

UPDATES FROM IPOS

FEBRUARY 2022

Dear readers,

We hope this update finds you well.

By the way, we have started archiving past issues of these updates (starting from July 2021) on our website. They are available at the following [link](#).

Recent Court decisions

- [TMRG Pte Ltd and anor v Caerus Holding Pte Ltd and anor](#) [2022] SGHC(A) 4

This was an appeal against the trial judge's [decision](#) in the "Luke's Oyster Bar" vs "Luke's Lobster" case. At first instance, the appellants (owners of Luke's Oyster Bar & Chop House) had sued the respondents for trade mark infringement, passing off, and sought a declaration of invalidity of the latter's two registered (Luke's Lobster) marks. The trial judge dismissed all of the claims and found that the respondents could rely on the "own name" and "registered mark" defences under ss 28(1)(a) and 28(3) of the Trade Marks Act. The appellants largely repeated their main arguments before the Appellate Division of the High Court, which ultimately dismissed the appeal.

- [Uday Mehra v L Capital Asia Advisors and ors](#) [2022] SGHC 23

In this case, the High Court found that an ex-employee's action of forwarding work emails to his personal email account rendered him liable for breach of confidence (in equity as well as in contract). The emails had been forwarded for the purposes of seeking legal advice against the defendant companies (which were his ex-employers). Nevertheless, given the circumstances (see [268]-[276] of the decision) the judge declined to exercise his discretion to award an injunction and awarded only nominal damages of S\$1,000.

- [Australian Grape and Wine Inc v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco](#) [2022] SGHC 33

We previously reported that: (1) the General Division of the High Court allowed an appeal against the first instance IPOS decision in [Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco](#) [2021] SGIPOS 9 (where Australian Grape and Wine Incorporated was unsuccessful in its opposition to the registration of "Prosecco" as a geographical indication); and (2) leave was obtained for a further appeal to the Appellate Division. The decision of the General Division is now available above.



- [Dong Wei v Shell Eastern Trading \(Pte\) Ltd and anor](#) [2022] SGHC(A) 8

Dong Wei (the appellant) was a freight trader employed by Shell Eastern. There were complaints about his conduct and investigations were commenced against him. His employment was eventually terminated. Shortly before termination, an article was published stating that Shell Eastern had been investigating claims of “unethical dealings including charges of corruption in its tanker chartering team”. It was said that due to the publication of the article, the appellant was unable to find employment in the shipping industry. At trial, the High Court judge dismissed all of the appellant’s claims for multiple alleged breaches of contract and commission of various torts. The Appellate Division of the High Court heard and dismissed the appeal against the trial judge’s decision. One of the issues that arose both at trial and on appeal was whether Shell Eastern had been negligent in failing to protect the confidentiality of the fact and content of the investigation (which led to the publication of the article). To establish alleged negligence, the appellant pointed to the fact that there was a leak and relied on the maxim *res ipsa loquitur*. The Appellate Division agreed with the trial judge’s holding that the maxim only applied to accident and injury cases and even if it did apply to leaks of confidential information, it would not have been satisfied given that there were loose ends as to who might have leaked the information. (Readers may also be interested to note that the appellate court observed, *obiter*, that it is not settled by the Court of Appeal that the implied term of mutual trust and confidence forms a part of Singapore law.)

- [CLM v CLN and ors](#) [2022] SGHC 46

In this case, the General Division of the High Court addressed two interesting and novel questions of law. First, can stolen cryptocurrency assets be the subject of a proprietary injunction? Second, does the court have jurisdiction to grant interim orders against persons whose identities are presently unknown? Both of these questions were answered in the affirmative in the judgment.

Recent IPOS decisions

- [Daimler AG v Vivo Mobile Communication Co., Ltd.](#) [2022] SGIPOS 1

This trade mark opposition was commenced by Daimler AG against “VIVO”, which sought to be registered in Class 12 by Vivo Mobile Communication Co Ltd in respect of “*Electric vehicles; Cars; Motorcycles; Driverless cars [autonomous cars]; Bicycles; Mobility scooters; Trolleys; Tires for vehicle wheels; Remote control vehicles, other than toys; Water vehicles; Air vehicles; Upholstery for vehicles*”. Daimler AG relied on its earlier “VITO” mark in Class 12, registered for “*Motor vehicles; parts and fittings therefor*”.

In dismissing the opposition, the hearing officer found, among other things, that: (a) the competing marks are more similar than dissimilar; (b) the goods overlap; but (c) there would be no likelihood of confusion in relation to motor vehicles and parts and fittings because of the high price point of vehicles and parts in Singapore and the manner in which the goods would be sold.



- [Choi Sun Mi v Comfort Lab Inc.](#) [2022] SGIPOS 2

This was a trade mark non-use revocation action against the mark “COMFORTLAB”, registered in Class 25 for “Coats; sweaters; shirts; underwear (underclothing); nightwear; socks and stockings; T-shirts; headgear for wear; shoes and boots; all included in Class 25”. After examining the evidence, the hearing officer made an order for revocation with effect from 19 January 2018.

Upcoming new legislation on court procedures for IP disputes

In October 2018, MinLaw held a public consultation on reforms to enhance access to our court system for IP disputes. This included an optional, simplified track for IP litigation. This new track, called the “Simplified Process for Certain Intellectual Property Claims”, will be implemented when the new Supreme Court of Judicature (Intellectual Property) Rules 2022 (“new Rules”) come into force on 1 April 2022.

A “transitional learning phase” from 1 April to 30 June 2022 which applies to the Rules of Court 2021 (see the Chief Justice’s Response at the Opening of the Legal Year 2022, at [17]) will likewise apply to these new Rules.

The new Rules will also consolidate the Rules of Court relating to IP rights in a single piece of legislation.

More information and a draft version of the new Rules can be found [here](#) and [here](#) for interim reference. Please note that the draft is subject to changes as it is currently undergoing the vetting process. The finalised new Rules will be published before they come into force.

Featured articles

- Professor David Tan, [Data Analytics in Fintech and the New Copyright Act](#) [2022] SAL Prac 4

In the above article, the author discusses data mining and analytics in the fintech industry against the backdrop of the Copyright Act 2021. In particular, the article explores the interplay between the computational data analysis exception and the fair use defence. Prof Tan suggests that in practice, a (data) miner in the fintech business is more likely to plead fair use rather than a hybrid of both defences and gives reasons for this view.

- Desmond Tan, [Mediation and/or arbitration proceedings – what are you getting yourself into?](#)

Readers may be interested to note that the author of the above article was tasked with the role as the designated patent and technical specialist in the mediation team of one of the parties to a dispute. In this regard, he was tasked with, among other things, seeking out appropriate technical experts in support of the pertinent subject matter for the purposes of the mediation.

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.

