OTHER DEVELOPMENTS IN TRADE MARK LAW IN SINGAPORE

Practice changes:

- From 2nd July 2007, an applicant may file for several classes of goods/services in a single application under a single application number. Prior to this, each class was given its own application number.
- a multi-class application may now be divided into two or more applications (with payment of official fees) and preserve the original filing date. The benefits are that applications in classes which do not face objections/opposition may proceed on their own. Also goods which do not fall within the class may be separated.
- possible to restore an abandoned application within 6 months.
- Licences for pending applications may now be recorded.

Interesting Cases:

- *Future Enterprises Pte Ltd v McDonald's Corp (*2007) SGCA 18

  The Court of Appeal upheld the lower Court and the Registrar of Trade Marks' decision that MacCoffee (Future Enterprise) is confusingly similar with MacCAFE owned by McDonald's when used for coffee and coffee substitutes and should be refused registration. A ground raised by Future Enterprise is that it had made prior use of its MacCoffee trade mark which preceded McCAFE registration and enjoyed unregistered rights to proprietorship of "MacCoffee". In upholding the Trade Mark Registrar's decision to allow McDonald's opposition the Court of Appeal held that Future Enterprise should have opposed MacDonald's application for McCAFE when it was advertised for opposition. Future had missed the opportunity to do so.

- *Amanresorts Limited and Anor vs Novelty Pte Ltd* [2007] SGAC 201

  This is the first Singapore High Court decision which dealt with the question whether a mark is well-known. The Defendant, a local real estate developer, named its new condominium project in Singapore "Amanusa". The Plaintiffs, operators of the Amanusa group of luxury hotels and resorts own the trade marks "AMAN" and "AMANUSA", which are registered in various countries, but not in Singapore. The Plaintiff sought a declaration that AMANUSA is a well-known trademark in Singapore and that the Defendant be disallowed from using AMANUSA for its condominium under the Trade Marks Act and passing off laws. The High Court held that AMANUSA is a well-known trade mark in Singapore and it is immaterial that there is no AMANUSA resort in Singapore. The mark had goodwill in Singapore by its substantial worldwide sales, promotions and marketing, its fame amongst travel agents, airlines and credit card companies in Singapore. Also, the Plaintiffs hosted in Singapore more than 20 domain names. The Defendants were therefore restrained from using the name AMANUSA.

  This decision is currently under appeal.

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