Baker McKenzie Wong & Leow.

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Guidance on the comparison of marks containing Chinese characters and Roman letters in the local context - *Starwood Hotels & Resorts Worldwide, Inc and Sheraton International IP, LLC v Staywell Hospitality Pty Limited* [2018] SGIPOS 11

Facts

Starwood Hotels & Resorts Worldwide, Inc. and Sheraton International IP, LLC (the "**Applicants**") sought to invalidate the registered trade mark "PARK REGIS 柏·伟诗酒店" (T1005795F) in Classes 35 and 43 (the "**Subject Mark**"), in the name of Staywell Hospitality Pty Limited (the "**Proprietor**"). On the basis of *inter alia* the trade mark "ST. REGIS" (T9512253G) in Class 42 (the "**Applicant's Mark**"), the Applicants sought to rely on Section 23 (Grounds for invalidity of registration), read with Sections 7(6) (bad faith), 8(2)(b) (confusingly similar marks and/or goods), 8(4)(i) and 8(4)(ii)(A) (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**").

This case is intertwined with the seminal case of ***Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc & anor*** [2014] 1 SLR 911, where the Court of Appeal found that the application mark "PARK REGIS" and the earlier registered mark "ST. REGIS", were overall, more similar than dissimilar.

Decision

The PAR held that the invalidation succeeded on Sections 8(2)(b) (confusingly similar marks and/or goods), 8(4)(b)(i) (well known in Singapore) and 8(7)(a) (passing off) of the TMA, but failed on Section 7(6) (bad faith) and 8(4)(b)(ii)(A well-known to the public at large in Singapore) of the TMA.

In particular, in relation to Section 8(2)(b) of the TMA, the PAR held that when assessing visual similarity, aside from visual attributes of a mark, the meaning of a mark also influences the visual appreciation of it. With no clear guidelines on comparing of marks containing Chinese characters and Roman letters in the local context, the PAR referred to the Hong Kong Intellectual Property Department Work Manual (the "**HK Work Manual**") for guidance. According to the HK Work Manual, a key consideration in analyzing how the meaning of a mark, containing foreign characters, influences the visual appreciation of it is whether the language of the words in the mark will be understood by the relevant consumer. Taking this into account, the PAR proceeded to hold that as English is the working language in Singapore, the Chinese characters are only of secondary significance, as compared to the English words "PARK REGIS", in the

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

mark. This contributed to the PAR's view that the distinctive component of the Subject Mark is the word "REGIS". Therefore, in view of the common distinctive word element "REGIS", the Subject Mark and the Applicant's Mark were held to be more similar than dissimilar.

Comment

As Singapore is a multi-ethnic and multilingual society, it is important for trade marks to be interpreted in a manner with regard to our local demographics. This case is significant in providing clear guidance on how the courts may compare marks containing Chinese characters and Roman letters in the local context, which provides further insight on how cases involving marks with Roman and other non-Roman characters may be treated in the future.

First Singapore decision on double patenting - *Singapore Shipping Association and Association of Singapore Marine Industries v Hitachi, Ltd* [2018] SGIPOS 13 and 14

Facts

Hitachi, Ltd. (the "**Proprietor**") is the owner of two patents, Singapore Patent No. 161075 (the "**075 Patent**") for an invention relating to a ballast water management system for a ship, and Singapore Patent No. 10201602094R (the "**94R Patent**") for an invention also relating to a ballast water treatment system for a ship (collectively referred to as "**The Patents**"). The 94R Patent was filed as a divisional application of Singapore Patent Application No. 2012082558, which itself is a divisional application of the Singapore Patent Application No. 2010031078, granted as the 075 Patent.

Singapore Shipping Association and Association of Singapore Marine Industries (the "**Applicants**") jointly applied for the revocation of The Patents on the following grounds of revocation:

(a) **The 94R Patent:** Sections 80(1)(a) (not a patentable invention) and 80(1)(g) (double patenting) of the *Patents Act (Cap 21)* ("**PA**"); and

(b) **The 075 Patent:** *inter alia*, Section 80(1)(d) of the PA (added subject matter).

Proceedings for The Patents were uncontested by the Proprietor, and progressed concurrently.

Decision

The application for revocation of the 94R Patent under Section 80(1)(a) (not a patentable invention) and application for revocation of the 075 patent under Section 80(1)(d) (added subject matter) of the PA both succeeded. Of interest, however, was the PAR's decision on the application for revocation of the 94R Patent under Section 80(1)(g) (double patenting) of the PA.

Double patenting under Section 80(1)(g) of the PA

In assessing whether or not the 94R Patent should be revoked on grounds of double patenting, the PAR compared the claims of the 075 Patent and the 94R Patent, as properly construed, to determine whether or not the claims of both patents are directed to the same features, either explicitly or implicitly. In comparing the construed independent claims, the PAR found that, whereas the independent claims of the 075 Patent require the claimed subject matter (i.e., pump) to necessarily perform two functions, the independent claims of the 94R Patent only requires the claimed subject matter (i.e., pump) to perform one function. In view of such distinction, the PAR held that the independent claims are not invalid on the grounds of double patenting.

For completeness, the PAR went on to assess the dependent claims of The Patents as well. Specifically, in cases (such as the present case) where a comparison of independent claims of separate patents identifies one or more features missing from an independent claim of one of the patents, double patenting can still arise if such missing feature(s) are found in one or more claims that depend on such independent claims. In comparing the dependent claims of the 94R Patent, the PAR held that the claims of the 94R Patent do not define the same invention as the claims of the 075 Patent and therefore the 94R Patent is not invalid on the grounds of double patenting.

Comment

The decision in relation to the 94R Patent is significant as it is the first Singapore decision on double patenting. The decision provides further clarity on how the courts will apply Section 80(1)(g) of the PA, which will be useful to applicants and patent attorneys when preparing to file divisional applications.

Intellectual Property (Border Enforcement) Act 2018

Following the introduction of the *Intellectual Property (Border Enforcement) Bill* (the "**Bill**") on 17 May 2018, the *Intellectual Property (Border Enforcement) Act 2018 (No. 34 of 2018)* (the "**IP BE Act**") was passed by Parliament on 9 July 2018 and was assented to by the President on 2 August 2018. The IP BE Act serves to amend the *Copyright Act* (Chapter 63 of the 2006 Revised Edition), the *Geographical Indications Act 2014* (Act 19 of 2014), the *Registered Designs Act* (Chapter 266 of the 2005 Revised Edition) and the TMA, to enhance border enforcement measures for intellectual property rights. The IP BE Act also empowers the Singapore Customs in providing intellectual property rights holders with the name and contact details of any person connected with the import or export of seized goods necessary for instituting intellectual property rights infringement proceedings.

For more information on the IP BE Act and the Bill, please refer to our May newsletter 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