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# IPOS Cases in 2015 - Selected Issues, Holdings and Comments of Interest

Note: Full Grounds of Decision (and Case Notes where available) accessible at:  
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**IPOS CASES IN 2015**

<b>Case Reference</b>	<b>Selected Issues, Holdings and Comments of Interest</b>	<b>Paragraph References</b>
<p><b><i>Tsung-Tse Hsieh v Redsun Singapore Pte. Ltd.</i> [2015] SGIPOS 1</b></p>	<ol style="list-style-type: none"> <li data-bbox="674 411 1859 560">1. The ground of invalidation under Section 8(2)(b) failed as the Applicants’ goods in Class 5 and the Registered Proprietors’ goods in Class 30 were not similar. Despite the differences in the respective goods in the specifications, the Applicant succeeded in their application under the separate ground of passing off.</li> <li data-bbox="674 600 1859 1222">2. The Applicants had established goodwill in their business under “RED SUN” selling tea and health supplements. The Applicants’ evidence showed that bubble tea outlets also sold tea in unprepared forms on the same premises. In particular, “Each A Cup” bubble tea outlet sold tea bags of honey red oolong tea; and “a gantea” bubble tea outlet sold various premium packed tea from Taiwan. The converse was also true in that businesses selling beverages in an unprepared form also expanded into the food and beverage space through cafés and restaurants. Such businesses sell their food and drinks for immediate consumption at their premises, under the same name and trade mark. Examples cited are Old Town White Coffee, Owl, TWG, Jones the Grocer, Dean &amp; DeLuca and The House of Robert Timms. Hence, for instance, 3-in-1 Old Town White Coffee is not only sold at supermarkets, provision stores and convenience stores, they can also be enjoyed at Old Town White Coffee café outlets in Singapore. The Applicants’ argument that there is a connection between the retail of a food or drink item in an unprepared form, and the service of providing that food or drink in a prepared form for immediate consumption, under the same name and mark, is persuasive. Such a connection is especially strong in respect of coffee and tea products and offerings. The element of misrepresentation was made out.</li> <li data-bbox="674 1262 1859 1367">3. This case also had interesting evidence that showed actual confusion by a few people who saw the Registered Proprietors’ local distributor’s bubble tea shop in Toa Payoh and mistakenly thought that it was opened by the Applicants. However, this evidence</li> </ol>	<p>[60] – [61], [64], [108]</p> <p>[97] – [102], [104]</p> <p>[103] – [104]</p>

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	<p>was merely corroborative as the Principal Assistant Registrar was already prepared to accept that there would be misrepresentation based on the evidence of the market practice in Singapore relating to prepared and unprepared beverages. It is reiterated that not every finding of misrepresentation is supported by evidence of actual confusion; and not every instance of actual confusion necessitates a finding of misrepresentation as the issue is one of both fact and law.</p>	
<p><b><i>Intel Corporation v Intelsteer Pte Ltd</i> [2015] SGIPOS 2</b></p>	<p>The ground of objection under Section 23 read with Section 8(4)(b)(ii) TMA was not made out as it has not been shown that dilution was caused in an unfair manner and it has also not been shown that there has been any unfair advantage taken. This is so even though the Registrar is prepared to hold that the Intel mark is well known to the public at large.</p>	<p>[126] – [170]</p>
<p><b><i>Romanson Co., Ltd. v Festina Lotus, S.A.</i> [2015] SGIPOS 3</b></p>	<p>Use with “consent” under Section 22(1) of the Trade Marks Act – Following the UK position, the onus is on the Registered Proprietors to prove consent to the use of the trade mark by the third party (who is not related to him in some way). Consent can take many different forms. The Registered Proprietors only need to show that there is “implied consent” or “authorization sufficient to ensure non-infringement” by the third party, and do not need to show that they exercised quality control over the goods in question. It is likely that “consent” can be implied in a parallel import situation.</p> <p><i>[Note: On appeal to the High Court, the Respondent (Romanson Co. Ltd.) did not contest; and the IPOS decision was reversed. No written Grounds of Decision are available.]</i></p>	<p>[56]-[72]</p>
<p><b><i>Japan Tobacco Inc v Philip Morris Products S.A.</i> [2015] SGIPOS 4</b></p>	<p>The sale of tobacco products is regulated by law such that tobacco products are displayed in retail outlets in a way that consumers will require the assistance of an employee of the retailer to obtain the items, usually from a display case behind the counter. Thus, the consumer would have to approach a staff to request for a particular brand of cigarettes or point to the brand which he wishes to purchase. In this regard, the visual and aural aspects of the marks are more important.</p> <p>This particularity in relation to the goods in question has an impact in the final analysis as to whether there is a likelihood of confusion, taking into account the conclusion on</p>	<p>[82] - [89]</p>

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	<p>similarity of marks etc. Thus it was found that the objection under Section 8(2)(b) was not made out for <b>L&amp;M Activate Mark</b>, as the marks are, in particular, dissimilar visually and aurally, given the dominant and distinctive component "L&amp;M". On the other hand, the same objection was made out for <b>Activate 2-in-1 Mark</b>, as the marks are similar.</p>	
<p><b>Sports Connection Pte Ltd v P.T. Eigerindo Multi Produk Industri [2015] SGIPOS 5</b></p>	<ol style="list-style-type: none"> <li>1. Aural Similarity – Where the consumer is unlikely to make reference to the words or phrase that is “subsidiary” in a mark, only the phonetic component of the main word will be considered, citing, <i>inter alia</i>, <b>Han's (F&amp;B) Pte Ltd v Gusttimo World Pte Ltd [2015] SGHC 39</b>.</li> <li>2. Bad faith and Partial Invalidation – Bad faith is made out where there is uncontested evidence that the Registered Proprietors’ representative had sight of samples of the Applicants’ products bearing the relevant marks in Indonesia but proceeded to export bags bearing similar marks for sale in Singapore and register a similar trade mark in Singapore. However, bad faith is not made out in relation to a different class of goods for which no submissions have been made. Accordingly, there was partial invalidation of the trade mark in question.</li> </ol>	<p>[39]-[42]</p> <p>[138]-[151]</p>
<p><b>Lisbeth Enterprises Limited v Procter &amp; Gamble International Operations SA [2015] SGIPOS 6</b></p>	<ol style="list-style-type: none"> <li>1. The grounds of decision in this revocation action decision examine various elements of the grounds of revocation for non-use, such as whether sale on third party websites such as <a href="http://www.perfumehypermart.com">www.perfumehypermart.com</a> and <a href="http://www.ebay.com.sg">www.ebay.com.sg</a> in this instance was with or without the consent of the Proprietors. On the evidence, the Proprietors have not shown that this was done with their consent. Hence, such sale, even if accepted as "use in Singapore" (which was the case in relation to <a href="http://www.perfumehypermart.com">www.perfumehypermart.com</a>), would not have been sufficient to defend the revocation.</li> <li>2. There were other issues of interest discussed, such as whether, in relation to the Subject Mark itself, the use of “Christina Aguilera INSPIRE” would suffice as genuine use of  <b>Inspiré</b></li> <li>3. This case illustrates the importance, to trade mark proprietors, of keeping records which</li> </ol>	<p>[37]-[39]</p> <p>[42]-[43]</p>

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	demonstrate use (i) in Singapore; (ii) in the relevant time period(s); (iii) in relation to the goods/services claimed in the specification; (iv) by the trade mark proprietor or with his consent; with (v) such use being genuine use of the registered trade mark (including use differing in elements which do not alter the distinctive character of the registered trade mark).	
<b><i>Formula One Licensing B.V. v. Idea Marketing S.A. [2015] SGIPOS 7</i></b>	<p>Distinctiveness as a trade mark – Something more than mere association with a sign must be shown to allow the average discerning consumer to immediately and readily perceive, recognise or identify the goods or services in question to originate from a particular trader and from no other. In the present case, the Plain F1 Mark (“F1”) could be associated with either the Opponents or the Applicants. In addition, there was further evidence that the Plain F1 Mark was a standard associated with either motor sport or power boating.</p> <p><i>[Note: The decision was upheld on appeal to the High Court. A further appeal has been filed against the High Court decision in the Court of Appeal.]</i></p>	[63]-[73] (see also [2015] SGHC at [20]-[40])
<b><i>Ceramiche Caesar S.p.A. v Caesarstone Sdot Yam Ltd [2015] SGIPOS 9</i></b>	<p>In relation to the impression of the marks and the possibility of imperfect recollection, there was evidence that the word “Caesar” is only used by the Opponents and the Applicants while “stone” is commonly used for goods in Class 19. Thus, the would-be consumer would focus on the “Caesar” component of the Application Mark such that their impression of the marks is that they are both “Caesar” marks. This is all the more so taking into account their imperfect recollection.</p> <p><i>[Note: An appeal against this decision has been heard in the High Court and is now pending the High Court’s decision – HC/TA 12/2015.]</i></p>	[82] – [85]
<b><i>The Polo/Lauren Company, L.P. v United States Polo Association [2015] SGIPOS 10</i></b>	<p>1. One interesting aspect of this case is the IP Adjudicator’s analysis of the argument on the pricing of eyewear. There was an argument that confusion was unlikely because both the Applicants’ eyewear and the Opponents’ eyewear were expensive items and hence purchasers were likely to exercise a higher degree of care when purchasing the eyewear. The IP Adjudicator indicated that, in considering pricing as a factor in the confusion inquiry, it would not be appropriate to consider if <i>the Opponents’ eyewear</i></p>	[107] – [108]

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	<p>and/or <i>the Applicants' eyewear</i> were expensive items. Rather, in order to pay heed to the Court of Appeal's decision in <i>Staywell Hospitality Group Pty Ltd v Starwood Hotels &amp; Resorts Worldwide, Inc</i> [2014] 1 SLR 911, the reference point should be the normal or average price of eyewear <i>as a type or category of goods</i>. She gave this example to illustrate the point: cars were expensive goods whereas erasers were inexpensive goods, and hence the degree of attention and care that went into buying a car would be greater than that which went into buying an eraser.</p> <p>2. She also indicated that it was not necessary in every case to focus on the price of the type of goods concerned. Ultimately, the aim of the exercise was to determine the degree of care that the average consumer was likely to pay when purchasing that type of goods. In this exercise, there might be factors other than price which are more useful.</p> <p>3. In her assessment, eyewear was a type of goods the purchase of which involved a fairly high degree of care regardless of their price range. She gave the following reasons. First, eyewear as a type of goods was not purchased on a regular or frequent basis. Second, eyewear as a type of goods was usually bought through salespersons particularly when they are sold in optical shops. Third, eyewear was a type of goods that would command a higher degree of fastidiousness on the part of a consumer who was likely to inspect the product closely in order to decide if the particular spectacle frame fit well in terms of comfort level (e.g. whether the nose pad of the spectacle frame sat comfortably on the consumer's nose bridge). This fairly high degree of care and attention that the average consumer would pay when purchasing eyewear, coupled with the very low degree of similarity between the two marks, were reasons for her conclusion that there was no likelihood of confusion.</p> <p><i>[Note: An appeal against this decision has been heard in the High Court and is now pending the High Court's decision – HC/TA 13/2015.]</i></p>	<p>[109]</p> <p>[110] – [112]</p>
<p><b><i>Converse Inc v Southern Rubber Works Sdn Bhd</i> [2015] SGIPOS 11</b></p>	<p>In relation to the preliminary issue of the <i>locus standi</i> of the Opponents to oppose, although the case of <i>J.E. Borie SA v MHCS</i> [2013] SGIPOS 4 concerns an opposition under section 8(2), the interpretation rendered is not confined to an opposition under section 8(2) only. It</p>	<p>[19]</p>

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	<p>does not matter whether the opposition filed under section 13 is relying on a ground of opposition under section 8(2) or any other ground of opposition, including the grounds of opposition under section 8(7)(a) and section 7(6) (save for an opposition against an applicant who has established honest concurrent use of the applicant’s later mark because under section 9, an opposition against such honest concurrent use may only be brought by the proprietor of the earlier trade mark). The standing to bring proceedings is found in the relevant provisions dealing with the respective proceedings, that is, section 13 that deals with opposition proceedings, section 22 that deals with revocation proceedings and section 23 that deals with invalidation proceedings. For opposition proceedings under section 13, as stated above, “any person” may bring such proceedings.</p>	
<p><b><i>Cheaney Shoes Limited v Widdy Trading Pte Ltd</i> [2015] SGIPOS 12</b></p>	<p>1. It is incumbent on every trade mark owner to document evidence of use. Being a business with small scale operations (and poor record-keeping) in itself will not salvage a case where the evidence does not show genuine use of the mark in Singapore.</p>	[40]-[43]
	<p>2. In a revocation action, the burden of proof lies with the registered proprietor to show use of the registered trade mark, and not with the Applicants to show non-use of the mark.</p>	[44]-[46]
<p><b><i>Lonza Biologics Tuas Pte Ltd v Genpharm International Inc.</i> [2015] SGIPOS 13</b></p>	<p>The proprietors withdrew from the hearing after filing its counter-statements and evidence. An evidential objection was raised as to whether the proprietor’s expert evidence should be considered since it did not participate in the hearing and its expert was not presented for cross-examination. It was held that the proprietor’s acquiescence and course of conduct was sufficient to amount to an acceptance of the applicant’s proposal to apply the Evidence Act to the hearing. Further, it was held that <i>Martek Biosciences Corp v Cargill International Trading Pte Ltd</i> [2011] 4 SLR 429; [2011] SGHC 71 established the principle that the written testamentary evidence a witness who does not appear before a tribunal and allow himself to be cross-examined ought to be excluded, unless a hearsay exception was applicable, as to keep it on record would be prejudicial to the opposing party. Rule 80(10) of the Patent Rules permitted the inclusion of this principle for IPOS hearings. However, expert evidence filed together with the proprietor’s counter-statement ought to remain on record as these formed a necessary part of the counter-statement.</p>	[24]-[42]

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<p><b><i>Fererro SpA v Dochirnie pidpriemstvo "Kondyterska Korporatsiia "ROSHEN" [2015] SGIPOS 14</i></b></p>	<ol style="list-style-type: none"> <li>1. Formal requirements of Supplementary SD (“SSD”) – An SSD that does not specify which country it was declared in and only bore the signature of the deponent, but not any notary public (if a non-Commonwealth country), commissioner of oaths (if in Singapore) or any other relevant authority, and is only signed by a translator and an “advocate &amp; solicitor, Singapore” will not be treated as admissible.</li> <li>2. Requirement of service by Registrar in IPOS proceedings – There is no obligation on the Registrar to comply with a party’s request to send documents by fax. The Registrar may send letters by post, fax or electronic communication.</li> <li>3. Costs award – The Registrar has the discretion to award costs as long as it is within the Fourth Schedule of the Trade Marks Rules. Where the Applicants’ actions have caused unnecessary complications to the proceedings and their behaviour consists of levelling accusations at the Registrar, the Registrar may give no order as to costs even though they are ultimately successful in the substantive action.</li> </ol>	<p>[11]-[13]</p> <p>[14]-[18]</p> <p>[96]-[103]</p>
<p><b><i>Axis Law Corporation v Axis Intellectual Capital Pte Ltd [2015] SGIPOS 15 (Interlocutory Hearing)</i></b></p>	<p>The application to amend the Statement of Grounds (SOG) was refused based on several factors, including the fact that the proposed amendments were substantial. The Applicants not only sought to add (i) further grounds for invalidation under Section 23; and (ii) an action for revocation under Section 22. The Applicants also sought to amend the proposed SOG late in the proceedings (<i>after</i> the filing of the Registered Proprietors’ evidence) and again (<i>a further</i> revision to the SOG) <i>after</i> the close of evidence.</p> <p><i>[Note: A judicial review has been filed against this decision in the High Court - HC/OS 960/2015.]</i></p>	<p>[20] - [23]</p>
<p><b><i>Metrojaya Bhd. and Metrojaya Sendirian Berhad v. The East India Company Holdings Pte Ltd [2015] SGIPOS 16 (Interlocutory Hearing)</i></b></p>	<ol style="list-style-type: none"> <li>1. Extension of time to file counter-statement in the context of revocation proceedings – An application for late extension of time will be considered in the same manner as with opposition proceedings, given that there are no differences in legislative wording. Administrative exigencies that do not amount to “exceptional circumstances” are not sufficient for the Registrar to exercise discretion to allow the application.</li> </ol>	<p>[14]-[29]</p>

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	<i>[Note: An “appeal” has been filed against this decision in the High Court in HC/TA 16/2015.]</i>	
<b><i>Bacardi &amp; Company Limited v G3 Enterprises, Inc [2015] SGIPOS 17</i></b>	<p>Marks that are technically distinctive nonetheless sit on a spectrum. Thus, even if a mark has been found to have acquired distinctiveness in relation to certain goods or services, this does not necessarily mean that the said mark has acquired a high level of acquired distinctiveness. Whether or not the said mark enjoys a high level of acquired distinctiveness beyond the level which is required for it to be considered to have acquired distinctiveness depends very much of the extent of use of the said mark.</p> <p><i>[Note: An appeal has been filed against this decision in the High Court – HC/TA 17/2015.]</i></p>	[30] – [33]

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