

## UPDATES FROM IPOS

MARCH 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](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

- [\*Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel\* \[2022\] SGHC 78](#)

The respondent (Dr August Wolff) first registered “VAGISAN” in Class 3 (“Soaps, perfumery, essential oils, cosmetics, hair lotions”) and Class 5 (“Pharmaceutical products, sanitary products for medical purposes; dietetic substances for medical purposes”) in 2012. At that time, the appellant (Combe) was the registered owner of four “VAGISIL” marks, three of which claimed goods in either Class 3 or Class 5.

In separate, earlier proceedings, the appellant successfully applied to invalidate the respondent’s “VAGISAN” mark and the decision was upheld on appeal by the General Division of the High Court (see *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] 4 SLR 626).

In a separate trade mark application, the respondent added the words “Dr. Wolff’s” to “VAGISAN” and applied for “Dr. Wolff’s VAGISAN” mark in Classes 3 and 5. The appellant opposed the trade mark application. The opposition was unsuccessful before the IP Adjudicator at first instance (see *Dr August Wolff GmbH & Co KG Arzneimittel v Combe International Ltd* [2021] SGIPOS 10). This led to the present appeal, which was ultimately dismissed by the General Division of the High Court.

- [\*Lim Oon Kuin & 2 Ors v Rajah & Tann Singapore LLP\* \[2022\] SGCA 29](#)

In this case, the Court of Appeal took the opportunity to clarify the law of confidence in light of the arguably conflicting decisions in *LVM Law Chambers LLC v Wan Hoe Keet and another and another matter* [2020] 1 SLR 1083 and *I-Admin (Singapore) Pte Ltd v Hong Ying Ting and*



*others* [2020] 1 SLR 1130. The accompanying case summary states in relevant part, under the heading “*Pertinent and significant points of the judgment*”, as follows:

“The court clarifies that the test for breach of confidence as set out in *I-Admin (Singapore) Pte Ltd v Hong Ying Ting and others* [2020] 1 SLR 1130 was intended to specifically fill the lacuna in the law for cases involving alleged harm to a plaintiff’s wrongful loss interest, and does not apply to cases involving alleged harm to a plaintiff’s wrongful gain interest: at [39], [41].”

### Recent IPOS decisions

- [Hotel Cipriani S.P.A. v Altunis - Trading, Gestão E Serviços, Sociedade Unipessoal, LDA](#) [2022] SGIPOS 3 (trade mark opposition: CIPRIANI and bartender device)

This was a successful opposition by Hotel Cipriani against Altunis Trading’s application to



register the CIPRIANI and bartender device (  ) mark. Although the opponent did not have any prior trade mark registrations in Singapore, it was able to establish a case of passing off since it had, among other things, existing customers (and hence goodwill) in this country who had travelled to Venice, Italy to stay at the high-end Belmond Hotel Cipriani. Nevertheless, despite the fact that the parties were known to each other and had been embroiled in long-running multi-jurisdictional disputes relating to the “CIPRIANI” mark, the opponent was unable to sufficiently prove that the application had been made in bad faith. Readers may also wish to note that on the bad faith ground, the opponent attempted to run the interesting and unusual — but ultimately unsuccessful — argument of transnational issue estoppel premised on foreign decisions in its favour: see [59]-[69].

- [Twitter, Inc. v V V Technology Pte Ltd](#) [2022] SGIPOS 4 (trade mark opposition: bird device)

Twitter succeeded in its opposition to a trade mark application for a bird device “



” in Class 42. It relied on its prior registration for its bird device “  ” (registered in a number of classes including 42) as well as its prior unregistered marks that were essentially earlier versions of its twitter bird logo. As mentioned in the introductory paragraph, the dispute raised interesting and complex issues regarding the assessment of similarity between two device marks (in this case: two “bird” devices), including the delicate balancing act between under-protection (e.g. where protection is confined only to a specific depiction of a bird) and over-protection (e.g. where protection is extended to any depiction of a bird).



- [BEABA v Biba \(Zhejiang\) Nursing Products Co., Ltd](#) [2022] SGIPOS 5 (trade mark opposition: BEABA)

This dispute involved two consolidated trade mark opposition actions commenced by a

**BEABA**

French company against a Chinese company's application to register in Classes 5 (for baby food, babies' diaper-pants, and other goods) and 16 (for paper, stationery, and related products). The opponent, which sells baby food making products and other childhood care-related products, relied on its earlier registration for "BEABA" which is registered in Classes 7, 9, 10, 11, 20 and 21 (but not 5 and 16). The hearing officer found that the competing marks had a very high degree of similarity and that the circumstances justified a finding that the applications had been made in bad faith. Accordingly, she allowed the oppositions against both applications.

Although the finding on bad faith was sufficient to dispose of the matter, the hearing officer also addressed the various other grounds of opposition raised. She also allowed the opposition against the Class 5 application on grounds of 'confusing similarity' under s 8(2)(b) despite the fact that the opponent did not have a registration in that class. Here, the pertinent finding was that "babies' diaper-pants" in Class 5 are similar to "potties for babies" in the opponent's Class 21 registration. However, the opponent was not able to establish similarity of goods vis-à-vis the Class 16 application and so the ground of opposition could not succeed there.

The decision also deals with the passing off ground of opposition (result: opposition succeeded against the Class 5 application but not against the Class 16 application) and copyright under s 8(7)(b) (result: succeeded against the Class 16 application and was not raised against the Class 5 application).

- [Sociedad Anonima Damm v Hijos de Rivera, S.A.](#) [2022] SGIPOS 6 (trade mark opposition: Estrella Galicia (with device))

The applicant and the opponent are both beer manufacturers from Spain. The applicant is known for its beer "ESTRELLA GALICIA" whereas the opponent is known for "ESTRELLA DAMM". The parties have co-existed for many years in Spain and countries in Europe and in the UK. However, as the parties expanded outside of the jurisdictions where they co-existed, they opposed the registration of each other's mark. In this case, the opponent opposed the



application for the stylised " ESTRELLA GALICIA mark based on, among other things, its "ESTRELLA DAMM" mark (registered for beers in Class 32). The IP Adjudicator found, among other things, that the competing marks are dissimilar. The opposition failed on all grounds.



## Upcoming new legislation on court procedures for IP disputes

- **New Supreme Court and Ministry of Law Media Release relating to the new Supreme Court of Judicature (Intellectual Property) Rules 2022**

On 5 April 2022, the Supreme Court and Ministry of Law issued a [media release](#), including an infographic, which readers may find helpful (note: if you have difficulty viewing the file, please right-click and attempt to open the infographic in a new tab) relating to the new Supreme Court of Judicature (Intellectual Property) Rules 2022, which came into force on 1 April 2022. These new rules implement the Simplified Process of Certain Intellectual Property Claims as well as consolidate most civil IP cases in the High Court.

- **Supreme Court Practice Directions relating to Simplified Process for Certain Intellectual Property Claims**

The Supreme Court has [published](#) Amendment No. 1 of 2022 (Practice Directions 2021), which introduces, among other things, a new Part 23 and a new Appendix I of the Supreme Court Practice Directions 2021 (which relate to the new Simplified Process for Certain Intellectual Property Claims). The amendments took effect on 1 April 2022. The document reflecting the amendments is accessible [here](#) (see, in particular, pages 6, 7, 8, 20 and 21).

- **Copyright Act 2021, Intellectual Property (Dispute Resolution) Act 2019 and Patents (Amendment) Rules 2022**

Sections 501(2) and (3), and 507(10) of the Copyright Act 2021, as well as the remaining provisions of the Intellectual Property (Dispute Resolution) Act 2019, Sections 13 to 19, 20(a), (c), (d), (f), (g) and (h), 22(b) and (e), 24(b), 31 and 32, came into operation on 1 April 2022. Please note the jurisdictional changes to certain types of IP disputes. The implementing subsidiary legislation, the Patents (Amendment) Rules 2022, also came into operation on the same day (1 April 2022).

## IP Adjudicators

We are pleased to announce the following appointments and reappointments of our IP Adjudicators for a 2-year term with effect from 1 April 2022.

Appointments: District Judge Vince Gui  
Lee Ai Ming  
M. Ravindran

Re-appointments: Senior Assistant Registrar Cheng Pei Feng  
David Llewelyn  
Burton Ong

We also record our appreciation for our IP Adjudicators, Mr Adrian Tan and District Judge Sheik Umar, who completed their terms on 31 March 2022.



## Mediation at IPOS

Read about a successfully mediated case: [Spiral Foods Pty Ltd & Nature's Glory Pte Ltd \[2022\] SGIPOS MED 2](#). See also [Leonid Kovalkov & JNBK Group Private Limited \[2022\] SGIPOS MED 1](#) for an example of the value of mediation even when no final settlement agreement is reached. If you are involved in IPOS proceedings, consider [mediation](#) as an appropriate dispute resolution process; funding is available under our [Revised Enhanced Mediation Promotion Scheme](#) (more below).

## Revised Enhanced Mediation Promotion Scheme (REMPS)

IPOS extended our current Enhanced Mediation Promotion Scheme, as [the Revised Enhanced Mediation Promotion Scheme \(REMPS\)](#), for up to three years from 1 April 2022. The **REMPS** encourages parties in IPOS proceedings to choose [mediation](#) as an alternative to a hearing. Under **REMPS**, parties in a mediation case can receive reimbursement of mediation costs, up to S\$10,000 (only Singapore IP rights) / **S\$14,000** (Singapore and foreign IP rights). Out of the funding, parties can claim up to **80%** of mediation-related lawyer / agent fees and disbursements. In addition, where both parties want to have their dispute mediated but one party does not wish to apply for funding, the sole party who applies for REMPS funding can claim up to **S\$3,000** per mediation case. REMPS will be available until the total funds of S\$180,000 set aside for the scheme are drawn down, or until 31 March 2025, whichever is earlier.

## Featured articles

- [Fraud and Asset Recovery: Cryptoassets – Guide to tracing, freezing and recovering stolen cryptoassets](#), by Wendy Lin and Leow Jiamin (WongPartnership Special Update, March 2022)

How can one trace, freeze and recover cryptoassets lost? How different is this from the recovery of traditional assets? In this article, the authors review the options available for victims of crypto fraud, and discuss the recent decision of the General Division of the Singapore High Court in *CLM v CLN & Ors* [2022] SGHC 46 and its implications.

- [The role of acquired distinctiveness in the marks-similarity analysis](#) [2022] SAL Prac 9, by Lim Siau Wen and Teo Xuan Lang

Ever since the Court of Appeal's seminal decision in *Staywell Hospitality Group v Starwood Hotels & Resorts* [2014] 1 SLR 911, trade mark practitioners and decision-makers have been divided on the role of acquired distinctiveness within the "step-by-step" approach and whether it should be considered at the marks-similarity stage or left for the likelihood of confusion stage. In this article, the authors outline some of the recent developments before concluding with some brief observations.

## In case you missed it...

- *EXXA Network Pte Ltd v SQ2 Fintech Pte Ltd* [2021] SGHCR 9

Our attention was recently drawn to this case where an Assistant Registrar allowed an application to stay court proceedings in favour of mediation and arbitration pursuant to s 8 of the Mediation Act and s 6 of the Arbitration Act. The main dispute involved a shareholders'



agreement relating to “IP Assets”, which was defined as including a platform for cryptocurrency trading with an artificial intelligence trading robot.

#### Oxford IP Moot

We are pleased to share that SMU Law’s Oxford Intellectual Property Moot team (Juhi Agrawal, Reinvs Loh and Benjamin Liow) came in joint third in the competition. Most notably, Juhi was placed as joint best individual mooter (The Sir Nicholas Pumfrey Award) and Reinvs was awarded 3<sup>rd</sup> best individual mooter. We understand that this is SMU law’s best performance in the Oxford IP Moot thus far.

#### NUS Law IP Arbitration Course

We are most privileged to have Mr Dinesh Dhillon (Allen & Gledhill), Immediate Past President of the Singapore Institute of Arbitrators, close off the semester by giving a most excellent guest lecture to the IP Arbitration class. This pioneering course on intellectual property arbitration—which is not currently offered by any other leading law school in the world—was launched by NUS Law in partnership with IPOS and Associate Professor Jean Ho and immediately attracted a full class of students. A link to the LinkedIn post with an embedded transcript of Mr Dhillon’s speech is available [here](#).

#### WIPO ADR Young in Asia

In conjunction with World IP Day 2022, WIPO Arbitration and Mediation Center will convene a webinar and panel discussion on “Interested in IP and ADR? Come and join us! – WIPO ADR Young in Asia” on 28 April 2022. IPOS warmly supports this event. Our former Young IP Mediator, Utsav Rakshit, who is also a member of WIPO ADR Young, is one of the panellists. Find out more and register [here](#).

