

Changes to Singapore's patent practice



by Edmund Kok

The Singapore Parliament has recently passed the Patents (Amendment) Bill that aims to fundamentally change Singapore's patent practice. These

changes, likely to come into effect later this year, aim to solidify Singapore's intellectual property (IP) regime, expand its IP capabilities and help develop Singapore to be an Asian IP hub. This article summarises two main changes.

The most significant amendment involves the replacement of the current "self-assessment" system with a new "positive grant" system. Under the current's "self-assessment", a patent applicant is under no obligation to amend his application at any stage, even in the face of an adverse examiner's opinion and/or report. A Singapore patent shall issue once the formal requirements are met and upon the completion of one of the search and examination procedures chosen for the application. Therefore, the establishment of an adverse examination report will not bar the application from proceeding to grant.

Under the new "positive grant" system, all patent applications must satisfy the patentability criteria of novelty, inventive step and industrial applicability in order to proceed to grant. It is Parliament's intention to raise the quality of Singapore-granted patents and to enhance Singapore's standing in the IP industry and bring the country's IP regime at par with that of the UK, US, Japan and European Patent Office.

The second key change involves the liberalisation of the patent agent sector in Singapore, thereby increasing expertise to better meet the growing demand for patent services.

It was reported in Parliament that Asian countries represent the highest growth in Patent Cooperation Treaty (PCT) applications filed. Thus, Singapore is faced with both an opportunity and challenge to develop as a one-stop shop in Asia for procuring and implementing patent services. Hence, with the new

changes, foreign qualified patent agents may be registered at the Intellectual Property Office of Singapore (IPOS) on the basis of their foreign qualifications. These IPOS-registered foreign qualified agents and foreign firms can undertake offshore patent work in Singapore as long as at least one partner or director is a foreign-qualified IPOS registered agent. The scope of offshore patent work that foreign-qualified agents can do will be restricted to applying for or obtaining patents anywhere except IPOS, preparing patent specifications for filing applications including PCT applications outside Singapore and providing expert advice on patent laws of other countries. The drafting and filing of applications with IPOS which requires knowledge of Singapore Patent law, will continue to be only open to registered Singapore patent agents, advocates and solicitors with practicing certificates.

"Lady Rose" vs "Rose Lady"?

By Oh Pin-Ping



Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd [2012] SGHC 104 concerned an action by the proprietor of the (stylized) "Lady Rose" trade mark, which is registered for, *inter alia*,

cosmetics, against the distributor and retailer of cosmetic products sold under the name "Rose Lady" for trade mark infringement and passing-off. The High Court found the defendants liable for trade mark infringement, but dismissed the plaintiff's claim for passing-off.

For there to be trade mark infringement, there must have been use of the offending sign "*in the course of trade*". The defendants argued in their defence that there was no infringement because the phrase "Rose Lady" was not used as a trade mark.

This argument was rejected by the judge. Citing numerous authorities, he held that a product was capable of having more than one trade mark, so that secondary or tertiary product identifiers can function as trade marks if they indicate the origin of a product.

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If the secondary product identifier is a fancy word, then it could not be taken as anything but a trade mark. The judge found "Rose Lady" to be non-descriptive and therefore a fancy mark that was used as a secondary mark.

The defendants also argued that the goods had been marketed under the sign "VOV" or "VOV Rose Lady", rather than "Rose Lady". The judge also rejected this argument on the basis that the "VOV" mark was not prominently displayed on the packaging of the products.

To establish infringement, the plaintiffs had to show (a) the "Rose Lady" sign was similar to the "Lady Rose" mark; (b) the "Rose Lady" sign was used in relation to identical or similar goods as those for which the plaintiff's mark was registered; and (c) there was a likelihood of confusion on the part of the public.

Identity of goods (i.e., cosmetics) was not in dispute. Notwithstanding that the "Lady Rose" mark and the "Rose Lady" sign consisted of inverted words, the judge found the mark/sign to be visually and aurally similar, particularly when the "imperfect recollection" of the consumer is taken into account. Because of imperfect recollection, the judge also gave little weight to the fact that the "Lady Rose" mark included elements (i.e., drawing of a rose and cursive font) that were not present in the "Rose Lady" mark.

Accordingly, the judge held that there was likelihood of confusion on the part of the public. The claim of trade mark infringement was thus made out.

However, the defendants were not liable for passing-off because the plaintiff could not establish that it had goodwill in the mark. Despite evidence that the plaintiff had been trading under the mark for 40

years, the judge was of the view that the plaintiff having failed to adduce evidence of adequate and sustained promotion and advertisement of its mark in recent years, there was no goodwill.

Interestingly, the judge also commented that he believed the defendants' "VOV" line of cosmetics to be a better known brand than "Lady Rose". Be that as it may, this did not prevent the judge from finding the defendants liable for trade mark infringement.

This case underscores the importance for a business to secure registration of its trade marks, including any secondary or tertiary product identifiers which it intends to use on products, and serves as a timely reminder that well-known-ness of a defendant's mark is not a defence to trade mark infringement.

Victoria's Secret v. Valentine's Secret



By Deryne Sim

The Opponent, Victoria's Secret Stores Brand Management, Inc., is the holder of the VICTORIA'S SECRET brands and sub-brands. The

Opponent supplies its products through specialty stores in the United States of America and to customers all over the world via its website and catalogue.

The Applicant, Eclectic Edge Inc., operates a fashion boutique named "Valentine's Secret" in Indonesia.

The relevant marks to these opposition proceedings are: -

The Applicant's Marks

Mark: 

Application No.: T0803761G

Date of Application: 24 March 2008

Class No.: 25

("the Valentine's Secret Mark")

The Opponent's Marks

Mark: "VICTORIA'S SECRET"

Date of Registration: 12 March 1991

Class No.: 25

("the Victoria's Secret Mark")

The Applicant's Mark

Mark:



Application No.: T0803762E

Date of Application: 24 March 2008

Class No.: 25

("the VS Mark and Slogan")

The Opponent's Marks

Mark: "VS SPORT"

Registration No.: T9809412G

Date of Registration: 17 September 1998

Class No.: 25

("the VS SPORT Mark")

The Opponent raised several grounds of opposition. The main grounds were that the Applicant's Marks should not be registered because: -

- Sections 8(2) - the Applicant's Marks are similar to the Opponent's Marks, and is to be registered for similar goods, such that there exists a likelihood of confusion on the part of the public.
- Section 8(4)(b)(i) - the Applicant's Marks are similar to the Opponent's Marks, which are well known in Singapore, and use of the Opposed Marks will indicate a connection between the Applicant's goods and the Opponent; and is likely to damage the interests of the Opponent.
- 8(7)(a) - the use of the Opposed Marks are liable to be prevented by the law of passing off.

On the issue of similarity of marks, the hearing officer, PAR Loo found that there was conceptual similarity between Valentine's Secret Mark and the Victoria's Secret Marks. Both marks evoked the idea of a secret which either belongs to a person or attaches to an event. However, even then, she felt that the relevant customers were not likely to be confused. The substantial business transacted via the Opponent's mail order business model in early 2000 (when online shopping had not yet caught on) indicates that the Opponent's customers are sophisticated shoppers who know what they want. These shoppers were probably astute individuals who preferred exclusive and specialized

goods available to the exclusive few on the Opponent's mailing list.

As for the VS Mark and Slogan and the VS SPORT Mark, she held that there was no similarity between these marks, and as such, there was no need to consider the remaining requirements of Section 8(2).

For the reasons stated above, the Opponent did not succeed under this ground.

As for the Valentine's Secret Mark, whilst there was no confusion under section 8(2), PAR Loo went on to consider whether the remaining elements under Section 8(4)(b)(i) were established i.e.: -

- a. that the Opponents' Victoria's Secret Mark is well known in Singapore,
- b. that the Applicants' use of the Valentine's Secret Mark in relation to Class 25 goods would indicate a connection between the Applicants' products and the Opponent; and
- c. is likely to damage the interests of the Opponent.

Although the Opponent did not have a physical shop front in Singapore, PAR Loo was impressed by the Opponent's volume and amount of sales in Singapore and the number of catalogues mailed to Singapore. In light of these figures, PAR Loo found that the Opponent's Victoria's Secret Mark was well known in Singapore.

However, as for the third requirement of "connection", PAR Loo held that this term does not mean a mere connection, but a connection which is likely to give rise to confusion. Under the Section 8(2) ground of opposition, PAR Loo had earlier found that there was no likelihood of confusion in respect of the Valentine's Secret Mark and the Victoria's Secret Mark. Applying the same reasoning, PAR Loo concluded that there was no confusing connection between the Applicant's goods applied with the Valentine's Secret Mark and the Opponent. Therefore, the Opponent failed under Section 8(4)(b)(i) as well.

It is to be noted that the Opponent did attempt to rely on Section 8(4)(b)(ii) as well. This ground of opposition would have been favourable to the Opponent as it did not require proof of confusion. However, what was required was that the Opponent prove that the Opponent's Marks were well known to the public at large in Singapore and that the use of the Applicant's Marks caused dilution or took unfair advantage of the Opponent's Marks. Given the Opponent's sales and fame in Singapore, the Opponent would

be likely to succeed in proving that its marks were well known to the public at large in Singapore. Unfortunately, such evidence was not included in the Opponent's evidence, and the Opponent did not succeed under Section 8(4)(b)(ii).

Under the third ground of opposition, the Opponent had to prove that the use of the Opposed Marks was liable to be prevented by the law of passing off. The three elements in the test for passing off are: goodwill, misrepresentation and damage.

The Opponent was not able to prove that it had goodwill in Singapore. Since the Opponent had no physical presence in Singapore, and the Opponent operated on a mail-order business model, PAR Loo held that there was no goodwill in the "VICTORIA'S SECRET" mark in Singapore.

For this reason, the Opponent's ground of opposition under Section 8(7) failed.

As the Opponent failed on all its grounds of opposition, PAR Loo allowed the Applicant's Marks to proceed to registration.

To this end, this author wonders if PAR Loo applied an unduly restrictive approach to determine whether the Opponent had goodwill in Singapore. Given the proliferation of e-commerce, physical shopfronts are no longer necessary to draw in customers. This decision reinforces the existing judicial authorities in Singapore which have held that where a mark is only well known in Singapore (as opposed to well known to the public at large), it would still be necessary to establish confusion as an element of the opposition under the relevant provision (i.e. section 8(4)(b)(i)).

The content of this update is of general interest and is not intended to apply to specific circumstances. The content should not therefore, be regarded as constituting legal advice and should not be relied on as such. In relation to any particular problem which they may have, readers are advised to seek specific advice. Further, the law may have changed since first publication and the reader is cautioned accordingly.

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