

CASE NOTE – TRADE MARKS

Global Yellow Pages Ltd v Promedia Directories Pte Ltd [2016] 2 SLR 165

The Plaintiff is the well-known publisher of telephone directories and unsuccessfully sued the Defendant for infringing its copyright (in a compilation work) by copying or referencing listings in its directories.

The High Court clarified the nature of compilation copyright in Singapore. Previously, dicta in the Singapore courts had appeared to lean towards the “sweat of the brow” approach, which confers copyright on a compilation in exchange for the work or expense incurred in producing the compilation. In this case, the High Court held that compilations had to show at least a minimal degree of intellectual effort or creativity in the selection or arrangement of the contents before they would be protected by copyright. Effort and labour alone, no matter how prodigious, would not be enough.

On the facts, only the telephone directories that exhibited intellectual effort in their selection and arrangement received copyright protection. This “intellectual effort” was most visible in the form of the classification or categorization of the listings, when, for example, the author of the telephone directories had to decide whether the classifications “Marble-Synthetic” and “Marble-Natural” belonged to the business-to-business listings, or the business-to-consumer listings. This indicated to the Court that intellectual effort and judgment, as well as

various factors, such as user experience, had to be considered.

On the other hand, the Court did not find any creativity in the “whole-of-the-universe” directories, as they did not derive their efficacy from any selection or arrangement of individual listings, but the lack thereof. Their alphabetical arrangement was also commonplace and dictated by function. As such, the Court ruled that they were not entitled to copyright protection.

The Court also did not find any creativity or originality in the individual listings themselves as they were bare facts, which were not copyrightable, or in the listings selected and arranged within each classification, as any intellectual effort expended there was directed at the discovery of facts and not at the selection and arrangement of the listings within each classification.

Database Right in Singapore

During the proceedings, the Defendant argued that the Court should supplement the originality requirement in copyright to take into account the absence of a *sui generis* database right in Singapore. A *sui generis* database right usually protects the investment made in producing a database. It exists in the UK and Europe, but not under

NEWS & UPDATES

ISSUE NO 01-16
JANUARY – DECEMBER 2016
PG 1 OF 17

Jo-Ann See
Director
+65 6303 6211
joann.see@amicalaw.com

Wilson Wong
Director
+65 6303 6213
wilson.wong@amicalaw.com

Jason Chan
Director
+65 6303 6215
jason.chan@amicalaw.com

Winnie Tham
Director
+65 6303 6217
winnie.tham@amicalaw.com

Elaine Tan
Director
+65 6303 6229
elaine.tan@amicalaw.com

Melvin Pang
Associate Director
Advocate & Solicitor
+65 6303 6220
melvin.pang@amicalaw.com

ADDRESS
30 Raffles Place
#14-01 Chevron House
Singapore 048622
Tel: +65 6303 6210
Fax: +65 6303 6222
+65 6536 9332

www.amicalaw.com



present Singapore law. It is distinct from copyright, as there is no requirement for originality.

The Court rejected the argument as the fact that the UK and Europe had a *sui generis* database right to protect investments in producing databases did not mean that the Singapore Parliament must have intended copyright to fill in the gap and protect the “sweat of the brow,” or the effort, labour, or investment that went into

creating a database. Simply put, it was not the Court’s role to extend copyright protection to an entirely new class of subject matter (i.e. database) on the basis of investment in its collection and arrangement. Nevertheless, the Court recognized that databases had become enormously significant, and that there may be a compelling public interest that may require legislature to protect them.

CASE NOTE – TRADE MARK OPPOSITION

Polo/Lauren Co LP v United States Polo Association [2016] 2 SLR 667

Plaintiff’s Mark



The owner of the Polo Ralph Lauren trade mark sought to oppose the registration of a sign filed by the United States Polo Association.

The opposed sign related to “eyewear” and was opposed on the basis of confusingly similarity to the Polo mark among other things. The opposition failed at first instance as the registrar found that there was no likelihood of confusion because eyewear is not purchased on a

Defendant’s Mark



regular basis and usually bought through salespersons generally in optical shops, which meant that it typically commands a higher degree of fastidiousness on the part of the consumer.

Upon appeal, the High Court agreed that there was a low degree of similarity between the trade marks, particularly in respect of visual similarity, and held that there was no likelihood of confusion.



Plaintiff's Mark

• CAESAR •

Defendant's Mark

The logo for Caesarstone, featuring a stylized orange and grey circular icon to the left of the word "caesarstone" in a lowercase, sans-serif font.

The Defendant is a manufacturer of quartz and stone products and sought to register their mark. The application was opposed by the Plaintiff, Ceramiche Caesar SpA, a manufacturer of porcelain stoneware tiles, who claimed that the defendant's mark was confusingly similar and that its trade mark should be protected as a well-known trade mark. The registry allowed the opposition and the defendant appealed to the High Court.

The High Court reversed the findings below and allowed the Defendant's mark to be registered. The Court found that goodwill associated with a particular trade mark is only one factor in assessing the similarity of trade marks even taking into account the fact that 8 years had elapsed since the application of the CAESARSTONE mark. It affirmed the principle that competing trade marks had to be assessed in totality and went on to find that the marks when

examined in totality were visually and conceptually dissimilar, especially since the Defendant's mark was a relatively complex composite mark whilst the Plaintiff's mark brought to mind the Roman statesman Julius Caesar.

But it did not find that the Plaintiff's mark was well-known and found that a claim to be well-known was not an easy task to prove. Whilst the Court of Appeal had opined in *Novelty Pte Ltd v Amanresorts Ltd [2009] SGCA 13* that it may not be too difficult for a trade mark to be regarded as well-known in Singapore, the fact of overseas sales and advertising expenditure as well as trade mark registrations will not automatically confer the status as a well-known trade mark. The Court cautioned against a simplistic application of the statement by the Court of Appeal in order to maintain a judicious balance of the rights of parties.



CASENOTE – TRADE MARK INFRINGEMENT

The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd [2016] 3 SLR 517

Plaintiff's Mark



Defendant's Mark



ISSUE NO 01-16
JANUARY – DECEMBER 2016
PG 4 OF 17

The Plaintiff was a company incorporated in August 2000 and had used their mark for events management services, such as marketing events, corporate sales and roadshows and media launches. It only sought and obtained registration for its trade mark in August 2012 in classes 35, 41 and 42.

The Defendant was incorporated in January 2012, and provided event and concert management services regionally. The Plaintiff's trademark was registered only after the Defendant's had started use of its sign.

The Plaintiff sued for infringement at the High Court. The Defendant argued that it was honestly using its own name and in good faith. Section 28(a) Trade Marks Act provides that a person does not infringe a registered trade mark when he uses his name or the name of his place of business, or the name of his predecessor in business or that of his predecessor's place of business, and such use is in accordance with honest practices in industrial or commercial

matters. The High Court agreed and dismissed the action. The Plaintiff

appealed to the Court of Appeal.

The Court of Appeal agreed that the marks in question were visually and aurally similar as to create a likelihood of confusion. It further held that the own name defence under section 28 applied to corporate names as well but required both objective and subjective honesty and was not an easy defence to mount. It adopted the principle found in the law of passing off, namely, that no man is entitled to describe his goods as to lead to the belief that they are the goods of someone else, even if the use of the description is not fraudulent but honest. This is because the focus of passing off law is on the actual or anticipated effect of the defendant's actions on the minds of the relevant public and not on the subjective honest intention or motive.

Nonetheless, this did not mean that the defendant's actual state of mind was entirely irrelevant; proof of subjective dishonesty on the part of a defendant relying on the own name defence should make it easier to establish a failure to accord with honest practices.



The Court helpfully summarised the position on the own name defence.

- (a) The defence is available in relation to the use of a defendant's name as a trade mark.
- (b) The defence is available in relation to the use of corporate names and this includes the use of the full company name as well as the defendant's trading name.
- (c) The defence is available only insofar as the defendant seeks to justify the use of its own name and nothing more.
- (d) The defence is only made out if the defendant uses the name in accordance with honest practices in industrial and commercial matters. This entails both subjective and objective elements so the court must have regard to standards and practices that are commonly applied in the industry or business as well as the particular motivations and intentions of the defendant. Each element is a necessary, but not in itself sufficient, condition for the defence to be made out. Hence, the Court must be satisfied that the invocation of the defence is in accordance with the standards and practices in the industry and also that the defendant is not actuated by dishonest motives or intentions.
- (e) The burden of establishing the defence on a balance of probabilities lies on the defendant. This calls for an evaluation of the evidence in the usual way. The assertions of honesty on the part of the defendant will not suffice if the court is not satisfied of this fact on a balance of probabilities upon considering all the evidence.
- (f) It may be relevant to have regard to the following, among other things, when conducting the inquiry into honesty:
 - It is for the defendant to adduce evidence of its *bona fides*, especially when the name in question is a trading name used by a company.
 - It is for the defendant to provide a justifiable basis for its choice of name especially if there is no apparent origin for that name or if it was selected after the plaintiff (ie, the trade mark owner) had begun using that name.
 - It is for the defendant to provide compelling reasons to explain any other significant sources of similarities between the marks



- Although some degree of confusion may be tolerated, proof of an intention to misrepresent will take the defendant outside the "honest practices" proviso, such as intention to create the impression that there exists a commercial connection between the defendant and the trade mark proprietor, or to

discredit or denigrate the registered trade mark, or to devalue the trade mark through the taking of unfair advantage of its distinctive character or repute.

On the facts of the case, the Court found that on a balance of probabilities, the Defendants did not meet the standard of honesty and allowed the appeal.

Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading) [2016] 4 SLR 86, Court of Appeal

The Singsung Get-Up (White)



The LS Get-Up (White)



The Singsung Get-Up (Blue)



The LS Get-Up (Blue)



The Singsung Get-Up (TV Sticker)



The LS Get-Up (TV Sticker)



Singsung Pte Ltd is in the business of exporting new electrical appliances manufactured in China to African and Asian markets. LG 26 Electronics Pte Ltd also traded in electrical appliances and targeted the same

export markets. LG26 admitted to copying Singsung's product get-up even though it applied a different trade mark. Both operate retail stores next to each other.



Singsung sued LG26 for passing off at the High Court. The Court found no conventional act of passing off as there was no evidence that the Singapore public associated the get-up of Singsung's product with Singsung. The Court also held that there was insufficient evidence that the public in Cameroon found Singsung's get-up to be distinctive to decide in favour of Singsung under the doctrine of instruments of deception. Singsung filed an appeal to the Court of Appeal.

The Court of Appeal did not make a determination on conventional passing off but found that there was passing off under the doctrine of instruments of deception. It clarified that passing off protects goodwill in a business, not a mark or get-up and that distinctiveness of a mark or get-up should be analyzed in the context of whether there is a misrepresentation and not whether there is goodwill. If a mark or get-up is not distinctive, use of something similar or identical by a defendant will not be a misrepresentation that the defendant's product are economically linked to the plaintiff.

Having clarified this, the Court of Appeal discuss the doctrine of instruments of deception at length.

- The tortious wrong under the doctrine of instruments of deception arises from the supply

of the instruments of deception, even before misrepresentation or damage occurs.

- Where the instruments of deception are inherently deceptive, the supplier will be liable for passing off notwithstanding the fact that his direct customers (as middlemen) are not deceived.
- The plaintiff must show that the indicia used by the defendant is distinctive of the plaintiff in that market, such that its use by the defendant is likely to deceive there.
- If the defendant used indicia similar to that used by the plaintiff because it intended to misrepresent its goods as those of the plaintiff, this is an admission by the defendant that the indicia is distinctive of the plaintiff and evidence towards the probability of deception.

The Court of Appeal found that Singsung had goodwill arising from its direct customers in Singapore (even though the goods were exported to Cameroon) and in view of LG26's deliberate copying of Singsung's product get-up, admission that the get-up was distinctive and the probability of deception, the Court allowed the appeal.



CASE NOTE - PATENTS

Warner-Lambert Company LLC v Novartis (Singapore) Pte Ltd [2016] SGHC 106

The Plaintiff, Warner-Lambert Company LLC (“**Warner-Lambert**”), owns a patent in Singapore for the use of pregabalin (marketed under the brand name “Lyrica”) for the treatment of pain.

The Defendant, Novartis (Singapore) Pte Ltd (“**Novartis**”), had previously applied to the Health Sciences Authority of Singapore for pregabalin product licences, and had alleged in their notice to Warner-Lambert that the patent would not be infringed.

Subsequently, Warner-Lambert sought a declaration that its patent would be infringed by the acts covered under the product licenses sought by Novartis. Novartis then counterclaimed for revocation of Warner-Lambert’s patent, on the basis that it was always invalid for claiming a monopoly over methods of treatment of the human or animal body, which are non-patentable in Singapore under section 16(2) of the Patents Act (the “**PA**”).

In response, Warner-Lambert filed an application to amend their method of treatment claim to a “Swiss-style” claim. The proposed Swiss-style claim was to cover the use of the compound to manufacture a medicament for a new therapeutic use (i.e. to treat pain). Instead of claiming the administration of a substance, which is non-patentable for being a method of treatment, Swiss-style claims cover the making

of a substance for administration.

Preliminarily, Novartis argued that Warner-Lambert’s amendments would be futile, as the amended patent would still fail to fulfil the requirements for patentability, namely, novelty, inventive step, and industrial application. However, the Singapore High Court (the “**Court**”) took the view that the issue of patent validity should be reserved for a more appropriate juncture where it can be thoroughly examined. Further, the Court opined that even if it had the residual power to refuse a futile amendment, such a power must be limited to “clear and obvious” cases, of which the present case was not.

The Court then went on to consider the two key issues: firstly, whether Warner-Lambert’s amendments would result in the specification disclosing additional matter, and secondly, whether these amendments would extend the protection conferred by the patent. If either of these two issues were answered in the positive, section 84(3) of the PA would preclude Warner-Lambert’s amendments. For completeness, the Court also discussed whether Warner-Lambert had incurred an unreasonable delay or sought an unfair advantage in taking out the application to amend, so as to justify the exercise of the Court’s discretion to refuse the application.



Whether the proposed amendments disclose additional matter

The Court held that the proposed amendments did not disclose any additional matter. It affirmed that the overall test is whether the skilled addressee would learn anything about the invention from the amended claim that he could not learn from the original claim.

The Court noted that the original claim covered a method of treating pain by the administration of a therapeutically effective amount of the compound. In the context of the proposed Swiss-style claim, this therapeutically effective amount of the compound would be the “medicament” for treating pain that is manufactured. Accordingly, the Court reasoned that the skilled addressee would understand that it was necessary for the proposed Swiss-style claim to include a manufacturing step, so as to ensure that the patent did not fall afoul of the method of treatment exclusion under section 16(2) of the PA. It was of the view that this manufacturing step did not add any technical aspect to the invention protected by the patent.

Further, the Court stated that the skilled addressee, when looking at the original claims, would realise that the existence of the medicament (i.e. the therapeutically effective amount of the compound) necessarily implied its *manufacture*.

Whether the proposed amendments extend the protection conferred by the patent

The Court decided that the proposed

amendments would extend the protection conferred by the patent, and thus should not be allowed under section 84(3) of the PA. Although the final objective of the original and amended claims was the same (i.e. to treat pain), they targeted different activities. The amended claim covered the *making* of the compound for the purposes of administration (to treat pain), whereas the original claim merely covered the follow-on act of *administration* of the compound to treat pain.

The Court also relied on hypothetical scenarios of infringement to explain the extension of protection. Under the original claim, infringement would be made out if a defendant offers or provides treatment of pain in Singapore by administering a therapeutically effective amount of the compound. In contrast, under the amended claim, infringement would be established if a defendant uses the compound in a process to manufacture the medicament for treating pain, or if they dispose, use, or import a product obtained directly from that manufacturing process.

Whether Warner-Lambert had incurred an unreasonable delay or sought an unfair advantage

In taking the view that there had been unreasonable delay on the part of Warner-Lambert in applying for the amendments, the Court was especially guided by the Australian case of *CSL Limited v Novo Nordisk Pharmaceuticals Pty Ltd* [2010] FCA 1251 (“**CSL**”). The Court expressed full agreement with Jessup J’s approach in *CSL* that the patentee’s constructive knowledge of the need



to amend would, in appropriate situations, suffice to justify judicial refusal of a subsequent application to amend. Accordingly, the Court found that Warner-Lambert had been put on notice of the need to amend from as early as 1998, when it was alerted to the fact that method of treatment claims are non-patentable in some patent systems. The Court was also cognisant of the fact that Warner-Lambert had previously amended its other method of treatment claims in Singapore to Swiss-style claims in 2005, 2007, and 2008.

Novartis further argued that Warner-Lambert was seeking to obtain an unfair advantage by commencing proceedings prior to applying for the amendments, despite knowing that the patent was invalid. However, the Court held that Warner-Lambert was not seeking to obtain an unfair advantage, because it had a mere 45 days from the date it was notified of Novartis' application for product licences to commence proceedings, and thus could not afford to wait for the grant of leave to amend the patent.

Comments

Although it was not necessary for the Court to rule on the validity of Swiss-style claims, it did note the readily-apparent theoretical difficulties presented by such claims, since novelty is somewhat artificially conferred on the method of manufacture by the new therapeutic use. Accordingly, the tenor in this judgment suggests that it might be time for the Singapore Parliament to consider abolishing the method of treatment exclusion, as is the position

in Australia since the High Court of Australia's decision in *Apotex Pty Ltd v Sanofi-Aventis Australia Pty Ltd* (2013) 253 CLR 284. Such a change could be implemented in conjunction with robust defences for medical practitioners, so as to maximise the incentive to find medical uses for known substances, while recognising the public interest in allowing medical practitioners to treat patients without fear of patent infringement.

From a practical standpoint, this case underscores the need for patentees to be mindful of the patentability requirements, both pre-grant and post-grant. As patentees are generally deemed to have access to all the relevant information, they should not wait until a challenge is made by a third party. Once patentees become aware of any facts or circumstances that may affect their compliance with patentability requirements, they should expeditiously seek out proper legal advice. This is especially true in Singapore, which adopts a self-assessment system that behoves patentees to make informed and considered decisions before proceeding to grant. In light of this decision, Singapore's Registry of Patents has recently released a circular (Circular 1/2016), which expressly laid down the following additional assessment criteria for post-grant amendments: (1) whether relevant matters are sufficiently disclosed; (2) whether there was any unreasonable delay in seeking amendments; and (3) whether the patentee has gained an unfair advantage obtained by delaying amendments which are known to be needed.




CASENOTE- TRADE MARK INFRINGEMENT AND PASSING OFF

Allergan, Inc and another v Ferlandz Nutra Pte Ltd [2016] 4 SLR 919; [2016] SGHC 131

This case concerned an action brought by Allergan, Inc and Allergan Singapore Pte Ltd (collectively, “Allergan”) against Ferlandz Nutra Pte Ltd (“Ferlandz”) for trade mark infringement, passing off, and malicious falsehood.

Allergan, a developer and distributor of healthcare products, had been selling an eyelash growth product (the “Latisse Product”) in Singapore since January 2011. Allergan markets the Latisse Product, used to treat hypotrichosis (a medical condition where the patient has insufficient eyelashes), under the following signs:

(a) “ **LATISSE** ”
(the “Latisse Mark”), which is registered in Class 5 for “pharmaceutical preparations used to treat eyelashes”; and

(b) “  ”
(the “Latisse Device”), which has not been registered as a trade mark.

Ferlandz, a Singapore cosmeticeutical and neutraceutical business, had been marketing an eyelash growth product (the “Lassez Product”) under the following signs (collectively, the “Infringing Signs”).

(a) “LASSEZ” (the “Lassez Sign”);
and

(b) “  ”
(the “Lassez Device”).

Trade Mark Infringement

The first category of trade mark infringement concerned Ferlandz’ use of the Infringing Signs on its Lassez Product. The second category concerned Ferlandz’ use of the Latisse Mark on promotional brochures as part of comparative advertising.

First category– use of the Infringing Signs

Under section 27(2)(b) of the Singapore Trade Marks Act (the “TMA”), the use of a sign, in the course of trade, will amount to trade mark infringement if the following conditions are satisfied:

(a) the sign is similar to a registered trade mark;

(a) the sign is used in relation to goods or services that are identical or similar to those for which the trade mark is registered; and

(a) there is a likelihood of confusion on the part of the public, on



account of the preceding two factors.

George Wei J (the “Judge”) held that all 3 conditions were satisfied. With regard to the first condition (i.e. similarity of marks), he cautioned it would not be appropriate to delve into the detailed characteristics and perceptions of actual consumers in the assessment of marks similarity. Instead, the court must assume the mantle of the “reasonable or ‘notional’ average consumer as opposed to an unthinking person in a hurry”. In finding that the Infringing Signs were similar to the Lassez Mark, the Judge reached the following conclusions:

- (a) Aural comparison. There was aural similarity between “Latisse” and “Lassez”. The Judge was more convinced with Allergan’s argument that “Latisse” and “Lassez” would be pronounced as “lah-tees” and “lah-sees” respectively. The Judge rejected the evidence led by Ferlandz as to the French pronunciation of “Lassez”, as he was not persuaded that Singaporean consumers would adopt the French pronunciation.
- (a) Visual comparison. There was visual similarity. The different font and colour used for the Infringing Signs was insufficient to dispel any similarity, as the Judge found “Latisse” to be an invented word with a high degree of inherent distinctiveness. Further, the registration of the Latisse Mark in block letters covered the use of the word in all fonts and styles.

- (a) Conceptual comparison. There was no conceptual similarity, as “Latisse” and “Lassez” were both invented words that would be meaningless to the average consumer.

The Judge also found that the second condition (i.e. identity or similarity of goods) was satisfied. The Latisse Product and the Lassez Product were similar, as both promoted eyelash growth, were sold to patients visiting medical clinics, and were in direct competition with each other.

As for the third condition (i.e. a likelihood of confusion), the Judge first decided that the end-users of the parties’ products’ (which included patients and those interested in improving the appearance of their eyelashes) were part of the relevant public for determining the characteristics of the average consumer. On the facts, the Judge was not satisfied that medical professionals would be confused, given their medical training and their opportunities to question sales representatives about the products. However, the Judge found that the end-users would be confused, as 59.1% of respondents in Allergan’s survey evidence thought that the Latisse Product and the Lassez Product originated from associated companies or the same company. Thus, on balance, a likelihood of confusion had been established.

Second category– use of the Latisse Mark in promotional brochures

Prima facie, infringement under



section 27(1) of the TMA had been made out, as Ferlandz had used a sign identical with the Latisse Mark in relation to identical goods or services (i.e. the Latisse Product). The Judge had no doubt that Ferlandz' use of the Latisse Mark was use "in a trade mark sense", as it had been used to identify the Latisse Product for the purpose of comparing it with the Lassez Product.

The Judge then considered the defence of fair use in comparative advertising under section 28(4)(a) of the TMA, a provision which permits fair use of a registered mark for commercial comparative advertising, thereby safeguarding the public interest in fair competition. The Judge noted that a false statement might negate fair use if it significantly undermines the basis of the comparison, and if the defendant knew or ought to have known that it was false. Disputes as to whether a statement is misleading should be resolved by asking whether the average consumer would find the statement misleading in a material manner.

On the facts, Ferlandz could not avail itself of this defence, because the comparative chart in their promotional brochure was misleading in a material manner, as it gave the false impressions that:

- (a) the Lassez Product was a pharmaceutical product approved by the FDA (just like the Latisse Product), when it was not; and
- (a) the Lassez Product produced

better results than the Latisse Product, even though there was no true "head to head" comparison, since different standards and studies were used to assess the respective products.

Passing Off

To succeed in a claim in passing off, the classical trinity of goodwill, misrepresentation and damage must be established.

The Judge reiterated the following recent clarifications handed down by the Court of Appeal (Singapore's apex court) regarding the element of goodwill:

- (a) passing off is concerned with goodwill in the business as a whole, and not its constituent elements such as the mark, logo, or get-up that it uses;
- (a) for conceptual clarity, the issue as to whether a mark or a get-up is distinctive of the plaintiff's goods or services should be dealt with in the misrepresentation inquiry; and
- (a) the goal of the tort of passing off is to prevent unfair competition occasioned by the defendant's deception or misrepresentation, as to, amongst other things, the origin of the goods or services. As such, where a defendant is found to have had the intention to deceive, the court will not be astute to find that the defendant had failed in his purpose.

The Judge found that Allergan enjoys



goodwill in their business in Singapore, based on their substantial sales turnover figures (S\$819,000 in 2011 and S\$680,000 in 2012) and marketing expenditure (S\$354,000 in 2011 and S\$128,000 in 2012).

Next, the Judge was of the view that the word “Latisse” is distinctive of the Latisse Product as a badge of origin, though the same could not be said for the Latisse Device, as many eyelash products and brands use similar eyelash devices. He then found that misrepresentation had been made out, based on Ferlandz’ intention to cause confusion. This intention was premised on two “badges of fraud” for which Ferlandz could not proffer satisfactory explanations for: firstly, the similarities between the words “Latisse” and “Lassez”, and secondly, the striking similarity between Allergan’s poster and the cover page of Ferlandz’ brochure.

With regard to the first badge of fraud, Mr Lee, the sole director and shareholder of Ferlandz, explained that “Lassez” was chosen as “Lass” evokes the image of a young lady and sounds like “lash” in “eyelash”. The Judge rejected this explanation – Ferlandz could not rely on the first syllable being read as “lass”, as it had also contradictorily asserted that “Lassez” will be pronounced as “LAH-SAY” by Singaporeans. Mr Lee also claimed that he had chosen “Lassez” as it is a French word embodying female beauty or fashion. However, this was contradicted by Ferlandz’ own expert witness had testified that “lassez” is the imperative form of the verb “lasser”, which

means to weary or tire.

With regard to the second badge of fraud, the Judge was clearly convinced that there was a striking similarity between Allergan’s poster and the cover page of Ferlandz’ brochure, based on a visual comparison:

Allergan’s Poster



Cover Page of Ferlandz’ Poster



Lastly, the Judge concluded that the element of damage had been made out. Blurring was likely to result from Ferlandz' misrepresentation, as the Latisse Product and the Lassez Product were in competition with each other. Blurring occurs when the plaintiff's get-up becomes indicative of the defendant's goods or services, resulting in a diversion of sales. The Judge also took the view that there may also be damage by restriction of expansion into related fields of activity.

Malicious Falsehood

In 2009, the United States Food & Drug Administration (the "FDA") had sent Allergan a letter setting out its view that Allergan had contravened US law as its promotional materials and website were misleading in respect of the risks associated with the Latisse Product. The letter also set out the FDA's request for remedial action by Allergan, which Allergan had subsequently complied with.

Allergan's claim in malicious falsehood was based on Mr Lee's distribution of this FDA letter to the staff of a medical centre. The Judge dismissed Allergan's claim, as the first

element (i.e. the falsity of the published material) could not be established. The FDA letter did not amount to a false statement, as a reasonable person would interpret the FDA letter as merely stating Allergan's past brush with, as opposed to continuing breach of, US law.

Comments

This decision clarifies the scope and application of the defence of fair use of comparative advertising under section 28(4)(a) of the TMA. Of particular note is the High Court's statement that the enactment of section 28(4)(a) of the TMA in 2004 meant that Singapore courts are no longer bound by the case law concerning its predecessor provision and its counterpart in the UK Trade Marks Act 1994. Further, although it was clear that Parliament was referencing the US fair use doctrine in its enactment of section 28(4)(a) of the TMA, the High Court also stated that Singapore courts are not bound by US decisions on fair use, leaving the door open for Singapore to develop its own body of jurisprudence in this area of trade mark law.



LEGISLATIVE UPDATE - TRADEMARKS

The Tenth Edition, Version 2016 of the Nice Classification came into force in Singapore on 1 January 2016. The Eleventh Edition, Version 2017 of the Nice Classification was announced on 28 Jul 2016 and will come into force on 1 January 2017. The Tenth Ed shall apply to all applications filed from 1 January 2016 to 31 December 2016. Applications filed on or after 1 January 2017 will be classified in accordance with the Eleventh Ed.

The following classifications have been clarified:

- Classification of “association services” is not acceptable per se. However, if suitably qualified, it will be accepted in the classes appropriate to the qualifier (eg, “association services, namely arranging business introductions” in Class 35).
- The description “arranging and conducting of exhibitions” will be accepted in both Classes 35 and 41, but will be deemed to be limited to commercial and advertising purposes in Class 35 or for cultural or educational purposes in Class 41, as the case may be.
- The description “providing a website” is regarded as a

webhosting service acceptable in Class 42. It will not be acceptable in other Classes.

- The description “kits” alone is too vague and must be suitably qualified to be classified (eg, “cosmetic kits” in Class 3, “sewing kits” in Class 26). The components of a kit may be specified but all components must fall within the same Class (eg, “repair kits comprising screwdrivers, pliers and hammers” in Class 8).

Work Manual

New chapters to the examination guidelines have been added covering international applications with subsequent designations for Singapore, international applications originating from Singapore, and priority claims. The existing chapters on shape marks and relative grounds of refusal were also updated.

Mediation

The Intellectual Property Office has launched a mediation scheme which will operate until 30 March 2019. In this scheme, IPOS will fund parties’ mediation costs of up to SGD5,500 per mediation case. Funding will be provided regardless of mediation outcome.



LEGISLATIVE UPDATE: CHANGES TO SINGAPORE'S COPYRIGHT REGIME

The Ministry of Law and the Intellectual Property Office of Singapore announced proposed changes to be made to the Singapore's copyright regime and invited public feedback. The proposed changes include:

- **Voluntary copyright registration system:**
Voluntary registration system to simplify the process of establishing copyright ownership
- **Ownership of commissioned works:**
Creators of certain commissioned works given first ownership of the copyright.
- **Duration of protection for unpublished works:**
Duration of copyright protection for certain unpublished works limited in order to prevent such works from being withheld from the public indefinitely.
- **Right of attribution**
Creators and performers of copyright works be attributed or credited.
- **Exceptions cannot be restricted by contracts**
Certain copyright exceptions, such as those relating to fair dealing, fair use, education and parallel importation, cannot be excluded by contract.
- **Orphan works:**
Options to allow for use of orphan works.
- **Text and data mining:**
Allowing copyrighted works to be reproduced for the purposes of data analysis and data mining.
- **Technological Protection Measures**
Exceptions where such measures may be circumvented be reviewed.

January / December 2016

This newsletter is intended to provide general information only and should not be relied upon as an exhaustive or comprehensive statement of law. Should you have any specific questions, please speak with your usual contact at Amica Law LLC.

