

ATMD Bird & Bird once again clinched the Singapore Firm of the Year award at the recent Managing Intellectual Property Global Awards 2010. The firm has also been ranked in Tier 1 in the following categories by Managing IP: Patent Prosecution, Patent Contentious, Trade mark Prosecution, Trade Mark Contentious and Copyright.

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We would like to welcome the following new additions to our team:

US Patent Attorney Robert Scott and Associate Oh Pin-Ping.



Valentino Globe loses in Court of Appeal

Oh Pin Ping



In the recent decision of *Valentino Globe BV v Pacific Rim Industries Inc* [2010] SGCA 14, the Singapore Court of

Appeal affirmed the decision of the High Court in rejecting Valentino Globe BV's (the "Appellant") opposition to Pacific Rim Industries' (the "Respondent") application for the registration of its "Emilio Valentino & V Device" mark in Class 18.

Appeal was brought on the grounds of confusing similarity and bad faith. The Appellant failed on both grounds – the Court of Appeal held that there was no likelihood of confusion, and that the Appellant failed to make out their allegation of bad faith.

On the issue of bad faith, the Appellant had to show that the Respondent's

conduct in applying for registration fell short of the normally accepted standards of commercial behaviour, and that the Respondent knew of facts which, to an ordinary person, would have made the latter realise that what it was doing would be regarded as breaching those standards.

The Appellant failed in their contentions that the Respondent had copied from a similar mark registered in Italy and was not proprietor of the mark, and that it had hijacked the Appellant's mark.

Firstly, the Appellant failed to make out a *prima facie* case of copying given that there was no evidence that the Italian mark had been in use prior to the Appellant's use of its mark.

Second, registration of a trade mark falls within the standards of acceptable commercial behaviour observed by reasonable and experienced persons so long as the registrant has proprietorship of, or the right to register, the trade

mark. Conversely, where it can be shown that the applicant knew of an exclusive proprietary right of another in relation to the mark, then any registration would fall short of the relevant standards. Although registration of an identical mark had first been sought by the Respondent's former distributor, it did not follow that the Respondent had acted in bad faith in seeking registration. Moreover, it was clear from the business arrangements between the parties that the Respondent had at least the right to register its mark.

Finally, the Court considered the "hijacking" claim unmeritorious given that the Appellant had no proprietary claim to a common name such as "Valentino".

This case provides both counsel and litigants with more clarity as to the test and standards the courts would apply in determining a claim of bad faith.



Nike trade mark registration allowed

Ankur Gupta



Under section 8(1) of the Singapore Trade Marks Act ("TMA"), one of the grounds on which a trade mark shall be refused

registration is when such a trade mark is identical with or similar to an earlier trade mark and is sought to be registered for similar goods/services for which the earlier trade mark is protected.

In the recent decision of *Campomar SL v Nike International Ltd* [2010] SGHC 140, the opponent (Campomar) raised section 8(1) as a ground to oppose the applicant's (Nike) trade mark registration in Class 3 (the "**Application Mark**").

The issue before the Singapore High Court ("SGHC") was whether the opponent's 1986 trade mark in Class 3 (the "**1986 mark**"), which the Applicant had successfully revoked in 2002, was deemed an earlier trade mark for the purposes of application of section 8(1) of the TMA. The opposition to the Applicant's trade mark in Class 3 (the "**Application Mark**") was filed in August 2006.

In coming to its decision, the SGHC noted that the definition of "earlier trade mark" under Section 2(a) of the TMA did not indicate whether the "earlier trade mark" must be a registered mark at the time of opposition proceedings.

The SGHC held that the relevant time period to consider whether an "earlier trade mark" was a registered mark was at the time when opposition proceedings were being heard as this was the time to consider whether the public may likely be confused. The SGHC adopted the approach of the Singapore Court of Appeal in a case involving the same issue.

Following a Singapore Court of Appeal decision, *Tiffany & Co. v Fabrigres de Tabac Reunies SA* [1992] 2 SLR (R) 541, where it was held that the appropriate point in time to consider whether the public may likely be confused between the Application Mark and the "earlier trade mark" was at the time opposition proceedings were heard, the SGHC held that in the instant case, the relevant time period was 2006, the year when opposition proceedings were instituted. As the 1986 mark stood revoked in 2006, the SGHC held that it was not an "earlier trade mark".

Developing an effective patent portfolio strategy

Lim Hui Yi



Patents have a significant influence on a company's success. But simply filing patents is not enough. A comprehensive, well

developed patent strategy is critical for success.

A well developed and solidly constructed patent portfolio may be used for a variety of business objectives and can deliver a competitive advantage. From drafting of the patent application to paying annual renewal fees, patents require significant resources. In turbulent economic times, developing and building a comprehensive patent portfolio can be prohibitively expensive. What are the considerations that a company should take into account when developing a patent portfolio strategy, especially one limited by financial resources?

The company must first identify its key business goals. This is to provide a long-term plan for the development of a valuable patent portfolio. Companies need to devise a patent portfolio strategy that is aligned with the company's business objectives.

An adequate budget should next be drawn up to plan for the expense of filing patent applications and maintaining them after grant. It is also necessary to determine if obtaining

protection in jurisdictions outside of Singapore is prudent. This is to be financially prepared for the hefty costs associated with overseas filings and to prevent wasteful expenditure in future.

Devising a patent portfolio development strategy early on can be a wise investment to help the company develop and build a strong foundational asset on which to grow. This investment will likely reward the company with positive returns for years to come. The focus should be on building a high-quality patent portfolio and not file everything.

It is of utmost importance that before a patent application is filed, there should be no public disclosure of the invention.

Immediate business opportunities and time demands often conflict with the timely preparation and filing of a patent application. Therefore a company will have to decide on when the invention should go into the public domain or when further development is needed.

Companies should first consult with the patent attorney to understand the various risks associated in the process of taking an invention to a marketable technology or product. A patent attorney will be able to draft a patent application that is able to give the best protection to the invention, which is the foundation of building an effective patent portfolio.

Coherent strategy will effectively link the

patent strategy with the strategic needs of the key products of the business that are sold in the domestic or export markets. This will prevent patent costs from spiraling out of control. Every cost must be seen in the context of the likely return on investment, and the risks involved in the process of taking an invention to a marketable technology or product.

In summary, a clear and focused strategy that has a good fit with the overall strategic objectives of a business is crucially needed before a company begins to devise and implement practical measures to own patents.

The content of this update is of general interest and is not intended to apply to specific circumstances. The content should not, therefore, be regarded as constituting legal advice and should not be relied on as such. In relation to any particular problem which they may have, readers are advised to seek specific advice. Further, the law may have changed since first publication and the reader is cautioned accordingly.

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