

IPOS Decisions 2020: 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/disputes/legal-decisions>
- (2) We have a mailing list where we provide updates on recent IPOS decisions. To join, please contact ipos_hmd@ipos.gov.sg.

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IPOS CASES IN 2020

Case Reference	Selected Issues, Holdings and Comments of Interest	Paragraph References
<p><i>Teraoka Seiko Co., Ltd v Digi International Inc.</i> [2020] SGIPOS 1</p>	<p>The parties to this trade mark opposition had both used “DIGI” marks in the course of their respective businesses for some time. The parties were not only familiar with each other but had even previously entered into a settlement agreement in 2002 to resolve trade mark disputes in Germany and worldwide in respect of certain “DIGI” marks.</p> <p style="text-align: right;">  </p> <p>Central to this dispute was Digi International’s application to register  as a trade mark for a wide variety of goods in Class 9 and services in Classes 38 and 42. Teraoka opposed, relying on bad faith under s 7(6). The essence of its case on bad faith was that Digi International had sidestepped the terms of the 2002 agreement. However, the IP Adjudicator was not persuaded of this on the facts and did not allow the opposition on this ground.</p> <p>Teraoka also raised various relative ground objections premised on an alleged conflict with its earlier  trade mark under ss 8(2)(b), 8(4)(b)(i) and 8(7)(a) of the Trade Marks Act. After consideration, the IP Adjudicator agreed, finding the competing marks to be similar, the respective goods/services to be similar, and that there would be a likelihood of confusion. She also found Teraoka’s  mark to have been well known to the relevant sector in Singapore.</p> <p>Ultimately, the opposition was allowed on all grounds except for bad faith (s 7(6)).</p> <p>Note: the decision has been appealed to the High Court.</p>	
<p><i>Seek Limited v Seek Asia Pte Ltd.</i> [2020] SGIPOS 2</p>	<p>This was a case wherein the Registrar exercised his discretion under rule 37(4) of the Trade Marks Rules (Cap. 332, 2008 Rev Ed) to allow a trade mark opposition without proceeding with a full substantive hearing.</p>	


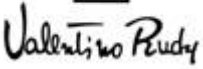



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	<p>The Applicant was unresponsive in the advanced stages of the opposition. The hearing officer relied on a relevant High Court decision, which held that the Applicant’s use of the Application Mark infringed the Opponent’s copyright, to similarly find in favour of the Opponent.</p>	
<p><i>Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel</i> [2020] SGIPOS 3</p>	<p>In this case, the owner of the trade mark “VAGISIL” (registered in Classes 3 and 5) succeeded in obtaining a declaration of invalidity against a registration for “VAGISAN” (also registered in classes 3 and 5).</p> <p>Note: the decision has been appealed to the High Court.</p>	
<p><i>Discovery Communications, LLC v A-STAR-Education Discovery Camps Pte. Ltd.</i> [2020] SGIPOS 4</p>	<p>This was a trade mark opposition by Discovery Communications, LLC—the owner of the trade mark  —against an application to register  . The opposition was unsuccessful.</p>	
<p><i>Florian Mack v Golden Cala Trading EST.</i> [2020] SGIPOS 5</p>	<p>This was a successful opposition by Mr Florian Mack against Golden Cala’s application to register “LENS ME” (stylised) in Class 9 for contact lenses. The opposition succeeded on the passing off ground (s 8(7(a) TMA), but not on the bad faith ground (s 7(6) TMA). The mark used in connection with Mr Mack’s business (that of an online store selling contact lenses) was also “LENS ME” (stylised).</p> <p>Interestingly, the opponent had approximately 74 actual customers in Singapore and the opponent’s business was conducted solely over the internet via an online store (the goods being shipped from outside of Singapore). The question was whether this was enough evidence to support a finding of goodwill (which is the first element in the tort of passing off).</p> <p>In arriving at his conclusion that there was sufficient goodwill, the hearing officer observed that despite the modest nature of the business in Singapore, the key point was that there were in fact customers in Singapore who had placed orders and received their goods; moreover, a number of them had made repeat purchases.</p>	<p>[38]-[41]</p>




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<i>Rolex S.A. v FMTM Distribution Ltd</i> [2020] SGIPOS 6	This dispute was between two established companies in the watch industry. FMTM (of the Franck Muller group) applied to register “MARINER” in Class 14 in respect of watches and other goods. The trade mark application was opposed by Rolex, based on its earlier trade mark registration for “SUBMARINER”—registered since 1959 in Class 14 for horological instruments (i.e. watches). The IP Adjudicator found that the respective marks and goods claimed were similar visually, aurally and conceptually, and that there was a likelihood of confusion. Rolex succeeded in the opposition.	
<i>Application for Extension of Time to File Counter-statement by FCA US LLC</i> [2020] SGIPOS 7	<p>In this case, the hearing officer granted FCA US LLC—a trade mark applicant which faced a deadline to file its counter-statement in the context of trade mark opposition proceedings—an extension of time under Rule 77C of the Trade Marks Rules.</p> <p>Rule 77C, which took effect on 5 June 2020, was one of the new legislative amendments enacted against the backdrop of the present global pandemic. In brief, it allows the Registrar to grant an extension of time limits where the Registrar is of the opinion that there are circumstances beyond the control of a party concerned or other special circumstances. This case was the first time that Rule 77C was invoked.</p> <p>The decision makes clear that in deciding whether to grant such an extension (and if so what length of extension to grant) some relevant factors include: (a) the actual circumstances faced and how they affected the party’s ability to take the requisite steps before the deadline; (b) the duration of the extension requested; (c) the extent of prejudice, if any, to the other party; and (d) whether the applying party would be able to make a request for an extension the usual way without an applicable fee.</p>	[18]-[19]
<i>Valentino S.p.A. v Matsuda & Co</i> [2020] SGIPOS 8	This was an unsuccessful trade mark opposition commenced by Valentino S.p.A. (owner of the following trade marks: (a)  ; (b)  ; and (c)	

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	 <p>VALENTINO) against  . The IP Adjudicator found that the relevant marks were not similar.</p>	
<p><i>Compagnie Des Montres Longines, Francillon S.A. (Longines Watch Co., Francillon Ltd.) v POINT tec Products Electronic GmbH [2020] SGIPOS 9</i></p>	<p>This was a trade mark opposition where Longines was unsuccessful in opposing Point Tec's trade mark application (in Class 14 for watches). In arriving at her conclusion that the opposition should be dismissed, the hearing officer found the competing marks to be more dissimilar than similar overall. The competing marks are set out below.</p> <p>Point Tec's application mark:  ; Longine's earlier trade mark: </p>	
<p><i>Comité Interprofessionnel du Vin de Champagne and Institut National de l'Origine et de la Qualité v Keep Waddling International Pte. Ltd. [2020] SGIPOS 10</i></p>	<p></p> <p>In this case, the latter applied to register "Sparkling wines, all originating from Chile" in Class 33 and the opponents (namely: (a) a French trade association representing the Champagne geographical indication; and (b) a French public administrative institution) filed collectively to oppose the registration. Four grounds of opposition were raised: (1) that the application mark was deceptive; (2) that the application mark would violate the Geographical Indications Act; (3) that the use of the application mark would constitute the tort of passing off; and (4) that the application mark was applied in bad faith.</p> <p>The hearing officer allowed the opposition on the ground that it had been applied for in bad faith but was not persuaded that the other three grounds of opposition were sufficiently made out.</p>	



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	<p>On the opposition under s 7(4)(b) of the Trade Marks Act, which prevents the registration of deceptive marks, the hearing officer summarized the applicable legal principles, before applying these to the facts of the case.</p> <p>The hearing officer also considered the issue of whether a trade mark “contains or consists of a geographical indication” within the meaning of s 3(4) of the Geographical Indications Act and s 7(7) of the Trade Marks Act. In his view, the relevant component of the trade mark must: (a) reproduce, without any modification or addition, all the elements constituting the geographical indication; or (b) viewed as a whole, contain differences so insignificant that they may go unnoticed by an average consumer.</p>	<p>[18], [19]-[32]</p> <p>[43]-[63]</p>
<p><i>Damiani International BV v Dhamani Jewels</i> DMCC [2020] SGIPOS 11</p>	<p>This trade mark opposition dispute was between two parties which use their family names as trade marks in the jewellery business.</p> <p style="text-align: center;">  </p> <p>The mark sought to be registered was  (in Classes 14 and 35). The Opponent, Damiani, relied primarily on its earlier registration for the stylised Damiani trade mark</p> <p style="text-align: center;">  </p> <p>in Class 14, as follows: . The opposition ultimately succeeded under s 8(2)(b) of the Trade Marks Act (which some refer to as the “confusing similarity” ground of opposition) as well as s 8(7)(a) of the Trade Marks Act (that is, passing off).</p> <p>However, the opposition did not succeed under s 8(4)(b)(i) (which relates to well known trade marks) because the Opponent’s evidence disclosed use of the plain word marks “DAMIANI” but not the stylised registered mark and the IP Adjudicator was not persuaded that the stylised mark relied on was well known in Singapore at the relevant date.</p>	

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	The IP Adjudicator also considered the issue of partial oppositions and came to the conclusion that the tribunal is not required, and does not have the authority, to grant partial oppositions whether or not they arise within the context of a single class or in multi-class applications.	[66]
<p><i>Application to File Notice of Opposition in a Geographical Indication Application by Bavaria N.V. and Objection Thereto by Bayerischer Brauerbund E.V. [2020] SGIPOS 12</i></p>	<p>This decision concerned an interlocutory hearing in the context of an opposition (filed by Bavaria B.V.) against Bayerischer Brauerbund E.V.'s application to register "BAYERISCHES BIER" as a geographical indication.</p> <p>The issue for determination in the interlocutory decision is the requirements for a successful filing of a notice of opposition under the Geographical Indications Rules (GIR). Specifically, should the notice of opposition be allowed as long as all the procedural requirements for filing have been complied with? Or is it also necessary to examine whether the grounds relied on would, if established, be sufficient to succeed in the opposition?</p> <p>The hearing officer was of the view that</p> <ul style="list-style-type: none"> (i) The substantive merits of the Applicant's objections, that is, whether the opposition should be directed at the Geographical Indication (GI) itself, and not a translation of the GI, should be dealt with at a full hearing (rather than at interlocutory hearing intended to resolve <i>procedural defaults</i>). (ii) A notice of opposition should be allowed as long as all the procedural requirements for the filing of a Notice of Opposition as per the GIR have been complied with. <p>In this case, Rule 28 of the GIR, has been complied with here. Specifically, the subject matter of the Opposition has been duly identified in the statement of grounds (which is the English translation of the subject GI) and that is all that is necessary for compliance with Rule 28(1) of the GIR.</p> <p>In the result, the hearing officer accepted the notice of opposition and allowed the proceedings to continue to the next stage.</p>	

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<p><i>Weider Global Nutrition, LLC v Morinaga & Co., Ltd.</i> [2020] SGIPOS 13</p>	<p>Weider Global Nutrition filed a trade mark opposition against Morinaga & Co's application to</p>  <p>register (series of two marks) in Classes 5 (for dietary and nutritional supplements and meal replacement bars) and 30 (for confectionery and related products).</p> <p>The main trade marks relied on by the opponent, Weider, were as follows:</p>  <p>and "IN" (all registered in Class 32).</p>	

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	<p>After evaluating the competing trade marks, the hearing officer arrived at the conclusion that: (a) Weider’s composite marks were dissimilar to the application mark; and (b) Weider’s “IN” word mark had an “above average” degree of similarity to the application mark.</p> <p>She also found that the goods in question were similar (even though they were registered in different classes), and that there would be a likelihood of confusion. In so doing, the hearing officer took into consideration the fact that the “IN” word mark was registered for “non-alcoholic protein and/or carbohydrate drinks”, which have similar uses to nutritional/dietary supplements (for which registration was sought under the application mark in Class 5). Ultimately, the opposition was allowed under s 8(2)(b) of the Trade Marks Act. (Various other grounds of opposition were also raised and considered, but ultimately were unsuccessful.)</p>	
<p><i>In the Matter of a Trade Mark Application by Yitai (Shanghai) Plastic Co., Ltd. and Opposition Thereto by Charlotte Pipe and Foundry Company [2020] SGIPOS 14</i></p>	<p>This trade mark opposition was commenced by an American company (“the opponent”) established in 1901 against the registration of a mark by a Chinese company (“the applicant”) established a hundred years later. Both parties are in the business of manufacturing pipes and fittings.</p> <p>CHARLOTTE, the trade mark in issue, was sought to be registered in Classes 17, 19, and 20. The following three grounds of opposition were raised: s 8(2)(b), s 8(4)(b)(i), and s 8(7)(a) of the Trade Marks Act.</p> <p>The opponent relied on the registered mark CHARLOTTE PIPE as well as three unregistered marks: (1) CHARLOTTE PIPE; (2) CHARLOTTE; and (3) CHARLOTTE PIPE AND FOUNDRY COMPANY. However, the registered mark was not an “earlier trade mark” since it had a later priority date as compared to the application mark. Furthermore, the IP Adjudicator found that the unregistered marks were not well known in Singapore as at the relevant date for the assessment. Consequently, the opposition under ss 8(2)(b) (which is based on conflict with an “earlier trade mark”) and 8(4)(b)(i) (which requires the opponent to show that it has an earlier trade mark that is well known in Singapore) was unsuccessful.</p>	

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	Nevertheless, the opposition was successful under s 8(7)(a): the passing off ground of opposition. Notably, on the element of misrepresentation, the IP Adjudicator found that the Applicant had deliberately copied the opponent's trade mark with the intention to deceive customers or to pass off the applicant's goods as being that of the opponent's.	

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