INTELLECTUAL PROPERTY
OFFICE OF SINGAPORE

UPDATES FROM IPOS

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Dear readers,

For those of you who have just subscribed, a very warm welcome!

If you know of anyone that would like to be added to this mailing list (which deals primarily with IP/IT dispute resolution in Singapore), please drop us a note at ipos_hmd@ipos.gov.sg. IPOS also separately maintains another mailing list for circulars, legislative amendments and other related matters which you can join by contacting news@ipos.gov.sg. For any comments or feedback (or to draw our attention to any interesting news we might have missed), please email gabriel_ong@ipos.gov.sg. Archived copies of our previous updates are available at the following link.

Recent Court decisions

- *IIa Technologies Pte. Ltd. v Element Six Technologies Limited* [2023] SGCA 5 (Court summary included)

  The Court of Appeal has found a patent for the manufacture of synthetic diamonds to be invalid on grounds of insufficiency. At first instance, Element Six claimed that IIa Technologies had infringed two of its patents in the field of synthetic diamonds. The High Court found that one of the asserted patents was invalid, whereas the other was valid and infringed by IIa Technologies. IIa Technologies appealed against the part of the judgment which was made in Element Six's favour. The appeal was allowed. The overall result is that both of the patents asserted by Element Six against IIa Technologies in the dispute have been revoked and there is no liability for patent infringement. (See also Singapore Law Watch coverage syndicating a report by The Straits Times under the headline "S'pore maker of lab-grown diamonds wins seven-year court battle against De Beers firm".)

  It may interest some to note that the Court of Appeal directed parties to prepare a primer document (with a 50-page limit) "*setting out their points of agreement and divergence on topics including the common general knowledge (such as different methods of growing diamonds and types of defects in diamonds), the state of the art (including other patents) and the inventive concept of* [the patent]", as well as convened a technology tutorial that was conducted over 3 days. These steps were considered to have "greatly assisted" the court in coming to grips with the highly complex subject matter (see [8] of the decision).

- *Kiri Industries Limited v Senda International Capital Limited & Anor* [2023] SGHC(I) 3 and [2023] SGHC(I) 4 (Court summary for both cases included)

  Readers would be familiar with our coverage of the long-running Dystar litigation. Previously, the Singapore International Commercial Court (SICC) had found Senda to be liable for oppressive conduct against Kiri and granted a buy-out order under which Senda had to purchase Kiri's shareholding in DyStar. In assessing the value of the shares, an issue arose as to the compensation to be paid in respect of the unauthorised use of DyStar's patent to produce certain dyes. The SICC had earlier found that this was tied to the concept of a notional licence fee, which was to be calculated based on the quantity of infringing products falling within the scope of the patent. In June 2021, the SICC issued its decision on the valuation of Kiri's shares in DyStar, and both parties appealed to the Court of Appeal. The Court of Appeal remitted the issue of the value of the notional licence back to the SICC to be reassessed. In [2023] SGHC(I) 3, the SICC determined the quantity of infringing products based on the best available evidence, and in [2023] SGHC(I) 4 ruled on the final valuation of the shares (which was US$603.8m) based on the expert's revised numbers.

- *Siemens Industry Software Inc. v Inzign Pte Ltd* [2023] SGHC 50

  The High Court has found a company, Inzign Pte Ltd, to be vicariously (but not directly) liable for copyright infringement arising out of the actions of its employee, Mr Win. Mr Win had downloaded and installed an unauthorised version of the plaintiff's software on an unused laptop which had been left in one of the drawers in the toolroom which he worked. The court assessed damages at S$30,574 and granted a permanent injunction against the defendant. (See also Singapore Law Watch coverage syndicating a report by The Straits Times under the headline "Company held liable for copyright infringement after employee installs unlicensed software".)

  Interestingly, there was a proposal by the defendant to call an expert witness to testify on the mechanisms and practices which companies can put in place to protect their software from online copyright infringement. The intention was to rely on this evidence to support an argument that the plaintiff was at fault for not adequately protecting its copyright. After consideration, the judge did not allow the defendant to adduce expert evidence: see [49]-[51] of the decision.

- *Tritech Water Technologies Pte. Ltd. & Anor v Duan Wei* [2023] SGHC 23

  This was an action by a company against its former employees for, among other things, breach of confidence. The claim was that an ex-employee had forwarded confidential documents to his personal email. Pertinently, the information in the documents was sufficient to replicate the company's entire production process. Subsequently, a competitor started production of identical or substantially similar products. The High Court found the defendants to be in breach of their equitable duty of confidence because they had taken confidential information from the company and used it to benefit a competitor.

- *Spacesats Pte. Ltd v Chan Chia Sern & 5 Ors* [2023] SGHC 40

  This was an action for contempt of court made against an individual in his personal capacity as well as in his capacity as sole director of a company subjected to the order. The court order was made in favour of Spacesats, a joint venture company that was established to develop and exploit proprietary technology relating to the development and production of micro plasma thrusters for use in small satellites. Spacesats had suspected that its intellectual property rights (which included the work product of its scientist employees / secondees) were not properly secured, and commenced a lawsuit to enforce this. Subsequently, it obtained summary judgment. The relevant part of the court order required Dr Chan to (among other things) deliver up personal laptops and external storage devices to the plaintiff. However, he refused to do so. The High Court found that Dr Chan had intentionally disobeyed the order, and sentenced him to imprisonment for a term of two months as well as imposed a fine of $2,000.

- *Shanghai Afute Food and Beverage Management Co. Ltd. v Tan Swee Meng & 2 Ors* [2023] SGHC 34

  This case concerned disputes relating to a franchise agreement for an intended coffee shop under the name of "After Coffee". However, the planned business never started operations. In its stead, the defendants started a business known as "Beyond Coffee". The plaintiff brought claims for: (1) breach of confidence; (2) passing off; (3) breach of a master franchise agreement; and (4) unlawful means conspiracy. The High Court allowed substantially all of the claims, except for passing off (which failed because the business had not commenced operations in Singapore and the plaintiff could not show that it had generated sufficient goodwill by virtue of its pre-trading activities). (See also Singapore Law Watch coverage syndicating a report by The Straits Times under the headline "Celebrity hairstylist Addy Lee's firm wins claims against franchisee over coffee business they set up".)

  It may also interest some to note that earlier in the proceedings, the plaintiff had obtained an interlocutory injunction against two of the defendants to protect its confidential information (including beverage recipes belonging to the plaintiff). The High Court subsequently found that the injunction had been disobeyed and that the defendants were in contempt of court (see *Shanghai Afute Food and Beverage Management Co Ltd v Tan Swee Meng and anor* [2021] SGHC 149).

Special feature: State Court copyright cases

Following the commencement of the relevant provisions of the Intellectual Property Dispute Resolution Act 2019, the High Court has exclusive original jurisdiction for civil copyright disputes. This does not affect cases commenced in the State Courts before 1 April 2022. The following District Court decisions are among the "legacy" cases.

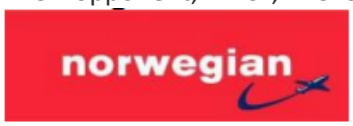
- *PHD Education and anor v Michelle Vera Lee Mei Jiao* [2022] SGDC 18 (factors to be considered in assessing statutory damages for copyright infringement in the context of examination and education materials for students)

- *Eri Organization Pte Ltd v Chen Lu and anor* [2022] SGDC 90 (successful claim for copyright infringement but unsuccessful claim for breach of contractual duties of confidence and loyalty; decision relates to District Court's findings in respect of the latter claim)

Recent IPOS decision

- *NCL Corporation v Norwegian Brand Ltd.* [2023] SGIPOS 5 (Case summary)

  This case involves two parties with established businesses in the global travel industry. The trade mark applicant provides air travel services and the opponent operates cruises under "NORWEGIAN CRUISE LINE". They share a common word in their respective trade marks, namely, the word "Norwegian". There is some overlap between the cruise company's services and the services claimed by the airline company in its international registrations designating Singapore.

  The opponent, NCL, relied on two main grounds in this opposition against 

. First, it relied on the "well known mark" provision under Section 8(4) of the Trade Marks Act 1998 ("the Act"). Second, it relied on the "passing off" provision under Section 8(7)(a) of the Act. The Principal Assistant Registrar decided that there was no likelihood of deception or confusion under the law of passing off as long as the airline company's specifications of services were appropriately qualified.

  The opposition was also directed at another of Norwegian Brand's international registrations, namely:  . However, this mark was found to be distinguishable from "NORWEGIAN CRUISE LINE" as their memorable and dominant elements differed. Here, the opposition was unsuccessful.

(Updated) MinLaw-IPOS IP&Tech Dispute Resolution Brochure (now in Chinese!)

As you may be aware, MinLaw/IPOS recently published a brochure: "SINGAPORE A World Class Venue for IP & Technology Dispute Resolution". We are happy that an updated edition, and also a new Chinese version, are now available. We hope the latter is useful in attracting more international IP/tech disputes from Chinese-speaking disputants and jurisdictions. The Chinese brochure can also be found at the link below, together with other useful links. Please feel free to circulate the brochure with your stakeholders, colleagues and contacts.

- New Chinese brochure
- Updated English brochure
- General IP dispute resolution page where you can find the above brochures as well as other related resources

Insights on IP Dispute Resolution in Singapore: a collection of interviews

Readers who've been following these updates may recall the series of interviews conducted by the NUS Intellectual Property Students Association with some key figures in Singapore's IP dispute resolution landscape. The interviews were published on Juris Illuminae, an online publication by the Singapore Law Review. We've recently included a link to them on our dispute resolution page as well (see hyperlink above).