

20.114 On the facts of *Dr Who*, the court was not persuaded that the company name DR. WHO (S) Pte Ltd was *merely* used for the purpose of identifying the fourth defendant. Here, the court was satisfied that the company name DR. WHO (S) Pte Ltd was used in relation to the goods it offered to IKEA, that is, the cartons of water evidenced both in terms of the printed words on the cartons as well as the use of the company name on the contract which would have constituted the sale of goods under the sign DR. WHO (S) Pte Ltd pursuant to s 27(4) of the Trade Marks Act.¹⁴⁷

20.115 The court went on to find that the company name DR. WHO (S) Pte Ltd was similar to the DR. WHO goods mark, and that the goods bearing the name DR. WHO (S) Pte Ltd were identical to those which the

145 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [148].

146 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [152].

147 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [153].

DR. WHO goods mark was registered for. Given the similarity between the infringing sign and the registered mark, and the identity of the goods in question, the court concluded that the relevant segment of the public (which would include actual and potential purchasers of the goods offered for sale by the plaintiffs and the fourth defendant) would likely be confused as to the source of the goods offered for sale under the fourth defendant's company name DR. WHO (S) Pte Ltd.¹⁴⁸

(7) *Remedies for trade mark infringement*

20.116 In terms of the remedies which the plaintiffs sought in relation to the defendants' infringing acts, the court granted a general injunction to restrain the defendants from infringing the plaintiffs' registered trade marks in Singapore. Even though the court acknowledged that several of the infringing acts had at time of trial been remedied, the "www.drwho.com.my" and "www.drwho.asia" websites still displayed the infringing DR. WHO quatrefoil device sign and the meta-title sign ("DR. WHO (M) SDN. BHD.") which could be discovered by consumers in Singapore through basic internet searches.

20.117 The court also ordered an inquiry into damages in relation to the acts of infringement. In the alternative, the plaintiffs may elect for an account of profits. However, the court declined the plaintiffs' prayer for delivery up of the vehicles and/or the cartons under s 33(1) of the TMA as the commercial vehicles had since been repainted and the defendants had also ceased production of the cartons once supplied to IKEA. In any case, the court was satisfied that the plaintiffs would be adequately compensated through damages or an account of profits.

20.118 Gill J also took the opportunity to clarify that an award of statutory damages under s 31(5) of the TMA is premised upon the use of a "counterfeit trade mark" by the defendant. On the facts of *Dr Who*, the court decided definitively that the plaintiffs failed to discharge the burden of proof that the defendants had used a "counterfeit trade mark".¹⁴⁹ Thus, the plaintiffs were precluded from claiming statutory damages against the defendants as such.

(8) *Passing off*

20.119 To succeed in passing off, the plaintiffs must prove the requisite elements of: (a) goodwill; (b) misrepresentation; and (c) damages.

148 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [156].

149 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [165].

20.120 Based on the evidence adduced before the court, it was clear that goodwill existed in the plaintiffs' business. The defendants also did not contest the subsistence of goodwill in the plaintiffs' business in Singapore.

20.121 The plaintiffs alleged five distinct acts of misrepresentation by the defendants which corresponded closely with the plaintiffs' claims on trade mark infringements. On the requirement of misrepresentation giving rise to confusion or a likelihood of confusion, given the court's earlier finding that the DR. WHO goods mark was inventive and inherently *distinctive* of the plaintiffs' goods, the high degree of similarities between the identifiers of the plaintiffs (which include the words DR. WHO used in the names of the plaintiffs' companies and the DR. WHO word marks used in the course of the plaintiffs' bottled water business) and the signs used by the defendants, and the identity of the goods sold by the plaintiffs and the defendants, the conclusion that the relevant sector of the public may be left with the mistaken impression that the defendants' goods and/ or business were in fact the plaintiffs', or were economically connected in some way with the plaintiffs', was a fairly straightforward one.¹⁵⁰

20.122 The court rejected the plaintiffs' submissions that there was either actual or probable damage to the plaintiffs' goodwill arising from the following three heads of damage: (a) the tarnishment of the plaintiffs' goodwill in their business; (b) the loss of exclusivity or erosion of the distinctiveness to their goodwill; and (c) the likelihood of damage to the plaintiffs' goodwill should the defendants get into financial, legal or other trouble. With regards to head (a), Gill J was not persuaded that there existed evidence to prove the quality of the defendants' goods or services was unsatisfactory, especially when the plaintiffs had been relying on the defendants for the supply of the bottled water for many years.¹⁵¹ For head (b), the court doubted that it is an accepted head of damage under Singapore law and rejected its applicability.¹⁵² Finally, for head (c), the court was of the view that a single incident of a traffic summons addressed to a driver employed by the defendants was insufficient to demonstrate that this head of damage applied on the facts of this case.¹⁵³ However, the court accepted the plaintiffs' submission that, given the association between the goods and business of the plaintiffs and the defendants resulting from the defendants' actionable misrepresentation to the relevant public, there existed a likelihood of damage in the form of some loss of sales suffered by the plaintiffs in Singapore.¹⁵⁴ The plaintiffs

150 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [168]–[185].

151 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [188].

152 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [189]–[190].

153 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [193].

154 *Dr Who Waterworks Pte Ltd v Dr Who (M) Sdn Bhd* [2023] SGHC 156 at [194].

were thus successful in their claim for passing off with respect to this head of damage.

20.123 Given the court's findings on the plaintiffs' multiplicity of claims, the defendants' counterclaims were dismissed save for the unpaid quantum for goods supplied by the defendants, which was not disputed by the plaintiffs.

B. Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng

20.124 In *Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng*¹⁵⁵ (“*Shanghai Afute*”), the General Division judgment handed down by Gill J provided useful guidance on the *bifurcated approach* that is to be applied in an action for the breach of the equitable obligation of confidence in Singapore. The action for a breach of the equitable obligation of confidence in *Shanghai Afute* arose in the context of a coffee franchise agreement and the alleged breach of said agreement.

(1) Facts and background

20.125 The plaintiff is a company incorporated in Shanghai. Its primary business is the sale of food and beverages, and it claims to be the sole proprietor of the “AFTER COFFEE” trade mark, which is used in connection with the sale of fruit- and vegetable-infused coffee by the plaintiff and its franchisees.

20.126 The first defendant (“Tan”) is a Singapore citizen and a businessman. The second defendant is Stay Victory Industries Pte Ltd (“Stay Victory”), a company incorporated in Singapore whose primary activity is the operation of cafes and coffee houses. The third defendant is Famous 5 Holdings Pte Ltd (“Famous 5”), a company incorporated in Singapore whose primary business activity is operating as a holding company. Famous 5 was the holding company of Umbrella Ventures Pte Ltd which was the holding company of Coffee Cupital Pte Ltd, which in turn held shares in Stay Victory.

20.127 Although the parties disputed the circumstances under which a franchise agreement (“Master Franchise Agreement”) for Tan to bring into Singapore the plaintiff’s AFTER COFFEE-branded fruit- and vegetable-infused coffee (the “Intended Business”) was entered into, it was not disputed that the relevant Master Franchise Agreement

155 [2024] 3 SLR 1098.

was signed in November 2019. It was not disputed that Stay Victory was incorporated in November 2019 for the purpose of operating the Intended Business in Singapore. Consequently, pursuant to the terms of the Master Franchise Agreement, the plaintiff had imparted to Tan and Stay Victory confidential and proprietary information as well as trade secrets in the form of menu and beverage names, recipes of and types of ingredients used, pricing, operating processes and procedures, branding collaterals, design layout and look and feel of stores, product design, and brand concept (“Alleged Confidential Information”). It was also undisputed that parties did not embark on the Intended Business in accordance with the Master Franchise Agreement. Instead, in July 2020, Tan and Stay Victory commenced business operations at Vivocity for the sale of beverages with a combination of fruits and coffee (the “Alleged Competing Business”).

(2) *Whether there was breach of confidence*

20.128 The plaintiff premised its claim for a breach of confidence on: (a) a breach of cl 6(5) of the Master Franchise Agreement on the prohibition against the sale and disclosure of the plaintiff’s trade secrets; and/or (b) a breach of a general obligation of confidentiality in common law or equity.

20.129 The court found that the defendants were indeed in breach of cl 6(5) of the Master Franchise Agreement.¹⁵⁶ The plaintiff’s claim for a breach of confidence was successful on this basis, and there was really no need for the court to consider the alternative claim in common law or equity. However, Gill J saw the need to address the merits of the breach of confidence claim under common law or equity because of the manner in which the plaintiff had pleaded its case. Gill J noted that the law in Singapore has rendered the precise interest affected a *critical element* in the plaintiff’s case¹⁵⁷ but the plaintiff’s pleadings were silent on the nature of the interest relied upon in its claim for breach of confidence. Following the court’s guidance in *I-Admin (Singapore) Pte Ltd v Hong Ying Ting*¹⁵⁸ (“*I-Admin*”), the correct approach is to first determine whether the defendant’s actions were an incursion to the *wrongful gain interest* or the *wrongful loss interest*, before applying the traditional approach or the modified approach respectively.¹⁵⁹

156 *Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng* [2024] 3 SLR 1098 at [99].

157 *Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng* [2024] 3 SLR 1098 at [102].

158 [2020] 1 SLR 1130.

159 *Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng* [2024] 3 SLR 1098 at [103].

20.130 In this case, the relevant interest was the *wrongful gain interest*. As such, the traditional approach under *Coco v AN Clark (Engineers) Ltd*¹⁶⁰ was applicable. The commentary on the judgment in respect of the breach of confidence claim is covered by Benjamin Wong in the chapter on “Confidential Information and Data Protection” in this same year’s Singapore Academy of Law Annual Review of Singapore cases.¹⁶¹

(3) *Whether there was passing off by use of defendant’s “BEYOND COFFEE” mark*

20.131 The plaintiff claimed that the defendant passed off and/or attempted to pass off and/or enabled or assisted to pass off the “BEYOND COFFEE” mark as being the same as the plaintiff’s AFTER COFFEE mark, or associated with the plaintiff and/or Lee Eng Tat (“Mr Lee”).

20.132 To establish an action under the tort of passing off, it is trite law that the claimant must prove the following: (a) the existence of goodwill in its business; (b) a misrepresentation that the defendant’s business was held out to be, or to be connected with, the plaintiff’s business, thereby giving rise to confusion or the likelihood of confusion; and (c) damage occasioned or is likely to be occasioned to the plaintiff’s goodwill from the misrepresentation.¹⁶²

20.133 Gill J was not persuaded that the plaintiff had generated goodwill by virtue of its pre-business activities quite unlike the finding in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd*.¹⁶³ The publicity efforts undertaken by Mr Lee to raise the profile of the Intended Business among his social media followers did not attract any local custom as they were directed at a franchise in Malaysia. In the same vein, it was not sufficient for the plaintiff to merely show that marketing efforts were undertaken. Instead, the plaintiff had to demonstrate that the marketing activities had generated an attractive force that would bring in custom when the Intended Business under the Master Franchise Agreement eventually materialised. In conclusion, the court found there was no sustained effort to generate pre-trading goodwill and the plaintiff has not discharged the burden that the Intended Business attracted goodwill of the nature and significance required to fulfil the requirement in an action

160 [1969] RPC 41.

161 Benjamin Wong, “Confidential Information and Data Protection” *Singapore Academy of Law Annual Review of Singapore Cases* (published on e-First 18 July 2024).

162 See *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975, *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 and *Tuitiongenius Pte Ltd v Toh Yew Keat* [2021] 1 SLR 231.

163 [1998] 1 SLR(R) 975.




of passing off.¹⁶⁴ The plaintiff’s claim for passing off thus failed since the first element of goodwill could not be satisfied, and as such, there was also no necessity for the court to consider the misrepresentation and damage requirements.

C. In the matter of a trade mark application by Louis Vuitton Malletier

(1) *Facts and background*

20.134 On 9 December 2020, Louis Vuitton Malletier (the applicant) applied via the Madrid Protocol to register a device mark (the “Application Mark”) for a long list of goods in Classes 9, 14, 18 and 25 in *In the matter of a trade mark application by Louis Vuitton Malletier*.¹⁶⁵ The Application Mark looks as follows:



20.135 The Application Mark consists of three devices, namely “”, “”, and “”, arranged in a particular manner (collectively referred to as “Applicant’s Flower Quatrefoil Marks”).

20.136 The applicant was unsuccessful before the Trade Marks Examiner (the “Examiner”) at the Intellectual Property Office of Singapore on the ground that the Application Mark was not distinctive as required under s 7(1)(b) of the TMA in relation to all the goods applied for. After several rounds of submissions and re-submissions before the Examiner without success, the applicant requested for an *ex parte* hearing under r 24(2)(b) of the Trade Mark Rules¹⁶⁶ and the matter was heard before PAR Mark Lim Fung Chian. The grounds of decision of the PAR provided useful guidance in relation to the registrability of patterns as trade marks.

20.137 At the outset and as a threshold issue, the PAR *rejected* the applicant’s argument that the Application Mark should be assessed on the

164 *Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng* [2024] 3 SLR 1098 at [121].

165 [2023] SGIPOS 10.

166 2008 Rev Ed.

basis that it will be used in relation to relevant goods or packaging in the form that it was filed, that is as a *label mark* consisting of three distinct devices arranged in a particular manner instead of a pattern mark to be applied throughout the surface of the relevant goods or packaging thereof. Trade mark registry manuals and practice guidelines elsewhere, such as the UK Intellectual Property Office's Manual of Trade Mark Practice and the European Union Intellectual Property Office Guidelines for Examination, support the PAR's finding that although patterns may be represented in the form of square or rectangular labels, they should nonetheless be assessed as if they covered the entire surface of the goods for which protection is sought.¹⁶⁷ Furthermore, the PAR found that there was not a single instance where the Applicant's Flower Quatrefoil Marks and its house mark ("V"), either individually or in combinations, were used in the form of a square or rectangular label. Instead, there was ample evidence that they were applied to apparel and bags/suitcases in the form of repeating patterns. Therefore, the Application Mark must be assessed on the basis that it will be used as pattern mark to be applied throughout the surface of the relevant goods or packaging thereof.

20.138 The PAR noted that *in general* and in the absence of evidence of use, pattern marks would *not* be distinctive as required under s 7(1)(b) of the TMA.¹⁶⁸ This is because the average consumer would normally regard a pattern as decorative and not as a badge of origin.

20.139 Having said that, the PAR was nevertheless of the view that in certain *limited* circumstances, where the pattern was: (a) used on goods or services which normally do not bear any patterns;¹⁶⁹ and (b) the pattern sought to be registered was fanciful, unusual and/or arbitrary, or departed from the norm or customs of the relevant sector, such a pattern mark may be inherently technically distinctive.¹⁷⁰

167 *In the matter of a trade mark application by Louis Vuitton Malletier* [2023] SGIPOS 10 at [11].

168 *In the matter of a trade mark application by Louis Vuitton Malletier* [2023] SGIPOS 10 at [38]–[39].

169 *In the matter of a trade mark application by Louis Vuitton Malletier* [2023] SGIPOS 10 at [23]–[32].

170 *In the matter of a trade mark application by Louis Vuitton Malletier* [2023] SGIPOS 10 at [60].

20.140 On this basis, the PAR found the Application Mark to possess inherent technical distinctiveness *only* in relation to certain goods, for example “grips, rings and holders adapted for smartphones; selfie sticks; binoculars; headphones *etc*” in Class 9; “chains [jewellery], pearls, semi-precious stone; precious stones; watch chains *etc*” in Class 14; and “leather cord; shoulder belts of leather; whips, walking sticks” in Class 18.

20.141 The Application Mark was allowed to be registered in relation to this limited specification of goods as such.

IV. Patents

20.142 This review covers two patents decisions handed down in 2023, one from the Court of Appeal and one from the General Division. In the former, the Court of Appeal confirmed that the doctrine of uncertainty is a species of insufficiency under Singapore law.

A. *Iia Technologies Pte Ltd v Element Six Technologies Ltd*

20.143 In *Iia Technologies Pte Ltd v Element Six Technologies Ltd*¹⁷¹ (“*Iia Technologies*”) the parties were competitors in the production of synthetic diamonds grown using chemical vapour deposition (“CVD”).¹⁷² Element Six Technologies Ltd (the respondent), a company incorporated in the UK, was in the business of designing, developing and producing “synthetic diamond supermaterials”.¹⁷³ The respondent had sued *Iia Technologies Pte Ltd* (the appellant), a Singapore-incorporated manufacturer of CVD diamonds, claiming the appellant infringed two of its patents registered in Singapore (“SG 872” and “SG 508”).¹⁷⁴ The appellant challenged the validity of both patents, counterclaiming for revocation. The General Division judge found that SG 508 was invalid and revoked it for lack of novelty and inventiveness. However, the judge held that SG 872 was valid and that the appellant had infringed some of its claims.¹⁷⁵ The appellant appealed against the judge’s findings in relation to SG 872.¹⁷⁶ SG 872 contained both process and product claims and purported to teach a new method of synthesising CVD diamonds with low optical birefringence.¹⁷⁷

171 [2023] 1 SLR 987.

172 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [1].

173 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [2].

174 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [3].

175 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [3].

176 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [4].

177 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [28]–[29].

20.144 The appellant challenged several aspects of the judge’s decision, including those pertaining to novelty, inventive step and sufficiency. The appellant also sought to rely on concepts recognised in English law which were not recognised locally, such as “*Biogen* insufficiency”. However, it sufficed for the Court of Appeal to focus on two parts of the appellant’s case, both of which related to the sufficiency requirement and were determinative of the appeal.¹⁷⁸ The unanimous judgment was delivered by Sundaresh Menon CJ.

20.145 The Court of Appeal first set out the foundational principles of patent law. The court noted the two main aims of the patent regime: first, to encourage innovation by granting the patentee a monopoly over the patented invention for a limited period; second, to disseminate knowledge by requiring the patentee to teach the working of the asserted invention.¹⁷⁹

20.146 The first aim is primarily furthered by only granting monopolies to inventions that meet the requirements of novelty and inventiveness, while the second aim is advanced by the “sufficiency” or “enabling disclosure” requirement.¹⁸⁰ A proper construction of the patent claims undergirds the novelty, inventive step and sufficiency inquiries.¹⁸¹

(1) *Who was “person skilled in the art” and what was common general knowledge?*

20.147 The “person skilled in the art” (“PSA”) and their common general knowledge are important concepts in the novelty, inventive step and sufficiency inquiries, but assume relevance in different ways:¹⁸²

When determining whether the patented invention is novel or contains an inventive step, the PSA employs his common general knowledge to interpret prior art, amongst other purposes ... However, this is not the case where claim construction and sufficiency are concerned. In these contexts, the PSA mainly directs his common general knowledge towards interpreting the patent claims and working the invention disclosed therein ...

Further, the precise assumptions applicable to the PSA are not identical in all areas of patent law. For instance, in matters of claim construction and sufficiency, the PSA is assumed to have the patent specification in his hands whereas when considering the issue of obviousness, the PSA is deemed *only* to be considering the prior art without the patentee’s invention in front of him ...

[emphasis in original]

178 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [46].

179 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [57].

180 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [58]–[61].

181 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [62].

182 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [64]–[65].

20.148 The Court of Appeal stated the relevant principles for constructing the PSA. The PSA is a reasonably intelligent but unimaginative technician in the subject matter with no inventive ingenuity.¹⁸³ The PSA may be an individual person, but also may be a notional team of people if the patent specification clearly engages more than one set of skills which in the real world are possessed by more than one person, such as where the art involves highly developed technology.¹⁸⁴

20.149 In the present case, the judge had found that the PSA, for the purpose of claim construction, would be a notional team of persons working in the field of growing CVD diamonds with expertise in diamonds and the relevant sciences.¹⁸⁵ While the parties did not challenge this on appeal, the appellant attempted to impute the PSA with the specific interest in producing etalons and anvils.¹⁸⁶ This was rejected by Menon CJ as the patent specification clearly envisaged a wide range of optical applications.¹⁸⁷

20.150 Common general knowledge is usually established by expert evidence. To prove that a particular disclosure in a scientific paper has become common general knowledge, it must be shown that it is *generally known* and *regarded as a good basis for further action* by the majority of those engaged in the relevant art.¹⁸⁸ On the facts, the common general knowledge included an agreed list of information relating to the growth of CVD diamonds as well as methods of measuring their physical properties.¹⁸⁹

(2) *Did product claims in SG 872 cover single product or class of products?*

20.151 Whether the patent claims a single product or a range of products is a question of construction of the claims in the patent.¹⁹⁰ In *Lee Tat Cheng v Maka GPS Technologies Pte Ltd*¹⁹¹ (“*Lee Tat Cheng*”), the court had held that the relevant date for claim construction was the date of the patent application. However, in the present case, the patentee sought to claim priority from an earlier filing, a complication that did not arise in *Lee Tat Cheng*. The English cases are divided over whether the relevant

183 *Ng Kok Cheng v Chua Say Tiong* [2001] 2 SLR(R) 326 at [21].

184 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [68].

185 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [70].

186 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [71].

187 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [72].

188 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [74].

189 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [75].

190 *Regeneron Pharmaceuticals Inc v Kymab Ltd* [2021] 1 All ER 475 at [3].

191 [2018] 3 SLR 1334.

date for patent construction is the priority date or filing date of the patent application, or the publication date of the patent.¹⁹² However, since the case did not turn on which of these three dates were adopted, the Court of Appeal expressed its preference to resolve this issue in a future case.¹⁹³

20.152 Menon CJ affirmed the substantive principles of claim construction in *Lee Tat Cheng* including, *inter alia*, the need to view the claims through the PSA's lens.¹⁹⁴ On the facts, the court agreed with the respondent that each product claim of SG 872 asserted a monopoly over a *class* of single crystal CVD diamond materials, as opposed to a single diamond material.¹⁹⁵ "Claim 1" in SG 872 encompassed diamond materials that possessed different combinations of physical properties, which would be treated as different diamonds by the PSA.¹⁹⁶ Subsequent claims, all of which incorporated Claim 1, likewise covered a range of diamonds, since the additional parameter or parameters specified in each subsequent claim could be satisfied by multiple diamonds in the Claim 1 range.¹⁹⁷

(3) *Which types of insufficiency existed under Singapore law?*

20.153 The sufficiency requirement is statutorily expressed in s 25(4) of the Patents Act¹⁹⁸ ("PA") and provides a ground for revocation under s 80(1)(c) of the PA. Despite differences in wording with the English equivalent, the standard of sufficiency in Singapore is not stricter.¹⁹⁹ Nevertheless, according to the Court of Appeal, not every aspect of the English law on insufficiency applies in Singapore, as the UK Patents Act 1977²⁰⁰ gives effect to the Convention on the Grant of European Patents²⁰¹ ("European Patent Convention").²⁰²

20.154 The core rationale of the sufficiency requirement is the "patent bargain": the inventor/patentee is rewarded with a limited-term monopoly in exchange for enabling a PSA to work the claimed invention and dedicating it to public use after the monopoly has expired.²⁰³ The

192 Colin Birss *et al*, *Terrell on the Law of Patents* (Sweet & Maxwell, 19th Ed, 2022) at paras 9-08–9-014.

193 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [78].

194 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [79].

195 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [83].

196 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [85].

197 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [88]–[94].

198 Cap 221, 2005 Rev Ed.

199 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [100].

200 c 37 (UK).

201 5 October 1973, 1065 UNTS 199 (entered into force 7 October 1977).

202 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [101].

203 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [102].

requirement involves a two-step assessment: first, identifying the invention and what it claims to enable the PSA to do; second, whether the specification enables him to do it.²⁰⁴ In the first step, the patent claims are constructed from the PSA's perspective, whereas in the second step, the PSA's common general knowledge supplants the information in the specification in order to enable him to perform the invention.²⁰⁵ The enablement must be in respect of the full breadth of the monopoly claimed.²⁰⁶ In the case of a claim to a class of products, the PSA must be able to work the invention in respect of all members of the class.²⁰⁷ This is explained with reference to the patent bargain, in that allowing the inventor/patentee to monopolise more than what he has enabled may unduly stifle research and discourage innovation.²⁰⁸

20.155 The Court of Appeal also noted that the majority in the UK Supreme Court's decision in *Regeneron Pharmaceuticals Inc v Kymab Ltd*²⁰⁹ ("*Regeneron*") had held that the patent is only required to enable the PSA to make "substantially" all the types of products within the scope of the claim. This threshold is satisfied where there is a *de minimis* scope of non-enablement. The court left the question of whether the substantiality threshold should apply in Singapore to be decided in a subsequent case. However, the court observed that the standard was endorsed in *Regeneron* in order to achieve interpretive consistency with EU law, whereas the Singapore courts are not so obliged.²¹⁰

20.156 Next, the Court of Appeal analysed the distinct ways in which a patent may be considered insufficient. The first way, which is well-established in English and local jurisprudence, is "classical insufficiency", which occurs when the patent specification is not clear and complete enough to enable the PSA to perform the invention across the whole breadth of the claim(s) without undue burden.²¹¹

20.157 Under English law, a patent specification which is not classically insufficient may nonetheless suffer from what is known as "*Biogen* insufficiency", which arises where the scope of the claim exceeds the "technical contribution to the art" made by the invention.²¹² This does

204 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [105].

205 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [106].

206 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [108].

207 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [109].

208 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [111].
209 [2021] 1 All ER 475.

210 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [112].

211 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [114].

212 Colin Birss *et al*, *Terrell on the Law of Patents* (Sweet & Maxwell, 19th Ed, 2022) at para 13-09.

not refer to the technicalities of performing the invention, but to how the invention has practically added to or advanced the state of the art. Singapore patent law had not yet recognised *Biogen* insufficiency under s 80(1)(c) of the PA. As it was unnecessary to decide the applicability of the doctrine in Singapore, the Court of Appeal left this question open for future determination, only observing that the doctrine was recognised by Lord Hoffmann in *Biogen Inc v Medeva PLC*²¹³ in the light of jurisprudence under the European Patent Convention.²¹⁴

20.158 A third species of insufficiency under English law is uncertainty, which is where the PSA does not know how to determine whether a particular product or process is within or outside the scope of the claim, even after employing the common general knowledge and applying the normal process of claim construction.²¹⁵ Uncertainty is distinct from classical insufficiency, in that the latter is concerned with whether the patent specification sufficiently teaches the PSA how to obtain the product or work the process in the claim, while the former is concerned with whether the PSA, after following the teachings in the specification, can verify whether the product obtained, or process worked, falls within the scope of the claim.²¹⁶ Uncertainty may arise where the claim is unclear as to *which* test should be used,²¹⁷ or how the prescribed test should be *applied*.²¹⁸

20.159 One of the appellant's objections on appeal was essentially one of uncertainty.²¹⁹ Uncertainty as a type of insufficiency had not been expressly recognised under Singapore patent law, although it had been contemplated in passing in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd*.²²⁰ In Menon CJ's view, where the PSA does not know how to determine if a particular product or process falls within the scope of the claim even after employing his common general knowledge and the normal claim construction process, the sufficiency requirement in ss 25(4) and 80(1)(c) of the PA is not satisfied.²²¹ The court provided three reasons for this view. First, the PSA can only be said to know how to perform the invention if he knows how to arrive within the claimed invention *and* knows how to determine if he has in fact obtained a product or worked a process within such scope. It would be useless to

213 [1997] RPC 1.

214 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [117].

215 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [118].

216 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [119].

217 *Glaxo Group Ltd v Vectura Ltd* [2018] EWHC 3414 (Pat).

218 *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2003] RPC 3.

219 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [123].

220 [2008] 1 SLR(R) 335.

221 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [124].

know the former but not the latter.²²² Second, if the PSA does not know whether he is working the invention, the claimed invention provides no public benefit and the inventor/patentee cannot be said to have fulfilled his end of the patent bargain.²²³ Third, since a patent grants the patentee a property right, it behoves the patentee to properly define when the property right has been infringed and to provide a method of ascertaining whether a particular product or process falls within the claimed property right, so that others would know how not to trespass.²²⁴

20.160 Therefore, as the law now stands, insufficiency is a single ground of revocation in s 80(1)(c) of the PA that arises in at least two distinct ways: classical insufficiency and uncertainty.²²⁵ The court also clarified the distinction between insufficiency arising from uncertainty under ss 25(4) and 80(1)(c) of the PA, and lack of clarity for the purpose of s 25(5)(b) of the PA. Whereas the former is a ground for revoking a patent, the latter is not.²²⁶ A lack of clarity does not *per se* amount to uncertainty as a type of insufficiency; rather, the lack of clarity must leave the PSA unclear as to how to determine whether the product or process is within the scope of the claim even after drawing upon his common knowledge or constructing the claim properly.²²⁷

20.161 The court considered each of the two types of insufficiency in turn, noting that the preceding discussion applied equally to the 2020 Revised Edition of the Patents Act 1994.²²⁸

(4) *Were any or all claims invalid due to classical insufficiency?*

20.162 Classical insufficiency arises when the PSA is saddled with an “undue burden” to work the invention, such as by having to engage in “prolonged research, enquiry and experiment”.²²⁹ The examples provided in the specification are relevant in determining whether there is sufficiency.²³⁰

222 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [125].

223 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [126].

224 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [127]–[128].

225 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [124].

226 *Ng Kok Cheng v Chua Say Tiong* [2001] 2 SLR(R) 326 at [74].

227 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [131].

228 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [132].

229 *Halliburton Energy Services v Smith International (North Sea) Ltd* [2006] EWCA Civ 1715 at [13].

230 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [136].

20.163 The Court of Appeal applied these principles to determine if “Claim 62”, the main process claim in SG 872, was invalid due to classical insufficiency. Claim 62 described a method of producing low-strain single crystal CVD diamond material that exhibited the optical properties defined in the product claims of SG 872.²³¹ It specified the use of a synthesis atmosphere containing a range of concentrations of molecular nitrogen, but did not specify other variables such as the ranges of temperature, gas flow rate and methane concentration (the “Other Growth Conditions”) that should be used in order to produce diamond material falling within the product claims of SG 872.²³² The court considered that Claim 62 imposed an undue burden on the PSA for several reasons.

20.164 First, the Other Growth Conditions affected the quality of the CVD diamond produced.²³³ Second, the specification of SG 872 merely provided a starting point for an onerous research programme. The patent provided inadequate guidance on suitable values or ranges of values for the Other Growth Conditions.²³⁴ Since the calibration of these conditions was complex and played a critical role in the entire growth process and the resultant product, the PSA was burdened with the need to experiment with innumerable combinations of those conditions across the entire nitrogen range of Claim 62 in order to produce a diamond meeting the desired product claim.²³⁵ The provision of discrete sets of process parameters as examples without a general or unifying principle to guide the PSA in calibrating these parameters to produce a desired product did not constitute sufficient enablement.²³⁶ Third, the appellant’s lack of experimental data was irrelevant to a finding of insufficiency.²³⁷ Lastly, calibrating the Other Growth Conditions did not form part of the common general knowledge.²³⁸ The other process claims which referred back to and narrowed the process taught in Claim 62 were likewise classically insufficient.²³⁹

231 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [37].

232 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [37] and [47].

233 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [138]–[143].

234 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [152]–[154].

235 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [155]–[157].

236 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [157]–[165].

237 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [167]–[168].

238 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [169]–[181].

239 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [182].

20.165 Since all the process claims in SG 872 were classically insufficient and it was the respondent's case that producing an SG 872 diamond was not possible prior to the discovery of the process in Claim 62, the sufficiency of the product claims was also called into question. Although the validity of a product claim is not necessarily tied to that of a related process claim as a matter of law, in this case, SG 872 did not teach an alternative method of producing an SG 872 diamond other than the process claims which had been found to be insufficient. As such, all the product claims in SG 872 were invalid. Even if the substantiality threshold in *Regeneron* applied, the court was of the view that the teaching of only five variants of diamond was not substantial enablement when measured against the innumerable combinations of growth parameters and variants of the diamond disclosed in the product claims.²⁴⁰

20.166 Menon CJ therefore allowed the appellant's counterclaim and revoked SG 872 in its entirety. Although this sufficed to dispose of the appeal, the court proceeded to consider if the claims were also invalid due to uncertainty.²⁴¹

(5) *Were any or all claims invalid due to uncertainty?*

20.167 A key integer of the CVD diamonds taught in Claim 1 of SG 872 was low birefringence, which was quantified in part under Claims 1(ii) and 1(iii) as a sample with an optical retardation " δ " remaining within a particular range of values (the "SG 872 First Order"). The specification of SG 872 directed the PSA to use the Deltascan machine (which was renamed as the Metripol since 2001) to determine whether a particular diamond satisfied the integer that δ was within the SG 872 First Order. The Metripol, however, did not calculate δ directly. Rather, it generated the value of " $|\sin \delta|$ ", each value of which could correspond to many δ values, with only one of these δ values lying within the SG 872 First Order. On this basis, the appellant argued that SG 872 was invalid for insufficiency by uncertainty.²⁴²

20.168 Menon CJ was satisfied that the Appellant had adduced sufficient evidence to suggest that the PSA would not have been able to determine if δ was within the SG 872 First Order for a particular single crystal CVD diamond. As such, the evidential burden shifted to the respondent to show that the PSA would know of a workable solution to ascertain this.

240 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [183]–[186].

241 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [187].

242 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [188]–[190].

The court adopted the test for uncertainty in *Glaxo Group Ltd v Vectura Ltd*²⁴³ (“*Glaxo Group*”):²⁴⁴

This means that the respondent must show that any of the [proposed solutions] fulfil two cumulative criteria: (a) it is a workable solution for ascertaining whether δ is within the SG 872 First Order where single crystal CVD diamonds are concerned, and (b) it is a solution that would have been known to the PSA either because (i) it is taught in the patent or (ii) it is part of the common general knowledge ...

20.169 To discharge the evidential burden of a workable test under the first criterion, the respondent was required to *minimally* show that the test was workable for most, if not all, of the single crystal CVD diamond samples.²⁴⁵ The court proceeded to apply the *Glaxo Group* criteria to the four solutions which the respondent had proposed for resolving the uncertainty in ascertaining δ .²⁴⁶

20.170 The first solution, which was called the “Gap Theory”, worked on the assumption that the PSA would know three technical premises relating to the measurement process (the “Premises”). Although the workability of the Gap Theory was disputed by the parties, the court did not need to decide this issue as the respondent had failed to prove, under the second *Glaxo Group* criterion, that the Gap Theory would have been known to the PSA at the relevant time.²⁴⁷ The Gap Theory and its Premises were neither taught in the specification of SG 872, nor did they form part of the common general knowledge at the relevant date.²⁴⁸

20.171 The second solution formed part of the common general knowledge at the relevant time.²⁴⁹ However, it was not a workable solution as it was an imprecise and inconclusive test that only provided an “approximation of whether δ is within the SG 872 First Order”.²⁵⁰

20.172 The last two solutions, collectively called the “Glazer 1996 Solutions”, were contained in an external document mentioned in the specification of SG 872. Even if the document had been successfully

243 [2018] EWHC 3414 (Pat).

244 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [194], referencing *Glaxo Group Ltd v Vectura Ltd* [2018] EWHC 3414 (Pat) at [180]–[181].

245 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [207].

246 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [194].

247 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [198].

248 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [198]–[205].

249 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [208].

250 *Iia Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [211]–[216].

incorporated into the specification, the Glazer 1996 Solutions were not workable tests. The Glazer 1996 Solutions were not originally introduced with the specific application to single crystal CVD diamonds in mind and could not conclusively ascertain if δ fell within the limited range of the SG 872 First Order.²⁵¹ The body of expert evidence also failed to establish that the Glazer 1996 Solutions could be applied to single crystal CVD diamonds.²⁵²

20.173 All four solutions having failed to meet the *Glaxo Group* criteria, the court concluded that the PSA would not know which test to apply to ascertain if the δ value of a particular diamond remained within the SG 872 First Order. Since the PSA would not know if a particular diamond material had satisfied limb (ii) or (iii) of Claim 1, this constituted non-enablement of a portion of the range of diamond materials within Claim 1.²⁵³ This insufficiency was not of a *de minimis* nature.²⁵⁴ The Court of Appeal employed similar reasoning as in respect of classical insufficiency to find that the uncertainty in Claim 1 caused all other product and process claims in SG 872 to fall.²⁵⁵

20.174 As such, uncertainty formed another ground for revoking the Respondent's patent in its entirety.²⁵⁶ The court allowed the appeal and set aside the judge's orders.²⁵⁷ In concluding, the court observed that it was unnecessary to decide on the correctness of the *obiter* in *Sunseap Group Pte Ltd v Sun Electric Pte Ltd*²⁵⁸ ("*Sunseap*") that a patent should be revoked if "all the independent claims in a patent have been found to be invalid", as the outcome of this appeal did not turn on its application.²⁵⁹

B. Millennium Pharmaceuticals, Inc v Zyfas Medical Co

20.175 In *Millennium Pharmaceuticals, Inc v Zyfas Medical Co*²⁶⁰ the first plaintiff was a US-incorporated company and proprietor of the two patents

251 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [219]–[221].

252 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [222]–[226].

253 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [228]–[229].

254 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [230].

255 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [234]–[238].

256 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [239].

257 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [241].

258 [2019] 1 SLR 645.

259 *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987 at [240], citing *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 at [70].

260 [2023] SGHC 360.

in issue (“SG 322” and “SG 29P”; collectively, the “Patents”). The Patents claimed processes relating to the manufacture of “bortezomib”, an international, non-proprietary name for a cancer drug. SG 322 purported to teach the use of an ether solvent with low miscibility in water during the synthesis of bortezomib, while SG 29P purported to teach the use of convergent synthesis for the large-scale manufacture of bortezomib. The second plaintiff was the purported exclusive licensee of the first plaintiff and distributor of the bortezomib drug, Velcade, in Singapore. The defendant was a Singapore-registered partnership which represented and distributed pharmaceutical products by pharmaceutical manufacturers globally, including one Dr Reddy’s Laboratories (“DRL”).²⁶¹

20.176 The plaintiffs alleged that the defendant infringed the Patents by supplying bortezomib to hospitals in Singapore. The defendants counterclaimed for revocation of the Patents for lack of novelty, lack of inventive step and insufficiency.²⁶² The issues for Gill J’s determination in the General Division were:

- (a) whether the second plaintiff had standing to commence proceedings;
- (b) whether the Patents were valid; and
- (c) whether the Patents were infringed by DRL’s manufacturing process.²⁶³

(1) *Whether second plaintiff had standing*

20.177 The right of action for patent infringement is generally reserved for the proprietor, with the exception of s 74 of the PA, which provides that an exclusive licensee may commence proceedings. The definition of an exclusive licensee is set out in s 2(1) of the PA. The court assesses all evidence put before it to determine if a party is an exclusive licensee.²⁶⁴

20.178 Here, the second plaintiff alleged that it was the exclusive distributor of the product produced by the first plaintiff’s process and that an exclusive distributor fell within the statutory definition of an exclusive licensee under s 2(1) of the PA.²⁶⁵ Having assessed the evidence before the court, Gill J found that the second plaintiff did not have standing. The plaintiffs failed to produce any evidence to show the scope of the second plaintiff’s alleged rights in Singapore. Furthermore, the second plaintiff

261 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [2]–[4].

262 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [1].

263 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [111]–[112].

264 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [59]–[62].

265 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [116].

had not been registered as an exclusive licensee, which is a prerequisite for the court to award damages or order an account of profits in favour of an exclusive licensee under s 75 of the PA.²⁶⁶ In coming to this conclusion, the court did not need to decide whether an exclusive distributor of a patent falls within the meaning of a statutory exclusive licensee in s 2(1) of the PA.²⁶⁷

(2) *Whether Patents were valid*

20.179 Gill J laid down the applicable legal principles on claim construction, the person skilled in the art and the common general knowledge.²⁶⁸ On the facts, the PSA was defined as one who had knowledge of process chemistry and the synthesis of organic compounds, at least five years of laboratory experience and a graduate degree in the field.²⁶⁹ The common general knowledge was broadly defined as the necessary knowledge of synthesising bortezomib and related organic compounds.²⁷⁰

20.180 The court proceeded to analyse the issues of novelty, inventive step and sufficiency in turn.

(a) Novelty

20.181 Gill J stated the well-established law on novelty and applied them to the claims in issue in the Patents.²⁷¹ In relation to SG 322, the court found that Claim 1(b)(ii) was not anticipated but that Claim 1(b)(i) was anticipated by a piece of prior art.²⁷² In relation to SG 29P, the compounds synthesised in the prior art were, at best, analogous but not identical to bortezomib, and therefore did not anticipate the invention of SG 29P.²⁷³ The defendant's key argument was better analysed under the inventive step requirement as one of obviousness through the mosaicking of different pieces of prior art.²⁷⁴

266 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [118]–[122].

267 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [118].

268 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [65]–[68].

269 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [124].

270 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [126]–[130].

271 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [73]–[78].

272 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [159].

273 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [183]–[194] and [196]–[200].

274 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [195] and [201]–[202].

(b) Inventive step

20.182 Turning to inventive step, Gill J applied the four-step test for obviousness in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd*²⁷⁵ (“Windsurfing”), which was endorsed by the Court of Appeal in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd*.²⁷⁶ The last step in the *Windsurfing* test – whether the differences between the matter forming the prior art and the inventive concept of the claim constitute steps that would have been obvious to the skilled man – is grounded in a holistic, multi-factorial assessment of factors relevant to obviousness.²⁷⁷ The “obvious to try” formulation has also been accepted locally.²⁷⁸ The court’s decision is ultimately one of fact, impression and judgment.²⁷⁹

20.183 Gill J considered the law on technical prejudice as the plaintiffs had relied on this factor. In the context of the obviousness analysis, this refers to the prejudice in overcoming the preconceptions of the skilled person in a particular field.²⁸⁰ In such cases, inventiveness lies in “finding out that that which those in the art thought ought not to be done, ought to be done”.²⁸¹ There must be a sufficiently widespread mindset within the industry that no notional skilled person in the art would consider the viability of the alleged inventive step.²⁸² Such a prejudice would cause modification to the prior art proposals to be regarded with “considerable reserve if not overt skepticism”.²⁸³

20.184 The prejudice alleged by the patent proprietor must be one that is technical in nature, rather than merely commercial. However, it is not necessary for the patent to explain why the prejudice is wrong or provide a scientific explanation of how the invention works to overcome it.²⁸⁴

20.185 Applying these principles to SG 322, Claim 1(b)(i) taught the use of a coordinating ether solvent with low miscibility with water, which was obvious to try. However, it was not obvious to try the core concept of

275 [1985] RPC 59.

276 [2008] 1 SLR(R) 335.

277 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [79]–[82].

278 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [84]–[85].

279 *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2018] 3 SLR 1334 at [126].

280 Colin Birss *et al*, *Terrell on the Law of Patents* (Sweet & Maxwell, 19th Ed, 2022) at para 12-97.

281 *Union Carbide Corp v BP Chemicals* [1998] RPC 1 at [25].

282 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [88]–[89].

283 *Dyson Appliances Ltd v Hoover Ltd* [2001] IP & T 1 at [156].

284 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [89].

Claim 1(b)(ii), which was the use of an ether solvent with low miscibility with water and a coordinating co-solvent in specified proportions.²⁸⁵

20.186 In relation to SG 29P, Gill J noted that bortezomib was sufficiently analogous to the compounds synthesised using convergent synthesis in several prior process patents (“WO 506” and “WO 507”).²⁸⁶ Taken together with the common general knowledge, the process of convergent synthesis employed in SG 29P would have been regarded by the person skilled in the art as obvious to try for the synthesis of bortezomib with a fair expectation of success.²⁸⁷

20.187 The court also rejected the plaintiffs’ argument that there existed industry opinion and therefore technical prejudice at the time against the utility of the processes advanced in WO 506 and WO 507. The plaintiffs relied on an observation in a textbook highlighting an issue with those processes to argue that the skilled process chemist would have found it counter-intuitive to embark on the convergent synthesis process in SG 29P. However, given the common general knowledge at the time and the existence of other materials pertaining to convergent synthesis, the skilled person in the art would not have interpreted the textbook’s observation as a significant hurdle to the process. Rather, the skilled person would have experimented with the convergent synthesis method and taken steps to deal with the issue highlighted in the textbook. There was therefore no technical prejudice occasioned by the textbook.²⁸⁸

20.188 Thus, the prior art rendered the invention in Claim 1 of SG 29P obvious.²⁸⁹ Following the reasoning of the Court of Appeal in *Sunseap*, the dependent claims in SG 29P were also invalid for lack of inventive step.²⁹⁰ The same conclusion would have been reached on the parties’ positions that the dependent claims were contingent on the same inventive concept in Claim 1.²⁹¹

285 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [164]–[167].

286 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [211].

287 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [212].

288 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [213]–[216].

289 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [217].

290 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [218]. However, the court noted (at [66]) that the correctness of the reasoning in *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 has since been questioned by the Court of Appeal in *Ila Technologies Pte Ltd v Element Six Technologies Ltd* [2023] 1 SLR 987.

291 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [218].

(c) Sufficiency

20.189 The defendant had also argued that Claim 12 of SG 322, which referred to a non-existent claim, should be invalidated for insufficiency.²⁹² The court relied on guidance from the High Court's decision in *Ng Kok Cheng v Chua Say Tiong*²⁹³ and the Court of Appeal in *Iia Technologies* in its evaluation of the present facts. Here, the person skilled in the art, applying the typical claim construction process to the entirety of SG 322, would have been able to conclude which claim was meant to be referred to, therefore enabling him to perform the invention without undue burden. Thus, Claim 12 was not invalid for insufficiency.²⁹⁴

(d) Conclusion on validity

20.190 In summary, SG 29P was found to be invalid for lack of inventive step and SG 322 was partially valid in so far as the claims related to the inventive concept in Claim 1(b)(ii). The court then dealt with the question of whether the valid asserted claims in SG 322 were infringed.²⁹⁵

(3) *Whether SG 322 was infringed*

20.191 The plaintiffs' primary case on infringement rested on the invocation of s 68 of the PA.²⁹⁶ The prevailing law on reversal of burden of proof for infringement under s 68(1) of the PA is trite. If the patent concerns a new product, the burden of proving that the product is not made by the process is on the alleged infringer. Otherwise, the proprietor must show: (a) a "substantial likelihood" that the product is made by the process; and (b) that the proprietor has been unable through reasonable efforts to determine the process actually used.²⁹⁷

20.192 Since borteozomib was known in the state of the art, the second limb of s 68(1) of the PA was applicable.²⁹⁸ Given the techniques that were available and part of the prior art, Gill J found that there was no "substantial likelihood" that the alleged infringing product manufactured by DRL could only have been made from the first plaintiff's process in SG 322.²⁹⁹

292 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [171].

293 [2001] 2 SLR(R) 326.

294 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [176]–[177].

295 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [219]–[220].

296 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [282].

297 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [94]–[96].

298 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [97].

299 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [227]–[260].

20.193 The plaintiffs also failed to prove that they had expended “reasonable efforts” to determine the process actually used by DRL. Thus, the burden of proof had not been successfully reversed.³⁰⁰

20.194 The plaintiffs’ secondary case on infringement employed similar arguments and sought to prove that DRL’s process must have used the methods taught in SG 322. This was dismissed in light of the court’s earlier findings under s 68 of the PA.³⁰¹ For completeness, the court considered and rejected the plaintiff’s arguments, holding that the similarities between the two processes did not necessarily lead to the inference that the claimed invention in SG 322 was being used by DRL.³⁰²

20.195 In conclusion, SG 29P was invalid for lack of inventive step. Although SG 322 was valid, the plaintiffs failed to prove that any of the asserted claims had been infringed by DRL’s manufacturing process.³⁰³

300 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [261]–[272].

301 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [282].

302 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [284]–[288].

303 *Millennium Pharmaceuticals, Inc v Zyfas Medical Co* [2023] SGHC 360 at [289].