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*There have been significant developments in the Intellectual Property landscape of Singapore, and this issue of IP COMPASS® offers our readership an overview of these changes. With the government's initiative to develop Singapore into a Global IP Hub in Asia, the Intellectual Property regime in Singapore has been bolstered by both legislative amendments as well as developments in case law.*

*We hope to provide our readers with an insight into some of the more significant developments of Singapore IPR laws, and highlight the implications of these recent developments for both IPR owners and stakeholders. We have enjoyed compiling this newsletter and hope you find it useful.*

**Katherine Kan**  
Editor  
IP Compass

## **Trademarks – Case Note**

### **THE CONCEPT OF INITIAL INTEREST CONFUSION IN SINGAPORE**

In the recent Court of Appeal judgment in **Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc. and Another [2013] SGCA 65**, the issue of whether the concept of initial interest confusion was part of Singapore trademark law was discussed. The Court of Appeal held that the concept was not part of Singapore law, nor should it be. Confusion which arose in the initial stages of the purchasing process but which was dispelled by the time of the purchase did not constitute confusion for the purpose of section 8(2) of the Trade Marks Act ("the Act"). Under Singapore law, the basis for infringement is more dependent on whether there is origin based confusion, not dilution or misappropriation of goodwill, although these concepts would still be applicable in the case of well-known marks.

The direction set by the Court of Appeal on the issue of initial interest confusion is opportune given the sharp rise in disputes between trademark owners who market their marks over the Internet. It also clarifies this area of law, given that the UK High Court in *Interflora v Marks & Spencer [2013] EWHC 1291* has held that initial interest confusion could be relied on to establish a likelihood of confusion. The

Singapore Court of Appeal has made it clear that they take a different view on this matter.

The facts of the case are briefly provided as follows. Staywell Hospitality Group Pty Ltd ("Staywell"), the Appellant, applied to register the mark "PARK REGIS" in classes 35 & 43. The application was filed on 03 March 2008. Staywell's application was opposed by the Starwood group ("Starwood"), relying on their Singapore trademark registration of "ST. REGIS" in classes 36, 37, 41 & 42. They claimed that the Appellant's application for "PARK REGIS" contravened the registrability requirements of the Act.

**Initial hearing at IPOS** - The initial hearing in the Intellectual Property Office of Singapore ("IPOS"), held that the marks were indeed similar and that there was a real likelihood of confusion as potential customers would be misled into thinking that Staywell's services originated from Starwood's. However, IPOS also found that Starwood failed to prove that there was goodwill in the "ST. REGIS" mark among the general public in Singapore. IPOS' decision was appealed.

**At the High Court** - On appeal to the High Court, the High Court upheld IPOS' decision that the marks, "ST. REGIS" and "PARK REGIS", were on the whole similar. The marks were held to be both aurally and conceptually similar, although visually dissimilar. However, although the marks

were considered as similar, and there was also a similarity of services (since both marks cater for the same nature of services, i.e. hotels), the High Court found that there was *no likelihood of confusion* on the basis that the marks could be readily detached from the hotel itself and any confusion could likely be dispelled either at the point of booking or check in. The High Court decided against IPOS' decision on the issue of whether there was a likelihood of confusion, and found that there was none. In the absence of a likelihood of confusion, the High Court found that there was no likelihood of damage to the "ST. REGIS" mark.

Significantly, the High Court also agreed that there was no goodwill attached to the "ST. REGIS" brand as at 03 March 2008, namely, the date of application of the "PARK REGIS" mark. "*Goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates*", and in the present case there was no evidence that persons who purchased units in the St. Regis Residences did so because of the merits of the services offered by Starwood under the "ST. REGIS" marks.

**In the Court of Appeal** - Starwood appealed against the High Court's decision and took the case to the Court of Appeal in 2013. Starwood was partially successful in the Court of Appeal. Some of the more interesting findings of the Court of Appeal are discussed below:-

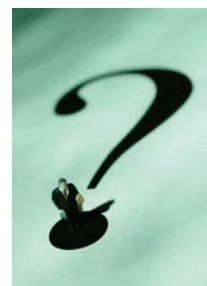
i. On the whole, the marks "ST. REGIS" and "PARK REGIS" were considered as similar. In assessing the respective marks in opposition proceedings, the Court was entitled to have special regard to the distinctive or dominant components of a mark, even while assessing the similarity of the two marks each as composite wholes. This approach will hopefully lead to more sensitive and refined comparisons between disputing marks in trade mark oppositions. In both opposition and infringement proceedings, there should be a step by step approach to the analysis, which allows consumer perception to be part of the analysis.

ii. Where a good or service in relation to which the registration is sought falls within the ambit of a specification in which the incumbent mark has been registered, the goods or services in question are to be regarded *prima facie* as

identical. This indicates that the Court of Appeal was inclined to adopt a broad approach to the concept of similarity of goods and services.

iii. The concept of initial interest confusion is not, and ought not to be, part of Singapore law. Confusion which arose in the initial stages of the purchasing process, but which was dispelled by the time of the purchase, did not constitute confusion for the purpose of section 8(2) of the Trade Marks Act. Policy reasons may be attributed to the limitation of the concept of initial interest confusion in Singapore, as extending the concept, particularly in the context of Internet activity, may result in undue restrictions on advertisements and be seen as anti-competitive. Under Singapore law, the basis for infringement is more related to whether there is origin based confusion, not dilution or misappropriation of goodwill, although these concepts would still be applicable in the case of well-known marks.

**INITIAL  
INTEREST  
CONFUSION**



**ORIGIN  
BASED  
CONFUSION**



iv. Pre-trading activity can generate goodwill. Pre-trading activity need not generate revenue as long as it is directed at generating demand for the plaintiff's business, and the trader shows an unequivocal intention to enter the market.

The decision of the Court of Appeal helps to clarify the applicable principles in trademark opposition cases, particularly on the issue of initial interest confusion.



**Farah Namazie**

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## Patents – Case Notes

### PATENTS AFTER GRANT

#### When are Amendments allowed?

Although a patent has already been granted, amendments to its claims may still be made so long as the amendments will not extend the subject matter disclosed in the original granted patent. A subject matter is deemed as an additional matter if it renders the granted patent materially different from that of the original patent. An application for an amendment after grant is filed by the proprietor and approved at the discretion of the Courts. However, no amendment may be made during the pendency of a proceeding before the Court or Registrar in which the validity of the patent is put in issue. When allowed, the amendment will have a retroactive effect from the grant of the patent.

In the recent case of **Novartis AG and another v Ranbaxy (Malaysia) Sdn Bhd [2013] 2 SLR 117**, the Court has exercised its discretion to allow the amendments of the patent claims and further discussed the guidelines to be considered when deciding whether to allow the amendments to a granted patent. We discuss the case below as follows:-

The facts of the case are briefly described as follows. The defendant, Ranbaxy, sought to import into Singapore the 'starval tablets', the various components of which relates to the plaintiff's (Novartis) registered patent in Singapore. The plaintiff filed an application to render the defendant's application invalid as it would infringe the plaintiff's registered patent. In its defense, the defendant alleged that the plaintiff's patent was invalid because the invention disclosed therein was anticipated by the prior art.

Thereafter, the plaintiff applied for leave to amend its patent claims *"to enhance clarity, to highlight the inventive contributions of the Patent and to reduce the number of claims"*, as well as to *"further distinguish the claims in [the Patent] from the [prior art] cited by the Defendant in its Defence"*.

The issue before the Court was whether the plaintiff may be allowed to amend its patent claims.

The Court held that under section 83(1) of the Patents Act, the Court or Registrar has the discretion to grant an application for amendment of patent claims subject to the following: (i) no amendment is allowed if it results in disclosing any additional matter and (ii) such amendment would extend the protection conferred by the patent (section 84 (3)).

The Court proceeded to discuss the factors to be taken into account when exercising its discretion to allow or disallow a proposed amendment of a patent:-

- a. Whether the patentee had disclosed all relevant information with regard to the amendments;
- b. Whether the amendments were permitted in accordance with the statutory requirements;
- c. Whether the patentee delayed in seeking the amendments, and if so, whether there were reasonable grounds for such delay;
- d. Whether the patentee had sought to obtain an unfair advantage from the patent; and
- e. Whether the conduct of the patentee discouraged the amendment of the patent.

Based on the statutory requirements and the above-mentioned factors, the Court was convinced that the amendments sought would lead to a narrowing of the scope of the patent, and will not further add any additional matter to the existing specification. It therefore allowed the plaintiff to amend its claims.

#### Further and Better Particulars ("FBPs")

In the case of **AstraZeneca AB (SE) v Sanofi-Aventis Singapore Pte. Ltd. [2013] SGHCR 7**, the Registrar tackled the question of whether to allow the defendant's application for FBPs. It was held in this case that patent actions, like any other action, have to contain pleadings which are properly particularized. Moreover, the Court has the power to order parties to give particulars of their pleadings upon such terms as it deems fit and just.

The facts of the case are briefly provided as follows. The defendant, Sanofi-Aventis, had earlier submitted to the Health Sciences Authority ("HSA") for product licenses in respect of its pharmaceutical product, particularly, the

Rosucard Film-coated tablets. Subsequently, the defendant served its Notice to a Proprietor of a Patent to the plaintiff, AstraZeneca – the owner of a granted Singapore patent SG 89993 for “Pharmaceutical Compositions Comprising a HMG COA Reductase Inhibitor”.

On 14 December 2012, the defendant brought an application to seek for the plaintiff’s FBPs for its Statement of Claim in Patent Infringement Proceedings, pursuant to O18 r 12 (3), and O 87A r 2 of the Rules of Court. The plaintiffs responded that the defendant was not entitled to the particulars sought. Hence, the issue on whether the defendant’s application for FBPs should be allowed.

The Registrar revisited the ‘Novartis judgment’ and held that the present case was similar to the *Novartis* case, based on the following grounds:-

1. Similar to *Novartis*, the present case involved a pharmaceutical patent and the precise patent infringement(s) might not be easily observable without the conduct of experiments.
2. The experiments were often very costly, as such, particularization at an early stage would avoid costs of misdirected and inadequate experiments.
3. The present case also involved a patent infringement claim under the Medicines Act which would trigger a 30-day moratorium if an action for prospective infringement was applied for. The availability of a moratorium could be used to hinder access by the public to the competitor’s products.

For the above reasons, the Registrar held that the application for FBPs is valid and that the provision of more particulars at an earlier stage of the proceedings may be necessary in exceptional cases, such as the present case. Moreover, where a claim has serious consequences to the public and to a defendant’s legitimate business, as a matter of good practice, the plaintiff should be required to give proper particulars of its claim.

The Registrar further discussed that it is necessary for patent actions to contain pleadings which are properly particularized. In addition, for patent infringement claims, a

specific type of particularization is required, i.e. “*the plaintiff in such actions must serve with his statement of claim particulars of the infringement relied on, showing which of the claims in the specification of the patent are alleged to be infringed and giving at least one instance of each type of infringement alleged*” (O 87 A, r 2(2)).

Out of the defendant’s 7 requests for FBPs, 5 were allowed and 2 were disallowed by the Registrar on the basis that they would not directly affect the experiments.

## Designs 101

The Singapore Designs Registry of the IPOS is tasked to oversee the registration of designs applications. A design registration protects the aesthetics or the external features of an article. Prior to filing a design application, one must ensure that the article is new and that the design can be applied to a certain article.

The designs system in Singapore operates on a first to file basis. Hence, it is important to file your design application as soon as possible.

In order to file a design application in Singapore, the following documents are required:-

- a. Drawings or photos of the design (best, left, right, top, bottom, front and back views) of up to a maximum of 10 representation, each representation must be at least 3 cm by 3 cm in size and no larger than 13 cm by 15 cm (one set per design application is sufficient);
- b. Statement of Novelty, describing the features of the design which the applicant considers to be new;
- c. Classification no. and Sub-Class no.; and
- d. Application form (Form D3).



**Glendoris R Ocampo**  
**Patents & Trademark Executive**

For more information on patents and designs application, you may wish to contact Glen at [ocampo@namazie-law.com](mailto:ocampo@namazie-law.com).

## **Recent Developments in IP Law**

In the recent years, the government has made several key developments in its IP Regime, such as the enactment of the Personal Data Protection Act ("PDPA") and the introduction of the Geographical Indications Registry. These developments will be discussed in more detail below.

### **PERSONAL DATA PROTECTION ACT ("PDPA")**

The most notable development in IP law in the recent years is the enactment of the PDPA. The PDPA takes into account of three main concepts, namely, (i) consent, (ii) purpose and (iii) reasonableness.



The purpose of PDPA is to balance the rights of individuals to protect their personal data and the commercial needs of organisations to use personal data. The Personal Data Protection Commission ("PDPC") was set up on 2 January 2013 to administer and enforce the PDPA by issuing advisory guidelines and maintaining the Do Not Call Registers ("DNC"). The other main provisions on data protection rules will come into force on 2 July 2014 to allow the organisations to have more time to comply with the statutory obligations.

### **Definitions**

i. **Personal Data** – Personal data is defined as data capable of identifying the individual, or other related information which organisations have or are likely to have access to. The protection of personal data under the PDPA extends to individuals who are living and deceased for less than ten years. Protection under the PDPA does not extend to non-individuals such as companies.

ii. **Organisations** – Organisations include individuals carrying on businesses in Singapore, corporate bodies and unincorporated bodies, having a place of business in Singapore or formed in Singapore.

Personal data collected before 2 July 2014 will remain valid unless the individual withdraws his/her consent to collect, use or disclose the personal data.

### **Obligations of Organisations**

Organisations can collect, use or disclose personal data, if the following obligations have been complied with:-

i. **Consent Obligation** – Organisations have to obtain the individual's consent in order to collect, use or disclose personal data about that individual, unless the individual is deemed to have given his/her consent, or that no consent is needed as it falls under the exceptions of the PDPA. Consent is deemed to be given in two situations: (i) when an individual voluntarily provides his/her personal data to the organisation for a specific purpose and that it is reasonable for the individual to do so, or (ii) when the individual has consented to the disclosure of his/her personal data by one organisation to another organisation for a specific purpose, the individual is deemed to have consented to the collection, use or disclosure of his/her personal data by that other organisation.

The PDPA has provided several situations in the Second, Third and Fourth Schedule where organisations need not obtain consent from the individual for the collection, use or disclosure of personal data.

ii. **Purpose Limitation Obligation** – Individuals must know the exact purpose for which their personal data is being collected, used, or disclosed.

iii. **Notification Obligation** – Organisations have to notify the individuals of the purposes for which the personal data is being collected, used or disclosed.

Organisations have to comply with the above three obligations when handling customers' and employees' personal data on a daily basis. In order to comply with the

aforementioned obligations, organisations may require the individuals to sign a standard consent form, which seeks the individual's consent for collecting, using or disclosing the personal data for a specific purpose.

**iv. Access and Correction Obligation** – An individual can request for access to be granted to his/her personal data, and the organisation will have to disclose how the individual's personal data has been used for the past one year. However, this only applies to reasonable requests made. An individual can also request for erroneous personal data to be corrected. This is not applicable to "opinion data", i.e. an employee's termination report. In order to comply with this obligation, organisations will have to set up a formal procedure to handle these requests.

**v. Accuracy Obligation** – Organisations must take reasonable efforts to ensure that personal data collected is accurate.

**vi. Protection Obligation** – Organisations have the obligation to protect all personal data given to them and have to make reasonable security arrangements to protect the personal data, such as designing and organising security arrangements to protect the personal data from any harm that might result from a security breach.

**vii. Retention Limitation Obligation** – Once the purpose for which the personal data was collected is no longer being served, organisations must remove, delete or erase the documents containing personal data or anonymise the personal data.

**viii. Transfer Limitation Obligation** – Organisations which have headquarters overseas must be careful when transferring personal data out of Singapore, as the data can only be transferred if the destination provides same standard of protection as given under the PDPA.

**ix. Openness Obligation** – Organisations need to be open about their policies and practices on data protection, including the complaints process available to the public upon such request.

### **Do Not Call ("DNC") Registry**

Individuals who wish to stop receiving unsolicited marketing messages from organisations can register their numbers with the DNC Registry, which consists of three registers, namely, "No Voice Call", "No Text message" or "No Fax".



Organisations have to register with the DNC Registry to access the DNC registers to check that the numbers they are contacting are not registered on the relevant registers, unless the individuals have given clear and unambiguous consent in written or other accessible form.

The purpose of the DNC Registry is to prevent unwanted telemarketing calls or messages of a commercial nature from being sent to consumers. Thus, the DNC Registry does not cover messages sent by individuals in a personal capacity. Any message for conducting market research or market survey is also not covered. Organisations can also make telemarketing calls or messages of a commercial nature to businesses.

### **Editor's Note**

Individuals need to make sure that they know who they are giving their personal data to and the purposes for which the personal data will be used.

Organisations need to ensure that there are mechanisms set up to comply with the PDPA. The PDPC has also issued sector-specific guidelines to address unique issues pertaining to sectors which are more affected by these rules, such as the real estate and the telecommunications sectors. Organisations need to ensure that they have complied with the obligations under the PDPA strictly, as non-compliance may attract hefty fines and/or criminal charges.

## GEOGRAPHICAL INDICATIONS (“GIs”)

In order to ratify the European Union-Singapore Free Trade Agreement, the GI Bill (“the Bill”) was passed on 14 April 2014 by the Singapore Parliament.

The Bill introduces a GI Registry, of which the registration system will be similar to the trade mark registration system, namely, (i) **application**, (ii) **examination**, and (iii) **publication and opposition**. Although registration of GIs is not compulsory and the unregistered GIs will continue to have the same level of protection as they currently enjoy, it is advisable for GI owners to file applications for their GIs promptly, as registration of their GIs will be *prima facie* evidence of the validity of their GIs in legal proceedings.

Registered GIs will also have a larger scope of protection compared to unregistered GIs, such as improved border enforcement measures. A registered GI owner in Singapore will be able to request the Singapore Customs authorities to detain products bearing the infringing GI mark from entering into Singapore or exporting out of Singapore.

## PLANT VARIETIES

Singapore has amended the Plant Varieties Protection Act (Cap 232A) (“the Act”) to ratify the UPOV Convention by the 10<sup>th</sup> year of its accession (i.e. July 2014).

Under the amendment, the varieties of plants protectable under the Act expanded from 16 varieties to **all plant genera and species**. After the plant variety has been granted protection in Singapore, the grantee will have the right to take proceedings against any infringement of his/her registration.

The above discussions portray the efforts of the Singapore government in enhancing the IP regime of Singapore. By aligning itself with more established IP regimes in the world, Singapore will move closer towards its goal of successfully developing itself into the Global IP Hub of Asia.



**Katherine Kan**

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## About Namazie & Co.

**IP COMPASS®** is a publication of **Namazie & Co**, an Intellectual Property and Technology law firm. Rated as one of the top ten IP practices in Singapore by Asia - Pacific Legal 500 for over a decade, we offer our clients comprehensive and personalized guidance of the intricacies of Intellectual Property and Technology law protection in Asia. Our international team comprises IP and technology professionals, with expertise and experience in a wide range of legal, commercial and technical issues.

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*May maintains our database and mailing lists for this Newsletter, as the Data Protection Officer, and the Editorial team wishes to acknowledge her excellent work and coordination in helping us get this publication to you. You can contact May at [may@namazie-law.com](mailto:may@namazie-law.com) or [general@namazie-law.com](mailto:general@namazie-law.com).*

*The Personal Data Protection Act (“PDPA”) will take effect from 2 July 2014, governing the collection, use, disclosure and care of personal data.*

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