

UPDATES FROM IPOS

AUGUST 2022

Dear readers,

We hope this update finds you well.

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. And, 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.

Recent Court decisions

- [*Nippon Shinyaku Co, Ltd v Registrar of Patents*](#) [2022] SGHC 164

The General Division of the High Court has allowed an appeal against the Registrar of Patents' decision to refuse a proposed correction to the specification of a patent application filed in Singapore. In arriving at the decision, the Judge considered, among other things, the issue of whether IPOS (the Intellectual Property Office of Singapore) or the Registrar of Patents should be the proper party to the appeal. (Answer: the Registrar.)

- [*3D Networks Singapore Pte Ltd v Voon South Shiong & Anor*](#) [2022] SGHC 167

This was a dispute involving ex-employees. The plaintiff, a Singapore-incorporated company, sued the first defendant (its former employee) and the second defendant (a competitor company which the first defendant had collaborated with). It was alleged, among other things, that the first defendant had: (a) solicited the plaintiff's former employees together with its suppliers and customers and diverted them to the second defendant; and (b) misappropriated the plaintiff's confidential and proprietary information. The plaintiffs succeeded in establishing most of its claims, including breach of confidence against the first defendant arising from his acts of communicating confidential information about the plaintiff's clients and financial information to the second defendant.

- [*Nalli Kuppuswami Chetti and Nalli Ramanathan & Anor v Nalli Pte Ltd & 2 ors*](#) [2022] SGHC 109

Our attention was recently drawn to this decision, which was handed down in May. It involved the "Nalli" business name and trade mark, which was used in connection with sarees/saris. In the 1990s, a High Court suit between the parties was settled by way of deeds



of settlement which governed, among other things, the use of “Nalli” in Singapore. The question in this case was whether the defendants’ use of “Nalli” was permissible or whether they had breached the deeds of settlement. The General Division of the High Court ultimately found that the deeds of settlement had indeed been breached by the first defendant and granted the plaintiffs an injunction to restrain the first defendant from continuing its offending conduct.

Recent IPOS decisions

- [Conorzio del Formaggio Parmigiano Reggiano v Fonterra Brands \(Singapore\) Pte. Ltd.](#) [2022] SGIPOS 11

We earlier reported on the Registrar’s Decision in [2022] SGIPOS 7 to allow the Consorzio’s opposition to Fonterra’s request to qualify protection for “Parmigiano Reggiano” by carving out the term “Parmesan” from the scope of geographical indication protection. Central to the outcome was the hearing officer’s finding, on the evidence, that “Parmesan” is a translation of “Parmigiano Reggiano”. Both parties wrote in to request for the full grounds of decision (which in essence is a longer version of the Registrar’s Decision), which have now been issued and published as [2022] SGIPOS 11.

- [The a2 Milk Company Limited v Société des Produits Nestlé S.A.](#) [2022] SGIPOS 12

Nestle was unsuccessful in its opposition to a2’s application to register



(note: the mark reads S-26 followed by Pro-Atwo below) in Classes 5 and 29 for infant formula and milk products respectively. The primary earlier trade mark relied on by Nestle was “A2”, also registered in Classes 5 and 29.

- [Swatch AG \(Swatch SA\) \(Swatch Ltd.\) v Apple Inc.](#) [2022] SGIPOS 13

Apple has successfully applied to register the mark “THINK DIFFERENT” in Class 9 for, among other things, smartwatches. This application was opposed by Swatch (registered proprietor of the “Tick different” trade mark in Singapore) on grounds that the application was made in bad faith. Swatch made various arguments in this vein, including that: (a) Apple had no intention to use the mark in Singapore; and (b) that Apple intended to use the mark as a tool to stop others from applying for, registering or using any two-word expression with “different” as the second word. However, the hearing officer was not persuaded that the grounds were made out.

Appeal against IPOS decision

- An appeal to the General Division of the High Court has been filed against the IP adjudicator’s decision in the Eng’s case (*Pauline New Ping Ping v Eng’s Char Siew Wantan Mee Pte. Ltd.* [2022] SGIPOS 10).



Mediation at IPOS

- Read about a successfully mediated trade mark case: [Worldwide Bible Society \(Singapore\) & The Bible Society of Singapore \[2022\] SGIPOS MED 3](#).

If you are involved in IPOS proceedings, consider [mediation](#) as an appropriate dispute resolution process; funding is available under our [Revised Enhanced Mediation Promotion Scheme](#).

Featured publication

The WIPO Arbitration and Mediation Center has published “WIPO Alternative Dispute Resolution Options: A Guide for IP Offices and Courts”, authored by Singapore practitioner Joyce A. Tan, who is also a member of the WIPO Mediation and Arbitration Advisory Committee. The introductory paragraph reads as follows:

“This Guide is designed to provide an overview of ADR processes for intellectual property and technology disputes, as well of the experience of the WIPO Center in the context of public ADR programs, and to present options for interested IPOs, courts and other bodies to promote and integrate ADR processes into their existing services. As such, without purporting in any way to be authoritative or prescriptive, this Guide is intended to serve as a practical primer for IPOs, courts and other bodies considering the development, implementation and/or improvement of ADR programs directed at intellectual property and technology disputes.”

Featured events

- **IP Mediation Certification Programme (IPMC)**

We are pleased to partner Singapore Mediation Centre to run a 1-day programme designed to enhance a mediator’s skills in mediating IP disputes. Find out more here <https://www.mediation.com.sg/course/ip-mediation-certification-programme-ipmc/>.

- **Thinking Internationally about IP and Dispute Resolution: What Every Lawyer & Corporate Counsel Should Know, an IP Week @ SG 2022 Associated Event**

IPOS is pleased to co-organise the above webinar with University of Chicago and WIPO Arbitration and Mediation Center. Join us on 11 Aug to find out about the role of experts in IP disputes, the pros and cons of different IP dispute options and more here <https://www.ipos.gov.sg/news/events/thinking-internationally-about-ip-and-dispute-resolution>.

