

Newsletter

August 2017

Singapore ranks top in Asia for innovation, seventh globally

The Global Innovation Index 2017 ranked Singapore as seventh for innovation performance, out of 127 countries worldwide. This makes Singapore the top country in Asia for innovation efficiency, with South Korea as the close runner-up in eleventh place.

"The Intellectual Property Office of Singapore ("IPOS") will leverage on our expertise and networks as an innovation agency to help our innovators and businesses grow through IP. With Singapore's increased emphasis on IP commercialization, we are confident that more local and foreign enterprises will use Singapore as a place for taking their ideas to regional markets and beyond, in turn creating value for our economy and society." -- Mr. Daren Tang, IPOS Chief Executive.

Read the full Global Innovation Index 2017 Report [here](#).

Public Consultation on proposed changes to Singapore's Patents Regime

The Ministry of Law and the IPOS are presently seeking feedback on proposed changes to Singapore's patents regime. These proposed changes are in line with the government's initiative of enhancing Singapore's patents regime by increasing the quality of patents and making it more user-friendly.

The current public consultation covers the following proposed changes:

- (1) amendments to the IPOS' Examination Guidelines on isolated products from nature;
- (2) a new formal process for the submission of Third Party Observations (before patent grant) and a new re-examination option;
- (3) amendments to the IPOS' patent examination guidelines on the new patents grace period arising from the Patents (Amendment) Act 2017; and
- (4) amendments to the Patents Rules concerning patentable subject matter and supplementary examination.

The deadline to submit your feedback and suggestions in relation to the proposals indicated above has been extended to 15 August 2017.

For more information, you can download the full alert [here](#).

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Common words may not be sufficiently distinctive - *Consolidated Artists B.V. v THEFACESHOP Co., Ltd.* [2017] SGIPOS 7

Facts

Consolidated Artists B.V. ("**the Opponents**") own the mark "MANGO" for many products, including clothing and cosmetics. The Opponents sought to rely on its earlier marks registered for cosmetics in Class 3 to oppose the registration of THEFACESHOP Co., Ltd's ("**the Applicants**") trade mark, "MANGO SEED THE FACESHOP" ("**Application Mark**") for cosmetics in Class 3. The Opponents relied on Sections 8(2)(b) (confusingly similar marks and/or goods), 8(4) (well-known in Singapore and/or to the public at large in Singapore) and 8(7)(a) (passing off) of the Trade Marks Act (Cap. 332) ("**TMA**") in this opposition.

*Application
Mark*

MANGO
SEED
THEFACESHOP

*Opponents'
Earlier Mark 1*

MANGO

*Opponents'
Earlier Mark 2*

MANGO
adorably

Decision

The opposition was unsuccessful on all grounds.

(i) Section 8(2)(b) - Confusingly similar marks and/or goods

Under Section 8(2)(b) of the TMA, a trade mark shall not be registered if it is similar to an earlier trade mark; is to be registered for goods similar to those which the earlier trade mark protects; and there exists a likelihood of confusion arising from the two similarities.

The Registrar was of the view that the marks were visually, aurally, and conceptually dissimilar. While the Opponents' Earlier Mark 1 had some level of distinctiveness due to its font, the level of distinctiveness was not high insofar as it could be considered descriptive of the Class 3 products concerned -- for example, that they are 'mango' flavoured or scented products. While the same may be said about the Application Mark in relation to the words "Mango" and "Seed", the Application Mark contained the particularly long word "THEFACESHOP" at the bottom, with no spaces in between the words "THE", "FACE" and "SHOP". The Registrar was of the view that the word "THEFACESHOP" was therefore allusive, capable of being distinctive of the relevant goods, and therefore capable of sufficiently and substantially distinguishing the Application Mark from the Opponents' Earlier Mark 1 and similarly, the Opponents' Earlier Mark 2 (collectively referred to as "**the Opponents' Earlier Marks**").



In relation to the likelihood of confusion, the Registrar found no risk of misperception of co-branding or any likelihood of confusion in the sense of an economic link between the parties, as the Opponents had consistently depicted the word "MANGO" (and "MANGO" only) in a specific font. The words "Seed" and "THEFACESHOP" in the Application Mark also sufficiently differentiated it from the Opponents' Earlier Marks.

Further, the cosmetics and self-care products covered under both marks are *highly personal products*, applied onto the face and body, and pertaining to the appearance of a consumer. Hence, the products would entail a relentless scrutiny as to their suitability, as a wrong purchase can have detrimental results. Consumers will therefore be more particular about the origin or marks of such goods, as they are likely to trust certain brands more than others.

(ii) Section 8(4) - Well-known in Singapore and/or to the public at large in Singapore

The element that "the whole or an essential part of the trade mark" must be identical or similar to an earlier mark under Section 8(4) of the TMA was not found to be satisfied since the Opponents' Earlier Marks and the Applicants' Mark were found to be dissimilar. Moreover, whilst the Opponents' Earlier Mark 1 was found to be well-known to the relevant sector in Singapore, the Registrar found that there was no confusing connection between the marks for the same reasons as provided by the Registrar in relation to the likelihood of confusion. The high evidential threshold required to support the "well known to the public at large" status of the Opponents' Earlier Mark 1 was also found not to have been met. The Registrar did not consider the Opponents' Earlier Mark 2 further as the Opponents were unable to establish that there was reputation in the local market.

(iii) Section 8(7)(a) - Passing off

The Registrar found that, based on the Opponents' sale and promotional figures in Singapore, the Opponents have the relevant goodwill in Singapore. However, the elements of misrepresentation and likelihood of damage were not made out due to the dissimilarity of the marks.

Comments

This case highlights the potential problems with employing common words as trade marks, especially where the marks are intended to cover a range of classes of goods and services. Common words will be non-descriptive and distinctive only where they cover goods and services that have absolutely no relation to the plain meaning of the words. The mark 'Mango' for cosmetics, as illustrated in this case, does not suffice.

Established trade marks may face claims of non-genuine use - *FMTM Distribution Limited v Van Cleef & Arpels S.A.* [2017] SGIPOS 6

Facts

Van Cleef & Arpels S.A. ("**the Proprietors**") are a supplier of fine jewellery and luxury watches sold under the Van Cleef & Arpels (VCA) trade mark. Established in France in 1896, VCA and their predecessors in title have been trading for over



100 years. FMTM Distribution Limited ("**the Applicants**") own, amongst others, the "Franck Muller" trade mark for watches.

The mark at issue is "MYSTERY SET", covering Class 14 jewellery and watches ("**the Subject Mark**"). The Applicants filed an application for revocation of the Subject Mark on the ground that it had not been put to genuine use, under Section 22(1)(a) of the Trade Marks Act (Cap. 332) ("**TMA**").

One of the main thrusts of the Applicants' attack is that "MYSTERY SET" has not been used by the Proprietors in a trade mark sense, but as descriptive of the technique employed by jewellers for setting gemstones in such a way that no prongs are visible.

Decision

The revocation failed in relation to jewellery, but partially succeeded in relation to watches, as no evidence was tendered by the Proprietors in relation to this item.

With respect to jewellery, the Registrar found that the Subject Mark had been used in the trade mark sense. He emphasized that the *trade name* of the technique (the setting of stones) is "invisible setting", and the terms "MYSTERY SETTING" or "MYSTERY SET" were *coined* by the Proprietors to describe a variant of the technique which had been patented by them. The terms "MYSTERY SETTING" or "MYSTERY SET" were not directly descriptive of the technique. Rather, they described the mysterious aura exuded by gemstones in such a setting, and can thus be considered to be at most allusive of the invisible setting and in turn, jewellery.

Comments

This case raises an interesting issue of a potential challenge an accomplished trade mark owner may face. A trade mark's very establishment and success may lead to a possible claim of general use of the mark to refer to, or to describe the characteristics of the product itself, and not as an indication of commercial origin.

"BIG BOX" neither descriptive, generic, nor indistinctive - Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd [2017] SGIPOS 5

Facts

Big Box Corporation Pte Ltd ("**Big Box Co.**") is the proprietor of the trade mark, "BIG BOX" ("**the Subject Mark**"), registered in Singapore since 26 January 2005 and covering a range of retail services supplied to consumers and other businesses. Courts (Singapore) Pte Ltd ("**Courts**") had opened a retail warehouse store, and had placed advertisements in the Straits Times for the warehouse store that described it as "COURTS BIG BOX MEGASTORE". Consequently, Big Box Co. sent Courts a cease and desist letter, alleging infringement of the Subject Mark by reason of Courts' use of the words "BIG BOX". Proceedings had, however, not been commenced as of the date of the hearing.

Courts then applied for a declaration of invalidity of the registration of the Subject Mark, on the ground that it was devoid of distinctive character, descriptive and/or generic at the application date. Courts supported its application with evidence of



the use of the term "BIG BOX" before and after 2005 as a description of a large retail or warehouse establishment, some from Singapore and others from elsewhere, particularly North America.

Decision

Courts' application was refused.

In relation to the descriptiveness and distinctiveness of the Subject Mark, the Adjudicator was of the view that "BIG BOX" was not descriptive of any characteristic of the services for which it was registered -- not warehouses or other types of buildings, but a range of services from retail to marketing and promotional services for businesses. In respect of these services, "BIG BOX" was thus inherently distinctive and capable of performing its function as an indication of trade origin.

The Adjudicator similarly rejected Courts' argument that the words "BIG BOX" were viewed by the body of traders in the retail and warehouse industries as a generic description of a "large retail or warehouse establishment". It was noted that whether a term is generic or not must be considered in the context of the relevant goods and services -- in this case, the provision of a range of services including retail services. The Adjudicator was thus not persuaded that the "man and woman on the SBS Transit bus" would perceive the words "BIG BOX" to be customary in either the current language, or the established practices of the trade as at the application date.

However, the Adjudicator emphasized that this did not mean others could never use the words "BIG BOX" as a description of a large retail or warehouse establishment without infringing Big Box Co's trade mark. As the Trade Marks Act (Cap. 332) provides honest traders with a defence if their use of the mark is a genuine description, whether the mark has been infringed upon would depend on all circumstances.

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Comments

In his decision, the Adjudicator noted that there is no general duty imposed by the law on traders to check what is on the Trade Marks Register. Nevertheless, traders should check the Register periodically, lest they run the risk of being threatened with a legal action for infringement of someone else's trade mark that they are not even aware is registered.