

## Intellectual Property & Technology Review

Dear Clients & Friends

### Feature Article on Trade Marks

#### Singapore Court of Appeal confirms that “Rooster” is not a common name in cordyceps trade

*Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd & Anor and Another Appeal* [2009] SGCA 9

The decision of the Singapore Court of Appeal in *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd & Anor and Another Appeal* is instructive in that the court has clarified and reinstated several important fundamental concepts relevant to the law of trade marks in Singapore.

In this case, both the plaintiff and the defendants had appealed to the Court of Appeal against the decision of the Judge in the High Court below (the “**Judge**”) in relation to the first defendant’s “Rooster” mark. The plaintiff appealed against:

- the Judge’s refusal to revoke the registration of the “Rooster” mark;
- the Judge’s refusal to invalidate the registration of the “Rooster” mark; and
- the Judge’s ruling that sections 22(1) and 23(1) of the Trade Marks Act (the “**Act**”) gave the court and the Registrar of Trade Marks a discretion not to revoke or invalidate the registration of a trade mark even though the grounds for revocation or the grounds for invalidation specified in the respective provisions have been established.

In upholding the High Court’s decision that the “Rooster” mark should not be revoked under sections 22(1)(a), (b) and (c) of the Act, the Court of Appeal agreed with the Judge that the “Rooster” mark had not become customary within the meaning of section 7(1)(d) of the Act. However, the Court of Appeal was of the opinion that the “Rooster” mark was clearly capable of distinguishing the cordyceps of the first defendant’s predecessor from that of other suppliers and overruled the High Court’s finding that the “Rooster” mark did not satisfy the definition of a trade mark. The Court of Appeal also expressed the view that the Judge had erred in holding that the court had the discretion to retain the mark even when the grounds for revocation or invalidation are established. Please [click here](#) to read on.

### Patents News

#### IPOS invites feedback on proposed changes to Singapore’s patent system

On 3 July 2009, the Intellectual Property Office of Singapore (the “**IPOS**”) issued a consultation paper on proposed changes to the Singapore patent system. The IPOS reviews the patent system regularly to update the patents legislation in line with Singapore’s economic development and trends in patent protection. The principal statute governing patents in Singapore is the Patents Act. The consultation is open for submission of comments until 4 September 2009. Please [click here](#) to read on.

## **Patent Prosecution Highway Pilot Programme between IPOS and Japan Patent Office**

In June 2009, it was announced that the Intellectual Property Office of Singapore (the “**IPOS**”) and the Japan Patent Office (the “**JPO**”) will be launching a cooperative initiative called the Patent Prosecution Highway (“**PPH**”). The PPH will have a pilot period of one year, commencing on 1 July 2009 and ending on 1 July 2010.

This initiative is intended to facilitate faster prosecution of patent applications as references to earlier work done could reduce or even eliminate the need for subsequent search and examination work. The initiative is also expected to result in better search and examination as one patent office may check with and rely on the other office for previously unavailable databases.

The initiative allows the IPOS and the JPO to share their search and examination results with each other. Applicants seeking patent protection for an invention in both countries may choose to go through this route. For instance, where the IPOS is the Office of First Filing and the Singapore application contains claims that are determined to be allowable/patentable, the applicant may request accelerated examination at the JPO for the corresponding application filed with the JPO as the Office of Second Filing.

The initiative will have a pilot period, followed by full implementation. The IPOS and JPO will assess the results of the pilot programme to decide whether and how the initiative may be fully implemented after the pilot period. The pilot period may be extended for up to another year. The patent offices may decide to terminate the initiative earlier depending on, among other things, the volume of participation and corresponding manageable level, in which case a notice will be published. A notice will be published by both offices if there is any adjustment to the pilot programme.

The following information is posted on the IPOS website [www.ipos.gov.sg](http://www.ipos.gov.sg):

- [Notice on filing PPH requests to the IPOS](#)
- [Notice on filing PPH requests to the JPO](#)

Please [click here](#) for more information about the initiative, which is posted on the IPOS website.

## **ASEAN States launch ASEAN Patent Examination Co-operation (ASPEC) Programme with effect from 15 June 2009**

The first regional patent co-operation project known as the ASEAN Patent Examination (ASPEC) Programme (the “**Programme**”) was launched on 15 June 2009. The programme will be subject to regular reviews. The eight participating intellectual property offices are from the ASEAN member states of Singapore, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Thailand and Vietnam (the “**participating IP offices**”).

Under the programme, a participating IP office may, in its own search and examination work, make reference to another participating IP office’s search and examination results. However, there is no obligation to adopt any of the findings or conclusions reached by another IP office. A participating IP office is expected to conclude its own search and examination work and decide on the grant of a patent based on its own national laws.

As the programme facilitates the sharing of search and examination results between the participating IP offices, there will be expected savings of time and effort through the reduced duplication of search and examination work done.

The following information is posted on the Intellectual Property Office of Singapore (the “**IPOS**”) website [www.ipos.gov.sg](http://www.ipos.gov.sg):

- [Notice and procedures](#)
- [ASPEC Request Form](#)

Please [click here](#) for more information about the initiative, which is also available on the IPOS website.

## General Developments

### MinLaw announces establishment of Singapore office of WIPO Arbitration and Mediation Center in January 2010

On 28 July 2009, the Ministry of Law (the “**MinLaw**”) announced that the Singapore office of the World Intellectual Property Organization (the “**WIPO**”) Arbitration and Mediation Center (the “**WIPO Center**”) will be officially opened in January 2010. It will be located at Maxwell Chambers ([www.maxwell-chambers.com](http://www.maxwell-chambers.com)) which is Singapore’s international dispute resolution centre.

As the only WIPO Center in the region, the Singapore office will focus on promoting alternative dispute resolution (“**ADR**”) services in the Asia Pacific region, providing training and advice on procedures such as arbitration, mediation and expert determination. It will administer and facilitate hearings in cases conducted under the WIPO Rules in Singapore. The Singapore office of the WIPO Center will offer companies and other parties in the region a cost-effective dispute resolution option.

The MinLaw has also announced that the WIPO and Singapore are cooperating to establish an international WIPO Mediation and Arbitration Scheme for Film Related Disputes (the “**WIPO Film ADR Scheme**”). The WIPO Center will work with Singapore’s Media Development Authority to develop the WIPO Film ADR Scheme. The WIPO Film ADR Scheme is expected to be launched in Singapore in late 2009.

For further information, please click on the relevant titles for the required information:

- [Press release issued by the MinLaw](#)
- [Fact sheet on the WIPO Center](#)

These resources are available from the MinLaw website [www.minlaw.gov.sg](http://www.minlaw.gov.sg).

### Further information

Should you have any queries as to how these developments may affect your business, please do not hesitate to get in touch with your usual contact at Allen & Gledhill LLP or any of the following:

Dr Stanley Lai  
Tel: +65 6890 7883  
E-mail: [stanley.lai@allenandgledhill.com](mailto:stanley.lai@allenandgledhill.com)

Low Pei Lin  
Tel: +65 6890 7516  
E-mail: [low.peilin@allenandgledhill.com](mailto:low.peilin@allenandgledhill.com)

Moi Sok Ling  
Tel: +65 6890 7538  
E-mail: [moi.sokling@allenandgledhill.com](mailto:moi.sokling@allenandgledhill.com)

Isaac Tung  
Tel: +65 6890 7522  
E-mail: [isaac.tung@allenandgledhill.com](mailto:isaac.tung@allenandgledhill.com)

Yours faithfully  
**Allen & Gledhill LLP**  
Singapore

Allen & Gledhill LLP  
T +65 6890 7188 | F +65 6327 3800 | [publications@allenandgledhill.com](mailto:publications@allenandgledhill.com)  
One Marina Boulevard #28-00 Singapore 018989 | [www.allenandgledhill.com](http://www.allenandgledhill.com)

This message is intended to highlight issues and not to be comprehensive, nor to provide legal advice.

If you do not wish to receive this newsletter or other intellectual property & technology related electronic communications from Allen & Gledhill LLP, please let us know by e-mailing us at [publications@allenandgledhill.com](mailto:publications@allenandgledhill.com). You will receive one additional e-mail message confirming your removal. If you would like to add any of your colleagues onto our mailing list, please let us know via return e-mail.

Allen & Gledhill LLP (UEN/Registration No. T07LL0925F) is registered in Singapore under the Limited Liability Partnerships Act (Chapter 163A) with limited liability. A list of the Partners and their professional qualifications may be inspected at the address specified above.

**CONFIDENTIALITY CAUTION:** This message is intended only for the use of the individual or entity to whom it is addressed and is privileged and confidential. If you are not the intended recipient, please notify us immediately by return e-mail, delete this message and you should not disseminate, distribute or copy any information contained herein.