

19. INTELLECTUAL PROPERTY LAW

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I. Copyright

A. **I-Admin (S) Pte Ltd v Hong Ying Ting – Copyright subsistence in compilation works – Copyright infringement**

19.1 In *I-Admin (S) Pte Ltd v Hong Ying Ting*,¹ the plaintiff (“i-Admin”) alleged that three of the defendants, being ex-employees of the plaintiff and its subsidiaries, conspired to infringe its copyright by taking and using its confidential information to set up a competitor firm in the business of payroll processing. The plaintiff’s claims were for copyright infringement, breach of confidence, breach of contract, conspiracy and inducing breach of contract. Aedit Abdullah J dismissed the plaintiff’s claims, save an award for nominal damages for breach of contract against Hong Ying Ting.

19.2 I-Admin is a Singapore-incorporated company in the business of providing outsourcing services and systems software, primarily in the areas of payroll and HR management. It began developing the “payAdmin” system comprising its core payroll engine from 2000 onwards. The primary defendant Hong, a former employee of i-Admin, was a general manager in the plaintiff’s systems department. The other key defendants were Liu Jia Wei (an ex-employee of the plaintiff’s subsidiary i-Admin (Shanghai) Ltd), Nice Payroll Pte Ltd (“Nice Payroll”) and Li Yong, a Chinese national and Singapore permanent resident who invested in Nice Payroll. There was a parallel suit against another employee, but it is not germane to this summary.

1 [2020] 3 SLR 615.

19.3 In 2009, Hong and Liu shared their frustrations about the plaintiff's payroll engine, which they both had experience using. They discussed creating a better payroll software and named their proposed project the "Kikocci Project". During this period, Liu began coding for the Kikocci Project using an online web-based application development tool, Oracle Application Express ("APEX"). The Kikocci Project was designed to be a portal that stored and displayed employee records in different APEX pages and was expected to perform better than i-Admin's system. In December 2009, Hong and Liu incorporated the Kikocci Corporation in the British Virgin Islands. On 18 March 2011, Li and Hong incorporated Nice Payroll, with Li as the only director and 100% shareholder, and the Kikocci Corporation was closed. Li invested \$100,000 in paid-up capital and provided a loan of \$900,000 pursuant to a Cooperation Agreement dated December 2011. On 30 April 2011, Liu resigned from i-Admin Shanghai, and Hong left i-Admin on 30 June 2011.

19.4 In 2013, i-Admin came across Nice Payroll's website while conducting market research. The plaintiff noted that Nice Payroll advertised itself as providing services and systems similar to the plaintiff's, and that Hong and Liu were its directors. The plaintiff alleged that Hong and Liu had, since 2009, schemed to set up a competing company, the Kikocci Corporation, and worked on the Kikocci Project during their working hours while still employed by the plaintiff, using the plaintiff's resources. They eventually decided to incorporate Nice Payroll with Li, and used the plaintiff's copyrighted and/or confidential materials to develop Nice Payroll's business and software codes. Five claims were made against the defendants.

19.5 In respect of the copyright infringement claim, Abdullah J held that for copyright to subsist in any literary work, there must be an authorial creation that is causally connected with the engagement of the human intellect.² His Honour emphasised that "a human author must first be identified before the work in question can be deemed to be original",³ but it is not necessary to name each and every author to make out a claim. The plaintiff must show "that the product was generated from a human author or human authors working alone or collaboratively, *ie*, the existence of such persons must be clearly established".⁴

2 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [44], referring to *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [24].

3 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [44], citing *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [94].

4 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615, referring to *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [75].

19.6 On the facts, although i-Admin did not identify specific authors of the source code materials (Category 1), the court was satisfied that they were nonetheless authored by the plaintiff's employees. Abdullah J distinguished this factual scenario from that in *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd*:⁵ there, the facilitative work of the identified employees in gathering and organising the information and data in the tables did not amount to authorship, and the respondents might have been unable to identify the relevant authors as a high degree of automation might have been involved in compiling the tables.⁶ In respect of the databases and technical infrastructure materials (Category 2), it was held that:⁷

... even if payitem and CPF information was publicly available, intellectual effort, analysis, industry knowledge, and knowledge of regulatory rules, HR policies and employment best practices were still required to organise the information into a format that was suitable for processing by a computer program ...

and the database tables constituted compilations of facts under s 7A(1)(a) of the Copyright Act⁸ that were original and attracted copyright protection. There were three other categories of materials but essentially the plaintiff failed on all the copyright infringement claims. This aspect of the decision is in line with local and Australian authorities where a human author (or authors) must be identified in factual compilation works published by corporations in order for copyright to subsist.⁹

19.7 Regarding infringement, Abdullah J held that copyright is only infringed if there has been a copying of a substantial part of the protected works and substantiality in relation to a compilation work:¹⁰

... depends on the quality, not quantity, of the material copied; the defendant must have copied or taken the parts of the work that *contributed towards the finding of originality*. [emphasis added]

5 [2011] 4 SLR 381.

6 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615at [48], referring to *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [77]–[82].

7 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [71].

8 Cap 63, 2006 Rev Ed.

9 See David Tan, “Copyright in Compilations: Embarking on a renewed quest for the human author and the creative spark” (2013) 18 MALR 151 at 158–160; *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381 at [73]–[82]; *Telstra Corp Ltd v Phone Directories Co Pty Ltd* (2010) 194 FCR 142; *Telstra Corp Ltd v Phone Directories Co Pty Ltd* [2010] FCA 44.

10 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [45], referring to *Global Yellow Pages Ltd v Promedia Directories Pte Ltd* [2017] 2 SLR 185 at [239].

19.8 The plaintiff must also establish a causal connection between the copyrighted work and the defendant's infringing work.

19.9 While copyright generally subsisted in the plaintiff's materials and the plaintiff had ownership of the copyright, the plaintiff's copyright was not infringed. While i-Admin showed that the defendants had access to its materials, there was no substantial copying of the plaintiff's software and source codes in the generation of Nice Payroll's various databases, templates, and other files and documents. Although there might have been some similarity between the materials, it did not follow and was not proved that copying had occurred.

19.10 In respect of the Category 1 materials, Abdullah J found the expert testimony provided by the defendants to be persuasive, and held it was:¹¹

... necessary to consider the overall architecture and design of its software to determine whether the plaintiff's copyright in its software had been infringed. This would entail a consideration of the programming language used and the logic of the source code, as well as the database components which the source code drew upon. It was not sufficient to focus on the contents of the database tables alone.

19.11 Ultimately the court found that there were many dissimilar features. What distinguished i-Admin's software was its organisation of its database architecture and its development of its source codes. I-Admin's software architecture was a three-tier application architecture: (a) the software was presented on webpages using JavaServer Pages on the presentation tier; (b) the main application logic was written in Java on the logic tier; and (c) the logic tier interfaced with the data tier (the Oracle database) using Structured Query Language ("SQL"). In contrast, Nice Payroll's software architecture was written in APEX, and Nice Payroll's data, application logic and user interface were stored in and on the Oracle database. Nice Payroll's application development required the application logic (code) to be written in PL/SQL. The difference in programming languages meant that the plaintiff's program could not be meaningfully compared to Nice Payroll's, which used PL/SQL. The court held that "any similarities in Nice Payroll's software and payroll output could be attributed to the functional and statutory requirements that informed what payroll reports should generally contain."¹²

19.12 In respect of Category 2 materials, it was held that the differences in the naming conventions and the number and type of hard-coded

11 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [56].

12 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [59].

payitems sufficiently distinguished Nice Payroll's payitem database table from the plaintiff's, and that no copying could be said to have occurred. Also, on the whole, there was clear evidence that Nice Payroll's CPF database table was organised differently from the plaintiff's.

19.13 In summary, having compared the copyrighted materials with the allegedly infringing materials, Abdullah J concluded that no substantial copying was proved in relation to the materials in Categories 1 and 2. Although the evidence showed that the defendants had access to some of the plaintiff's materials in the other alleged categories when they developed Nice Payroll's payroll systems, the court could not conclude that there was copying on this basis alone.¹³

II. Breach of confidence

A. *I-Admin (S) Pte Ltd v Hong Ying Ting – Actual use of confidential information*

19.14 In *I-Admin (S) Pte Ltd v Hong Ying Ting*, i-Admin also alleged that three of the defendants, being ex-employees of the plaintiff and its subsidiaries, in addition to infringing its copyright in its "payAdmin" system, had also used its confidential information to set up a competitor firm in the business of payroll processing.

19.15 Abdullah J found that the defendants indeed owed obligations of confidence to the plaintiff, but there was no use of the plaintiff's confidential information in the relevant sense, and dismissed the claim.¹⁴

19.16 His Honour reiterated that the elements that have to be established for an action in breach of confidence to succeed are listed in *Clearlab SG Pte Ltd v Ting Chong Chai*¹⁵ ("*Clearlab*"):¹⁶

(a) "The information must possess the necessary quality of confidentiality." This is satisfied if it is relatively inaccessible to the public, that is, it has not become public knowledge.

(b) "The information must have been imparted in circumstances importing an obligation of confidence." Where there is a contract expressly or impliedly imposing an obligation of confidence, this element may be satisfied simply by reference to the contract.

13 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [106].

14 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [107].

15 [2015] 1 SLR 163.

16 *Clearlab SG Pte Ltd v Ting Chong Chai* [2015] 1 SLR 163 at [64]–[66].

(c) “There must be an unauthorised use of that information to the detriment of the party communicating it.”

19.17 The court found that Hong was bound by the non-disclosure agreement (“NDA”) he signed, and he owed the plaintiff a contractual duty of confidence, regardless of the extent to which the plaintiff enforced its security protocols.¹⁷ I-Admin’s enforcement of the NDA did not seek to restrict Hong’s ability to utilise his skill and knowledge to compete with the plaintiff; rather, it sought to protect its own confidential information that was:¹⁸

... separate from information that should be regarded as part of an ex-employee’s skill and knowledge acquired in the course of employment which he is entitled to use and which the plaintiff may not protect for its own.

19.18 While the other defendants Liu and Tan did not owe the plaintiff contractual duties of confidence, they did owe equitable duties to the plaintiff to the extent they came into possession of its materials through their employment with its subsidiaries, and to the extent they knew the materials in question were created by the plaintiff.¹⁹ As Hong was a director of Nice Payroll, his state of mind and knowledge was attributable to Nice Payroll, and the company was also subject to equitable duty of confidence.²⁰ But Li owed no such duty as there was no evidence to show that he had been involved in the running of Nice Payroll’s business such that he would have had knowledge of any confidential information being received or used by the other defendants.²¹

19.19 The judge agreed that:²²

... the plaintiff’s source codes, systems, database structures and client materials were confidential, but only to the extent the information in question was not found in the public domain and was original.

19.20 Following from his findings in relation to the copyright claim above that no reproduction or copying of the plaintiff’s materials had occurred *per se*, and relying on the reasoning in *Clearlab*, Abdullah J held that “mere copying [of information] did not amount to actual use for the purposes of making out the breach of confidence claim”.²³ The defendants in *Clearlab* had actually used Clearlab’s confidential information: the

17 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [111].

18 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [112], referring to *Clearlab SG Pte Ltd v Ting Chong Chai* [2015] 1 SLR 163 at [80].

19 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [112].

20 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [113].

21 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [114].

22 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [115].

23 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [116].

use of the copied data was shown to be critical to the actual running of Aquilus's operations and to the defendants' ability to obtain relevant licences within months, thereby bypassing the research and development and trial process. But the plaintiff in this instance had not proven that the defendants had actually used the plaintiff's materials; hence, no breach of confidence had occurred. His Honour also declined to accept the so-called "expansive approach" taken in *Clearlab* where the mere taking of the plaintiff's materials could amount to a breach of confidence on the grounds that this formulation of the breach of confidence claim had not been pleaded and that the present facts were not so egregious as in *Clearlab* to warrant this specific consideration.²⁴

19.21 The plaintiff also alleged that the following constituted a breach of confidence: (a) the defendants used a copy of its payroll software to generate Nice Payroll's internal payroll reports; (b) Hong's access to and use of the plaintiff's demonstration platform; and (c) disclosures to HSBC Bank (Singapore) Limited and ADP International Services BV. The court similarly dismissed the claims as the plaintiff could not demonstrate unauthorised use.

19.22 This decision is significant in highlighting that a finding of an obligation of confidence will not automatically result in a finding of a breach of that confidence. A defendant's possession of and access to a plaintiff's confidential information is insufficient to support on a balance of probabilities that there was breach.²⁵ Actual use must be shown, and this includes establishing that the use of the plaintiff's materials had resulted in the creation of the defendants' own materials. The decision is on appeal to the Court of Appeal.

III. Patents

19.23 For the year under review, there are two Court of Appeal judgments and two decisions from the High Court Registrar in the subject matter of patents.

A. *Sunseap Group Pte Ltd v Sun Electric Pte Ltd – Original jurisdiction – Revocation of patent*

19.24 In *Sunseap Group Pte Ltd v Sun Electric Pte Ltd*²⁶ ("Sunseap v Sun Electric"), the Singapore Court of Appeal, comprising five judges,

24 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [124]–[125].

25 *I-Admin (S) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615 at [123]–[124].

26 [2019] 1 SLR 645.

delivered a judgment on an important point of law regarding the High Court's original jurisdiction to hear an application for the revocation of a patent under the Patents Act.²⁷

19.25 The issue of the High Court's original jurisdiction to hear patent revocations arose in a patent infringement suit ("the Patent Suit") taken out by Sun Electric Pte Ltd ("Sun Electric") against Sunseap Group Pte Ltd and two of its subsidiaries, Sunseap Energy Pte Ltd and Sunseap Leasing Pte Ltd ("Sunseap Group") in November 2016. Sun Electric is the registered proprietor of a Singapore patent ("the Patent") in respect of a power grip system and a method of determining power consumption at building connections in the system. Sunseap Group is a licensed electricity retailer and a developer and manager of rooftop solar photovoltaic systems. There were a total of 12 claims in the patent.

19.26 In the Patent Suit, Sun Electric claimed that Sunseap Group infringed eight out of 12 claims in the patent. These eight claims were referred to as the "Asserted Claims" whereas the remaining four claims in respect of which no infringement was alleged were referred to as the "Unasserted Claims".²⁸ In response to the Patent Suit, Sunseap Group denied all allegations of infringement on the basis that the patent was and had been at all material times invalid on the grounds of lack of novelty, lack of inventive step and insufficiency. The validity of the Asserted Claims was put in issue by way of defence whilst the validity of the Unasserted Claims was put in issue by way of counterclaim. In the defence and counterclaim, Sunseap Group sought numerous reliefs, including a declaration that the Patent was and had always been invalid, and an order that the Patent be revoked, amongst others. In March 2017, Sun Electric applied under O 18 r 19 of the Rules of Court²⁹ to strike out certain portions of the defence and counterclaim and the particulars of objection for the reason that the validity of any of the claims of the patent could not be put in issue by way of counterclaim in infringement proceedings.

19.27 The assistant registrar held that the validity of all the claims in the patent could be put in issue by way of counterclaim in infringement proceedings and that revocation proceedings could be commenced in the High Court at first instance, particularly where infringement proceedings are already before the High Court and revocation proceedings are brought by way of counterclaim. Sun Electric appealed to the High Court.

27 Cap 221, 2005 Rev Ed.

28 *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 at [21].

29 Cap 322, R 5, 2014 Rev Ed.

19.28 The High Court previously held in *Sun Electric Pte Ltd v Sunseap Group Pte Ltd*³⁰ that all applications for the revocation of a patent at first instance must be heard by the Registrar of Patents. The High Court's jurisdiction was limited to hearing appeals from the Registrar's decisions as it had no original jurisdiction to hear revocation proceedings by way of application or to grant a prayer for revocation whether or not by way of counterclaim in infringement proceedings because (a) there was no express statutory provision in the Patents Act 1994³¹ which conferred original jurisdiction on the High Court for patent revocations; and (b) the High Court needed to have *in rem* jurisdiction before it could revoke a patent.

19.29 The Court of Appeal was of the view that in answering the question of whether the High Court has original jurisdiction to hear an application for revocation of a patent, a distinction must be made between two categories of cases: (a) applications for revocation that were brought by way of counterclaim in infringement proceedings; and (b) applications for revocation brought independently of infringement proceedings. These two categories of cases must be treated differently.

(1) *Applications for revocation which are brought by way of counterclaim in infringement proceedings*

19.30 Under category (a), the defendant is challenging the validity of a patent from its position of being a “defender” and is seeking an order from the High Court that the patent be revoked if it is so found to be invalid. According to the Court of Appeal, the basis of the High Court's jurisdiction to determine the validity of a patent is found in s 67(1) read with s 82(1)(a) of the Patents Act.

19.31 Section 67(1) is a jurisdiction-conferring provision under which “civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent”. In the context of infringement proceedings, s 82(1)(a) provides that a defendant is entitled to challenge the validity of the patent by way of defence. Reading s 67(1) together with s 82(1)(a), the Court of Appeal is of the view that the High Court is conferred original jurisdiction to determine the validity of the patent concerned, at least where the issue of validity is raised in the context of infringement proceedings by the defendant in defence of the claim of infringement.

30 [2017] SGHC 232.

31 Act 21 of 1994.

19.32 The above analysis of ss 67(1) and 82(1)(a) of the Patents Act is, however, premised on the condition that the entire patent, that is, the validity of *all* the claims in the patent has been put in issue in the infringement proceedings. In situations where the patent owner has raised allegations of infringement in respect of some but not all of the claims in the patent, a different analysis follows.

19.33 Logically speaking, a defendant can only put the validity in issue “by way of defence” in respect of claims where the patent owner has alleged infringements. It follows that the validity of all other unasserted claims cannot be put in issue by way of the defendant’s defence and counterclaim. In such situations, even if the court finds the asserted claims to be invalid, it is not appropriate for the court to exercise its power to revoke the entire patent. The only time in which it is appropriate for the court to exercise its power to revoke the entire patent is when the validity of all the claims of the patent is put in issue and that the court finds all of them to be invalid.

19.34 An example of such a scenario is where all the independent claims in a patent have been found to be invalid. In such a case, even if the defendant did not challenge specifically the validity of the dependent claims in its defence, the dependent claims could not stand once all the independent claims were found to be invalid as dependent claims must necessarily refer back to the independent claims and incorporate all their features.³² Therefore, the whole of the patent must be regarded as invalid in such cases and it is appropriate for the High Court to revoke the entire patent.

19.35 A defendant who faces allegations of infringement of some but not all of the independent claims in a patent may be entitled to a declaration of invalidity in respect of those asserted independent claims if it is successful in its defence in the infringement proceedings. Alternatively, if the defendant seeks a revocation of the patent, it may do so by bringing proceedings before the Registrar under s 80 of the Patents Act. The defendant has the option of doing so after the completion of the High Court proceedings or seeking the court’s leave to proceed before the Registrar while the court proceedings are ongoing. If the unasserted independent claims are also found to be invalid before the Registrar, it would be appropriate for the Registrar to revoke the entire patent having taken into account the declaration of invalidity of the independent claims granted by the High Court in the earlier proceedings.

32 See *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2017] 3 SLR 1334 at [104].

(2) *Applications for revocation brought independently of infringement proceedings*

19.36 The second category of cases comes squarely within s 82(1)(d) of the Patents Act, in which it explicitly provides that a party is entitled to challenge the validity of the patent in the course of proceedings for revocation before the *Registrar*, and no reference to the “court” is made in the section. The Court of Appeal further ruled that s 82(2) read together with s 82(1)(d) confers on the Registrar the exclusive jurisdiction to determine the validity of patents where the revocation application is brought independently of infringement proceedings. Thus, a party who has not been sued for patent infringement but has successfully established a cause of action and who consequently wishes to challenge the validity of a patent *must* commence revocation proceedings before the Registrar and not the High Court. The applicant for revocation who is dissatisfied with the ruling of the Registrar will have the recourse of an appeal to the High Court and thereafter, if necessary, to the Court of Appeal.

19.37 The Court of Appeal’s judgment, in rejecting the contention (by the respondent in *Sunseap v Sun Electric*)³³ that *only* the Registrar has the exclusive original jurisdiction to hear *all* application for revocation and confirming that the High Court has original jurisdiction to determine the validity of patents when this is brought by way of defence and counterclaim, accords with Parliament’s intention to save costs in patent litigation.

19.38 In the first category of cases where the validity of the patent claims is put in issue by way of defence and counterclaim, it is sensible for the revocation proceedings to be resolved together with the infringement proceeding that is brought before the High Court. Parliament could not have intended otherwise. In the second category of cases, where the revocation proceeding is brought independently by an interested party, it is also sensible that the originating jurisdiction should reside with the Registrar as there are no cost savings for the proceedings to be heard before the High Court given that there are no pending court proceedings. There are further advantages to be reaped with this ruling as the Registrar, being a specialised forum with the requisite domain knowledge, is well placed to take on these cases and consequently, valuable court time and resources are saved.

19.39 With regard to the question whether the High Court needs to have *in rem* jurisdiction before it can revoke a patent, the Court of Appeal held that this is not a necessary prerequisite. An *in rem* judgement does

33 See para 19.24 above.

not arise only from the court's exercise of its *in rem* jurisdiction. It may arise equally in an *in personam* action. For example, a divorce decree arising from a divorce proceeding (an *in personam* action) "may be a judgment *in rem*, in so far as it determines the status of the parties".³⁴ Furthermore, *in rem* judgments may also arise through the court's exercise of its admiralty jurisdiction. All these provide support for the Court of Appeal's conclusion that only *in personam* jurisdiction is necessary and the High Court has such jurisdiction once a defendant is served in the manner as prescribed by the Rules of Court or has submitted to the High Court's jurisdiction.

19.40 Applying the legal principles to the present case, the Court of Appeal found that it fell within the first category of cases where the application for revocation is brought by way of defence and counterclaim in the context of infringement proceedings. Consequently, the High Court has the jurisdiction to determine the validity of the Patent, and if the Patent is found to be invalid, the High Court may exercise its power to revoke it.

19.41 From a practice perspective, the Court of Appeal's judgment in *Sunseap v Sun Electric*³⁵ provides important guidelines on how a defendant in infringement proceedings should frame its pleadings and these are noteworthy:³⁶

- (a) In its defence, the defendant is limited to challenging only the validity of the asserted claims (*ie*, the claims in respect of which allegations of infringement have been made).
- (b) In its counterclaim, the defendant may include a prayer for revocation but the wording of the prayer depends on whether all or only some of the claims in the patent have been put in issue.
 - (i) If the validity of all the claims in the patent have been put in issue, the defendant may ask simply for 'an order that the patent be revoked'.
 - (ii) If the validity of only some of the claims have been put in issue, the defendant will be required to plead for 'an order that the patent be revoked, if the court finds that the asserted claims are invalid and as a consequence the remaining unasserted claims cannot be maintained without the invalid asserted claims', or words to a similar effect.

34 *Murakami Takako v Wiryadi Louise Maria* [2007] 4 SLR(R) 565 at [33].

35 See para 19.24 above.

36 *Sunseap Group Pte Ltd v Sun Electric Pte Ltd* [2019] 1 SLR 645 at [72].

B. Millennium Pharmaceuticals, Inc v Drug Houses of Australia Pte Ltd – Striking out statement of claim – Injunction

19.42 In 2019, besides *Sunseap v Sun Electric*, the Court of Appeal also delivered an *ex tempore* judgment in respect of an application to strike out a statement of claim on the ground of no reasonable cause of action and an application for an injunction in *Millennium Pharmaceuticals, Inc v Drug Houses of Australia Pte Ltd*³⁷ (“*Millennium Pharmaceuticals v Drug Houses of Australia*”), which was an appeal from the High Court’s decision in *Millennium Pharmaceuticals, Inc v Drug Houses of Australia Pte Ltd*.³⁸

19.43 It should be recalled that the High Court found that the respondent (defendant in the High Court proceedings) had failed to comply with the requirements under the Health Products (Therapeutic Products) Regulations 2016³⁹ (“TPR”) in making a truthful and accurate declaration on the existence and validity of any patent in respect of its therapeutic product. Accordingly, the material falsehood declaration claim was held to disclose a reasonable cause of action and the respondent’s application for striking out based on this claim failed. However, the High Court allowed the respondent’s striking-out application based on the prospective infringement declaration claim and the injunction claim as well as the actual infringement declaration claim on the grounds that they all disclosed no reasonable cause of action.

19.44 The Court of Appeal’s grounds of decision allowing the appellant’s appeal in respect of the respondent’s partly successful application at the High Court for the striking-out of the appellant’s statement of claim may be summarised as follows:

- (a) It was undisputed that the respondent did not declare the existence of the appellant’s two patents to the Health Sciences Authority (“HSA”) despite clear requirements in reg 23 of the TPR. It was further undisputed that the respondent was aware of the existence of the appellant’s patents. The fact that the respondent averred that its product did not infringe the processes protected by the appellant’s patents, and consequently the patents had no relevance to the product, did *not* provide a basis for the respondent’s non-declaration of the appellant’s patents to the HSA. The respondent had to declare the patents, even as it sought to contend that they were invalid or would not be infringed, and it was for the HSA to invoke reg 23(5) of the

37 [2019] SGCA 31.

38 [2018] SGHC 149.

39 S 329/2016.

TPR to require the respondent to serve the requisite notice on the appellant.

(b) If the notice had been directed to be served, a 44-day moratorium in reg 23(8) of the TPR followed by a 30-month moratorium in reg 23(9) of the TPR would be implemented. The respondent's non-compliance had allowed it to bypass these moratoriums and the Court of Appeal was of the view that the respondent could not now argue that the appellant could only proceed by the route in reg 23 of the TPR when it was the respondent's non-compliance that has deprived the appellant of that route in the first place.

(c) Regulation 24 of the TPR provided the basis for a challenge to the registration of the respondent's product if the appellant obtained a court order determining the matters stated in reg 24(1)(a)(i) or 24(1)(a)(ii), the very same matters that the appellant's statement of claim sought to achieve.

(d) As far as reg 24(1)(a)(i) was concerned, the Court of Appeal opined that the provision was not necessarily about proving actual or past infringement of a patent. It was possible to argue that under reg 24(1)(a)(i), the court was required to determine whether an act or acts (authorised by the registration of the therapeutic product) such as supply, manufacture, import and wholesale as pleaded in the appellant's statement of claim could amount to infringement of a patent in the particular circumstances. The act or acts concerned might or might not have taken place. The Court of Appeal felt that such an interpretation of reg 24(1)(a)(i) was not entirely untenable. Even if proof of actual infringement was necessary, the Court of Appeal was of the view that an argument might be made that such infringement took place when the respondent participated in the hospitals' public tender for the product by offering the product for sale and that such products were obtained directly by means of the patented process within the meaning of s 66 of the Patents Act. Again, this was not an entirely hopeless or obviously unsustainable argument.

(e) Where reg 24(1)(a)(ii) of the TPR is concerned, the Court of Appeal agreed with the High Court that the appellant's material falsehood declaration claim should not be struck out.

(f) The Court of Appeal rejected the respondent's argument that to allow the appellant to proceed to challenge the registration of the therapeutic products under regs 24(1)(a)(i) and 24(1)(a)(ii) would open the door to abuse by those who missed the deadlines in reg 23 of the TPR. A patent proprietor

who misses the deadlines in reg 23 of the TPR runs the risk of the competitor flooding the market with generic products after registration as he has lost the opportunity to delay or stop the registration process but where the patent proprietor is seeking to have the registration cancelled on the grounds that he can obtain a court determination of the specified matters in regs 24(1)(a)(i) and 24(1)(a)(ii), there can be no abuse of the registration process and imposition of moratoriums against registration.

19.45 Finally, in respect of the application for an injunction, the Court of Appeal found that the appellant did have a reasonable cause of action and as such, there was a serious question to be tried. However, the Court of Appeal was not convinced that the evidence adduced by the appellant showed that, at that stage, damages would not be an adequate remedy. In the event that the appellant succeeded in its action, the appellant's monopoly of a specialised clientele would be restored, and any damages suffered by the appellant could be quantifiable as the hospitals who were the purchasers of the product kept proper records of their purchases. The appeal by the appellant in relation to an unsuccessful application for an injunction at the High Court was dismissed but on grounds that were different from those provided by the High Court.

C. Sun Electric Pte Ltd v Sunseap Group Pte Ltd and Sun Electric Pte Ltd v Sunseap Group Pte Ltd – Application for further and better particulars – Framing of interrogatories

19.46 In 2019, two High Court judgments on civil procedures in relation to patent infringement issues were also delivered by the assistant registrar, namely, *Sun Electric Pte Ltd v Sunseap Group Pte Ltd*⁴⁰ (“Suit No 190 of 2018”) and *Sun Electric Pte Ltd v Sunseap Group Pte Ltd*⁴¹ (“Suit Nos 1229 of 2016 and 190 of 2018”). The former was concerned with an application for further and better particulars, with an alternative prayer for striking out parts of pleadings whilst the latter concerned applications for further and better particulars and the withdrawal of interrogatories, brought in two related patent infringement suits.

(1) *Suit No 190 of 2018*

19.47 In general, a plaintiff does not have to construe the terms and claims of his patent at an early stage of infringement proceedings but is nevertheless obliged to inform the defendant of sufficient particulars to enable the defendant to know the case to be met. Contentions, however,

40 [2019] SGHCR 4.

41 [2019] SGHCR 11.

frequently arise as to the proper characterisation of the requests made. In Suit No 190 of 2018, the assistant registrar provided guidance by setting out situations in the more extreme ends of a spectrum which characterise such requests.

19.48 At one end of the spectrum are requests which may be properly characterised as requiring a plaintiff to positively and exhaustively define the ambit of the terms or claims of this patent. Such requests made of the plaintiff at an early stage of patent infringement proceedings will be granted only in exceptional circumstances.⁴² The rule exists for practical reasons, to prevent unnecessary costs and efforts being expended in early claim construction.⁴³

19.49 At the other end of the spectrum is a request requiring a plaintiff to identify the specific acts on the part of the defendant which the plaintiff complains of, without which the defendant is left unaware of the case to be met. It is recognised that in order for the plaintiff to identify these specific acts, the plaintiff will be required, directly or indirectly, to provide some information about the ambits of the terms or claims of the plaintiff's patents. Such requests are, however, conceptually different from requests requiring the plaintiff to *positively and exhaustively* define the ambit of the terms or claims of this patent, and as such would be allowed. This is because the defendant ought not be burdened with "undertak[ing] guesswork" in order to understand the claim against him, and is instead "entitled to know the precise manner in which, according to the plaintiff, the defendants have infringed [the claims in question]".⁴⁴ Having said this, it is, however, not possible to apply a bright-line rule in the characterisation of every request, and the merits of each request must be assessed with the objectives of the policies in mind.

19.50 A final point worth noting in the assistant registrar's decision in Suit No 190 of 2018 pertains to the level of particularisation required for pleading a claim of common design in patent infringement. Having considered the relevant case law on elements of liability for joint tortfeasorship by common design, the assistant registrar set forth the details to be particularised in the pleadings:

- (a) the primary and secondary tortfeasors in question;
- (b) the relevant act of the primary tortfeasor;
- (c) the common design in question; and

42 *AstraZeneca AB (SE) v Sanofi-Aventis Singapore Pte Ltd* [2013] SGHCR 7 at [47].

43 *Sun Electric Pte Ltd v Sunseap Group Pte Ltd* [2019] SGHCR 4 at [20].

44 *Sun Electric Pte Ltd v Sunseap Group Pte Ltd* [2019] SGHCR 4 at [23].

(d) the assistance allegedly rendered by the defendant, pursuant to the identified common design, towards the primary tortfeasor's commission of an act.

19.51 A bare pleading that cross-references all the allegations of primary infringement set out in the particulars of infringement does not meet the level of particularisation required in a claim on common design.

With the above guiding principles in mind, the assistant registrar in Suit No 190 of 2018 granted the requests for further and better particulars for some of the defendant's requests and rejected others.

(2) *Suit Nos 1229 of 2016 and 190 of 2018*

19.52 In Suit Nos 1229 of 2016 and 190 of 2018, the assistant registrar was presented with the question whether particulars should be deferred pending the responses to the interrogatories. The law permits a plaintiff to seek discovery or interrogatories before particularising his claim if the following requirements are satisfied:

- (a) pending discovery or interrogatories, the plaintiff has no knowledge of the particulars sought or has given the best particulars available to him;
- (b) the material facts in question are entirely within the knowledge of the defendant; and
- (c) despite the plaintiff's lack of knowledge of the particulars pending discovery or interrogatories, there is nonetheless a "substantial foundation" for his claim.

19.53 In certain patent disputes, as in the present case, a complication arises in respect of requirement (b) because, although the defendant's processes are entirely within his knowledge, he may not be in a position to provide the requisite information in the absence of sufficient particulars of the claim against him. At the same time, the plaintiff may well be unable to further particularise his claim, precisely because he does not have sufficient knowledge of the defendant's processes.

19.54 The solution offered by the assistant registrar to overcome this apparent impasse akin to the proverbial "chicken and egg" dilemma was "for the plaintiff to serve interrogatories that are narrowly and precisely framed, co-relating to specific aspects and features of the asserted claim in question" which:⁴⁵

45 *Sun Electric Pte Ltd v Sunseap Group Pte Ltd* [2019] SGHCR 11 at [30].

... should neither require the defendant to perform a construction of the plaintiff's claim, nor be of a broad, roving and fishing character going beyond the legitimate requirements of the circumstances at hand.

19.55 When this practical approach is properly applied, the court is able to make a holistic assessment of whether it would be appropriate to order that further and better particulars be deferred pending the responses to the interrogatories.

IV. Trade marks

19.56 For the year under review, there were two trade marks judgments: one from the Court of Appeal and another from the High Court. *Burberry Ltd v Megastar Shipping Pte*⁴⁶ (“*Burberry v Megastar*”) was a case on liability of a freight forwarder for trade mark infringement as the importer and/or “would be” exporter of the goods; and *Scotch Whisky Association v Isetan Mitsukoshi Ltd*⁴⁷ (“*Scotch Whisky v Isetan*”) was a case on the registration criteria of a trade mark and whether the registration of the applicant mark ISETAN TARTAN could be successfully opposed on the absolute grounds for refusal under ss 7(4)(b), 7(5) and 7(7) of the Trade Marks Act.⁴⁸

A. ***Burberry Ltd v Megastar Shipping Pte Ltd – Meaning of use of a sign – Meaning of importing and exporting – Freight forwarding and infringement liability***

19.57 In *Burberry v Megastar*, the Court of Appeal was called upon to decide a novel point of law regarding the liability of a freight forwarder for trade mark infringement under s 27(1), read together with s 27(4)(c), of the Trade Marks Act.

19.58 The appellants were two trade mark proprietors of luxury brands, Burberry and Louis Vuitton, whilst the respondent was a freight forwarder company which provided transshipment services in Singapore.

19.59 At the High Court, the appellants' trade mark infringement action was dismissed on the basis that although the signs were clearly used in the course of trade and the goods were also imported under the sign, the respondent was, however, *not* the importer of the goods. Furthermore, the High Court also found that the goods were not exported

46 [2019] 1 SLR 536.

47 [2020] 3 SLR 725.

48 Cap 332, 2005 Rev Ed.

under the sign because they had not left Singapore and an intention to export was insufficient. Consequently, the appellants' action for trade mark infringement under s 27(1), read together with s 27(4)(c), of the Trade Marks Act failed. The appellants appealed to the Court of Appeal against the High Court's decision.

19.60 Tay Yong Kwang JA, delivering the judgment of the Court of Appeal, highlighted a few important points about the facts of the case that were given substantial weightage in the court's analysis and decision:

- (a) The involvement of the respondent freight forwarder was limited to only receiving the cargo from one country (China) and forwarding it to another country (Indonesia).
- (b) The goods were in sealed containers, were never placed on or intended for the Singapore market and were not seen by any consumers in Singapore.
- (c) There was no evidence that the respondent knew or had reason to believe that the cargo contained counterfeit goods, or that he was aware that there were *signs* on the goods and that the signs were trade mark infringing.

19.61 The main issue before the Court of Appeal was the meaning of “importing” and “exporting” under the sign as this constituted “use of a sign” under s 27(4)(c) of the Trade Marks Act for the purposes of finding trade mark infringement under s 27. More specifically, *Burberry v Megastar*⁴⁹ raises the following two pertinent questions in respect of trade mark infringement for goods in transit:⁵⁰

- (a) To what extent does the Trade Marks Act regulate goods in transit for the purposes of infringement, if such goods are never intended for the Singapore market?
- (b) Assuming that goods in transit are caught by the infringement provisions in the Trade Marks Act, who is to be held liable for such infringement?

19.62 The Court of Appeal reiterated that “trade mark use” is a necessary requirement for infringement to occur under s 27 of the Trade Marks Act. The requirement “trade mark use” means the infringing sign must have been *used* as a trade mark, that is, it is used to identify the trade mark proprietor as the origin of the goods. In this regard, the Court of Appeal made the important distinction between use in a trade mark sense and

49 See para 19.57 above.

50 *Burberry Ltd v Megastar Shipping Pte* [2019] 1 SLR 536 at [23].

mere decorative use.⁵¹ The former type of use constitutes trade mark infringement if it is done without the trade mark proprietor's consent whilst the latter does not. In *Burberry v Megastar*, it was not disputed that the goods in issue were counterfeit goods bearing the appellants' trade marks and, consequently, there was no disagreement that the requirement of trade mark use was fulfilled. However, the Court of Appeal pointed out that whether there is trade mark use in Singapore is *not* dependent on whether the trade mark was actually seen by consumers in Singapore.

(1) *Whether the act of import into Singapore and/or the intended export to Indonesia amount to infringing trade mark use*

19.63 The starting point of the Court of Appeal's analysis was the meaning of "import" under the Trade Marks Act. It was noted that no definition is provided by the Trade Marks Act and as such, the Court of Appeal adopted the meaning found in s 2 of the Interpretation Act,⁵² which states that:

In every written law, the word 'import' shall mean 'to bring or cause to be brought into Singapore by land, sea or air' unless 'there is something in the subject or context inconsistent with such construction'.

19.64 By this definition, the Court of Appeal concluded that goods in transit, once brought into Singapore, would be taken as imported even if they were not intended for the Singapore market. The context and structure of the Trade Marks Act were consistent with a broad interpretation of "import" covering goods that were brought into Singapore only for the purpose of transit. In its analysis, the Court of Appeal rejected the submission that the purpose of the Trade Marks Act was only to protect Singapore-registered trade marks and their proprietors' economic interests in the Singapore market. As such, there should be no protection for trade mark proprietors when their trade interests in the Singapore market are not affected, such as for goods in transit, when the infringer did not intend to circulate the infringing sign in the jurisdiction where the said trade mark was protected. This was because the Court of Appeal was not persuaded that the purpose of the Trade Marks Act was limited to protect trade mark proprietors who marketed their trade-marked products in Singapore.

19.65 With regard to the definition of "export" in s 27(4)(c) of the Trade Marks Act, the Court of Appeal once again referred to s 2 of the Interpretation Act, which states that "export" means "to take or cause to be taken out of Singapore by land, sea or air". More importantly, the

51 *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382.

52 Cap 1, 2002 Rev Ed.

question of whether a mere intention to export without any actual act of export is sufficient to constitute infringement must be answered by examining whether there are accompanying actions which are directed at fulfilling that intention. If there is clear evidence that export was imminent or would definitely take place (as in the present case), this constitutes a threatened infringement of the proprietor's trade mark by way of export, and he is entitled to a *quia timet* injunction against the infringer.

19.66 With regard to the identification of the person liable for such a use, the Court of Appeal opined that it was essentially a question of fact whether the respondent was the importer or exporter of the goods with the infringing signs. Mere identification as the importer on customs declarations for the purposes of custom duties under the Customs Act⁵³ was not determinative. Important factors which must be considered in the assessment included the degree of involvement of the respondent and whether its involvement is needed for the goods to be brought into Singapore. In this regard, the Court of Appeal agreed with the High Court that a distinction was to be made between factors which were considered substantively responsible for and benefited from the import of the infringing goods, and those which merely facilitated the movement of the goods in a technical sense.

19.67 It was noted that in general, freight forwarders tended to have only transitory and facilitative control of the shipment and often lacked actual knowledge of what was contained in the shipment beyond what had been declared to them, as it was not practical to expect freight forwarders to examine all the goods which they were asked to handle. Notwithstanding these limiting factors, the Court of Appeal ruled that the key determining factor of liability in such cases was really the *intention to import or export* under the signs. In other words, if the freight forwarders *knew* that infringing signs were on the goods that it was transshipping, they would be liable for infringement even if they have no title to or an interest in the goods or was acting merely as agent for someone else. It was also not open for the freight forwarders in such circumstances to claim in their defence that they did not know that the goods were not genuine. This is because trade mark infringement is a strict liability tort, and intention or knowledge on the part of the infringer is not relevant. However, if the evidence showed that there was a complete lack of knowledge on the part of the freight forwarders of the existence of the infringing signs on the goods they were transshipping, the freight forwarders ought *not* to be found liable in such a situation.

19.68 In the present case, the Court of Appeal found that while the respondent could have facilitated the physical act of importing goods, he was not liable for trade mark infringement because he did not “use” the signs, as the evidence before the court showed that he was not even aware of their presence and had no reason to believe that they were on the goods he transhipped.

19.69 By focusing on the freight forwarders’ intentions to import and export under the signs, the Court of Appeal’s judgment in *Burberry v Megastar*⁵⁴ served to strike an appropriate balance between the commercial interests of the trade mark proprietors and those of honest freight forwarders who merely played a facilitative role. In this connection, the Court of Appeal made two further points which are noteworthy:

(a) The freight forwarders’ intention and knowledge are to be assessed separately at the time of import and the time of export. Therefore, they are put on notice by events and happenings during the time the goods are in transit that the goods they are transhipping are infringing, and if the freight forwarders so choose to export under these circumstances, they run the risk for being liable for trade mark infringement.

(b) Whilst freight forwarders may not be liable for trade mark infringement, they nevertheless have a duty to disclose any relevant information if they are in possession of counterfeit goods under ss 85A and 93A of the Trade Marks Act.

**B. Scotch Whisky Association v Isetan Mitsukoshi Ltd –
*Opposing registration – Deceiving public as to geographical
origin – Geographical Indications Act***

19.70 In *Scotch Whisky v Isetan*,⁵⁵ the High Court heard an appeal against the decision of the assistant registrar of trade mark dismissing the opposition proceedings commenced by the appellant, Scotch Whisky Association against the registration of the respondent’s (Isetan Mitsukoshi Ltd) ISETAN TARTAN mark in Class 33 for all alcoholic beverages except for beer and sake.

19.71 The grounds of appeal raised by the appellant were:

(a) The ISETAN TARTAN mark should not be registered as it would be contrary to s 7(4)(b) of the Trade Marks Act because

54 See para 19.57 above.

55 See para 19.57 above.

the mark was of such a nature as to deceive the public as to its geographical origin.

(b) The ISETAN TARTAN mark should not be registered as it would be contrary to s 7(5) of the Trade Marks Act read with s 3 of the Geographical Indications Act.⁵⁶

(c) The ISETAN TARTAN mark should not be registered as it would be contrary to s 7(7) of the Trade Marks Act as it contained a geographical indication.

19.72 Before the High Court, the appellant succeeded in its appeal to oppose the registration of the respondent's application mark ISETAN TARTAN on the ground that it would be contrary to s 7(4)(b) of the Trade Marks Act because the mark was of such a nature as to deceive the public as to its geographical origin but failed in relation to the other two absolute grounds for refusal under ss 7(5) and 7(7) of the Trade Marks Act.

(1) *Is the ISETAN TARTAN trade mark of such a nature as to deceive the public as to its geographical origin under section 7(4)(b) of the Trade Marks Act?*

19.73 In applying s 7(4)(b) of the Trade Marks Act to the respondent's ISETAN TARTAN trade mark, the High Court highlighted a number of pertinent principles to be taken note of.

19.74 First, the objection raised in s 7(4)(b) pertains to the deceptiveness of the inherent nature of the trade mark and not deception caused by the similarity of the mark to another. Be that as it may, the assessment of the trade mark is not to be carried out in a vacuum but must be considered against the goods or services applied for and in the general context of the relevant trade. The objection that the trade mark is deceptive to the public as to the geographical origin of the goods has to be a real one. The public in the context of s 7(4)(b) refers to the segment of the public in the general context of the relevant trade. In this particular case, as the appellant had confined its opposition solely to the respondent's use of the ISETAN TARTAN mark in relation to whisky that was not Scotch whisky, the relevant public thus referred to the consumers who drank and purchased whisky.

19.75 The High Court rejected the respondent's argument that there was no real or sufficiently serious risk or danger that a consumer would be deceived that the goods originated from Scotland because even if the

56 Cap 117B, 1999 Rev Ed.

appellant was successful in showing that Singaporeans were familiar with the term “Tartan” and its close association with Scotland, the combination of the both words in the trade mark ISETAN TARTAN called to mind Japan because Isetan was strongly evocative of Japan. Instead, the High Court accepted the appellant’s submissions that the ISETAN TARTAN trade mark was indeed deceptive as to its geographical origin.

19.76 The High Court found that although “tartan” was a generic reference to a cross-checked repeating pattern of different coloured bands, stripes, or lines of definite width and sequence, woven into woollen cloth, it was internationally recognised as an iconic symbol of Scotland. The High Court also held that the evidence adduced by the appellant supported the conclusion that the Singapore public (consumers who drank and purchased whisky) associated any whisky bearing the label TARTAN with whisky originating from Scotland and as such, when TARTAN was used on whisky products that originated from Scotland, the public was likely to be deceived as to the geographical origin of the goods. The deception remained even when ISETAN was used in conjunction with TARTAN as the High Court was of the view that the average consumer of whisky products would attach greater significance to the word TARTAN (as opposed to ISETAN, which was evocative of Japan) and consequently were likely to be deceived that the non-Scotch whisky products bearing the TARTAN label were from Scotland. The appellant’s opposition of the ISETAN TARTAN trade mark was allowed on this ground.

(2) *Should the ISETAN TARTAN trade mark be refused registration as it contains or consists of a geographical indication (section 7(7) of the Trade Marks Act) and the use of a geographical indication is prohibited by the Geographical Indications Act (section 7(5) of the Trade Marks Act)?*

19.77 The appellant also sought to oppose the registration of the respondent’s ISETAN TARTAN trade mark under s 7(5) of the Trade Marks Act on the ground that the use of the trade mark was prohibited in Singapore by any written law or rule of law. To succeed, it was necessary to identify with precision which particular “written law or rule of law” in Singapore was breached. In this regard, the relevant written law or rule of law relied upon by the appellant was the Geographical Indications Act, which prohibited the use of a geographical indication in Singapore in specified situations such as misleading the public as to the geographical origin of the goods (s 3(2)(a)); constituting an act of unfair competition within Art 10 *bis* of the Paris Convention for the Protection of Industrial

Property⁵⁷ (s 3(2)(b)); and identifying a spirit which did not originate from the place indicated by the geographical indication (s 3(2)(d)).

19.78 Another ground for refusal of registration relied upon by the appellant was s 7(7) of the Trade Marks Act, which provides that a trade mark which contains or consists of a geographical indication in respect of a spirit shall be refused registration if the trade mark is used or intended to be used in relation to a spirit not originating from the place indicated in the geographical indication.

19.79 To successfully oppose the respondent's ISETAN TARTAN trade mark under ss 7(5) and 7(7) of the Trade Marks Act, the appellant must prove that there has been "use of a geographical indication" that is prohibited by law, and that the respondent's applicant trade mark "contains or consists of a geographical indication" respectively. Thus, the important and common issue raised by both ss 7(5) and 7(7) was what constituted a "geographical indication".

19.80 In this regard, the High Court held that the phrase "geographical indication" is statutorily defined under s 2 of the Geographical Indications Act, which reads:

'geographical indication' means any indication used in trade to identify goods as originating from a place, provided that –

- (a) the place is a qualifying country or a region or locality in the qualifying country; and
- (b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place.

19.81 One important element in the definition of a geographical indication is the link between the *indication* used in trade to identify goods and the *place* that these goods originate from, that gives the goods a given quality, reputation or other characteristics essentially attributable to *that* place. Therefore, geographical indications usually take the form of *actual geographical name* of places or origins; for example, "Champagne" for wine, "Prosciutto di Parma" for dry-cured ham and "Camembert de Normandie" for Cheese.

19.82 Besides actual geographical names of places or locations, the High Court was of the view that iconic symbols could also serve as geographical indications on the condition that they denote particular *places*.

57 28 September 1979; entry into force 3 June 1984.

19.83 Whilst the High Court was of the view that the word “tartan” was an iconic symbol of Scotland and that the relevant public in Singapore (consumers who drank and purchased whisky) was familiar with the denotation of tartan and its close association with Scotland, it did not find that “tartan” was a geographical indication within the meaning of s 2 of the Geographical Indications Act. This was because a “geographical indication” must refer to a geographical location or place, but the word “tartan” is the name for a cross-chequered repeating pattern. In the absence of a clear connection between the indication and a place or location, the fact that “tartan” was an iconic symbol closely associated with Scotland or was evocative of Scotland was not enough to render it a geographical indication. Based on this finding, the appellant’s grounds of opposition based on ss 7(5) and 7(7) of the Trade Marks Act were dismissed.