

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF  
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
REPUBLIC OF SINGAPORE**

Trade Mark Nos. 40201702614Q, 40201702615U, 40201702617X & 40201704650Q  
Hearing Date: 30 January 2019  
(Further Written Submissions: 22 February 2019, 23 February 2019 & 6 March 2019)

**APPLICATION FOR CONFIDENTIALITY SAFEGUARDS  
BY TWG TEA COMPANY PTE. LTD.  
("APPLICANT")**

**AND**

**OBJECTION THERETO  
BY T2 SINGAPORE PTE. LTD. & TEA TOO PTY LTD ("RESPONDENTS")**

Principal Assistant Registrar Mark Lim Fung Chian  
Decision date: 10 April 2019

*Interlocutory hearing – application by Applicant in opposition proceedings for confidentiality safeguards from Respondents in respect of sales and marketing figures – objection by Respondents – whether confidentiality safeguards should be ordered – if so, what should these safeguards be.*

**I. INTRODUCTION**

1. In trade mark opposition proceedings, it is common for a party to adduce sales and marketing figures. These figures are invariably used to support that party's proposition that a trade mark has acquired distinctiveness, is well known in Singapore or is well known to the public at large in Singapore.<sup>1</sup>
2. Should the confidentiality of such sales and marketing figures be safeguarded? If so, under what circumstances? And what would be the appropriate confidentiality safeguards?
3. Perhaps surprisingly, it appears that this is the first time that a Singapore court or tribunal has had to adjudicate on these issues. Indeed, it seems that little guidance can be gleaned from other relevant common law jurisdictions as well.

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<sup>1</sup> See [21] below.

## II. EVENTS LEADING UP TO THIS INTERLOCUTORY APPLICATION

4. The Applicant seeks to register the trade marks “SINGAPORE BREAKFAST”, “NEW YORK BREAKFAST”, “LONDON BREAKFAST” and “CARAVAN” (“**the Subject Marks**”) for tea and other goods in Class 30.
5. The Respondents oppose the registration of these marks on various grounds, including that the marks are “*devoid of any distinctive character*” (see Section 7(1)(b) of the Trade Marks Act (Cap. 332) (“**TMA**”)) and/or that the marks are descriptive of the goods in question (see Section 7(1)(c) TMA<sup>2</sup>).
6. I understand from the Applicant that these objections were not raised (or were ultimately overcome by the Applicant) when the marks were applied for and examined by the Trade Mark Registry. The Applicant of course cannot know whether the Registrar would take the same position in opposition proceedings, where the Respondents will put forward evidence and raise arguments in support of these objections.
7. The Applicant therefore argues that, in any event, the marks have “*in fact acquired a distinctive character as a result of the use made of it.*” Accordingly, as provided under Section 7(2) TMA, the marks should “*not be refused registration by virtue of [Section 7(1)(b) or (c) TMA].*”
8. In support of this argument, the Applicant seeks to adduce the following in evidence:
  - a. the amounts spent by the Applicant in the five (5) years preceding the dates of application for the respective Subject Marks, to engage PR firms to advertise and create awareness for the Applicant’s products, which includes products bearing the respective Subject Marks; these PR firms were engaged from 2008 to 2015;
  - b. the total sales figures for tea sold under the respective Subject Marks from 2011 to 2017 in Singapore; and
  - c. the total sales figures of pots of tea sold under the Subject Marks respectively from 2012 to 2017 at the Applicant’s tea salons and its franchisees’ tea salons in Singapore.

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<sup>2</sup> Section 7(1)(c) TMA provides that “*trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services*” shall not be registered.

For convenience, I will refer to the figures in paragraph (a) as “**the Applicant’s Marketing Figures**”, and the figures in paragraphs (b) and (c) collectively as “**the Applicant’s Sales Figures.**”

9. The Applicant asserts that this evidence constitutes confidential information.<sup>3</sup> Thus, before disclosing the information to the Respondents, the Applicant seeks various confidentiality safeguards.
10. Specifically, the Applicant proposes that the Respondents provide a confidentiality undertaking on the following terms<sup>4</sup>:
  - a. not to use the confidential information for any purposes other than the conduct of the IPOS proceedings in respect of the Subject Marks;
  - b. to disclose the confidential information only to: (i) the Respondents’ Singapore solicitors and support staff, (ii) employees of the Respondents as approved by the Applicant, and (iii) IPOS;
  - c. an indemnity from the Respondents against “*any loss, damage, liability, claims, demands, fees, costs and expenses (including legal and professional costs and expenses)*” incurred by the Applicant arising from any breach of the undertaking; and
  - d. consent by the Respondents to injunctive relief in the event of any threatened or actual breach of the undertaking.
11. The Respondents refuse to provide such a confidentiality undertaking.<sup>5</sup> Hence, the Applicant has applied to the Registrar for these confidentiality safeguards to be imposed on the Respondents.
12. Pending a resolution of this issue, and in view of the deadline for the Applicant to file its evidence in support of the registration of the Subject Marks, the Applicant filed statutory declarations of its director Taha Bou Qdib with the confidential information (set out at [8] above) redacted.
13. Pending the resolution of the issues relating to the confidential information, the deadline for the Respondents to file its reply evidence has been stayed.

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<sup>3</sup> In these grounds of decision, I refer to this evidence as “**confidential information**” for convenience, while noting that neither the Registrar nor the Respondents have actually had sight of this information. For the avoidance of doubt, nothing in this decision shall prevent the Respondents from subsequently challenging the confidentiality of this evidence, should they choose to do so.

<sup>4</sup> For full details of the proposed undertaking, see letter from Drew & Napier LLC to Amica Law LLC dated 6 September 2018. The terms set out are essentially the same as those contained in an earlier letter dated 28 June 2018, save that the Applicant no longer required individual undertakings from the Respondents’ employees.

<sup>5</sup> Initially, the Respondents had been amenable to providing an undertaking to the Applicant in accordance with [10(a)] above: see letters from Amica Law LLC to Drew & Napier LLC dated 21 August 2018 and 11 September 2018. However, at the hearing, the Respondents informed me that this offer (which had been rejected by the Applicant) was no longer on the table.

14. It should be mentioned that, when this matter was heard before me, the parties were also involved in related proceedings before the High Court (High Court Suit 633/2017). The suit involved claims by the Applicant against the Respondents for: (1) trade mark infringement in respect of trade marks for the “get-up”/label of some of the Applicant’s products bearing the Subject Marks<sup>6</sup>; and (2) passing off. Parties informed me that similar confidentiality issues had not arisen in the High Court proceedings, at least not at the time of the hearing before me. Subsequently, the Applicant updated IPOS that the High Court suit had been settled and the suit discontinued.<sup>7</sup>

### III. DISCUSSION

15. At the outset, I wish to record my thanks to the parties for their helpful submissions.
16. Questions of confidentiality commonly arise in proceedings relating to intellectual property.
17. The competing public interests which arise are succinctly set out by International Judge (“IJ”) Simon Thorley in the recent decision of the Singapore International Commercial Court in *B2C2 Ltd v Quoine Pte Ltd* [2018] SGHC(I) 04 (at [16]):

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<sup>6</sup> The trade marks involved in the suit are:



(Trade Mark No. T1013903J);



(Trade Mark No. T1004787Z);



(Trade Mark No. T1004809D); and



(Trade Mark No.

T1308460A).

<sup>7</sup> See letter from Drew & Napier to IPOS dated 3 April 2019. The Applicant had eventually applied for a confidentiality undertaking in the High Court suit, but this was naturally also withdrawn as a result of the settlement.

The difficulties faced by courts when dealing with questions of confidentiality in the course of legal proceedings are well known. There is a public interest in open justice and there is an equivalent public interest in ensuring a fair trial in which both parties have unfettered access to all relevant material. Yet there is a competing public interest in ensuring that confidential information – particularly, trade secrets – of one party does not come into the public domain or become exposed to the possibility of misuse by the other party as a result of legal proceedings. This is particularly so when the parties are competitors.

18. Thorley J also discussed in some detail a number of decisions from various common law jurisdictions (England and Wales, Australia, Hong Kong and Ireland) which have considered this issue. For the purposes of my interlocutory decision, it is not necessary to examine these decisions.

19. It should, however, be noted that these issues arise most frequently in claims for patent infringement and (of course) claims for breach of confidence. A typical example is where a claimant seeks discovery or inspection of a defendant's secret process which is alleged to infringe the claimant's patent. At this point of time, the court has not adjudicated on whether or not the patent has been infringed. As observed in *Diagcor Bioscience Incorporated Ltd v Chan Wai Hon Billy* [2015] HKCU 1853 (at [13]; citing *Warner-Lambert v Glaxo Laboratories Ltd* [1975] RPC 354 at 356):

If the defendant is in fact infringing, it should not be permitted to shelter behind a plea of secrecy. If, however, he is not infringing, he is entitled to have the secrets associated with its process maintained intact.

20. Importantly, in these cases, it is the party resisting discovery which seeks the protection of confidentiality safeguards before disclosing its trade secrets to the counter party, which is almost invariably a trade rival.

21. In trade mark proceedings, however, the allegedly confidential sales and marketing information is normally voluntarily put forward by a party to support a position which it takes. For example, in trade mark opposition proceedings:

- a. An applicant may adduce sales and marketing figures in support of its position that the mark in question has acquired distinctiveness (as in the present case; see [4]-[7] above).
- b. An opponent may adduce such figures in support of its position that a mark it is relying on to oppose the mark applied for is a “*well known trade mark*” under Section 2(1) read with Section 2(7), (8) & (9) TMA – if so:
  - i. this mark can be relied on as an “*earlier trade mark*” under Section 8(1) & (2) (read with Section 2(1)) even if the mark has not been registered or applied for prior to the mark sought to be opposed; or

- ii. under Section 8(4) TMA, an opponent can succeed in opposition proceedings even if this mark is registered for dissimilar goods.<sup>8</sup>
  - c. An opponent may also adduce such figures in support of its position that a mark it is relying on to oppose the mark applied for is “*well known to the public at large in Singapore*” under Section 8(4)(b)(ii) – if so, the opposition could succeed even if this mark is registered for dissimilar goods and there is no likelihood of confusion on the part of the public.<sup>9</sup>
22. It is not necessary to discuss the details of these provisions. The point I am making is that, in trade mark proceedings, the allegedly confidential information is normally voluntarily put forward. It is not the case that a party is being compelled to provide information which it then seeks to protect as a “condition” of being forced to disclose this information.
23. Perhaps for this reason, neither party has been able to locate any trade mark decision in Singapore where sales and marketing information has not been disclosed.<sup>10</sup> To give just two examples from the Singapore Court of Appeal, actual or (fairly precise) approximate sales and marketing figures were provided in: *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 at [6], [9], [10], [17] & [22]; and *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 at [12] & [13].
24. Of course I accept the Applicant’s point that the issue of whether confidentiality safeguards should be ordered does not appear to have been argued in any of these cases. Nevertheless, I cannot ignore the fact that the normal practice in trade mark cases in Singapore is for sales and marketing information to be disclosed.
25. In the corresponding opposition proceedings in the UK, the applicant’s request to restrict disclosure of the confidential information (in those proceedings) to the opponent’s solicitors was refused.<sup>11</sup>

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<sup>8</sup> The opponent would need to establish that use of the mark applied for would indicate a connection between the goods or services for which the mark applied for is sought to be registered and the opponent, and is likely to damage the interests of the opponent.

<sup>9</sup> The opponent would need to establish that use of the mark applied for would cause dilution in an unfair manner of the distinctive character of the opponent’s mark; or would take unfair advantage of the distinctive character of the opponent’s mark.

<sup>10</sup> At the hearing, I asked the Applicant if there were any Singapore trade mark cases where sales & advertising figures were not included in the judgment. The Applicant was not able to identify any such cases at that point of time, and asked for some time to check. I therefore directed the parties to write to the Registry setting out any Singapore trade mark cases (in the past 5 years) where sales and advertising figures of any party were sealed. The parties checked and wrote back to the Registrar accordingly: see letter from Amica Law LLC to IPOS dated 22 February 2019 (examining cases dating back to 2000) and letter from Drew & Napier LLC to IPOS dated 23 February 2019 (examining cases dating back to 2012).

<sup>11</sup> See Respondents’ Written Submissions at [30]-[33].

26. In contrast, confidentiality safeguards were ordered in the decision of *TWG Tea Company Pte Ltd v Mariage Frères* [2016] R.P.C 7.<sup>12</sup> I am also aware that the UK IP Office does issue decisions where confidential sales and marketing figures are redacted (see, for example, *Alphinstars Research SRL v Oro Star Sports Limited* (UK IP Office, Case No. O/448/18)).
27. The Respondents drew my attention to some guidance set out in the **UK Trade Marks Manual**<sup>13</sup> under “12. Confidentiality”:

*If it had been the intention for all sales and advertising figures submitted in ex parte evidence to be kept confidential the rules might have been expected to reflect this. There will be occasions where it can be shown that, for specific reasons, public inspection of particular sales or advertising figures will be damaging to the applicant and in such a case favourable consideration will be given to a request for confidentiality. Depending on the weight of the case for confidentiality and the significance of the figures to the monopoly being sought, the Registrar may agree that the figures for particular periods be kept confidential either absolutely, or on condition that a supplementary summary, showing the figures in a less specific way, be submitted for the public record. For example sales for a particular period could be expressed as being not less than £XXX, or between £XXX and £YYY. In such a case the summary may be made available for public inspection but the actual figures kept in the confidential section of the file.*

*It is always open to the applicant or their representative to submit evidence in a form that avoids the need to refer to specific figures. For example, one applicant submitted evidence which provided details of the length of user, the number of outlets through which the goods had been sold and their location, and a “not less than” figure for sales through each outlet. The point being that it is not always necessary to provide precise sales figures in order to establish factual distinctiveness.*

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<sup>12</sup> This was the only trade mark case cited to me by the Applicant. In that case, after hearing submissions from both parties, the hearing officer had issued a confidentiality order to limit disclosure of the opponent’s sales figures to the applicant’s solicitors (“the first decision”). The applicant objected on the basis that the first decision was made without regard to certain letters from the applicant setting out the basis of its objections; for some unexplained reason, the letters had not been matched with the relevant files by the computer system, and so had not been read by the hearing officer. After hearing further submissions from the parties, the hearing officer purported to reverse the first decision in that he now allowed disclosure of the opponent’s sales figures to the applicant as well (“the second decision”). The Appointed Person allowed the appeal against the second decision on the basis that the hearing officer did not have the power to rehear the first decision. He therefore reinstated the first decision.

<sup>13</sup> <https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide> (accessed by the Respondents on 9 January 2019).

*The registrar has agreed to confidentiality in cases where either sales figures were not central to the decision to accept the application, or specific reasons for keeping them confidential were provided. Most requests for confidentiality so far received have not included reasons to justify the request beyond generalities such as the exhibit “contains sensitive commercial information”. These have not been accepted. However, if specific reasons are provided for such requests the registrar must consider them and, if justified, agree to confidentiality.*

28. However, there does not appear to be any decision which sets out a principled basis as to when confidentiality safeguards would be ordered. This issue was not considered in any of the UK cases cited above.
29. I therefore return to the fundamental question that arises in the application before me — Is there a difference in a case where a party is seeking confidentiality protection over information which it voluntarily puts forward in support of its case (as here), and a situation where it is compelled to provide the information?
30. In my view, the answer must be “yes”. A person should generally not be permitted to have his cake and eat it. In the present case, for example, since the Applicant is relying on these figures to argue that it should be entitled to a monopoly over the Subject Marks, a strong argument can be made that it is only reasonable that these figures should be made available to other traders against whom this monopoly may be asserted.
31. Furthermore, it is unfair to impose confidentiality obligations on a party in respect of information which it never asked for in the first place.
32. As a starting point therefore, I am of the view that confidentiality undertakings should not be imposed in such cases.
33. This does not mean that confidentiality safeguards should never be imposed. However, the case for imposing such safeguards would need to be compelling.
34. In my view, some factors to consider would include:
  - a. The importance of the information to the issues in dispute — the more critical the information, the less likely it should be kept private; in accordance with the principle of open justice, it is important to be able to ascertain the basis of a court or tribunal’s decision;
  - b. The degree to which the information is confidential — if the same type of information is available through publicly available sources (e.g. if the party providing the confidential information is publicly-listed, some of the

information may be publicly available; some of the information may be available through industry or trade publications);

- c. How current the information is – in most trade mark disputes before IPOS, the tribunal is concerned with the status of matters at the date of application for registration of the mark in dispute; this could be a few years before the date when the information is provided; the more “historic” the information, the less likely that it will still be commercially valuable;
- d. Whether the parties are competitors – if so, it would be more important to have confidentiality safeguards; but this cannot be decisive since the parties in such proceedings will in many cases be competitors;
- e. The extent of prejudice to a party should the confidential information be disclosed to its competitor – this will depend very much on the facts of each individual case; and
- f. The stage of the proceedings – as the matter advances towards a hearing, it will become progressively more important for a party to be fully apprised of the case it has to answer, and it is plausible that more individuals within that party might need access to the confidential information to enable meaningful discussions as to the conduct of the case, including whether the possibility of a settlement should be explored.

35. I now apply the above to the present case.<sup>14</sup>

36. The parties are direct competitors both in Singapore and abroad. The Respondents operate four (4) T2 stores in Singapore offering a large variety of tea blends to customers.<sup>15</sup> The Applicant operates 12 tea salons and tea boutiques in Singapore.<sup>16</sup> It appears from the corresponding opposition proceedings in the UK (mentioned at [25] above) that the parties are also competitors there.

37. The Respondents sell tea and tea-related products under the names “SINGAPORE BREAKFAST”, “NEW YORK BREAKFAST”, “LONDON BREAKFAST” and “RUSSIAN CARAVAN”. For ease of reference, it will be recalled that the Subject

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<sup>14</sup> The information set out below is taken from the parties’ statutory declarations, and is accepted at face value for the purposes of these interlocutory proceedings. There are four sets of statutory declarations in respect of the opposition proceedings for each of the Subject Marks. While the contents of the parties’ respective statutory declarations are similar, the paragraph numbers pertaining to each point are not necessarily the same. For convenience, I have therefore not made reference to the precise paragraphs of the parties’ statutory declarations in these grounds of decision.

<sup>15</sup> As at 14 March 2018, the date of the Respondents’ statutory declarations in support of the various opposition proceedings against the Subject Marks.

<sup>16</sup> As at 17 September 2018, the date of the Applicant’s statutory declarations in support of the application for registration of the Subject Marks.

Marks applied for by the Applicant are “SINGAPORE BREAKFAST”, “NEW YORK BREAKFAST”, “LONDON BREAKFAST” and “CARAVAN.”

38. It appears that the Applicant’s Marketing Figures (which have been redacted) are in respect of the Applicant’s products generally and are not specific to products bearing the Subject Marks. The Marketing Figures are until the year 2015.
39. In contrast, the Applicant’s Sales Figures (which have also been redacted) are for sales of goods bearing the Subject Marks. These also include goods sold to corporate clients and franchisees at a highly discounted rate. The Sales Figures are also fairly current (until 2017).
40. The commercial value to the Respondents of the Applicant’s Sales Figures is clear. The Applicant gave the following example of how these figures could be used – “*assuming that the [information] shows that the sales figures for the Applicant’s product or pots of tea sold under the SINGAPORE BREAKFAST Mark are the highest, the [Respondents] may focus its resources in promoting products under the same mark.*”<sup>17</sup> This in my view is a plausible hypothesis.
41. As far as the Applicant’s Marketing Figures are concerned, the damage caused by disclosure to the Respondents is less apparent. As noted, these figures are not specific to goods bearing the Subject Mark, and are no longer current (they date back to 2015).
42. Apart from considering the Applicant’s commercial interests, it should also be remembered that the interests of the Respondents and of open justice must be considered.
43. Taking into account the above circumstances, and with a view to balancing the various competing interests, I am of the view that the confidential information, and in particular the Applicant’s Sales Figures, should be protected by appropriate confidentiality safeguards at this point of time.<sup>18</sup>
44. As for what these safeguards should be (see [10] above for the safeguards requested by the Applicant), I am of the view that the Respondents should:
  - a. not use the confidential information for any purposes other than the conduct of the IPOS proceedings in respect of the Subject Marks; and
  - b. disclose the Applicant’s Sales Figures only to: (i) the Respondents’ Singapore solicitors and support staff, (ii) specified employees of the Respondents, and (iii) IPOS.

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<sup>17</sup> Applicant’s Written Submissions at [33(b)].

<sup>18</sup> As discussed at [47] below, I also consider it necessary to make provision for the possibility of varying the position should it be appropriate to do so in the future.

45. The Applicant's requests for an indemnity from the Respondents and consent by the Respondents to injunctive relief in the event of any threatened or actual disclosure of the confidential information, however, go too far. The Applicant has not been able to point me to any case (even cases pertaining to patent infringement or breach of confidence) where such orders were made. Considering that the Respondents have not even asked for the confidential information in the first place, it is all the more important that such onerous obligations should not be imposed on the Respondents.

#### IV. DIRECTIONS

46. I order as follows:

- (1) The Respondents shall not use the Applicant's confidential information for any purposes other than the conduct of the IPOS proceedings in respect of the Subject Marks.
- (2) The Applicant's Sales Figures shall be disclosed only to: (i) the Respondents' Singapore solicitors and support staff, (ii) Ms Nicole Tania Sparshott, who is a director of both Respondents and the deponent of the various statutory declarations in support of the oppositions against the Subject Marks, and (iii) IPOS.
- (3) The Applicant shall, **within two (2) weeks** of the date of this decision, re-file and serve the statutory declarations of Taha Bou Qdib with only the Applicant's Sales Figures redacted. If the Applicant chooses not to disclose the Applicant's Marketing Figures, the Applicant shall, **within two (2) weeks** of the date of this decision, re-execute statutory declarations with this information removed, and shall file and serve these statutory declarations with the Applicant's Sales Figures redacted.
- (4) The Applicant shall, **within two (2) weeks** of the date of this decision, provide one copy each of the unredacted statutory declarations of Taha Bou Qdib (or unredacted statutory declarations with the Applicant's Marketing Figures removed) to: (i) IPOS, (ii) Amica Law LLC; and (iii) Ms Nicole Tania Sparshott. Copies (ii) and (iii) shall be served on Amica Law LLC and may, if the Applicant wishes, be numbered copies. These copies shall be returned to the Applicant after the conclusion of the opposition proceedings in respect of the Subject Marks (including any subsequent appeals). Copy (i) shall be filed through IP2SG with a cover letter indicating the document contains matter over which the Registrar has granted confidentiality safeguards.
- (5) The Respondents shall, **within four (4) weeks** of the date of receipt of the Applicant's statutory declarations, file their statutory declarations in reply.

(6) Parties may vary the terms of this order by agreement, and failing agreement shall have liberty to apply to vary the terms of this order.

(7) Costs in the cause.

47. It is important to give parties the flexibility to apply to vary the terms of this order for at least two (2) reasons. First, the Respondents (and the Registrar) have not actually seen the confidential information yet. For example, once complete information is placed before the Registrar, and with the benefit of parties' submissions when the opposition proceedings are heard on the merits, it may transpire that it is necessary to include some of the confidential information in the grounds of decision to explain how the decision was reached. Secondly, there may be a change in circumstances in future (e.g. staff turnover) and there may be good reason for the Respondents to require wider dissemination of the protected information. Indeed, the Respondents may apply forthwith to vary the order if they are of the view that the Applicant's Sales Figures need to be disclosed to anyone else apart from Ms Sparshott. At the time of writing the first draft of this judgment, a third reason to give parties liberty to apply was that there were related court proceedings which were then on-going. It was therefore necessary to have some flexibility to align this order to any conflicting court order which may have been given in future. The High Court suit has, however, since been discontinued pursuant to a settlement reached between the parties (see [14] above).

## V. OTHER ISSUES

48. I briefly address two other issues which have arisen in the course of arguments.

### A. Effect of Letters from IPOS dated 3 July 2018

49. By a letter from Drew & Napier LLC to IPOS dated 28 June 2018, the Applicant requested for confidentiality safeguards as the information to be included in the Applicant's statutory declarations "*contain confidential information pertaining to the Applicant's and its franchisees' financial information, including but not limited to internal details about local sales figures, advertising expenditure and trade activities.*" The letter went on to state that "*if the [Respondents] do not agree to provide confidentiality undertakings... we will write in to the Learned Registrar for further directions. In the meantime, we look forward to receiving the Learned Registrar's written confirmation on [the confidentiality safeguards requested by the Applicant].*"
50. By letters from IPOS dated 3 July 2018 in respect of the opposition proceedings for each of the Subject Marks, IPOS agreed to the Applicant's request.
51. The parties disagree on the effect of these letters. While the letters could have been written in clearer terms, I agree with the Respondents that the letters simply reflect an

interim position taken by the Registrar pending full arguments by the parties. This is consistent with IPOS' practice in relation to preliminary views: see *Application for Cross-examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company* [2016] SGIPOS 9 at [26]. As both parties are aware, the Registrar generally does not make any final orders without first hearing from all parties to the dispute.

52. In any event, I have in this decision ordered certain confidentiality safeguards in respect of the Applicant's confidential information, in particular the Applicant's Sales Figures.

### **B. The Riddick Principle**

53. It is well established that a party to litigation who had obtained discovery of a document owes an implied undertaking to the court not to use that document for any collateral or ulterior purpose. This is known as the *Riddick* principle and derives its name from the case of *Riddick v Thames Board Mills Ltd* [1977] QB 881.
54. The parties do not dispute the applicability of this principle to court proceedings. Where they disagree is on whether the *Riddick* principle also applies to proceedings before IPOS. Ironically, the Applicant (which is seeking confidentiality safeguards) argues that it does not apply<sup>19</sup>, whereas the Respondents (who are objecting to the imposition of confidentiality safeguards) takes the position that it does apply.
55. I note that parties to IPOS proceedings have always assumed that documents/information provided in the course of these proceedings cannot be used for other purposes.
56. In the present case, I have ordered that the Respondents shall not use the Applicant's confidential information for any purposes other than the conduct of the IPOS proceedings in respect of the Subject Marks. This essentially reinforces the *Riddick* principle as an explicit term of an order of this Tribunal, and is one of the suggested methods for safeguarding confidentiality set out in the **Supreme Court Intellectual Property Court Guide (supplement to Orders 87 and 87A of the Rules of Court (Cap 322, R5, 2006 Rev Ed))**. In the circumstances, I say no more about the applicability of the *Riddick* principle, save to express my view that it would be surprising if the *Riddick* principle does not apply to IPOS proceedings.

## **VI. CONCLUDING COMMENTS**

57. I have imposed certain confidentiality safeguards after hearing detailed submissions from the parties both in writing and orally.

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<sup>19</sup> It should be mentioned that the Applicant had initially taken the position that the *Riddick* principle did apply to IPOS proceedings: see letter from Drew & Napier LLC to IPOS dated 19 September 2018.

58. In future, it may be more expedient and cost-effective for parties to agree on appropriate safeguards (if any) instead of requiring an interlocutory hearing to determine the issue. If purportedly confidential information appears on documents which a party wishes to adduce in evidence, that party may also simply redact this information if it is not relevant to the issues in dispute.

**Legislation referred to:**

Trade Marks Act (Cap. 332), ss 2(1),(7),(8)&(9); 7(1)(b),(1)(c)&(2); 8(1),(2)&(4)

**Cases referred to:**

*Alphinstars Research SRL v Oro Star Sports Limited* (UK IP Office, Case No. O/448/18)  
*Application for Cross-examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang t/a Yong Yew Trading Company* [2016] SGIPOS 9  
*B2C2 Ltd v Quoine Pte Ltd* [2018] SGHC(I) 04  
*Diagcor Bioscience Incorporated Ltd v Chan Wai Hon Billy* [2015] HKCU 1853  
*Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687  
*Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216  
*Riddick v Thames Board Mills Ltd* [1977] QB 881  
*TWG Tea Company Pte Ltd v Mariage Frères* [2016] R.P.C 7  
*Warner-Lambert v Glaxo Laboratories Ltd* [1975] RPC 354

**Other materials referred to:**

Supreme Court Intellectual Property Court Guide (supplement to Orders 87 and 87A of the Rules of Court (Cap 322, R5, 2006 Rev Ed)  
UK IPO Trade Marks Manual, under “12. Confidentiality”

**Representation:**

Ms Vanessa Ho (Drew & Napier LLC) for the Applicant  
Mr Nicholas Tong (Amica Law LLC) for the Respondents