

## 20. INTELLECTUAL PROPERTY LAW

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### I. Copyright

#### A. **I-Admin (Singapore) Pte Ltd v Hong Ying Ting – Copyright infringement – Amendment of claim**

20.1 In *I-Admin (Singapore) Pte Ltd v Hong Ying Ting*,<sup>2</sup> 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 brought claims for, among other things, copyright infringement, breach of confidence and breach of contract. In the High Court, Aedit Abdullah J dismissed the plaintiff’s claims, save an award for nominal damages for breach of contract against Hong Ying Ting.<sup>3</sup> The plaintiff appealed to the Court of Appeal. Only the appeal on the copyright infringement claim will be summarised here.

20.2 I-Admin is a Singapore-incorporated company in the business of providing outsourcing services and systems software, specifically payroll administrative data processing services and human resource information systems. 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)

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2 [2020] 1 SLR 1130.

3 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 3 SLR 615.

Ltd (“I-Admin (Shanghai)”), Nice Payroll Pte Ltd (“Nice Payroll”), and Li Yong, a Chinese national and Singapore permanent resident who invested in Nice Payroll.

20.3 In 2009, Hong and Liu shared their frustrations about the plaintiff’s payroll calculation engine, which they thought was flawed and inadequate for the tasks it had to perform. 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 co-operation agreement dated December 2011. On 30 April 2011, Liu resigned from I-Admin (Shanghai), and Hong left I-Admin on 30 June 2011.

20.4 In 2013, the appellant came across Nice Payroll’s website which 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.

20.5 The allegedly infringed materials included: (a) source codes for the appellant’s payroll systems and human resources information systems (“HRIS”) (“Category 1 materials”); (b) databases and other materials constituting the technical infrastructure supporting the payroll systems and HRIS (“Category 2 materials”); (c) business development and client-related materials (“Category 3 materials”); and (d) materials related to its operations, such as documents setting out internal guidelines and policies (“Category 4 materials”).

20.6 The High Court held that there was no copyright infringement.<sup>4</sup> Abdullah J held that while copyright generally subsisted in the plaintiff's materials and that 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 may have been some similarity between the materials, it did not follow, and was not proven, that copying had occurred. Abdullah J found that there had been no substantial copying of the Category 1 and Category 2 materials. He also dismissed the claim in relation to the Category 3 materials because the appellant failed to identify and compare infringing materials belonging to the respondent. No substantive submissions were made on the Category 4 materials and the judge considered it unnecessary to deal with this.

20.7 The appellant challenged these findings, asserting that the respondents had (a) substantially reproduced and/or adapted the Category 2 materials for financial gain ("higher level claim"); and (b) downloaded, possessed and circulated unauthorised copies of the Category 1 to Category 3 materials ("lower level claim").

20.8 The respondents argued that there "has been a substantial change in the appellant's case, in that the claims of copyright infringement and breach of confidence "were premised on the respondents' *use and/or substantial copying* of its materials. Having failed to prove this, the appellant is reframing its case on appeal. It now says that the respondents are liable simply because they *possessed* and *circulated* unauthorised copies of its materials" [emphasis in original]. The respondents contended that "[i]t would be improper and prejudicial to allow the appellant to advance this position on appeal".<sup>5</sup>

20.9 Sundaresh Menon CJ, delivering the unanimous judgment of the Court of Appeal, was of the view that the "general tenor of the appellant's pleadings concerns the use of its material for financial or commercial gain" and "it plainly prioritised its higher level claim of copyright infringement at the trial".<sup>6</sup> It was also acknowledged that "nowhere in the appellant's closing submissions was relief sought purely on the basis of mere possession and circulation".<sup>7</sup>

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4 For a summary and analysis of the High Court decision, see David Tan and Susanna H S Leong, "Intellectual Property Law" (2019) 20 SAL Ann Rev 541 at 541–545.

5 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 1 SLR 1130 at [28].

6 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 1 SLR 1130 at [32].

7 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 1 SLR 1130 at [34].

20.10 The Court of Appeal held that the appellant's lower level claim was not part of its pleaded case. Had the lower level claim been signposted, the trial before the High Court judge would have proceeded quite differently. Menon CJ noted that the question of infringement would have been resolved simply by examining what materials were in the respondents' possession and where those materials came from. There would have been a shorter and much more straightforward trial as there would have been no need for the parties to canvass issues of substantial reproduction and adaptation.<sup>8</sup> Importantly, if one were to proceed on this hypothesis, the respondents might well have chosen to pursue a different channel or litigation strategy from the one they did in fact pursue, and the High Court judge would have likely heard other defence arguments and, possibly, have had to examine further evidence relevant to that. The Court of Appeal concluded that it would therefore be prejudicial to the respondents to make a finding of infringement based solely on the fact of possession and circulation.<sup>9</sup>

20.11 Regarding the higher level claim that concerned the substantial reproduction of Category 2 materials to develop the third respondent's payitem bibles, the question of infringement turned on whether the respondents had reproduced the *organisation* of the Category 2 materials. The Court of Appeal held that both the drafts and final version of the payitem bibles contained differences in arrangement which sufficiently distinguished them from the appellant's materials; hence, there was no copyright infringement.<sup>10</sup>

## II. Patents

### A. **Element Six Technologies Ltd v Iia Technologies Pte Ltd – Patent validity and infringement**

20.12 The parties in *Element Six Technologies Ltd v Iia Technologies Pte Ltd*<sup>11</sup> are chemical vapour deposition (“CVD”) diamond manufacturers. The plaintiff (“Element Six Technologies Ltd”) is the proprietor of two Singapore patents, Singapore Patent No 115872 (“SG 872”) and Singapore Patent No 110508 (“SG 508”), in respect of an optical quality synthetic single crystal CVD diamond material and its method of production. The plaintiff brought the present proceedings against the defendant (“Iia Technologies Pte Ltd”) for allegedly infringing its patents

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8 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 1 SLR 1130 at [35].

9 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 1 SLR 1130 at [35].

10 *I-Admin (Singapore) Pte Ltd v Hong Ying Ting* [2020] 1 SLR 1130 at [41]–[42].

11 [2020] SGHC 26.

and produced three samples of CVD diamonds (“the Samples”) that were purchased directly from either the defendant or the defendant’s related entities or distributors.

20.13 The defendant disputed the validity of the plaintiff’s patents and sought to revoke them in its counterclaim. Furthermore, the defendant contended that the CVD diamonds in the Samples were not its responsibility and did not infringe the plaintiff’s patents. In particular, Claim 1 and Claim 62 of SG 872 and Claim 1 of SG 508 were the focus of the dispute.

20.14 In a lengthy judgment of more than 200 pages, Valerie Thean J provided an in-depth and comprehensive analysis of the following issues:

- (a) validity of SG 872 and SG 508;
- (b) whether the defendant was responsible for the Samples; and
- (c) whether the Samples infringed SG 872 and SG 508.

20.15 The High Court held that SG 872 was valid, but SG 508 was not. In addition, the court held that the Samples originated from the defendant and infringed SG 872 but not SG 508.

(1) *Patent claims in SG 872 and SG 508*

20.16 SG 872 contained both product and process claims whilst SG 508 was a process claim. Claim 1 in SG 872 was a product claim that it was a new grade of single crystal CVD diamond material with exceptionally low strain, in particular low optical birefringence, primarily suitable for use in optical applications. Claims 1(ii) and 1(iii) in SG 872 were the focus of the dispute. The main process claim in SG 872 was Claim 62 which described a method of producing the CVD diamond material comprising substrate preparation and the deliberate adding of nitrogen to the synthesis process. The process claim in SG 508 essentially described the controlled conversion of a coloured single crystal CVD diamond to another colour in a process known as annealing (heat treatment).

20.17 Thean J prefaced the patent validity analysis in her judgment with a few important points:

- (a) The validity of a patent in Singapore must be considered from the three criteria of novelty, inventive step, and capability of

industrial application, upon which a patent is granted under the Patents Act.<sup>12</sup>

(b) Claim construction is integral in the analysis of novelty and inventive step of a patent, and the claims are to be construed purposively from the perspective of a person skilled in the art (“PSA”).<sup>13</sup>

(c) In the present case, the relevant PSA would include a team of individuals with general knowledge and expertise in diamonds and science as well as specialised individuals with doctorate qualifications.<sup>14</sup>

(2) *Validity of SG 872 Claim 1 (Product claim)*

(a) Priority date

20.18 The priority date which is also the date of filing of the patent application is important as it serves as the “cut-off” date in respect of the state of the art in the case of an invention which is used to determine if the invention for which a patent is sought satisfies the requirement of novelty and inventive step under the Patents Act.

20.19 The principle of priority entitlement is well established and a patent application may claim priority from earlier priority applications. In fact, the different claims of a patent application, or even parts thereof, may claim priority from different priority applications; thus, different claims of the same patent may have different priority dates.

20.20 Whilst there was no dispute as to the priority date of 21 November 2002 for Claim 1(ii) in SG 872 on the basis that its priority document GB Patent Application No 0227261.5 (“GB 261”) was filed on 21 November 2002, the defendant, however, argued that the Claim 1(iii) had a later priority date of 20 November 2003 because it was not supported by and extended beyond what was disclosed in the priority document of GB 261.

20.21 The judge set out the relevant provision of s 17(2) of the Patents Act and was persuaded to follow the relevant principles set out in the English Court of Appeal decision in *Unwired Planet International Ltd v Huawei Technologies Co Ltd*<sup>15</sup> (“Unwired”) given that s 17(2) is *in pari*

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12 Cap 221, 2005 Rev Ed.

13 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [12].

14 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [14].

15 [2017] Bus LR 1917 at [56].

*materia* with s 5(2) of the UK Patents Act 1977.<sup>16</sup> In determining whether Claim 1(iii) in SG 872 can claim an earlier priority date of 21 November 2002, the structured approach in *Unwired* requires the court to:<sup>17</sup>

- (a) First, to read and understand, through the eyes of the PSA, the disclosure of the priority document as a whole.
- (b) Second, to determine the subject matter of the relevant claim.
- (c) Third, to decide whether, *as a matter of substance and not form*, the subject matter of the claim can be *derived directly and unambiguously* from the disclosure of the priority document. [emphasis in original]

In addition, it is important to note that the right question is “whether the *invention* is directly and unambiguously derivable from the priority document, not whether every possible embodiment of the invention is so derivable” [emphasis in original].<sup>18</sup> And that “the priority document must be read with the benefit of the common general knowledge which forms the factual matrix against which the technical disclosure is assessed”.<sup>19</sup>

20.22 Applying the structured approach, Thean J was of the view that Claims 1(ii) and 1(iii) are simply different ways of quantifying or measuring the optical birefringence of the CVD diamond produced through the process disclosed in GB 261 and SG 872.<sup>20</sup> There is no difference in inventive concept or method between GB 261 and SG 872, and this is also not disputed by the defendant. As such, the judge held that there is implicit disclosure as a low birefringent CVD diamond within the range claimed in Claim 1(iii) can be derived directly and unambiguously from the priority document GB 261. Claim 1(iii) of SG 872 is therefore entitled to claim priority from GB 261 with a priority date of 21 November 2002.

20.23 The important implication of this conclusion is the reduction of the pieces of prior art citable against SG 872 in the court’s assessment of novelty and inventive step.

(b) Novelty

20.24 Section 14 of the Patents Act is the governing provision on the criteria of novelty in a patent grant. There are two steps to the novelty inquiry: (a) to identify the prior art which are relevant invention in

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16 c 37.

17 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [21].

18 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [22(a)].

19 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [22(b)].

20 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [26].

question; and (b) to consider if the particular piece of prior art identified *anticipates* the invention. Singapore courts have endorsed the test for anticipation as it was set out in the English Court of Appeal decision of *The General Tire & Rubber Co v The Firestone Tyre and Rubber Co Ltd*<sup>21</sup> which requires that “the prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee”. The following relevant principles, as summarised by Thean J, are noteworthy:<sup>22</sup>

(a) The prior art must constitute an enabling disclosure. In the present context, this essentially means that it is not sufficient for the defendant to merely disclose a low birefringent CVD diamond within the SG 872 range in the prior art. More importantly, it must be shown that the prior art also enabled the PSA to make or obtain the said CVD diamond.

(b) Disclosure of the invention in the prior art express or implicit. It can also be inherent, so long as the invention is an inevitable result when a PSA follows the directions in the prior art and this constitutes disclosure notwithstanding that the prior art might not have been described the invention in the same terms as the patent.

(c) The requirement of inevitability in an inherent disclosure must be assessed in a practical manner.

(d) When applying the test of anticipation, each prior art must be considered separately, not to be combined or “mosaic”, unless there is specific reference to a specific portion of an earlier document.

(e) The prior art must be construed as if the court had to construe it at the date of publication. An *ex post facto* analysis of publications post-dating the priority date is not permissible but a distinction ought to be made between *the use of such publications to subjectively interpret the prior art* and the use of such publications *as a means to objectively establish a scientific fact*. The latter is allowed.<sup>23</sup>

(f) The requirement of making available to the public is satisfied even if it has only been disclosed to a single member of the public.

(g) The burden of proving anticipation it is on the party resisting the patent claim.

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21 [1972] RPC 457 at 484.

22 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [29]–[37].

23 See *Smith & Nephew plc and Convatec Technologies Inc* [2013] RPC 6.



20.25 The defendant construed Claim 1 of SG 872 as a product-by-process claim and contended that “a prior art which discloses a natural or HPHT [that is, high pressure and high temperature] diamond within the SG 872 Range will anticipate Claim 1 as CVD diamonds are not a distinct type of diamond”.<sup>24</sup> However, the defendant was unable to show that a CVD diamond is exactly like a natural diamond in its various characteristics and properties. In contrast, the plaintiff was able to demonstrate that a CVD diamond is distinguishable from natural and HPHT diamonds, by looking at the distribution, nature and combination of defects across the three types of diamonds. With the help of instruments such as DiamondView or a photoluminescence spectrometer, a PSA would be able to identify the three different types of diamonds. As such, the court rejected the defendant’s first contention.

20.26 The defendant’s second contention was that the parameters in Claims 1(ii) and 1(iii) were technically meaningless and arbitrary. As such, Claim 1 was a parametric claim which had to be invalidated. The court confirmed that parametricity did not constitute an independent ground for invalidating a patent.<sup>25</sup> Furthermore, the court found that the parameters were essential as they provided a quantitative measurement of the birefringence in the diamond material, and it was logical and sensible for the plaintiff to define a quantitative measurement of the birefringence as what they were claiming was a new grade of CVD diamond with lower birefringence than what had been produced previously.

20.27 In addition, the defendant put forth three categories of arguments to prove anticipation citing three main pieces of prior art, WO 01/96633 and WO 01/96634 (“WO 633” and “WO 634”) and SG 506, against SG 872 Claim 1. The categories of arguments are:

- (a) certain correlations can be observed between dislocation density, Raman peak width and various electrical properties and optical birefringence and the cited prior art enables a PSA to make CVD diamond material with a birefringence value that will fall within the SG 872 range (“Category (a) correlations”);
- (b) prior art which enables a PSA to make CVD diamond material suitable for applications such as etalons, anvils and diamond detectors, and these applications have a birefringence value that fall within the SG 872 range (“Category (b) correlations”); and

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24 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [39].

25 See *Raychem Corp’s Patents* [1998] RPC 31 at 37.

(c) prior art which discloses a similar method of teaching as SG 872, and as such Claim 1 product is inevitably produced (“Category (c) correlations”).

20.28 Thean J accepted that it was not necessary for the defendant to conduct experiments to prove that the prior art anticipated SG 872.<sup>26</sup> The defendant could use other means so long as the burden of proof is satisfied.

**(i) WO 633 AND WO 634**

20.29 The parties agreed that the processes in WO 633 and WO 634 were the same, and the teachings were to eliminate nitrogen in the synthesis gas phase. Both patents were citable against SG 872 as prior art. Both patents did not provide a quantitative measurement of the birefringence of the CVD diamond material produced, but it was still the defendant’s contention that the diamond material would be of a low birefringence within the SG 872 range. The judge, however, concluded that the defendant had not discharged its burden of proof to show that WO 633 and/or WO 634 anticipated Claim 1 of SG 872.

20.30 In relation to Category (a) correlations, Thean J was of the view that there was a need to make a distinction as to whether the authors of the prior art had sought to establish a certain correlation between the relevant parameters of the diamond material such as dislocation density and birefringence, or were merely making empirical observations based on a limited set of data. Whilst the judge accepted that there was no need for the defendant to show a known formula of conversion from dislocation density into a corresponding value of optical birefringence, and that it was sufficient if the defendant could show that the correlation resulted in a CVD diamond material with a birefringence value within the SG 872 range, the judge concluded that the defendant failed to discharge its burden of proof.

20.31 Importantly, Thean J found that the various publications that the defendant relied upon for the alleged correlations failed to support its argument of anticipation for either one or a combination of the following reasons: (a) the publication was concerned with other types of diamond; (b) the publication was merely reporting on empirical observations; (c) the publication did not mention the thickness of the diamond; and (d) the publication actually supported the plaintiff’s position to some extent.<sup>27</sup>

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26 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [42].

27 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [65]–[91].

20.32 As for Category (b) correlations, Thean J similarly found that publications that the defendant relied on did not concern CVD diamond and failed to establish any correlation in terms of birefringence values. If any, they merely illustrated best practices or common practices in the selection of diamond material. In the case of etalons, the judge found that it was:<sup>28</sup>

... not sufficient for the defendant to show that selected CVD diamond material produced according to the directions WO 633 and WO 634 could be used as etalons. The test for anticipation requires a PSA, following the directions in WO 633 and WO 634, to inevitably produce a low birefringent diamond of requisite thickness within the SG 872 Range.

## (II) SG 506

20.33 Specifically, SG 506 teaches a method of improving the quality of substrates by growing a CVD diamond using the methods claimed in WO 633 and WO 634 and by cutting the grown diamond parallel to the growth direction. The defendant cited Examples 1 and 2 of SG 506 to prove anticipation of the invention in SG 872 Claim 1. The plaintiff argued that Examples 1 and 2 of SG 506 were not citable against SG 872 as they were not found in the priority document of SG 506, that is, GB Patent Application No 0221949.1 (“GB 949”).

20.34 Thean J held that s 17(2)(b) of the Patents Act provides that a “matter” is only allowed to claim priority from an earlier application if it was “disclosed”.<sup>29</sup> As Examples 1 and 2 of SG 506 were not disclosed in the priority document of SG 506, that is, GB 949, they were not relevant for the novelty inquiry. Examining the merits of the contention that Examples 1 and 2 of SG 506 anticipated the invention in SG 872, the judge concluded that if Example 1 of SG 506 was disclosed and thus relevant, it would have anticipated Claim 1 of SG 872. On the other hand, the judge found the general teaching in SG 506 does not anticipate Claim 1 of SG 872. The defendant could not show that “a PSA following the broad teaching in SG 506 would *invariably* produce a diamond that is ‘suited to the application of etalons,’ if the method used in Example 1 is not otherwise followed”.<sup>30</sup> Hence, SG 506 does not anticipate Claim 1 of SG 872.

20.35 The court further noted that the defendant could have conducted experiments to show that following the teachings in SG 506 would

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28 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [127].

29 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [138].

30 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [142].

inevitably result in a low birefringent CVD diamond within the SG 872 range, but the defendant did not.

20.36 In relation to Category (c) correlations, the defendant contended that the prior art cited must result in the product of Claim 1 as identical methods were asserted, and accordingly the prior art anticipated SG 872 Claim 1. Thean J rejected the contention that the methods in the prior art were identical to the one in SG 872 as the method in SG 872 taught the controlled addition of nitrogen within a specific range, whilst none of the other prior art cited disclosed this method.<sup>31</sup>

(c) Inventive step

20.37 Section 15 of the Patents Act sets out the requirement of inventive step in a patent grant. Making a note that the “relevant state of the art for the inventiveness inquiry excludes unpublished patent applications which have a priority date earlier than the invention”,<sup>32</sup> the judge emphasised that when considering the requirement of inventive step, it is assumed that the invention is novel in the sense that it differs in some identifiable aspects from the prior art. The analytical framework for inventive step is the four-step approach as set out in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd*<sup>33</sup> (“*Windsurfing*”). Furthermore, “it is permissible to ‘mosaic’ the various pieces of prior art in the inquiry for inventiveness, unless the act of ‘mosaicing’ itself is not obvious to the PSA”.<sup>34</sup>

20.38 It is important to remember that the novelty inquiry should not be conflated with the inventiveness inquiry, an error which the court highlighted that the defendant had made by arguing that “the product claim does not involve an inventive step simply because it is anticipated by the prior art.” Rather, the right question to consider is “whether the steps to be undertaken, in order to obtain a CVD diamond within the SG 872 range, would have been obvious to a PSA”.<sup>35</sup> Concluding that there was inventiveness, the judge found that using the prior art relied upon by the defendant would not have been obvious to a PSA.

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31 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [151].

32 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [153].

33 [1985] RPC 59.

34 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] [2020] SGHC 26 at [159].

35 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] [2020] SGHC 26 at [169].

(d) Sufficiency

20.39 To qualify for a patent grant, s 25(4) of the Patents Act requires for the disclosure in the patent application to be sufficient. An enabling disclosure or a sufficient disclosure is one which is “clear and complete for the invention to be performed by a person skilled in the art”, without which the patent may be revoked in accordance with s 80(1)(c) of the Patents Act. The relevant two-stage test to be applied is set out in the English case of *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd*,<sup>36</sup> which is adopted by the Court of Appeal in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd*.<sup>37</sup> The first stage is to “identify the invention and decide what it claims to enable the skilled man to do”. The second stage is to then assess “whether the specification enables him to do it”.<sup>38</sup> The following considerations and principles are relevant:

(a) The specification must be specific enough to enable a skilled person in the industry to carry out the invention without making further inventions or prolonged study. However, it is not necessary to be so detailed such that the invention could be performed with any trial or experiment.

(b) The “description of the invention should not be unnecessarily difficult to follow, and must not contain any traps or seriously misleading statements which the reader cannot correct”.

(c) The question of sufficiency is a matter of fact and degree.

(d) The burden of proof is on the party seeking to invalidate the patent to show that the ambiguities would render the invention unworkable from the point of view of a PSA.

(e) The breadth of the claims is relevant to an assessment of the sufficiency requirement.

20.40 In her judgment, Thean J addressed the defendant’s contentions on why Claim 1 of SG 872 was not sufficient, all of which were highly technical in nature, in light of the expert evidence that was subjected to cross-examination. The judge concluded that the Claim 1 of SG 872 disclosed the invention sufficiently for a PSA to perform it and that Claim 1 of SG 872 was valid.

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36 [2005] RPC 9 at [103].

37 [2008] 1 SLR (R) 335 at [61]–[62].

38 *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9 at [102]–[104].

(3) *Validity of SG 872 Claim 62 (Process claim)*

20.41 Claim 62 of SG 872 discloses the method of producing the CVD diamond material, which is the product invention claimed in Claim 1. It teaches the “deliberate and controlled addition of nitrogen in the range of 300ppb to 5ppm” (“Claim 62 range”) to produce the CVD diamond with a low optical birefringence in the range of values stated in the claims. There is no dispute as to its priority date.

(a) Novelty

20.42 The defendant’s main contention in the novelty inquiry was that it was sufficient to establish anticipation if a prior art disclosed a single value that falls within the Claim 62 range or, where there was an overlap in ranges but no specific example in the range of the overlap, it was sufficient if a PSA would have seriously contemplated applying the prior art in the region of the overlap.

20.43 In terms of the issue of anticipation of ranges, the court adopted the approach in the English Court of Appeal case of *Jushi Group Co Ltd v OCV Intellectual Capital LLC*<sup>39</sup> (“*Jushi*”) and decided that the question to be asked was “whether the prior art taught the PSA that they should operate in the area of the combined overlap of the ranges”.<sup>40</sup> In the novelty inquiry of the case before the judge, the question that had to be addressed was whether the performance of the teachings in the prior art will inevitably result in an infringement of Claim 62.

20.44 Taking the example of cited prior art, SG 508, which only contained three examples which were disclosed in GB 772 (its priority document), Thean J explained the approach to the anticipation inquiry of overlapping ranges as set out in *Jushi*. In these examples, nitrogen was introduced into the growth process at a concentration of 10ppm. The question to address was whether the prior art SG508/GB 772 taught the PSA to add a nitrogen concentration in the combined region of overlap – 0.5ppm to 5ppm. Given that the preferred range is between 2ppm and 30ppm, and the examples expressly stated that nitrogen was introduced at 10ppm, this would have pointed the PSA away from operating at the combined region of overlap of 0.5ppm to 5ppm. There is “nothing in SG 508 which teaches the PSA *not to use* nitrogen above 5ppm” [emphasis in original].<sup>41</sup> Instead, the PSA would be taught by the prior art to use

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39 [2019] RPC 1.

40 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [234].

41 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [239].

nitrogen at 10ppm. Therefore, the court concluded that SG 508 did not anticipate Claim 62 of SG 872.

20.45 Applying a similar approach and upon reviewing all the relevant prior art, the court concluded that Claim 62 of SG 872 had not been anticipated and was thus novel.

(b) Inventive step

20.46 Applying the *Windsurfing* approach,<sup>42</sup> the question was whether it would have been obvious to a PSA to add nitrogen within the controlled range of 300ppb to 5ppm in the synthesis atmosphere in order to obtain a low birefringent diamond in the SG 872 Range.

20.47 The addition of nitrogen within the controlled range was contrary to common general knowledge at the time of the priority date. In fact, the common general knowledge was that “nitrogen was seen as an impurity or contaminant which ought to be reduced to the lowest practical levels possible”.<sup>43</sup> Hence, the addition of nitrogen would not have been obvious to the PSA. The judge highlighted that the defendant failed to address the right question which is to be directed at the inventive concept of Claim 62, that is, whether it would be obvious to add nitrogen, in a controlled range, to obtain CVD diamonds of lower birefringence than those that existed in the prior art.

(c) Sufficiency

20.48 The court rejected the defendant’s argument that the claim was insufficient because a PSA would not know how to select the appropriate nitrogen concentration because the claim clearly stated a range between 300ppb to 5ppm. With regard to the contention that a PSA would not be taught how to calibrate the other growth parameters to ensure that the level of nitrogen was kept consistently at the desired level, the judge rejected the argument because the missing details would be within the knowledge of the PSA and the burden of proof was on the defendant to show that this ambiguities would render the invention unworkable.<sup>44</sup> The mere pointing out of the ambiguities was insufficient for the court to conclude that the disclosure was not enabling. The argument that the claim was insufficient because of the overlap of examples in SG 872, SG 508 and GB 115 was also rejected as the judge failed to see why such overlap would render Claim 62 of SG 872 insufficient. What was required

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42 See para 20.37 above.

43 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [256].

44 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [285].

was for Claim 62 to be clear and complete such that a PSA could work the invention. The fact that the plaintiff had not stressed the significance of certain parameters which were different from other patents did not mean that Claim 62 was insufficiently disclosed.<sup>45</sup>

(4) *Validity of SG 508 (process claim)*

20.49 SG 508 teaches a method of annealing CVD diamonds to the desired colour. Thean J found SG 508 neither novel nor inventive.

(a) Novelty

20.50 SG 508 is anticipated by WO 406 because the scope of WO 406 would not have been intended to be limited to natural diamonds due to the use of the word “generally” in Claim 1 and the wording of Claim 2 which refers specifically to natural diamond.<sup>46</sup> SG 508 is also anticipated by EP 482 and US 430 because there is inherent disclosure as it is clear that the annealing process in SG 508, EP 482 and US 430 are the same. Furthermore, there are two papers which support this fact. SG 508 is anticipated by Schmetzer as he “teaches that the original brown colour of CVD diamonds can be ‘removed’ or ‘lightened’ through EP 482”.<sup>47</sup>

(b) Inventive step

20.51 SG 508 is not inventive as it is clear from the prior art that annealing would change the colour of the diamond.<sup>48</sup> There is lack of evidence to the contrary.

(5) *Infringement of SG 872 and SG 508*

(a) Provenance

20.52 The defendant denied that the three samples provided by the plaintiff originated from it. The burden of proof was on the plaintiff to demonstrate that the infringing samples originated from the defendant. Thean J rejected the defendant’s proposition that, based on case law, the plaintiff *must* call persons with personal knowledge to testify to prove provenance.<sup>49</sup> To the contrary, the plaintiff could adduce other evidence including documentary evidence to prove provenance of the Samples.

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45 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [287].

46 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [298].

47 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [312].

48 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [321].

49 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [342].



The judge found that the plaintiff had established, on a balance of probabilities, that the Samples originated from the defendant on the basis of contemporaneous documentary records.<sup>50</sup>

(b) Chain of custody

20.53 The burden of proof was on the plaintiff to prove the chain of custody of the Samples. The judge was of the view that it was sufficient “for the plaintiff to prove that it is more likely than not that the Samples remained the same between the time they were purchased from the defendants and underwent the relevant tests”.<sup>51</sup> Thean J rejected the defendant’s proposition on the basis that the cases relied on by the defendant did not support the proposition; in fact they were founded purely on the theoretical possibility of a break in the chain of custody.

(c) Infringement

20.54 The court held that the Samples infringed both Claims 1 and 62 of SG 872 on the basis of measurements which were recorded in experiments conducted at the University of Warwick.<sup>52</sup> Though Claim 1 of SG 508 was technically infringed, there was a complete defence to infringement as SG 508 was found to be invalid for lack of novelty and inventiveness.

**B. Zyfas Medical Co v Millennium Pharmaceuticals Inc – Leave to appeal – Statutory interpretation**

20.55 In *Zyfas Medical Co v Millennium Pharmaceuticals Inc*<sup>53</sup> before the Court of Appeal, the appellant, Zyfas Medical Co, is a distributor of generic pharmaceutical, medicinal and healthcare products. The respondent, Millennium Pharmaceuticals, Inc (“Millennium”), sought a declaration from the High Court that the appellant had failed to disclose the existence of the respondent’s process patents in its application to register a therapeutic product, Myborte, with the Health Sciences Authority (“HSA”) under the Health Products Act<sup>54</sup> (“HPA”) and the Health Products (Therapeutic Products) Regulations 2016<sup>55</sup> (“TPR”). The process patents relate to the manufacturing process that produces

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50 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [351].

51 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [352].

52 *Element Six Technologies Ltd v Ila Technologies Pte Ltd* [2020] SGHC 26 at [416].  
53 [2020] 2 SLR 1044.

54 Cap 122D, 2008 Rev Ed.

55 S 329/2016.

the active ingredient, bortezomib, that can be found in the appellant's therapeutic product.

20.56 The appellant took the position that there was no omission in its statements to the HSA as the process used to manufacture the therapeutic product did not infringe the respondent's patents. The appellant's arguments were similar to those made by Drug Houses of Australia Pte Ltd ("DHA") in *Millennium Pharmaceuticals Inc v Drug Houses of Australia*<sup>56</sup> ("*Drug Houses of Australia*"), involving the same patent proprietor, Millennium (the respondent in the present case). Millennium commenced an action against DHA for obtaining registration of bortezomib as a therapeutic product without declaring the existence of the process patents. DHA argued that its process for manufacturing bortezomib did not infringe Millennium's patents and the patents therefore did not have to be disclosed, and was successful before the High Court. On appeal, the Court of Appeal held that DHA had to declare the existence of Millennium's process patents and then state that the patents were invalid or would not be infringed by the doing of the act for which registration was sought. It was then for the HSA to decide whether to invoke reg 23(5) of the TPR to require DHA to serve a notice to Millennium as proprietor of the patents.

20.57 As such, the appellant conceded in its submissions before the High Court that the *obiter dicta* in *Drug Houses of Australia* correctly represented the law and that the High Court judge was bound by that decision.<sup>57</sup> Hence, the appellant's sole argument before the High Court was that it did not knowingly or intentionally omit to declare the material information with regard to the existence of the appellant's patents as they applied to register the product a year before the decision of *Drug Houses of Australia*. Thus, the sole issue that the High Court considered was whether there was a requirement for knowledge or intention for the omission before a declaration could be granted, to which the judge concluded that there was no such requirement. All that the respondent is required to show was a failure to disclose in order to obtain the declaration. The High Court granted the declaration and the appellant appealed.

20.58 On appeal, the appellant sought to argue that the process patents fall outside the ambit of reg 23 of the TPR and that only product patents are required to be disclosed. The Court of Appeal had strong words for this change in position by the appellant. It was highly unsatisfactory for the appellant to have done so as (a) it was "effectively asking the Court of Appeal to rehear the entire case on a totally different basis, thereby

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56 [2019] SGCA 31.

57 *Zyfas Medical Co v Millennium Pharmaceuticals Inc* [2020] 2 SLR 1044 at [12].

converting what should have been an appeal into a second trial”;<sup>58</sup> and (b) the “new” argument was obviously not new and should have been considered and conceded by counsel.

20.59 Nevertheless, Tay Yong Kwang JA, delivering the unanimous judgment of the Court of Appeal, granted the appellant leave to appeal on the grounds that (a) certainty on this point of law is necessary as it would affect many stakeholders; (b) it would not cause prejudice to the respondent who had ample notice; and (c) it would not disturb the High Court’s finding of being bound by the *obiter dicta* in *Drug Houses of Australia* anyway, even if the appellant did not make any concessions.

20.60 Having considered the parties’ arguments and applying the three-step purposive approach to statutory interpretation laid down in *Tan Cheng Bock v Attorney-General*,<sup>59</sup> the Court of Appeal concluded that (a) they “agree with the Judge that the purpose of reg 23 TRP was to fulfil Singapore’s obligations under the USSFTA through the patent linkage scheme”;<sup>60</sup> and (b) local legislation is not to be interpreted in derogation to treaty obligations, but to be interpreted as consonant as possible.<sup>61</sup> The Court of Appeal held that process patents fall within the scope of reg 23(2)(a) of the TPR such that a broad interpretation should be taken.<sup>62</sup> As this is consistent with the legislative purpose of giving notice and protection to proprietors, there is no reason for the law to accord more protection to product patents.

### III. Trade marks

#### A. *Tomy Inc v Dentsply Sirona Inc – Invalidation against registration – Bad faith*

20.61 *Tomy Inc v Dentsply Sirona Inc*<sup>63</sup> is a trade mark dispute between two orthodontic manufacturers. The respondent, Dentsply Sirona Inc, is the holding company for GAC International LLC (“GAC”), which is the appellant’s distributor in Singapore. The relationship between the appellant and GAC spans across several successive agreements, four of those were relevant to the present dispute, namely, 1986, 1998, 2004 and 2012 agreements. It is important to note that each successive agreement expressly supersedes the previous one. The respondent raised four grounds

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58 *Zyfas Medical Co v Millennium Pharmaceuticals Inc* [2020] 2 SLR 1044 at [30].

59 [2017] 2 SLR 850 at [37]–[53].

60 *Zyfas Medical Co v Millennium Pharmaceuticals Inc* [2020] 2 SLR 1044 at [44].

61 *Zyfas Medical Co v Millennium Pharmaceuticals Inc* [2020] 2 SLR 1044 at [45].

62 *Zyfas Medical Co v Millennium Pharmaceuticals Inc* [2020] 2 SLR 1044 at [48].

63 [2020] 5 SLR 424.

of invalidation against the registration of the following trade marks by the appellant, “MICROARCH”, “SENTALLOY”, and “BIOFORCE”, that is, the disputed marks. The intellectual property adjudicator found for the respondents on the basis that the appellant had filed in bad faith, causing the applications to be invalid.<sup>64</sup> He also decided that it was not necessary to consider the remaining grounds of invalidation.

20.62 The appeal to the High Court, therefore, focused on the ground of bad faith. Dedar Singh Gill JC agreed with the adjudicator that there was bad faith on the part of the appellant and also found it unnecessary to consider the remaining grounds.

20.63 Gill JC first dismissed the appellant’s contention that the respondent was not a party to the 2012 agreement and therefore should not be able bring a claim of ownership. This is because s 23(5) of the Trade Marks Act<sup>65</sup> (“TMA”) allows for “any person” to apply for a declaration of invalidity. In order to determine whether there is bad faith, it is necessary first to decide on the question of ownership<sup>66</sup> and this question is often answered by looking at the contractual agreements between parties assigning or stipulating for the right to register a trade mark.<sup>67</sup>

20.64 It is only in the absence of such contractual agreements that the default common law position that the first user of the mark in Singapore is the true owner will apply. The court noted that there was no dispute as to ownership of the disputed marks for countries that were specifically listed in Exhibit 3 of the 2012 agreement. Therefore, the determinative question was “whether GAC’s ownership of the Disputed Marks extends beyond the listed countries based on a proper construction of Art 13 of the 2012 Agreement”.<sup>68</sup> In other words, the critical issue before the court was the scope of the term “Existing Trademarks” and whether it includes the unregistered disputed marks.

20.65 The judge took the view that the unregistered disputed marks fell within the meaning of “Existing Trademarks” upon a proper construction of Art 13.4 of the 2012 agreement and gave two reasons. First, Art 13.4 of the 2012 agreement was to be construed in light of Art 14.4 of the 1998 agreement, which sought to achieve two objectives: (a) to impose an obligation on GAC to maintain the marks at its own expense; (b) to grant

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64 *Tomy Inc v Dentsply Sirona Inc* [2019] SGIPOS 13.

65 Cap 332, 2005 Rev Ed.

66 *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR (R) 1073.

67 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [31].

68 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [42].

Tomy Inc a non-exclusive licence to use the “Existing Trademarks” “for the purpose of producing and selling the ‘Products’”.<sup>69</sup>

20.66 Second, the language of Art 13.4 of the 2012 agreement is consistent with the intentions of the parties in Art 14.4 of the 1998 agreement to include the unregistered disputed marks. This is emphasised through the use of a particular phrase such as “includ[e] but [are] not limited to, those which are identified in Exhibit 3”.<sup>70</sup>

20.67 Examining the agreements between the parties, Gill JC found that their relationship was clearly not one of a straightforward manufacturer and distributor. Whatever the state of their relationship then, it was clear that the parties at the time of the contract intended to collaborate on the invention of patents. The patent and trade mark licensing clauses collectively indicated that the nature of the parties’ relationship was akin to one where an original equipment manufacturer (the appellant) makes products on the instructions of a third party (the respondent). In other words, the appellant was permitted to utilise the patented technology for products that it sold in its own capacity, but it was not allowed to use the disputed marks in its own capacity.<sup>71</sup>

20.68 Applying the subjective component of the “combined” test in *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd*,<sup>72</sup> the court found that the appellant registered the subject marks on 22 January 2013 knowing that it was not entitled to do so without first consulting GAC or the respondent. The proper construction of the contract, the prior agreements, and the parties’ pre-existing relationship all led to the conclusion that the appellant knew that it was not entitled to register the disputed marks.<sup>73</sup>

20.69 With regard to the objective component of the test for bad faith, Gill JC held that the appellant’s registration of the disputed marks fell outside the scope of acceptable commercial behaviour observed by reasonable and experienced persons, because it registered marks belonging to its business partner with whom it has a contractual relationship.<sup>74</sup> The appellant’s conduct was akin to trade mark hijacking.<sup>75</sup> Therefore, the appellant registered the subject marks in bad faith pursuant to s 7(6) read with s 23(1) of the TMA.

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69 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [43].

70 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [44].

71 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [49].

72 [2009] 2 SLR(R) 814.

73 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [62].

74 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [64].

75 *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [63].

**B. Harvard Club of Singapore v President and Fellows of Harvard College – Opposition to registration – Passing off – Bad faith – Prohibition by law**

20.70 In *Harvard Club of Singapore v President and Fellows of Harvard College*<sup>76</sup> before the High Court, the appellant, Harvard Club of Singapore (“the Club”), is a registered society which has served the Harvard Alumni in Singapore for close to 50 years. The respondent, President and Fellows of Harvard College (“the University”), is the body corporate which constitutes Harvard University. As a result of disputes between the leadership of the Club and the University, the University officially terminated its affiliation with the Club in 2015. In the midst of the dispute, the University applied for registration of “Harvard Club of Singapore” and “Harvard University Club of Singapore” (“Application Marks”) on 24 December 2014. The Club opposed the University’s trade mark applications on three grounds: (a) passing off under s 8(7)(a) of the TMA; (b) bad faith under s 7(6) of the TMA; and (c) use prohibited in Singapore by written law or rule of law under s 7(5) of the TMA read with s 4(3)(c) of the Societies Act.<sup>77</sup> The Principal Assistant Registrar (“PAR”) at the Trade Marks Registry ruled in favour of the University and the Club appealed. In the High Court, Chan Seng Onn J considered the appeal on a *de novo* basis and dismissed the appeal on all three grounds.

(1) *Passing off under section 8(7) of the Trade Marks Act*

20.71 To successfully oppose the Application Marks under s 8(7) of the TMA, the Club had to establish a *prima facie* case of passing off by proving that the three elements of the tort namely, goodwill, misrepresentation and damage were satisfied.

(a) Goodwill

20.72 Goodwill is the attractive force which brings in custom, and Chan J noted that the protection which passing off confers can extend to the goodwill that non-commercial organisations such as charities and non-profit association such as the Club may generate.<sup>78</sup> It was not disputed that the Club’s activities had generated goodwill. Instead, the critical issue before the High Court was the ownership of the goodwill. After completing a three-step analysis, Chan J concluded that ownership of the goodwill belonged to the University.

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76 [2020] 4 SLR 1378.

77 Cap 311, 2014 Rev Ed.

78 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [37].

20.73 First, the judge studied whether there was an implied licence between the Club and the University. Although a formal trade mark licence agreement had not been entered into between the parties with regard to the use of the Harvard marks, Chan J concluded that there was an implied licence to use because the University has exerted *a sufficient degree of control and supervision over* the Club and its activities.<sup>79</sup> It was clear that the founders of the Club intended the Club to operate under the auspices of the University. The Club was aware, at all times, that it had to fulfil certain basic conditions to maintain its affiliation with the University and the Club had complied with these conditions. The Club continued to seek guidance from the University and was fully aware of the conditions imposed by the University during the first three years of Irene Lee Siew Mun's tenure as the Club's President. The parties had conducted themselves in a manner that parties in a licensor-licensee relationship would.

20.74 Furthermore, the court found the implied licence between the Club and the University to be a limited and an exclusive one.<sup>80</sup> It was limited in the sense that the implied licence only covered the sphere of the Club's activities and operations, and nothing more. The implied licence was exclusive because it was not disputed that up to 2014 (before relationships broke down between the University and the leadership of the Club), the Club was the first and only Harvard Club in Singapore. In late 2011, the Club took swift action to call upon the University to enforce its trade mark rights when it felt that its position as the sole Harvard alumni organisation in Singapore was threatened by the actions of another alumnus who was not officially sanctioned by the University, and the University responded by providing guidance.

20.75 Finally, on the issue of whether the existence of an implied licence *ipso facto* also meant that the licensor owns all the goodwill, Chan J was of the view that as there was no express contract or agreement between the parties, this question must be answered having regard to all the facts of the case.<sup>81</sup> After reviewing the factual matrix of the present case, the judge concluded that ownership of the goodwill resides in the University because (a) the "success and continued operation of the Club would not be possible without the help and support of the University"; and (b) "events post-termination do show that the attractive force in the

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79 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [78].

80 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [82].

81 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [90].

activities and functions of the Club is actually rooted in its connection to the University”.<sup>82</sup>

(b) Misrepresentation

20.76 The High Court reiterated that the distinctiveness inquiry must only be considered at the misrepresentation stage of proving passing off.<sup>83</sup> Put simply, if the Application Marks, in particular “The Harvard Club of Singapore”, were found *not* distinctive of the Club’s services and activities, then the University, in attempting to register the Application Marks and presumably using it in the future would not have committed an actionable misrepresentation. Chan J concluded that the Application Marks were not distinctive of the Club but of the University and its Harvard Clubs as a whole. This was because the goodwill generated by the Club was associated with the word “HARVARD”, which is evocative of the University that is a result of the University’s substantial investment in advertising, promoting and protecting the Harvard marks in Singapore and around the world.<sup>84</sup>

(2) *Bad faith under section 7(6) of the Trade Marks Act*

20.77 The judge summarised the principles of bad faith<sup>85</sup> (as set out by the Court of Appeal in *Valentino Globe BV v Pacific Rim Industries Inc*)<sup>86</sup> as follows:

- (a) Bad faith includes legitimate dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade.
- (b) The test for bad faith “contains both a subjective element (what the particular applicant knows) and an objective element (what ordinary people adopting proper standards would think)”.
- (c) There must be sufficient evidence to support an allegation of bad faith.
- (d) The burden of proof is on the party opposing the trade mark application.

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82 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [94]–[95].

83 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [101].

84 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [103].

85 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [110].

86 [2010] 2 SLR 1203.



- (e) The date of filing the application for registration is the relevant date for determining bad faith.

20.78 Chan J rejected all three arguments submitted by the Club and found that the Club had “failed to discharge its burden to show even a *prima facie* case of bad faith”.<sup>87</sup> The Club’s first argument that there was lack of authority on the part of the Harvard Alumni Association and its representative to file the trade mark applications was wholly without merit. The court found that the University was clearly aware of what was going on, and the persons involved had authority by virtue of their office to act for and on behalf of the University in the trade mark applications. Regarding the Club’s assertion that the conduct of the University was improper, dishonest or unacceptable, the judge agreed with the PAR’s decision to reject this line of argument because the University being the owner of the goodwill generated by the Application Marks, is entitled to file for their registration and this fall within the standards of acceptable commercial behaviour. Finally, the Club contended that there was no intention on the part of the University to use the trade marks but the judge ruled that it was clear that use of a registered trade mark need not be immediate. Under s 22(1)(a) of the TMA, a registered mark only becomes liable to be revoked on the basis of non-use for five years after the completion of registration.

- (3) *Use prohibited in Singapore by written law or rule of law under section 7(5) of the Trade Marks Act read with section 4(3)(c) of the Societies Act*

20.79 The Club mounted this ground of opposition in relation to only the first application mark, that is, “HARVARD CLUB OF SINGAPORE”. The Club attempted to rely on the refusal of the Registrar of Societies to register the society on the basis that its name “HARVARD UNIVERSITY CLUB OF SINGAPORE” was caught by the deceptive resemblance ground under s 4(3)(c) of the Societies Act, as the basis that the use of “HARVARD CLUB OF SINGAPORE” is prohibited by a written law.

20.80 Chan J agreed with the PAR that s 7(5) of the TMA is not meant to be read together with s 4(3)(c) of the Societies Act so as to cover the situation at hand.<sup>88</sup> First, the judge ruled that prohibition by “written law” refers to express prohibition in a statute, and the decision of the Registrar of Societies to disallow registration cannot count as a “written

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87 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [123].

88 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [129 (b)]

law”. Even the less defined term of “rule of law” in s 7(5) of the TMA is not meant to cover the situation of the Registrar of Societies exercising his discretion to refuse registration of a society for falling foul of either the deceptive resemblance or identical name grounds under the Societies Act. Furthermore, the word “use” in s 7(5) of the TMA relates to “actual use” in the trade mark sense and does not cover the mere registration of a society. Chan J was of the view that the authority of the Registrar of Societies under ss 4(3)(c)(i) and 4(3)(c)(ii) of the Societies Act is limited to the registration of society names; it does not extend to trade marks. As the Societies Act and the TMA govern distinct regimes that deal with wholly disparate subject matters, it is against public policy to allow a registration in the Register of Societies to block a trade mark application in the trade marks register.<sup>89</sup>

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89 *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] 4 SLR 1378 at [132].