

SECTION 1 COPYRIGHT AND NEIGHBOURING RIGHTS

*A. Introduction to copyright**(1) Copyright refers to bundle of negative rights to prevent copying*

12.1.1 Copyright is the term used to describe the bundle of rights that is granted by statute in respect of original works and other subject-matter for limited periods of time and subject to certain permitted exceptions. In Singapore, that statute is the Copyright Act (Cap 63, 2006 Rev Ed) (the "CA"). Unlike registered designs and patents, copyright is not a monopoly. It is essentially a negative right to prevent copying. This means that if two identical works were in fact produced independently of one another, there is no infringement of copyright by one of the other (*Chua Puay Kiang v Singapore Telecommunications Limited* [1999] 1 SLR(R), *Virtual Map Singapore Pte Ltd v Singapore Land Authority and Another Application* [2009] 2 SLR(R) 558 and the *High Court decision at* [2008] 3 SLR(R) 86 where the defence of independent creation failed based on the evidence).

(2) Copyright only protects way in which ideas are expressed

12.1.2 There is no copyright in ideas, information, principles and facts as such. Rather, copyright only protects the way in which they are expressed. Further, copyright protects the skill, labour and/or judgment used in creating the expression. In particular, copyright subsists in literary, dramatic, musical and artistic works ("works" or "a work"), such as novels, plays, musical compositions, paintings, sculptures and compilations, as well as in subject-matter other than the works, such as sound recordings, films, broadcasts, cable programmes and published editions of works. Additionally, copyright protection is available in respect of live performances and rights management information, such as information identifying the author of a work and the terms and conditions relating to the use of the work.

(3) Copyright subsists immediately upon creation

12.1.3 Copyright arises immediately upon creation. Specifically, there is copyright protection in a work as soon as it is expressed or fixed in a material form (e.g. paper, tape and film) from which it is capable of being reproduced. In relation to literary, dramatic, musical and artistic works, there must also exist an identifiable author who is a natural person (*Asia Pacific Publishing Pte Ltd v Pioneer & Leaders (Publishers) Pte Ltd* [2011] 4 SLR 381). Unlike registered designs, patents and trade marks, there are no formalities required for copyright to subsist and no system of registration of rights. In general, copyright subsists in a work or subject-matter in Singapore if (1) the work or subject-matter was first published or made in Singapore or in a member country of the Berne Convention or the WTO; or (2) the author of the work or the maker of the subject was a citizen or resident of Singapore or of a member country of the Berne Convention or the WTO at the time when the work was first published or made.

(4) Duration of copyright

12.1.4 Generally, copyright in a literary, dramatic or musical work, or in an artistic work other than a photograph, subsists during the life of the author plus 70 years after his death. In the case of a sound recording and film, copyright subsists until the expiry of 70 years after the expiry of the calendar year in which the recording or film was first published. The duration of copyright protection for a broadcast and cable programme is 50 years from the end of the calendar year in which the broadcast was made or the programme was first included in a cable programme service. The duration of copyright protection for a published edition of a work or works is 25 years from the expiry of the calendar year in which the edition was first published.

(5) Ownership of copyright

12.1.5 The general rule is that the person who created a work is the owner of the copyright in the work. However, another person is the owner if

- the copyright was assigned to that person; or
- the work was created by the creator in the course of his employment by that person.

12.1.6 Additionally, if the person who created the work

- was doing so in the course of his employment as a journalist or a writer for a newspaper, magazine or periodical or under a contract of service or apprenticeship, the proprietor of the newspaper, magazine or periodical would be the owner of the copyright, but only for the purpose of publishing or reproducing the work in the newspaper, magazine or periodical;
- is a photographer or artist engaged to take a photograph of a person or to draw the portrait of a person, the person would be the copyright owner and he has the right to prevent the photographer or artist from using the photograph or painting for any purpose that he has not agreed to.

B. Exclusive rights and infringement

(1) Copyright owner has exclusive right to do or to authorise others to make primary infringements

12.1.7 The CA confers on the copyright owner the exclusive right to do, or to authorise others to do, certain acts ('primary infringements') in relation to a work, or subject matter like sound recordings, and films, such as:

- to reproduce the work in a material form;
- to publish the work if the work is unpublished;
- to perform the work in public;
- to make an adaptation of the work or to do any of the above in relation to an adaptation; to communicate the work to the public;
- to make a copy of the sound recording or film;
- to enter into a commercial rental arrangement in respect of the recording; and to cause the film, insofar as it consists of visual images, to be seen in public.

(2) Copyright infringers are those who commit primary infringements without owner's consent, or who make secondary infringements

12.1.8 Copyright infringers are therefore those who do any of the above acts without the copyright owner's consent. The owner's rights are also infringed by such acts ('secondary infringements') as

- importing, selling, offering for sale and exhibiting in public of any article where the infringer knows, or ought reasonably to know, that the article was made without the copyright owner's consent;
- falsely attributing the authorship of a work or the identity of the performer of a performance; and
- falsely removing or altering the rights management information electronically attached to a work.

A copyright owner can sue an infringer in respect of any of these primary and secondary infringements, seeking any of the remedies referred to in [Section 12.1.16](#) below. However, if he does not succeed in his claim of infringement, he may find himself liable for a claim for making groundless threats of copyright infringement (*Asia Pacific Publishing Pte Ltd v Pioneer & Leaders (Publishers) Pte Ltd [2011] 4 SLR 381*). The remedies in such a claim can include those referred to [Section 12.1.16](#) below, such as an injunction against the continuance of the threats, damages as well as a declaration that the threats are unjustifiable.

C. Copyright infringements can constitute offences

12.1.9 The primary and secondary infringements can also be the subject of criminal proceedings initiated by the copyright owner. The proceedings are available for a primary infringement if it is wilful and significant and the infringer commits the infringement to obtain a commercial advantage, in which event he would be liable, if convicted, to a fine not exceeding \$20,000 and/or imprisonment for a term not exceeding 6 months. In the case of a second or subsequent offence, the maximum fine and imprisonment term are \$50,000 and 3 years respectively.

12.1.10 As regards the secondary infringements, the penalties generally range from a fine not exceeding \$10,000 per article or \$100,000 in the aggregate, whichever is the lower, and/or an imprisonment for a term not exceeding 3-5 years. The courts have imposed both fines and custodial sentences on offenders who deal in a large number of infringing items and who commit the infringements in an organised fashion (eg. as part of a syndicate).

D. Permitted acts

(1) Provisions in the CA strike fair balance between interest of copyright owners and public interest

12.1.11 The CA has several provisions permitting certain acts which do not constitute copyright infringements. These acts are intended to strike a fair balance between the interest of copyright owners and the public interest. They include acts (popularly known as "fair dealings") for the purposes of research and study, criticism or review, and reporting current events. To constitute fair dealing for research and study, not more than an article in a periodical or a reasonable proportion of a work (generally, 10% of the pages or a chapter) is to be taken, and the court is also to have regard to such factors as the nature of the work, the amount and substantiality of the part of the work that was copied in relation to the whole work as well as the effect on the potential market. In respect of fair dealing for criticism or review, or for reporting current events, there must also be a sufficient acknowledgement of the work.

(2) Additional defences available

12.1.12 In addition, there are defences catering to a variety of more esoteric acts, such as

- reproduction for purposes of judicial proceedings, professional advice or simulcast;
- temporary, incidental or transient reproduction of a work as part of the technical process of making or receiving a communication
- observing, studying or testing the functioning of a computer program in order to determine the ideas and principles which underlie any element of the program;
- making a backup of a non-infringing copy of a computer program if it is made for the sole purpose of being used in lieu of the original in the event that the original is lost, destroyed or rendered unuseable; incidental inclusion of a work in a film,
- television broadcast or cable programme; and
- reading or recitation of an extract of a reasonable length from a published literary or dramatic work in public.

E. Dealings in Copyright

(1) Copyright, being property right, can be transferred in a variety of ways

12.1.13 Being a property right, copyright can be licensed, assigned or otherwise transferred in a variety of ways. For instance, the copyright owner can license or assign the right to reproduce his work in a material form to one person and the right to perform the work in public to another person. He can also license or assign the copyright in terms of the whole or part of the copyright period or by geographical area. As a result, there can be a bewilderingly large number of licensees and/or owners of different parts of the copyright in a work.

(2) Assignment of copyright must be in writing and signed by copyright owner

12.1.14 An assignment of copyright (whether total or partial) must be in writing and signed by or on behalf of the assignor (the copyright owner). An assignment can also be entered into in respect of copyright that has yet to come into existence, in which event the assignment will only be effective to transfer ownership of the copyright as soon as the work is created.

(3) Licence need not be in writing, although advisable for it to be so

12.1.15 A licence need not be in writing, although it is advisable that it should be so, especially in the case of an exclusive licence (see below). A licence which is not in writing does not bind subsequent assignees of the copyright except a bona fide purchaser for value who does not know of the licence. A licence may be exclusive or non-exclusive. An exclusive licence even excludes the licensor (i.e. the copyright owner) from doing whatever the licence permits – that is, the exclusive licensee is almost the owner of the copyright. Indeed, section 123 of the CA treats an exclusive licensee as the owner for many purposes connected with remedies, as it states that the rights and remedies of an exclusive licence are concurrent with those of the copyright owner.

F. Remedies for infringement

12.1.16 The range of remedies which the Court can order in infringement proceedings includes an injunction, either damages or an account of profits, an order for delivery up and/or disposal of infringing articles in relation to the copyright. In lieu of damages or an account of profits, the copyright owner can elect for an award of statutory damages, for which the court can grant not more than \$10,000 for each work or subject matter in respect of which the copyright has been infringed but not more than \$200,000 in the aggregate, unless the owner proves that his actual loss from such infringement exceeds \$200,000. In awarding statutory damages, the court shall have regard to a number of factors, including

- the nature and purpose of the infringing act (e.g. whether it was of a commercial nature);
- the flagrancy of the infringement;
- whether the defendant acted in bad faith;
- the need for deterrence;
- any loss that the plaintiff has suffered or is likely to suffer by reason of the infringement;
- and any benefit shown to have accrued to the defendant by reason of the infringement.

SECTION 2 INDUSTRIAL DESIGNS

A. Source of law

12.2.1 Protection of industrial designs is available under the Registered Designs Act (Cap 266, 2005 Rev Ed) (the "RDA"). This Act is modelled on the UK Registered Designs Act 1949 (as amended in 1988), and therefore many fundamental concepts in this regime of protection are traceable to English registered design law.

B. Formalities of registration

(1) Registration may be obtained through domestic or international application

12.2.2 Registration may be obtained in two ways: through (i) a domestic application filed with the Registry of Designs within the Intellectual Property Office of Singapore (IPOS), or (ii) an international application filed in accordance with the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, designating Singapore as a country where protection is sought.

(2) Person who has earlier filed application in Paris Convention/ WTO country may claim right of priority

12.2.3 A person who has earlier filed an application for registration in a Paris Convention/WTO country may, if he files for registration in Singapore within 6 months from the date of such application, claim a right of priority. [For the significance of a claim of right of priority, see [Section 12.2.10](#) below]

(3) Application must specify article(s) in respect of which registration is sought

12.2.4 The application must specify the article(s) in respect of which registration for the design is sought. This exercise is important because the monopoly conferred by registration is limited to the article(s) so specified [see further [Section 12.2.15](#) below]. The specification and classification of articles adopted at the Registry of Designs follow that of the Locarno Agreement Establishing an International Classification for Industrial Designs.

C. Subject matter of protection

(1) Subject matter must be a 'new' 'design'

12.2.5 There are two key criteria for registration: the subject matter must be (i) a 'design', which is (ii) 'new'.

(2) Definition of 'design'

(a) 'Design' means features of shape, configuration, pattern or ornament applied to article by any industrial process

12.2.6 A 'design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process. Unlike in some other jurisdictions, there is no additional requirement that the design should have 'eye appeal' or 'individual character'. But there are limits to this broad definition of 'design'. The following cannot be registered:

- Designs which are dictated solely by the function which the article has to perform (the 'functionality' exclusion).
- Designs which are dependent upon the appearance of another article, of which it is intended by the designer to form an integral part (the 'must match' exclusion).
- Designs which enable the article to be connected to, or placed in, around or against, another article so that either article may perform its function (the 'must fit' exclusion).
- Methods or principles of construction.
- Computer programs or layout designs of integrated circuits.
- Designs for articles which are of a primarily artistic character such as wall plaques, medals, book jackets, dress-making patterns.
- Designs the publication or use of which would be contrary to public order or morality.

(b) Examples of registrable designs

12.2.7 Examples of registrable designs include the shape and configuration of an electrical meter box ([Hunter Manufacturing Pte Ltd v Soundtex Switchgear & Engineering Pte Ltd \[1999\] 3 SLR\(R\) 1108](#)); the shape of a chair ([Sebel Furniture Ltd v Tiong Hin Engineering Pte Ltd \[1999\] 3 SLR\(R\) 690](#)); the shape of an orchid applied to ornamental pieces for use as brooches and pendants ([Risis Pte Ltd v Polar Gems Pte Ltd \[1994\] 2 SLR\(R\) 1091](#)).

(c) Example of unregistrable design

12.2.8 An example of an unregistrable design is the shape and configuration of an electrical isolator where the features depended entirely on industry standards ([Nagasima Electronic Engineering Pte Ltd v APH Trading Pte Ltd \[2005\] 2 SLR\(R\) 641](#)).

(3) Definition of 'new'

(a) Design is new if it is not substantially same as any other design registered or published in Singapore or elsewhere

12.2.9 A design is new if it is not the same, or substantially the same, as any other design that has been registered or published in Singapore or elsewhere. Publication includes sale or use of any article which embodies the design.

(b) Novelty of design assessed as at date of application for registration

12.2.10 The novelty of a design is assessed as at the date of the application for registration. Where the applicant has claimed a right of priority [see [Section 12.2.3](#) above], the date of his application shall be the date of his application in the foreign country.

(c) Certain prior disclosures disregarded when assessing novelty of design

12.2.11 Certain prior disclosures are disregarded when assessing the novelty of a design. These are essentially disclosures which cannot be said to have thrown the design into the public domain. For example, a disclosure of a design made during business negotiations such as to import an obligation of confidence on the parties involved would not destroy the novelty of the design ([Hunter Manufacturing Pte Ltd v Soundtex Switchgear & Engineering Pte Ltd \[1999\] 3 SLR\(R\) 110](#)).

D. Ownership and dealings of design

(1) Owner of design usually person who created it

12.2.12 The owner of a design is usually the person who created the design, and he is the one entitled to apply for registration of the design. There are two notable exceptions to this general rule:

- Design created in pursuance of a commission – unless there is an agreement to the contrary, the commissioning party shall be treated as the owner.
- Design created by an employee in the course of employment - unless there is an agreement to the contrary, the employer shall be treated as the owner.

(2) Registered design is personal property and may be assigned as such

12.2.13 A registered design or any right in it is personal property and may be assigned as such, absolutely or by way of security. Licences may also be granted for the use of the registered design. Such dealings should be registered with the Registry of Designs; failure to do so means that the assignment or licence is ineffective as against a person acquiring a conflicting interest in the registered design in ignorance of it.

E. Maximum duration of rights conferred is 15 years

12.2.14 The maximum duration of the exclusive rights conferred by registration is 15 years.

F. Exclusive rights and infringement

(1) Registered owner has exclusive rights to make or import articles which embody the registered design

12.2.15 The registered owner has the exclusive rights to make or import for the purposes of trade (eg. sale, hire) articles, in respect of which his design is registered, which embody the registered design (or one that is substantially the same).

(2) Infringement occurs when person does exclusive rights without authorisation or certain preparatory acts

12.2.16 Infringement occurs not only when a person does any of the above exclusive rights without authorisation; there can also be infringement in respect of certain preparatory acts, for example, making something that enables the infringing article to be made.

(3) Protection conferred by registration limited to allow for certain acts

12.2.17 The monopoly conferred by registration is limited to allow for certain acts such as:

- Acts done for a private non-commercial purpose.
- Acts done for the purpose of evaluation, analysis, research or teaching.
- Acts done in relation to genuine articles, that is, those marketed in and outside of Singapore, by the registered owner or with his consent (conditional or otherwise).

G. Remedies for infringement

12.2.18 The range of remedies which the Court can order in infringement proceedings includes an injunction, either damages or an account of profits, an order for delivery up and/or disposal of infringing articles in relation to the registered design. However, if the registered owner does not succeed in his claim of infringement, he may find himself liable for a claim for making groundless threats of design infringement. The remedies in such a claim can include an injunction against the continuance of the threats, damages as well as a declaration that the threats are unjustifiable.

F. Protection available under the RDA only when there is overlap with copyright protection

12.2.19 It is very possible that designs which qualify for protection under the RDA are also original artistic works in which copyright subsists [see [Section 12.1.2](#) above].

12.2.20 Where there is such an overlap, there is no cumulative protection under registered design and copyright law: protection is available under the RDA only. Also, if a design is registrable under the RDA but has not been registered, the design falls to be covered by neither the registered design nor the copyright regime. Therefore, if the artistic work is a registrable design and the intention is to industrially apply it, steps should be taken to register it under the RDA; otherwise, there would be no protection for the design at all.

SECTION 3 PATENTS

A. Source of law

12.3.1 Inventions are protected in Singapore under the Patents Act (Cap 221, 2005 Rev Ed) (the "PA"). It is based on the UK Patents Act 1977, but there are some important differences.

B. Formalities of registration

(1) Registration may be obtained through domestic or international application

12.3.2 Registration may be obtained in two ways: through (i) a domestic application filed with the Registry of Patents within the Intellectual Property Office of Singapore ('IPOS'), or (ii) an international application filed in accordance with the Patent Cooperation Treaty, with the Registry acting as the Receiving Office for the application.

(2) Person who has earlier filed application in Paris Convention/WTO country may claim right of priority

12.3.3 A person who has earlier filed an application for registration in a Paris Convention/WTO country may, if he files for registration in Singapore within 12 months from the date of such application, claim a right of priority. [For the significance of a claim of right of priority, see [Section 12.3.6](#) below] It is important to note that it is an offence for a Singapore resident, without the Registrar's written consent, to file or cause to be filed a patent application outside Singapore without first filing an application for the same invention in Singapore at least two months before the application outside Singapore is made.

*C. Subject matter of protection**(1) Patent may be granted for invention which is product or process*

12.3.4 A patent may be granted for an invention which is a product or a process. The invention must satisfy the following conditions:

- it is new;
- it involves an inventive step;
- it is capable of industrial application; and
- the publication or exploitation of the invention would not generally be expected to encourage offensive, immoral or anti-social behaviour.

Behaviour is not to be regarded as offensive, immoral or anti-social merely because it is prohibited by any law in force in Singapore.

(2) Invention is 'new' if it does not form part of state of art

12.3.5 An invention is 'new' if it does not form part of the state of the art. The state of the art refers to all matters (whether a product, a process, information about either, or anything else) which have at any time before the priority date of the invention been made available to the public (whether in Singapore or elsewhere) by written or oral description, by use or in any other way. A matter contained in a prior patent application is also included. There is no need for the matter to be widely available to the public in order to form part of the state of the art (*Windsurfing International Inc. v Tabur Marine (GB) Ltd* [1985] RPC 59). If a known product is disclosed in a form which makes it suitable for a stated use, it is no longer new notwithstanding that it has never been described for that use (*Martek Biosciences Corp v Cargill International Trading Pte Ltd* [2012] 2 SLR 482). A useful guide to determining whether an invention is new is the "reverse infringement test". Under this test, an invention is no longer new if a prior art publication contains clear and unmistakable instructions or descriptions, which if followed would allow a person skilled in the art to obtain a product or process which would infringe the patent, assuming that the patent is valid (*Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] 2 SLR 724; *Dien Ghin Electronic (S) Pte Ltd v Khok Tai Ting* [2011] 3 SLR 227). It is a general rule that "mosaicing" of prior art, i.e. combining selected features in different prior art publications, is not allowed when assessing whether an invention is new (*FE Global Electronics Pte Ltd v Trek Technology (Singapore) Pte Ltd* [2006] 1 SLR(R) 874 and *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] 2 SLR 724).

12.3.6 Whether an invention is new is to be assessed as at the date of the application for registration. If the applicant claims a right of priority [see [Section 12.3.3](#) above], the date of his application shall be the date of his application in the foreign country.

(3) Invention involves 'inventive step' if it is not obvious to person skilled in art

12.3.7 An invention involves an inventive step if it is not obvious to a person skilled in the art. Such a notional person is not to be endowed with inventive capacity but is deemed to have practical knowledge and experience of the kind of work in which the invention is intended to be used (*Ng Kok Cheng v Chua Say Tiong [2001] 2 SLR(R) 326*, referred to by the Court of Appeal in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd [2008] 1 SLR(R) 335*). He may be a team of highly qualified researchers whose combined skills would normally be employed in the relevant art (*Optical Coating Laboratory v Pilkington [1995] RPC 145 at 156*).

12.3.8 To determine whether an invention is obvious, the court would

- first identify the inventive concept embodied in the patent;
- then assume the mantle of the normally skilled but unimaginative person in the art at the priority date of the patent and impute to him what was, at that date, common general knowledge in the art;
- identify what, if any, differences exist between that knowledge and the patented invention; and finally
- consider whether, without knowledge of the invention, those differences constitute steps which would have been obvious to the person skilled in the art or whether they require any degree of invention.

(*Windsurfing International Inc. v Tabur Marine (GB) Ltd* at 73-74, applied in *Merck & Co. Inc. v Pharmaforte Singapore Pte Ltd [2000] 2 SLR(R) 708* and by the Court of Appeal in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd [2008] 1 SLR(R) 335* and and *Mühlbauer AG v Manufacturing Integration Technology Ltd [2010] 2 SLR 724*; see also *Pozzoli SPA v (1) BDMO SA et al [2007] EWCA Civ 588*, where the *Windsurfing* test is reformulated in the context of obviousness). The fact that an invention is simple does not mean that it is obvious (*Peng Lian Trading Co. v Contour Optik Inc. [2003] 2 SLR(R) 560*, followed in the *First Currency* case). Commercial success is a factor which can be taken into account in determining obviousness though it is not conclusive (*Ng Kok Cheng v Chua Say Tiong [2001] 2 SLR(R) 326* and and in and *Mühlbauer AG v Manufacturing Integration Technology Ltd [2010] 2 SLR 724*).

12.3.9 When assessing whether an invention involves an inventive step, "mosaicing" of prior art is generally allowed, unless it would not have been obvious to a person skilled in the art to "mosaic" the different pieces of prior art (*Martek Biosciences Corp v Cargill International Trading Pte Ltd [2012] 2 SLR 482*).

(4) Invention taken to be 'capable of industrial application' if it can be made or used in any kind of industry

12.3.10 An invention is to be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture. However, a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body will not be considered capable of industrial application, although this does not prevent the patenting of drugs to be used in any such treatment or diagnosis.

D. Ownership and dealings of patent**(1) Patent normally granted to actual devisor of invention**

12.3.11 The patent for an invention is normally granted to the actual deviser (inventor) of the invention unless, by virtue of any statute, rule of law, treaty, international convention or enforceable term of any agreement entered into with the inventor before the making of the invention, it is to be granted to any other person or a successor in title.

(2) Patent or application for patent is personal property

12.3.12 A patent or an application for patent is personal property. As such, it and any rights in or under it may be assigned, mortgaged, licensed or vested by operation of law in the same way as any other personal property. The assignment, mortgage, application for a patent or any right in a patent or application as well as any assent relating to any patent, application or right shall be void unless it is in writing and signed by or on behalf of the parties to the transaction.

(3) Any person who claims to have acquired property in patent should register transaction

12.3.13 Any person who claims to have acquired the property in a patent or an application for a patent by virtue of any transaction, instrument or event (collectively, 'transaction') should register the transaction with the Registrar of Patents, failing which his rights are restricted as against an infringer and person acquiring a conflicting interest in the invention in ignorance of the transaction.

(4) Exclusive licensee of patent has right to bring proceedings for infringement

12.3.14 An exclusive licensee of a patent has the same right as the proprietor of the patent to bring proceedings for infringement of the patent.

E. Duration of patent

12.3.15 The maximum period of duration of the exclusive rights conferred by registration of a patent is 20 years from the filing date. To enjoy this full term, the patent must be renewed before the expiry of the 4th year and every year thereafter.

F. Exclusive rights and infringement

(1) Registered owner has exclusive right to prevent any person from doing certain things

12.3.16 The registered owner has the exclusive right to prevent any person from doing any of the following things in Singapore in relation to a patented invention:

- if the invention is a product, making, disposing of, offering to dispose of, using or importing the product or keeping the product whether for disposal or otherwise;
- if the invention is a process, using the process or offering it for use in Singapore when the person knows, or it is obvious to a reasonable person in the circumstances, that its use without the owner's consent would be an infringement of the patent; and
- if the invention is a process, disposing of, offering to dispose of, using or importing any product obtained directly by means of the process or keeping the product whether for disposal or otherwise.

(2) Whether rights have been infringed depends on comparison of alleged infringing product with patent claims

12.3.17 Whether these rights have been infringed depends on a comparison of the alleged infringing product or process with the patent claims. The claims are to be construed purposively (*Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183) and the following comparative approach has been endorsed by our Court of Appeal in *Genelabs Diagnostics Pte Ltd v Institut Pasteur & anor.* [2000] 3 SLR(R) 530 (see also the affirmation of the *Catnic* case as the "bedrock of patent construction" in *House of Lords in Kirin - Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46 at [51]-[52]; also referred in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd* [2008] 1 SLR(R) 335 and *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] 2 SLR 724):

- Does the variant have a material effect on the way the invention works? If yes, the variant is outside the claim. If no –

- Would this (that is, the variant having no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art. If no, the variant is outside the claim. If yes
- Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention, If yes, the variant is outside the claim.

12.3.18 The abovementioned approach would give the patentee the full extent, but no more than the full extent, of the monopoly which a reasonable person skilled in the art, reading the claims in context, would think that the patentee was intending to claim (and [Mühlbauer AG v Manufacturing Integration Technology Ltd \[2010\] 2 SLR 724](#)).

(3) Permitted acts which do not constitute infringement of patent

- acts done privately and for non-commercial purposes;
- acts done for experimental purposes relating to the subject-matter of the invention; and
- acts which consist of the extemporaneous preparation of a medicine for a person in accordance with a medical or dental prescription or consist of dealing with such medicine.

G. Remedies for infringement

12.3.20 The remedies which the Court can order in infringement proceedings include an injunction, either damages or an account of profits, an order for delivery up and/or disposal of infringing articles in relation to the registered patent and a declaration that the patent is valid and has been infringed.

H. Groundless Threats

12.3.21 Where a person threatens another person with proceedings for any infringement of a patent, the aggrieved person may also counterclaim for groundless threats of infringement proceedings. To succeed, the plaintiff in the groundless threats proceeding must prove that the threats were so made and satisfy the court that he is the person aggrieved by them. He will be entitled to relief unless the defendant is able to justify the threat by showing that the acts in respect of which infringement proceedings were threatened constitute or would constitute an infringement of its patent, and the patent must not be invalid in the relevant respect ([ASM Assembly Automation Ltd v Aurigin Technology Pte Ltd \[2010\] 1 SLR 1](#)).

SECTION 4 CONFIDENTIAL INFORMATION/ TRADE SECRETS

A. Nature of law on confidential information

12.4.1 The law on confidential information is concerned with preventing a person from divulging information which has been given to him in confidence and on the express or implicit understanding that the information should not be disclosed to others or otherwise used by him. It is given statutory recognition in Singapore in section 6 of the Copyright Act which states:

‘Nothing in this Act shall affect the operation of the law relating to breaches of trust or confidence.’

The law on confidential information provides a useful adjunct to the other intellectual property rights. For instance, whilst copyright protects the expression of the idea only (as mentioned in [Section 12.1.2](#) above), the law on confidential information is wider and can

protect the idea itself. Additionally, the law can be useful for certain types of trade secrets for which the other rights may not be appropriate, such as the recipe for the 'Coca-Cola' drink or a secret business plan.

B. Elements of the law on confidence

12.4.2 To be protectable,

- the information must have the necessary quality of confidence about it;
- the information must have been imparted in circumstances importing an obligation of confidence; and there
- must be an unauthorised use of the information to the detriment of the party communicating it.

(*Coco v Clark (Engineers) Ltd* [1969] RPC 41 followed by the Court of Appeal in *Obegi Melissa and Others v Vestwin Trading Pte Ltd and Another* [2008] 2 SLR(R) 540).

(1) "Necessary quality of confidence"

(a) Information must not already be available to public at large

12.4.3 To have the "necessary quality of confidence", the information must not already be available to the public at large. It does not have to be new, inventive or special, as any ordinary or mundane information can be the subject matter of confidence provided it is private to the person who discloses the information, even though others could gather similar information if they took the trouble to do so. The information can relate to technical, commercial and personal matters (e.g., price lists, customer lists and financial statements). The information can be confidential as a whole even though its component parts are in the public domain; however, the information has to be sufficiently well developed such that it can be defined with sufficient objective certainty (*Invenpro (M) Sdn Bhd v JCS Automation Pte Ltd* [2014] 2 SLR 1045). Mere gossip or information relating to scandalous or immoral material is not protectable.

(b) Factors affecting confidentiality of information

12.4.4 In general, the information is likely to be considered to be confidential and therefore protectable if

- release of the information would injure the owner of the information or benefit
- others; the owner believes the information to be secret and not already in the public
- domain; the owner's belief in respect of (a) and (b) above is reasonable; and
- the information must be judged in the light of usages and practices of the particular trade or industry concerned.

(*Thomas Marshall (Exports) Ltd v Guinle* [1979] Ch 227).

(c) Information must be clearly and specifically identified in action for breach of confidence

12.4.5 In an action for breach of confidence, the owner must clearly and specifically identify the confidential information that is alleged to have been wrongly disclosed or used by the defendant (*Chiarapurk Jack v Haw Par Brothers International Ltd* [1993] 2 SLR(R) 620).

(2) "Obligation of confidence"

(a) Obligation of confidence can arise by contract or by implication of law

12.4.6 The obligation can arise by contract or be implied in equity by applying principles of good faith and conscience, such as where there is a duty of good faith as in the relationship between a lawyer and his client, a banker and his customer and an employer and his employee. Another situation in which such an implication would arise is where a person discusses his information (e.g. business plan) with a potential business partner with a view to commercially exploiting the information. A person who is given confidential information will not be bound by the obligation if he is unaware (and has no reason to be aware) of the confidential nature of the information. If the parties deal directly, an objective test is the preferred basis for determining whether good faith and conscience supports the imposition of a duty of confidence (*Invenpro (M) Sdn Bhd v JCS Automation Pte Ltd* [2014] 2 SLR 1045).

12.4.7 In addition, an equitable obligation of confidentiality may be imposed on a third party recipient who has knowledge of the breach of confidence by the direct recipient. Such knowledge is usually sufficient to give rise to actual or constructive knowledge/notice of the breach (*Invenpro (M) Sdn Bhd v JCS Automation Pte Ltd* [2014] 2 SLR 1045).

(b) Ex-employee not bound by duty of good faith

12.4.8 An ex-employee is not bound by the duty of good faith. He is permitted to make use of his memory of the information that he has acquired during employment, except trade secrets and information covered by the express term of his employment contract. Whether the information is to be regarded as a trade secret depends on such factors as

- the nature of the employment;
- the nature of the information;
- how the information was handled in the company (e.g. whether the employer stressed the confidential nature of the information); and
- whether the information could easily be isolated from the other information that the employee could use.

(*Faccenda Chicken Ltd v Fowler* [1987] Ch 117, applied in *Tang Siew Choy v Certact Pte Ltd* [1993] 1 SLR(R) 835; *Asia Business Forum Pte Ltd v Long Ai Sin* [2003] 4 SLR(R) 658 and the Court of Appeal in *Man Financial (S) Pte Ltd v Wong Bark Chuan David* [2008] 1 SLR(R) 663; and *Clearlab SG Pte Ltd v Ting Chong Chai* [2014] SGHC 221).

(3) "Unauthorised use of information"

(a) Objective test of conscionability as to whether there is obligation not to disclose or use confidential information

12.4.9 A person who has acquired confidential information under confidential circumstances is under an obligation not to disclose or use the information. Whether there is such an obligation on him depends on whether it is conscionable for a recipient of confidential information to disclose or use the information in the circumstances in question (*Douglas v Hello! Ltd* [2001] QB 967 at [65]). The test is objective. He is liable even if he does not appreciate the confidentiality of the information (*National Broach v Churchill Gear* [1967] 1 WLR 384), has no intention to take advantage of the information (*Interfirm Comparisons v Law Society of New South Wales* [1977] RPC 137), or uses the information "subconsciously" (*Seager v Copydex* [1967] 1 WLR 923).

(b) Third party to whom confidential information has been wrongfully disclosed would not be liable if he is bona fide purchaser

12.4.10 A third party to whom confidential information has been wrongfully disclosed would not be liable for disclosing or using the information if he is a bona fide purchaser for value without notice of the confidentiality of the information (see *Stevenson, Jordan and Harrison Ltd v Macdonald and Evans Ltd* (1951) 69 RPC 10). But once he knows that the information was originally given in confidence, he can be restrained from disclosing or using the information (*Wheatley v Bell* [1984] FSR 16).

(c) Unauthorised disclosure is allowed if it is in public interest

12.4.11 Unauthorised disclosure is allowed if it is in the public interest or there is a just cause or excuse (e.g. to prevent cover-up of a wrongdoing) (*Lion Laboratories Ltd v Evans* [1985] QB 526).

C. Remedies for breach of confidence

12.4.12 Where the requirements are established, the owner of the confidential information can apply to the Court for an injunction, either damages or an account of profits, and an order for delivery up and/or disposal of materials containing the confidential information.

SECTION 5 TRADE MARKS: PROTECTION UNDER TRADE MARKS ACT

A. Source of law

12.5.1 Singapore has a dual system of trade mark law: protection for trade marks may be available both under the Trade Marks Act (Cap 332, 2005 Rev Ed) (the "TMA") and at common law [see [Section 6](#) below]. These two systems are independent of each other.

B. Formalities of registration

(1) Protection under TMA conditional upon registration of trade mark

12.5.2 Protection under the TMA is conditional upon registration of the trade mark with the Registry of Trade Marks within IPOS. There is one exception in this regard: special protection is granted under the TMA to 'well known' trade marks, regardless of whether they are registered (see further [Sections 12.5.30 – 12.5.32](#) below).

(2) Registration may be obtained through domestic or international application

12.5.3 Registration may be obtained in two ways: through (i) a domestic application filed with the Registry of Trade Marks; or (ii) an international application filed under the Madrid Protocol, designating Singapore as a country where protection is sought.

(3) Person who has earlier filed application in Paris Convention/WTO country may claim right of priority

12.5.4 A person who has earlier filed an application for registration in a Paris Convention/WTO country may, if he files for registration in Singapore within 6 months from the date of such application, claim a right of priority. [For the significance of a claim of right of priority, see [Section 12.5.13](#) below.]

(4) Application to specify the goods and services for which trade mark is to be registered

12.5.5 Singapore follows the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

C. Subject matter of protection

12.5.6 There are three key criteria for registration: the subject matter must be (i) a 'trade mark' which (ii) is 'distinctive', and (iii) does not conflict with an earlier trade mark.

(1) 'Trade mark'**(a) Trade mark is any sign capable of being graphically represented to distinguish goods or services**

12.5.7 A trade mark is any sign capable of being graphically represented that is used, or proposed to be used, by a trader to distinguish his goods or services from those of other traders. Classic examples include brand names, devices or logos and colours. Where the sign consists of a three-dimensional shape, it must not consist exclusively of:

- the shape which results from the nature of the goods themselves;
- the shape of goods which is necessary to obtain a technical result; or
- the shape which gives substantial value to the goods.

12.5.8 Non-visually perceptible signs (eg. sound marks such as the Intel chime) can also qualify as trade marks, provided that they are graphically represented.

(b) Sufficient for trade mark registration if trader has bona fide intention to use sign

12.5.9 As indicated in [Section 12.5.7](#) above, to qualify as a trade mark, the sign need not have been used in the course of trade as at the date of filing the application for registration. It is sufficient if the trader proposes to use the sign or, to use the language of the TMA, has a bona fide intention to use it [see further [Section 12.5.18](#) below]. In such a case, the trader must ensure that within 5 years following the date of completion of the registration procedure, the trade mark is put to genuine use; otherwise, the registration may be revoked.

(2) 'Distinctive'**(a) Meaning of distinctiveness**

12.5.10 A trader's trade mark is distinctive of his goods or services if, in particular, it is not descriptive of those goods or services. It is a question of degree in every case whether the sign is so descriptive of the goods or services in question that it will be refused registration. There are some signs which are so descriptive that they are incapable of distinguishing the trader's goods or services: for example, 'soap' for soap. Such a sign cannot qualify as a trade mark, regardless of the amount of use made of it by the trader.

12.5.11 A sign which is less descriptive of the trader's goods or services may nevertheless be devoid of distinctive character if it cannot do the job of distinguishing without the trader first educating the public that it is a trade mark. Trade marks falling within this category include the word 'LOVE' in relation to jewellery ([Love & Co Pte Ltd v The Carat Club Pte Ltd \[2009\] 1 SLR\(R\) 561](#)) and laudatory terms like 'ROYAL' to convey pre-eminence or superior quality of the goods or services ([Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd \[2000\] 2 SLR\(R\) 604](#)). A trader who adopts such an inherently descriptive trade mark may, however, use it to such an extent that it becomes in fact distinctive of his goods or services; in such a case, the requirement for distinctiveness would be satisfied. To prove that the trade mark has acquired distinctiveness through use, it is usual to tender evidence of sale volume, advertisements etc.

12.5.12 The following is an example of a trade mark which, while not totally meaningless when used in relation to the goods or services in question, is not so descriptive as to be devoid of distinctive character: 'LADY ROSE' in relation to perfumes ([Hai Tong Co \(Pte\) Ltd v Ventree Singapore Pte Ltd \[2013\] SLR 941](#)).

(3) No conflict with earlier trade marks**(a) Trade mark which conflicts with earlier trade mark would be refused registration**

12.5.13 A distinctive trade mark would nevertheless be refused registration if it conflicts with an earlier trade mark, that is, an earlier registered trade mark or a trade mark (whether registered or not) which is well known in Singapore. In determining whether which mark is earlier in time, account will be taken of any priority claimed in respect of the trade marks [see [Section 12.5.4](#) above].

12.5.14 There is a conflict, generally speaking, when the two marks are identical or similar and their co-existence in the market would be likely to confuse the public. There are two situations where it is not necessary to prove such confusion.

(b) Situations where it is not necessary to prove that co-existence would be likely to confuse public

12.5.15 The first situation is where the marks are identical and the goods/services in question are identical. The likelihood of confusion is presumed.

12.5.16 The second situation is where the earlier trade mark is well known to the public at large in Singapore. This special category of well known trade marks is protected against any registration in relation to identical/similar/dissimilar goods or services which would cause dilution in an unfair manner, or take unfair advantage, of the distinctive character of the mark. This is the Singapore model of the 'anti-dilution' right. It is modelled after the WIPO Joint Recommendations Concerning the Provisions on the Protection of Well-known Marks.

(4) *Other obstacles to registration*

12.5.17 Finally, there are other obstacles to registration. For example, a trade mark shall not be registered if it is contrary to public policy or morality, or the application is not made in good faith. Examples of lack of good faith would be the case where the applicant has no bona fide intention to use the trade mark at all but wishes to prevent a competitor from using the mark or one that is similar to it ([Weir Warman Ltd v Research & Development Pty Ltd \(2007\] 2 SLR\(R\) 1073](#) and, where a distributor in Singapore registers a trade mark that is similar to his foreign principal's trade mark ([Nautical Concept Pte Ltd v Mark Richard Jeffery \[2007\] 1 SLR\(R\) 1071](#)).

D. Ownership and dealings of trade mark

(1) *Application seeking registration of trade mark has to assert claim to proprietorship*

12.5.18 An applicant seeking registration of a trade mark has to assert a claim to proprietorship in the trade mark in the application form: this merely takes the form of a declaration that the applicant is using the trade mark in the course of trade or that he has a bona fide intention to so use the trade mark. This claim to proprietorship may be challenged by another party on the ground that the application was made in bad faith [see [Section 12.5.17](#) above].

(2) *Registered trade mark is personal property, which may be assigned by proprietor*

12.5.19 A registered trade mark is personal property, which may be assigned by the registered proprietor as such, absolutely or by way of security. Such dealings should be registered with the Registry of Trade Marks; an unregistered assignment is ineffective as against a person acquiring a conflicting interest in the trade mark in ignorance of it.

12.5.20 The registered proprietor may also grant licences to use the registered trade mark, and these are also registrable transactions.

E. Duration of protection

12.5.21 The initial period of protection is 10 years from the date of registration. Thereafter, the registration may be renewed for further periods of 10 years.

12.5.22 To maintain the trade mark on the register, apart from taking steps to renew it at the appropriate time, it is very important to ensure that there is genuine use of the trade mark in the course of trade in Singapore. This is because non-use for an uninterrupted period of 5 years without proper reason constitutes a ground for revocation of the registration. Once this ground is proved, there is no discretion to maintain the trade mark on the register (*Wing Joo Loong Ginseng Hong (S) Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814).

F. Exclusive rights and civil infringement

(1) Registered proprietor has exclusive right to use trade mark in relation to goods or services for which trade mark is registered

12.5.23 The registered proprietor has the exclusive right to use the trade mark in relation to the goods or services for which the trade mark is registered. Infringement occurs when there is unauthorised use in the course of trade of an identical/similar mark in relation to identical/similar goods or services, where such use is likely to confuse the public. Where the marks are identical and the goods or services are identical, the presence of confusion is presumed.

(2) Scope of protection wider where registered trade mark well known in Singapore

12.5.24 Where the registered trade mark is well known in Singapore, the scope of protection is wider. Firstly, it is infringement when the unauthorised use is made in relation to goods or services which are not similar to those for which the well known trade mark is registered, where such use is likely to confuse the public. A registered trade mark is deemed to be well known in Singapore if it is well known to a relevant sector of the public in Singapore.

12.5.25 Secondly, where the registered trade mark is well known to the public at large in Singapore, its proprietor is entitled to restrain by injunction any use in relation to identical/similar/dissimilar goods or services which would cause dilution in an unfair manner, or take unfair advantage, of the distinctive character of the mark, regardless of whether there is any likelihood of confusion. This is the Singapore model of the 'anti-dilution' right. [See also [Section 12.5.16](#) above.]

(3) Limitations on scope of protection

12.5.26 The monopoly conferred by the TMA is limited to allow for certain uses such as:

- Honest use of one's own name.
- Honest descriptive use (eg. to indicate the kind or quality of the goods).
- Fair use in comparative commercial advertising or promotion.
- Use for non-commercial purpose.
- Use for the purpose of news reporting or news commentary.
- Use in relation to genuine goods, that is, those marketed in and outside of Singapore, by the Singapore registered proprietor or with his consent (conditional or otherwise).

G. Remedies for civil infringement

12.5.27 Except where the infringement relates to the enforcement of the 'anti-dilution' right where the only remedy available is an injunction [see [Section 12.5.25](#) above], the range of remedies which the Court can order in civil infringement proceedings include an injunction, either damages or an account of profits, an order for delivery up and/or disposal of infringing articles in relation to the

registered design. Where the infringement involves the use of a counterfeit trade mark, the Court may even award statutory damages of up to S\$1 million without proof of actual loss.

H. Trade mark offences

12.5.28 Aside from these civil remedies, the registered proprietor may also enforce his trade mark rights in criminal proceedings. The following infringing acts can give rise to criminal liability:

- Counterfeiting a registered trade mark.
- Falsely applying a registered trade mark to goods or services.
- Making or possessing articles for committing offences.
- Importing or selling etc goods with falsely applied trade mark.

12.5.29 Conviction for any of these offences attracts severe penalties: a fine of up to S\$100,000 and/or imprisonment for a maximum term of 5 years. Singapore courts take a very serious view of trade mark offences; in fact, custodial sentences are the norm unless the quantity of infringing articles is quite small. The imposition of strong deterrent sentences is part of the 'efforts to promote Singapore as a regional intellectual property centre and the concomitant need to clamp down on piracy of intellectual property' (per Yong CJ in *Ong Ah Tiong v Public Prosecutor* [2004] 1 SLR(R) 587 at [23]).

I. Protection for well known trade marks

(1) Special protection that conforms to international standards

12.5.30 As noted in [Section 12.6.4](#) above, there is special statutory protection for proprietors of trade marks which are well known in Singapore, whether or not their trade mark has been registered under the TMA. This special protection, found in section 55 of the TMA, conforms to the international standards set out in Article 6bis of the Paris Convention and in the WIPO Joint Recommendations Concerning the Provisions on the Protection of Well-known Marks.

(2) Proprietor entitled to restrain unauthorised confusing use, if trade mark is well known to relevant sector of public in Singapore

12.5.31 A trade mark is deemed to be well known in Singapore if it is well known to a relevant sector of the public in Singapore. The proprietor of the well known trade mark is entitled to restrain by injunction use in the course of trade of an identical/similar trade mark or business identifier:

- in relation to identical or similar goods or services, where the use is likely to cause confusion; and
- in relation to any goods or services, where the use would indicate a connection between those goods or services and the proprietor, and is likely to damage the interests of the proprietor.

(3) Proprietor entitled to restrain unauthorised dilutive use, regardless of likelihood of confusion, if trade mark is well known to public at large in Singapore

12.5.32 Further, where the trade mark is well known to the public at large in Singapore, its proprietor is entitled to restrain by injunction any use in relation to any goods or services which would cause dilution in an unfair manner, or take unfair advantage, of the distinctive character of the trade mark. This is Singapore's model of the 'anti-dilution' right. Infringement of this right is not dependent on proof of likelihood of confusion.

(4) Limitations of protection

12.5.33 The protection under section 55 is limited to allow for certain uses such as:

- Honest use of one's own name.
- Honest descriptive use (eg. to indicate the kind or quality of the goods).
- Fair use in comparative commercial advertising or promotion.
- Use for non-commercial purpose
- Use for the purpose of news reporting or news commentary.

SECTION 6 TRADE MARKS: COMMON LAW ACTION FOR PASSING OFF

A. Tort of passing off provides second system of trade mark law in Singapore

12.6.1 At common law, it is an actionable wrong for a defendant to represent for trading purposes, that his goods are those of another, or his business is that of another (*Excelsior Pte Ltd v Excelsior Sport (S) Pte Ltd [1985-86] SLR(R) 81* at [10]; see *Louis Vuitton Malletier v City Chain Stores (S) Pte Ltd [2009] 2 SLR(R) 684*, and *Novelty Pte Ltd v Amanresorts Ltd and another [2009] 3 SLR(R) 216*.) This tort, called 'passing off', provides the second system of trade mark law in Singapore which is independent of, and can co-exist with, protection under the TMA [see [Section 12.5.1](#) above]. In some other jurisdictions, especially those with a civil law tradition, a similar type of protection is available within their law against unfair competition.

B. Elements of action for passing off

12.6.2 The three elements that must be proved to succeed in an action for passing off are: (a) goodwill; (b) misrepresentation; and (c) damage.

(1) Goodwill

(a) Goodwill must be attached to a business

12.6.3 The goodwill relevant in a passing off action is 'the goodwill between a trader and his customers' (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975* at [45]). In other words, goodwill must be attached to a business. This means that the plaintiff in a passing off action must show, not merely that he enjoys sufficient reputation in Singapore, but that he has a business within jurisdiction to which his goodwill is attached. This requirement can pose challenges for some foreign traders of well known trade marks. However, it should be noted that the courts' approach to this question is very business-oriented. For example, it has been held that pre-trading activities, such as pre-launch publicity, could generate goodwill because '[t]his is a commonsense approach and is in line with commercial reality where promoters of businesses usually embark on massive advertising campaigns before the commencement of trading to familiarise the public with the service or product' (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 1 SLR(R) 975* at [58]). Pre-trading activities which can generate goodwill are those which unequivocally evince the plaintiff's intention to enter the Singapore market, and which has generated an attractive force that will bring in custom when the business in Singapore eventually materialises (*Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc [2014] 1 SLR 911*).

(b) Foreign traders of unregistered well known trade marks can seek redress under the TMA

12.6.4 Foreign traders of unregistered well known trade marks who, in spite of this liberal approach, do not have any goodwill in Singapore, can seek the alternative redress provided under section 55 of the TMA. This section was specifically enacted for the benefit of traders from a Paris Convention/WTO country whose trade mark is well known in Singapore, and it is expressly provided

that the protection is available whether or not the trader 'carries on business, or has any goodwill, in Singapore'. For the scope of this protection under section 55, see [Sections 12.5.31 – 12.5.32](#) below.

(c) Plaintiff must show that trade mark has become specifically distinctive of business

12.6.5 To establish goodwill, the plaintiff must show that the trade mark or 'get-up' – such as the colour scheme used in the packaging of the goods (*White Hudson & Co v Asian Organisation Ltd* [1965] 1 MLJ 186) and the shape of the packaging (*Haw Par Brothers International Ltd v Chiarapurk Jack* [1991] 1 SLR(R) 425) – has become specifically distinctive of his business. Evidence that is usually tendered for this purpose includes sales volumes achieved under his trade mark, advertisements and other publicity materials using this trade mark in Singapore.

(d) Burden of proving goodwill heavy for trade mark which is descriptive of plaintiff's goods or services

12.6.6 It is possible for a trade mark which is descriptive of the plaintiff's goods or services, or get-up which consists of a functional shape, to be protected in a passing off action. But the burden of proving goodwill is a heavy one, and evidence of extensive and long usage of the trade mark or get-up is required to convince the court that the trade mark or get-up has indeed become distinctive of the plaintiff's goods or services. Further, a slight difference between the plaintiff's mark and the defendant's mark would suffice to distinguish them, thereby making it less likely for the court to find a misrepresentation (*The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] 2 SLR 495).

(2) Misrepresentation

(a) Classic form of passing off involves misrepresentation as to origin of goods or services

12.6.7 The classic form of passing off involves a misrepresentation as to the origin of the goods or services, where the defendant by adopting a trade mark or get up for this goods or services which is identical or similar to the plaintiff's, misleads or confuses the public into thinking that his goods or services are those of the plaintiff, or are associated with the plaintiff. It is not essential for the plaintiff to prove that the defendant had an intention to deceive, but where this is shown to exist, it becomes easier to establish that there is a likelihood of confusion (*The Singapore Professional Golfers' Association v Chen Eng Waye* [2013] 2 SLR 495).

(b) Parties in action for passing off need not be in mutual competition

12.6.8 The defendant's goods or services can be different from those provided by the plaintiff. In other words, the parties in an action for passing off need not be in mutual competition (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [63]). But where there is a common field of activity, the plaintiff's case on misrepresentation is strengthened.

(3) Damage

12.6.9 There must be damage, or a real likelihood of damage, to the plaintiff's goodwill. The classic example of damage to the plaintiff's goodwill takes the form of loss of sales suffered by the plaintiff. This loss of sales may be due to the public buying the defendant's goods/services thinking that they originate from the plaintiff ('blurring of goodwill') or due to the public not buying the plaintiff's goods/services because the defendant's goods/services are of low quality or have some unsavoury connotations ('tarnishment of goodwill'). Another type of damage that the action for passing off protects against is the restriction on the plaintiff's expansion into related fields of business activities (*Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216).

C. Remedies available

12.6.10 the range of remedies available to the successful plaintiff in an action for passing off includes an injunction, damages or account of profits.