

IPOS Decisions 2019: Year-in-Review






Selected Issues, Holdings and Comments of Interest

Please note:





- (1) Full Grounds of Decision and case summaries (where available) are accessible at: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>
- (2) We have a mailing list where we provide updates on recent IPOS decisions. To join, please contact gabriel_ong@ipos.gov.sg.

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IPOS CASES IN 2019

| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|---|----------------------|
| <p><i>Swatch AG (Swatch SA) (Swatch Ltd) v Apple Inc.</i> [2019] SGIPOS 1</p> | <p>Swatch opposed Apple’s application to register “IWATCH” in respect of Class 9 goods (including computers, computer hardware, computer peripherals and wireless communications devices). Swatch relied on its earlier trade marks “SWATCH” and “”. The Hearing Officer considered the competing marks to be dissimilar. The opposition was ultimately unsuccessful.</p> <p><u>Point of interest</u></p> <p>Although “swatch” has a dictionary meaning in the English language (“<i>a sample of cloth or other material</i>”), the Hearing Officer found that the average consumer was likely to view “SWATCH” as an invented word because the word “swatch” as defined in the dictionary is not the sort of word that is used by most people on a regular basis.</p> | <p>[32]</p> |
| <p><i>Mahendra Naidu A/L R. Manogaran trading as Sri Sai Traders v Navin Trading Pte. Ltd.</i> [2019] SGIPOS 2</p> | <div style="display: flex; justify-content: space-around; align-items: center;">  <div style="text-align: center;">  </div> </div> <p>Invalidation actions were filed against the following registered marks “” and “”. However, the Registered Proprietor failed to file its evidence in support of the registration by the deadline. Subsequently, the Registered Proprietor made an interlocutory application with a view to obtaining an out-of-time extension of time to file evidence. The interlocutory application was refused, which meant that the Registered Proprietor was taken to have admitted to the facts alleged by the Applicant for invalidity.</p> <p>On the evidence of the Applicant for invalidity, the Hearing Officer found as follows: (a) that the Applicant had first use of “SHREE” and “SHREE GOLD” in Singapore; (b) that the Registered Proprietor’s director, known as Boss, used to import the Applicant’s goods into Singapore; (c)</p> | <p>[9] – [18]</p> |




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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|--|----------------------|
| | <p>that the subject marks were applied for on the very same day that Boss asked the Applicant for pictures of the Applicant's products (on the pretext that he would help to promote them in Singapore); and (d) Boss acted in a manner which suggested that he knew that his actions were not "above board".</p> <p>The marks were declared invalid on grounds that they had been registered in bad faith.</p> | |
| <p><i>Guess? Inc v Jen, Chi</i> [2019] SGIPOS 3</p> | <div style="text-align: center;">  </div> <p>Guess?, Inc, opposed the registration of  (the stylised word reads: "Hater"), which was sought to be registered in Class 25 for various items of clothing. It relied on the following earlier registrations in Class 25 (also for various items of clothing):</p> <div style="display: flex; justify-content: center; align-items: center;">  and  </div> <p>The Hearing Officer found that the marks are dissimilar, and the opposition failed as a result.</p> | |
| <p><i>The Scotch Whisky Association v Isetan Mitsukoshi Ltd.</i> [2019] SGIPOS 4</p> <p>Note: the decision on s7(4)(b) TMA was reversed by the High Court on appeal</p> | <p>This case concerned the Scotch Whisky Association's opposition to Isetan's application to register "I SETAN TARTAN" in Class 33. Of course, most people would have heard of Scotch whisky, but this case was not about Scotch. It was about "Tartan". More specifically, is "Tartan" a geographical indication designating whisky from Scotland? If so, is it entitled to protection under the Geographical Indications Act (Cap. 117B, 1999 Rev Ed) ("GIA")?</p> <p>After evaluating the evidence and hearing arguments, the Hearing Officer concluded that there was no evidence to support a finding that "Tartan" is a geographical indication or that it was also accorded protection as a geographical indication in the UK. As such, the grounds of opposition based on the claim that "Tartan" is a geographical indication failed. (In this case: Section 7(7) of the Trade Marks Act (TMA) and Section 7(5) TMA read with Section 6 GIA.)</p> | <p>[23] – [26]</p> |

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|---|---|----------------------|
| | <p>Notably, this is the first time that this tribunal has considered a case under the GIA since it came into force in 1999.</p> <p>The Scotch Whisky Association also argued that “Tartan” would be deceptive when used in relation to whisky not of Scottish origin, and that the application mark is not distinctive on account of the word “Tartan”. Disagreeing with these arguments, the Hearing Officer found that while each Scottish clan may have its own distinctive tartan pattern, tartan patterns are not used exclusively by the Scots and the word “Tartan” is not synonymous with Scotland. Further, the application mark contains the house mark “ISETAN” as the first word, which would either evoke Japan more than Scotland (for those familiar with the mark) or else be considered as a meaningless invented word. Accordingly, the opposition based on Sections 7(4)(b) and 7(1)(b), (c) TMA failed as well.</p> <p>The decision on the ground under s7(4)(b) was reversed by the High Court which found that “Isetan Tartan”, when used for whisky that is not Scotch, is of such a nature as to deceive the public as to its geographical origin. In arriving at that conclusion, the court found that: (a) tartan is an iconic symbol of Scotland; (b) the public in Singapore is familiar with tartan, and Scotland more generally; (c) the word “Isetan” in front of “Tartan” does not make the mark any less deceptive; (d) the average consumer of whisky would attach greater significance to the second word “Tartan” and would therefore likely be deceived that the product is from Scotland.</p> | [40] – [43] |
| <p><i>Singapore Shipping Association and Association of Singapore Marine Industries v Hitachi, Ltd. and Mitsubishi Shipbuilding Co., Ltd.</i> [2019] SGIPOS 5</p> | <p>This case deals with an opposition to amendments to a patent specification proposed by the patent proprietors (in the larger context of a revocation challenge).</p> <p>The Hearing Officer, in considering the factor of “unfair advantage”, extended its application to a scenario of monetisation. This went beyond the traditional infringement scenario.</p> <p>On the facts, Hitachi purported to monetise its patent by holding it out in its unamended state to two shipping companies, Sembcorp and Keppel. According to the Opponents, the “advantage” that Hitachi sought to gain was the opportunity to sell or license the patent, and the opportunity to close the deal at a higher price or subject to terms that were more favourable than would otherwise have been the case if the patent were amended.</p> | [86] – [94] |



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|--|--|----------------------|
| | <p>The Hearing Officer took the view that at the very least, Hitachi should have pointed out that some amendment to the patent was likely to be necessary. Instead, it appeared from the evidence that Hitachi continued to base their discussions around the unamended patent, producing a brochure depicting the unamended claims. A misleading statement was also made by the marketing agents acting for Hitachi.</p> <p>The Hearing Officer found that the Proprietors' unreasonable delay in applying for an amendment was compounded by the behaviour of Hitachi in their discussions with Keppel and Sembcorp. Using the words of Lee J in <i>Ship's Equipment Centre Bremen GmbH v Fuji Trading (Singapore) Pte Ltd</i> [2015] 4 SLR 781 at [155], the Proprietors' actions could be considered as "covetous conduct". The opposition therefore succeeded and the proposed amendments to the patent specification were refused.</p> | |
| <p><i>The Patisserie LLP v Aalst Chocolate Pte Ltd</i> [2019] SGIPOS 6</p> | <p>In this dispute, The Patisserie sought an order for revocation of Aalst Chocolate's trade mark registration for  in Class 30 on grounds of non-use. (Also see related dispute in [2019] SGIPOS 7 summarised below.)</p> <p>Aalst Chocolate conceded that there was no evidence of any use of the impugned mark in the exact form in which it had been registered, and that its best evidence of use was as follows:</p> <div style="display: flex; justify-content: space-around;">   </div> | <p>[23] – [59]</p> |

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|--|--|----------------------|
| | <p>The IP Adjudicator held the above use was insufficient to show use of the impugned mark, and made an order for revocation.</p> | |
| <p><i>Aalst Chocolate Pte Ltd v The Patisserie LLP</i> [2019] SGIPOS 7</p> | <p>In this related dispute (see [2019] SGIPOS 6), Aalst Chocolate was unsuccessful in obtaining a declaration of invalidity in respect of the following mark, registered by The Patisserie in Classes 30 and 35, on grounds that the mark is devoid of any distinctive character and/or descriptive.</p> <div data-bbox="943 571 1391 703" data-label="Image"> </div> <p>This decision sets out the approach to marks with foreign word elements e.g. the French word “Patisserie” in this case. The Registrar then considered the evidence and found that the mark “The Patisserie” was not descriptive and not devoid of any distinctive character at the relevant date in 2005.</p> <p>If the concern is that the trade mark has become the common name in the trade for the product or service in respect of which it is registered due to the acts or inactivity of the proprietor, the solution would be to seek revocation of the registration under Section 22(1)(c) of the Trade Marks Act instead.</p> | <p>[42] – [73]</p> |
| <p><i>CTBAT International Co. Limited v N.V. Sumatra Tobacco Trading Company</i> [2019] SGIPOS 8</p> | <p>CTBAT International (“Opponent”) and N.V. Sumatra Tobacco Trading Company (“Applicant”) are in the tobacco business. The instant dispute concerned the following trade mark application, sought to be registered by the Applicant in Class 34 for various tobacco products and related goods:</p> | |


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|----------------|---|----------------------|
| | <div style="text-align: center;">  </div> <p>The Opponent's sole ground of opposition was that the mark was applied for in bad faith.</p> <p>Interestingly, a few days prior to the commencement of the instant action, the Opponent had commenced separate proceedings to revoke the Applicant's "Tri Happiness" registered trade mark (also registered in Class 34 for various tobacco products and related goods) for non-use. The</p> <div style="text-align: center;">  </div> <p>Applicant did not resist the revocation action and the "Tri Happiness" mark was later revoked for non-use.</p> <p>The Opponent's case on bad faith may be summarised as follows:</p> <ul style="list-style-type: none"> (i) The Applicant has no bona fide intention to use the Application Mark in Singapore; (ii) The Applicant's "track record of applying to register other tobacco proprietors' trade marks"; | |





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|---|--|---|
| | <p>(iii) The Applicant did not discharge its duty to investigate into the bona fides of the Application Mark before seeking registration; and</p> <p>(iv) The Applicant’s knowledge of third party registration and use of similar marks.</p> <p>After considering the evidence (including that which was given during cross-examination of the Applicant’s witness) and the parties’ submissions, the Hearing Officer arrived at the conclusion that the Opponent had not established a case of bad faith, and so dismissed the opposition.</p> | <p>[34]-[37], [40]-[42], [45]-[50] and [52]</p> |
| <p><i>Application for Confidentiality Safeguards by TWG Tea Company Pte. Ltd. and Objection Thereto by T2 Singapore Pte. Ltd. & Tea Too Pty Ltd [2019] SGIPOS 9</i></p> | <p>T2 Singapore & Tea Too (“Opponents”) opposed applications by TWG Tea (“Applicant”) to register “SINGAPORE BREAKFAST”, “NEW YORK BREAKFAST”, “LONDON BREAKFAST” and “CARAVAN” for tea and other goods in Class 30 (“the Subject Marks”). The Opponents’ case, among other things, was that the marks are devoid of any distinctive character and/or descriptive. In order to meet this allegation, the Applicant intended to tender evidence of acquired distinctiveness through use.</p> <p>However, the Applicant wanted safeguards in place before it was prepared to disclose certain advertising expenditure and sales figures (referred to in the decision as “Marketing Figures” and “Sales Figures” respectively) which were said to be confidential. These safeguards included: confidentiality undertakings, indemnities, and consent to injunctive relief in the event of any threatened or actual breach of the undertakings. As the Opponents were unwilling to agree to the proposed terms, the interlocutory dispute proceeded to a hearing.</p> <p>The Hearing Officer noted the competing public interests of: (1) open justice and ensuring a fair trial in which both parties have unfettered access to all relevant material; and (2) ensuring that confidential information of one party does not come into the public domain or become exposed to the possibility of misuse by the other party.</p> <p>The Hearing Officer was of the view that, as a starting point, confidentiality undertakings should not be imposed in cases where a party is seeking confidentiality protection over information which it voluntarily puts forward in support of its case. Since the Applicant is relying on the</p> | <p>[10]</p> <p>[16] – [19]</p> <p>[20] – [32]</p> |

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|--|---|---------------------------------------|
| | <p>Marketing and Sales 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. Furthermore, it is unfair to impose confidentiality obligations on a party in respect of information which it never asked for in the first place.</p> <p>However, confidentiality safeguards could be imposed by the Registrar where there is a compelling case for doing so. Some (non-exhaustive) factors to consider in this regard would include: (a) the importance of the information to the issues in dispute; (b) the degree to which the information is confidential; (c) how current the information is; (d) whether the parties are competitors; (e) the extent of prejudice should the confidential information be disclosed to its competitor; and (f) the stage of the proceedings.</p> <p>On the facts of the case, the Hearing Officer was of the view that some confidentiality safeguards should be put in place, including that the confidential information should not be used for any purposes other than the IPOS proceedings. He also made a confidentiality order in relation to the Applicant’s Sales Figures by restricting disclosure to select individuals. However, the Hearing Officer declined to grant the Applicant’s remaining requests.</p> <p>As far as we are aware, this is the first time that a Singapore court or tribunal has had to adjudicate on these issues.</p> | <p>[33] – [34]</p> <p>[35] – [45]</p> |
| <p><i>Tiger Coatings GMBH & Co. KG v Seng Fong Paints Pte Ltd</i> [2019] SGIPOS 10</p> | <p>Seng Fong Paints applied to register the following trade marks in Class 2 in respect of “paints”:</p> <div style="text-align: center;">  </div> | <p>[72] – [81]</p> |

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|----------------|---|----------------------|
| | <div style="display: flex; flex-direction: column; align-items: center;">   <ul style="list-style-type: none"> • The applications were opposed by Tiger Coatings, which relied on, among other things, the following earlier trade marks registered in Class 2 for “paints”: <ul style="list-style-type: none"> • TIGER <div style="display: flex; align-items: center; margin: 0 0 10px 20px;">  <ul style="list-style-type: none"> • </div> <div style="display: flex; align-items: center; margin: 0 0 10px 20px;">  <ul style="list-style-type: none"> • </div> </div> <p>The pleaded grounds of opposition were: ss 8(2)(b) and 8(7)(a) Trade Marks Act.</p> <p>While the application marks contain a representation of a tiger, the word “TIGER” itself does not appear. Thus, an important issue which the IP Adjudicator had to decide was whether the competing marks were similar notwithstanding that the application marks did not contain the word “TIGER”. The IP Adjudicator discussed and left open the possibility that in some instances, there could be conceptual similarity between a word mark and a pictorial representation thereof.</p> | |

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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|---|----------------------|
| | <p>Ultimately, the IP Adjudicator found the competing marks to be visually, aurally and conceptually dissimilar. Since an opposition on the pleaded grounds cannot be sustained where the marks are dissimilar, the action was dismissed.</p> | |
| <p><i>Abbott Laboratories v Société Des Produits Nestlé S.A.</i> [2019] SGIPOS 11</p> <p>Note: Appeal Pending</p> | <p>Nestlé applied to register “HM-O” in respect of the following:</p> <p><u>Class 5</u> Nutritional supplements; dietetic supplements for medical use; dietetic substances, beverages and foodstuffs for medical and clinical use; food for babies; lacteal flour for babies; powdered milk for babies; nutritional supplements for medical use for pregnant women and breastfeeding mothers; vitamin preparations.</p> <p><u>Class 29</u> Cooked dishes based on vegetables, potatoes, fruits, meat, poultry, fish and seafood products; milk; dairy products; milk substitutes; milk beverages, milk predominating; milk-based beverages containing cereals and/or chocolate; yogurts; soya milk (milk substitute).</p> <p>Abbott Laboratories opposed the application on grounds that the application should be refused on grounds of descriptiveness and/or non-distinctiveness (i.e. s 7(1)(c) and/or 7(1)(b) Trade Marks Act).</p> <p>After considering the evidence, the Hearing Officer allowed the opposition on both pleaded grounds. In so doing, he made, inter alia, the following findings. The term “human milk oligosaccharides” (which are a group of milk sugars present in human breast milk) was commonly abbreviated as “HMO(s)” prior to the relevant date. The abbreviation appeared to have been first used by a segment of the scientific community, healthcare professionals, and companies in the field of infant nutrition or health supplements. Sometime prior to the relevant date of the assessment, scientific breakthroughs allowed product manufacturers to be able to introduce HMOs as an ingredient in infant formula milk. Efforts by various companies (including Nestlé) were made to educate the public about what HMOs are, especially for products that</p> | |

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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|--|----------------------|
| | <p>contain one or more HMO strains as an ingredient. On the flip side, there was no evidence that any trader had used “HMO” in the marketplace as a trade mark: a badge of origin.</p> <p>The Hearing Officer also rejected Nestlé’s argument that the application mark was distinctive as a whole on account of the presence of the hyphen in “HM-O”. The hyphen was found to be insignificant. Moreover, a hyphen serves a joining function, and seeks to ensure that a reader would read the elements together.</p> | |
| <p><i>Dentsply Sirona Inc. v Tomy Incorporated</i> [2019] SGIPOS 13</p> <p>Note: Appeal Pending</p> | <p>This was a trade mark invalidation action commenced by Dentsply Sirona against the following trade marks owned by Tomy Incorporated: “MICROARCH”, “SENTALLOY” and “BIOFORCE” (all in Class 10 in respect of orthodontics goods).</p> <p>The IP Adjudicator found that (a) the parties had been in a pre-existing commercial relationship relating to the manufacture, sale and distribution of orthodontics products; (b) one of the agreements governing the commercial relationship between the parties contemplated that ownership of IP rights in respect of “MICROARCH”, “SENTALLOY” and “BIOFORCE” would vest in Dentsply Sirona only; and (c) Tomy Incorporated’s action of knowingly registering the subject marks, despite the aforementioned contractual agreement, was tantamount to trade mark hijacking, which fell outside the scope of acceptable commercial behaviour. Accordingly, the IP Adjudicator concluded that the subject marks had been applied for in bad faith and declared their registrations to be invalid.</p> | |
| <p><i>Harvard Club of Singapore v President and Fellows of Harvard College</i> [2019] SGIPOS 14</p> <p>Note: Appeal Pending</p> | <p>In this interesting dispute, Harvard Club of Singapore crossed swords with President and Fellows of Harvard College (better known as Harvard University).</p> <p>One of the benefits from graduating from Harvard is the alumni network. Access to the official Harvard alumni network is through Harvard Clubs, which (with very few exceptions) only Harvard graduates may join. There are around 200 Harvard Clubs worldwide. Most of them are known as “Harvard Club of [Location]”. All official Harvard Clubs are supported by the Harvard Alumni Association or “HAA” for short.</p> | |



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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|----------------|---|----------------------|
| | <p>For 45 years (since 1969), Harvard Club of Singapore was formally affiliated with Harvard University. But, in 2015, the relationship between the parties came to an end. This milestone event, which formed an important part of the backdrop to the dispute, took place during the time that Dr Irene Lee was President. Dr Lee first took office in November 2011, and she devoted significant time and effort towards improving the club's administration and infrastructure and advancing the interests of Harvard alumni in Singapore. In this regard, she worked closely with the HAA.</p> <p>However, things changed dramatically later on. In April 2014, the HAA indicated that it wanted to see a change of leadership within the club (which meant that Dr Lee would have to step down). Despite this, in November 2014, Dr Lee stood for presidency in the elections and was once again voted in as President. Thereafter, she was accused of breaching HAA rules (one of which said that a President may serve no more than a three-year term). In the months that followed, there were calls from certain quarters within the club for her to call an EGM.</p> <p>Various things happened, but in the end, no EGM was called and Dr Lee remained in office as President. This led to the HAA terminating the relationship in May 2015. As a result, the Club lost Harvard University's permission to use the names "Harvard" and "Harvard Club" (as well as other university trade marks). From that point on, Harvard Club of Singapore was no longer an official Harvard Club. Subsequently, the HAA recognised "Harvard University Alumni Association of Singapore" as the official club for Harvard alumni in Singapore.</p> <p>In December 2014, while the events described above were still going on, Harvard University applied to register two trade marks to cover "club services", namely: (a) "HARVARD CLUB OF SINGAPORE"; and (b) "HARVARD UNIVERSITY CLUB OF SINGAPORE". The Club filed opposition proceedings in response.</p> <p>Briefly, the Club's arguments were that the trade marks should be refused registration because: (a) both marks were applied for in bad faith; (b) the Club's goodwill in relation to its full name "Harvard Club of Singapore" would be damaged if either mark was allowed; and (c) as the Club's full name is still registered on the societies register, any future registration of "Harvard Club of Singapore" by the university as a society name would be refused under the Societies</p> | |



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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|--|----------------------|
| | <p>Act, and therefore, the use and registration of the mark “HARVARD CLUB OF SINGAPORE” would be prohibited by law (that is, the Societies Act) in Singapore.</p> <p>Harvard University’s main defence was structured along the following lines. First, the parties were in a trade mark licensor-licensee relationship between May 1969 to May 2015. Second, although there was no formal signed agreement, an agreement could be implied from the facts and the way the parties conducted themselves. Third, the law in licensor-licensee situations is that unless the parties agree otherwise, by default the licensor owns all of the goodwill, not the licensee. Fourth, as a result, Harvard University owns all of the goodwill connected to “Harvard Club of Singapore”, therefore there cannot be damage to the Club’s goodwill for it has none. Fifth, as the licensor, it was well within the university’s rights to apply for the trade marks in question at any time it deemed fit and there was thus no bad faith involved. Sixth, registration as a society is different from registration as a trade mark, and the Societies Act does not prohibit the use of “HARVARD CLUB OF SINGAPORE” as a trade mark in Singapore.</p> <p>The Hearing Officer agreed with Harvard University’s arguments and allowed the trade mark applications to proceed to registration.</p> | |
| <p><i>Multi Access Limited v Guangzhou Pharmaceutical Holdings Limited</i> [2019] SGIPOS 15</p> <p>Note: Appeal Pending</p> | <p>“王老吉” (the Chinese characters are pronounced “Wang Lao Ji” in Mandarin and “Wong Lo Kat” in Cantonese) is a widely known and popular brand of herbal tea in China first formulated by Mr Wong Chak Bong during the Qing dynasty.</p> <p>Today, “王老吉” herbal tea is produced, marketed and sold by two different companies. Guangzhou Pharmaceutical Holdings Limited sells it in mainland China, whereas Multi Access Limited sells it in Hong Kong. Both parties have trade mark registrations relating to “王老吉” and its derivations and transliterations in numerous jurisdictions around the world. In Singapore, the Opponent, Multi Access, is the registered proprietor of, among other things, “WONG LO KAT” in Classes 5 and 30.</p> <p>The present dispute arose out of Guangzhou Pharmaceutical’s application to register “WONGLO” in Singapore under an international registration in Classes 5, 30 and 32. The</p> | |

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|--|--|----------------------|
| | <p>Opponent relied on its earlier “WONG LO KAT” registration in order to oppose the trade mark application.</p> <p>Ultimately, the Hearing Officer found the competing marks to be more dissimilar than similar overall and the opposition was unsuccessful.</p> <p>Point of interest: Personal full names as opposed to personal names or surnames are better able to distinguish goods and services of one trader from another. Personal full names, when used as trade marks, will automatically imbue the mark with the capacity to distinguish, subject to whether the full name is deemed extremely common or whether it is used in a trade where there is a large number of traders.</p> | [46] – [47] |
| <p><i>Intuit Inc. v Minterest Private Limited</i> [2019] SGIPOS 16</p> | <p>The Applicant, Minterest, applied to register “www.mint.com) and the MINT mobile app.</p> <p>Intuit owned registrations for “MINT” in Classes 9, 36 and 42. Its pleaded case was based on confusing similarity (under s 8(2)(b) of the Trade Marks Act) and passing off (under s 8(7)(a) of the Act). In the assessment, the Hearing Officer found the competing marks “MINT” and “ (1) Such a claim must be pleaded; and (2) The marks relied on as constituting a family must be registered. </p> | [51] |







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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|---|----------------------|
| <p><i>Bavaria N.V. v Bayerischer Brauerbund e.V.</i> [2019] SGIPOS 17</p> <p>Note: Appeal Pending</p> | <p>This is the first case in Singapore where an application for a collective mark has been opposed. Unlike a trade mark, which serves to identify a specific trader as the source of goods (or services), a collective mark can be used by any member of an association designated by the collective mark. The opposed collective mark, “BAVARIAN BEER”, was sought to be registered for “beers” in Class 32 by the Applicant, Bayerischer Brauerbund, an umbrella association for the Bavarian brewing industry in the German Federal State of Bavaria formed in 1880. The Opponent, Bavaria N.V., has brewed beer under the name “Bavaria” in Netherlands since 1930. The following trade marks were relied on as earlier marks by the Opponent:</p> <p>(a) “BAVARIA HOLLAND BEER”, registered for beer in Class 32</p> <div style="text-align: center;">  </div> <p>(b) _____, registered for beer (among other things) in Class 32</p> <div style="text-align: center;">  </div> <p>(c) _____, registered for beer (among other things) in Class 32. (This mark was referred to in the decision as the “Earlier Blue Label Mark”)</p> <p>The Opponent raised the following grounds of opposition: (i) confusing similarity under s 8(2)(b); (ii) passing off under s 8(7)(a); well-known trade marks under s 8(4)(b)(i) and 8(4)(b)(ii).</p> | |

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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|---|--|----------------------|
| | <p>In addition to the above grounds, the Opponent raised Paragraph 4 of the First Schedule (of the Trade Marks Act) as a ground of objection to the application. The provisions in the First Schedule set out additional requirements which a collective mark must comply with, beyond the requirements applicable to trade marks. Para 4(1) provides that a collective mark “<i>shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark</i>”. Para 4(2) states that the Registrar “<i>may accordingly require that a mark... include some indication that it is a collective mark</i>”. One of the Opponent’s argument, was that having regard to its earlier registered trade marks (above), the public would be misled into believing that the “BAVARIAN BEER” application was for a trade mark rather than a collective mark.</p> <p>After hearing arguments, the Hearing Officer decided to exercise the Registrar’s discretion under Para 4(2) of the First Schedule to require that the application mark include an indication that it is a collective mark. Consequently, the application was amended to include the words “Collective Mark” below the words “BAVARIAN BEER”, which had the effect of addressing the objection.</p> <p>In the result, the opposition was allowed under ss 8(2)(b) and 8(7)(a) on account of the fact that the application conflicted with the Earlier Blue Label Mark. (The Hearing Officer did not find the application mark to be similar to the other two earlier marks relied upon by the Opponent.)</p> | |
| <p><i>Aussino International Pte Ltd v Aussino (USA) Inc.</i> [2019] SGIPOS 18</p> | <p>This dispute involved an unsuccessful application for non-use revocation against the following series of marks, registered in Class 24 in respect of “<i>Textiles and textile goods, not included in other classes; bed and table covers; bed blankets; bed clothes; bed covers; bed linen; bedspreads; all included in Class 24.</i>”</p> | |

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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References | | | | |
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| | <div data-bbox="1025 300 1408 520" data-label="Image"> </div> <p data-bbox="562 564 1783 695">One of the key issues that arose in the case was whether the Registered Proprietor’s use of the following variants of the mark amounted to genuine use of the registered mark. The Hearing Officer’s decision was that it <i>did</i> amount to genuine use given that the variants did not alter the distinctive character of the registered mark, which resided in the word component “AUSSINO”.</p> <table border="1" data-bbox="725 730 1615 1362"> <thead> <tr> <th data-bbox="725 730 1189 778">Mark as Used #1⁹</th> <th data-bbox="1189 730 1615 778">Mark as Used #2¹⁰</th> </tr> </thead> <tbody> <tr> <td data-bbox="725 778 1189 1362">  </td> <td data-bbox="1189 778 1615 1362">  </td> </tr> </tbody> </table> | Mark as Used #1 ⁹ | Mark as Used #2 ¹⁰ |  |  | |
| Mark as Used #1 ⁹ | Mark as Used #2 ¹⁰ | | | | | |
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| Case Reference | Selected Issues, Holdings and Comments of Interest | Paragraph References |
|--|---|----------------------|
| <p><i>In the matter of a trade mark application by Ferrero S.p.A. [2019] SGIPOS 19</i></p> | <p>In this ex parte decision, the IP Adjudicator refused Ferrero’s application to register the following mark as a three-dimensional shape mark for “<i>Pastry and confectionery, pralines, stuffed wafer, chocolate and chocolate-based products, ices.</i>” on the basis that it is devoid of any distinctive character.</p> <div data-bbox="1055 469 1375 804" data-label="Image"> </div> <p>In so doing, the IP Adjudicator evaluated the Applicant’s documents and evidence of alleged distinctiveness, but did not regard them as sufficient to support its contention that the application mark itself (as opposed to the word mark “FERRERO ROCHER”) had acquired distinctiveness through use.</p> <p>After all, although there have been very extensive sales to and in Singapore of Ferrero Rocher chocolate products, the evidence showed that the overwhelming majority of such sales were in boxes that featured the word mark “FERRERO ROCHER” on the outside as well as on each of the individually wrapped pralines. And, in all of the promotional/point of sale material where a product could be discerned, the brand “FERRERO ROCHER” was prominently featured.</p> | |

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