

Newsletter

May 2018

In This Issue:

Adducing relevant evidence of use - *Monster Energy Company v Glamco Co., Ltd* [2017] SGIPOS 08

Significance of *locus standi* for site-blocking application - *PCCW Media Ltd v M1 Ltd and others* [2018] SGHC 99

Imepnding legislative changes to border enforcement measures against goods infringing intellectual property rights

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

Adducing relevant evidence of use - *Monster Energy Company v Glamco Co., Ltd* [2017] SGIPOS 08

Facts

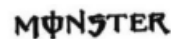
Glamco Co., Ltd (the "**Applicant**") applied to register its trade mark, "SWEET MONSTER" (the "**Application Mark**") in Class 30. Monster Energy Company (the "**Opponent**") sought to oppose the registration of the Application Mark on the basis of its earlier marks, relying on Sections 8(2)(b) (confusingly 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)* (the "**TMA**"). The focus of the Court's analysis was on the Opponent's "MONSTER" marks (the "**Opponent's Monster Marks**"), which were closest to the Application Mark.

Decision

The opposition was unsuccessful on all grounds.

The Opponent argued that the various "MONSTER" trade marks forming the "MONSTER" family of trade marks have in fact been used in Singapore, resulting in a high degree of recognition of the "MONSTER" family of trade marks in Singapore. However, the Principal Assistant Registrar ("**PAR**") held that there was no family of marks.

In this regard, the PAR highlighted that the Opponent's evidence which was dated after the application date of the Application Mark had to be disregarded. Crucially, the PAR found few instances of use where the "MONSTER" word appeared on its own without any embellishment. On the contrary, the Opponent's evidence related primarily to other marks which, for instance, used the word "MONSTER" in conjunction with "ENERGY" and a claw device, or featured a stylized version of the word "MONSTER":



Likewise, given that the evidence tendered with regard to use in Singapore did not reflect the "MONSTER" word *simpliciter*, the PAR concluded that the Opponent's Monster Marks were not well-known in Singapore or well-known to the public at large.



In addition, the PAR found that the "MONSTER" word mark was not inherently distinctive, and held that the Opponent's and Applicant's marks were aurally, visually, and conceptually dissimilar.

Comments

This case serves as a caveat to trade mark proprietors to ensure that any evidence of use falls within the applicable time frame, and features the Opponent's mark(s) in question without further embellishments. Otherwise, the extensive time and resources invested in procuring the evidence would ultimately be rendered fruitless.

Significance of *locus standi* for site-blocking application - *PCCW Media Ltd v M1 Ltd and others* [2018] SGHC 99

Facts

The Plaintiff, PCCW Media Ltd, operates a content service known as VIU which allows users to stream drama and variety shows produced by certain Korean broadcasters (the "**Korean Broadcasters**"). The Plaintiff is also a non-exclusive licensee of these drama and variety shows.

The Plaintiff applied under Section 193DDA of the *Copyright Act* (Cap. 63) (the "**Act**") for an order for the Defendant network service providers ("**NSPs**"), comprising the major telecommunications companies in Singapore, to take reasonable steps to disable access to five flagrantly infringing online locations ("**FIOLs**"), namely, DramaNice; DramaCool; MyAsianTV; KShowOnline and KissAsian.

The Plaintiff had entered into assignment agreements with each of the Korean Broadcasters, which purported to assign to the Plaintiff the right to sue for the purpose of obtaining relief under Section 193DDA of the Act.

Issues

Under Section 193DDA of the Act, it is only the owner or exclusive licensee of copyright in a material that may make an application. In this regard, the Plaintiff sought to persuade the High Court that it was, by virtue of the assignment agreements, the "*owner of copyright*" in the drama or variety shows for the purpose of Section 193DDA of the Act. The High Court therefore considered the following issues:

- (i) Whether the assignment agreements were of any effect; and
- (ii) Whether being assigned the right to sue for the purposes of obtaining a site-blocking order made the Plaintiff an "*owner of copyright*" within the meaning of the Act.



(a) Whether the assignment agreements were of any effect

The High Court held that the assignment agreements had no effect. There was nothing in Section 193DDA of the Act to suggest that the right to apply for a site-blocking order was intended to be assignable. Therefore, such a right could not be assigned to third parties, and was limited to the owner and / or exclusive licensee of the copyright only.

With this in mind, the High Court found it unnecessary to consider the second issue. However, as the Plaintiff had argued that the assignment made it the "effective owner" of the copyright, the High Court proceeded to address the issue.

(b) Whether the Plaintiff was the "effective owner" of the copyright

The High Court rejected the Plaintiff's argument. Specifically, the Plaintiff had submitted that Section 194(2)(a) of the Act provides that an assignment of copyright may be limited to specific classes of acts which the owner of copyright has the exclusive right to do. As such, an assignment of the right to bring actions for infringement was a partial assignment of copyright which made the Plaintiff a copyright owner.

The High Court held that Section 194(2)(a) of the Act does not go so far as to define what exactly a copyright is, or what bundle of rights it comprises. Instead, other provisions of the Act (i.e. Sections 26 and 82 to 86) explicitly describe the nature of copyright. The right to sue in respect of copyright infringement was therefore not a copyright, but merely a remedy available to the owner of a copyright.

Accordingly, the Plaintiff, being neither an owner nor exclusive licensee of copyright in the drama or variety shows, had no *locus standi* to bring the application.

Comments

This decision highlights the importance of ensuring that one has the requisite standing to make an application under Section 193DDA of the Act. By resolving the issue of *locus standi* at the outset, applicants can avoid incurring unnecessary costs and delays in bringing proceedings which they may not even be entitled to commence.



Impending legislative changes to border enforcement measures against goods infringing intellectual property rights

On 17 May 2018, Parliament introduced the *Intellectual Property (Border Enforcement) Bill* (the "**Bill**"), which proposes amendments to the *Copyright Act* (the "**CA**"), *Trade Marks Act* (the "**TMA**"), *Registered Designs Act* (the "**RDA**") and *Geographical Indications Act* (the "**GIA**") (collectively, the "**IP Acts**").

The Bill aims to:

- (i) implement Singapore's obligations under the European Union-Singapore Free Trade Agreement (the "**EUSFTA**") to enhance border enforcement measures against goods infringing intellectual property rights ("**IPR**");
- (ii) delineate new powers for Singapore Customs ("**Customs**") to obtain and provide information relating to the goods they seize; and
- (iii) standardise the terms and provisions relating to border enforcement across the IP Acts.

Enhanced Border Enforcement Measures

At present, both the CA and TMA provide for Customs to detain on their own volition infringing goods which are imported or exported. IPR holders may also request Customs to seize infringing goods that are imported.

The Bill seeks to amend the CA and TMA to allow IPR holders to request for the seizure of infringing goods that are to be exported.

In addition, the Bill will permit, under the RDA, IPR holders to request Customs to seize infringing goods that are imported or to be exported. The RDA presently does not provide a border enforcement regime.

For completeness, under the new GIA passed in April 2014, Customs may take *ex officio* action to detain infringing goods that are imported or to be exported. Likewise, IPR holders may lodge notices for action to be taken against both the import and export of infringing goods.

Customs' Powers to Obtain and Provide Information

Customs will be empowered across the IP Acts to provide IPR holders with the names and contact details of any person connected with the import or export of the seized goods necessary for instituting IPR infringement proceedings.

The information may be disclosed upon the following:

- (i) Customs has seized the infringing goods, and



- (ii) IPR holders have provided Customs with a security deposit and supporting documents as evidence of their IPR ownership.

Furthermore, the Bill will provide Customs with a broad power to request any information or document that may be relevant for border enforcement purposes.

Standardisation of border enforcement terms and provisions

The Bill will standardise the border enforcement terms and provisions across the IP Acts, to ensure that the border enforcement measures are uniformly applied.

Implementation Timelines

Upon the passage of the Bill, the new powers in the CA and TMA for Customs to obtain and provide information relating to the seized goods will come into force.

Thereafter, once the EUSFTA enters into force, the enhanced border enforcement measures and standardised terms and provisions under the CA and TMA will be implemented.

Within 3 years of the entry into force of the EUSFTA, the enhanced border enforcement measures, new powers for Customs and the standardised terms and provisions in respect of the RDA and GIA will come into force.

Comments

The impending legislative amendments are a welcome shift that should marshal a more robust and comprehensive border enforcement regime that protects IPR holders' interests across the IP Acts. It remains to be seen if Parliament will introduce further changes to the RDA to allow the *ex officio* seizure of imported and exported infringing goods, in the interest of fully aligning the border enforcement measures under the RDA with the CA, TMA and GIA.

A copy of the Bill can be found [here](#).

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

©2018 Baker & McKenzie. All rights reserved. Baker & McKenzie Wong & Leow is a member of Baker & McKenzie International, a Swiss Verein with member law firms around the world. In accordance with the common terminology used in professional service organizations, reference to a "partner" means a person who is a partner, or equivalent, in such a law firm. Similarly, reference to an "office" means an office of any such law firm.

This may qualify as "Attorney Advertising" requiring notice in some jurisdictions. Prior results do not guarantee a similar outcome.

This alert is provided as general information and does not constitute legal advice.