

UPDATES FROM IPOS

JANUARY 2023

Dear readers,

Happy new year!

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

- [Razer \(Asia-Pacific\) Pte. Ltd. v Capgemini Singapore Pte. Ltd. \[2022\] SGHC 310](#)

Razer succeeded in its lawsuit against Capgemini, its information technology consultant. This dispute arose as a result of the misconfiguration of a server file, which resulted in a leak of Razer's non-public customer data. Razer sued for losses incurred in connection with the leak, and was awarded damages of around US\$6.5 million. The case was reported in the Straits Times [here](#).

Recent IPOS decisions

- [Skins IP Limited v Symphony Holdings Limited \[2022\] SGIPOS 16](#) (note: appeal to the General Division of the High Court pending)

Skins IP Limited applied to revoke the trade mark registration of "S SKINS" in the name of Symphony Holdings Limited in Classes 10, 18, 25 and 28. The registered proprietor could show some use of its mark, including on-line use where active steps were taken to target consumers in Singapore. However, there was no evidence of use on certain items in the specifications and as such, the application for revocation was partially successful.

- [The a2 Milk Company Limited v Société des Produits Nestlé S.A. \[2022\] SGIPOS 17](#)

Although this case bears the same name as [2022] SGIPOS 12, it concerns a different trade mark application. Here, a2 Milk Company sought to oppose Nestle's applications to register



(which reads "Atwo Illuma") and



(which reads "Atwo Illumcare") in classes 5 and 29 for infant formula and milk products respectively. Just

like in the earlier case, a2 Milk Company relied on its earlier registration for “A2” in Classes 5 and 29. Its central case was that the marks conflicted because “Atwo” would be perceived by consumers as “A2”. However, the hearing officer did not agree, and found that the marks were overall more dissimilar than similar. Accordingly, the opposition was unsuccessful.

- [Aramara Beauty LLC \(dba Glow Recipe\) v Sinchen Group Pte. Ltd.](#) [2022] SGIPOS 18

Aramara Beauty LLC (dba Glow Recipe) applied for a declaration of invalidity against the registration of the “GLOW RECIPE” trade mark in the name of Sinchen Group Pte. Ltd. By procedural default, the registered proprietor was deemed to admit to the facts alleged in the application for a declaration of invalidity; the requisite elements of s 8(2)(a) of the Trade Marks Act were established; and the registration was declared invalid.

- [Fair Isaac Corporation v LAC Co., Ltd.](#) [2022] SGIPOS 19


Fair Isaac Corporation, which is the proprietor of the “FALCON” mark, failed in its attempt to oppose an application to register “CloudFalcon” as a trade mark. Among other things, the hearing officer was of the view that: (1) When a later trade mark (“CloudFalcon”) wholly incorporates an earlier trade mark (“FALCON”), the inherent technical distinctiveness (or otherwise) of the earlier mark is critical in determining whether the later mark is similar to the earlier mark (see [34]-[43]; for detailed discussion, see [22]-[43]); and (2) The state of the register can be considered when assessing whether a particular mark or word is distinctive (see [67]-[72]; for detailed discussion, see [55]-[74]).

- [In the matter of a Trade Mark Application by Schweiger, Martin Rainer Gabriel](#) [2023] SGIPOS 1

In this case, an IP Adjudicator allowed an application to register “STRONG BY CHOICE” in Class 25 for “Shorts; T-shirts” to be accepted for registration. At first instance, the examiner considering the application took the view that the application mark was devoid of distinctive character. However, the IP Adjudicator was of a different view, and considered the slogan to be inherently distinctive in relation to the goods in question.

- [Baidu Online Network Technology \(Beijing\) Co., Ltd v Baidu Europe BV](#) [2023] SGIPOS 2

Baidu Online, a subsidiary of the NASDAQ listed Baidu Inc, applied to invalidate Baidu

Europe’s registrations in Singapore for the marks “baidu” and the stylised “BAIDU” mark in Class 38 for telecommunications services. Baidu Europe is linked to Michael Gleissner, an individual who has been described by publications such as the World Trade Mark Review as being an “infamous troll”.

The applicant does not have any earlier registration for the plain word mark “baidu” in

Singapore, and relied on its earlier  mark, registered in Class 42 for internet search engine services and computer software design services. (The mark also used to be registered in Class 38 for telecommunications services but this was revoked for non-



use following an earlier separate action by Baidu Europe: see [2021] SGIPOS 8.) In allowing the invalidation action, the hearing officer found that the marks were filed for in bad faith and that the competing marks were confusingly similar.

IPOS Year in review 2022 & Updates to Trade Marks Case Guide

We are pleased to share that our roundup note: “2022 Year-in-Review: Selected Issues, Holdings and Comments of Interest”, has now been published. You can find it [here](#). We’ve also updated our Trade Marks Case Guide to take into account the various new cases and legal developments. It can be accessed [here](#).

Roundup of .sg domain name dispute decisions 2022

For those that may not be aware, the Singapore Mediation Centre’s website hosts the administrative panel decisions made under the Singapore Domain Name Dispute Resolution Policy Service (SDRP). In 2022, three decisions were issued involving the following disputed domain names: (a) [cil.sg](#) (result: name transfer); (b) [softbank.sg](#) (result: name transfer); and (c) [sgdx.sg](#) (result: complaint dismissed).

Featured events

Kwa Geok Choo Distinguished Visitors Lecture – Fair Use in the US Redux: Reformed or Still Deformed? – by Professor Jane Ginsburg (31 January 2023, 5.30pm to 7.00pm at NUS Law, Wee Chong Jin Moot Court)

In 2019, Professor Jane Ginsburg delivered the Distinguished Visitor in Intellectual Property Lecture at NUS. Titled "Fair Use in the US: Transformed, Deformed, Reformed?", the lecture explored US caselaw applying the statutory fair use exception, highlighting its excesses and apparent rebalancing. Three and half years (and a pandemic) later, while appellate courts have reined in some of the more extreme applications of "transformative use", the Supreme Court has rendered a decision in one fair use case (Google v. Oracle) and has heard arguments in another (Andy Warhol Foundation v Goldsmith). Together, these controversies prompt inquiry into the prospects for further judicial reforming, or deforming, of US fair use and copyright law. That inquiry extends to the fair use doctrine's potential to accommodate massive inputs of copyrighted works into databases to enable "machine learning" by artificial intelligence systems.

There is no registration fee for this lecture but seats are limited. Visit <https://bit.ly/3ExvgRm> to register by Tuesday, 24 January 2023, 5.00 PM. The course flyer is located [here](#).

10th Developments in IP Law Series

Come February 2023, we are bringing back our flagship programme for IP professionals – the 10th Development in Law Series closer to you in a physical setting.

Like its previous sell-out editions, this 10th edition returns with a line-up of prestigious speakers, comprising distinguished academics, experienced practitioners, and industry and public sector representatives. Look forward to speakers like Professor David Llewelyn (David Llewelyn & Co LLC), Justice James Mellor (High Court of England & Wales), Lord Justice Colin Birss (Court of Appeal of



England and Wales), Adrian Tan (TSMP Law Corporation & Law Society of Singapore) and Professor David Tan (EW Barker Centre for Law & Business, NUS Law) to name a few.

The schedule (with corresponding sign-up links) is below.

[10th Developments in IP Law Series – Trade Marks/Passing Off](#)

02 February 2023 (Thursday) | 2:00pm - 5:40pm (GMT +8)

[10th Developments in IP Law Series – Patents](#)

09 February 2023 (Thursday) | 2:00pm - 5:30pm (GMT +8)

[10th Developments in IP Law Series – Breach of Confidence/Privacy and Data Protection](#)

16 February 2023 (Thursday) | 2:00pm - 5:30pm (GMT +8)

[10th Developments in IP Law Series – Copyright](#)

23 February 2023 (Thursday) | 2:00pm - 5:30pm (GMT +8)

This seminar is highly relevant for all lawyers, in-house counsels, patent agents, IP professionals and suitable for all other professionals interested in the topic(s).

