

## Newsletter

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## Proposed Reforms to Singapore's Intellectual Property Dispute Resolution Regime

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### What's changing

The Ministry of Law ("**MinLaw**") has proposed certain changes to the Intellectual Property ("**IP**") Dispute Resolution regime in Singapore, based on the recommendations of the IP Dispute Resolution Committee and the Civil Justice Review Committee. MinLaw has proposed the following:

1. A consolidation of civil IP proceedings
  - a. Currently, IP disputes are heard in the High Court, State Courts and the Intellectual Property Office of Singapore ("**IPOS**") with the chosen forum based on the nature of the IP rights, type of proceedings and value of claims. With the proposed changes, the High Court will have exclusive jurisdiction over infringement of all forms of IP, passing off and declarations of non-infringement of patents and registered designs.
  - b. The High Court will continue to have concurrent jurisdiction with the State Courts over disputes relating to trade secrets and breaches of confidence, and concurrent jurisdiction with IPOS over post-grant revocation and invalidation of IP rights.
2. Two litigation "tracks" - the "default track" and the "fast track"
  - a. Under the "default track", cases will proceed in the same manner as other types of civil disputes.
  - b. Parties will have the option for "fast track" IP litigation. The "fast track" is intended for lower value claims or where parties prefer their case to be further expedited. The proposed features of the "fast track" are:
    - i. A limit of two hearing days for trial.
    - ii. A cap of SGD 500,000 on the value of the claim, where the cap can be waived by agreement of the parties.
    - iii. Any material to be submitted must be expressly allowed by the court.
    - iv. A cap on the maximum amount of party-and-party costs and disbursements recoverable for each stage of the proceeding. There will be an overall cap of SGD 50,000 on the total costs. However, there will be exceptions to the cap where the court considers that there is an abuse of process and/or where the validity of a registered IP right has been challenged.



- c. Parties will be able to apply to transfer their case from one "track" to another, or the case can be transferred on the court's motion. The considerations for transfer by the court are yet to be decided.

## What it means for you

The consolidation of civil IP proceedings in the High Court will reduce the complexity of IP dispute resolution and benefit parties from having their cases heard by judges with specialist IP experience on the High Court bench.

In addition, parties who are less well-resourced, such as individuals and SMEs, will be able to benefit from the "fast track" option. These parties will be able to use this method to enforce their IP rights or defend themselves at a lower cost than what they may have incurred if they had proceeded to litigation in the "default track". The "fast track" would also benefit parties who wish to have their case further expedited due to time constraints.

You can find more details on the proposed changes in the Public Consultation Paper ([here](#)), and in the Report of the IP Dispute Resolution Committee ([here](#)).

## Proposed Reforms to Singapore's Civil Justice System

### What's changing

In addition to the proposed changes to the IP Dispute Resolution regime, MinLaw has proposed changes to Singapore's civil justice system based on the recommendations of the Civil Justice Review Committee. We highlight some of the key proposed changes below:

1. Enhanced judicial involvement in civil proceedings
  - a. The Chief Justice will be empowered to determine the extent to which the Rules of Court apply to certain categories of cases. For instance, certain rules may be disapplied for smaller value claims.
  - b. When a case comes to trial, there will be increased judicial involvement to allow judges to take greater control of the conduct of the trial and avoid excessive time and costs being expended on lengthy trials.
2. A duty will be imposed on parties to proceedings to consider amicable resolution of the dispute before commencing any action or appeal. If the court is of the view that this duty has not been discharged properly, the court will be empowered to order parties to attend alternative dispute resolution.
3. Greater flexibility and autonomy to manage cases during Case Conferences.
  - a. Parties will be required to file a list of issues prior to the first Case Conference.



- b. Parties may be directed to exchange Affidavits of Evidence-in-Chief (AEIC) of all or some of the witnesses before any exchange of documents.
  - c. The court will control the number of and the period within which interlocutory applications may be filed by determining the applications which are required and ordering each party to file a single application as far as possible.
  - d. Parties will be required to submit a case note to the court at the pre-trial stage, preferably before directions on evidence are given.
  - e. The court will not allow pleadings to be amended within 14 days before trial. The court may draw appropriate inferences if material facts in the pleadings are amended. This is to eliminate parties seeking to amend pleadings close to the trial date or even on the first day of trial. However, exceptions can be made for special cases.
4. A system of scale costs where solicitor-and-client costs would be equal to party-and-party costs. The intended result is that a successful litigant who conducts their case reasonably throughout should recover all litigation costs. However, parties will be able to make an informed choice whether to depart from the scale costs.

## What it means for you

The proposed reforms to the civil justice system are intended to simplify rules and eliminate time-consuming or expensive procedural steps. These advancements in the rules are intended to ensure fairness to all parties in civil proceedings where disputes will be resolved and further expedited based on the factual and legal merits of the matter while ensuring costs are maintained at reasonable levels.

You can find more details on the proposed changes in the Public Consultation Paper ([here](#)), and in the Report of the Civil Justice Review Committee ([here](#)).

## Similarity of goods and services - *New Yorker S.H.K. Jeans GMBH & Co. KG v Daidoh Limited* [2018] SGIPOS 18

### Facts

Daidoh Limited (the "**Opponent**") sought to oppose the trade mark application in the name of New Yorker S.H.K. Jeans GmbH & Co. KG (the "**Applicant**") for **NEWYORKER** (the "**Application Mark**") in Class 35 on the basis of its earlier mark "**NEWYORKER**" (the "**Opponent's Mark**") in Class 25, relying on Sections 8(2)(a) (identical marks) and 8(2)(b) (confusingly similar marks and/or goods) of the Trade Marks Act ("**TMA**").



In response to the opposition, the Applicant commenced separate proceedings against the Opponent's Mark seeking revocation for "non-use". These proceedings were heard in 2017, where the Principal Assistant Registrar (the "**Registrar**") found that the Opponent's Mark had been put to genuine use in relation to most, but not all, of the goods in respect of which it was registered. Ultimately, the Registrar granted partial revocation of the prior mark, but noted it had no impact on the present opposition.

## Decision

As a preliminary matter, the Registrar briefly touched on the possibility of a partial opposition under the TMA. This issue arose as the Opponent had initially offered to withdraw the opposition in respect of certain services under the Application Mark in Class 35, but not the rest of the services in the same class (the "**Uncontested Services**"). In substance, this would therefore have amounted to a partial opposition, which the Registrar noted to be a thorny issue. However, the Opponent eventually abandoned its request to withdraw its opposition to the Uncontested Services, and instead proposed that some, but not all, of the services under the Application Mark in Class 35 should be treated as dissimilar to the goods covered in the Application Mark. Those services that were considered similar to the goods were referred to as the "Contested Services". With no objection from the Applicant, this was endorsed by the Registrar by way of direction.

The Registrar then found that the marks were identical on the whole - i.e. aurally, conceptually and visually - and allowed the opposition under section 8(2)(a), or alternatively under section 8(2)(b) if it was not correct in viewing the marks as identical.

In relation to section 8(2)(a), it was common ground between the parties that the marks were aurally and conceptually identical. The Registrar was of the view that while visual differences existed, there was nothing distinctive about the visual differences, which would not stand out in the average consumer's imperfect recollection.

In assessing the similarity of the goods to the Contested Services, the Registrar relied on the principles set out in *Guccio Gucci S.p.A. v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 and *British Sugar Plc v James Robertson & Sons Ltd*. [1996] RPC 281 ("**British Sugar**") to find that similarity of goods and services existed between the Contested Services and some of the goods under the Opponent's Mark. This was particularly so where the Contested Service involved the service of providing the Opponent's good itself. While the Registrar did not spell out his analysis with reference to the classic *British Sugar* factors (i.e. comparison of respective uses, users, etc.), the Registrar noted that this is not strictly necessary as numerous subsequent decisions have demonstrated that the factors are not rigid rules of law.



Further, the Registrar agreed with the Opponent that if the Application Mark was allowed to proceed to registration, a substantial portion of the relevant public would likely be confused because the marks are identical and the respective goods and services are similar. The Registrar commented that while there might not be evidence of actual confusion, this is expected since the Applicant has no stores in Singapore.

## Comment

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While this case did not rule on the yet-undecided issue of partial oppositions under the TMA, it is worth noting the Registrar's endorsement of the Opponent's alternative strategy to confine its arguments to the contested services, which parties in a similar position in a future case would do well to follow suit.

This case also affirms the position in the limited pool of case law that goods can be considered to be similar to services. In particular, it clarifies that similarity can exist where the earlier mark was registered for the services of retailing certain goods, and the application mark is applied to be registered for those specific goods, and vice versa.