

IPOS Cases in 2017 – Selected Issues, Holdings and Comments of Interest

Note: Full Grounds of Decision (and Case Notes where available) accessible at:

<https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>

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IPOS CASES IN 2017

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<p><i>Application to amend pleadings and file further evidence in a trade mark opposition by Monster Energy Company and Objection thereto by Chun-Hua Lo [2017] SGIPOS 1</i></p>	<p>The main purpose of a PHR (Pre-Hearing Review) is to assess if a matter is gearing up for a full hearing and, if so, to deal with all procedural issues to render the case ready. It is a matter of good practice and courtesy, for counsel to seek pertinent instructions from their clients / foreign counsel, as appropriate, in relation to the developments with regard to the matter, at the very latest, by the PHR date so that the matter can move forward. Should such updates not be forthcoming, the relevant party would have to be prepared to bear the consequences of non-committal answers [to questions posed or issues raised at the PHR].</p>	<p>[16]</p>
<p><i>Audi AG v Lim Ching Kwang [2017] SGIPOS 2</i></p>	<p>It is legitimate for businesses to seek registration of a mark, not only for the categories of goods and services which it markets at the time of filing the application, but also for other categories of goods and services which it intends to market in the future. There is no bad faith in applying for a broader specification than one which a trader currently trades in. A possible or contingent intention to use the mark at some future date may suffice. To support a finding of bad faith, there must be something more to suggest that there has been some unconscionable business conduct and/or moral impropriety on the applicant's part.</p>	<p>[59(vi)]</p>
<p><i>Marvelous AQL Inc.'s Trade Mark Application [2017] SGIPOS 3</i></p>	<div style="text-align: right; margin-bottom: 10px;">  </div> <p>This was an ex parte hearing concerning an application to register for various goods and services. The Principal Assistant Registrar ("PAR") upheld the examiner's objections under Sections 7(1)(b) and 7(1)(c) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("TMA") and refused registration of the mark.</p> <p>Note: Subsequently, the decision was appealed to the High Court. The appeal was dismissed, and no written grounds were issued.</p>	

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	<p><u>Key points considered</u></p> <ul style="list-style-type: none"> • Relevant principles underlying the “descriptiveness” objection under Section 7(1)(c) • Evidence of a claimed fact should be filed by way of SD • Significance of other trade marks on the Register which were accepted for registration • Relevance of foreign registrations • Policy considerations against allowing descriptive / laudatory marks to be registered 	<p>[29]</p> <p>[41], [55]</p> <p>[44] – [46]</p> <p>[52]</p> <p>[58] – [59]</p>
<p><i>Bigfoot Internet Ventures Pte. Ltd. v Apple Inc.</i> [2017] SGIPOS 4</p>	<p>Online, post-sale support in the form of upgrades and updates of software could potentially be “use” of a trade mark for the purposes of a non-use revocation action.</p>	<p>[40]</p>
<p><i>Courts (Singapore) Pte Ltd. v Big Box Corporation Pte Ltd.</i> [2017] SGIPOS 5</p>	<p>Evidence post-dating the Application Date may assist to draw inferences as to what the position [on descriptiveness] was at and before that date.</p> <p>Cautionary observations concerning market surveys:</p> <p><i>“From experience in legal practice in England, I am aware that there is often pressure to conduct market surveys to try and find evidence to support factual contentions made in trade mark proceedings. However, my experience is also that such evidence is rarely determinative and is often disproportionately expensive to obtain; it is for that reason that the practice has grown up in England of using mini-market surveys as a method of finding witnesses prepared to give written statements (or appear as witnesses in court proceedings), on the basis that there is no substitute for a real person saying real things under oath (see the general section on ‘Surveys and questionnaires’ in the First Supplement (2014) to the 15th edition of Kerly’s, at [21-018] to [21-042s], and particularly [21-042q] to [21-42s] on surveys to prove meaning).</i></p>	<p>[36]</p> <p>[60] – [61]</p>

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	<p><i>Of course, there remains a role for market survey evidence if that is the only sufficient evidence that can be obtained but, if so, very careful consideration needs to be given to the form of the questions and the process for administering them, and recording accurately and fully the responses, so as to ensure that the evidence goes to the factual questions in support of which it is intended it be adduced.”</i></p> <p>Note: There was an appeal to the High Court against this decision. The appeal has been heard, but a decision has yet to be issued.</p>	
<p><i>FMTM Distribution Limited v Van Cleef & Arpels S.A.</i> [2017] SGIPOS 6</p>	<p>A trade mark’s very success may lead to a possible claim of general use of the mark to refer to the characteristic of the product itself.</p>	<p>[2] – [3]; [81] – [83]</p>
<p><i>Consolidated Artists B.V. v THEFACESHOP Co. Ltd.</i> [2017] SGIPOS 7</p>	<p>This was an unusual case wherein the trade mark applicant’s request to enter a disclaimer on the application mark prior to the opposition hearing was allowed, albeit on the specific facts.</p>	<p>[19] – [39]</p>
<p><i>Louis Dreyfus Commodities MEA Trading v Orco International (S) Pte Ltd</i> [2017] SGIPOS 8</p>	<p>When one party has filed its pleadings and evidence, but does not file Form HC1 (Notice of Attendance at Hearing) prior to the hearing, the Registrar has the discretion to, and will typically, proceed with the hearing in that party’s absence. In this case, the Registrar exercised the discretion to proceed with the opposition hearing in the trade mark applicant’s absence.</p>	<p>Footnote 1 and [20] – [22]</p>
<p><i>FMTM Distribution Ltd v Tan Jee Liang trading as Yong Yew Trading Company</i> [2017] SGIPOS 9</p>	<p>One interesting issue raised in this case concerned the admissibility of documents produced in the course of cross-examination for the purposes of IPOS proceedings. In holding that most, but not all of the documents were admissible, the Principal Assistant Registrar applied the following axiom: “<i>the touchstone of admissibility is relevance</i>”.</p>	<p>[18] – [36]</p>

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	Another interesting issue that arose in this case concerned the requisite nexus between Singapore and the evidence of use required to defeat a non-use revocation action. Specifically, must the evidence show that the mark was applied to goods that were advertised and sold to consumers in Singapore? Or is it sufficient to show evidence of <i>entrepôt</i> trade conducted under the mark in question, never mind the issue of whether the goods were exposed to consumers in Singapore? Although the Principal Assistant Registrar was not required to decide the issue, he set out the arguments on both sides and proffered some observations.	[137] – [151]
<i>Apple Inc. v Xiaomi Singapore Pte Ltd</i> [2017] SGIPOS 10	Passing off under S8(7)(a) – the misrepresentation leading to deception and confusion must stem from the use of the Application Mark and not matters which are extraneous to the mark itself, such as the way the goods look or the way the goods are marketed.	[110]
<i>U-Manga International Business Co., Ltd v Nunufish.com</i> [2017] SGIPOS 11	Parties' evidence should be curated with a view to addressing the grounds in issue.	[64]
<i>Monster Energy Company v Mixi Inc.</i> [2017] SGIPOS 12	While the similarity of marks comparison is to be undertaken mark-for-mark, without consideration of any external matter, to the extent that the respective goods/services are relevant to the issue of the distinctiveness (in both its technical and non-technical senses) of the competing marks, they may be taken into account.	[37]
<i>Multi Access Limited v Guangzhou Pharmaceutical Holding Limited</i> [2017] SGIPOS 13	The bar for bad faith is high. One cannot jump to the conclusion that the mere registration of famous marks (not belonging to the then-applicant) is enough to show bad faith on the part of the then-applicant in relation to the specific trade mark registration at hand (not the other famous marks).	[29]
<i>Tan Buck Hai v United U-Li Projects Pte Ltd</i> [2017] SGIPOS 14	The general starting position between a manufacturer and its distributors is that the ownership of a trade mark over the goods/services concerned typically remains with the manufacturer and does not pass over to the distributor. Note: An appeal was filed to the High Court, but it has since been discontinued.	[28] – [29]

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<i>Eley Trading Sdn Bhd v Kwek Soo Chuan</i> [2017] SGIPOS 15	<p>Use of a sign as a business name does not necessarily equate to use of that sign as a trade mark for the purposes of acquired distinctiveness.</p> <p>Note: An appeal to the High Court is pending.</p>	[71]
<i>New Yorker S.H.K. Jeans GmbH & Co. KG v Daidoh Limited</i> [2017] SGIPOS 16	<p>An order for non-use revocation may, in certain circumstances, be backdated to take effect from an earlier date. However, the Registrar has no power to backdate the effective date of revocation to a day within the first 5 years from the date of the completion of the registration procedure.</p>	[7], [73] – [97]
<i>Monster Energy Company v Chun-Hua Lo</i> [2017] SGIPOS 17	<p>In this case, it was opined (<i>obiter</i>) that non-alcoholic beverages in Class 32 are similar to cafes and restaurant services in Class 43.</p> <p>Note: An appeal to the High Court is pending.</p>	[153]
<i>Starbucks Corporation d/b/a Starbucks Coffee Company v Morianaga Nyugyo Kabushiki Kaisha (Morinaga Milk Industry Co. Ltd.)</i> [2017] SGIPOS 18	<p>Where the Application Mark is depicted in black and white, colour is <i>not</i> a factor which influences the mark-similarity assessment <i>either way</i>, it neither adds to, nor detracts from, the similarity between the marks.</p> <p>Cases wherein deception (Section 7(4)(b) TMA) was pleaded as a ground of opposition are few. In this case, the deception ground was argued, albeit unsuccessfully. In arriving at her conclusion, the IP Adjudicator held, among other things, that the applicable threshold for deception is that of a “real tangible danger” that the public be deceived (as distinguished from a mere “cause to wonder”).</p> <p>In the F&B industry, there is a trend for marks to be inspired by geographical locations. As such, one should be slow to find “deceptiveness” at the application stage in the absence of a clear and express indication or representation which is plainly false.</p>	<p>[37]</p> <p>[142]</p> <p>[182]-[183], [193]-[194]</p>

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<p><i>The Polo/Lauren Company, L.P. v Royal County of Berkshire Polo Club Ltd</i> [2017] SGIPOS 19</p>	<p>This is the most recent in a long line of cases before the courts and/or IPOS involving The Polo/Lauren Company's trade marks. In this dispute, The Polo/Lauren Company sought, unsuccessfully, to invalidate the following trade mark:</p> <div style="text-align: center;">  </div> <p>In the assessment, the Principal Assistant Registrar found that the textual components of the application mark – specifically, the words “Royal County of Berkshire” and “POLO CLUB” – to be not negligible and therefore could not be disregarded. Indeed, they both played an essential part in the overall impression conveyed by the mark.</p>	<p>[65]</p>

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