

Trademarks

Contributing editors

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DEAL THROUGH 

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1 Ownership of marks

Who may apply?

Regardless of nationality or residency, a trademark may be applied for by an individual, firm or a company that is currently using or intends to use its trademark in the course of trade in Singapore. A trademark registration can be owned solely or jointly by two or more persons in equal undivided shares in the trademark.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

The Trade Marks Act (TMA) defines a trademark as 'any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person'. A sign can be 'any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof'.

Based on the aforesaid definition, both conventional and non-conventional marks such as colour marks, three-dimensional marks, sound marks, smell marks, movement marks, holograms are registrable in Singapore. In addition to conventional and non-conventional marks, certification marks and collective marks are also registrable in Singapore.

A certification mark is defined under the TMA as 'a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade and certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from other goods or services dealt with or provided in the course of trade but not so certified'.

A collective mark is defined under the TMA as 'a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association'.

3 Common law trademarks

Can trademark rights be established without registration?

Yes, a business owner can acquire unregistered trademark rights under common law through use of a trademark on specific goods or services sold in Singapore. Under the tort of passing-off, a business owner who has prior trademark rights through use may be able to rely on its common law trademark in a legal action against a third party who sells goods or services in Singapore to consumers under the same or similar trademark as the business owner.

To succeed under the tort of passing-off, three requirements must be met:

- The presence of goodwill: goodwill can be described as 'the attractive force arising from the business' name and reputation which brings in custom'. A business owner must have reputation in Singapore as well as a goodwill attached to a business based in Singapore before pursuing a legal action under passing-off.

Whether goodwill is present depends on a number of factors including the volume of sales and advertising over the years.

- Misrepresentation: in addition to proving goodwill, a business owner must show that there has been misrepresentation by a third party as to the origin of goods or services because the third party has adopted a trademark or get up for its goods or services which is identical or similar to the business owner's, thereby misleading or confusing consumers into thinking that the goods or services of the third party belong to or are associated with the business owner. It is not necessary to show that the third party intended to deceive consumers.
- Damage: finally, the business owner must show that there was, and is likely to be, some form of damage, for example damage to reputation, dilution of its goodwill or loss of profits, as a result of the third party's misrepresentation.

In general, the burden of proof in an action based on the tort of passing-off is high, making it difficult to succeed. Therefore, although common law trademark rights exist in Singapore, ideally, if a business owner wants exclusive rights to use a trademark in Singapore and stop third parties or competitors from any unauthorised use of this trademark, the best approach is to register the said trademark in Singapore.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

Assuming no office action is issued or third-party opposition is filed, it takes approximately eight to 10 months for a straightforward trademark application to be registered in Singapore. The application process includes a formal examination at the Intellectual Property Office of Singapore (IPOS) as well as a two-month opposition period from the date of publication of the application in the Trade Marks Journal. If, during examination, an office action is issued against a trademark application by IPOS or a trademark application is opposed by a third party after it has been published, the time frame to register the trademark will increase.

The costs to register a straightforward trademark application in Singapore would vary depending how many classes are involved and how the application is filed, for example, through the Madrid Protocol system or nationally, through a local trademark agent or by the business owner itself. As an estimate, the costs to register one mark in one class could range between US\$800 to US\$1,000, inclusive of IPOS official fees. Some trademark agents charge lower professional filing fees for additional classes in a multi-class application, although the IPOS official fees are the same for each class.

With effect from 1 April 2017, IPOS official fees for filing have been reduced by 30 per cent only when an application is filed using IPOS pre-approved list of goods or services.

No power of attorney or any other document is required to file a trademark application in Singapore.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

Singapore adopts the 11th edition of the Nice Classification, which entered into force on 1 January 2017. Multi-class applications are available in Singapore but there are no cost savings because the IPOS official fees are the same for each class.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

Once an application is filed, it enters the examination stage within three months. At the examination stage, a registrar will review the application to determine whether the trademark applied for is inherently registrable, namely whether it is distinctive and capable of distinguishing the goods or services of the applicant from that of another trader and is not descriptive of the goods or services applied for. The registrar will also conduct a search of existing trademark applications and registrations to determine whether the trademark applied for could be in conflict with prior or earlier trademarks such that confusion among relevant members of the public is likely.

Should the registrar raise an objection against a trademark application, the applicant is notified through an office action and is given an opportunity to respond to the objections raised within a stipulated deadline of four months from the date the office action issued. Extensions of time are available. If no office actions are issued, then the application will be published in the Trade Marks Journal for a period of two months, following which, if no opposition is filed, the application will proceed to registration.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

In general, use of a trademark or service mark does not have to be claimed before registration is granted. The exception being where a registrar is of the view that the trademark applied for is not inherently distinctive and an office action to this effect is raised. In such a circumstance, the applicant may then respond to the office action by submitting evidence of use to prove that the mark in question has acquired distinctiveness through use over a long period of time.

Within six months of the first application filed in any country that is a member of the Paris Convention or World Trade Organization, a trademark owner can file an application for the same trademark in respect of the same goods or services in Singapore and claim priority such that the filing date of the Singapore application is the same as the earlier date of the first-filed foreign application.

A trademark registered based on intent to use in Singapore must be put to genuine use within five years from the date of completion of the registration procedure, failing which the application may be subject to a non-use revocation action. The registration may be revoked if there has been no proper reason for non-use or if use of the trademark ceases or is suspended for an uninterrupted period of five years and there are no proper reasons for non-use.

8 Appealing a denied application

Is there an appeal process if the application is denied?

Where a trademark owner seeks to appeal against a decision of the registrar, for example a decision on the registrability of the mark or an

opposition decision, such an appeal is to be made to the High Court. Further appeals from the High Court to the Court of Appeal can only be made with leave of the court. The Rules of Court govern the appeal procedures in Singapore.

9 Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Assuming a trademark application goes through examination smoothly, it will be published in the Trade Marks Journal. The opposition period is two months from the date of publication. During the two-month period, a third party may oppose a published trademark application by filing a notice of opposition. The opposition can be based on a number of grounds under the TMA, including lack of distinctiveness, confusing similarity to an earlier trademark, bad faith, passing-off or well-known mark. Oppositions based on bad faith, passing-off or well-known mark provisions have a high burden of proof.

Following the registration of a trademark, it may be cancelled, revoked or invalidated. A cancellation action may be filed by a registered proprietor with IPOS whereas a revocation and invalidation action may be filed by any person with IPOS or the court. The grounds for a revocation action include non-use or deception whereas invalidation actions are based on the lack of inherent registrability of a trademark.

Depending on the complexity of the issues and volume of evidence filed, third party opposition or cancellation proceedings can be costly. As an estimate, the costs of the proceedings from commencement to a full hearing or trial may range from US\$15,000 to US\$20,000.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

A trademark registration in Singapore is valid for a period of 10 years from the date of registration, following which it has to be renewed for successive periods of 10 years. Although proof of use is not required to maintain the trademark registration, a trademark not in use for a period of five years after the date of completion of the registration procedure may be subject to cancellation for non-use. Moreover, a trademark could also be subject to non-use cancellation if it is alleged that the use of the trademark is in a form that materially alters the distinctive character of the mark from the manner in which it was registered. Therefore, it is prudent for trademark owners to ensure that the mark used is in substantially the exact form as is registered.

11 The benefits of registration

What are the benefits of registration?

Registering a trademark under the TMA gives a trademark owner the exclusive rights to use that trademark in the course of trade for its registered goods and services. The trademark owner may also grant licences to third parties to use the registered trademark in relation to the same goods and services. In circumstances where a trademark owner discovers a third party making unauthorised use of its trademark amounting to infringement, he or she may bring a claim at the High Court and seek relief under the TMA. Moreover, under the TMA, criminal sanctions may be imposed on alleged infringers or counterfeiters and border enforcement measures are also available to a proprietor of a registered trademark who suspects infringing goods are expected to be imported into Singapore.

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

In Singapore it is not compulsory to record the grant of a licence. Should a trademark owner license the use of its registered trademark to a third party, he or she may record the grant of a licence in the Register with IPOS. The rationale of doing so would be to provide notice of the licensee's interest under the registered mark to third parties.

13 Assignment

What can be assigned?

A proprietor of a registered trademark or pending application may assign its all of its trademark rights, with or without goodwill of a business to another party. The assignment can be for all or only part of the goods or services covered by the registration or application.

14 Assignment documentation

What documents are required for assignment and what form must they take?

A trademark assignment of a registered trademark or a pending application is not effective unless it is in writing signed by or on behalf of the assignor. Typically, a trademark is assigned from one party to another through a deed of assignment. A certified copy of the deed of assignment may be submitted to IPOS when recording the change of ownership but it is not a requirement.

15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

Under the TMA, if an assignment is not recorded with IPOS, it will be regarded as being ineffective as against a person acquiring a conflicting interest in or under the registered trademark in ignorance of the transaction. Moreover, a person who becomes the proprietor of a registered trademark by virtue of the assignment is not entitled to damages, an account of profits or statutory damages in respect of any infringement of the registered trademark occurring after the date of the assignment and before the date of the application for the registration of that assignment.

16 Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The granting of any security interest, whether fixed or floating, over a registered trademark, or any right in or under it, is a registrable transaction under the TMA. Until the grant of a security interest is recorded on the Register, it will be regarded as being ineffective as against a person acquiring a conflicting interest in or under the registered trademark in ignorance of the transaction. As with an assignment, a person who becomes the proprietor of a registered trademark by virtue of the security interest is not entitled to damages, an account of profits or statutory damages in respect of any infringement of the registered trademark occurring after the date of the grant of the security interest and before the date of the application for the registration of that grant of the security interest.

17 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

There are two symbols that can be used by a trademark owner to indicate trademark use or registration:

- the symbol ® can be used on a sign once that sign is registered as a trademark under the TMA; and
- the symbol ™ can be used on a sign that is being used in the market on goods or services but that sign is not yet registered as a trademark under the TMA.

Though it is not compulsory to use either symbol, the rationale behind doing so is to educate and inform members of the public that a sign is a trademark (ie, an indicator of source of origin, and that it belongs exclusively to an individual, firm or company).

Under the TMA, it is an offence to falsely representing trademark as registered. Any person who falsely represents that a mark is a registered trademark or makes a false representation as to the goods or services for which a trademark is registered, knowing or having reason to believe that the representation is false, shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000.

The TMA clarifies that if the word 'registered' or any other word or symbol importing a reference (express or implied) to registration is used on a trademark in the course of trade in Singapore, it shall be deemed to be a representation as to registration under the TMA, unless it is shown that the said representation as to registration relates to a country other than Singapore and that the trademark is in fact so registered for the goods or services in question.

18 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Under the TMA, the owner of a registered trademark can enforce its trademark rights against an alleged infringer or dilutive use of its mark by making a claim of infringement in the High Court. The proprietor has the right to obtain relief such as an injunction, an account of profits and damages, under the TMA for infringement of its trademark. Section 27 of the TMA sets out the acts amounting to infringement of a registered trademark.

Other than provisions governing trademark infringement, the TMA also contains provisions pertaining to acts that amount to a criminal offence, in particular, counterfeiting of a registered trademark, falsely applying a registered trademark to goods or services, importing or selling goods or services with falsely applied trademark. The tariff for a criminal act of infringement as provided in the TMA is up to S\$10,000 per infringing article up to an aggregate maximum of S\$100,000, five years' imprisonment, or both.

Border enforcement measures are also available to the owner of a registered trademark under Part X of the TMA. A proprietor or a licensee of a registered trademark who expects infringing goods to be imported into Singapore may give written notice to the Director-General, providing sufficient information to identify the said goods, to enable the Director-General to ascertain when and where the goods are expected to be imported, to satisfy the Director-General that the goods are indeed infringing goods and clearly stating that the trademark proprietor or licensee objects to such importation. The notice is valid for 60 days, unlike in some other countries that have a one-time registration system.

19 Procedural format and timing

What is the format of the infringement proceeding?

A civil action at the High Court for infringement of a registered trademark is usually commenced by way of writ of summons. Following this, unless the parties amicably settle the matter, the stages of a civil action include filing of pleadings, discovery of documents, exchange of evidence via affidavits and, finally, trial in open court. Provisional remedies such as an interlocutory injunction are available to a plaintiff. As with most legal actions in court, the trial would involve cross-examination of witnesses as well as filing of written submissions. Upon considering the facts of the case and relying on the applicable law, a High Court judge will then decide on the case. A civil action may take between 12 and 18 months to be concluded, depending on the complexity of the case and whether any interlocutory remedies are requested.

Criminal enforcement proceedings are carried out by the Intellectual Property Rights Branch (IPRB) of the Singapore Police Force. In general, it is the responsibility of trademark owners to be aware of counterfeiters or alleged infringers in the market. Assuming,

through trap purchases, counterfeits are found in the market, the proprietor of a registered trademark is able to coordinate with the IPRB and file a complaint with a magistrate of the State Courts in Singapore. A search warrant is then issued by the magistrate to the IPRB officers who then have the power to search the premises where the counterfeits are found and to seize those goods. The trademark owner then returns before the magistrate, usually within two to three days of the raid, to report on the items seized. The person from whom the items were seized is also allowed to appear should he or she have complaints about the manner the search was carried out. Following this, the trademark owner or its legal counsel may prosecute the offence within six months of the offence, on the authorisation of the Attorney General's Chambers (AGC). Under the supervision and authority of the AGC, the offence may be further prosecuted or the parties may decide to enter into negotiations and settlement, subject to the AGC's sanction.

20 Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof in a civil action to establish infringement or dilution falls on the party initiating the action, that is, the plaintiff. Typically, the standard of proof in a civil action is on 'the balance of probabilities' whereas in a criminal action, the prosecution has the burden of proving the charges 'beyond reasonable doubt'.

21 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Under the TMA, a trademark owner or a licensee with exclusive rights may bring a claim for infringement under his or her own name. An exclusive licensee has the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

A licensee (non-exclusive), on the other hand, is only able to bring a claim for infringement in his or her own name if the trademark owner, having been called upon to do so by the licensee, refuses to or fails to act within two months. Where infringement proceedings are brought by a licensee (non-exclusive), that licensee may not, without the leave of the court, proceed with the action unless the trademark owner is either joined as a plaintiff or added as a defendant.

A criminal complaint may be filed by either the trademark owner or licensee provided a letter of authorisation from the trademark owner is produced to the magistrate.

22 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

The provisions of the TMA (or common law trademark rights) pertain only to activities that take place within Singapore. This includes the import of infringing goods into Singapore or export of infringing goods out of Singapore. In this regard, infringing activities that take place outside of Singapore fall outside the realm of the TMA or the common law tort of passing-off.

23 Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

After a claim or writ of summons has been filed with the High Court and assuming no counterclaim is filed, the next stage of the proceeding would be discovery. In general, parties to the proceedings are required to disclose and produce all relevant evidence in its possession, custody or power, except for documents protected by legal privilege. Where one party does not provide the relevant information or documents required of it, the other party may apply to the court to compel that party for specific disclosure of the missing or incomplete information or documents. If deemed fit, pre-action discovery may be applied for prior to commencement of the action.

24 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

A civil action at the High Court may take between 12 and 18 months to conclude. The time frame very much depends on the complexity of the case as well as whether interim remedies, for example interlocutory injunctions and interlocutory applications for discovery, are sought. An application for an interlocutory injunction may be heard by the court within a few days. Sometimes, a plaintiff may also seek summary judgment against a defendant where there is no real arguable defence put forward. In the event an appeal is filed to the Court of Appeal against the decision of the High Court judge, the time frame for the appeal process may be anywhere from a few months to about one year.

25 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

As an estimate, the costs in bringing or defending an infringement or dilution action could range between US\$100,000 and US\$300,000 up to the conclusion of trial. Generally, it is difficult to provide a typical range of costs associated with an infringement or dilution action because in some instances the case can be rather complex, especially where the alleged infringement is challenged by the defendant, and the evidence presented by both parties is voluminous. In complex cases, the costs would tend to be on the higher side whereas where there is clear-cut infringement and no real defence is put forward (in which case summary judgment would be possible), the costs can be lower than expected. Legal counsel in infringements proceedings commonly charge based on an hourly rate, though increasingly lawyers are open to the concept of fixed fees. This varies from firm to firm.

A successful party may recover its costs from the losing party, but the amount of costs awarded is usually decided by the court. Costs recovered are not compensatory in nature and thus the winning party is not likely to recover all the costs and expenses incurred in the proceedings.

26 Appeals

What avenues of appeal are available?

Under the TMA, decisions made by a registrar in opposition, invalidation or revocation proceedings can be appealed to the High Court. Further appeals can be made to the Court of Appeal with leave of the court. Infringement proceedings under the TMA are heard in the High Court and appealed to the Court of Appeal. Passing-off actions may be brought in the State Courts or the High Court, depending on the amount of damages sought. Appeals from the State Courts can be made to the High Court and further appeals to the Court of Appeal, which is the highest appellate court in Singapore.

27 Defences

What defences are available to a charge of infringement or dilution, or any related action?

Under the TMA, a party named as a defendant in an infringement action may be able to rely on the following defences:

- use of the defendant's own registered trademark;
- use is with consent of the trademark owner;
- use is of the defendant's name or the name of his or her place of business or the name of his or her predecessor in business or the name of his or her predecessor's place of business;
- the trademark is non-distinctive and is descriptive of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services;
- the trademark used indicates the intended purpose of goods or services, and such use is in accordance with honest practices in industrial or commercial matters;
- there has been prior and continuous use of the trademark earlier than the trademark owner;

Update and trends

Most trademark owners get frustrated when, legally, it is not possible to stop a parallel importer from importing and selling genuine goods in Singapore. Parallel importers are protected by the defence of exhaustion of rights under section 29(1) of the TMA. Earlier in 2017, a case dealing with this very issue was brought before the Singapore High Court. In this case, the parallel importer was found to have infringed a registered trademark, giving the trademark owner relief rather than grief. The case in question is *Samsonite IP Holdings Sarl v An Sheng Trading Pte Ltd* [2017] SGHC 18, wherein the High Court had to consider the scope and effect of the defence of exhaustion of rights in Singapore.

Section 29(1) of the TMA states that: 'a registered trademark is not infringed by the use of the trademark in relation to goods which have been put on the market, whether in Singapore or outside Singapore, under that trademark by the proprietor of the registered trademark or with his express or implied consent (conditional or otherwise).' This defence, however, does not apply where:

- the condition of the goods has been changed or impaired after they have been put on the market; and
- the use of the registered trademark in relation to those goods has caused dilution in an unfair manner of the distinctive character of the registered trademark.

In this case, Samsonite, as plaintiff and owner of the SAMSONITE marks in Singapore and globally, brought a claim of trademark infringement under section 27 of the TMA against An Sheng Trading, who was a parallel importer. An Sheng imported into Singapore a shipment of backpacks bearing Samsonite's trademark, which were detained at Singapore customs. As part of its IP policy, Samsonite allowed its subsidiaries in a specific country to use the SAMSONITE marks in that country. In this instance, Samsonite in China was granted a licence to use the SAMSONITE marks in a co-branding agreement between Samsonite China and Lenovo PC HK Ltd.

The salient terms of the co-branding agreement were:

- computer cases and backpacks (Samsonite's goods) were to be manufactured and supplied to Lenovo by Samsonite in China;
- Samsonite's goods would bear the SAMSONITE and LENOVO trademarks (co-branded goods);
- Lenovo would give away the co-branded goods for free with the sale of certain models of Lenovo laptops exclusively in China;
- Lenovo, its retailers and distributors were not allowed to sell or otherwise dispose of the co-branded goods independently from the sale of the Lenovo laptop in China; and
- Lenovo had the responsibility of ensuring that its China-based distributors and retailers complied with the terms of the co-branding agreement.

Pursuant to the co-branding agreement, Lenovo provided the co-branded goods to their authorised distributors and retailers to be given away for free in conjunction with the sale of Lenovo laptops. However, some of Lenovo's authorised dealers decided to sell Samsonite's goods separately and without the Lenovo laptops to unauthorised dealers. Those unauthorised dealers then in turn sold Samsonite's goods to An Sheng, a parallel importer.

Samsonite, together with Samsonite in China, commenced proceedings against An Sheng for trademark infringement under the TMA, alleging that An Sheng had used its SAMSONITE marks in relation to identical registered goods and that such use was without consent. Samsonite sought injunctive relief against An Sheng as well as asking An Sheng to deliver up Samsonite's goods detained at Singapore customs, an inquiry as to damages and an account of profits. An Sheng naturally relied on the defence of exhaustion of rights under section

29(1) of the TMA. In doing so, An Sheng claims that Samsonite's goods were genuine goods and were parallel imported, then sold into Singapore with Samsonite's implied consent. Therefore there was no trademark infringement by An Sheng.

Samsonite sought summary judgment in this case. Besides this issue, the High Court had to decide whether An Sheng's defence held up (ie, whether Samsonite's goods were 'put on the market' as set out in section 29(1)).

The rationale behind the exhaustion of rights defence is that once a trademark owner puts its goods on the market, whether in Singapore or outside Singapore, that trademark owner loses all rights to object to further exploitation and dealing of those goods (ie, the trademark owner's rights are deemed to be 'exhausted' in respect of those goods). Other traders, for example parallel importers, are free to sell those genuine goods, with implied consent.

Having reviewed the facts of the case and evidences presented, the High Court held that An Sheng did infringe Samsonite's marks for the following reasons:

- The wording 'put on the market' refers to 'the realisation of the economic or commercial value of the trademark, which in this case is the penetration of the Chinese consumer market and the boosting of the reputation or awareness of the SAMSONITE marks by association with Lenovo laptops'. This is essential because the doctrine of exhaustion of rights is premised on allowing the proprietor to receive 'fair reward for the exploitation of his property right'.
- Samsonite had never consented to Samsonite's goods being diverted by some of the authorised dealers into the hands of unauthorised dealers, including An Sheng.
- It is clear that the only consent that Samsonite gave under the co-branding agreement was in relation to acts leading to the putting of the co-branded goods on the market, namely for Samsonite in China, its licensee, to manufacture the co-branded goods and apply the SAMSONITE marks on them, Samsonite in China to supply the co-branded goods to Lenovo and Lenovo to pass the co-branded goods to its authorised distributors and retailers to give away in conjunction with the sale of certain models of Lenovo laptops to end users in China only.
- In the present case, the goods manufactured by Samsonite China were the co-branded goods. The laptops were made by Lenovo. The co-branded goods and the Lenovo laptops were intended to be provided as a bundled item to consumers in China. The commercial concept was to develop the brand awareness of Samsonite in China through the association with Lenovo.
- Since the co-branded goods, in particular Samsonite's goods, were separately sold to unauthorised dealers, including An Sheng, this was in breach of the co-branding agreement and the exhaustion of rights defence failed.

Accordingly, Samsonite succeeded in its summary judgment against An Sheng, whereby the High Court granted Samsonite an injunction to restrain An Sheng and its officers, servants and agents from infringing the SAMSONITE mark, a delivery up of the detained goods, and an inquiry as to damages or an account of profits.

This case is important because it is one of the few cases whereby a parallel importer got into trouble for importing and selling genuine goods thinking that there was implied consent under the exhaustion of rights principle when in fact there was unauthorised use of a trademark. It is noteworthy because a proprietor managed to stop a parallel importer from selling genuine goods that are otherwise allowed to be sold in Singapore, considering the stance of the Singapore Parliament is generally in favour of parallel imports.

- use of the trademark constitutes fair use in comparative commercial advertising or promotion;
- use of the trademark is for a non-commercial purpose;
- use of the trademark is for the purpose of news reporting or news commentary; and
- use of the trademark is in respect of genuine goods or parallel-imported goods.

Other notable defences include the use of a trademark that has been disclaimed, or there was delay in taking action or acquiescence on the part of the trademark owner.

In an action based on the common law tort of passing-off, possible defences include:

- there is no likelihood of appreciable damage;
- the alleged passing-off is not in relation to the trademark owner's goods, services or business; and
- there has been a delay in taking legal action or acquiescence on the part of the trademark owner.

28 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

Under the TMA, a trademark owner may be able to claim the following remedies for infringement of a registered trademark:

- an injunction;
- damages;
- an account of profits;
- statutory damages;
- an order for erasure of the offending sign; and
- an order for delivery up and disposal of the infringing goods.

Monetary awards are compensatory in nature and the plaintiff must provide evidence of the losses claimed. Preliminary injunctions are generally granted when the balance of convenience lies in favour of granting the injunction whereas a final injunction is granted after a trial on the merits of the case.

In criminal actions, the remedies include fines, imprisonment, orders for forfeiture and destruction of goods or articles.

29 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Yes, ADR techniques are available and commonly used in Singapore. In fact, there are a number of ways, including direct negotiations, in which the parties in a dispute may amicably resolve their differences without having to endure a long and costly hearing at IPOS or a legal action in the High Court, such as mediation and arbitration.

Mediation

Parties who seek a win-win solution in a dispute, for example, trademark opposition, trademark invalidation or trademark cancellation, have the option of selecting mediation at IPOS. On 28 September 2011, IPOS and the World Intellectual Property Office (WIPO) signed a memorandum of understanding under which a joint dispute resolution procedure to facilitate the mediation of intellectual property disputes pending before IPOS was established. There are three types of mediation available, in particular WIPO mediation, mediation with Singapore Mediation Centre or mediation with the Singapore International Mediation Centre. According to IPOS, the success rate of mediation is high. Last year, IPOS introduced the Mediation Promotion Scheme in which parties who choose mediation may be funded up to S\$5,500 per mediation case. This scheme is available from 1 April 2016 until 31 March 2019 for an estimated 30 cases. More information on the Mediation Promotion Scheme is available on the IPOS website.

Arbitration

Besides mediation, parties may also settle their disputes through arbitration in Singapore. Domestic arbitrations are governed by the Arbitration Act, while international arbitrations are governed by the International Arbitration Act. Arbitration in Singapore may be conducted under ad hoc rules or administered by an arbitration institution, the Singapore International Arbitration Centre. Parties can choose one or three arbitrators, who are experts in the relevant area of law. The advantages of arbitration over court hearings include the lower costs of arbitration, the arbitration process is kept private and confidential

and it is easy to enforce domestic or foreign arbitration awards. Unlike court decisions, which may be appealed, arbitration awards are final with limited scope of appeal.

30 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

Under the TMA, a 'well-known trademark' is any registered trademark that is well known in Singapore or any unregistered trademark that is well known in Singapore and that belongs to a person who is a national of a Paris Convention country or is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Singapore.

A well-known trademark is afforded protection regardless of whether:

- the trademark has been registered in Singapore or is a pending application; and
- the trademark owner of the trademark carries on business, or has any goodwill, in Singapore.

To prove that a trademark is well known, some of the factors considered are:

- the degree to which the mark is known to or recognised by any relevant sector of the public in Singapore;
- the duration, extent and geographical area of any use or promotion of the mark;
- any registration or application for registration of the mark in any country or territory in which the mark is used or recognised, and the duration of such registration or application;
- any successful enforcement of any right in the mark in any country or territory, and the extent to which the mark was recognised as well known by the competent authorities of that country or territory; and
- any value associated with the mark.

Should a trademark owner of a well-known mark discover that another trader is using, in the course of trade in Singapore and without consent, a sign that is identical with or similar to its well-known mark and in relation to identical or similar goods or services, that trademark owner could seek injunctive relief to restrict such use where:

- the use is likely to cause confusion; or
- the use would indicate a connection between those goods or services and the well-known mark owner, and is likely to damage the interests of the well-known mark owner; or
- the use would indicate a connection between the business in respect of which it is used and the well-known mark owner, and is likely to damage the interests of the well-known mark owner; or

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- assuming the trademark is well known to the public at large in Singapore, the use would cause dilution in an unfair manner of the distinctive character of the well-known mark or would take unfair advantage of the distinctive character of the well-known mark.

A well-known mark owner would not be entitled to injunctive relief if the use of the trademark or business identifier began before the trademark became well known in Singapore, unless the trademark or business identifier has been used in bad faith.

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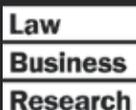
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