

## UPDATES FROM IPOS

JANUARY 2022

Dear readers,

Happy new year! We hope that it has been a good one so far.

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](mailto: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](mailto: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](mailto:gabriel_ong@ipos.gov.sg).

### Recent Court decisions

- [Fuji Xerox Asia Pacific Pte Ltd & 2 Ors v PTC Business Systems Pte Ltd](#) [2021] SGHC 272

The plaintiffs sued the defendant for trade mark infringement, passing off and copyright infringement (primary, secondary, and infringement of rights in rights management information). The claims were in respect of the defendant's activities in selling modified photocopiers, printers and fax machines bearing the plaintiffs' "ApeosPort", "DocuCentre" and/or "Fuji Xerox" marks in Singapore. As regards copyright infringement, the plaintiffs claimed that the defendant had, among other things, made an unlicensed adaptation of the software/firmware and infringed their rights management information. The defendant denied all of the claims and argued, among other things, that the machines were parallel imports and that the marks in question used in connection with them were used in a descriptive manner.

The plaintiffs ultimately succeeded in substantially all of its claims except for double-identity trade mark infringement and primary copyright infringement (since the plaintiff was unable to prove that the defendant had made an unlicensed adaptation), and the judge held that the asserted defences did not apply. In addition to the usual reliefs (injunction, damages, delivery up for destruction), the court also awarded additional damages under the Copyright Act (which are meant to punish and deter infringement rather than benefit the plaintiff) in the sum of \$100,000.

- [All India Supermart Pte Ltd v Indian Supermart Pte Ltd & Anor](#) [2021] SGHC 293

All India Supermart Pte Ltd ("AISPL") is the owner of the "ALL INDIA SUPERMART" trade mark, registered in Class 35 for "*supermarket retailing; retailing of goods by any means; retail store services; wholesale store services; wholesaling of goods by any means*". It commenced an action for trade mark infringement and passing off against the first defendant, Indian Supermarket Pte Ltd ("ISPL")



and the second defendant, ISPL's director and 50% shareholder. AISPL's objection was directed at the defendants' use of its trade name, "INDIAN SUPERMARKET", in relation to supermarket services. AISPL also concurrently filed an action seeking the invalidation of ISPL's registration for



"INDIAN SUPERMARKET" (a composite mark comprising the words "INDIAN SUPERMARKET" below a device of a person pushing a supermarket trolley with the number "23"). The High Court (General Division) dismissed all of AISPL's claims as well as its action for invalidation. One of the judge's key findings was that "ALL INDIA SUPERMART" and "INDIAN SUPERMARKET" are dissimilar. In particular, AISPL's registration was found to have a relatively low degree of inherent distinctiveness and thus there was a low bar for "INDIAN SUPERMARKET" to be considered dissimilar to it.

- [Michael A. Baker \(executor of the estate of Chantal Burnison, deceased\) v BCS Business Consulting Services Pte Ltd & 2 Ors](#) [2021] SGHC(I) 19 (note: case summary is also available within the same link)

This decision of the Singapore International Commercial Court (SICC) deals with the final tranche of the dispute between the parties over the rights to the inventions and patents of the compound "Ethocyn" (a skin product said to make skin look younger and better toned) and the income or proceeds generated therefrom, as well as other trust monies paid on the facts of the case. In the result, the SICC ordered the defendants to pay US\$7,859,424.23 and CHF1,662,894.67 as sums due on the taking of accounts.

- [Gravitas International Associates Pte Ltd v Invictus Group Pte Ltd](#) [2022] SGHC 2

Readers may also be interested in the above case involving contractual claims arising out of a contract for the provision of consultancy services relating to an initial coin offering (of cryptocurrency tokens).

#### Appeals

- Further appeal of "Prosecco" case to Appellate Division of the High Court

In our previous email update, we reported that the General Division of the High Court allowed an appeal against the first instance 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). Leave has now been obtained for a further appeal to the Appellate Division. (Note: no written grounds of the court's decision are available at this point of time).

#### Recent Copyright Tribunal decision

- [SingNet Pte Ltd v Composers and Authors Society of Singapore Ltd](#) [2021] SGCRT 1

For years, SingNet, an internet service provider and the operator of the SingTel TV pay television service (formerly MioTV), has been embroiled in a dispute with the Composers and Authors Society of Singapore Ltd ("COMPASS"), a collective management organisation, over the appropriate licence fee to be paid to COMPASS over the right to communicate copyright musical works.



The issue was brought by SingNet before the Copyright Tribunal. SingNet’s position was that COMPASS’ charges were unreasonable and arbitrary. After consideration, the Copyright Tribunal dismissed SingNet’s application and held that COMPASS’ methodology in deriving the licence rate was principled, objective and logical. In so doing, the Copyright Tribunal adopted the judicial estimation approach to assess the reasonableness of the licence rate.

#### Recent IPOS decision

- [S. C. Johnson & Son, Inc. v Off-White LLC](#) [2021] SGIPOS 16

S.C. Johnson & Son, Inc (“Applicant”) applied for a declaration of invalidity against Off-White LLC’s



registration for the following series of stylised “OFF” marks in Class 3: which were registered for, among other things, “lotions for skin care; non-medicated skin care preparations; non-medicated toiletry preparations”. The Applicant relied primarily on its two stylised “OFF!” marks



( and ) , both registered in Class 5 for, among other things, fungicides, rodenticides, insecticides and insect repellent. The IP Adjudicator found that average consumers would find the respective marks to be markedly different, and that the relevant goods are dissimilar. The action for invalidation failed.

#### Mediation at IPOS

- *Leonid Kovalkov & JNBK Group Private Limited* [2022] SGIPOS MED 1

The parties in this mediation (conducted at the Singapore Mediation Centre) had been embroiled in several disputes before IPOS since 2012, including several which proceeded to full hearings and resulted in three full grounds of decision issued by the Registrar. While the parties were unable to conclude a mediation settlement agreement, the two proceedings which were the subject of the mediation were withdrawn. As at 21 December 2021, there are no other pending disputes between the parties. This case showcases the value of mediation even when no final settlement agreement is reached. More details are available [here](#).

#### IPOS resources: Year-in-Review & Update to Trade Marks Case Guide

- Every year, we publish a “Year-in-Review” document summarising the key aspects of IPOS decisions across the year and highlighting (where applicable) any issues, holdings and comments of interest. The 2021 version is available [here](#).
- On 6 January 2022, we published an update to our [Trade Marks Case Guide](#). This update includes discussion on two new topics: “Can strong reputation point away from a likelihood of confusion?” and “Failure to disclose meaning of word in foreign language to the Registrar”. The relevant case additions are captured in our changelog at the back of the Guide.



## Feature article

- [In Conversation with Dr Michael Hwang, SC](#)

We are happy to present the [fifth interview](#) in the series of interviews by the NUS Law Intellectual Property Students Association ("IPSA") with key players of the intellectual property ("IP") field in Singapore. This interview is with the renowned practitioner and arbitrator, Dr Michael Hwang, SC. The focus of this interview is on how the global arbitration landscape interacts and intersects with disputes involving intellectual property.

- Professor David Tan has authored a piece for the Law Gazette titled "[We Don't Need Permission to Dance](#)": Key Features of the New Copyright Act 2021. The abstract is set out below.

"Dance as a metaphor connotes relationships between control and experimentation, order and improvisation, purpose and play. The Copyright Bill 2021 which was passed in September 2021, and is expected to come into force before the end of the year, is carefully calibrated to balance between protecting rights owners and enabling others to have access to these works in order to create new ones. This commentary will focus on changes to fair use and the introduction of a text and data mining (**TDM**) exception."

## Launch of NUS Law module: Intellectual Property Arbitration

We are very glad to announce that the National University of Singapore law school has launched a new module on IP arbitration. It is a 5-credit semester-long course, co-taught and convened by IPOS officers (Adjunct Prof Mark Lim and Adjunct As/P Gabriel Ong) in partnership with Associate Professor Jean Ho. The course is now running and is fully subscribed. More information can be found [here](#).

## [New!] IT Law Series

IPOS International, in conjunction with the Technology Law Cluster of the Singapore Legal Service, is launching a series of seminars focused on technology, media and telecommunications law in March 2022.

It features distinguished speakers from legal practice (both public and private sectors), industry and academia. For example, one of the speakers for the first session is Justice Robert French, International Judge, Singapore International Commercial Court. Among other things, Justice French was the Chief Justice of Australia from Sep 2008 to Jan 2017.

The first session is on "Online Contracting", and is scheduled for 24 March, 2022. For more information and the sign-up link, please click [here](#).

## Developments in IP Law Series 2022

(Fully Online) 9th Developments in IP Law Series, 20 January 2022 (Trade Marks / Passing Off), 27 January 2022 (Patents), 10 February 2022 (Breach of Confidence / Privacy and Data Protection), 17 February 2022 (Copyright)



Stay current on the latest IP law developments in Singapore and the UK with this flagship programme for IP professionals. Where relevant, developments in the EU, US, and Australia are also discussed in this series, which typically runs in the first quarter of the year.

Like its previous sell-out editions, this 9th edition returns with a line-up of prestigious speakers, comprising distinguished academics, experienced practitioners, industry representatives, and representatives from the public sector. Anyone with an interest in IP will benefit greatly from this programme. For more information, please click [here](#).



