

UPDATES FROM IPOS

JULY 2021

Dear readers,

Hope this email 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. Finally, 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.

Featured Event

IPOS is proud to support and participate in “**Thinking Internationally about IP and ADR: What Every Lawyer & Corporate Counsel Should Know**”, an associated event of IP Week @ SG 2021. Find out more and register [here](#).

The importance of mediation and arbitration in resolving high-stakes intellectual property disputes is often overlooked. This free online program on Thursday 19 August 2021 8.40 pm - 11 pm, SGT, featuring experienced speakers from government, international organisations, and industry, will offer an honest and practical discussion of related topics, including:

- ADR as a viable alternative in IP disputes.
- Understanding how IP-ADR works in Asia, Europe, and the United States.
- Standard Essential Patents: ADR as an alternative to national forum grabs.
- The role of international IP organisations and national IP offices in ADR.
- Trademarks and ADR: What brand owners need to know.

Recent Court decisions

In *Kiri Industries Ltd v Senda International Capital Limited and another* [2021] SGHC(I) 6, the SICC gave its decision on the final valuation of Kiri’s shares in DyStar. The court’s decision is available [here](#), and the SupCt case summary is available [here](#).

In *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165, the High Court dismissed an appeal against an IPOS IP Adjudicator’s decision (available [here](#)) to refuse the registration of the DIGI application mark. The court’s judgment and accompanying case summary are available at the following [link](#).



Recent IPOS decisions

- *Application for Extension of Time to File Evidence in a Trade Mark Revocation by Symphony Holdings Limited and Objection Thereto by Skins IP Limited* [2021] SGIPOS 5 (Principal Asst Registrar Sandy Widjaja)

This dispute arose in the context of trade mark revocation proceedings. The registered proprietor of the impugned trade mark did not file its evidence in time, and only filed a (late) request for extension of time 4 working days after the expiration of the deadline citing (among other things) delays relating to Covid-19. Following an interlocutory hearing, the hearing officer allowed the extension of time request. The decision may be accessed at the following [link](#).

- *GCIH Trademarks Limited v Hardwood Private Limited* [2021] SGIPOS 6 (Principal Asst Registrar Gabriel Ong)

This trade mark opposition was commenced by the owner of the “TANGO” trade mark, registered in Class 30 for chocolate and cocoa products, against a competitor’s application to register “OT TANGO” in Class 30 for chocolate and cocoa products. The opposition was successful. The decision may be accessed at the following [link](#). (Paragraphs 103 to 112 contains a discussion on the complex issue of the role of distinctiveness at the marks-similarity stage, which some might find interesting.)

- *Warrior Pte Ltd v Nippon Paint (Singapore) Co. Pte. Ltd.* [2021] SGIPOS 7 (Principal Asst Registrar See Tho Sok Yee)

This was an unsuccessful trade mark opposition against Nippon Paint (Singapore)’s application to register “NW1” in Class 1 in respect of adhesives and chemical additives/preparations. The opponent, Warrior, relied on the following earlier “W-1” marks (both registered in Class 1 for adhesives and

other related goods: ; . The decision may be accessed at the following [link](#).

Publications of interest

Readers may be interested in the following short articles.

- Professor David Tan (NUS Law) has written a feature article for the Law Gazette: “Mad About Memes... But is it Fair Use in Singapore”, available [here](#).
- Professor Saw Cheng Lim (SMU Law) has published an article “The Curious Case of Horseracing Data Caught in a Tangled Web of Relationships – *The Racing Partnership Ltd v. Sports Information Services Ltd* [2020] EWCA Civ 1300” (2021) 52(6) *International Review of Intellectual Property and Competition Law* 752-774”, available [here](#) (note: may be paywalled).
- Allen & Gledhill has published a case comment on the IPOS decision of *Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2021] SGIPOS 4, available [here](#).



News relating to WIPO

- Appointment of Joyce Tan to the WIPO Mediation and Arbitration Advisory Committee

We are pleased to share that Singapore lawyer and mediator Joyce Tan (Joyce A Tan & Partners) has been appointed to the WIPO Mediation and Arbitration Advisory Committee (2021-2024), which is an informal consultative body composed of selected high-profile WIPO Mediators and Arbitrators. The Advisory Committee is consulted on WIPO Mediation and Arbitration policy-related matters and its members participate as faculty in Center workshops and other events. For more information on the Committee and its Members please click [here](#).

- Updated WIPO Mediation, Arbitration, Expedited Arbitration and Expert Determination Rules

WIPO ADR proceedings are regularly conducted fully or partly online with the assistance of WIPO tools. The WIPO Center has updated the [WIPO Mediation, Arbitration, Expedited Arbitration and Expert Determination Rules](#) to confirm such procedural options. Effective from 1 July 2021, the updated Rules expressly permit, and foresee as a default option, the electronic filing of new WIPO ADR cases, as well as the electronic submission of any case communication. Remote WIPO mediation and arbitration meetings and hearings are expressly permitted and encouraged by the updated Rules. This includes the preparatory conference, emergency arbitrator proceedings, mediation meetings, and arbitration hearings. The [updated Schedule of Fees and Costs](#) introduces a 25% reduction on the WIPO Center's fees that applies if one or both parties to a dispute is a small and medium-sized enterprise (SME).

