

Singapore IP

Evolution & Enforcement

Trademark #1

GE
23 February 1939
(electric incandescent lamps)





1980s – 1990s





Copyright Act 1987

Trade Marks Act 1988

Computer Misuse Act 1993

Patents Act 1995



AMBASSADOR
OF THE
REPUBLIC OF SINGAPORE
1121 R STREET, N.W.
WASHINGTON, D.C. 20009
TEL: (202) 697-7515

TSMP
LAW CORPORATION

15 April 1987

The Honorable George Shultz
Secretary of State
Department of State
Washington DC 20520

Dear Secretary Shultz:

I have the honour to refer to the discussions between representatives of our governments regarding the establishment of copyright relations between the Republic of Singapore and the United States of America.

2 My government has instructed me to state its assurances that with a view to establishing copyright relations between our two countries the Copyright (International Protection) Regulations 1987, a copy of which is enclosed, will be promulgated under Section 184 of the Singapore Copyright Act 1987 so that works of United States nationals and residents and works first published in the United States are entitled to protection in Singapore on the same basis as works of Singaporean nationals and residents and works first published in Singapore. Such protection shall also extend to works of United States nationals and residents and works first published in the United States, which were in existence on the day immediately prior to the effective day of the Copyright (International Protection) Regulations, if such works still enjoy copyright protection in the United States.

1 The protection in Singapore of works of United States nationals and residents and works first published in the United States is granted on the understanding that the United States of America will grant protection under Title 17 to works of Singapore nationals or domiciliaries or works first published in Singapore.

Yours sincerely

TOMMY T B KOH

TSMP LAW CORPORATION

US Trade Representative

(§301 of US Trade Act – trade sanctions imposed. Special 301 for IP transgressions)

WTO member on 1/1/95
Singapore founding member

TRIPS came into force 1/1/95
**(Agreeing to TRIPs is a requirement to
join WTO)**

- Extension of copyright to life + 50 years
- Copyright granted automatically – no registration needed
- Patents grants in “all fields of technology”. Software & business method patent issues not answered
- Geographical indications – automatic protection

Singapore became signatory to Berne Convention on 21 December 1998

- Recognition of copyright of other signatory countries**

**Singapore became signatory to WCT
(WIPO Copyright Treaty) on 17 April
2005**

- Computer programs specifically
protected (s.7A Copyright Act)**
- No circumvention of
technological measures (Part
XIIIA Copyright Act)**

ACTA

Current draft made public on 21 April 2010

- **Border measures**
- ***De Minimis* provision**
- **Disclosure of information of shipment –
consignor, importer, exporter,
manufacturer etc**
- **Unauthorized filming in movie theatre**

- Enforcement procedures for infringement via the Internet
- Third party liability for those who authorize infringement
- Exclusion of liability for third party online service providers
 - No actual knowledge by online service provider
 - Not initiated by online service provider
 - Comply with take down notice
- No circumvention of technological measures
- No removal of DRM

Digital Tsunami

Network Effect

New Business Models

Social Media aka Web 2.0

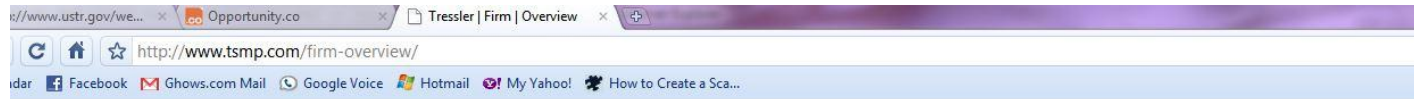
- Harder to keep a reign on IP**
- Viral marketing put trademarks at risk due to loss of control**
- Loss of privacy**
- Loss of trade secrets**
- P2P networks – US content distributed faster than local TV stations can air it**

Domain protection is super important

Increasing number of new ccTLDs (country code TLD) being opened up for commercialization

–.co (Columbia) latest ccTLD

- **Land grab – NOL v nol.com**
 - Case heard by National Arbitration Forum
 - NOL lost case
 - Registration was on “first come first served” basis
 - Respondent showed legitimate interest in domain name
 - Names online
- **UDRP – outcomes not uniform – mentioned by USTR in 2010 Report**



Tressler LLP

DISCOVER TRESSLER

[FIRM](#) | [PRACTICE](#) | [ATTORNEYS](#) | [NEWS & EVENTS](#) | [PUBLICATIONS](#) | [CAREERS](#) | [DIVERSITY](#) | [OFFICES](#)



[OVERVIEW](#)

[DISPUTE RESOLUTION](#)

[ADMINISTRATIVE MANAGEMENT](#)

[MANAGING PARTNER MESSAGE](#)

Overview

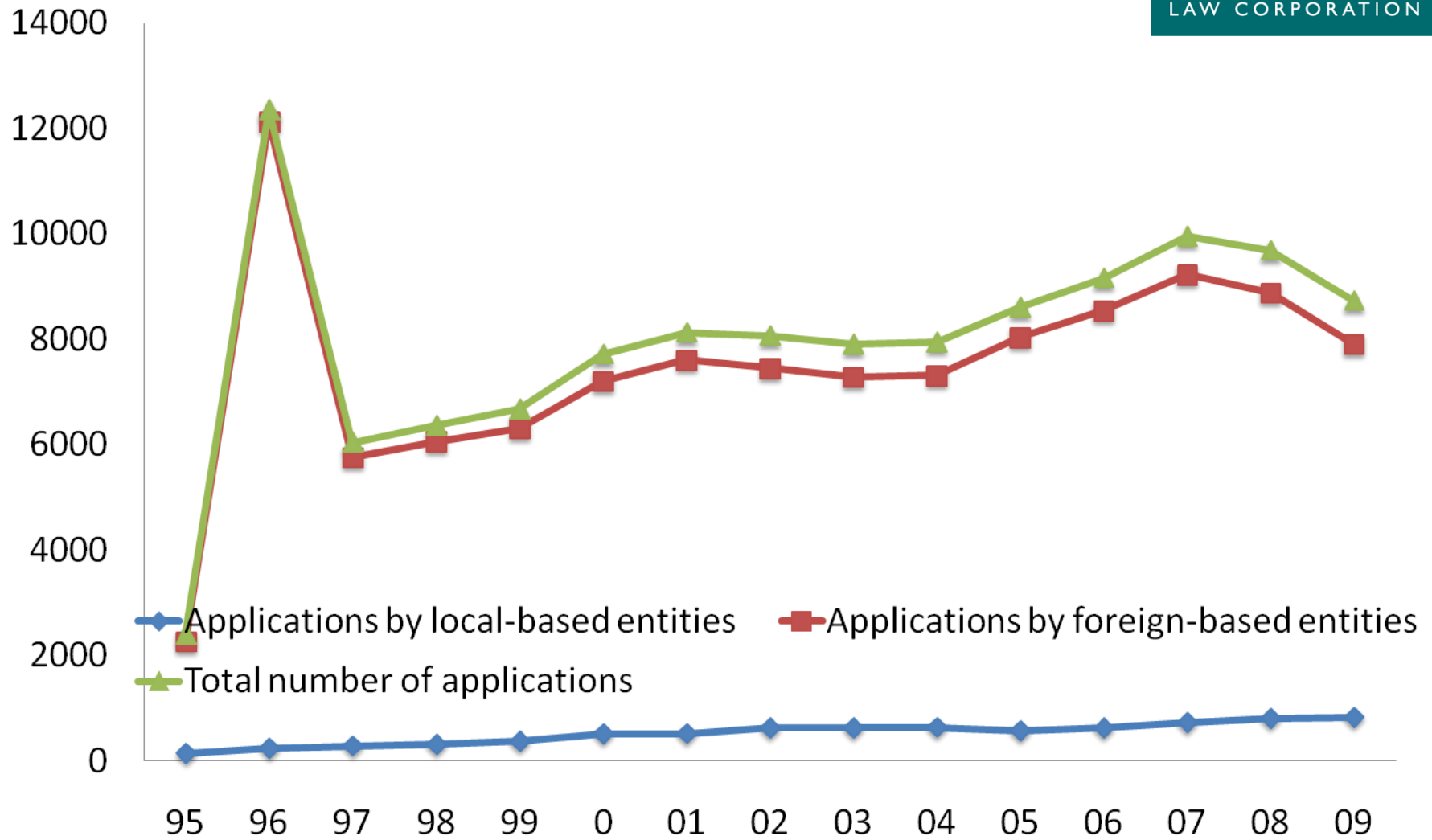
[PRINT](#) [EMAIL](#)

Tressler LLP is a full-service law firm comprised of more than 135 attorneys practicing in seven offices across the country. Our attorneys are experienced counselors and advocates who appear in state and federal courts, and in governmental proceedings, throughout the United States. We are aggressive, imaginative, goal-oriented and responsive. While our legal services span numerous areas of the law, our core practices include business organization services, governmental entities, insurance services, healthcare, homeowners associations, estate planning, business purchases and sales and real estate.

Our attorneys have:

- > Conducted more than 1,000 trials
- > Handled over 1,000 appeals
- > Appeared in court in all 50 states
- > Prepared more than 10,000 analyses of insurance coverage issues
- > Drafted over 1,000 insurance policy forms and endorsements
- > Filed over 5,000 insurance policy forms with state regulators
- > Represented over 100 governmental entities
- > Bought, sold or organized over 1,500 businesses
- > Represented over 700 condominium and common interest community associations
- > Contributed to over 100 charitable causes
- > Participated in over 100 professional organizations
- > Delivered more than 500 educational presentations
- > Published more than 700 articles

Patents



Patent infringement cases
2000 – 2010: ~70 reported
1990 – 1999: ~30 reported

First Currency Choice v Main-Line Corporate Holdings Ltd [2007] SGCA 50

- **“Flat world where businesses have ... rights to protect in several different jurisdictions”**
- **End user – UOB Bank was a defendant**
- **English cases were a guide in determining specification and infringement**
- **Publication of patent application can serve as notice thus modifying ability to plead innocent infringement**

TRADE MARKS & PASSING OFF RECENT CASE LAW DEVELOPMENTS

Adeline Lee

‘Likelihood of Confusion’ in trademark infringement

The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd [2006] 2 SLR 690

No presumption of confusion

-once similarity of marks & goods present

Looked at globally:-

- Closeness of goods**
- Impression given by marks**
- Types of customers buying respective goods**
- Steps taken by defendant to differentiate its goods**

- In the *Polo* case,
- Defendant sold apparel manufactured in China bearing the sign 'POLO PACIFIC'



**Plaintiff, registered proprietor of trade mark 'POLO',
sued for trademark infringement.**

- **Court of Appeal held**
 - **word mark 'POLO' not distinctive**
 - **linked with Ralph Lauren**
 - **ordinary English word**
 - **'POLO PACIFIC' visually, aurally & conceptually different**

- **No likelihood of confusion**
 - **disparity in prices, different sales location & packaging**
 - **products aimed at different target groups**

- *'a matter of feel than science'*

Valentino Globe BV v Pacific Rim Industries [2010] SGCA 14

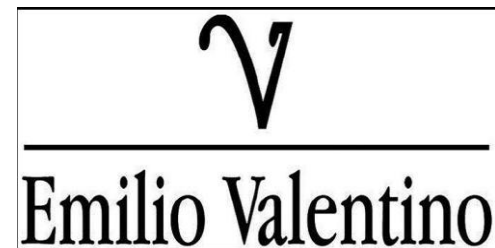
- mark not similar
- no likelihood of confusion
- up market goods & fairly discerning consumers



T89/07704E



T89/07703G



Application mark

MediaCorp News Pte Ltd v Astro All Asia Networks plc [2009] SGHC 176



- No real likelihood of confusion**
- average consumer commercial enterprises**
 - careful in choosing its service providers**

Mitac International Corp v Singapore Telecommunications Ltd and another action [2009] SGHC 137



No likelihood of confusion

- No evidence that 'mio' distinctive of plaintiff**
- process of subscribing and installing the defendant's mio services made it impossible for confusion to arise**

Higher threshold for trademark infringement

- **High level of similarity required**
- **Raised bar for establishing likelihood of confusion**

Greater emphasis on circumstances of use of mark & type of consumers involved

‘Classic Trinity’ in passing off

**• *Novelty Pte Ltd v Amanresorts Ltd* [2009]
SGCA 13**

- the Court of Appeal considered the classic trinity of passing off and the protection of well known trademarks.

In Novelty,

- The plaintiff, Amanresorts, is a luxury resort operator who owns an exclusive resort at Bali named Amanusa.**
- The defendant, a local property developer, named one of its residential projects as Amanusa.**
- The plaintiff alleged passing off and infringement of a well-known mark against the defendant.**

Goodwill vs Reputation

```
graph TD; G[Goodwill] --> A[Attractive force brings in custom]; A --> B[Particular sections of public. Not negligible.]; B --> C[Amanresorts: High income, once in lifetime]; R[Reputation] --> D[Desire to be customer];
```

**Attractive force
brings in
custom**

**Desire to be
customer**

**Particular sections of
public.
Not negligible.**

**Amanresorts:
High income, once in
lifetime**

Misrepresentation

- Likelihood of confusion sufficient
(no need for actual confusion)**

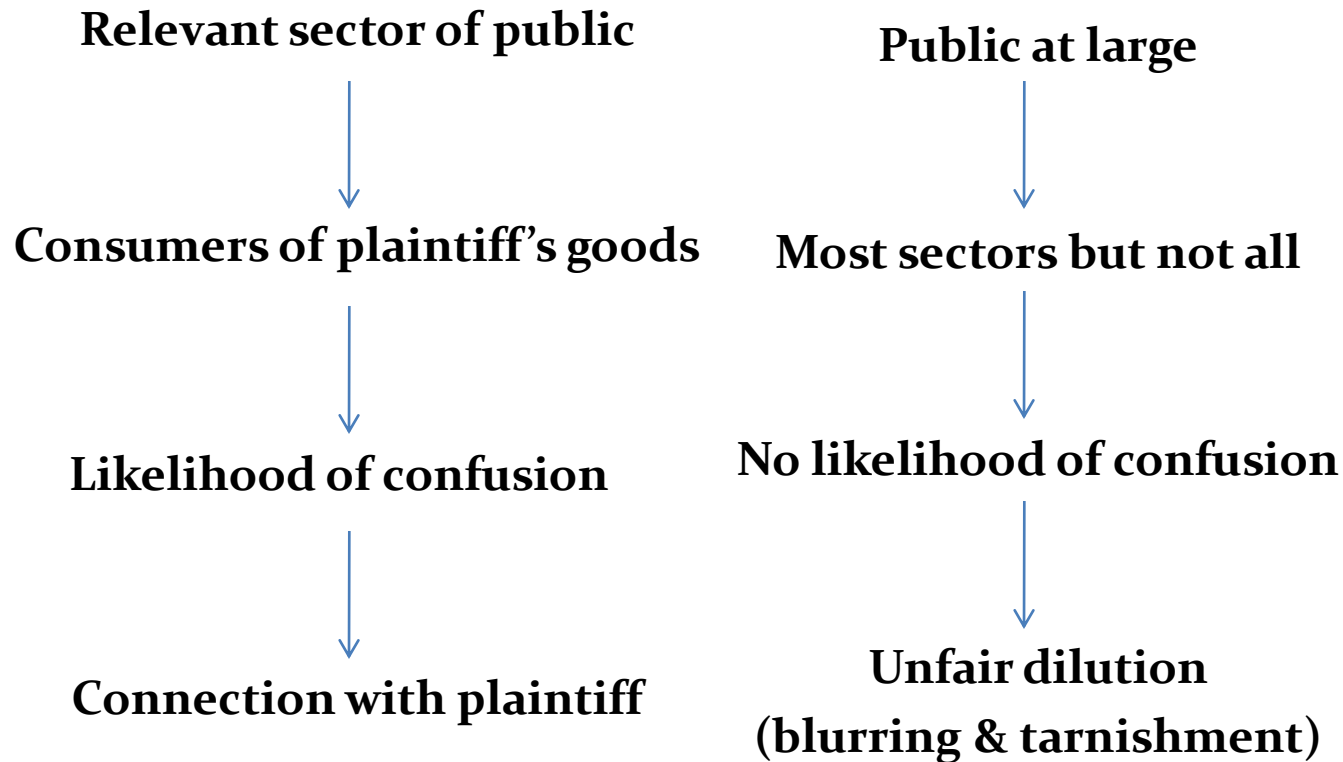
- Relevant factors**
 - business in same or closely related field?**
 - fraudulent intention in using the same name?**

- Confusion as to whether same source or somehow connected**

- Amanresorts : likelihood of confusion**
 - identical names**
 - closely related business**

- **Real tangible risk of substantial damage**
 - **Blurring**
 - plaintiff's get up indicative of defendant's goods as well
 - plaintiff's goodwill spread over defendant's goods
 - parties in competition
 - **Tarnishment**
 - defendant's goods of inferior quality / undesirable characteristic
 - plaintiff's goodwill loses attractive quality
 - parties need not be in competition
 - **Amanresorts – tarnishment**
 - difference in quality of defendant's residential accommodation
 - likelihood of damage to Amanresort's goodwill
-

**Well Known Marks
(Section 55 of TMA)**



Objective test whether trade mark is well known

- Degree to which trade mark is known / recognized**
 - by any 'relevant sector of the public'**

Protection of plaintiff's interest:-

- Unregistered trademark**
- No goodwill in trademark**
- No business in Singapore**
- Dissimilar goods and services**

Confidential Information

Ian Lim

Confidential Information

- **IP and Breach of Confidence**
- **Confidential Information and Restraint of Trade**
- **Computer Misuse Act**

IP and Breach of Confidence

- **Intellectual Property (IP):** product or result of intellectual activity in the industrial, scientific, literary or artistic fields
- **WTO in TRIPS defined “protection of undisclosed information”** as part of IP (along with copyright, trade marks, patents, etc)
- **Likewise defined under ACTA**

IP and Breach of Confidence

Three elements in action for breach of confidence

- Information must have necessary quality of confidence**
- Must be communicated in circumstances imposing obligation of confidence**
- Unauthorised use of information**

IP and Breach of Confidence

Necessary quality of confidence

- Not freely available in public domain
- Not limited to commercial information
- Need not possess any element of inventiveness or ingenuity (may be very simple idea)

IP and Breach of Confidence

Necessary quality of confidence (con't)

- Marking information 'confidential' or making it inaccessible not necessarily conclusive
- Failure to take precautionary measures to safeguard also does not destroy confidentiality
- Information must be assessed as a whole

IP and Breach of Confidence

Circumstances imposing obligation of confidence

- Contract implicitly imposing obligation**
- Equitable duty of confidence (reasonable man test)**
- Equitable duty also binds indirect recipients (and takers) of information**

IP and Breach of Confidence

Unauthorized use

- **Connection between information used/to be used and information sought to be protected required**
- **However, threat of misuse sufficient for cause of action (and potential interim injunctive relief)**

Restraint of Trade – General Rule

- **Restraints of trade are, without more, void**
- **Rule based on public policy, takes precedence over freedom of contract per se**
- **However, restraint may be construed valid if reasonable in interests of parties and public**
- **Law construes restrictive covenants in employment context more strictly (e.g. than sale of business)**

Restraint of Trade – Legitimate Proprietary Interests

- **Employment context: restraint reasonable if seeks to protect legitimate proprietary interests, and goes no further than necessary**
- **Main interests traditionally identified to merit protection:**
 - **Trade secrets (or equivalent information)**
 - **Business connections (customers/clients)**
- **Trade secrets protected in absence of express provision, possibly likewise for business connections**

Restraint of Trade – Legitimate Proprietary Interests

- **Recent recognition as legitimate proprietary interest:
Maintenance of a stable, trained workforce**
- **Court unlikely to protect in absence of express term
though (therefore protect through non-solicitation
clause)**

Restraint of Trade – Trade Secrets and Confidential Information

- **In employment context, obligations of confidentiality subject to slightly different considerations, possibly due to doctrine of restraint of trade**
- **Information acquired by employees during the course of employment may be divided into 3 categories:**

Restraint of Trade – Trade Secrets and Confidential Information

- 1 - Trivial or easily accessible information - not confidential - employee can disclose during employment
- 2 – Confidential information - under duty of fidelity, employee cannot disclose during his employment
- 3 – Trade secrets or equivalent information - employee cannot disclose even after employment (even without express restrictive covenant)

Restraint of Trade – Trade Secrets and Confidential Information

- **In determining whether information falls into 3rd category, following factors must be considered:**
 - **Nature of employment, nature of information**
 - **Whether employer impresses on employee the confidentiality of the information**
 - **Whether information can be isolated from non-confidential information**

Restraint of Trade – Trade Secrets and Confidential Information

- Authorities not entirely clear whether disclosure of 2nd category information post-employment can be prevented by express term in employment contract
- *Dictum in Faccenda Chicken v Fowler* [1987] 1 Ch 117, referred to in part and without discussion in *Tang Siew Choy v Certact Pte Ltd* [1993] 1 SLR (R)835.

Restraint of Trade – Trade Secrets and Confidential Information

- However, High Court in *Asia Business Forum v Christina Kan Yoke Yong* [1997] SGHC 230, in upholding such an express clause, stated:

“The present case was not one that was based on the breach of an implied duty not to disclose trade secrets after termination of employment. It was based on an agreement as to confidentiality of the plaintiffs’ documents which was spelt out clearly in the defendant’s employment contract.”

Restraint of Trade – Trade Secrets and Confidential Information

- **In any event, express term on confidential information help to specifically identify and list trade secrets/equivalent information that employee will be prevented from disclosing after employment is over**
- **Assists in satisfying requirement that the employer impresses the confidentiality of the information on the employee**

Computer Misuse Act

- **Act to secure computer material against unauthorised access or modification**
- **Not directly concerned with confidential information, but in practice represents a further avenue for protection of confidential information**

Computer Misuse Act

Section 3 – Unauthorised access to computer material:

- Knowingly causing computer to perform function for purpose of securing unauthorised access to any program/data in any computer**
- Fine up to S\$5,000 or imprisonment up to 2 years, or both (enhanced punishment for repeat offenders or where damage caused as a result)**

Computer Misuse Act

- **Section 5 – Unauthorised modification of computer material:**
 - **Knowingly causing unauthorised modification (by deletion or addition) of contents of any computer**
 - **Fine up to S\$10,000 or imprisonment up to 3 years or both (enhanced punishment for repeat offenders or where damage caused as a result)**

Computer Misuse Act

- **Section 9 – Enhanced punishment for offences involving protected computers**
 - **Where access to any protected computer obtained in committing offence under ss. 3, 5, 6 or 7, fine up to S\$100,000 or imprisonment up to 20 years, or both**
 - **Protected computer: used with or necessary for (i) security, defence or international relations of Singapore; (ii) provision of services to communications infrastructure, banking and financial services, public utilities, public transportation/key infrastructure; etc**

Computer Misuse Act

- **Citibank Six & Jonathan Seah**
- **CMA section 3 read with section 9 – fines up to S\$173,000 imposed**

Thank you

Bryan Ghows
bghows@tsmp.com.sg

Ian Lim
ian@tsmp.com.sg

Adeline Lee
al@tsmp.com.sg