

# ATMD Bird & Bird & IP Pulse

Singapore, December 2014

## IP Group welcomes new associates

We would like to welcome **Neo Ling Yee** and **Tan Lijun**, who recently joined ATMD Bird & Bird's Intellectual Property Group as associates.



Neo Ling Yee



Tan Lijun

## Contents

IP Group welcomes new associates	1
Time Inc loses Singapore trademark case	1
Protecting your assets: Add bite to your rights!	2

## Time Inc loses Singapore trademark case



By **Tan Lijun**

lijun.tan@twobirds.com

In a recent Intellectual Property Office of Singapore (IPOS) case, US publishing giant

Time Inc and proprietor of well known magazines Time and Fortune, failed to invalidate the Singapore trade mark



(the "Subject Mark").

Li San Zhong, the proprietor of the Subject Mark and Chinese bi-monthly financial magazine Fortune Times, had failed to adduce evidence in support of his trade mark registration in the invalidation proceedings and was deemed to have admitted to the facts alleged by Time Inc in its invalidation application. Yet, Time Inc was unable to succeed on any of the grounds of its invalidation application.

Amongst other things, Time Inc claimed its trade mark was "well-known" under the Singapore Trade Marks Act (the "Act") and that the Subject Mark contained two of its most famous registered trade marks,

"FORTUNE" and "TIME", and was therefore confusingly similar to the said marks and was registered in bad faith.

The approach to comparing marks in Singapore is a mark-for-a mark and does not permit a comparison of the totality of Time Inc's "FORTUNE" and "TIME" marks on the one hand with the Subject Mark on the other. The IPOS hearing officer found that in comparing "FORTUNE" with the Subject Mark and comparing "TIME" with the Subject Mark, the respective pairs of marks were not similar on the whole. She further found that there was no confusing connection between the Subject Mark and Time Inc and consequently, use of the Subject Mark was not likely to damage Time Inc's interest.

In addition, the IPOS hearing officer found that even if it were assumed that the competing marks were similar, there was no likelihood of confusion. The IPOS hearing officer found that the consumer was thought to be likely to exercise a sufficient degree of care in selecting reading content of interest to him.

Though the IPOS hearing officer found that for the purposes of Section 7(6) of the Act, Time Inc enjoyed goodwill in Singapore, she found that Time Inc failed on this ground of invalidation because there was no marks-similarity, no reasonable likelihood of confusion between the Subject Mark and Time

Inc's marks, no misrepresentation by Li San Zhong and thereby no damage caused.

The IPOS hearing officer reiterated that there is a high threshold for a claim of bad faith. Time Inc's assertion that Li San Zhong chose to confuse customers into thinking that there is an association between the Subject Mark and the Time Inc's marks was unsupported by evidence and did not pass the high threshold required.

As the IPOS decision was only released earlier this month, it remains to be seen whether Time Inc will appeal the decision to the Singapore High Court. If appealed, the appeal will be a total re-hearing and the High Court will have the power to require that further evidence be given. In the meantime, the Subject Mark remains on the register and it will continue to co-exist with Time Inc's marks in Singapore.

It worth noting that this is the second time in recent months that Time Inc has suffered a trade mark defeat. In November, the publisher lost a claim in the UK that its 'Ideal Home' trademark was infringed by Media 10's use of the trade mark on its website for its annual Ideal Home Show in London.

# Protecting your assets: Add bite to your rights! The importance of a good brand management strategy in Singapore and elsewhere



**By Adele Lim**  
adele.lim@twobirds.com

Filing multiple trade mark applications for various representations of your key marks will

almost always mean incurring additional costs, but you should consider doing so at least for your key brands – here's why.

## The 'Angry Birds' decision

Rovio Entertainment ('Rovio'), the developer of the popular mobile phone app game Angry Birds, had separately

registered the following marks in Singapore:

- the word mark ANGRY BIRDS and;
- the device mark (A)

covering a range of goods and services, including snack food.



Device mark (A)



Device mark (B)

Kimanis Food Industries ("Kimanis") filed an application for its mark (B), covering the same goods.

- In designing its mark, Kimanis had admitted to being inspired by Rovio's trade marks.
- However, the Intellectual Property Office of Singapore ("IPOS") dismissed Rovio's opposition and allowed Kimanis' mark to proceed to registration.
- IPOS decided that overall, Kimanis' mark was not similar to

Rovio's prior registered marks because the marks in question were to be compared "mark for mark" i.e. as set out in Table 1, not Table 2. In this case, each registered trade mark had to be treated separately on its own, whereupon Kimanis' mark was assessed to be adequately different from each of Rovio's marks.

## Important lessons

It appears from this decision that the fact that Rovio had registered components of its mark separately and did not have a composite mark may have worked against it, as each registered mark had to be individually compared against Kimanis' mark as a whole in assessing if the marks were confusingly similar.

For optimum protection, it is therefore important for brand owners to consider an appropriate filing strategy to ensure that your brands are properly and adequately protected.

At least in respect of key brands, it is prudent to ensure that the individual elements of the mark are protected individually and as a whole together with the word elements.

Table 1

Where Rovio's marks are assessed individually against Kimanis' mark

S/N	Application Mark	Opponent's Earlier Mark T1111886Z
1.		
		Opponent's Earlier Mark T1113897F
2.		<b>ANGRY BIRDS</b>

Table 2

Where Rovio's marks are assessed collectively against Kimanis' mark

S/N	Application Mark	Opponent's Earlier Mark T1111886Z
1.		
		Opponent's Earlier Mark T1113897F
		<b>ANGRY BIRDS</b>

*Newsletters give general information only as at the date of first publication and are not intended to give a comprehensive analysis. They should not be used as a substitute for legal or other professional advice, which should be obtained in specific circumstances. Furthermore, information in our newsletters is provided subject to our terms and conditions of use.*

**twobirds.com**

Abu Dhabi & Beijing & Bratislava & Brussels & Budapest & Copenhagen & Dubai & Dusseldorf & Frankfurt & The Hague & Hamburg & Helsinki & Hong Kong & London & Lyon & Madrid & Milan & Munich & Paris & Prague & Rome & Shanghai & Singapore & Skanderborg & Stockholm & Sydney & Warsaw

ATMD Bird & Bird LLP is a Singapore law practice registered as a limited liability partnership in Singapore. The firm is associated with Bird & Bird, an international legal practice. It is solely a Singapore law practice and is not an affiliate, branch or subsidiary of Bird & Bird or Bird & Bird LLP.