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## IP NEWS UPDATE

### NEW BILL TO ENHANCE INTELLECTUAL PROPERTY DISPUTE RESOLUTION IN SINGAPORE

On 8 July 2019, the Intellectual Property (Dispute Resolution) Bill was tabled in Parliament. While the Bill's final form has yet to take shape, IP rights holders should take note of the key improvements proposed to Singapore's IP law regime.

#### Consolidation of Jurisdiction in the High Court for IP Disputes

Under the current regime, initiating IP disputes can be confusing for IP rights holders as jurisdiction is divided up amongst several adjudication bodies. To tackle this, the Bill confers the High Court with jurisdiction to hear all civil IP disputes with two exceptions:

1. Either the High Court or IPOS may hear standalone claims regarding the invalidation or revocation of a registered IP.
2. For trade secrets or breach of confidence cases, the State Courts will hear claims below S\$250,000. Claims above S\$250,000 will be heard by the High Court.

The Bill's Committee has also recommended the establishment of a "fast track" for IP litigation cases in the High Court to reduce the costs and length of proceedings. Further details on these plans are expected to be released soon.

#### Confirming Arbitration as an alternative in IP Disputes

In line with Singapore's development as a hub for IP dispute resolution, the Bill seeks to clarify the law's position on the arbitrability of IP disputes. Currently, the law is silent on the use of arbitration in IP related disputes. Amendments to the Arbitration Act and International Arbitration Act will affirm the arbitrability of IP disputes in Singapore.

#### Consistency in Certificates of Contested Validity

A Certificate of Contested Validity may be awarded when the validity of an IP right is challenged and subsequently upheld. These certificates are currently only available for patents. Under the new Bill, the relevant Acts will be amended to make this available to all IP rights.

#### Contesting Patents: Before Grant – Third Party Observations

At present, the examiner is not required to take into consideration *ad hoc* objections submitted during the examination process.



The Bill aims to introduce this process and structure it such that third parties may submit their objections within a stipulated period. If a third party's submission complies with all formalities, the Registrar is obliged to consider them during the examination process. This provides for better protection to holders of IP rights.

### **After Grant – Patent Re-Examination**

The current process for challenging a patent is time consuming and costly. Further, there are only a limited number of situations where the High Court would allow the challenge to proceed.

The new Bill structures and simplifies the process. Rather than having to embark on the arduous process of the current regime, third parties may seek re-examination if they think a registered patent:

- a) is not a patentable invention;
- b) is not sufficiently clear nor complete to be reproduced by an appropriately trained person;
- c) extends to matters beyond the submission;
- d) should not be allowed; or
- e) has been filed two or more times.

Once a request has been submitted, the applicant third party will not be involved in the re-examination. Depending on the outcome, the Registrar may revoke the patent.

### **REGISTRATION OF GEOGRAPHICAL INDICATIONS (GIS) NOW AVAILABLE IN SINGAPORE**

Following the European Parliament's ratification of the European Union-Singapore Free Trade Agreement (EUSFTA), a new Registry of Geographical Indications was launched to allow registration of GIs in Singapore from 1st April 2019, providing GI holders with enhanced protection. Dispute resolution procedures relating to GI applications and registrations have also been introduced.



## (A) Application Process for GIs

Applications for GIs will be processed in a similar way as trade mark applications:

<b>Formalities check:</b>	The application is checked to ensure that it meets filing requirements.
<b>Substantive examination:</b>	The application is examined to determine if the GI meets the legal requirements for registration.
<b>Publication:</b>	If the application meets the requirements for registration, it will be accepted and published in the Geographical Indications Journal for opposition purposes. The opposition period is 6 weeks.
<b>Registration:</b>	If there is no opposition to the registration of the GI or all opposition proceedings are resolved in favour of the applicant, the GI will be registered. A certificate of registration will be issued to the applicant.

The total processing time from the date on which the application for registration is filed to the registration of the GI is presently estimated at around nine months, if the application did not contain any deficiency or face any objection.

Once registered, a GI will enjoy 10 years of protection which is renewable every 10 years upon payment of the requisite renewal fees.

## (B) Registration Criteria for GIs

To be eligible for registration, a GI must:

- (a) be an indication used in trade to identify goods as originating from a place that is a qualifying country or a region/locality therein, and a given quality, reputation or other characteristic of the goods is essentially attributable to that place;
- (b) identify goods that fall within at least one of the following categories:
  - (i) Wines;
  - (ii) Spirits;
  - (iii) Beers;
  - (iv) Cheese;
  - (v) Meat and meat products;
  - (vi) Seafood;
  - (vii) Edible oils;
  - (viii) Non-edible oils;



- (ix) Fruits;
  - (x) Vegetables;
  - (xi) Spices and condiments;
  - (xii) Confectionery and baked goods;
  - (xiii) Flowers and parts of flowers;
  - (xiv) Natural gum;
- (c) not be contrary to public policy or morality;
- (d) be protected as a GI in its country or territory of origin;
- (e) not be identical to the common name of the goods identified by the GI. For example, “gouda” and “camembert” may be considered to have become the common name for types of cheeses, rather than GIs;
- (f) not contain the name of a plant variety or an animal breed and be likely to mislead the consumer as to the true origin of the product;
- (g) not be confusingly identical or similar to an existing geographical indication, whether registered or not;
- (h) not be confusingly identical or similar to an earlier trade mark in Singapore, whether registered or not;
- (i) not be identical with or similar to a well-known trade mark in Singapore and likely to mislead consumers as to the true identity of the goods identified by the GI; and
- (j) be applied for registration by a person who is entitled to file the application.

### **(C) Entitlement to apply for GIs**

The following persons are entitled to apply for registration of a GI:

- (a) a person who is carrying on an activity as a producer in the geographical area specified in the application with respect to the goods specified in the application;
- (b) an association of persons referred to in (a); or
- (c) a competent authority having responsibility for the GI for which registration is sought.

For further details and information on the filing requirements for GIs, please contact

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## 6-MONTH FAST TRACK FOR ARTIFICIAL INTELLIGENCE (AI) PATENT APPLICATIONS

To complement Singapore's shift towards a digital economy and support innovative enterprises in protecting and commercialising AI technologies, the Intellectual Property Office of Singapore (IPOS) has launched AI<sup>2</sup> (Accelerated Initiative for Artificial Intelligence) in which AI patent applications may be granted in as quickly as 6 months, subject to prescribed eligibility criteria.

Prescribed eligibility criteria under AI<sup>2</sup> include:

1. The application is an AI invention.

Examples of AI invention include, but are not limited to, image recognition, speech/voice recognition, natural language processing, autonomous system.

2. Application has to be first filed in Singapore.

Application contains no priority claim and is not a divisional application.

3. Form PF1 (Request for Grant of Patent) and Form PF11 (Request for Search and Examination Report) have to be filed on the same day.

4. Application shall contain 20 or fewer claims.

5. Applicant needs to respond within two weeks from the date of receipt of the formalities examination adverse report.

6. Applicant needs to respond within two months from the date of receipt of the written opinion.

Examiner may contact applicant for an interview which generally serves to resolve or address issues with regards to the patent application. Applicant is highly encouraged to agree to an interview upon request by the examiner as it is expected to speed up prosecution.

7. A supporting document tagged as Fast Track document has to accompany Form PF11.

This Fast Track document should state that the patent application relates to an AI invention and include applicant's request to fast track the application under AI<sup>2</sup>.

AI<sup>2</sup> is effective from 26 April 2019 for a period of 2 years and limited to 50 applications. IPOS, however, has the discretion to adjust the cap limit and/or eligibility criteria.



Separately, an accelerated FinTech Fast Track (FTFT) initiative is available for financial technology (FinTech) patent applications. FTFT is effective from 26 April 2018 for a period of 2 years. Eligibility criteria for FTFT are similar to AI<sup>2</sup>, except for the aforementioned first criteria. In particular, patent applications eligible for FTFT have to relate to FinTech which generally refers to technology applied in financial-related services or used to help companies manage the financial aspects of their business. Examples of FinTech inventions include, but are not limited to, electronic payment, investment platforms, insurance technology, blockchain and banking, security, fraud and authentication.

If a patent application relates to both AI and FinTech inventions, it may qualify for either the AI<sup>2</sup> or FTFT initiative. In this case, the Fast Track document should indicate that the patent application relates to AI and/or FinTech in order for IPOS to consider and determine an appropriate initiative.

For further details and information on the AI<sup>2</sup> and FTFT initiatives, please contact:

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## **A MAJOR CHANGE TO SINGAPORE'S PATENT PROSECUTION PROCEDURE**

### **Current procedure**

Currently, Singapore patent applicants can rely on the issuance of a favourable International Preliminary Report on Patentability (IPRP) established for a PCT application or successful prosecution of a foreign patent application in countries such as the US, Canada, Europe, Japan, Korea, Australia and New Zealand for the same invention for grant of the Singapore patent. Under this so-called "foreign route", the Singapore application does not undergo local substantive examination of patentability requirements such as novelty and inventive step.

### **Changes come 1 January 2020**

This "foreign route" is currently planned for closure on **1 January 2020**.

This means that (a) all Singapore patent applications with a filing date on or after 1 January 2020 or (b) all Singapore divisional applications with a lodgement date on or after 1 January 2020, must be fully examined by the Intellectual Property Office of Singapore (IPOS).



The intention for closing this route is to ensure all patent applications are fully examined by local examiners against Singapore's standards of patentability and to allow Singapore's patent system to further mature.

### **What should you do?**

Many patent applicants, who have obtained the successful grant of a corresponding foreign application, favour the quicker and cost effective "foreign route" because the cost of substantive examination in Singapore is avoided.

Therefore, those who wish to take advantage of the benefits offered by the "foreign route" should take steps to ensure that their Singapore applications are filed before 1 January 2020.

For those who have pending Singapore patent applications and wish to adopt the "foreign route" but are not likely to meet the grant requirements (i.e. issuance of an allowance of a corresponding patent application) before 1 January 2020, we suggest filing divisional application before 31 December 2019.

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## **CASE NOTE – PATENTS**

### **SUNSEAP GROUP PTE LTD AND OTHERS V SUN ELECTRIC PTE LTD [2019] 1 SLR 645 [2019] SGCA 4**

This case involved patent infringement proceedings and a counterclaim for patent revocation in the High Court.

The Plaintiffs in the Suit, Sun Electric Pte Ltd ("**SE**"), brought patent infringement proceedings against the Defendants, Sunseap Group Pte Ltd and others ("**SG**"), alleging that 8 out of 12 claims in SE's Patent were infringed. Unsurprisingly, SG's Defence was that the Patent was invalid, and filed a Counterclaim for revocation of all 12 claims in the Patent.

In response, SE mounted a procedural challenge to SG's Defence and Counterclaim, and applied to strike out the Counterclaim. SE argued, *inter alia*,



that the High Court did not have jurisdiction to hear patent revocation proceedings by way of counterclaim. Thus, if SG wanted to revoke SE's Patent, it had to commence a separate action with the Intellectual Property Office of Singapore (“**IPOS**”).

The Assistant Registrar (“**AR**”) of the High Court ruled in favour of SE. On appeal, the High Court judge reversed the judgment. On further appeal, the Court of Appeal (“**CA**”) reinstated the AR's decision at first instance and ruled in favour of SE.

### **Revocation proceedings at first instance via defence and counterclaim in High Court is proper**

The issue of law before the courts was framed as such: can patent revocation proceedings be properly brought before the High Court at first instance, by way of defence and counterclaim in infringement proceedings?

The CA ruled that such revocation proceedings were proper. Its analysis was simple and based on the provisions of the Patents Act (Cap 221, 2005 Rev Ed) (“**PA**”). Section 67 of the PA provides that the High Court has jurisdiction to hear patent infringement proceedings. Section 82(1)(a) of the PA further provides that in patent infringement proceedings, the defendant can put in issue the validity of a patent by way of defence and counterclaim. Section 91(1) PA then grants the High Court the power to revoke a patent once it is found to be invalid.

The High Court's power to revoke a patent is subject to the following principles:

1. If the plaintiff has asserted all claims in the patent against the defendant and the defendant successfully shows that all the asserted patent claims are invalid, then the court should revoke the patent,
2. If the plaintiff has asserted all independent claims in the patent against the defendant and the defendant successfully shows that all the asserted independent claims are invalid, then the court should revoke the patent. In such a case, the CA held that where all the independent claims in a patent are found to be invalid, all of its dependent claims must necessarily also fall away because the dependent claims referred to the independent claim and incorporated all of its features.
3. If there are independent claims the validity of which has not been impugned and which can be maintained without the invalid claims, the courts should not revoke the patent. The defendant would be entitled to a declaration of invalidity in relation to those asserted independent claims if it succeeds in its defence in the infringement proceedings.





## **Outside of infringement proceedings, the High Court cannot hear patent revocation proceedings at first instance**

Where the application is brought independently of infringement proceedings, the High Court does not have jurisdiction to determine the validity of the patent. The CA held that Sections 82(2) and 82(1) of the PA have expressly excluded the High Court's jurisdiction to hear patent revocation proceedings when they are brought independent of infringement proceedings. Instead, such jurisdiction is reserved for the Registrar.

### **In rem jurisdiction is not required to revoke a patent**

The CA also explained its disagreement with the High Court judgment. The High Court judge had held that a court had to be vested with *in rem* jurisdiction to revoke a patent. This was because a granted patent is a right *in rem*, enforceable against the public at large. Since the Supreme Court of Judicature Act (Cap 322, 2007 Rev Ed) only granted the High Court in *personam* jurisdiction and unlimited subject matter jurisdiction, the High Court lacked the requisite *in rem* jurisdiction to hear patent revocation proceedings.

The CA disagreed that an express grant of *in rem* jurisdiction was required for courts to hear revocation proceedings. Instead, the CA clarified that an *in rem* judgment can arise from an *in personam* action, giving the example of a divorce decree which determines the status of parties.

### **Comment**

This case has raised significant concerns amongst some of the IP community. This is due to the CA's statement that once an independent claim is found invalid, every subsidiary dependent claim "must necessarily fall away". This appears to be fundamentally inconsistent with current patent claim interpretation. By nature, a dependent claim is narrower and more restrictive in scope over the independent claim on which it depends, and therefore it should not necessarily follow that it will fall away if the independent claim is revoked. The dependent claim could still survive, provided it meets the patentability requirements. If the CA's statement is followed, dependent claims become wholly redundant and inventors would suddenly find the scope of their patents severely reduced. It would be interesting to see whether this statement would be followed and whether there would be further clarifications on this.

On a positive note, this case has clarified the ambit of the High Court's jurisdiction in hearing patent revocation proceedings. It is now clear that the current wording of the Patent Acts only confers jurisdiction on the High Court to hear patent revocation proceedings at first instance where brought by way of



defence and counterclaim in infringement proceedings, but not as standalone actions. This gap however looks set to be plugged. The Intellectual Property (Dispute Resolution) Bill (Bill No. 17/2019), which was read for the first time in the Singapore Parliament on 8 July 2019, seeks amongst others, to amend Section 80 of the PA, so as to confer the High Court with concurrent jurisdiction to revoke patents brought by way of a standalone application. Once this change comes into effect, parties may choose whether to commence standalone revocation proceedings in IPOS, or the High Court.

## CASE NOTE – TRADE MARKS

### **BURBERRY LTD V MEGASTAR SHIPPING PTE LTD AND ANOTHER APPEAL [2019] SGCA 1**

The Appellants are trade mark proprietors of luxury brands Burberry and Louis Vuitton. The Respondent, Megastar Shipping Pte Ltd, is a freight forwarder providing transshipment services in Singapore.

The present dispute arose as counterfeit goods infringing the Appellants' trade marks were shipped from China to Singapore in sealed containers with the Respondent named as the local consignee. The goods were to be transhipped from Singapore to Indonesia, but were seized by Singapore Customs before the goods left Singapore.

The Appellants, along with 3 other trade mark proprietors, claimed that the Respondent was liable for trade mark infringement under s 27(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**TMA**”). However, the High Court dismissed the trade mark proprietors' claims and the Appellants appealed.

In this appeal, the central issue was whether a freight forwarder would be liable for trade mark infringement as an importer and/or “would be” exporter of the goods.

#### **Trade Mark Infringement for Goods in Transit**

Under s27(1) of the TMA, a person infringes a registered trade mark if, without the consent of the trade mark proprietor, he uses in the course of trade a sign which is identical with the trade mark for identical goods or services for which the trade mark is registered. Section 27(4)(c) of the TMA further states that a person uses a sign if he “imports or exports goods under the sign”.



A question arose as to whether the TMA regulates goods in transit for the purposes of infringement.

After examining the context and structure of the TMA, the Court of Appeal (CA) found that the infringement provision under s 27 of the TMA includes goods in transit. In the CA's view, there was nothing in the TMA to suggest that trade mark protection under the TMA is limited to those who intended to market their trademarked products in Singapore. Goods in transit in Singapore would therefore fall within the definition of "import" and "export" in s 27(4)(c) of the TMA.

On the issue of whether a "would be" exporter would be liable under the TMA, the CA agreed with the High Court that a mere intention to export is generally insufficient to constitute export under the TMA, provided that the intention remains a mere state of mind without any accompanying actions. Where there are accompanying actions which are clearly directed at fulfilling the intention to export, or clear evidence that export would take place, a trade mark proprietor could apply for a *quia timet* injunction on the basis that there is a threatened infringement of its trade marks by way of export.

### **Liability for Import and Export**

Who is to bear the liability for the import and export of infringing goods under the TMA?

The CA held that whether a person is the importer or exporter of the goods is a question of fact. This depends on the level of involvement of the person and whether his involvement was needed for the goods to be brought into Singapore. In determining the level of involvement, it is not determinative that the person is identified as the importer/exporter in shipping documents or is treated as such by the Customs Act (Cap 70, 2004 Rev Ed), as there are different purposes and considerations behind the Customs Act and the TMA. The key determining factor of liability is whether the person had the intention to import/export goods under the signs with knowledge or reason to believe that there was a sign. Therefore, if a freight forwarder knowingly caused or facilitated counterfeit goods to be brought into Singapore, it should be held liable for infringement.

In the present case, the CA found that although the Respondent facilitated the physical act of importing the goods, it did not "use" the infringing signs as it was not even aware and had no reason to believe that they were on the goods it was transshipping. Accordingly, the Respondent was not liable for trade mark infringement.



## Strict Liability in Trade Mark Infringement?

The Appellants sought to counter this by arguing that innocence is not a defence to trade mark infringement, and that the mental state of the alleged infringer is entirely irrelevant. The CA clarified that this principle applies when a defendant intends to use the sign, but maintains that it does not know that the sign was infringing. This is different from the present situation where the Respondent did not even know that a sign was applied or present on the goods. If a person intends to use a sign, he must first know or have reason to believe that there is a sign, but in this case there was no evidence that the Respondent knew or had reason to believe there were signs on the goods. The documents given to the Respondent merely indicated household goods and other seemingly innocuous generic merchandise. There was no reason to suspect that the goods were counterfeit luxury goods.

The CA also took the opportunity to clarify that the knowledge and intention of freight forwarders are assessed separately at the time of import and the time of export. This means that even if the freight forwarders did not know or have any reason to believe that they were importing infringing goods, if events transpired during the goods' transit in Singapore that put them on notice that their goods might be infringing but they nevertheless choose to export the goods, they run the risk of being liable for trade mark infringement.

### Comment

This case is significant as it clarifies the role and liability of freight forwarders who are honest commercial persons tangentially involved in the movement of counterfeit goods and who are wholly unaware of the existence of any infringing sign. It also introduced a mental element of “knowing” or “having reason to believe”, which is likely to increase the burden of proof to be discharged by trade mark proprietors in infringement proceedings.

While this decision offers more protection to freight forwarders, trade mark proprietors can still take advantage of the Intellectual Property (Border Enforcement) Act which was recently amended in 2018. The Act allows trade mark proprietors to obtain more information from freight forwarders which will facilitate the tracing of the counterfeit goods to its source, aiding proprietors in commencing infringement proceedings against the relevant parties.



## CASE NOTE – TRADE MARK

### APPLICATION FOR CONFIDENTIALITY SAFEGUARDS BY TWG TEA COMPANY PTE. LTD. AND OBJECTION THERETO BY T2 SINGAPORE PTE. LTD. & TEA TOO PTY LTD [2019] SGIPOS 9

#### Outcome

Principal Assistant Registrar Mr Mark Lim (“**PAR Lim**”) of the Intellectual Property Office of Singapore (the “**Registry**”) partially granted TWG’s request for confidentiality safeguards in respect of TWG’s sales figures but refused to grant the same in respect of TWG’s marketing figures.

#### Background

This is the first judgment in Singapore which deals with the issues of whether the confidentiality of sales and marketing figures adduced in trade mark opposition proceedings should be safeguarded and, if so, what the appropriate safeguards should be.

By way of background, TWG Tea Company Pte. Ltd (the “**Applicant**” or “**TWG**”) sought to register the trade marks “SINGAPORE BREAKFAST”, “NEW YORK BREAKFAST”, “LONDON BREAKFAST” and “CARAVAN” (collectively, the “**Subject Marks**”) for tea and tea-related goods in Class 30.

T2 Singapore Pte. Ltd. and Tea Too Pty Ltd (collectively, the “**Opponents**” or “**T2**”) opposed the registration of the Subject Marks on various grounds, including that the Subject Marks are devoid of any distinctive character as per Section 7(1)(b) of the Trade Marks Act (Cap. 332, 2005 Rev Ed) (the “**Act**”) and/or that the Subject Marks are descriptive of the goods in question as per Section 7(1)(c) of the Act.

In response, TWG sought to establish that the Subject Marks have acquired distinctiveness as per Section 7(2) of the Act and wanted to adduce sales and marketing figures in support. However, TWG claimed that such sales and marketing figures constitute confidential information and sought various confidentiality safeguards before disclosing them.

Specifically, TWG proposed that T2 provide a confidentiality undertaking on the following terms:

- (a) not to use the confidential information for collateral purposes;
- (b) limited disclosure of confidential information to T2’s solicitors and support staff, certain T2 employees, and the Registry;



- (c) indemnity from T2; and
- (d) consent by T2 to injunctive relief in the event of any threatened or actual breach of undertaking.

T2 rejected TWG's proposal, hence TWG applied to the Registry for the above safeguards to be imposed on T2.

### **Registry's Decision**

In deciding to grant TWG's request for confidentiality safeguards in respect of TWG's sales figures but not TWG's marketing figures, PAR Lim opined that there would be a difference in cases where a party is seeking confidentiality protection over information which it voluntarily puts forward in support of its case, as opposed to a situation where it is compelled to provide the information, because there is an element of unfairness in imposing confidentiality obligations on a party in respect of information which it never asked for.

Nevertheless, PAR Lim opined that confidentiality obligations may still be imposed on a party in respect of information which it never asked for and cited the following non-exhaustive list of factors to be considered:

- (a) The importance of the information to the issues in dispute;
- (b) The degree to which the information is confidential;
- (c) How current the information is;
- (d) Whether the parties are competitors;
- (e) The extent of prejudice to a party should the confidential information be disclosed to its competitor; and
- (f) The stage of the proceedings.

In this case, PAR Lim took account of the following facts:

- (a) TWG and T2 are direct competitors, both in Singapore and abroad;
- (b) TWG's marketing figures are general in nature and are not specific to products bearing the Subject Marks;
- (c) TWG's marketing figures are not current (until 2015);
- (d) TWG's sales figures are specific to products bearing the Subject Marks;
- (e) TWG's sales figures are also fairly current (until 2017);



- (f) The commercial value of TWG's sales figures to T2 is clear. PAR Lim accepted TWG's hypothesis that assuming that TWG's sales figures for its product or pots of tea sold under the **SINGAPORE BREAKFAST** Mark are the highest, T2 may focus its resources in promoting products under the same mark.

Based on the above, PAR Lim partially granted TWG's request for confidentiality safeguards in respect of TWG's sales figures but refused to grant the same in respect of TWG's marketing figures.

However, the extent of the confidentiality safeguards is limited to T2 not using TWG's sales figures for collateral purposes and disclosure of the sales figures to T2's Singapore solicitors and support staff, the director of T2 and the Registry. In particular, PAR Lim rejected TWG's requests for indemnity from T2 and consent by T2 to injunctive relief in the event of any threatened or actual disclosure of the confidential information, as he considered that granting these requests would go too far and that TWG had failed to provide any case precedent for such onerous obligations to be imposed on T2.

### Comment

In trade mark opposition proceedings, it is common for a party to adduce sales and marketing figures to support that party's proposition that its trade mark had acquired distinctiveness, is well known in Singapore or is well known to the public at large. This decision provides useful guidance as to when confidentiality safeguards should be ordered in respect of such figures, and the extent of safeguards required. T2 was represented by Nicholas Tong of Amica Law.

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