

UPDATES FROM IPOS

JUNE 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

- [*Asia Petworld Pte Ltd v Sivabalan s/o Ramasami & another*](#) [2022] SGHC 128

In this case, the General Division of the High Court dismissed a drop shipping company's claim against its former employee and his new company for breach of confidence, breach of duty of good faith and fidelity, and conspiracy. The linked judgment also has an accompanying case summary which sets out the pertinent and significant points of the judgment. Notably, the decision (see [56]) discusses and applies the Court of Appeal's recent decision in *Lim Oon Kuin* (which further clarified the *I-Admin* approach relating to claims for breach of confidence).

- [*Pacific Prime Insurance Brokers Singapore Pte. Ltd. & Anor v Lee Suet Fern & 3 Ors*](#) [2022] SGHC 86

In this case, the General Division of the High Court dismissed an application to discharge certain confidentiality interim injunctions, but allowed them to be varied in scope. On the facts, the judge found that if the confidentiality of the information in question were to be breached, it would be permanently lost; therefore, the balance of confidence favoured the preservation of the confidentiality pending the determination of the main action.

- [*Wong Leng Si Rachel v Olivia Wu Su Han*](#) [2022] SGDC 42

In this District Court case, a Deputy Registrar made an order to disclose correspondence relating to ongoing legal proceedings for defamation. An unsuccessful attempt was made to resist the application on the basis of, among other things, alleged infringement of privacy and confidentiality. Although access to the full decision requires a Lawnet subscription, a Straits Times report "Instagram influencer fails to block access to correspondence, diary



entries in defamation lawsuit, 25 Apr 2022” is available [here](#) (may be paywalled), and a free-to-access commentary by That.Legal, a law firm, is available [here](#).

Recent IPOS decisions

- [Conorzio del Formaggio Parmigiano Reggiano v Fonterra Brands \(Singapore\) Pte. Ltd.](#) [2022] SGIPOS 7

Under the Geographical Indications Act 2014, protection for a geographical indication (“GI”) may extend to translations of a GI. However, there is no need to specify translations at the point of an application for GI registration. Any issues pertaining to the protection of translations of a GI can be dealt with via the request for qualification procedure. This case concerned Fonterra’s request to qualify “Parmigiano Reggiano” by carving out the term “Parmesan” from the scope of GI protection. The Consorzio opposed the request for qualification. The hearing officer found, on the evidence, that “Parmesan” is indeed a translation of “Parmigiano Reggiano” and allowed the opposition to the request for qualification.

- [In the matter of a Trade Mark Application by Arangur UG \(haftungsbeschränkt\)](#) [2022] SGIPOS 8

The applicant sought to register the slogan “PARTY LIKE GATSY” as a trade mark for a variety of services in Classes 41 and 43. However, it did not adduce any evidence of use in Singapore. The examiner refused to accept the sign on the basis that it is inherently non-distinctive and hence objectionable under s 7(1)(b) of the Trade Marks Act. The applicant then applied for a hearing. At the hearing, it argued that the slogan was inherently distinctive. The IP Adjudicator disagreed, and maintained the examiner’s objection.

- [In the matter of a Trade Mark Application by Floor Xpert Pte. Ltd.](#) [2022] SGIPOS 9

This was an application to register “FLOOR XPERT” in Class 37 for various flooring related services. The examiner objected to the application on the basis that the mark is non-distinctive and under ss 7(1)(b) and (c) of the Trade Marks Act. In response, the applicant filed evidence of use, but the examiner took the view that the evidence was deficient in that it showed use of different versions of the sign and in relation to goods or services that were outside the scope of the specifications applied for. The applicant then applied for a hearing. The hearing officer disagreed with the examiner and found that the evidence of use was sufficient to prove that the sign had acquired distinctiveness through use and allowed the mark to be accepted. In so doing, the hearing officer made various observations relating to trade mark examination procedure.

Note: on 1 October 2021, rule 24(5A) of the Trade Marks Rules came into effect. It provides that the Registrar can, of the Registrar’s own accord, send the grounds of decision to the applicant. If this rule is invoked by the Registrar, the public will have access to the decision without the need for the applicant to file a request for it. This appears to be the first time that a decision to accept a trade mark was issued under this rule.



Appeal against IPOS decision

An appeal to the General Division of the High Court has since been filed against the decision in [Twitter, Inc. v V V Technology Pte Ltd](#) [2022] SGIPOS 4. (At first instance, Twitter succeeded in its



opposition to a trade mark application for a bird device “ ” in Class 42.)

IPOS Hearings: Practice Updates

- **Updated Compendium of Hearings & Mediation Department Circulars**

15 HMD Circulars in the [Compendium of Hearings & Mediation Department Circulars](#) have been updated. You can view the marked-up amendments at [Amendment No. 1 of 2022](#).

- **Page Limits on Evidence in Trade Mark Opposition, Invalidation and Revocation Proceedings**

The current pilot introducing page limits to evidence in trade mark proceedings will end on 1 June 2022. With effect from 2 June 2022, these page limits will become the Registrar’s practice as set out in a new HMD Circular 3.3 in the Compendium of Hearings & Mediation Department Circulars.

- **Summary Assessment of Costs**

For most trade marks hearings fixed from 2 June 2022, the Registrar will assess costs summarily. Parties will give brief submissions on the award of costs, and the costs quantum, in their written submissions. The Registrar will, in most cases, specify in the grounds of decision any award of costs with its quantum. This approach will be more cost- and time-effective for parties compared to taxation proceedings after the substantive decision.

Featured event

Thinking Internationally about IP and Dispute Resolution: What Every Lawyer & Corporate Counsel Should Know (11 August 2022 at CT 7.40am / SGT 8.40pm)

The importance of considering different dispute resolution options in resolving high stakes intellectual property disputes is often overlooked. [Join us](#) at this two-hour CLE program, featuring experienced speakers from government, international organizations, academia, and industry, for an honest and practical discussion of related topics, including:

- International IP organizations and government IP offices as drivers of dispute resolution innovators.
- Recent cases and other developments.

