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CASE NOTE – TRADE MARKS

Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd [2009] SGCA 9

The 1st defendant, Qinghai Xinyuan Foreign Trade, owned a 'Rooster' trademark in Singapore and China covering cordyceps, a type of mushroom used for Chinese traditional medicinal purposes. It granted an exclusive licence of the trademark to Yu Ceng Trading, the 2nd defendant, in 2005. Yu Ceng Trading sought and obtained criminal search warrants against the plaintiff, Wing Joo Loong, under the Trade Marks Act to seize cordyceps bearing a mark similar to the 'Rooster' trademark.

The plaintiff applied to revoke the registration of the 'Rooster' trademark on the grounds of non-use, or that it had become customary to the trade or that it was devoid of any distinctive character and had no "capacity to distinguish". It also sought a declaration that any copyright in the trademark was not owned by either the 1st or 2nd defendant and that the plaintiff had not infringed the copyright.

The High Court found that the term "rooster cordyceps" was not seen by the public as being synonymous with cordyceps and hence did not agree that the term had become "..*customary in the current language or in bona fide and established practices of the trade*." But the court was satisfied that the term was used by other parties in Singapore and had become known, at the time of application for registration of the mark, as denoting cordyceps from China. Accordingly, the court found that the term lacked capacity to distinguish.

On appeal, the Court of Appeal did not agree that the evidence showed that the public had associated the term with cordyceps generally or with cordyceps from China, in the sense of a name commonly used to denote a particular type, kind or characteristic of goods. The court found that the term remained capable of distinguishing the trademark owner's cordyceps from those of other traders because of the distinctive "rooster flower" device. The court cited and applied *Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 2,* where the court clarified that that a trademark's capacity to distinguish must arise from the inherent features or characteristics of the mark itself. The court also noted that even if more than one party is entitled to use a particular mark for the same product, that would does not by itself indicate that the mark is incapable of distinguishing the various sources of the product. In such situations, the mark still functions as a badge of origin. The mere fact that a trademark is popular or even used to market a particular product does not *ipso facto* render that mark generic. Nor would that mean it constitutes "customary in the current language or established practices of the trade". Accordingly, the Court of Appeal found that the term was sufficiently distinctive, rather than descriptive, and that the registration was valid.

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In relation to the issue of genuine use, the Court of Appeal opined that it should refrain from applying a single objective formula but rather, consider the facts of each individual case, such as the commercial volumes undertaken, length of the period during which the mark was used and the frequency of use. There was also no presumption that *de minimis* use should be disregarded. Rather, small or limited the use of a mark could suggests that the use is colourable or non-genuine. Genuine use of the mark should be proved by solid and objective evidence of effective and sufficient use of the mark in the market concerned, applying the ECJ decision in *La Mer Technology (2008) ETMR 9.* The court went on to find that the sales made by the exclusive licensee were genuine and not insubstantial and hence the claim for non-use failed.

Bad faith & misrepresentation

The test to be applied in ascertaining bad faith was whether there was any relevant conduct that fell short of normally-accepted standards of commercial behavior and knowledge of facts which would have led an ordinary honest person to conclude there was a breach. The court held that the grounds of fraud or misrepresentation in section 23(4) Trade Marks Act only apply to the original registration, not registration of assignments of the mark. If there was fraud or misrepresentation in subsequent transactions, recourse would be by way of other civil claims. In any case, the court also found that in any case, assuming s. 23(4) applied to subsequent transactions, the plaintiff failed to discharge its burden of proving fraud and misrepresentation.

Discretion not to grant relief

Whilst the court found it unnecessary to consider whether it has a residual discretion to refuse relief as the grounds for revocation and invalidation had not been established, it proceeded to comment *obiter* that the power of revocation or invalidation in the Trade Marks Act did not include or confer any residual discretion on the court or registrar not to revoke or invalidate a registration where the grounds of invalidation and revocation have been established. Since the function of a trademark is to provide the proprietor with a monopoly over the use of the mark, there was no discretion to retain the mark on the register once those grounds are established. However the court added that even if it was wrong on this point, the court below had taken the correct approach in deciding how its discretion should be exercised.

Chai Chyau Ling (trading as Racetech Auto) v. Racing Technology Pte Ltd [2009] SGHC 105

The plaintiff operated a business in the name of 'Racetech Auto' and had been using 'Racetech' as its trade name for over 20 years. She also registered 'RACETECH' as a trade mark in October 2006. The defendant operated a business known as 'Racing Technology Pte Ltd' and used a logo comprising the word 'RACE TECH', in a typeface similar to the registered trade mark. It also used a domain name and email address which included the words "RACE TECH". The plaintiff brought an action for infringement and passing off.

Trade Mark Infringement

The court affirmed the following principles in an action for infringement:

> The confusion must arise from the similarity between the offending sign and the trade mark, and relate to or concern usage on similar goods and services.
>
> Following the Court of Appeal decision in *The Polo/Lauren Co. LP v. Shop-In Department Store Pte Ltd* [2006] 2 SLR 690, similarity between the marks does not automatically mean that there will be a likelihood of confusion. The likelihood of confusion on the part of the public must be shown to arise from the similarity between the marks.
>
> The court is entitled to look beyond intrinsic factors in determining whether there would be confusion on the part of the public.

While the court agreed that the criterion of whether competing marks are "identical" must be interpreted strictly, a sign remains identical to the registered mark if the differences are so insignificant they would be unnoticed by the average customer. Similarities will also be considered in terms of visual, aural or phonetic, and conceptual similarities. Racing Technology argued that its logo was dissimilar to the registered trade mark due to differences in typefaces, colors and spacing. The court did not agree and observed that the differences between the marks were insignificant. The average consumer would not have an opportunity to make a direct comparison between the marks and notice the differences. The marks were derived from the same words and spelt identically. The distinctive feature of the trade mark is the combination of words "RACE" and "TECH". The differences in colour and typeface were also immaterial, since what remains distinctive in a word mark is the word itself. In any case, even if the marks were not identical, the visual similarity was compelling and there was a likelihood of confusion on the part of the general public, and not just car enthusiasts. The court cited with approval the approach in *Nation Fittings (M) Sdn Bhd v. Oystertec Plc and Another Suit* [2006] 1 SLR 712, that the average consumer is not necessarily extended in all cases to the general public, but can be limited to that portion of the general public which has an interest.

Passing Off

The court similarly found for the plaintiff under the claim for passing off. It found that there was sufficient goodwill in the plaintiff's business, notwithstanding the modest amounts spent on advertising, given that the business was profitable and running for more than 20 years. The court also found that the offending logo could pass of as the trade mark as the differences were minor. It was also probable that the plaintiff would have suffered some damage, given the likely lower level of expertise of the defendant and possible diversion of custom.

Kickapoo (Malaysia) Sdn Bhd and Another v The Monarch Beverage Co (Europe) Ltd [2009] SGCA 63

This is an interesting case which illustrates the interplay between contractual breach and infringement of trade marks and passing-off.

The plaintiff, The Monarch Beverage Company (Europe) Limited, is the registered proprietor of two trade marks in Class 32, 'KICKAPOO JOY JUICE' and 'KICKAPOO', for non-alcoholic beverages and juices. Monarch acquired rights in 1996 to the trade marks and the business from The Monarch Company Inc ('TMCI'), an American company. The 1st defendant was Kickapoo (Malaysia) Sdn Bhd ("KM"), a Malaysian company which was granted an exclusive licence to produce 'Kickapoo Joy Juice" soda in cans and PET bottles in Malaysia and Singapore by TMCI. The 2nd defendant, Kickapoo Beverage Pte Ltd ("KB"), is KM's subsidiary in Singapore.

In 2002, Monarch granted a licence to Heng Seng Company ("HSC") to manufacture and sell Kickapoo beverage in Shanghai ("the Shanghai licence"). HSC was the sole distributor of KM for Kickapoo beverage in Singapore. Shortly thereafter, Monarch informed KM that 'Kickapoo Joy Juice" beverage base concentrates would be sold to KM at an increased price of over 900%. This commercially made it unfeasible for KM to continue producing 'Kickapoo' soda. Although KM was contractually required to purchase beverage bases from approved sources, the price increase prompted KM to purchase the soda bases from unauthorised sources. Monarch relied on this to terminate the licence agreement in 2005 and appointed HSC as the new bottler and distributor of 'Kickapoo' soda drinks for the Singapore. Monarch also sued KM for trade mark infringement and passing off for using unauthorised beverage bases.

Trade Mark Infringement and Passing Off

S.27(1) Trade Marks Act provides that a person infringes a registered trade mark if, *without the consent of the proprietor of the trade mark*, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered. Since KM was purchasing Kickapoo concentrates from unauthorised suppliers, the court found that the use of 'Kickapoo' was without the consent of the proprietor and amounted to trade mark infringement and passing off. KM claimed to be mitigating their damage arising from the breach of contract by Monarch by sourcing alternative suppliers of concentrates, but since it had in fact affirmed the contract (and not accepted the breach), this argument did not succeed.

Breach of Licence Agreement and Conspiracy

Monarch claimed that it had sought to terminate the licence agreement on various occasions, for failure to furnish monthly reports, construct a bottling plant on time and use of unauthorized concentrates. The court found that the latter breach justified termination of the licence agreement. KM also counterclaimed for breach of the licence agreement by Monarch. The court considered the alleged acts of breaches prior to the termination in 2005 and concluded that Monarch had breached the agreement by failing to supply some quantities of concentrates to KM.

KM also alleged the tort of conspiracy by Monarch and HSC as they had wrongfully sought to terminate the licence agreement and the distributorship agreement between KM and HSC. The court agreed that the Shanghai licence given to HSC was in fact a sham and all 'Kickapoo' drinks produced under the Shanghai licence were in fact sent to Singapore. Accordingly, Monarch and the 2nd to 5th defendants involved were held to commit the tort of conspiracy by unlawful means. The defendants appealed to the Court of Appeal.

Decision of Court of Appeal

The first issue on appeal was whether KM was entitled to be excused from trade mark infringement on the ground that Monarch was in breach of contract and had conspired to injure KM. The Court of Appeal found that trade mark infringement and the contractual infringement were two independent legal wrongs and one could not be used to justify or amounted to a defence of the other. Neither could KM claim that its acts of infringement should be regarded as acts towards mitigating damage.

The second issue was whether there was in fact passing off, on the basis that there was no misrepresentation as to the quality of the beverages, authority and/or trade source. The Court of Appeal agreed there was no deception since the unauthorised concentrates were in fact made using the original 'Kickapoo' formula.The misrepresentation however arose from deceiving the public that KM's 'Kickapoo' drinks were produced under the authorisation of Monarch, which was stated on can and PET labels. The public would have made the incorrect inference that the quality of KM's 'Kickapoo' product had been approved by Monarch. Accordingly, the claim in passing was made out and the appeal dismissed.

CASE NOTE - COPYRIGHT

RecordTV Pte Ltd v MediaCorp TV Singapore Pte Ltd and Ors [2009] SGHC 287

The plaintiff was the owner and operator a website service called "RecordTV". The website enabled registered users to select television programmes, aired on free-to-air channels by the defendants, for later viewing. The programmes would be downloaded and stored on the plaintiff's servers for later access by the registered users. This service is commonly referred to "time-shift" recording. The defendants issued cease-and-desist letters to the plaintiff claiming copyright infringement. The plaintiff then responded by commencing an action for groundless threats of infringement, which prompted the defendants to sue for infringement. The issues that the High Court had to deal with were whether the plaintiff was liable for communicating the free-to-air programmes to the public and if found liable, whether the plaintiff can rely on any safe harbour or fair dealing provisions.

Direct Infringement

The claim for copyright infringement revolved around the issue of who was responsible for the acts of reproduction of the programmes. The plaintiff argued that the actual maker of the copies was the end-user, and not the plaintiff, who merely provided the means of recording. Section 103 Copyright Act defines infringement of a television broadcast to be the doing or authorising the doing in Singapore of any act comprised in the copyright.

The High Court found that automation of a process did not fundamentally alter the fact that the process of copying was initiated via a "voluntary human agency". Unlike the case of a video recorder, which gave its makers no control over how it would be operated, the RecordTV website was clearly devised for the purpose of reproduction, even if facilitated through an automated process. The court did not agree with the decision in *Cartoon Network LP v CSC Holdings Inc 536 F 3d 121* (2nd Cir 2008), which had found that that consumers undertook the copying and were the direct infringers, since consumers decided what programs will be copied and transmitted for later viewing and the remote recorder merely automatically reacts to customers' orders, akin to a user pushing the "record" button on a video cassette recorder. The court preferred the reasoning in *Sony Music Entertainment (UK) Ltd v EasyInternetCafe Ltd* [2003] FSR 48 instead and found that the end-user was the "maker" of the copies and that the plaintiff was not liable for direct infringement.

Authorisation of Infringement

The court adopted the principle in *CBS Songs Ltd v Amstrad Consumer Electronics Plc* [1998] 1 AC 1013 and held that to authorise an act means "*a grant or purported grant, which may be express or implied, of the right to do the act complained of*". In the present case, the end-user would probably be sophisticated enough to realise that the plaintiff had no authority to grant them the right to make copies of the television programmes. Hence, it could not have been possible for the plaintiff to have authorised infringement.

However, in the "FAQs" section of the RecordTV website, the plaintiff claimed to have consulted with the local info-communication and media authorities and obtained all necessary regulatory licenses from the Government of Singapore. This statement implied that the plaintiff had actual authority to provide the service and hence, was found to have authorised the acts of reproduction. Nevertheless, the tort of authorising infringement is premised on there being an act of primary infringement to begin with. While the end-user is the actual maker of the copies, he may not be guilty of infringement. Section 114(1) Copyright Act provides that the copyright in a television broadcast is not infringed by the making of a film of the broadcast for the private and domestic use. Section 114(1)(b) provides an exception to this if the film is made for the purpose of broadcasting the film or including it in a cable programme.

The issue that falls to be decided for the court was whether the RecordTV had included the broadcasts in a "cable programme". The court followed cases which suggested that a "cable programme service" would include transmission of information over the internet. Therefore, by facilitating the placement of recorded materials on its website, the plaintiff had included the broadcasts in a "cable programme".

However, this interpretation meant that end-users would not be able to avail themselves of the exception in section 114(1). To resolve this, the court reasoned that section 114 was aimed at the situation where the communication of copyrighted material was being made to someone. Hence, section 114(3)(b) "prohibits the making of a copy of a 'cinematograph film…for the purpose of…including it in a cable programme' *only where the cable programme is transmitted to viewers other than the end-user himself*". Hence, the end-user would not be regarded as actually having included a broadcast in a cable programme as all he has done is used that cable programme (the website) as a means of accessing his copy of the copyrighted material.

Liability for communicating to the public

The court found that the works was communicated to the public despite the requirement of subscription, since any member of the public with an internet connection could avail themselves of the service. Also, although the person responsible for communicating a copyright work to the public must also have "*control over the content of the communication at the time the communication was made*", as required in the Act, the court decided that there was an important distinction between the making and transmission of copyrighted material. Hence, after the end-user has communicated his preference for which broadcast or film he wanted to view, the plaintiff was responsible for determining the content of the communication upon playback. Therefore, the plaintiff was held liable for infringing the defendants' copyright in communicating the latter's broadcasts and films to the public.

Safe Harbour Provisions

The plaintiff argued that they were performing services of a "network service provider" and sought exemption against liability pursuant to section 193B Copyright Act. This was rejected as the court was of the opinion that the definition of a "network service provider" was that of a business providing the service of enabling a person to access and connect to a network. The court relied on Parliament's intention of limiting the exemption to only protect *bona fide* network service providers from inadvertently being found liable for copying copyrighted materials.

Insofar as the general defence of fair use was concerned, while the court accepted that "time-shifting" of the copyrighted material was permitted, this did not permit the plaintiff to rely on its users' fair dealing right to exculpate its own behaviour. Furthermore, the court found that as RecordTV was inherently a commercial endeavour and did not satisfy the five criteria for fair dealing.

CASE NOTE - PATENTS

Muhlbauer AG v Manufacturing Integration Technology Ltd [2009] SGHC 45

The Plaintiff is a German company with a registered patent ("invention") in Singapore. The patent described a machine for checking and rotating electronic components. Claim 1 was a device claim which contained three essential features and Claim 7 was a process claim with three essential features. The inventive concept was asserted as being "inspection on the fly".

The Defendant manufactured and marketed a machine which the Plaintiff claim infringed the patent. The Defendant did not dispute infringement but counterclaimed that the patent is invalid for lack of novelty and inventiveness. The Defendant relied on four patents and a machine to invalidate the patent for lack of novelty. The Defendant also claimed that there was no or insufficient inventive step as the invention.

The court found that the invention in this case was not novel as the key concepts within Claims 1 and 7 have been clearly anticipated by prior patents. Although the invention had a few differences from the prior art, these were either not material enough to be considered novel (such as the difference between a horizontal axis and a vertical axis) or insignificant to the invention. While some of the prior art patents did not specifically disclose the full details of the possible variants to their machines, these would be obvious to a person skilled in the art, applying the 4 step *Windsurfing International* test. Based on the Defendant's expert witness, the crux of the inventive concept of the patent was the conducting of vision inspection concurrently during the rotation of the pick-up heads and via the through opening between the pick-up heads. These concepts were already present in a prior art patent and the only technical difference between that patent and the Plaintiff's patent was immaterial.

Cargill International Trading Pte Ltd v Martek Biosciences Corporation [2009] SGIPOS 12

The plaintiff sought to revoke a pharmaceutical patent owned by Martek Biosciences under sections 80(1)(a) and 80(1)(c) Patents Act. The patent relates to processes for the production of arachidonic acid containing oils, free of eicosapentaenoic acid. Arachidonic acid is required for human metabolism but cannot be synthesized in humans *de novo*. Cargill International cited ten prior art and alleged that the patent claims were not novel or inventive and that the specifications did not disclose the invention clearly and completely for it to be performed by a person skilled in the art. Martek responded by seeking amendments to the patent, which were not opposed. Notwithstanding some findings of novelty in some claims, the court found that the main claims lacked an inventive step. As such all the dependent claims failed and the invention in the Patent was not patentable. The amendments were allowed, as they did not result in the specification disclosing any additional matter nor extending the protection conferred by the Patent.

The case is useful to practitioners for the discussion by the court on the role and type of expert witnesses. The court acknowledged that an expert's role is to provide assistance by explaining words or terms of science or art appearing in documents which have to be construed by the court. The court also highlighted that the expert must be seen to be fairly independent and have no commercial interest in the outcome of the proceedings. Where as in the present case, the sole inventor and a former director with the company were called as expert witnesses, their testimony would be subject to greater scrutiny by the court.

CASE NOTE – DOMAIN NAME

Domain Name Dispute Resolution - "unilever.com.sg" Case No. SDRP-2009/0002(F)

Background

The Complainant is Unilever PLC ("Unilever"), a company incorporated in the United Kingdom. Unilever is the proprietor of the name "UNILEVER" for a wide range of goods and services, and it has used the "UNILEVER" name on its products. It also owns many domain names containing the name "UNILEVER", including unilever.sg.

The Respondent is Fuzhou Zhongsikong Network Service ("Zhongsikong"), a company registered in China. It registered the domain name www.unilever.com.sg ("Domain Name"). Unilever filed a complaint contending that the Domain name was identical or confusingly similar to its many "UNILEVER" domains, the "UNILEVER" name, and its trade mark. It also contended that Zhongsikong registered and used the Domain Name in bad faith.

The Respondent did not submit a response. The panel affirmed that the case would thus be decided on the basis of complaint.

Infringement

The Domain Name is identical or confusingly similar to the name or mark "UNILEVER". The panel observed that it has been accepted that the addition of the portion ".com.sg" is insignificant. The panel found that Zhongsikong reproduced the name "UNILEVER" and incorporated it into the Domain Name, with little modification or addition, thus committing an act of infringement. The panel also agreed that the "UNILEVER" name and trade mark qualified as a well known trade mark in Singapore.

Bad Faith

Zhongsikong's use of the UNILEVER name on the Domain Name amounted to bad faith. The panel noted that it was entitled to draw an adverse inference from Zhongsikong's failure to file a response. It found that there was no bona fide use of the Domain Name and website. The website was used for 'domain name parking', and it stated that the website was available for sale. The links titled "Ponds", "Dove", "Omo", "Hazeline" and "Lux" did not pertain to any products or services but led instead to pages that were similar to the main web page. These were also brand names and trade marks belonging to Unilever. Zhongsikong's use of the Domain name would potentially mislead internet users into thinking that it was associated with Unilever or Unilever's website. There was also no evidence of legitimate non-commercial or fair use of the Domain Name. The Panel found that Zhongsikong most likely registered or acquired the Domain Name for the purposes of selling it, and thus did so in bad faith.

Zhongsikong also breached the SGNIC Registration Policies, Procedures and Guidelines by registering a Domain Name which infringed on the rights of Unilever.

Passing Off

The Panel found that Unilever had established its rights in the mark "UNILEVER", and it also possessed valuable and substantial goodwill in the "UNILEVER" name and trade mark. It engaged in significant advertising and promotion of its products and services by reference to the UNILEVER name and trade mark. The Panel accepted Unilever's argument that the Domain name was a misrepresentation to the public that Zhongsikong was connected with Unilever. The registration of the Domain Name would thus likely cause erosion to Unilever's reputation and goodwill, and cause damage to Unilever.

DEVELOPMENTS

Code of Conduct for Patent Agents

On 15 December 2009 the Patents (Patents Agents) (Amendment) Rules 2009 came into force bringing with it a new "Code of Conduct" ("the Code") for patent agents. The newly implemented section 15A Patents (Patent Agents) Rules 2001 ("the Rules) requires every registered patent agent with a practicing certificate to comply with the Code. Supplementing the aforementioned section, the Fifth Schedule of the Rules ("the Schedule) includes the specifics of the Code. In addition to the standard requirement to be suitably qualified, article 2 of the Schedule requires the patent agent to inform his client of his expertise

Rules of professional etiquette also apply to patent agents, as they are required to, maintain professional standards, be courteous and ethical (article 5); not act in a manner that is fraudulent, deceitful (article 5), against the interests of the client (article 9), or in any way misleading (article 12). Finally, an interesting addition is article 7 which lays out guidelines for when a client is referred to the patent agent by a third party. Essentially, the patent agent must exercise independent judgment and not be influenced in any way by the referrer.

Appointment of Hungarian Patent Office as a Patent Examiner and Fee Revision

The Hungarian Patent Office has been appointed to carry out search and examination work on patents and applications for patents filed in Singapore. The other external examination offices are the Australian Patent Office, the Austrian Patent Office and the Danish Patent and Trademark Office as Examiners. However, the Australian Patent Office will cease to handle search and examination of patents in Singapore as of 6 December 2010.

Removal of Patent Specification from Certificate of Grant

The Intellectual Property of Singapore (IPOS) announced that with effect from November 2009, the Certificate of Grant will not be accompanied by the patent specification as granted. A copy of the patent specification can be downloaded from the ePatents website at www.epatents.gov.sg.

Patent Prosecution Highway Pilot Programme with USPTO and JPO

IPOS and the United States Patent and Trademark Office (USPTO) launched a Patent Prosecution Highway (PPH) pilot program in 2009 to allow applicants to obtain corresponding patents in the United States and Singapore faster and more efficiently. Another program was initiated with the Japan Patent Office to allow the two offices to share their search and examination results.

ASEAN Patent Examination Co-operation Programme (ASPEC)

A regional patent co-operation project called "Asean Patent Examination Co-operation" (ASPEC) was launched in 2009. Under the program, IP offices from participating ASEAN member states can utilize search and examination results from another participating office for reference purposes in its own search and examination work. The 8 participating IP offices are from Singapore, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Thailand and Vietnam.

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