

Newsletter

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For more information, please contact:

Andy Leck
+65 6434 2525
andy.leck@bakermckenzie.com

Lim Ren Jun
+65 6434 2721
ren.jun.lim@bakermckenzie.com

Abe Sun
+65 6434 2547
vasan.abe.sun@bakermckenzie.com

IPOS and Deloitte Partner to Encourage Commercialising Intellectual Property

The Intellectual Property Office of Singapore ("IPOS") and Deloitte Southeast Asia Financial Advisory Services have jointly signed a Memorandum of Understanding to help 100 innovative enterprises commercialise their intellectual property and compete globally, particularly for companies in the biomedical, healthcare, manufacturing, engineering and deep tech fields.

The aim is to help companies understand technology trends to make strategic decisions for investment as well as commercialise their IP and other intangible assets for business growth. This will help companies scale up and internationalise quickly.

For more information, you can read the article [here](#).

Warner-Lambert Company LLC v Novartis (Singapore) Pte Ltd [2017] SGCA 45

Facts

Warner-Lambert Company LLC ("**Warner-Lambert**") owns a Singapore Patent pertaining to the use of pregabalin, an active ingredient for the treatment of pain. Novartis (Singapore) Pte Ltd ("**Novartis**") applied for product licences to market generic pregabalin products in Singapore.

Warner-Lambert commenced action against Novartis, seeking a declaration that the generic pregabalin products would infringe their Singapore patent. Novartis counter-claimed for a revocation of the Singapore patent, on the ground that the claims were directed towards a method of treatment of the human or animal body, which are impermissible under the Singapore Patents Act due to a lack of industrial application.

In view of the revocation proceeding, Warner-Lambert applied for leave to amend the claims of the Singapore patent to a Swiss-style claim, which is typically framed as "*use of substance X in the manufacture of a medicament for the treatment of condition Y*".

Decision

The Court of Appeal dismissed Warner-Lambert's appeal to amend the claims of the Singapore patent. The Court of Appeal further considered whether second and subsequent medical uses of known substances could be patented by Swiss-style claims.

(i) **Amendment of the claims**

Firstly, the Court found that amendments to "obviously invalid" claims, such as the method of treatment claims in Warner-Lambert's patent, should be rejected.



Furthermore, the Court held that amending the claims from method of treatment claims into Swiss-style claims would extend the scope of protection conferred by the Singapore patent, as the granted claims protected a method of treatment of the human body whereas the amended claims protected the manufacture of a medicament.

The Court also found that there was an undue delay in bringing about the amendments as Warner-Lambert took over a decade to apply for the amendment.

(ii) Permissibility of Swiss-style claims

The issue of permissibility of Swiss-style claims had never been fully explored in the Singapore courts. The Court commented (*in obiter*) that Section 14(7) of the *Patents Act* appeared to support the patentability of second and subsequent medical uses of known substances. This is contrary to the UK approach, where the equivalent provision (i.e. Section 2(6) of the *UK Patents Act 1977*) has been interpreted as protecting only the first medical use of known substances.

As such, the Court observed that it might no longer be necessary for inventors to resort to Swiss-style claims to frame second and subsequent medical uses, since purpose-limited product claims (in the form of “*Compound X for use in the treatment of disease Y*”) may sufficiently cover second and subsequent medical uses.

Comments

This case is a landmark decision in patent law as it was the first time the Singapore courts explored the permissibility of Swiss-style claims and whether second medical uses of known substances are patentable. The topic has hitherto been hotly debated in other jurisdictions such as the UK and EU.

It should be noted that the patent examination guidelines by IPOS currently allow Swiss-style claims but not purpose-limited product claims. In light of this decision, it remains to be seen if IPOS will revise their guidelines accordingly.

Orco International (S) Pte Ltd v Louis Dreyfus Commodities MEA Trading DMCC [2017] SGIPOS 08

Facts

Orco International (S) Pte Ltd (the “**Applicants**”) applied to register its trade mark in Class 30 for “Rice” (the “**Application Mark**”). Louis Dreyfus Commodities MEA Trading DMCC (the “**Opponent**”) sought to oppose the registration of the Application Mark on the basis of its 3 earlier unregistered marks (the “**Opponent's Marks**”), relying on Sections 8(1) (identical to earlier trade mark), 8(2)(b) (confusingly similar marks and/or goods), 8(4) (well-known in Singapore and/or to the public at large in Singapore), 8(7)(a) (passing off) and 7(6) (bad faith) of the *Trade Marks Act (Cap. 332)* (“**TMA**”).



*Application
Mark*



*Opponents'
Earlier
Unregistered
Mark 1*

"PADDY LEAF"

*Opponents'
Earlier
Unregistered
Mark 2*

PADDY LEAF

*Opponents'
Earlier
Unregistered
Mark 3*



Decision

The opposition was unsuccessful on all grounds.

(i) Section 8(1) - Identical to an earlier trade mark; Section 8(4) - Well-known in Singapore and/or to the public at large in Singapore

Under Section 8(1) of the TMA, a trade mark shall not be registered if it is identical with an "earlier trade mark" and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

In this case, the Opponents argued that although the Opponent's Marks were unregistered, they satisfied the definition of an "earlier trade mark" in Section 2(1) TMA, because they were well-known trade marks at the relevant date (i.e., 5 May 2014) to consumers of rice and rice traders in Singapore. As such, the outcome of the decision on Section 8(1) TMA turned on that of Section 8(4) TMA.

The Registrar found that the Opponent's Marks were not well-known to either rice traders or consumers of rice in Singapore. There was no evidence that rice bearing the Opponent's Marks were ever advertised or sold to consumers in Singapore, or imported into Singapore. While the Opponent may have used the Opponent's Marks as far back as 2007, such use was strictly in relation to goods and traders located outside of Singapore and were therefore not well-known to consumers of rice or rice traders in Singapore.



(ii) 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.

As the Registrar found that the Opponent failed to establish that any of its earlier marks were well-known in Singapore, there was no "earlier trade mark" to rely on.

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

Section 8(7)(a) of the TMA provides that a trade mark shall not be registered if its use in Singapore is liable to be prevented "*by any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*".

Although the Opponent enjoyed goodwill in its business, the Registrar found that the Opponent's Marks were not distinctive of the Opponent's rice in Singapore as none of the Opponent's Marks had been used in Singapore in relation to rice. As such, the opposition under Section 8(7)(a) was unsuccessful.

(iv) Section 7(6) - Bad faith

Section 7(6) TMA provides that a trade mark "*shall not be registered if or to the extent that the application is made in bad faith*".

The Opponents argued that there was direct copying of the Opponent's Marks, save for a perfunctory addition of the words "LA FLEUR DE PADDY". However, the Registrar found that the Opponent's evidence did not meet the required threshold, as the evidence did not suggest actual dishonesty or commercially unacceptable dealings.

www.bakermckenzie.com

Baker McKenzie Wong & Leow
8 Marina Boulevard
#05-01 Marina Bay Financial Centre
Tower 1
Singapore 018981

Tel: +65 6338 1888
Fax: +65 6337 5100

Comments

This case highlights the potential obstacles which brand owners may face in enforcing their rights in unregistered trade marks, especially where the marks have only been used outside of Singapore. As a matter of prudence, brand owners may wish to register such trade marks in order to circumvent the requirement of an "earlier trade mark", thereby strengthening the merits of their claims in respect of the various grounds of opposition.