

Question Q214

National Group: Singapore

Title: Protection against the dilution of a trade mark

Contributors: Teresa O'Connor and Jonathan Foong

Representative within Working Committee: Jonathan Foong

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

1. *Do the laws of your country provide for protection against dilution of a trademark? If so, which laws?*

Yes.

Singapore Trade Marks Act (Cap. 332 2005 Revised Edition).

The 'anti-dilution' right is modelled after the WIPO Joint Recommendations Concerning the Provisions on the Protection of Well-known marks.

2. *Is there a legal definition of dilution in your legislation or case law?*

Yes. Section 2(1) defines dilution to mean "the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is – (a) any competition between the proprietor of the trade mark and any other party; or (b) any likelihood of confusion on the part of the public. (inserted by Act 20/2004 w.e.f. 1st July 2004)

In the case of *Novelty Pte Ltd v Amanresorts Ltd* [2009] SGCA 13, March 13 2009 the Singapore Court of Appeal accepted that the definition of dilution in Singapore includes both dilution by blurring and dilution by tarnishment.

- 3.1. *Which trademarks are afforded protection against dilution? What are the eligibility criteria? (Please only briefly list the eligibility criteria here; more detailed explanations will be required below).*

Singapore national trade marks and trade marks protected under Article 6bis Paris Convention. The latter would be covered under section 55(3) of the Trade Marks Act.

The trade mark must be proved on a balance of probabilities to be a well known trade mark. Registration in Singapore is not necessary. It is also not necessary that the well known mark be used in Singapore.

- 3.2. *To be eligible for protection against dilution, does a mark need to be distinctive? If so, does the protection depend upon the mark being inherently distinctive or are marks that have acquired distinctiveness through use also protected?*

There is no express requirement that the mark must be distinctive.

- 3.3.1 *To be eligible for protection against dilution, does a mark need to have a reputation or be well-known or famous? If so, when does a mark have a reputation, when is it well-known or when is it famous? Are the factors mentioned in paragraph 15 and 22 above relevant for determining whether a mark has a reputation, is well known or famous? For what point in time does this have to be assessed?*

Yes, trade marks will be protected against dilution only if they can be shown to be well known in Singapore. The factors listed in paragraph 15 of the preamble are listed in Section 2(7) of the Trade Marks Act as a guide to the Singapore Court and Registry as being relevant for taking into account when deciding whether a certain trade mark is well known. The trade mark must have been famous at the time when the third party application or action takes place.

- 3.3.2 *For a mark to have a reputation or to be considered well known or famous, must it meet a certain knowledge or recognition threshold? If so, what is that threshold? What percentage of population awareness is required? How widespread must the awareness be across the country? If a mark is well known or famous in one country, what effect, if any, does this have with regard to other countries?*

The trade mark must be shown to be well known to the public at large, for which there is no legislation providing for any percentage or threshold.

- 3.3.3 *What is the relevant population in determining the knowledge, recognition or fame of the mark, the general public at large or the relevant sector of public? Is recognition or fame in a limited product market ("niche market") sufficient?*

It must be the general public at large. Recognition in a limited product market is insufficient.

3.4. *To be eligible for protection against dilution, is it required that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country where protection is being sought?*

No.

3.5. *Are there any other criteria a mark must comply with to be eligible for protection against dilution?*

No.

3.6. *Is eligibility for protection against dilution a matter of law or an issue of fact? Who bears the burden of proof regarding the eligibility criteria? How does one prove that a mark meets the eligibility criteria? Are sales and advertising figures sufficient or is survey evidence required? Which evidential standard must this proof satisfy?*

It is a matter of law and fact. The evidential burden must be borne by the party who seeks to show that his trade mark is well known. One would normally seek to do this through filing of evidence through Statutory Declaration or Affidavit. In certain circumstances a survey evidence would be advisable. The standard of proof is on a balance of probabilities.

3.7. *Is there any registry of eligible marks in your country? If so, what is the evidentiary value of registration? Can it be challenged in litigation?*

No, there is no registry.

4. *Does your law require the existence of a 'mental association' or 'link' between the earlier trademark and the later trademark? If so, in which circumstances does a 'mental association' or 'link' between the earlier trademark and the later trademark exist? Are the factors mentioned in paragraph 27 and 28 above relevant for assessing the existence of such a 'mental association' or 'link'? Are there other factors to take into account? Is the assessment of a link a question of fact (so something that can be established by market surveys), or is it a question of law to be established by the courts or authorities on the basis of such factors?*

No, a mental association or link is not required.

5. *Does such 'mental association' or 'link' between the earlier trademark and the later trademark automatically result in detriment to the earlier trademark's repute or distinctive character? Or does detriment have to be proved over and above the existence of a 'mental association' or 'link'?*

Not applicable.

6. *Are the same factors taken into consideration to assess the existence of detriment as those already discussed for the link? Are there additional ones?*

In order to determine the existence of detriment, the factors to be considered are the degrees of similarity between the trade marks and the goods/services, the strength of the earlier mark's reputation and distinctiveness and the likelihood of confusion.

7. *Must actual dilution be proved or is a showing of likelihood of dilution sufficient? Whose burden of proof is it? How does one prove dilution or likelihood of dilution? Does detriment require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely? If so, what is a change in the economic behaviour of the average consumer? Is reduced willingness to buy goods sold under the earlier mark a change in the economic behaviour? How do you prove a change in the economic behaviour of the average consumer or likelihood of such change in behaviour?*

Actual dilution is not required to be shown. The burden of proof lies on the owner of the earlier mark.

8. *What is the extent of protection afforded to marks which are eligible for dilution protection? May the owner of the earlier trademark object*
- *to the registration of a later trademark?*
 - *to the actual use of a later trademark?*
 - *in respect of dissimilar goods only or also in respect of similar goods?*

The owner of an earlier trade mark which is well known to the public at large may object by way of opposition to a later trade mark, as well as to obtain an injunction through the High Court restraining a third party from using an identical or similar mark. The goods/services may be either similar or dissimilar.

9. *What are the legal remedies? May the owner of the earlier trademark file an opposition and/or a cancellation action? May he ask for injunctive relief or preliminary injunctive relief? Does your trademark office refuse the registration of a later trademark on grounds of likelihood of dilution?*

An opposition and invalidation action is available. Injunctive relief is also available.

II. Proposals for adoption of uniform rules

The Groups are invited to put forward proposals for adoption of uniform rules with a view to protecting trademarks against dilution. More specifically, the Groups are invited to answer the following questions:

1. *Which trademarks should be eligible for protection against dilution? What should the eligibility criteria be? Should recognition or fame in a limited product market ("niche market") be sufficient?*

All well known marks should be eligible for protection against dilution, not just those which can be shown to be well known to the public at large.

2. *Should it be a criteria for being eligible for dilution protection that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country?*

No.

3. *Should there be a registry of eligible marks? If so, what should the evidentiary value of registration be? Should it be possible to challenge it in litigation?*

No.

4. *Should the existence of a 'mental association' or 'link' between the earlier trademark and the later trademark be an independent requirement for a trademark dilution claim?*

In practical terms, the existence of a mental association or a link must be shown.

5. *Should detriment to the distinctive character or reputation of the earlier mark require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely?*

No. It is very difficult to obtain such evidence. The Courts should be prepared to draw its own conclusions from the evidence that is tendered.

6. *What should the remedies be for dilution of a mark?*

There are currently adequate remedies contained in the Trade Marks Act.

National Groups are invited to comment on any additional issue concerning the protection of a mark against dilution.

No comments.

Summary

The Singapore Trade Marks Act provides protection against dilution for both Singapore national trade marks and trade marks protected under Article 6bis of the Paris Convention. The ground of dilution may be raised by proprietors of both kinds of trade marks in opposition and invalidation proceedings. The proprietor of a well known trade mark would also have protection against dilution in infringement cases and be entitled to injunctive relief. A national registry of well known trade marks would not be appropriate, as there would be practical difficulties in determining which marks would qualify for registration, and whether they continue to be sufficiently well known over time to remain on the registry after registration.

Registration would also be onerous to proprietors of such marks who would have to ensure that their marks are registered in order to be entitled to protection.