

ENFORCEMENT OF TRADEMARK RIGHTS - INFRINGEMENT OF REGISTERED TRADEMARKS AND OPPOSITION PROCEEDINGS

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Protection of registered trade marks and well-known marks – infringement and opposition proceedings

The Trade Marks Act (Cap 332, 2005 Rev Ed) (“**TMA**”) grants registered proprietors exclusive rights to use certain trade marks and to authorise other persons to use such trade marks. The protection provided under the TMA lasts for an initial period of 10 years from the date of registration, and the registration is renewable for further periods of 10 years at the request of the proprietor, subject to the payment of a fee. Registered proprietors should ensure that the registered trade marks are put to genuine use in the course of trade in Singapore to prevent the possibility of a revocation of their registered marks on grounds of non-use.

Trade mark owners in Singapore may seek redress for infringement of their registered trade marks under the TMA and for unauthorised use of their unregistered trade marks at common law under the tort of passing off. In this article, we discuss the rights of proprietors of registered trade marks (“**registered proprietors**”) under the TMA.

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Infringement of registered trade mark

A registered proprietor has the exclusive right to use the registered trade mark in relation to the goods or services for which the trade mark is registered. Infringement occurs where there is unauthorised use by a third party of an identical trade mark in relation to goods or services which are identical with those for which the registered trade mark is registered or where a likelihood of confusion arises by the unauthorised use by a third party of an identical or similar mark in relation to identical or similar goods or services in the course of trade. Infringement can also occur even if there is unauthorised use by a third party of a trade mark which is not registered in Singapore but which is a well-known mark in Singapore.

There are 3 questions to ask to determine whether there is an infringement of a registered trade mark.

- (a) Firstly, whether there is (i) identity between the infringing sign or mark and the registered trade mark or (ii) visual, aural and conceptual similarity between the two marks.
- (b) Secondly, whether the infringing sign or mark and the registered trade mark were used in relation to similar or identical goods or services.

The comparison for similarity would be between the actual use by the infringing sign or mark and the specifications for which the registered proprietor had registered the trade mark.

The factors to be considered are:

- (a) The uses of the goods and services
- (b) The users of the goods and services
- (c) The physical nature of the goods or acts of service
- (d) The trade channels through which the goods and services reach the market
- (e) The extent to which the respective goods and services are competitive
- (f) Lastly, where the answers to (a) and (b) are affirmative, whether there exists a likelihood of confusion on the part of the public. The mere association of the public between the two marks based on their similar use is not in itself a sufficient basis for concluding that there is a likelihood of confusion. In considering whether there is a likelihood of confusion, the court will consider whether the infringing party had taken steps to distinguish his goods from the registered proprietor, the level of similarity between the marks, the distinctiveness of both marks and the level of sophistication and discernment of the registered proprietor's target customers.

Defence to infringement

The owner of the infringing sign or mark may have a defence under s28 of the TMA for:

- (a) Honest use of his name or the name of his place of business
- (b) Honest use of the sign or mark to indicate the intended purpose of the goods
- (c) Continuous use of his sign or mark since before the date of registration of the registered trade mark
- (d) Fair use in comparative commercial advertising or promotion
- (e) Use for non-commercial purposes

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- (f) Use for the purpose of news reporting or news commentary
- (g) Use of another registered trade mark

Remedies for infringement

The types of remedies which the court can grant include (i) an injunction; (ii) damages, an account of profits or statutory damages. The court may also grant an order for (i) the erasure, removal or obliteration of the offending sign or mark; (ii) delivery up and/or (iii) disposal of goods, materials and articles.

The registered proprietor may also enforce his trade mark rights in criminal proceedings. Some of the acts which constitute trade mark offences and attract criminal penalties include (i) counterfeiting a registered trade mark; (ii) falsely applying a registered trade mark to goods or services; (iii) making or possessing articles for committing offences; and (iv) importing or selling goods with falsely applied trade marks. Upon conviction for any of these offences, the penalties are a fine of up to S\$100,000 and/or imprisonment for a maximum term of 5 years with a possibility of forfeiture and destruction of goods or infringing articles.

Opposition proceedings

A third party who attempts to apply for a trade mark which is identical or similar to an earlier registered trade mark or an unregistered trade mark for identical or similar goods or services may be prevented from proceeding during the 2-month period within which the registered trade mark owner can oppose the application.

Under Section 8 of the TMA, there are several grounds upon which a trade mark shall not be registered, including the following:

- (a) 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 earlier mark; or
- (b) if it is (i) identical with an earlier trade mark and is to be registered for goods or services similar to the earlier trade mark or (ii) similar to an earlier trade mark and is to be registered for goods or services identical to the earlier trade mark, and there exists a likelihood of confusion on the part of the public; or
- (c) if it is identical with or similar to an earlier trade mark, the earlier trade mark is well known in Singapore and the use of the later trade mark would
 - i) indicate a connection between those goods and services and the proprietor of the earlier trade mark and which use is likely to damage the interest of the proprietor of the earlier trade mark; or
 - ii) if the earlier trade mark is well known to the public at large in Singapore and would cause dilution in an unfair manner of the distinctive character of the earlier trade mark or would take unfair advantage of the distinctive character of the earlier trade mark.

Questions similar to those considered in determining whether there is an infringement would also be asked to determine if the opposition would be successful. However, for opposition proceedings, the assessment of whether there is a reasonable likelihood of confusion can take into account the notional fair use to which

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the registered proprietor of the earlier trade mark has or might fairly put to use.

Finally, under Section 8(7) of the TMA, a trade mark shall not be registered if, or to the extent that its use in Singapore is liable to be prevented

(a) by virtue of 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; or

(b) by virtue of an earlier right, in particular by virtue of the law of copyright or any law with regard to the protection of designs.

As such, proprietors of registered or unregistered earlier trade marks should be vigilant in reviewing trade marks which are published in trade mark journals so that they may raise oppositions if necessary, preventing the risk of suffering the consequences of competition from later identical or similar marks.

Bill No. 17/2019 Intellectual Property (Dispute Resolution) Bill

Intellectual Property (IP) disputes are currently resolved in the High Court, State Courts and the Intellectual Property Office of Singapore (IPOS). A bill read in Parliament on 8 July 2019 streamlines the IP dispute resolution process such that IP disputes are consolidated in the High Court, save for standalone revocation claims which remain to be shared between the High Court and IPOS and claims for breach of confidence for damages up to S\$250,000, which remain within the purview of the State Courts.

An additional track in the High Court for the litigation of IP disputes with simplified processes is being introduced to enable small and medium-sized enterprises to afford IP litigation.

It is also the intention to amend the Arbitration Act and the International Arbitration Act to allow IP disputes to be arbitrated in Singapore.

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