

THE ACQUISITION AND CONSEQUENCES OF CUMULATIVE PROTECTION UNDER THE COPYRIGHT AND TRADE MARK LAWS OF SINGAPORE

Intellectual property rights in Singapore are governed by separate statutes as well as the common law. While there are instances where cumulative protection under more than one intellectual property regime is either expressly acknowledged or restricted, there are other situations which are not so dealt with. This article examines one such situation, *viz*, how it may be possible to acquire both copyright as well as trade marks protection, and the consequences of such cumulative protection.

INTRODUCTION

INTELLECTUAL property legislation is the means by which limited statutory monopolies are granted in respect of products and creations.¹ These “products and creations” may range from industrial products and consumer products (including those meant for leisure and recreation such as entertainment or artistic products), to the various forms of technology which result in the making of these products. In short, a wide range of material linked by the fact that they are the results of intellectual effort and investment is covered by the term “intellectual property”, and legislation in this area may be said to protect the fruits of such labour and investment.

The various pieces of intellectual property legislation are based on the assumption that those who have expended time, effort and money on their intellectual endeavours should receive some measurable reward for their work.² In the main, the concern must be to prevent others from freely and

¹ Copyright is not necessarily a true monopoly but may be more accurately considered a quasi-monopoly, in the sense that a copyright owner's exclusive rights are infringed only when there is copying. The independent creation of two similar works would not constitute infringement of either copyright: see EP Skone James, JF Mummery, J Rayner James and KM Garnett (editors), *Copinger and Skone James on Copyright* (13th ed, 1991), at 1.

² For a description and critical evaluation of the main rationale for awarding intellectual property rights, see D Vaver, “Some Agnostic Observations on Intellectual Property”, (1991) 6 IPJ 125. The recognition and existence of moral rights of authors in copyright law seems to point to moral, as well as economic, basis for protection, although the effectiveness of moral rights protection is questioned by Vaver at 132-133. However, the fact that copyright protection is extended to unpublished works (see, *eg*, s 27(1), Copyright Act, Cap 63, 1988

effortlessly benefitting from the creator's hard work, or, in other words, to prevent these others "reaping where they have not sown".³ This concern is particularly acute where, as is commonly the case, the "intellectual property" in question is commercially valuable. The existence of any intellectual property legislation thus attempts to protect the initial investment of time, effort and money by allowing the investor to enjoy its fruits, most commonly, by granting him the exclusive rights to exploit his creations. Indeed, protection of intellectual property is not limited to legislation; in areas where legislation is absent, the common law has not abstained from conferring protection where it felt it justified.⁴

By thus allowing intellectual property owners the exclusive right to commercially exploit their products and creations, it becomes necessary to consider whether or not the absence of any control mechanism in the intellectual property laws might in effect confer commercial monopolies, thus stifling competition and innovation.⁵ However, this does not appear to be the case as several control mechanisms do exist within the laws in attempts to prevent such a result. First, there may be a "trade-off" built into the grant of protection. For example, inventions which have to be new at the time of application in order to qualify for patent protection are not

Rev Ed) and that these works, if unpublished, may even enjoy perpetual copyright (see, *eg*, s 28(3)) may point to recognition that protection is not based entirely on economic interests.

³ This reason for giving intellectual property protection is based "partly on morality and partly on the concept of reward": see DI Bainbridge, *Intellectual Property* (2nd ed, 1994), at 17-18.

⁴ In Singapore, the three main common law actions which apply to intellectual property rights would be the law of confidence, passing off and injurious falsehood. For a general overview of these and the legislative actions, see Ng Siew Kuan, "Intellectual Property Law in Singapore: A General Overview", (1992) 4 SAclJ 32. Note, however, that in 1994, a new Patents Act, (No 21 of 1994) based substantially on the Patents Act 1977 of the United Kingdom, was enacted in Singapore. For a discussion of the main provisions of the new Patents Act, see Ng Siew Kuan, "An Overview of Patent Protection in Singapore", a paper delivered at the Workshop on "Recent Developments in Intellectual Property Law" of the Singapore Conferences on International Business Law (Conference VII), on 30 August 1994. Note also that Singapore does not have a general law or statute governing unfair competition, although it is possible to see the concept of unfair competition as being a general policy factor behind some intellectual property rights, in particular, the law of passing off: see, *eg*, the House of Lords decision in *Erven Warnink v Townend* [1980] RPC 31. However, Cornish opines that, despite such modifications to the traditional reluctance of the United Kingdom courts towards developing an unfair competition or misappropriation doctrine, "it remains unlikely that common law doctrine [in this area] will develop rapidly": see WR Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (2nd ed, 1989), at 6-10.

⁵ As already noted, even "fair" competition may entail some degree of imitation or copying. It is submitted that it would be unwise for intellectual property laws to be developed solely on the basis that all copying must needs be unlawful.

longer considered secret (and protectable under the law of confidence) once they are published as part of the patent specifications, a necessary step before the patent grant.⁶ In the area of trade marks, the proprietor's exclusive rights to the mark are limited to the goods and services in respect of which the mark is registered.⁷

Secondly, all statutory monopolies are limited, in both extent and time. Generally, the exclusive rights are infringed only by acts specified in the statutes, which may themselves also provide for specific defences, partial or otherwise.⁸ Further, most exclusive rights do not run perpetually with no further effort on the part of the owners: they are either specifically limited to a particular period,⁹ or have to be renewed at specific times and upon payment.¹⁰ It may be noted at this point that, in general, those intellectual property regimes regarded as "weaker" (or "quasi") monopolies tend to have longer protection periods (*eg*, copyright), while those carrying "stronger" monopolies would be protected for a far shorter time (*eg*, patents).¹¹

Thirdly, even during the monopoly period, it is possible for the original conferment, or its continuance, to be challenged. This is commonly done by defendants to infringement actions,¹² or, as provided for in some statutes, by persons who are aggrieved¹³ or whose interests may be otherwise prejudiced¹⁴ by the conferment of intellectual property rights.

Finally, while not strictly a control mechanism, the promise of legal protection and financial reward can serve as a powerful motivator for innovation, both for the current owners, and future aspirants.¹⁵

⁶ See s 27, Patents Act. Such publication would amount to putting the information contained in the specifications into the public domain: as an illustration, see *Mustad v Dosen* (1964) 1 WLR 1293. However, although a patent takes effect on the date on which notice of its grant is published (s 36(1)), it is possible to claim damages for acts of infringement which occur between the date of publication of the patent specifications and the date of grant (s 76(1)).

⁷ See s 45(1), Trade Marks Act (Cap 332, 1992 Rev Ed).

⁸ See, *eg*, ss 26, 31, 32 and 33 in the Copyright Act, on copyright infringement and the various specific defences throughout the Act, including ss 35 to 43. For trademarks, see generally s 45, Trade Marks Act.

⁹ For copyright, see s 28, Copyright Act. *Quaere* the possible perpetual duration of unpublished works. For patents, see s 36, Patents Act.

¹⁰ See, *eg*, ss 32 and 34, Trade Marks Act.

¹¹ *Supra*, note 9.

¹² The Patents Act contains a specific reference to this possibility in s 82(1)(a).

¹³ *Eg*, s 39(1)(a) of the Trade Marks Act permits the court to, *inter alia*, expunge a registered trademark upon application by a "person aggrieved": see the case of *Re AUVI Trademark; Auvi Pte Ltd v Seah Siew Tee & Anor* [1992] 1 SLR 639, discussed *infra*, at notes 167-190 and the accompanying main text.

¹⁴ See, *eg*, s 4 of the United Kingdom Designs (Protection) Act (Cap 339, 1985 Rev Ed).

¹⁵ As to which see Vaver, *supra*, note 2.

Thus the aim of intellectual property legislation can generally be said to be to achieve a balance between conferring economic benefits and rewards on the monopoly owners who have expended effort and money on the process of creation, and achieving freedom of competition. In spite of the different intellectual property rights being contained in separate and unrelated statutes in Singapore, the examples cited above would show this to be the underlying theme behind all of them. The lack of a single governing statute or uniform law covering the entire intellectual property rights system is therefore not a problem in this regard.¹⁶

However, the existence of individual pieces of legislation each dealing with different intellectual property rights may lead to another related problem. This is one of cumulative protection, *ie*, where the creator or proprietor may acquire separate protection under more than one intellectual property regime. Obvious examples of such a situation include the possibility of a trade mark proprietor taking up a passing off action as well as one for trade mark infringement, and industrial design rights owners also obtaining artistic copyright protection for their design drawings. With regard to the former, this possibility is expressly recognised and permitted under the Trade Marks Act.¹⁷ For the latter situation, the Copyright Act contains several provisions which either limit the duration of copyright protection for industrial designs or which prevent the assertion of copyright in cases where the design is either registered or capable of being registered.¹⁸

This article seeks to examine another specific situation of cumulative protection, *viz*, the possibility of a rights owner obtaining both copyright as well as trade mark protection under the respective statutes. The article is divided into two main Parts. Part I deals with how such cumulative protection may be acquired under the two regimes, while Part II will outline the consequences of cumulative protection.

¹⁶ Unlike the United States, which has developed possibly the oldest competition and antitrust laws, or even the United Kingdom, which not only has individual statutes which in some way regulate competition, but is also obliged to apply the provisions of the Treaty of Rome (such as Articles 30 to 36 and 85 to 90) in order to ensure free movement of goods and competition within the Common Market, the relationship between intellectual property rights and competition laws has been little discussed in Singapore and there is little if any indication of any movement to adopt a doctrine of unfair competition or misappropriation. For a detailed discussion of the meaning of these terms as well as an overview of the competition laws of the United States and selected European countries, see P Kaufmann, "Passing Off and Misappropriation: An Economic and Legal Analysis of the Law of Unfair Competition in the United States and Continental Europe", IIC Studies in Industrial Property and Copyright Law (1986) Volume 9.

¹⁷ See s 53, Trade Marks Act.

¹⁸ See ss 73 and 74, Copyright Act.

PART I: THE ACQUISITION OF CUMULATIVE PROTECTION UNDER THE COPYRIGHT AND TRADE MARK LAWS OF SINGAPORE

I. FUNCTIONS OF COPYRIGHT AND TRADE MARKS LEGISLATION

It may be pertinent to set out here the main differences between copyright and trademark protection in Singapore. First, unlike trademarks, acquisition of copyright is not dependent on registration. Under the Copyright Act, once the material in question falls within the range of protected materials and the necessary connecting factor between the material and Singapore exists, the material will be protected as copyright, and will thus attract the range of exclusive rights as specified in the Act.¹⁹ No procedure or payment is necessary to acquire this.

However, it is impossible to acquire trademark protection in Singapore under the Trade Marks Act without registration. Further, registration is not a purely formal process. The applicant has to show that his mark fulfils the substantive legislative requirements as laid down in the Trade Marks Act, *eg*, that it is a distinctive trade mark. Once registered, he is then considered the proprietor of the trademark (as registered) and will be entitled to the exclusive right to use the trademark in respect of the goods or services for which it is registered.²⁰

Secondly, the duration of protection works rather differently under the two regimes. For copyright, the general protection period lasts from the date of acquisition to fifty years after the death of the maker of the copyright work.²¹ For trademarks, registration is renewable every ten years upon payment of the requisite fees, hence the maximum period is not fixed.²² In practical terms, this would be for as long as the trader wishes to trade in goods or services under that mark. Of course, during the period for which protection has been acquired, the trademark is still open to challenge by aggrieved parties, possibly on the basis that it ought not to have been conferred originally, or that events subsequent to its conferment warrant

¹⁹ See text under Part II Section (1), *infra*, at note 193 and accompanying main text.

²⁰ See text under Part II Section (2), *infra*, notes 202-203 and the accompanying main text. Note that under the common law of passing off, the assertion of goodwill in a name, logo or product setup may amount to proprietorship over an unregistered (or even unregistrable) trade mark. In other cases, the copyright in the trade mark would be relevant to the issue of proprietorship: see discussion *infra*.

²¹ *Supra*, note 9.

²² See ss 32 and 34, Trade Marks Act.

its removal from the register.²³ Non-use would be yet another ground for removal.²⁴

At a more fundamental level, copyright protection can be seen as differing somewhat in its aims from trade mark protection. While both do protect commercial investment and the rights owner's initial effort, *eg*, through rewards from publishing a copyright work when it is finished, or by trading under a specially-chosen name, it is clear that each regime does take into account other needs as well. For example, the recognition and existence of moral rights for copyright owners would indicate a willingness to protect certain aspects of an author's personality which may not always translate easily into pure commercial interests.²⁵ Indeed, as already noted,²⁶ the existence of copyright for unpublished works necessarily implies a right of self-censorship which is more easily justifiable on moral, rather than economic, grounds.

Copyright also recognises another type of commercial interest. The awarding of the so-called "entrepreneurial" rights²⁷ such as sound recordings and films to their "makers"²⁸ under the Copyright Act (as opposed to the "classical" copyright works of authors – literary, dramatic, musical or artistic works, which, as the description suggests, generally awards copyright to the authors)²⁹ indicates an overt legislative decision to separate the artist or "creative originators" (*eg*, the singer, songwriter or actor, director) from

²³ As to the powers and jurisdiction of the court to order removal and different substantive grounds for so ordering, see the cases of "*GE*" *Trade Mark* [1973] RPC 297 and "*Bali*" *Trade Mark* [1969] 2 All ER 812.

²⁴ See s 40, Trade Marks Act and its application in *Re "Aloha Swanfu" Trade Mark* [1993] 1 SLR 293 and [1994] 1 SLR 625, and *Re Jaguar Trade Mark* [1993] 2 SLR 466. See also *Imperial Group v Philip Morris* [1982] FSR 72.

²⁵ For a brief description of moral rights and their extent in the United Kingdom, see Cornish, *supra*, note 4. For the full text of Article 6*bis* of the Berne Convention for the Protection of Literary and Artistic Works, see A Christie & S Gare (editors), *Blackstone's Statutes on Intellectual Property*, 1992. As Singapore is not currently a signatory to this Convention, she is not obliged to implement its provisions. At present, moral rights protection in Singapore is somewhat weak as it is limited only to certain specific situations dealt with by several express provisions of the Copyright Act (see, *eg*, ss 40, 41, 56, 144, 145, 188, 189) and other laws depending on the circumstances of the particular case, such as contract law.

²⁶ *Supra*, note 2.

²⁷ These rights are also termed "neighbouring rights". For a fuller discussion, see Cornish, *Supra*, note 4, chapter 9.

²⁸ The term "maker" in relation to sound recordings and films is defined in ss 16(3) and 16(4), Copyright Act, from which it is clear that the recording or film company or studio will generally be considered the "maker". Similarly, for the other "entrepreneurial" rights such as broadcasts, cable programmes and published editions of works, copyright ownership is given to the Singapore Broadcasting Authority or a licence holder, the provider of the cable programme service, and the publisher respectively: see ss 97 to 101, Copyright Act.

²⁹ See s 30, Copyright Act.

the commercial investor or risk-taker (*eg*, the recording company, or the film producer). It is the latter to whom the entrepreneurial copyright is awarded.

In contrast, for trademarks, there is no distinct separation of the recipient of the exclusive rights (*ie*, the “proprietor” of the trade mark)³⁰ from the creator of the trade mark (*eg*, the designer of the mark). Instead, the emphasis is that the applicant for registration must be the “proprietor” of the trade mark in question, and he is to be the person who uses or proposes to use the trade mark in his trading activities.³¹ The lack of separation of identity between designer (say) and proprietor means that the trade mark regime is not concerned with the type of “moral” (in the sense that it is not based on economics or commerce) rights which copyright awards to authors, for if it was, some recognition should surely have been expressly given to the effort behind the creation of the mark. This conclusion is supported by the fact that the award of trade mark proprietorship turns very much on the question of use in a form of business activity: the applicant must use his trade mark for the purpose of indicating a connection in the course of trade between himself, and the goods or services for which the trade mark is registered.³² Thus the proprietor may or may not be the same person as the creator/deviser/designer of the trade mark; this fact does not determine the award of trade mark protection. Instead, the more significant factor is the commercial purpose for registration. As such, curious overlaps can result between copyright and registered trade marks law: while, generally, the copyright is vested in the author (who for the most part will be the person who “created” the work),³³ the exclusive rights conferred by trade mark registration may belong to another person entirely. This situation commonly arises where the copyright owner assigns the copyright, or

³⁰ See s 12(1), Trade Marks Act.

³¹ *Ibid.* While this is the position for a registered trade mark, it has already been noted (*supra*, note 20) that under the common law of passing off, the rights are vested in the person who establishes goodwill, who may not be the “creator” of the trade mark: see the Singapore case of *De Classici Shoe Manufacturer v South Star Company* (unreported), noted in G Wei, “Intellectual Property Rights in Singapore: Developments from 1990-1995 and Future Trends”, a paper delivered on 11 November 1995 at the Singapore Academy of Law Conference 1995: Review of Judicial and Legal Reforms in Singapore between 1990 and 1995, at 45.

³² See the definition of a “trade mark” in s 2, Trade Marks Act.

³³ Interestingly, “author” is not defined in the Copyright Act (except in the case of photographs where the author is expressly stated to be the person who took the photograph: see s 7(1)); however, given the need for a copyright work to exist in a material form before any copyright can subsist (see s 27 read with s 16), it would seem axiomatic that the author of a copyright work is the person who first reduces the work into material form, which, in most cases, would be the creator or originator of the work.

licenses the right to use the work for purposes amounting to trade mark proprietorship, to another person. Alternatively, the three specific situations where copyright does not belong to the author, save for contrary agreement, as outlined in section 30 of the Copyright Act,³⁴ may also separate the author/creator from the copyright owner/trade mark proprietor.³⁵

At this juncture, it would be pertinent to note some other functions of trade mark registration, all of which stem from the clear recognition that the basis of protection is the conferment of exclusive rights, upon the commercial use in trade, of the trade mark. First, it protects the investment put into the creation and use of the trade mark, commonly through a trader's using his registered trade mark to build up his goodwill in the market.³⁶ The most obvious manifestation of such investment is through advertising.³⁷ Indeed, the current extent of the exclusive rights awarded under the Trade Marks Act covers not merely the unlicensed use by another trader of the plaintiff-proprietor's mark as a badge of origin for that other trader's goods; the plaintiff-proprietor is also within his rights if he wishes to prevent another trader from "importing a reference" to himself or his goods or services through specific forms of advertising.³⁸

In respect of trade marks as a "badge of origin", the function of trade mark registration is its utility in indicating the source, or origin, of certain goods and services, to the consumer public. Thus the exclusive right to use a particular trade mark can only enhance the proprietor's opportunities to distinguish his product from others'. However, while this may enable the buying public to tell from where a product hails, it does not necessarily aid them in identifying the quality of the products offered.³⁹ This distinction can be important, *eg*, where goods are manufactured for an international market by several companies, either through a franchising operation, or a licensing agreement between the grantor [the original producer] and the grantees. The public may be unaware of the existence of such agreements,

³⁴ The three situations involve journalists' works for purposes of publication in a newspaper, periodical or magazine (s 30(4)), certain specific artistic works which are commissioned and for which valuable consideration exists (s 30(5)) and works created by employees in pursuance to their employment under contracts of service or apprenticeship (s 30(6)).

³⁵ In addition, as already noted, *supra*, note 20, the plaintiff in a passing off action would be the person entitled to the goodwill. In most cases, this would be the person who would be the proprietor of the trade mark if registered. Questions could then arise as to the relationship between copyright and the rights in passing off and those of the registered trade mark system.

³⁶ See Cornish and Phillips, "The Economic Function of Trade Marks: An Analysis with Special Reference to Developing Countries", (1982) 13 IIC 41.

³⁷ For an analysis of the economic functions of advertising, in particular, the use of comparative advertising, see Kaufmann, *supra*, note 16, at 33-40.

³⁸ See s 45(1), Trade Marks Act.

³⁹ *Supra*, note 36.

and indeed would primarily be concerned only that the product which they know by a certain name or brand, be of the same quality. Trade mark protection in each country may then ensure some measure of quality control over the products. It is not uncommon to find that it may be the licensee who would be entitled to the trade mark rights; in these cases, he would probably also be required by the licensing agreement to use these rights to exercise the necessary quality control.⁴⁰

Thus trade mark rights are closely connected to whoever intends to use that trade mark in the country. However, it does not necessarily follow that such a user of the trade mark would always be considered the “proprietor” as required by section 12(1) of the Trade Marks Act. This can raise questions as to who is entitled to claim proprietorship, for example, whether he must also be the owner of other legal rights relating to the mark such as copyright. This is a tricky question as it has implications on the main discussion regarding the impact of cumulative intellectual property protection.

It ought to be noted at this juncture that this article will focus on the possible overlap between trade mark rights, and copyright in authors’ works rather than in the “neighbouring” entrepreneurial copyright material. This is because the nature and physical characteristics of the latter type of copyright material (*ie*, sound recordings, cinematograph films, television and cable broadcasts and published editions of authors’ works) would not come within the ambit of registrable trade marks. Hence, in the ensuing discussion, references to copyright protection will be limited to copyright in relation to authors’ works only.

II. ACQUIRING SEPARATE PROTECTION UNDER COPYRIGHT AND TRADE MARK LEGISLATION

(1) *Copyright*

The current copyright law of Singapore is set out in the Copyright Act.⁴¹ For the different types of authors’ works, there are some common requirements to be fulfilled. Essentially, the work must first be an original one⁴² in the sense that it is not copied from another work. The author must have put in some intellectual effort, skill, time, labour and judgement in coming up with the work. In this respect, it is trite law that the originality lies

⁴⁰ Aside from the consumer, the question of the quality of a product can be relevant in at least two other ways, *viz*, when registering a licensee as a registered user (see, in particular, s 30(5)(d) and (e) of the Trade Marks Act), and when controlling parallel imports (see, *eg*, *Colgate-Palmolive v Markwell Finance, infra*, note 225).

⁴¹ See generally G Wei, *The Law of Copyright in Singapore* (1989).

⁴² See s 27, Copyright Act.

not in the idea for the work, but in the form in which that idea is expressed. The “form of expression” itself is not the structure within which the idea is fleshed out (*eg*, whether it is a novel or a play) but the actual expression of the idea (*eg*, the words of the novel, the dialogue in the play).⁴³

Secondly, the work must be one that the Copyright Act contemplates as being protectable. Thus, it must be either a “literary, dramatic, musical or artistic work.”⁴⁴ While what constitutes a musical work is not defined by the Act, presumably as this would be a matter of common sense, this is not the case for artistic, literary and dramatic works.⁴⁵ This lack of a full definition for literary works does carry implications for the main question under discussion. This is because many trade marks consist of a word or a few words, and the question is whether or not such marks would also enjoy copyright as literary works, a point to which we will return.

Thirdly, section 27 makes it clear that the original author’s work must have some connection with Singapore before copyright can be acquired in Singapore. The connection to be established depends on whether the work is published or not.⁴⁶ For an unpublished work, there is only one connecting factor that is possible, *viz*, the fact that the author was a “qualified person” (meaning a citizen of or person resident in Singapore) at the time the work was made. For published works, there is more than one way to establish the necessary connection. First, that regardless of citizenship or residence, the work was first published in Singapore. Alternatively, that regardless of where first publication occurred, the author was a qualified person at the time of such first publication, or if dead, immediately before his death.⁴⁷

Once copyright is acquired, the exclusive rights thus conferred include rights of material reproduction, performance and adaptation, the last of which

⁴³ *Per* Peterson J in *University of London Press v University Tutorial Press* [1916] 2 Ch 601 at 608-610. Note, however, that while English courts have accepted this distinction between idea/expression, there has been little effort to draw a bright line between protectable expression and unprotectable “raw” facts or information: see, *eg*, the comments of Jacob J in *Ibcos Computers Ltd v Barclays Mercantile Highland Finance Ltd* [1994] FSR 275. See also G Wei, “Problems in Applying the Form of Expression and Idea Principle in Copyright Law”, a paper delivered at the Workshop on “Recent Developments in Intellectual Property Law” of the Singapore Conferences on International Business Law (Conference VII), on 30 August 1994.

⁴⁴ See s 27, Copyright Act.

⁴⁵ In s 7 of the Copyright Act, there is an exhaustive definition of artistic works while dramatic and literary works are non-exhaustively defined.

⁴⁶ As to the meaning of “publication” for copyright purposes, see s 24 of the Copyright Act and Wei, *supra*, note 41, at 67-70. The main text in this area focusses only on Singapore works which come within the purview of the Copyright Act 1987. On the position of pre-1987 works, both foreign and local, and the extension of the Copyright Act 1987 to new foreign works, see Wei, *supra*, note 41, at 75-59.

⁴⁷ See generally s 27, Copyright Act.

will in turn confer the same rights of reproduction and so forth on an adaptation made from the work.⁴⁸ These rights in the absence of specific situations (such as employment) generally belong to the author himself, and last till fifty years after his death.⁴⁹

(2) Trade Marks

Several substantive requirements have to be fulfilled before an application to register a trade mark is granted. Essentially, it has to fall within the statutory meaning of a “distinctive trade mark”.

A “mark” is defined as including “a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.”⁵⁰ This definition is non-exhaustive, and it is therefore possible for other material not expressly mentioned to also qualify as a mark. The noteworthy point to which we shall return⁵¹ is the possibility of those which are expressly included in this definition also acquiring copyright protection in their own right, *eg*, devices as artistic works, words as literary works.

A second requirement is that the mark has to be a “trade mark”, whether for goods or services.⁵² It has already been seen⁵³ that the primary points to be established concern the question of use in trade, and how this connects the proprietor with the goods or services for which he wishes to register the mark.

On the question of distinctiveness, the Act differentiates between marks to be registered in Part A of the trade marks register, and those to be registered in Part B. For the former, any one of four characteristics listed in section 10 of the Trade Marks Act, if found in the trade mark in question, suffices for a presumption of distinctiveness to be raised. These include names, *eg*, of companies or individuals “represented in a special or particular manner,”⁵⁴ the proprietor’s own signature or that of his predecessor in the business,⁵⁵ invented words,⁵⁶ and words which are not directly or ordinarily descriptive, geographical or surnames.⁵⁷ Even if a trade mark does not possess any of

⁴⁸ The exclusive rights conferred by copyright for authors’ works are listed in s 26, Copyright Act.

⁴⁹ As to the ownership of copyright in authors’ works, see s 30, Copyright Act. As to the duration of such copyright, see *supra*, note 9.

⁵⁰ S 2, Trade Marks Act.

⁵¹ See *infra*, notes 66-136 and the accompanying main text.

⁵² *Ibid.*

⁵³ See *supra*, notes 30-40 and the accompanying main text.

⁵⁴ See s 10(1)(a), Trade Marks Act.

⁵⁵ See s 10(1)(b), Trade Marks Act.

⁵⁶ See s 10(1)(c), Trade Marks Act.

⁵⁷ See s 10(1)(d), Trade Marks Act.

the above characteristics such as to raise the presumption of distinctiveness, it is still possible under section 10(1)(e) of the Trade Marks Act to register it as “any other distinctive mark”, provided it can be shown that it is adapted to distinguish the goods or services in question.⁵⁸ Evidence of such distinctiveness must show the extent to which the trade mark is both inherently and in fact (*eg*, through use) adapted to distinguish the proprietor’s goods or services from others’.⁵⁹

For Part B trade marks, there is no provision for a presumption of distinctiveness to operate. Distinctiveness must therefore be proven, and the requirement here is stated differently from that in section 10(2) for Part A marks. For registration in Part B, section 11(1) requires that the trade mark be one that is “capable ... of distinguishing” the proprietor’s goods or services. Capacity to distinguish is examined with regard to both inherent capacity as well as capacity in fact.⁶⁰

It is commonly accepted that the difference in wording between distinctiveness in Part A and Part B means that a lower level of distinctiveness (which would be unacceptable for a Part A registration) is not necessarily barred from registration in Part B.⁶¹ It follows that the extent of protection offered by a Part B registration should be narrower, and in fact is narrower, than a Part A one. For example, the validity of the original registration in Part A cannot be challenged in the absence of specific facts such as fraud after 7 years from the registration date;⁶² there is no such corresponding conclusive time limit for Part B marks. Further, section 46(2) provides that a plaintiff in an action for infringement of a Part B mark should not be awarded injunctive and other relief if the defendant can prove that his use is unlikely to cause confusion, or indicate a trade connection, between his goods and the plaintiff.

Upon registration, the proprietor is given the exclusive right to use the registered trade mark in relation to the goods or services for which he has registered it.⁶³ The initial registration period is for ten years, after which

⁵⁸ See s 10(2), Trade Marks Act.

⁵⁹ See s 10(3), Trade Marks Act. Although this subsection states that the respective extent of inherent and factual adaptability are factors which the Registrar or the court “may” have regard to, the practice has been to consider both factors such that even proof of extensive use has not been able to make up for lack of inherent adaptability: see, *eg*, *Yorkshire Copper’s Application* [1953] 71 RPC 150. See also *Tobacco Importers v Registrar of Trade Marks* [1976] 1 MLJ 250.

⁶⁰ See s 11(2), Trade Marks Act. Since the issue of inherent and factual capacity to distinguish a trade mark is laid out in the same manner as that in s 10(3), presumably the approach taken in interpreting s 10(3) will also be adopted in interpreting s 11(2). This is, in fact, the case: see “*York*” *Trade Mark* [1984] RPC 231.

⁶¹ See Cornish, *supra*, note 4, at 447, 473-474.

⁶² See s 48, Trade Marks Act.

⁶³ *Supra*, note 7.

the proprietor may within the prescribed period apply for renewal for a further ten years upon payment of a renewal fee.⁶⁴

III. ACQUIRING CUMULATIVE PROTECTION UNDER COPYRIGHT AND TRADE MARKS LEGISLATION

There is no provision either in the Copyright Act or the Trade Marks Act which forbids or deals with the possibility of cumulative protection. This is possibly because any overlap in protection would not be obvious or common, unlike, say, copyright and registered design rights, or trade marks and the tort of passing off, both of which are expressly dealt with by the respective statutes.⁶⁵ In fact, as the following discussion shows, overlaps between copyright and trade marks protection can be quite common.

How then can any overlap arise between copyright and trade marks? This issue will be examined in relation to, first, literary works, and secondly, artistic works.

(1) *Literary Works Under Copyright*

The non-exhaustive definition of a “literary work” in section 7 of the Copyright Act deals only with tables, compilations and computer programs. Thus, while it is impossible to imagine that novels would not be considered literary works, there are certain “works” not included in the definition which may pose problems. The most common of these, and the most relevant to the current discussion, involve single words and short phrases.

The problem may be framed in this way: since trade marks such as brand names may consist of single words, or a few words seen together, is it possible for such marks to also be protected by copyright?

As the Singapore Copyright Act 1987 has, in many respects, similar provisions to the English copyright legislation, it is submitted that the points and arguments made below would, for the most part, apply to a case arising in Singapore as well.

In English law, it is extremely difficult to successfully argue that a single word or a short phrase constitutes an original literary work. The leading case in this area in respect of a single word is the case of *Exxon Corpn v Exxon Insurance*,⁶⁶ where the single word “Exxon”, despite its creation being the result of much time, effort and expense, was held not to qualify as an original literary work. At first instance, although Graham J acknowledged it to be original as it was invented, he could not accept

⁶⁴ *Supra*, note 10.

⁶⁵ *Supra*, notes 17, 18.

⁶⁶ [1981] 3 All ER 241 (hereinafter the *Exxon* case).

that it was a subject for copyright as “[i]t is a word which ... has no meaning and suggests nothing in itself ... [and] ... only takes on meaning or significance when actually used with other words ... or in a particular juxtaposition.”⁶⁷ In the Court of Appeal, Graham J’s judgement was approved and affirmed. In addition, it would appear from the leading judgement in the Court of Appeal (delivered by Stephenson LJ), that while the requirement of originality must be satisfied in every case, it would not be proper to break up the term “original literary work” into its three component words, and examine whether the work in question separately fulfils each component. Instead, given the history of copyright protection for literary works, particularly the increasing broadening of its scope, the phrase should be construed in its entirety.⁶⁸

Stephenson LJ then went on to consider several other reasons for the court’s decision. First, he referred to three cases which seemed to expressly affirm that one could not acquire monopoly rights in a name or word, whether invented or not. Although not all the cases were directly concerned with copyright, the monopoly rights referred to would seem to also include copyright.⁶⁹ Secondly, he adopted the statement made by Davey LJ in *Hollinrake v Truswell*⁷⁰ that “a literary work is intended to afford either information and instruction, or pleasure, in the form of literary enjoyment,”⁷¹ as stating the ordinary meaning of the phrase “literary work”. Given these, and the reasons stated by Graham J in the court below, the single word “Exxon” was denied copyright protection.

It is not the intention of this writer to attempt an exhaustive analysis of literary copyright. However, several points arise from the *Exxon* case which merit further consideration due to their implications for the current discussion.

Perhaps most importantly, the decision did not close the avenue of copyright to all single words or titles. Indeed, Graham J stated that he did not mean to suggest that “a word which is used as a title can, as a matter of law, never in any circumstances be the subject of copyright.”⁷² This was not contradicted in the Court of Appeal. It is therefore possible for titles, or presumably, even single words, to acquire copyright as original literary works in the appropriate case; whether that be due to their innate ability to suggest a meaning in itself, or by fulfilling Davey LJ’s definition, or because the policy reasons against awarding monopoly rights are not as

⁶⁷ [1981] 2 All ER 495 at 503.

⁶⁸ *Supra*, note 66, at 245, 249.

⁶⁹ *Ibid*, at 247.

⁷⁰ [1894] 3 Ch 420.

⁷¹ *Ibid*, at 427-428; *supra*, note 66, at 248.

⁷² *Supra*, note 67, at 503.

compelling as in the cases mentioned.⁷³

At this juncture, it may be instructive to examine a few cases which have considered the possible acquisition of copyright of such words and phrases. In respect of titles, the position appears to be just as difficult as for single words. Except for the late nineteenth-century case of *Weldon v Dicks*,⁷⁴ where the court held that the title “Trial and Triumph” for a book could enjoy copyright, the trend since then has apparently gone the other way. For example, “Splendid Misery” (a book title),⁷⁵ “The man who broke the bank at Monte Carlo” (a song title),⁷⁶ “Opportunity Knocks” (a television programme title)⁷⁷ and “The Lawyer’s Diary” (a title of a legal directory)⁷⁸ all failed to be recognised as literary works such as to attract copyright protection.

It may be interesting to enquire if the failure by words, titles or short phrases to acquire copyright is because it fails to pass some *de minimis* principle or “substantiality” threshold, rather than because it is either not a literary work, or that it is not original due to lack of intellectual skill or effort. Some of the cases mentioned in the preceding paragraph would appear to be based on a combination of these reasons.⁷⁹ It is submitted that refusing copyright protection based solely on the first ground of lack of substantiality would not lead to any objection in principle, at least where titles and phrases are concerned. Such a reason would lend validity to the claim that no one is to be permitted a monopoly over “the basic building blocks of language which everyone should be free to use.”⁸⁰ However, it may be possible then to argue that virtually all single words would never be substantial enough to warrant copyright protection, regardless of the amount of skill or effort that may have been involved in coming up with that word. In spite of this, it is submitted that this basis is more defensible than either adopting a rigid and comprehensive definition for a literary work where there is none provided by the Copyright Act, or to ignore the fact that the work in question is undoubtedly original such that the real question should rather be whether or not it is a literary work. The *Exxon* case seems to have relied more on the latter two reasons which is perhaps unfortunate.

⁷³ See generally, Dworkin and Taylor, *Blackstone’s Guide to the Copyright, Designs and Patents Act 1988* (1989), at 21-22.

⁷⁴ [1878] Ch 247.

⁷⁵ *Dicks v Yates* [1881] Ch 6.

⁷⁶ *Francis Day & Hunter Ltd v Twentieth Century Fox Corp Ltd* [1940] AC 112.

⁷⁷ *Green v Broadcasting Corp of New Zealand* (1983) 2 IPR 191.

⁷⁸ *Rose v Information Services Ltd* [1987] FSR 255.

⁷⁹ See generally, J Cullabine, “Copyright in Short Phrases and Single Words”, [1992] 6 EIPR 205; D Lyons, “Copyright in Trade Marks”, [1994] 1 EIPR 21.

⁸⁰ *Supra*, note 73, at 22.

However, it is important to acknowledge that even while refusing copyright protection to words, titles and phrases, many judges have been careful to state that they are not expounding a general principle that these can never enjoy copyright.⁸¹ Moreover, it is possible to argue that none of these cases (including *Exxon*) “intended to establish a comprehensive or exhaustive definition of a literary work for copyright purposes.”⁸²

One writer has suggested at least two alternative possible means by which words and phrases may effectively acquire literary copyright, *viz.*, either as a compilation (which is accepted as a “literary work” under section 7(1) of the Copyright Act) or simply because it may actually form a substantial part of the whole copyright work (such as a song lyric).⁸³ Support for the first alternative can be drawn from the case of *Ladbroke (Football) Ltd v William Hill (Football) Ltd*⁸⁴ where a betting coupon for playing the football pools draw was held to be a compilation and thus a literary work. The originality component was satisfied as sufficient skill was required to work out the composition, writing and layout of the coupons in question. Of course, such an argument would work only if the word, title or phrase in question is part of a composite work – it may even be combined with other components which could themselves be artistic works such as drawings. The importance of this fact for the current discussion is obvious: since many trade marks are composite works, not only would the acquisition of literary copyright bring up the issue of cumulative protection with trade marks law, but the combination of literary and artistic material into a composite work would also necessitate consideration under artistic, as well as literary, copyright. For reasons which are outlined below,⁸⁵ it is submitted that in Singapore, an argument that such words and phrases enjoy literary copyright as compilations may well be problematic.

Unlike the compilation argument, the second possible means by which literary copyright may be acquired does not confer literary copyright on the word or phrase in question. Instead, protection depends on the greater, or whole, work being a copyright work, the infringer copying the word or phrase in question, and this word or phrase forming a substantial part of the whole copyright work.⁸⁶ It is submitted that this alternative is

⁸¹ See, *eg.*, *supra*, note 75, at 89, *infra*, note 83, at 476, *supra*, note 67, at 503.

⁸² *Per* Aldous J in *C & H Engineering v Klucznik & Son Ltd* (1993) 26 IPR 133 at 139.

⁸³ See Cullabine, *supra*, note 79, at 208-209.

⁸⁴ [1964] 1 All ER 465.

⁸⁵ See *infra*, note 134 and accompanying main text under “Artistic Works Under Copyright”.

⁸⁶ Under the Copyright Act, s 31 provides, *inter alia*, that the doing of “any act comprised in the copyright” constitutes infringement. Under s 26(1), to “reproduce [a] work in material form” is an act comprised in the copyright, and “reproduction” is further defined in s 10(1)(b) as including “reproduction ... of a substantial part of the work”. See generally, Wei, *supra*, note 41, Chapter 6.

extremely narrow and is unlikely to be satisfied in most cases. Further, single words, particularly non-invented ones, will almost certainly not form a substantial part of the work for copying purposes. It is also extremely unlikely that this alternative will be useful in considering the question of cumulative protection, as few, if any, trade marks, are likely to consist of a larger work incorporating the single word, phrase or title of the type described by Cullabine. They are more likely to be considered composite, possibly compilation, works.⁸⁷

There has been judicial recognition that copyright can subsist in extremely simple drawings as a type of original artistic work. While simplicity is not a bar to copyright, the cases do suggest that the degree of simplicity may be relevant to the question of infringement. As a general rule, the more simplistic the work, the greater the exactitude of copying before infringement is established.⁸⁸ Could not the same test be applied to cases of single words, short titles or phrases, at least in cases where the originality requirement is clearly fulfilled such as in the case of an invented word like “Exxon”? However, it is submitted that even such a test may not save single, non-invented words from failing to acquire copyright, especially as the fundamental policy reason against awarding a monopoly over ordinary words would be at its strongest in such an instance.⁸⁹ In any event, on the theoretical plane, it may not be appropriate to test the question of subsistence of copyright by reference “forward” to issues relating to infringement.

The *Exxon* decision was considered in the subsequent case of *Express Newspapers v Liverpool Daily Post*,⁹⁰ where Whitford J commented that the *Exxon* case “proceeded upon [the] basis ... that this word [Exxon] conveyed no information; ... provided no instruction; and ... gave no pleasure.”⁹¹ Applying it to the instant case, he held that grids (consisting of twenty-five letters of the alphabet set out in rows of five horizontally and vertically to form a square) and individual letters sequences (each consisting of five letters of the alphabet) published in the plaintiffs’ news-

⁸⁷ In this respect, one important question which arises is whether or not these “compilations” would be considered literary or artistic works: see discussion *infra*, notes 134-136 and the accompanying main text.

⁸⁸ See, *eg*, *Kenrick v Lawrence* (1890) 25 QBD 99. This approach is broadly in line with the requirement for copyright infringement that there must be substantial taking on the part of the defendant. However, it could be argued that, unlike the *Kenrick* case (where the skill required as well as the final drawing in question was undeniably simple), in a case like *Exxon*, although the final product appears simple, the amount of skill and effort which may have gone into coming up with a suitable name, catchy title or pithy phrase may have been considerable.

⁸⁹ See *supra*, note 73.

⁹⁰ [1985] FSR 307.

⁹¹ *Ibid*, at 310.

paper on a daily and changing basis as a contest for readers to match with cards, were literary works. These grids and sequences provided information in the sense that readers looked at them to see if these matched those on the cards to find out if they had won the contest; “information is [therefore] the whole purpose of the publication of these grids and five-letter sequences.”⁹²

It is submitted that this last statement of Whitford J ought not to be taken literally, as to do so may lead to one having to ask (in cases of alleged literary works which do not fall within the specific inclusions in the Copyright Act) what is the purpose of the work, that purpose being confined to either the provision of information, or instruction, or the giving of pleasure in the form of literary enjoyment.⁹³ Such an approach may be too narrow given the fact that this definition does not appear at all in the Copyright Act. Taking this approach to the extreme and applying it to names and titles, it could be said that a name gives information about the owner of the name, as does a title about the book: indeed, the whole purpose of the name and the title is to provide this information; they should therefore qualify as literary works. However, it is submitted that this should not be the complete test. At best, the fact that the work does offer pleasure, information or instruction may be the starting point for analysis as to whether or not a “work” is a literary work. It may not always follow that just because the requirement is satisfied that the work would, in law, be a literary work. Arguably, there must be more than a *de minimis* amount of information, and in some cases, it may be that even if the “work” does give a lot of information, instruction or pleasure, it may not be a literary work, *eg*, a symphony by Beethoven, or da Vinci’s Mona Lisa, may both provide considerable pleasure. However, such pleasure would not be “in the form of literary enjoyment”, which phrase is part of the definition of literary work given in *Hollinrake v Truswell*. This can be seen to be the very reason why names and titles ought not to be considered literary works: since they do nothing and serve no other purpose than to inform,⁹⁴

⁹² *Ibid*, at 311.

⁹³ In regard to this phrase, it was noted by Stephenson LJ in *Exxon* that it may not be clear as to what the phrase “may add to the word ‘pleasure’” (at 248).

⁹⁴ It may be that in interpreting the definition of literary work adopted by Stephenson LJ in the *Exxon* case, one ought not to sever the phrase “in the form of literary enjoyment” from the purpose of providing information or instruction, thereby limiting the phrase to only the provision of pleasure. While it is true that the word “pleasure” is the least precise of the three functions, it is at least arguable that the last phrase sheds some light on the question of what types of work which provide either information or instruction would be considered literary works, and what would not. Such an interpretation would recognise that not all works which provide either of these two would necessarily be literary works for the purpose of copyright; an approach that supports the non-recognition of, *eg*, names, for copyright purposes. However, it may then be questionable whether the grids and sequences in

could it not be said that they are merely pieces of information? If so, surely copyright cannot protect them, as copyright law does not protect mere information.⁹⁵ Further, names can, very often, generate goodwill for the owner (eg, either personally or as a business). In such cases, it may be arguable that the more appropriate vehicle for protection ought not to be copyright, but rather trade marks law or the action in passing off.⁹⁶

It could also be said that the meaning (and therefore the information provided) of words can change with the context in which it is used. The grids and letter sequences in *Express Newspapers v Liverpool Daily Post*⁹⁷ provided information only because they were used as part of a contest for which readers had to possess matching cards in order to win; they could only discover possible matches by consulting the newspaper. If the same grids and letter sequences were to be taken out of this context, it is arguable that they would not then provide any information; they would be merely combinations of letters, possibly incapable of pronunciation⁹⁸ and devoid of any meaning under the *Hollinrake* approach, these may not then qualify as literary works.

Whether or not combinations of letters *per se* (ie, regardless of the context in which they appear or are used) can be literary works for copyright purposes is not entirely clear. First, the Copyright Act does not expressly include these as “literary works”. Secondly, it is possible to question whether or not combinations of letters, if either unpronounceable or incapable of meaning, are “words” in the first place.⁹⁹ In *Exxon*, Graham J had referred to Lewis Carroll’s nonsense poem “Jabberwocky” as an illustration that the single word title could not itself be a literary work;

the *Express Newspapers* case would then qualify as literary works for copyright purposes, at least, where the context is not to be looked at.

⁹⁵ As to the possible basis for the idea/expression and fact/expression dichotomy, see G Wei, *supra*, note 43.

⁹⁶ This point clearly raises an issue on cumulative protection: see *infra*, note 139 and accompanying main text.

⁹⁷ *Supra*, note 90.

⁹⁸ Should such a sequence then be used to apply for a registered trade mark, problems may arise as to it not being a pronounceable word: see “IQ” *Trade Mark*, discussed *infra*, at note 279 and the accompanying main text.

⁹⁹ Although the wide approach to literary works espoused by Peterson J in the *University of London Press* case (see *supra*, note 43) encompasses “work which is expressed in print or writing” such that “[t]he word “literary” seems to be used in a sense somewhat similar to the use of the word “literature” in political or electioneering literature and refers to written or printed matter” (see judgement at page 608), it is arguable that even this approach presumes that the written or printed matter consists of recognisable words. In *DP Anderson & Co Ltd v Leber Code Co* ([1917] 2 KB 469), the argument that words selected from among 100,000 words to form a telegraphic code were meaningless, failed as to each word a meaning would be attributed by both the sender and recipient of the code (see the discussion in *Exxon*, *supra*, note 66, at 248).

only the poem itself, including the title, could. Although the principle which Graham J sought to illustrate by using this analogy is admittedly different from the question at hand, it is interesting that the learned judge seemed willing to recognise the whole “Jabberwocky” poem to be a literary work, as many of the words in the poem itself were made up by Lewis Carroll for the nonsense poem. This may point to the possibility that words, even if devoid of meaning, may be literary works (provided, of course, that they do not fall foul of some of the other principles, such as substantiality, already discussed. Such cases would be more likely to succeed if in a more substantial form than a name, title or short phrase). However, even if this is so, it may not be possible for the same result to be obtained in respect of combinations of letters, as the question there, as already stated, is not whether the word which they form is a work, but rather, at a more fundamental level, whether or not they form a word in the first place.¹⁰⁰

In contrast, under registered trade marks law, there appears to be no such problem in respect of registering such combinations of letters as trade marks, as “mark” is defined in the Trade Marks Act as including “... name, signature, word, letter, numeral or any combination thereof.”¹⁰¹ While there may be other problems in registering such combinations (eg, if the combination results in something that is unpronounceable),¹⁰² the fact is that trade marks law expressly recognises the possibility that trade mark protection may exist in respect of such combinations, while the matter appears more doubtful under copyright law.

Where the word that results from the combination of letters is meaningless, another objection to the name or title being a literary work could then be that such a word would not “in itself [be] a title or distinguishing name [as] ... it only takes on meaning or significance when actually used with other words ... or in a particular juxtaposition” (*per* Graham J in *Exxon*).¹⁰³ However, this point seems not to have been important in Whitford J’s decision in the *Express Newspapers* case.

It may be that the other basis for Whitford J’s decision would present less difficulty. He seemed to accept that the grids and sequences could be considered tables.¹⁰⁴ A table is specifically included as a literary work in the Copyright Act, and hence, provided there is no problem with originality, would be an original literary work. It was accepted by Whitford J that “a

¹⁰⁰ See the remarks of Pincus J in the case of *Roland v Lorenzo* (discussed *infra*, under “Artistic Works Under Copyright” in Part I), where he stated that “mere random collection of letters of the alphabet could not be copyright” (at 249).

¹⁰¹ See s 2, Trade Marks Act.

¹⁰² See “IQ” *Trade Mark*, *infra*, note 279 and the accompanying main text.

¹⁰³ *Supra*, note 66, at 503.

¹⁰⁴ *Supra*, note 97, at 310.

great deal of skill and, indeed, a good deal of labour went into the production of the grid and the ... sequences.”¹⁰⁵

This approach would imply that it may be unnecessary to consider the context within which a word, words or works, appear. If so, supposing that in a particular case (whether that be of a single word, title or name) there is no difficulty with the originality requirement, the underlying question may well be whether or not there is any policy reason for denying it copyright protection as an original literary work.¹⁰⁶

It may be pertinent to ask if there is another underlying basis for denying single words, names and titles copyright protection, *viz.*, that these do not possess any “quality, style, and ... literary finish.”¹⁰⁷ Although this is clearly not a requirement for a work to be a literary work for copyright purposes,¹⁰⁸ it is tempting to draw a parallel between extremely short works such as Lord Byron’s famous quick rhyme¹⁰⁹ or the type of poem known as “haiku” (where convention dictates that such poems are not to be longer than seventeen syllables), and a title, phrase or slogan. It is difficult to imagine that copyright protection would be denied to the former type of work; but it seems clear that the latter type of work would encounter some difficulty in being accepted as a literary work for copyright purposes. This could be one situation where even the substantiality principle (operating as a means to deny copyright to the latter type of case) may break down.

The present position, therefore, seems to be that many situations similar to the *Exxon* case would face difficulty acquiring literary copyright. The fact that much research and creativity has gone into inventing the word or title does not appear from that case to be sufficient in itself to attract copyright. It is thus unclear exactly what may sway the decision in favour of copyright, although it may arguably be different if the word or title in question can stand by itself, *ie.*, it suggests a meaning or is otherwise significant, without the need to juxtapose it with other words.¹¹⁰ This would be so particularly if it can be demonstrated that there would be little danger of thereby conferring a monopoly over language, *eg.*, if it is recognised that practically the whole of the word or title, if a simple one, would have to be taken in order for the exclusive rights to be infringed. The copyright

¹⁰⁵ *Supra*, note 90, at 309.

¹⁰⁶ See Dworkin & Taylor, *supra*, note 73.

¹⁰⁷ *Per* Peterson J in *University of London Press Limited v University Tutorial Press Limited*, *supra*, note 43, at 608.

¹⁰⁸ *Ibid.*

¹⁰⁹ This work was referred to by Peterson J in the *University of London Press* case, albeit in relation to the originality requirement rather than whether or not it would qualify as a literary work.

¹¹⁰ *Per* Graham J, *supra*, note 67, at 503. See also *supra*, note 99, and accompanying main text.

monopoly in these instances would necessarily be a thin one. In the cases where individual names, invented words, short phrases, titles and other similar works would, despite the above discussion, attract literary copyright as well as registered trade mark protection, there would then clearly be a case of cumulative protection.

The importance of recognising that it is not impossible for some words, titles or phrases to acquire copyright lies in the fact that for those words which do so, there is nothing in the Copyright Act which forbids the copyright owner from seeking trade mark protection as well. In fact, in the *Exxon* case, it was said that an invented word such as “Exxon” would in fact be a typical subject for trade mark registration, although the fact that such protection might be available was not considered to be a weighty factor in determining the question of copyright.¹¹¹ Since the outcome of the case was that copyright protection was not available, however, there was no need to examine the question of cumulative trade mark protection.

(2) *Artistic Works Under Copyright*

Unlike literary works, artistic works are exhaustively defined in section 7 of the Copyright Act 1987 as follows:

“artistic work” means -

- (a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not;
- (b) a building or model of a building, whether the building or model is of artistic quality or not; or
- (c) a work of artistic craftsmanship to which neither paragraph (a) nor (b) applies.

For paragraph (a), with the exception of sculptures, the other works are also defined in section 7, exhaustively for photographs, but not for drawings or engravings. As drawings would be relevant to the later discussion, it is prudent to note the definition given, which is that it “includes any diagram, map, chart or plan”.

For paragraph (b), a “building” is defined to include “structure[s] of all kinds”, so presumably a model of a building would also include models of structures of all kinds.

¹¹¹ *Per* Graham J, *supra*, note 67, at 503; *per* Stephenson LJ, *supra*, note 66, at 249.

“A work of artistic craftsmanship”, however, as listed in paragraph (c), is not defined at all. This has caused the courts considerable difficulty, especially in view of the fact that it would appear from the definition of “artistic work” that while artistic quality or merit is irrelevant to artistic works falling under paragraphs (a) or (b), the exclusion of this defining phrase from paragraph (c) would appear to imply that artistic quality is required in order for an article to qualify as a work of artistic craftsmanship. This conclusion is supported by the decision of the House of Lords in *Hensher (George) Ltd v Restawile Upholstery (Lancs) Ltd*¹¹² where a prototype working model for a suite of furniture was denied copyright on the basis that it was not a work of artistic craftsmanship. Although the judgements are not uniform on all counts, what generally emerged was the idea that the work in question had to be one that had, as its primary intention, aesthetic appeal.¹¹³ On this point, some of the judges felt that the intention of the craftsman behind the object would be of importance. This factor has since been accepted as embodying the proper approach to works of artistic craftsmanship.¹¹⁴

It has already been noted in the previous section how invented words and other short word marks, *eg*, names and titles which may be protected by trade marks,¹¹⁵ could also acquire literary copyright, although at present this is admittedly somewhat difficult. However, trade marks are not limited to word marks. It is common to find trade marks which consist of logos or devices (which may consist partly of letters or words and partly of drawings)¹¹⁶ such as to become composite works. It is possible that these examples would fall within the scope of “drawings”¹¹⁷ and hence acquire copyright protection as artistic works, provided the element of originality is present.

¹¹² [1974] 2 All ER 420.

¹¹³ See J Phillips, *Artistic Copyright*, (1975) *Modern Law Review* 86.

¹¹⁴ See, *eg*, *Merlet v Mothercare* [1986] RPC 115.

¹¹⁵ *Supra*, notes 50-59. This question is discussed in greater detail in Part II, *infra*, notes 137-143 and the accompanying main text.

¹¹⁶ *Eg*, the “AUVI” trade mark, *supra*, note 13; see also TA Blanco White & R Jacob (editors), *Kerly’s Law of Trade Marks and Trade Names* (12th ed, 1986) at para 8-56.

¹¹⁷ There may be some problems with distinctiveness when attempting to register drawings which are mere pictorial representations of the goods, in particular, commonplace goods, as granting trade marks for these may be considered to amount to depriving other traders from fairly using similar pictures to market their own goods: see Kerly, *ibid*, at para 8-59; see also *Unilever PLC’s Trade Mark* [1984] RPC 155. In the Singapore case of *Cheng Kang Pte Ltd v Sze Jishian* [1992] 2 SLR 214, Rubin JC held that a trade mark for joss paper, consisting of a representation of a gold or silver ingot, was not distinctive, being descriptive of the character and quality of the goods in question. Affidavit evidence had shown that such ingots symbolised good luck, wealth and prosperity, as did the burning of joss paper; and that joss paper was usually folded into the shape of ingots prior to being burnt.

Where drawings are concerned, it has previously been mentioned¹¹⁸ that the mere fact that it is a simplistic one has not been a bar to its acquiring artistic copyright. Indeed, in *British Northrop v Texteam*¹¹⁹ Megarry J stated that he “[did] not think that the mere fact that a drawing is of an elementary and commonplace article makes it too simple to be the subject of copyright.”¹²⁰

In the same vein, Whitford J in *Karo Step Trade Mark*¹²¹ considered only straight lines and circles to be examples of drawings too simple to be a “work”. And in *Kenrick v Lawrence*,¹²² a simple drawing of a hand holding a pencil was held to be protected by copyright.

Interestingly enough, the first two cases were referred to by Stephenson LJ in the *Exxon* decision, who felt that they were not helpful on the issue of whether or not “Exxon” was an original literary work.¹²³ This would appear to indicate that, unlike pure word marks, marks which can be said to be drawings, even if consisting partly of words or letters, would not encounter the same tests (as would cases of literary copyright) in attempting to qualify for artistic copyright. They would do so rather easily provided they do not fall foul of the *de minimis* principle.

What degree of stylisation or embellishment would be necessary in order for a mark consisting of a letter, word or phrase to be considered an artistic rather than a literary work? In both the *Karo Step* and *AUVI* cases, no attempt was apparently made to argue that the mark was a literary work. However, in the Australian case of *Roland Corp & Another v Lorenzo & Sons Pty Ltd*,¹²⁴ the lack of clear distinction between characterising a composite work, or device mark, as either a literary or artistic work, appeared to trouble Pincus J, who found that:

[A] mere random collection of letters of the alphabet could not be copyright and presumably a mere random scribble could not either, but the devices with which I am concerned are by no means random, and were plainly drawn with care, to obtain an effect.¹²⁵

It has been suggested by a writer that since device marks are, by nature, artistic works, Pincus J could simply have ruled on that basis.¹²⁶ With respect,

¹¹⁸ *Supra*, note 88.

¹¹⁹ [1974] RPC 57.

¹²⁰ *Ibid*, at 68.

¹²¹ [1977] RPC 255.

¹²² (1890) 25 QBD 99.

¹²³ *Supra*, note 66, at 246-247.

¹²⁴ (1991) 22 IPR 245.

¹²⁵ *Ibid*, at 249.

¹²⁶ See Lyons, *supra*, note 79, at 22.

however, it is submitted that the matter may not be as easily settled. First, there is no direct authority on this issue, since the case of *Kohler Company's Trade Mark Application*¹²⁷ on which the suggestion is based¹²⁸ although allowing the stylised K's to be registered, did not rule on the specific issue whether the mark in question should be considered a literary or artistic work.¹²⁹ Secondly, it is unclear what would be the threshold separating a device consisting entirely of a stylised letter (as in *Roland*) and one consisting partly of short words or stylised letters, possibly encased in a simple drawing (as in *Karo Step*) or with a slight symbol (as in *AUVI*).¹³⁰

With regard to the second problem, it is submitted that it would be possible to draw some assistance from the case of *Interlego AG v Tyco Industries Inc*¹³¹ where artistic copyright was claimed in respect of engineering drawings which had been modified from prior drawings (whose patent and design protection had expired and in which no artistic copyright protection further subsisted). It was held that the modified drawings would not enjoy any artistic copyright, since the significant changes that had been made which resulted in the final drawings were almost entirely technical ones, and any visual changes were minimal.¹³² While it seems clear that the decision may have been prompted by policy, *viz*, not to permit exploitation of artistic copyright provisions such as to extend one's monopoly beyond that conferred by registered design rights, it is submitted that it may be of assistance even in cases of non-derivative drawings, such as the present problem of composite works.

In particular, reliance may be placed on the following statement by Lord Oliver of Aylmerton that "[w]hat is important about a drawing is what is visually significant."¹³³ Applying this reasoning, by extension, to all artistic works, this would mean that the essence of an artistic work is its visual impact, even where the work in question may be a diagram, engineering drawing or chart. If that is the case, then where device marks and composite works are concerned, the dividing line between literary and artistic works ought similarly to depend on the question of its visual significance. It is submitted that, provided the stylisation is sufficiently eye-catching, such

¹²⁷ [1984] RPC 125.

¹²⁸ *Supra*, note 79, at 22.

¹²⁹ Whitford J seemed to consider the stylised K's a device, which he then considered to be a trade mark rather than a mere visual representation of the letter K, on the basis that the visual impact on first impression would be that of a trade mark, albeit with "hidden" letters: see *supra*, note 127, at 129-130.

¹³⁰ In the *AUVI* case, Chao J proceeded on the basis that it was an artistic work: see *infra*, note 173 and accompanying main text.

¹³¹ [1988] 3 All ER 948.

¹³² *Ibid*, at 968.

¹³³ *Ibid*.

a threshold would permit even combinations of letters and single words, to enjoy copyright protection as artistic works.

Alternatively, a strict interpretation of the definition of a “compilation” in the Copyright Act could be used to distinguish between a literary and an artistic work. In section 2, a literary work is defined as including a “table or compilation, expressed in words, figures or symbols”. It can be said that to include drawings and other artistic material and works as “figures or symbols” would be over-extending the words of the statute. Composite works which include such material, as opposed to composite works consisting of different literary material or stylised words, would then fall to be considered as artistic rather than literary works.¹³⁴

One problem which would then arise is whether or not it is possible to claim copyright protection for compilations consisting entirely of artistic works, *eg*, several drawings combined together. As already mentioned, a compilation is treated as one type of literary work under section 7(1) of the Copyright Act; would it also be over-extending the meaning of the word “compilation” in this context, to also include compilations of purely artistic works?

The editors of *Copinger and Skone James on Copyright* assume that, despite the context in which the word “compilation” is used in the Copyright Act, it also relates to compilations of artistic material alone.¹³⁵ While it may be possible to treat a compilation this way where there is no further qualification, in Singapore, as already pointed out, given that tables and compilations apparently have to be “expressed in words, figures or symbols”, this liberal interpretation may not be possible.

However, an alternative means by which compilations of purely artistic material may acquire copyright (assuming there is no difficulty with originality) may be to treat them as drawings. Since logos, devices and stylised letters can be drawings, there may be little reason not to extend the same treatment to most compilations of artistic works.¹³⁶

(3) Trade Marks

The division between literary and artistic works that exists in copyright law does not appear to be as problematic under the registered trade marks regime. This can be seen from the provisions, already briefly mentioned, on distinctiveness for Part A trade marks.¹³⁷ Sections 10(1)(c) and (d) are

¹³⁴ See Lyons, *supra*, note 79, at 24.

¹³⁵ See *Copinger & Skone James on Copyright*, *supra*, note 1, at 20.

¹³⁶ This argument would, of course, not be successful in all cases of compilations of artistic works; *eg*, a photograph combined with a drawing may be held to over-extend the meaning of “drawing”.

¹³⁷ See *supra*, notes 54-59.

clearly confined to word marks (either invented or non-descriptive), while section 10(1)(e) makes no distinction between word and non-word marks. The division, if any, is less clear in sections 10(1)(a) and (b).

In the former, a trade mark which consists of “the name of a company, individual or firm represented in a special or particular manner” is presumed to be distinctive. The phrase “represented in a special or particular manner” has been interpreted to mean the opposite of represented in a general manner.¹³⁸ The editors of *Kerly’s Law of Trade Marks and Trade Names* point out that there seems little difference between “special” and “particular”; however, this phrase seems directed at preventing infringement by someone unintentionally or honestly using his own name.¹³⁹ Under copyright law, the difficulty in obtaining literary copyright protection for a name has already been discussed. However, the discussion in this Part would then seem to indicate that, should the same name be sufficiently stylised or embellished, it may well be protectable under artistic copyright. Should the stylisation or embellishment be considered representing the name in a special or particular manner, it would then be presumed distinctive under the Trade Marks Act and registrable provided the other substantive requirements of trade mark registrability are fulfilled.

Under section 10(1)(b), “the signature of the applicant for registration or some predecessor in his business” is also presumed distinctive.¹⁴⁰ It can be said that, generally, signatures would either consist of parts of one’s name (*eg*, an initial and surname) or the full name. In such cases, there would again be difficulty in acquiring literary copyright in the signature; however, it may still be possible to argue that a signature is, usually,¹⁴¹ necessarily an embellished or stylised name, and hence ought to attract artistic copyright protection.

It should be noted that, while under section 10(1)(a), there seems to be nothing to prevent the applicant for registration from attempting to register a trade mark which comprises someone else’s name,¹⁴² this is prohibited under section 10(1)(b). It would therefore seem that, where signatures are concerned, a copyright owner of a signature is unlikely to see someone else making such an attempt, without his permission and in the absence of an assignment¹⁴³ of the copyright to him.

¹³⁸ See “Benz” Trade Mark (1913) 30 RPC 177.

¹³⁹ See *Kerly’s Law of Trade Marks and Trade Names*, *supra*, note 116, at para 8-12. As to the honest use of one’s own name, see ss 25, 48 and 53, Trade Marks Act.

¹⁴⁰ As to the difficulties and problems with this subsection, see *Kerly*, *ibid*, at paras 8-14 and 8-15.

¹⁴¹ Except, perhaps, for the rare cases where a signature is simply a rendering in plain print or ordinary writing of a name.

¹⁴² *Kerly*, *supra*, note 116, at paras 8-08 to 8-10.

¹⁴³ Where an assignment of the copyright has been made, the copyright owner would no longer

(4) *Relevant Case Law*

Given that there can be instances of overlap between artistic copyright and trade mark protection, it would be appropriate at this juncture to refer to some of the cases where the facts could have led to a consideration of this point.

In *Roland v Lorenzo*,¹⁴⁴ the stylised letters which were the subject of the copyright argument had been registered under the Australian Trade Marks Act. Although the question of cumulative protection appears not to have formed any major part of either party's arguments, Pincus J considered it appropriate to discuss the question, albeit generally. Having reviewed several cases which touched on cumulative protection in areas other than copyright with trade marks, he concluded that the "underlying notion appears to be that a piece of intellectual property may be deprived of protection in one category on the ground that it is more appropriately dealt with under another."¹⁴⁵ He also considered that Graham J in the *Exxon* case may have subscribed to the same philosophy, and alluded to instances where continued copyright protection may have "anomalous results" where trade mark protection had been removed, either by expiry or non-use.

However, he went on to say that:

... [T]he question whether an appropriate limitation [to cumulative protection] should be read in depends not so much upon one's views of intellectual property law, but upon the general question of the courts' freedom to make implications in statutes.

... the problem of the relationship between trade mark and copyright protection is one of some practical complexity and I prefer to follow what appears to be the orthodox assumption, that the two may co-exist ...¹⁴⁶

be the author/creator of the work. While there would then be nothing preventing the assignee from registering the work as his trade mark (*eg*, the assignee would then be the rightful proprietor of the trade mark: see the discussion of the *AUVI* case, *infra*, notes 167-190 and the accompanying main text; and of Conclusion (2) in Part II, *infra*, notes 254-258 and the accompanying main text), difficulties can arise, *eg*, as to whether or not there can have been goodwill in the previous owner's prior use of his copyright work, and if so, whether or not this would still belong to him, or if it passes with ownership of the copyright (if not specifically addressed in the assignment). This point can have implications should there be a possibility of a passing off action against a third party, as the plaintiff in any passing off action must first prove he possesses the requisite goodwill in the thing alleged to have been passed off by the defendant: see *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873.

¹⁴⁴ *Supra*, note 124.

¹⁴⁵ *Ibid*, at 249-251.

¹⁴⁶ *Ibid*, at 251.

In *Rolls-Royce Motors Ltd v Dodd*,¹⁴⁷ the plaintiff manufacturers of Rolls-Royce motorcars were granted interlocutory injunctions in respect of trade mark infringement and passing off against a defendant engineer who had built a motorcar bearing devices similar to the plaintiffs' registered trade marks. These trade marks consisted of representations of a radiator grille, a statuette of the "Spirit of Ecstasy" and the letters and words "RR" and "Rolls-Royce" respectively. One interesting point about this case concerned the fact that the plaintiffs had initially also sought relief for copyright infringement in respect of the "Spirit of Ecstasy" statuette. They had done so in the belief that the defendant's statuette appeared to have been made in gold, which had never been done for a genuine statuette. However, it transpired that the defendant's statuette was in fact a gold-plated genuine statuette, and hence the plaintiffs withdrew the copyright action.¹⁴⁸

It is interesting to consider the possible grounds for the copyright claim, as this could have arisen in more than one way, all of them due to the different types of artistic work allowed by the Copyright Act. First, the two-dimensional design drawings of the statuette itself would certainly be "drawings" within paragraph (a) of the definition¹⁴⁹ and therefore artistic quality would have been irrelevant.

Secondly, the statuette itself might be considered a "sculpture", again within paragraph (a), "sculpture" not being defined further in the Act except as including "a cast or model made for purposes of sculpture".¹⁵⁰ According to the Concise Oxford Dictionary,¹⁵¹ "sculpture" is the "art of forming representations of objects *etc*, or abstract designs in the round or in relief by chiselling stone, carving wood, modelling clay, casting metal, or similar processes". This definition would seem to require something in the nature of an artistic purpose in the sculpting; coupled with the non-exhaustive definition in the Copyright Act which mentions making for purposes of sculpture, this would seem to support the argument that not all casts, models or such three-dimensional forms would necessarily be sculptures. They would only be so if they were done for a non-industrial, possibly artistic, purpose. This is to be distinguished from the question whether or not the

¹⁴⁷ [1981] FSR 517.

¹⁴⁸ The copyright action, if successful, could have permitted the plaintiffs to claim conversion damages under s 18 of the Copyright Act 1956 (now repealed by the Copyright, Designs and Patents Act 1988). Under that section, the copyright owner was deemed to be the owner of all infringing copies of the work and so would be entitled to sue for conversion damages: see, *eg*, *Infabrics Ltd v Jaytex Ltd* [1982] AC 1. Such damages in the *Dodd* case, if the defendant's statuette was an infringing copy cast in real gold, would have been extremely high.

¹⁴⁹ *Supra*, note 45.

¹⁵⁰ See s 7(1).

¹⁵¹ Sykes (editor), *The Concise Oxford Dictionary of Current English*, (7th ed, 1987).

resulting work possesses any artistic quality, as this is explicitly excluded as a requirement. If this is the case, then it is possible to argue that the “Spirit of Ecstasy” statuette is a sculpture. Although it was modelled for use as a mascot for cars, its appearance and the fact that an aesthetically-pleasing statuette is not something associated with products like cars may be sufficient to disarm protests that it was made ultimately for industrial purposes, and hence cannot be a sculpture. It may even be that it would not be necessary for objects to be made for non-industrial purposes, to qualify as “sculptures” under the Copyright Act.¹⁵²

Thirdly, the statuette could be considered to be a work of artistic craftsmanship under paragraph (c). As we have seen,¹⁵³ works seeking copyright under this heading must possess some measure of artistic quality, and this would be reflected in the intention of the craftsman who made it: *viz*, whether or not he consciously intended to create a work of art. Applying this approach to the “Spirit of Ecstasy” statuette, it could be argued that despite its eventual use on all Rolls-Royce cars, the initial intention of the maker who fashioned it was to create an aesthetic piece of art.

However, whatever the mode in which copyright is acquired, any unlicensed reproduction of the copyrighted work in a material form would constitute infringement of the copyright.¹⁵⁴ In this respect, section 15(3)(a) and section 15(3)(b) of the Copyright Act make it clear that reproducing a two-dimensional work in three-dimensional form, or reproducing a three-dimensional work in two-dimensional form, would come within the scope of the exclusive rights of reproduction. Thus, if the defendant in *Rolls-Royce v Dodd* had used an unlicensed copy of the genuine statuette, the copyright claim would

¹⁵² Even casts and models made for industrial or non-artistic purposes can be considered “sculpture” and hence artistic works protectable by copyright: see *Wham-O Manufacturing Co v Lincoln Industries Ltd* [1985] RPC 130 (New Zealand Court of Appeal), where wooden models from which moulds for Frisbee discs were to be made (hence the wooden model was but one step in the process of manufacturing Frisbees) were held to be sculptures. On the other hand, the moulds were held to be engravings, and hence were another type of artistic work (following *James Arnold & Co Ltd v Miafern Ltd* [1980] RPC 397). *Quaere* whether or not it matters if the alleged sculpture, if but a step in the production process and not being intended to have any permanent existence, would also qualify: see *Davis (J & S) (Holdings) Ltd v Wright Health Group Ltd* [1988] RPC 403, where plastic models meant as a step toward producing actual prototypes of dental impression trays were not considered sculptures as they were not produced for purposes of sculpture. However, *Wham-O* was referred to and followed by Falconer J in *Breville Europe plc v Thorn EMI Domestic Appliances Limited* [1995] FSR 77, who held that plaster casts made for the production of die-casting moulds, from which heating plates for toasters were to be made, were sculptures. Interestingly, Falconer J also referred to the same definition of “sculpture” as this writer: see *ibid*, and accompanying main text.

¹⁵³ *Supra*, notes 112-114 and accompanying main text.

¹⁵⁴ *Supra*, note 48.

probably have succeeded based on the fact that the original design drawings would enjoy artistic copyright.

Had that been the case, it would have created a situation where the plaintiffs would have been given the benefit of copyright protection in addition to their registered trade mark rights. We shall be comparing the protection afforded by both regimes in Part II of this article.¹⁵⁵

In the case of *Karo Step Trade Mark*,¹⁵⁶ the court had to consider the validity of a UK trader's registration of the KARO STEP mark for continental quilts in Part B of the UK Trade Marks Register. This had been challenged by a German body which had subsequently attempted to register the same mark in the UK. The mark in question was one that the German body did not itself use, it not being a trading body, but its members were German traders who used the mark for quilts; as such it was registered as an association mark in Germany. The UK proprietor obtained her quilts from these German traders, and had built up a substantial business in the UK in the quilts, which were sold bearing the KARO STEP mark. She had also taken out advertisements which emphasised the origin of her quilts as Germany. The evidence showed that at no time prior to her application to register the KARO STEP mark in the UK did the German manufacturers or association sell goods bearing the KARO STEP mark in the UK.

The judge decided in favour of the German applicants on several grounds. First, he concluded from the evidence, showing the way in which the UK proprietor conducted her business, that this was designed to give the impression to prospective purchasers that they would be buying a genuine German quilt. As such, the mark used on the goods must be accepted as a German manufacturer's mark, and it would therefore be neither capable of distinguishing nor in fact be distinctive of the UK trader's goods.¹⁵⁷ He then went on to consider further arguments related to copyright which had been brought up by the German party.

They had claimed that the mark in question, which had been specially designed and consisted of the words KARO STEP encased in a "circle within four arcs of circles which meet to form ... the character of a star", was an artistic work within the meaning of the Copyright Act.¹⁵⁸ Whitford J accepted this argument, holding that the mark was a drawing, in which artistic quality is irrelevant, and was not too simple as to be disentitled to copyright protection.¹⁵⁹ As the German association was the owner of the copyright residing in the mark, this would mean that any unauthorised use

¹⁵⁵ In particular, see *infra*, notes 205-231 and the accompanying main text.

¹⁵⁶ *Supra*, note 124.

¹⁵⁷ *Ibid*, at 272.

¹⁵⁸ *Ibid*, at 273.

¹⁵⁹ *Ibid*.

by the UK trader would amount to copyright infringement and thus be a use “contrary to law” under section 11 of the UK Trade Marks Act (the Singapore equivalent being section 15). That being the case, section 11 would prohibit the UK trader from lawfully registering the mark.

Moreover, the Trade Marks Act requires that the applicant for registration be the proprietor of the mark in question.¹⁶⁰ Based on the ownership of the copyright in the mark, Whitford J opined that another objection which could have been raised by the German association was that the UK trader could not possibly be in any position to claim to be the proprietor of the KARO STEP mark. Although the judge hastened to add that this did not mean the applicant has to claim property in the mark, it must still mean that he must have:

a proprietary interest in the sense that he has an absolute right to use it. Any such claim must, in my view, be bad if on copyright grounds some third person is going to be in a position to stop the applicant using the mark at all.¹⁶¹

He then stated that “[t]he proprietors of a mark in which copyright exists can, I think, only be the owners of the copyright in the mark.”¹⁶²

The *Karo Step* case was considered in the subsequent case of *OSCAR Trade Mark*,¹⁶³ where the Academy of Motion Picture Arts and Sciences (hereinafter “the Academy”), an American corporation which awarded gold statuettes commonly referred to as “Oscars” yearly to outstanding achievers in the motion picture industry, opposed the registration of a device mark bearing the word “Oscar” next to a representation of a similar statuette in silhouette. They had also applied to rectify the register in respect of two other marks consisting of the word “Oscar”.

Mr Myall, in the Registry, held that the Academy had not proven that they were the copyright owners in the statuette whose silhouette had been used in the respondents’ trade mark application. As such, it was unnecessary to consider whether such a use would be a breach of copyright, which, had it been the case, Mr Myall would have followed *Karo Step* and held that this would have disclosed a valid ground for opposition under section 11 of the Trade Marks Act for being a use “contrary to law”.

An interesting point which is raised by some of Mr Myall’s remarks concerns the question whether or not the copyright owner would first have to be successful in a copyright infringement action in order to succeed under

¹⁶⁰ *Supra*, note 30.

¹⁶¹ *Supra*, note 121, at 274.

¹⁶² *Ibid.*

¹⁶³ [1979] RPC 173.

section 11. Mr Myall, having held that in cases where it is asserted that there has been use “contrary to law” by virtue of another’s copyright, there must be infringement, went on to say that

[s]uch matters are not strictly within the Registrar’s province. Of course, it would be a different matter if there had been a ruling by the court on an action taken under the Copyright Act and the injured party, armed with that judgement took appropriate action under the Trade Marks Act to preserve or maintain his rights.

However, it has been argued that a prior judicial ruling ought not to be necessary when the circumstances are so clear that a *prima facie* case of copying can be shown to exist.¹⁶⁴ It is submitted that this approach is only logical, as it would otherwise necessitate the copyright owner to first go through the expense and effort of suing for copyright infringement, before he is able to mount a section 11 (our section 15) challenge.

While the mark which registration was opposed seemed to have been a device mark,¹⁶⁵ the marks in respect of which rectification was sought were pure word marks, consisting only of the word “Oscar”. It was held that:

the Academy can have no claim to copyright in this word so that the matters that fall to be considered are free of any complications introduced in that respect that might affect the operation of section 11 and the proprietorship of the mark.¹⁶⁶

¹⁶⁴ See H Pearson, “The Oscar Trade Mark – an Award Winning Opposition – in the End”, [1979] 6 EIPR 170, who suggests that such a ruling may be necessary when “there was a substantial dispute on the facts as to whether the mark was a reproduction or whether copying took place” (at 170-171).

¹⁶⁵ Interestingly, Mr Myall accepted that copyright, if any, subsisted in the statuette as a sculpture (at 178 of the judgement). As such, supplying the public with photographs and engravings of a model of a sculpture, would not have constituted publication (this is also the position in Singapore: see s 24(3), Copyright Act). The copyright claim failed as reproductions of the work had not been supplied to the public such as to constitute “publication” for purposes of acquiring copyright (see the judgement at 179). See also Pearson, *ibid.*, and P Prescott, “The Oscar Trade Mark – Was the Decision Correct?”, [1980] 11 EIPR 374.

¹⁶⁶ It should be noted that in the rectification proceedings, the court has to first consider if the applicant for registration is a “person aggrieved”, a preliminary point that is unnecessary in opposition proceedings: see *OSCAR Trade Mark*, *supra*, note 113, at 183-186 and the *AUVI* case at 649-655, discussed *infra*, at notes 167-190 and the accompanying main text. It would appear that the Academy in the *OSCAR* case were held not to be a “person aggrieved” as it had not suffered (nor was it likely to suffer) damage to its reputation (*inter alia*) by reason of the respondents’ registration. In the *AUVI* case, Chao J discussed the *OSCAR* decision and distinguished it on the basis that the Academy did not have sole proprietary rights in the word “Oscar” (unlike the applicants in *AUVI*). It is submitted that the limitation

It is submitted that this example illustrates the difference between a trade mark that is protected by copyright (such as a device mark protected by artistic copyright) and one that is not (such as a single word which would be unlikely to acquire any literary copyright).

Both the *Karo Step* and *OSCAR Trade Mark* cases were discussed by Chao Hick Tin J in the Singapore case of *Re AUVI Trade Mark*.¹⁶⁷

The positions of the parties in the *AUVI* case can be said to be similar to the parties in the *Karo Step* case in that the applicants for revocation of the *AUVI* mark were not themselves using the mark as a trade mark. However, unlike the German association, the applicants in the *AUVI* case did not themselves wish to register it as a trade mark. Indeed, they could not possibly do so even had they wished to, as they did not trade in goods using *AUVI* as a trade mark. Instead, they were the Singapore agents and distributors for several foreign brands of high fidelity equipment, and used the specially-designed logo incorporating the company name merely as a logo in advertisements and on stationery. The use would thus not fall within the requirement of the Trade Marks Act that the mark be one used to indicate a connection in the course of trade between the trader/proprietor and the goods marked with the trade mark.¹⁶⁸ The logo had been created by another party who had subsequently assigned his copyright in the logo to the applicants.

The mark that was registered by the respondents was very similar in appearance to the applicant's logo. The respondents were manufacturers and sellers of electronic equipment which were sold bearing the *AUVI* mark. They were therefore engaged in the same industry as the applicants' business.

The basic objection raised by the applicants was similar to the copyright arguments made in the *Karo Step* case, *ie*, the applicants claimed they had artistic copyright in their corporate logo, which was infringed by the respondents' use of a similar mark. Such use would be "contrary to law"

in the *OSCAR* case of "person aggrieved" to the question of damage, and the mention, by Mr Myall, of persons without "trading interest in the goods concerned" (at 184 of the judgement) is probably more restricted than Chao J's interpretation of the same phrase in the *AUVI* case: see discussion *infra*, note 178 and the accompanying main text.

¹⁶⁷ *Supra*, note 13.

¹⁶⁸ Ss 2 and 12, Trade Marks Act; *supra*, notes 30-31 and accompanying main text. *Quaere* whether or not the applicants could have registered the logo as a product trade mark for their stationery, on the basis that the stationery was essential, rather than incidental, to their business as distributors of high-fidelity equipment (an argument similar to the reasoning in *VISA Trade Mark* [1985] RPC 323). *Quaere* also whether or not, since the amendment to our Trade Marks Act to permit the registration of service marks, the applicants could have registered the logo as one: see s 2, Trade Marks Act, and the possible problems with registering service marks raised by *Dee plc's Application* [1989] 3 All ER 948. Note, however, that the United Kingdom provisions on service marks as discussed in the *Dee* case differ somewhat from Singapore's.

under section 15(1) of the Trade Marks Act and hence could not be lawfully registered by the respondents. The applicants also relied on Whitford J's opinion that, as they were the copyright owners, the respondents could in no way claim to be the proprietors of the mark as required by section 11 (which section, at the time, dealt with the question of proprietorship, now section 12).

In arriving at his decision, Chao J thus had to rule on the copyright claim put forward by the applicants in order to determine whether or not the trade mark could be expunged on these grounds. This case illustrates clearly the closeness of the copyright/trade mark relationship and it would therefore be appropriate to outline the learned judge's approach at this point.

Chao J summarised the issues he had to decide thus:¹⁶⁹

- (1) Was the AUVI mark created independently by the respondents or was it copied from the applicants' logo?
- (2) If the latter, was the logo then an original artistic work protected by the Copyright Act 1987?
- (3) Were the applicants "persons aggrieved" as required by section 39(1)(a) of the Trade Marks Act in order to bring rectification proceedings?
- (4) If so, was the applicants' case that the mark was an "entry made without sufficient cause" affected by the fact that at that time they were the equitable and not the legal owners of the copyright?
- (5) Was there any delay on the applicants' part in bringing these proceedings such as to enable the court to exercise its discretion not to remove the mark from the register?

On the first issue, Chao J decided that the respondents had copied their mark from the applicants' logo. There was a high degree of substantial similarity between the two (which had been admitted by the respondents) and this raised a *prima facie* inference of copying which the respondents had failed to rebut. The fact that their mark was not an exact copy could still lead to a finding of copying in law.¹⁷⁰

On the second issue, the learned judge ruled that the logo was an original artistic work which would be protected by copyright.¹⁷¹ There appears to

¹⁶⁹ *Supra*, note 13, at 645.

¹⁷⁰ *Ibid*, at 648.

¹⁷¹ *Ibid*, at 649.

have been no dispute as to the category of work the logo would fall to be considered under; the respondents seem to have accepted that the logo would be within the rubric of “artistic work”, their arguments relating only to its lack of originality. It is tempting to contemplate the possibility of the respondents’ arguing that the logo ought properly to be considered a literary work. After all, their actual arguments relating to lack of originality point out that the logo “contains nothing more than just embellishments of four ordinary letters of the alphabet”. It is possible to see in this argument similarities to the *Exxon* case. This would thus involve the respondents alleging that AUVI, being “an invented word with no meaning ... a typical subject for trade mark registration” (*per* Graham J in the *Exxon* case),¹⁷² could not possibly enjoy copyright as an original literary work for the reasons given in that case by Stephenson LJ.

However, it is submitted that even if the respondents in this case had attempted to argue that the AUVI logo is more properly a case for literary copyright, they would probably still have failed on this issue. This is due to several reasons.

First, it may be argued by the applicants that although AUVI is a single invented word, it is embellished and stylised in such a manner that it resembles the mark in the *Karo Step* case (where the device was considered as an artistic work) and hence would still enjoy copyright, unlike the word *Exxon*, which does not appear from the case report to have been embellished in a similar manner but was created for use as a company name. This scenario reveals the possibility that people wishing to claim artistic, rather than literary, copyright in single words or combinations of letters forming a word, would simply have to embellish the word so that it can be considered a “drawing” and hence an “artistic work”, irrespective of the artistic quality. This state of affairs results from the lack of comprehensive legislative guidance in determining what constitutes a “drawing”,¹⁷³ and the statutory principle that artistic merit is irrelevant for such works.

¹⁷² *Supra*, note 67.

¹⁷³ However, reference should be made to the case of *Anacon Corp Ltd v Environmental Research Technology Ltd* [1994] FSR 659, where Jacob J held that circuit diagrams indicating the components for a circuit board and accompanied by written information on each component were both artistic and literary works. On the latter point, he considered that the diagram was “all written down and contains information which can be read by somebody, as opposed to appreciated simply with the eye” and was thus “an engineer’s notation” (at 663). While the definition in the English copyright legislation of “writing” (that is “includes any form of notation or code”) differs from the Singapore definition (where it “means a mode of representing or reproducing words, figures or symbols in a visible form ...”), it is submitted that where diagrams similar to those in *Anacon* are concerned, Jacob J’s reasoning may still be applicable. This could be due to the nature of such diagrams, where the finished product looks nothing like the two-dimensional diagram; in such situations,

However, it is worth noting that in the *Exxon* case, the plaintiffs had in their statement of claim declared that it had set out to “devise and select a new name *and trade mark*”¹⁷⁴ (emphasis added). Graham J also appears to have assumed that the plaintiffs could have registered the word as a trade mark. It would thus appear that if the word Exxon was plainly written as it is spelt, without embellishment, it would be registrable as a trade mark only if it were an “invented word”, or “any other distinctive mark”, for if it were to be registrable by the fact of its being the company’s name, it would have to be “represented in a special or particular manner”. This seems to further emphasise the difference between classifying a work as literary or artistic for the purposes of copyright, for it would appear that this classification underlies and determines the categories for distinctiveness under the trade mark system as well.

The second reason that an argument based on literary copyright would probably fail would follow from an acceptance of the first reason outlined above. If an embellished single invented word can be considered a drawing and hence an artistic work, it is clear that it would be preferable to opt for artistic rather than literary copyright. The reason for this has already been discussed previously:¹⁷⁵ briefly, this is because it appears to be easier to acquire artistic copyright than literary copyright, at least in cases where the work would be an Exxon-type work for literary copyright.

Having accepted that the AUVI logo was a drawing and hence an artistic work, the learned judge went on to hold that it was sufficiently original to be protected by copyright. He considered the question whether or not the logo could be said to be too simple to attract copyright, and answered this in the negative; saying that barring cases of “naked and barren simplicity,”¹⁷⁶

The cases would appear to show that simplicity *per se* does not prevent a work from acquiring copyright ... it is always a question of determining whether he has put in sufficient skill and labour to justify copyright protection for his result.¹⁷⁷

The applicants’ logo was therefore protected by copyright. The question then remained one of whether by virtue of this, they were therefore entitled

the reasoning in *Anacon* could be seen as no more than an application of the discussion of the importance of the visual significance of an artistic work in *Interlego v Tyco* (discussed *supra*, note 131).

¹⁷⁴ *Supra*, note 66, at 243.

¹⁷⁵ See *supra*, notes 123-134 and the accompanying main text.

¹⁷⁶ *Supra*, note 13, at 648.

¹⁷⁷ *Ibid.*

to ask the court to expunge the respondents' trade mark. This brought Chao J to the third issue.

He decided that the applicants were "persons aggrieved" and could hence bring proceedings for rectification under section 39(1)(a) of the Trade Marks Act. The respondents had argued that as the applicants did not trade in goods to which the mark had been applied, simply being the copyright owners of the mark did not *per se* make them aggrieved parties. This argument was rejected by Chao J, who felt that having a real interest in protecting the copyright in the logo would suffice to render the applicants as aggrieved persons. The fact that the two parties were not trade rivals, in the sense that the applicants were not also trading in goods with the same mark, did not militate against the applicants, as Chao J in reviewing the cases concluded that none of them had attempted to give a definition of the phrase when the legislature had deliberately not done so. In particular, the *Karo Step* case fortified the learned judge in holding that a person did not actually have to trade using the mark to be an aggrieved party. That case also supported his conclusion that an alternative action in copyright infringement did not preclude the copyright owner from also having a remedy under the trade mark regime.¹⁷⁸

On the fourth issue of whether or not the applicants had to be the legal owners of the copyright in the logo at the time of its registration by the respondents, Chao J decided that the assignments through which the applicants subsequently acquired full legal ownership retrospectively vested the copyright in them. This, added to the fact that, while they were equitable owners, they could have called for the assignment at any time, meant that the right assigned to them to sue for infringement included asking for relief in the form of rectification of the register.¹⁷⁹ He then proceeded to state an alternative ground for his decision on this point.

This was based on the fact that the applicants had actually been granted leave to amend their motion to add another ground for rectification; *viz*, that the respondents' mark was one "wrongfully remaining on the register". This therefore meant that the relevant date would be the date of commencement of the proceedings, and not the date on which the entry was made. In that case the applicants were by the commencement of proceedings clearly the legal owners of the copyright. The learned judge therefore considered this fourth issue to be "academic".¹⁸⁰ While this may have been so on the facts and issue in the *AUVI* case, it should be noted that the facts upon which a court determines whether an entry is one "made without

¹⁷⁸ *Ibid*, at 655.

¹⁷⁹ *Ibid*, at 656.

¹⁸⁰ *Ibid*, at 656-657.

sufficient cause” (as the applicants also alleged) or one “wrongfully remaining on the register” can be different. This difference arises from the House of Lords decision in the *General Electric* case.¹⁸¹

In that case, Lord Diplock considered that a trade mark could be expunged on the ground that it wrongfully remained on the register where there was some blameworthy conduct on the part of the proprietor occurring since the date of the original registration.¹⁸² This type of situation would not be covered by section 41 of the UK Trade Marks Act (the Singapore equivalent being section 48), which only barred removal of a trade mark after seven years on grounds of fraud or invalidity pertaining to the original registration itself.

The learned judge came to this conclusion having decided certain matters. First, he stated that section 32(1) of the UK Trade Marks Act 1938 (the Singapore equivalent being section 39(1)) permitted removal of a trade mark, whose original registration may have been lawful, from the register, where another provision in the Act would prohibit its remaining on the register. These other prohibitory provisions need not be limited to those which expressly conferred a power of removal. At this stage, this would clearly include provisions such as section 11 (our section 15(1)) which prohibited the registration of a trade mark which, “by reason of its being likely to deceive or cause confusion..., [would] be disentitled to protection in a court of justice”. It should be noted that, in interpreting section 11, Lord Diplock appeared to consider that, linguistically and otherwise, the mere fact of likelihood of deception or confusion could not, without more, *ipso facto*, disentitle a mark from protection.¹⁸³

Secondly, Lord Diplock construed section 11 itself. He held that despite the use of the words “It shall not be lawful to register...” in the opening words of that section, it could apply both to the original entry of a mark as well as its subsequent removal. He arrived at this conclusion through a consideration of the legislative history of this provision as well as an examination of the language used by the draftsman in this section.

At this stage, the court had to consider if the trade mark that was alleged to be “wrongly remaining on the register” could be expunged for falling foul of section 11. Lord Diplock did not consider the earlier case of “*Bali*” *Trade Mark*¹⁸⁴ to be helpful on this point, as he stated that that case was concerned with whether or not a trade mark had been entered without sufficient cause, thus rendering the relevant time there to be the making of the original entry. In the present case, the court was only concerned

¹⁸¹ [1973] RPC 297. See also s 39(1)(a), Trade Marks Act and Cornish, *supra*, note 4, at 460.

¹⁸² *Ibid.*, at 335.

¹⁸³ *Ibid.*

¹⁸⁴ *Supra*, note 23.

with events occurring since the original entry was made, which might amount to the trade mark now wrongly remaining on the register. The learned judge therefore made the distinction between the two grounds upon which an aggrieved party may ask for expunction of another's trade mark very clear.

His Lordship also relied upon several earlier cases to support his conclusion that section 11 could cover situations of deceptiveness subsequent to registration, where he considered the question to then depend on whether or not such deceptiveness resulted from the trade mark proprietor's conduct, or was a result of events beyond his control.¹⁸⁵

The *General Electric* case was not referred to in Chao J's treatment of the fourth issue in the *AUVI* case. This is perhaps unfortunate. Since Chao J accepted that the relevant time to consider whether a trade mark was one that wrongly remained on the register was the commencement of proceedings, this clearly marks an acceptance of Lord Diplock's distinction between an entry made without sufficient cause, and one that wrongly remains on the register. However, as the *General Electric* case was not cited, it is not clear whether or not Chao J would also have followed Lord Diplock, in accepting as relevant to the latter situation, events occurring not only at the time proceedings were commenced, but also events which may have occurred at any time subsequent to the registration of the *Auvi* mark, up to the time of the proceedings. There seems no reason why Chao J's remarks¹⁸⁶ should not be read to encompass this, rather than be restricted to events occurring only at the time of commencement of proceedings.

However, another problem which arises from the lack of reference in the *AUVI* case to the *General Electric* case is the question of whether a Singapore court would also require blameworthy conduct on the part of the proprietor (in this case the respondents) before permitting expunction on the additional ground cited by the applicants for removal. If so, this would clearly require the court to examine the respondents' conduct since their registration of the *Auvi* trade mark, a factor which, being irrelevant to the original ground for expunction, was not elicited on the evidence.¹⁸⁷

On the fifth issue of whether or not the court would exercise its discretion in matters arising under section 39(1) in favour of the respondents, and rule that the device mark be varied to a word mark, Chao J held that to do so would "involve a change which substantially affects the identity of the mark"¹⁸⁸ and thus contravene section 38 of the Trade Marks Act. Further, he held that the respondents had not convinced him to exercise

¹⁸⁵ See generally, *supra*, note 181, at 322-335.

¹⁸⁶ *Supra*, note 179.

¹⁸⁷ The current Singapore law on this point would appear to follow Lord Diplock's reasoning in the *General Electric* case: see, *eg*, *Re "Aloha Swanfu" Trade Mark*, *supra*, note 24.

¹⁸⁸ *Supra*, note 13, at 657-658.

his discretion in their favour, the applicants not having unduly delayed their action.¹⁸⁹

Finally, the learned judge stated that in the light of his conclusions,

the respondents cannot claim to be the proprietors of the Auvi mark ... [which] ought not to have been registered as provided in section 15(1), because the use of that mark [by the respondents] would be contrary to law, *ie*, an infringement of the applicants' copyright: see *Karo Step Trade Mark*.¹⁹⁰

Based on the reasoning employed by Chao J, this conclusion is inevitable, and serves as a confirmation of the *Karo Step* case. The significance of the *AUVI* case for the purposes of the present discussion can be summarised thus:

- (1) A single word, if sufficiently stylised or embellished, may be treated as an artistic work for copyright purposes. This avoids the tests, and, indeed, the difficulties, presented by the *Exxon* case in relation to single words being dealt with by literary copyright.
- (2) Whether the subject matter acquires copyright protection or not does not affect the acquisition of trade mark rights, which requirements as laid down in the Trade Marks Act makes no reference to copyright. Indeed, the presumptions of distinctiveness for a Part A mark found in section 10 seem to suggest that single words are not precluded from trade mark protection. Thus, *eg*, the name of a company or person, if embellished in such a manner as to be "represented in a special or particular manner", would be presumed to be distinctive under section 10(1)(a) of the Trade Marks Act. Similarly, the use of the phrase "word or words" in both section 10(1)(c) and section 10(1)(d) would bear out this conclusion.

However, titles made up of non-invented or descriptive words, other than specially-represented names of companies or individuals or signatures, would not be registrable under any of the presumed heads of distinctiveness under section 10(1). It would also be unlikely that these could be registered upon proof of distinctiveness under section 10(1)(e), as they would be unlikely

¹⁸⁹ *Ibid.*

¹⁹⁰ *Ibid.*, at 657.

to fulfil the cumulative requirements of inherent and factual distinctive adaptability.¹⁹¹ Thus titles of books not made up of invented words, such as “Little Women” or “Great Expectations” would likely not be registrable trade marks, should the author wish to trade in goods or services under these titles, unless these titles are not descriptive of the goods or services, *eg*, “Little Women” for portable radios. However, it is submitted that in the majority of cases where there may be an overlap between copyright and trade mark protection, this type of scenario would be uncommon, as most cases would be concerned with the exploitation of invented words or names. (*eg*, Karo Step, Exxon).

- (3) If the mark in question would also be the subject of copyright, then no one other than the owners of the copyright in the mark can claim to be the proprietors of the mark. It would then follow that only the copyright owner is entitled to apply for trade mark registration under section 12 of the Trade Marks Act. This being the case, it is possible under the present laws for copyright owners to acquire cumulative trade mark protection.
- (4) Moreover, the copyright owners need not themselves be trade mark proprietors to be protected under the Trade Marks Act. This is clearly illustrated by the facts of the *AUVI* case, where the applicants could not possibly have registered their company logo as a trade mark, as they did not trade in goods under that mark. However, by simply being the copyright owners, they could prevent others from registering a similar mark if the use of that other mark would amount to an infringement of the copyright in the first mark or logo, and thus be non-registrable for being “contrary to law” under section 15(1).
- (5) Alternatively, arising from (3) above, the copyright owner could simply allege that the other party could not claim to be the proprietor of the mark, and thus have no right to apply for registration by virtue of the wording of section 12 of the Trade Marks Act.
- (6) Yet another point which could be raised by copyright owners would be the question of deception or confusion under section 15(1). This would be the issue raised by most aggrieved parties

¹⁹¹ *Supra*, note 59, and the cases mentioned therein.

(not necessarily copyright owners themselves) objecting to a trade mark either being registered, or remaining on the register. Then, according to the reasoning in the *General Electric* case, the time frame would, for the former, be the time the entry was originally made; for the latter, the effect of events subsequent to the original registration, which by some blameworthy conduct on the registered proprietor's part, caused the deception or confusion. There is nothing in the Trade Marks Act, nor the cases, to suggest that copyright owners could not avail themselves of this ground of objection as well. Indeed, it may be possible to say that deliberate copying and use of another's logo (as in the *AUVI* case) could point to blameworthy conduct. However, this factor would be relevant only to proceedings based on events subsequent to the registration of the trade mark; a copyright owner wishing to attack the initial registration would not be required to adduce evidence of blameworthy conduct on the applicant's part.

It is therefore submitted that the copyright and trade mark laws of England and Singapore permit the acquisition of cumulative copyright and trade mark protection. The consequences of such an approach will be examined in the next Part.

PART II: CONSEQUENCES OF CUMULATIVE PROTECTION

It has already been pointed out at the beginning of this article that the award of intellectual property rights is intended to give the owner of these rights an exclusive monopoly over the commercial exploitation of the result of his efforts. It would therefore seem an obvious inference that awarding one person such rights under more than one regime (*eg*, in both copyright and trade marks), could lead to an expanded commercial monopoly. However, it does not necessarily follow from the principle of cumulative protection that there is thus considerable overlap, or even duplication of functions, under both regimes. Any attempt to examine this possibility necessitates further enquiry into and comparison of the consequences of dual protection.¹⁹²

The owner of any copyright which subsists in a work would be entitled to all the exclusive rights conferred by the Copyright Act.¹⁹³ For all authors' works, they would be entitled to:

¹⁹² *Eg*, in a case of copyright and trade mark infringement as well as passing off, it would be highly unlikely that the plaintiff would recover damages for all three actions separate and independent of one another. Instead, it is probable that the court in assessing damages for each action would take into account the fact of recovery of losses under the other actions as well.

¹⁹³ See s 26, Copyright Act.

- (i) reproduce the work in a material form;
- (ii) if the work is unpublished, publish the work in Singapore or another country in relation to which the Copyright Act 1987 applies;
- (iii) include the work in a cable programme.

For literary, dramatic and musical works, other exclusive rights are the rights to:

- (i) perform the work in public;
- (ii) broadcast the work;
- (iii) make an adaptation of the work;
- (iv) do any of the six acts listed above in relation to an adaptation of the work. This would thus include the right to make a further adaptation of the first adaptation.

These latter three exclusive rights are not available to copyright owners of artistic works. It seems clear that the Copyright Act assumes that an artistic work as defined in section 7(1), whether in two- or three-dimensions, would not be capable of public performance.¹⁹⁴

Similarly, given the definition of “adaptation” in the Copyright Act which makes no reference to artistic works,¹⁹⁵ the adaptation rights enjoyed by literary, musical and dramatic works are not expressly awarded to artistic works. However, given the breadth of the concept of reproduction in a material form, it may be that this concept is actually wide enough to include

¹⁹⁴ However, increased experimentation and liberalisation in the arts have led to the development of an art form, popularly called “performance art”, which does not seem to fit into any of the definitions of “artistic work” under the current Copyright Act. Performance art appears, by its nature, to be intended for display in front of a live audience and often involves movement and other forms of theatrical expression. As such, it would probably come within the definition of “performance” in s 22. *Quaere* whether or not such an art form would be considered a dramatic work; *quaere*, further, whether or not there would be a fundamental objection as to the “work”’s lack of existence in material form unless it is so reduced: see, eg, *Merchandising Corp of America v Harpbond* [1983] FSR 32. But *cf* the case of *Bookmakers’ Afternoon Greyhound Services Ltd v Wilf Gilbert (Staffordshire) Ltd* [1994] FSR 723, where the act of turning on a television monitor amounted to reproducing the plaintiff’s work in a material form.

¹⁹⁵ See s 7(1), Copyright Act.

some forms of adaptation of artistic works. Since the essence of an artistic work is its visual significance,¹⁹⁶ in order to infringe the plaintiff's artistic copyright, the defendant must have substantially reproduced¹⁹⁷ that which was visually significant about the plaintiff's work. So, *eg*, where a defendant, inspired by the plaintiff's photograph of a particular scene, recreates the scene using his own style, he may not have infringed the copyright in the photograph as the plaintiff cannot claim a monopoly over the natural arrangement of the scene or its features. The position would, however, be different if the "feeling and artistic character" of the plaintiff's work has been recreated; or, possibly, if the defendant copies the plaintiff's special composition or selection of features meant to achieve a particular effect.¹⁹⁸ Finally, also due to the fact that artistic works would primarily be those which have visual impact,¹⁹⁹ the broadcast rights are limited to that in relation to television, while for the other types of works, sound broadcasts are also within the range of exclusive rights.

Under the Trade Marks Act, registration would give the proprietor of the trade mark "the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered."²⁰⁰

In examining matter which may come within the purview both of copyright and trade mark law, it has already been noted that such matter, for copyright purposes, may be the subject of either literary copyright, artistic copyright, or in some cases, possibly both. Consequently, the problem, mentioned earlier, whether or not matter such as logos or stylised words (including signatures) fall to be considered as literary or artistic works, might be said to assume even greater importance, as the exclusive rights are different for literary and artistic works.

From the foregoing discussion, it is therefore clear that the following conclusions would apply to copyright owners of words, titles, logos, devices and other similar material registrable as trade marks:²⁰¹

- (1) If he also intends to use his copyright work as a trade mark, there is no express provision in either the Copyright Act or the Trade Marks Act which prohibits him from registering the copyright work as a trade mark and thereby obtaining dual protection.

¹⁹⁶ See *Interlego Industries A G v Tyco Industries Inc*, *supra*, note 131.

¹⁹⁷ See s 10(1)(a), Copyright Act.

¹⁹⁸ See *Baumann v Fussell* [1978] RPC 485. See also the discussion in *Copinger and Skone James on Copyright*, *supra*, note 1, at 189-190.

¹⁹⁹ *Supra*, note 131, at 968.

²⁰⁰ *Supra*, note 63.

²⁰¹ The discussion that follows seeks to examine the implications of each conclusion in greater detail.

- (2) If he does not intend to or otherwise cannot use the copyright work as a trade mark (for instance, the position of the applicants in the *AUVI* case), he may still prevent anyone else from registering as a trade mark a similar word, title, logo or device. As copyright owner, he would be considered an “aggrieved party” in any opposition or rectification proceedings. He could then assert any of the substantive grounds outlined in the summary section of Part I, all of which are based on the one common fact of copyright ownership.
- (3) Where the mark in question consists of a short phrase, title or word, it is probably difficult to assert literary copyright. However, if the same phrase, title or word were to be embellished, stylised or coupled with a drawing, it may then be possible to claim artistic copyright, for it may then be considered a device mark or logo rather than a pure word mark.
- (4) The requirement of distinctiveness under the Trade Marks Act, whether for registration in Part A or Part B of the Trade Marks Register, does not expressly distinguish between works of artistic and literary copyright. However, for Part A registration, the separation of the four presumed heads of distinctiveness may thereby separate marks which are the subject of artistic copyright, from marks which are the subject of literary copyright: *eg*, while the *AUVI* device mark, assuming that was the company name, may arguably qualify under section 10(1)(a) as the company name “represented in a special or particular manner”, if the mark were to consist solely of the word *AUVI* in simple print, it would more likely be dealt with under section 10(1)(c) as an invented word rather than under section 10(1)(a). Section 10(1)(c) and (d), of course, cover only word marks and hence would only extend to literary works.

Implications of the Conclusions

CONCLUSION (1)

The copyright owner will in many cases enjoy the benefit of protection under both copyright and trade mark regimes. In some instances, what amounts to trade mark infringement may also be tantamount to copyright

infringement.

Under section 45(1) of the Trade Marks Act, infringement is deemed to take place when:

any person who, not being the proprietor ... or a registered user ... uses in the course of trade a mark identical with or nearly resembling [the registered trade mark] in relation to any goods or services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken ...

- (a) as being use as a trade mark ... or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or is use at or near the place where the services are available for acceptance, or in an advertising circular or other advertisement issued to the public, as importing a reference to ... proprietor or registered user ... or to goods and services with which such a person ... is connected in the course of trade.

The division of the defendant's manner of using the trade mark into section 45(1)(a) and (b) clearly indicates that trade mark infringement covers not only instances where a defendant trader adopts the same or similar mark on his own goods or services (being goods or services for which the plaintiff proprietor has registered his trade mark) as a badge of origin. This type of "classic" trade mark infringement is dealt with by section 45(1)(a).²⁰² The wording of section 45(1)(b) makes it clear that certain situations that fall outside such "classic" cases would also constitute trade mark infringement.²⁰³ A common example would be the defendant reproducing the plaintiff's trade mark in a press advertisement lauding his own goods over that of the plaintiff's.

In both of these examples, the plaintiff proprietor may very often have an action in copyright as well. One of the exclusive rights conferred by the copyright regime is the exclusive right "to reproduce the work in a material form", which would include reproduction of a substantial part of the work.²⁰⁴ Thus, so long as the defendant copies a substantial portion of the plaintiff's copyright work, he will be liable as an infringer. It follows that a defendant who chooses to adopt the same trade mark or a closely similar one would be liable for copyright and trade mark infringement if, for example, he prints this chosen mark on his own goods. Equally, he

²⁰² See generally, Cornish, *supra*, note 4, at 471-478.

²⁰³ *Ibid*, at 478-480.

²⁰⁴ See s 10, Copyright Act.

may use a completely different trade mark, but if he runs a press advertisement reproducing the plaintiff's copyright trade mark, that too would infringe exclusive rights under both regimes.

It is also possible that one regime may afford a plaintiff copyright owner/trade mark proprietor protection where the other cannot. Some examples of such a result include:

(a) *Where there is no registered trade mark*

This is exemplified by the type of fact situation seen in the *AUVI* case, where, despite the lack of a registered trade mark, the fact of copyright ownership allowed the applicants to utilise trade mark provisions to remove the respondents' trade mark. Moreover, the local owner of the Singapore copyright may be a foreign trade mark owner who has yet to register his trade mark here; in fact, he may even not intend to do so as he may not intend to use the trade mark here and hence he would not be permitted to register it.²⁰⁵ Be that as it may, the fact that he owns the Singapore copyright in the trade mark in question might arguably put him in the same position as the applicants in the *AUVI* case. This result raises interesting questions about the extent to which a local court would be willing to consider the foreign trade mark owner an aggrieved party in rectification proceedings. Further, it also carries implications for the tort of passing off. Given that it may be difficult for the foreign trader (who has no business in Singapore) to succeed in an action for passing off against a local defendant, because he may be held lacking in the requisite goodwill,²⁰⁶ it may be some comfort to him that he can sue the local defendant for copyright infringement, as well as prevent him from registering the same trade mark for use locally.

These illustrations demonstrate that in some respects, copyright protection may be more advantageous than either passing off or registered trade mark protection; *eg*, the copyright owner need not prove he possesses any goodwill (in the sense required by passing off) in his copyright work to sue for infringement, nor must his work be distinctive (in the sense required by the Trade Marks Act). On this latter point, it is probably far less difficult, given the low threshold of originality in copyright law compared to the

²⁰⁵ The definition of a "trade mark" in s 2 of the Trade Marks Act requires that it is "used or proposed to be used in relation to goods and services" in order to establish the necessary trade connection. On the possible difficulties of the meaning of the phrase "proposed to be used", see *Imperial Group v Philip Morris* [1982] FSR 82. On the relationship between this phrase and the non-use provisions in s 40, Trade Marks Act, see *Re Aloha Swanfu Trade Mark*, and *Re Jaguar Trade Mark* [1993] 2 SLR 466, *supra*, note 24.

²⁰⁶ On this point, see Ng Siew Kuan, "Foreign Traders and the Law of Passing Off: the Requirement of Goodwill Within the Jurisdiction", (1991) SJLS 372.

requirement of distinctiveness under the Trade Marks Act, to acquire copyright protection. A further advantage of copyright protection may lie in the tougher, possibly broader, criminal offences created by the Copyright Act as compared to those under the Trade Marks Act.²⁰⁷

(b) *Where the defendant does not use the trade mark or reproduce the work in the course of trade*

The acts which are deemed to constitute trade mark infringement only cover the defendant's use of the same or similar trade mark while in the course of his trade.²⁰⁸ Presumably, this is because the aim of trade mark registration is to establish a trade connection between the plaintiff proprietor and his goods or services, and hence other traders would be forbidden from interfering with that trade connection by use of the same or similar trade mark while trading on their own account.²⁰⁹

On the other hand, any unlicensed reproduction of a copyright work, whether done privately or in the course of trade, would infringe the owner's exclusive rights. The general right of reproduction is therefore not restricted, under copyright, to commercial reproduction or trade. In fact, the infringement sections of the Copyright Act are laid out in such a way as to first incorporate a general act of infringement²¹⁰ (either by the defendant doing the infringing act himself or authorising it), followed by specific sections²¹¹ for unlicensed commercial dealings in copyright works.²¹²

(c) *Where the defendant uses the trade mark or reproduces the work on different goods or services*

The exclusive rights conferred by trade mark registration only extend to those goods or services for which the plaintiff proprietor has registered

²⁰⁷ Discussed in this Part, under comparison (f)(ii), "Criminal Sanctions", *infra*, notes 238-253 and the accompanying main text.

²⁰⁸ See s 45(1), Trade Marks Act.

²⁰⁹ *Supra*, note 63.

²¹⁰ See s 31, Copyright Act.

²¹¹ See ss 32, 33, Copyright Act.

²¹² This lack of restriction of infringement to commercial activity can help to explain the large number of sections in the Copyright Act which deal with defences, *eg*, defences for students and researchers (s 35), critics and reporters (ss 36, 37), and entire Divisions in the Act which deal with copying by libraries (Division 5), educational institutions (Division 6) and acts not constituting infringement (Divisions 3, 4 and 9).

²¹³ *Supra*, note 63.

his trade mark.²¹³ Thus if he registers a trade mark for soap but the defendant uses it for tinned foods he cannot assert his monopoly against such use. The trade connection is between the plaintiff and his soap product and therefore does not extend to tinned foods.²¹⁴

Under the copyright regime, there is no such limitation on the scope of the monopoly. The essence of infringement is the copying of the plaintiff's work without his permission by the defendant and therefore the focus is on whether there has been such copying or not, rather than the purpose of the defendant's doing so.

(d) *Copying not necessary for trade mark infringement*

The main limitation on the copyright monopoly in the realm of infringement centres round the concept of "copying". Hence, if the defendant's work, though substantially the same as the plaintiff's, is proved to be an independent creation, no infringement will have occurred.²¹⁵ On the other hand, under section 45(1) of the Trade Marks Act, there seems to be no restriction against a trade mark owner suing for infringement where a defendant may have coincidentally used the identical or closely similar mark.

(e) *Control over parallel imports*

Both the Trade Marks Act and the Copyright Act contain provisions which deal with the extent to which a local rights owner may prevent the market entry of "grey market" goods or "parallel imports".²¹⁶

The copyright position is governed by section 32, which reads:

The copyright in a literary, dramatic, musical or artistic work is infringed by a person who, without the *licence* of the owner of the copyright, imports an article into Singapore for the purpose of –

- (a) selling, letting for hire, or by way of trade offering or exposing

²¹⁴ This may be contrasted with the passing off action, where it seems clear that a "common field of activity" between the plaintiff and the defendant is not a requirement of the action; see *Mirage Studios v Counter-Feat Clothing* [1991] FSR 145, and H Carty, "Character Merchandising and the Limits of Passing Off", Vol 13, 3 Legal Studies 289.

²¹⁵ See Cornish, *supra*, note 4, at 287-289.

²¹⁶ There are many articles on this topic. See generally G Wei, "Parallel Imports and Intellectual Copyright in Singapore", (1990) 2 SAclJ 286, G Wei, "Competing with Yourself and International Businesses: Parallel Imports Revisited – Themes and Issues", a paper presented at Conference VII of the Singapore Conferences on International Business Law, 1994.

for sale or hire, the article;

... where he knows, or ought reasonably to know, that the making of the article was carried out without the *consent* of the owner of the copyright. (*emphasis added*)

Additionally, section 25(2) states, *inter alia*, that in regard to acts done without the licence of the copyright owner, the phrase “copyright owner” means the person entitled to the copyright in respect of their making in the country into which the articles are imported.

The meaning of and relationship between the phrases “licence of the owner of the copyright” and “consent of the owner of the copyright” is unclear, particularly as the same juxtaposition of phrases is also used in the definition in section 7(1) of what constitutes an “infringing copy” of a work. This issue was raised in the case of *Public Prosecutor v Teo Ai Nee*,²¹⁷ where the Singapore High Court decided that, based on the ordinary meaning of the words, the copyright owner whose consent (rather than licence) is required also referred to the copyright owner entitled to make the articles in the place where the articles are imported into. Thus, if articles are imported into Singapore, the relevant person whose consent would be in question would be the Singapore copyright owner.

This issue was finally settled in the Copyright (Amendment) Act 1994,²¹⁸ in which section 4 states that the identity of the person whose consent to the making of articles is required means “the person entitled to the copyright in respect of its application to the making ... in the country where the article was made” – this clearly refers to the copyright owner in the country of manufacture. However, where the imported articles were made in a country where there is no copyright owner, section 4 further provides that the relevant party whose consent is required means the person entitled to the copyright in Singapore.

As to the meaning of “consent”, this, too, is clearly spelt out in the Act in section 4 as follows:

and the making of the article shall be deemed to have been carried out with the consent of that owner if, after disregarding all conditions as to the sale, distribution or other dealings in the article after its making, the article was made with his licence (other than a compulsory licence).

²¹⁷ [1994] 1 SLR 452.

²¹⁸ No 14 of 1994. The Act came into effect as of 1 October 1994.

It is not within the reach of this article to attempt a full analysis of the effect of this provision. However, a reading of the provision would indicate that while the extent to which a copyright owner can control parallel imports is still related to the question of his “consent” to the making of the imported articles, the legislature has made it clear that what constitutes consent can be taken broadly.

In essence, the provision first identifies whose consent is necessary – if the articles are made in a country where there is a copyright owner, it is this party’s consent that is in question. If there is no copyright owner in the country of manufacture (*eg*, possibly because no copyright would subsist in that country), only then is the Singapore copyright owner’s consent in question.

Secondly, the provision goes on to determine what would constitute the requisite consent. Basically, it states that this will be satisfied once the articles are made with the relevant copyright owner’s licence, and any conditions which may pertain to dealings in the articles subsequent to their manufacture are not relevant.²¹⁹

It seems clear that this reading of the provision means that a Singapore copyright owner can do little against parallel importers, as most goods which can be described as “parallel imports” are genuine goods, and not fakes or unlicensed reproductions; the only difference with the local owner’s goods being usually that they are manufactured elsewhere, possibly by a parent company, or another subsidiary, or licensee. In this type of situation, it may be possible to argue that the relationship between the foreign and local copyright owner could itself give rise to implied consent on the part of the latter, an argument that is often used, successfully, in trade mark cases on parallel imports.²²⁰ Indeed, even prior to the Copyright (Amendment) Act 1994, the decision in the *Teo Ai Nee* case would still have permitted such an argument to be made.²²¹

Under the Trade Marks Act, the control of parallel imports is linked to two alternative factors, either that the local proprietor has himself applied the trade marks to the goods in question, or has consented, expressly or

²¹⁹ As to whether or not this provision ought to be read literally, see G Wei, “Competing with Yourself and International Businesses: Parallel Imports Revisited – Themes and Issues”, *supra*, note 216, at 29.

²²⁰ See *infra*, note 223-225 and accompanying main text.

²²¹ See the articles cited at *supra*, note 216.

²²² See s 45(3)(a), Trade Marks Act. It should be noted that the trade mark whose use must be consented to, is the trade mark registered in Singapore for the purpose of establishing the necessary trade connection in Singapore between the registered proprietor and his goods or services. Thus, even if the Singapore-registered trade mark is identical in all respects with the foreign trade mark (*ie*, the trade mark registered in the country of manufacture), they are legally distinct.

impliedly, to its use.²²² Once either factor is made out, the trade mark owner/ proprietor cannot sue the defendant parallel importer for infringement.

Unlike the position in copyright, there is no legislative guidance as to the meaning of “consent”. In the trade mark cases which have come before the courts on this issue, the position seems to be rather difficult for local rights owners who are subsidiaries of, or otherwise related to, foreign companies.

In *Revlon v Cripps*,²²³ the trade mark owner in the United Kingdom could not prevent parallel imports obtained by the defendant from the plaintiff’s parent company in the United States. The parent-subsidiary relationship would have made it impossible for the plaintiff to object should the parent company itself choose to export the goods to the United Kingdom, and therefore they were taken to have impliedly consented to the parent company’s use of the trade mark. This result was later followed in the Malaysian case of *Winthrop Products v Sun Ocean*.²²⁴

In *Colgate-Palmolive v Markwell Finance*,²²⁵ the question of consent was again raised, although this time, the defendant had obtained his goods from another subsidiary (in Brazil) rather than the parent company. The plaintiff, who was the subsidiary in the United Kingdom, succeeded in this case as the Brazilian subsidiary was bound under a limitation not to export to countries which already had a company subsidiary. It could not therefore be said that the plaintiff had impliedly consented to the use of the trade mark. In this case, the Brazilian subsidiary’s product was also of a different quality, and this difference went some way toward explaining the need for market separation.

Comparing the “consent” provisions of the copyright and trade mark regimes, the following points emerge:

- (a) The act to which the local rights owner has to consent to is different. For copyright, it is consent to the making of the imported articles. For trade marks, it is consent to the use of the trade mark (being the trade mark registered for use in Singapore) in relation to the goods. In many cases, the use in trade mark cases would be tied up with the making of the goods in question, in that it would be the same party who both makes the goods and uses the trade mark (eg, applies it or sells the goods under that trade mark in the foreign country); however, in principle, it can be seen as two different acts. Even so, it is submitted that this point would make little difference in practice. The importance of consent to the use of

²²³ [1980] FSR 85.

²²⁴ [1988] 2 MLJ 317.

²²⁵ [1989] RPC 497.

the trade mark in trade mark cases can be traced simply to the basis of awarding trade mark protection – that in use, it establishes a trade connection between the goods and the trade mark proprietor (being the person entitled to use the trade mark).

- (b) The copyright regime has expressly defined consent as a licence to manufacture irrespective of any limitations on dealings with the goods after they are made. In contrast, there is no such definition in the Trade Marks Act. Indeed, it can be seen from the case of *Colgate-Palmolive v Markwell Finance* that the limitation against export, which is surely a dealing with the goods after their manufacture, negated the possibility of consent. If one were to interpret the “consent” provisions on copyright literally, it may well be that Singapore copyright owners in cases where the original manufacture was subject to an express limitation, *eg*, against export, may not be able to sue parallel importers. It is therefore submitted that, on this point at least, the copyright regime may possibly be more liberal in allowing parallel imports than the current trade marks position.
- (c) Where there is a relationship between the foreign and local rights owners, such as parent-subsidiary or licensor-licensee, the “implied consent” argument would continue to be relevant in parallel import cases under both copyright as well as trade mark laws. The provisions of the Copyright (Amendment) Act 1994, in so far as they deal with acts not affecting the question of consent can, however, serve to highlight some of the difficulties of the “implied consent” argument, including the situation discussed in (b).²²⁶
- (d) The question of consent in copyright cases is a two-step process in that it is necessary to first enquire whether or not there is a copyright owner (being either the same person as, or distinct from, the Singapore copyright owner) in the country where the imported articles were made; it is only where there is no such party (or, possibly, where it is the same person) that the Singapore copyright owner’s consent to the original manufacture of the imported articles becomes relevant. In comparison, under the trade marks regime, it has been noted already that it is the trade mark proprietor’s consent which is relevant; it is also clear that the proprietor, being the person who would be entitled to use the trade mark,²²⁷ must

²²⁶ *Supra*, note 219.

²²⁷ *Supra*, note 30.

mean the Singapore rights owner.

- (e) Additionally, under section 32 of the Copyright Act, civil liability attaches only if the defendant, in these cases the importer, “knows or ought reasonably to know” that the articles which he is importing were made without the relevant copyright owner’s consent. This requirement is not a necessary element in liability for trade mark infringement by way of parallel importation. The trade mark owner therefore does not have to prove that the importer knew, or should have known, that the trade mark was used without the proprietor’s consent.
- (f) Finally, the burden of proof appears to be somewhat different under the two regimes. For copyright infringement by parallel importation, the copyright owner in Singapore has to prove, first, the unlicensed act of importation; secondly, the purpose for the importation; and thirdly, the defendant’s knowledge (actual or constructive) that the articles were made without the relevant copyright owner’s consent.²²⁸

In contrast, for trade mark infringement by parallel importation, the plaintiff proprietor would sue under the general infringement section, alleging that the defendant is deemed to have infringed his exclusive rights.²²⁹ He would therefore have to prove that the defendant, being neither the proprietor or a registered user conforming to his permitted use, has, while in the course of trade, used an identical or closely similar mark to his, in relation to goods or services for which he has registered his trade mark, in a manner falling under either section 45(1)(a) or (b). These elements are common to all trade mark infringement actions and are not, unlike copyright, specifically directed at parallel imports cases. At this point, the question of consent to the use of the trade mark may arise, as may the question of who applied the trade mark. However, the key difference between trade marks and copyright here is that this question arises by way of defence: if the defendant can show, *eg*, that the plaintiff consented, expressly or impliedly, to the use of the trade mark, then the plaintiff’s exclusive rights are not

²²⁸ See s 32, Copyright Act, read with s 4, Copyright (Amendment) Act 1994.

²²⁹ See s 45(1), Trade Marks Act. As to the relationship between the general words and the specific deeming provisions in this subsection, see *Bismag Ltd v Amblins (Chemists) Ltd* [1940] Ch 669 and the comments of the trial judge in *Chanel Limited v L’Arome (UK) Limited* [1991] RPC 335.

²³⁰ For a similar position in relation to imports of articles protected by patents which have been produced with the patentee’s consent, see s 66(2)(g), Patents Act 1994.

deemed to have been infringed.²³⁰

(f) *Other comparisons between the copyright and trade mark monopolies*

It may be instructive for copyright and trade mark owners to compare other areas which may also come within their monopoly, particularly where the rights owner may have a cause of action under both regimes. In this respect, the two most important would be the question of remedies in cases of civil proceedings under either regime, and the criminal provisions of both statutes. The discussion on remedies will focus on those available after the final rather than interlocutory proceedings.²³¹

(i) *Remedies in civil proceedings*

The most common remedies available to a victorious rights owner are those of damages, account of profits (which operate as an alternative to an award of damages), orders for delivery up and injunctions. Where these are equitable remedies, they will of course be a matter for the discretion of the court. However, both the Copyright Act and the Trade Marks Act contain express provisions which may affect the issue of remedies.

Under the Copyright Act, section 119(4) permits the award of additional damages where the court considers it proper, having regard to all relevant matters, including the flagrancy of the defendant's actions and the benefits obtained by him from the infringing act. It is therefore possible that the court may, in using its powers under this subsection, compensate the plaintiff for damage which may not be covered by common law damages. Moreover, this subsection allows the court to take into account benefits which the defendant may have obtained by reason of his infringing act, and possibly translate some of these benefits into the additional damages payable. It may even be possible that this subsection allows the court to impose punitive or exemplary damages in the proper case.²³²

In Singapore, this subsection was applied by the High Court in the case of *Novell Inc v Ong Seow Pheng*,²³³ where the defendants' conduct, including pricing their copies far below the plaintiffs' products and releasing them prior to the launch of the authorised products, allowed the court to conclude that the plaintiffs had thereby suffered additional losses that justified an inquiry into additional damages under section 119(4). The defendants had "displayed a calculated disregard of the plaintiffs' rights in their highly

²³¹ See generally, Ng Siew Kuan, *supra*, note 4; Wei, *supra*, note 31.

²³² See Dworkin and Taylor, *supra*, note 73, at 118-119.

²³³ [1993] 3 SLR 700.

²³⁴ *Ibid*, at 708.

profitable pursuit of pecuniary benefit ... [which had lead to the plaintiffs suffering] additional loss that [was] difficult to compensate.”²³⁴

One interesting point that arises is that the order for the inquiry into damages allowed the plaintiffs to opt for an account of profits instead. This seems to imply that, just as an account of profits is generally an alternative to an award for damages, the Singapore courts will still follow this principle when exercising their discretion in awarding additional damages under section 119(4), such that additional damages cannot be combined with an account of profits.²³⁵

The Trade Marks Act does not have an equivalent provision. Hence, where a plaintiff may sue for infringement under either copyright or trade marks laws, there may be certain cases where the additional remedy in section 119(4) may be available to him should he choose to sue in copyright. He would not have the option of pleading for additional damages should he sue for trade mark infringement instead. There, presumably, the measure of damages will be based on the principle of compensation (subject, possibly, to other principles such as remoteness of damage) for his losses such as lost sales, although it is arguable that compensation can also include damage to reputation, *eg*, if the defendant’s products are of lower quality.²³⁶

Aside from the courts’ inherent power to order delivery up of infringing material for the purpose of destruction, section 120 of the Copyright Act states that in lieu of such an order, the court may order that the defendant pay “just and equitable” damages. It is, however, not clear what would constitute “just and equitable” damages, nor is the relationship between such an award and the award of additional damages under section 119(4) further elaborated on.²³⁷ In any event, this is another relevant consideration for a plaintiff suing in copyright, as such damages would not be available in a case of trade mark infringement. An account of profits, if pleaded for, would operate only as an alternative to damages, such that in this respect at least, both copyright and trade marks law are similar.

²³⁵ However, it should be noted that the the terms of the orders relating to damages in the various suits heard before the learned judge varied slightly. In regard to the computer programmes and manuals, Clause 6 gave the plaintiffs an option between an inquiry as to damages and an account of profits, while Clause 7 was an apparently independent order of an inquiry into additional damages under both ss 119 and 120 of the Copyright Act. In regard to the floppy disks and the remaining manuals, there was only one clause dealing with damages and account of profits, to the effect of ordering “an inquiry as to damages including additional damages under s 119 and s 120 of the Act or at the plaintiffs’ option an account of profits”: *ibid*, at 708-709, 710-711.

²³⁶ See Kerly, *supra*, note 116, at paras 15-78 to 15-82.

²³⁷ In the *Novell* case, in ordering an inquiry as to damages including additional damages, Punch Coomaraswamy J did so under both ss 119 and 120: see *supra*, note 233. This could mean that the learned judge considered the same factors to be relevant in ordering both additional damages under s 119(4) and s 120(b), a situation that is not entirely satisfactory.

Both copyright and trade marks statutes also provide for partial defences in the award of remedies. Under section 119(3) of the Copyright Act, damages are not awarded if the defendant can prove that he was not aware and had no reasonable grounds for suspecting that the act constituted copyright infringement. For trade mark infringement, the defence is rather different. section 46(2) provides that

... no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

In addition, it is clear that this defence is only available against Part B trade marks. Thus, three differences between such defences for copyright and trade mark infringement may be discerned.

First, the basis of denying relief works rather differently. For copyright, the question is that of the defendant's innocence, regardless of the effect of the copying. For trade marks, the yardstick is the perspective of the public – regardless of his motives or knowledge, the question is whether or not his actions may result in public deception or confusion, or in the possible mistaking of a trade connection where there in fact is none.

Secondly, the copyright defence is concerned only with the question of damages while the trade marks provision is in issue for “injunction or other relief” as well.

Thirdly, section 120 of the Copyright Act may be pleaded against all copyright owners but section 46(2) of the Trade Marks Act is not applicable to owners of Part A trade marks.

(ii) *Criminal Sanctions*

Both copyright and trade marks statutes contain express provisions dealing with criminal liability for certain acts. In general, under both regimes, the offences so created involve cases of commercial exploitation and dealings in copyright or trade mark matter.

For example, in copyright, commercial activities such as manufacturing, selling, hiring and importing infringing copies attract punishments on conviction of either a fine (\$10,000 per infringing copy or a sum of \$100,000 whichever is less), or imprisonment (up to five years), or both. However, the offence depends on whether or not the defendant knew

²³⁸ See generally Division 5 of the Copyright Act, and specifically, s 136.

or ought reasonably to have known that the article(s) in question was/were infringing copies.²³⁸

For trade marks, importing, selling, exposing or possessing for sale or for other specified trade purpose, goods or things to which either a counterfeit trade mark has been applied, or to which a registered trade mark has been falsely applied, carries a similar punishment as the copyright offences described in the above paragraph. However, the defendant will be acquitted if he can prove that:

having taken all reasonable precautions against committing an offence ... he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark ...

In addition, he must also show that “he gave all the information in his power with respect to the persons from whom he obtained the goods” to the prosecution.²³⁹

Other copyright offences include distributing infringing copies for purposes of trade, possessing infringing copies for purposes of trade, manufacturing or possessing plates for purposes of infringement, and causing public performance of a copyright work.²⁴⁰ In all of these cases, the question of whether or not the defendant knew or ought to have known about the purpose or nature of the articles in question is also relevant.

For trade marks, counterfeiting a trade mark, or making or possessing instruments for counterfeiting purposes, are offences.²⁴¹ Interestingly, there does not appear to be any requirement of *mens rea* on the part of such a defendant.²⁴²

In addition, the false application of a trade mark to services is an offence under section 73A. However, this section, like section 73 which deals with commercial dealings in goods, makes allowance for a defendant who “proves that he had acted innocently”.

It can therefore be seen that, in relation to criminal offences, both regimes clearly frown on unlicensed commercial dealings with the copyright or trade mark. In the former case, this may be dealings with the actual infringing copies while in the latter case, it is the nature of the use and

²³⁹ See s 73, Trade Marks Act. This section also allows for a separate defence of innocence, discussed extensively in *Trade Facilities & Others v Public Prosecutor* [1995] 2 SLR 475, discussed *infra*, at note 232 and the accompanying main text.

²⁴⁰ *Supra*, note 238.

²⁴¹ See ss 70-72, Trade Marks Act.

²⁴² It may, however, be possible to argue that given the gravity of the offence disclosed by s 72, and the nature of the remarks regarding counterfeiting in *Ng Chye Mong v PP* [1988] 2 MLJ 150, that some *mens rea* may well be required: see *Wei, supra*, note 31.

abuse of the trade mark rather than the articles to or in relation to which the trade mark is applied or used that is generally in question. This may explain the arguments in cases such as *Ng Chye Mong v Public Prosecutor*²⁴³ to the effect that no offence relating to trade marks is committed where the trade mark was applied to genuine goods.²⁴⁴ This difference between copyright and trade marks obviously stems from the nature of the thing protected under each regime – where copyright protects the whole article which is subject to copyright (whether that be the title of a book or the book itself), trade mark registration is concerned with the badge of identity which is to be used to establish the necessary trade connection between the proprietor and his goods or services. In relation to words, titles, short phrases, logos and devices, therefore, the criminal offences created by copyright law would probably have little impact, save for the possible situation where any of these works are part of a greater work such as a book.

An interesting question in relation to whether or not a trade mark offence has been committed can be raised when the facts disclose that the trade mark in question, being also an artistic work that enjoys copyright protection, is reproduced without the proprietor's permission and then applied to goods which are sold. The act of reproduction without the copyright owner's permission would constitute copyright infringement as well as, possibly, a criminal offence under section 136 of the Copyright Act. This would be the case, *eg*, if the infringer "makes [the reproduction] for sale or hire" with the requisite knowledge, or if he, or another to whom he passes on the copies, then possesses these copies for the commercial purposes specified in section 136(2)(a), (b) or (c), again with the requisite knowledge. Would this also constitute a trade mark offence? If so, this would be a clear case of cumulative protection within the criminal law.

In *Challenger Technologies Pte Ltd v PP*,²⁴⁵ a case which dealt with the issue of a criminal offence under section 73 of the Trade Marks Act, *viz*, for dealing in goods to which a trade mark has been falsely applied, Lai Kew Chai J held that the false application had to be to goods that were false or spurious, rather than genuine goods from the proprietor. One of the reasons given was that:

The legislature could not have intended to criminalize the mere act of reproducing a registered trade mark without consent of the proprietor.

²⁴³ [1988] 2 MLJ 150.

²⁴⁴ However, it should be noted that in both *Ng Chye Mong* as well as the *Challenger* case (discussed *infra*, at note 245 and the accompanying main text), the court considered that proof of the counterfeit nature of the articles was essential in order to disclose an offence.

²⁴⁵ [1994] 2 SLR 446.

At common law, a trade mark is not a copyright, so that a person may copy a trade mark ... provided that he does so without any intention to pass off ... There is no reason why the owners of a trade mark should obtain more rights in such marks which are not otherwise available under civil law.²⁴⁶

With respect, it is submitted that this statement may not necessarily be true in all cases. If, in the hypothetical example outlined above, the reproduction also constitutes making the trade mark without the proprietor's consent, that is deemed to be counterfeiting the trade mark. The act of reproduction, therefore, would probably constitute a trade mark offence under section 70. If the counterfeit trade mark is then applied to goods which are, *eg*, sold or imported, this would bring the case within the purview of section 73 of the Trade Marks Act – in such a case, the importer or seller may not even be the same person as the counterfeiter. The defendant may then wish to bring his case within either of the two defences in section 73.²⁴⁷

Section 73 therefore encompasses two offences: either that the defendant has commercially dealt with (*ie*, imports, sells, exposes or possesses for sale or for any other trade or manufacturing purpose) goods or thing to which a counterfeit trade mark has been applied; or that the defendant has commercially dealt with (being any of the several types of commercial activity described above) goods or thing to which a registered trade mark has been falsely applied. In either case, a defendant may plead either of the two available defences (*ie*, either under section 73(a) or (b)). Where the *Challenger* case dealt with the situation of false application of a registered trade mark, the *Ng Chye Mong* case considered the situation where a counterfeit trade mark was applied to goods which were then sold by the defendant.

It appears curious that, although both these cases deal with different offences, it was held in both cases that the prosecution had to prove that the goods in question were spurious. Given that the situation in *Challenger* was a new offence created in 1991, whereas the *Ng Chye Mong* scenario concerned an offence that already existed prior to 1991, requiring proof of spurious goods in both instances necessarily raises the question as to what, if any, is the difference between the two offences. Further, in civil cases of trade mark infringement under section 45 of the Trade Marks Act, there is clearly no need to prove that the goods are false: *eg*, if under section 45(3)(a), it is not trade mark infringement to use the registered trade mark

²⁴⁶ *Ibid*, at 453.

²⁴⁷ The decision in the *Challenger* case is not without its difficulties: see Wei, *supra*, note 31. In the circumstances, whether the validity of just one of the reasons for the learned judge's decision in the case would have affected the result or not is unclear.

in relation to goods to which the proprietor has actually applied the trade mark (and has not subsequently removed or obliterated it), or to which the proprietor has expressly or impliedly consented to the use of the trade mark, it must follow that where the proprietor has not applied the trade mark nor consented to its use, that the defendant's use would then constitute trade mark infringement. This would be the case even if the goods in question were genuine goods. However, civil liability for infringement does not necessarily mean that criminal liability will follow; that this may be the case in Singapore is indicated by the *Challenger* and *Ng Chye Mong* cases.

It therefore appears that where the commercial dealing is with genuine goods, following these two cases, no trade mark offence under section 73 would be disclosed even where the defendant copies (without consent) the plaintiff's trade mark and proceeds to apply it to the genuine goods. Under copyright law, however, where genuine goods are imported (*eg*, by way of parallel importation) and sold, an offence under section 136 may take place if the goods are "infringing copies", *ie*, made without the consent of the copyright owner. In the case of genuine goods, it may be necessary to look to the civil cases on parallel imports to determine if his consent has, expressly or impliedly, been given.²⁴⁸ Given the 1994 amendments regarding the nature of consent in parallel imports, already discussed, it may be that section 136 is of limited application, at least where the alleged infringing copies are genuine imported goods.

However, one possible scenario where a copyright offence may be committed under section 136 may be where the copyright work in question is also a trade mark, *eg*, a logo or device. The importer may bring in genuine goods, not marked with the trade mark, but, prior to selling the goods in Singapore, proceed to make copies of the trade mark and then attach them on the previously unmarked goods. In such a case, the act of making the logo would constitute reproducing the logo (protected by artistic copyright) in a material form which would be a case of copyright infringement under section 31 of the Copyright Act; in addition, the sale of the goods under the copied logo may constitute infringement under section 33 (assuming

²⁴⁸ See the discussion comparing the civil provisions regarding parallel imports in both copyright and trade marks law, *supra*, notes 216-230 and the accompanying main text.

²⁴⁹ Unlike cases of primary infringement under s 31, civil cases of copyright infringement which involves commercial exploitation of the copyright work requires that the defendant "knows, or ought reasonably to know, that the making of the article constituted an infringement of the copyright or, in the case of an imported article, the making of the article was carried out without the consent of the owner of the copyright" (see ss 32 and 33, Copyright Act). For a discussion of the *mens rea* required (which is similar for both civil and criminal copyright cases), see Wei, *supra*, note 31. For a discussion of the meaning of "consent of the owner of the copyright", see the discussion on "Control of Parallel Imports", *supra*, notes 216-230 and the accompanying main text.

the requirement of *mens rea* is satisfied).²⁴⁹ Further, these same acts of manufacture and sale may disclose a criminal offence under section 136 of the Copyright Act (again assuming the necessary *mens rea* is established). Finally, the earlier discussion on civil trade mark infringement under section 45(3)(a) of the Trade Marks Act would also indicate that this type of use of the trade mark by the defendant would not be excused by section 45(3)(a), thereby making it a case of trade mark infringement as well. It therefore appears somewhat curious that, despite these various liabilities, civil and criminal, which the defendant would face, the effect of the *Challenger* decision would be that no trade mark offence would have been committed as the goods in question are genuine goods.

It seems clear from the above example that while the civil and criminal provisions of the Copyright Act are very much in line with each other (in the sense that the requirement of knowledge as to the act of infringement in Singapore or, where the articles are imported, as to the copyright owner's consent, being similar in both types of liability, would in most cases result in the defendant being liable both civilly and criminally), this may not be the case under the Trade Marks Act. Why this should be the case is not entirely clear, given that the parallel importer does exactly the same thing in both regimes: the foreign copyright owner/trade mark proprietor sells genuine goods without the copyright logo that is also his trade mark. The parallel importer, without the former's consent, makes and attaches (or re-attaches, as the case may be), the logo in Singapore. His purpose for doing so is obvious: the consumer would be more likely to buy what he has to sell if it is accompanied by a recognisable trade mark. The parallel importer is therefore "reaping where he has not sown" by trading on the goodwill built up in the logo by the original trade mark proprietor, in order to maximise his profits; yet this does not constitute a trade mark offence because the goods to which the logo is attached are not spurious (although the parallel importer's action would doubtless constitute falsely applying a registered trade mark).

The fact that consumers would more readily purchase goods backed by a recognisable trade mark in fact recalls the functions of a trade mark: that it operates as a badge of origin, or even quality, for the product in question.²⁵⁰ In addition, the fact that the parallel importer is attempting by his actions to benefit from the trade mark proprietor's goodwill is reminiscent of the

²⁵⁰ See discussion under Part I(I), "Functions of Copyright and Trade Mark Legislation", *supra*, notes 19-40 and the accompanying main text.

²⁵¹ It is clear that the action in passing off encompasses not only passing off as to origin, but quality as well: see Kerly, *supra*, note 116, at para 16-28. Thus, one trader may sell goods of varying qualities; it would then be passing off for the defendant to sell goods of "B" quality as if they were "A" quality.

passing off action.²⁵¹ It may be that the goods which the parallel importer has purchased overseas are of inferior quality to the usual product sold under the trade mark – an example would be a famous winery producing wines cheaper than its trade marked line, such cheaper wines being made by a different process, or without the same long period of maturation as the trade marked line, being intended for mass market consumption only. In such a case, the cheaper wine clearly originates from the same winery as the more expensive, trade marked line of wine, but it is apparent that the winery would have valid commercial reasons for not using the trade mark (reserved for the more expensive line) on the cheaper wine. Yet, if the parallel importer who buys the cheaper wine then attaches the trade mark to these bottles, it is arguably not a trade mark offence as the goods are not spurious. Given that such actions bring to mind the language and basis for passing off and registering trade marks, it is a little surprising that this should be the result, especially as the same actions may attract both civil and criminal liability under copyright law, which prevents copying (whether or not involving any public deception or association) and which is not concerned with the public association of the trade mark with the original goods and the trade mark proprietor.

On a different matter, where many copyright offences depend on the actual or constructive knowledge of the defendant, this is not the case for trade mark offences. While the defendant's knowledge, actions and motives are not mentioned as relevant considerations in the offences concerning the counterfeiting of a trade mark, for the other offences, the question of his state of mind or actions is relevant. However, there is no mention of actual or constructive knowledge. Instead, section 73 questions whether the defendant, having taken reasonable precautions, had any reason to suspect the genuineness of the mark used. An interesting question is whether or not this phraseology is any different from that requiring constructive knowledge. It is submitted that, while alleging that someone may well have grounds to suspect a mark's genuineness would, in many cases, approximate constructive knowledge, the trade mark offence additionally necessitates an enquiry as to whether or not the defendant took reasonable precautions in the first place. This is not required in copyright offences.

Additionally, the burden of proof is different in that for trade mark offences, the defendant has to prove what was his state of mind and the reasonableness of this conduct while in the copyright offences, knowledge seems a necessary element of the offence, the burden of proving which lies on the prosecution.

Finally, section 73 has an alternative "defence" of innocence, as does section 73A. Again, the burden of proof is on the defendant and the question

²⁵² [1995] 2 SLR 475.

of his innocence is not a necessary element in proving the offence.

In *Trade Facilities Pte Ltd & Others v Public Prosecutor*,²⁵² Yong Pung How CJ considered the applicability of the two defences under section 73. He held that although a defendant may fail to prove the requisite elements to succeed under section 73(a), this did not preclude him from pleading section 73(b) successfully, nor would he be prevented on relying on facts which would have been relevant to his failed section 73(a) defence. This would mean, *eg*, that even if he had not taken reasonable precautions such as to satisfy section 73(a), he could still have acted innocently if he can point to other factors which indicate his innocence.

The broad terms in which section 73(b) is couched, compared to the specific requirements of section 73(a), ought to make it easier to plead a section 73(b) defence in that additional factors and circumstances may be adduced. It is submitted, however, that it is a little difficult to see what factors would cause a section 73(b) defence to succeed where a section 73(a) defence is pleaded unsuccessfully.²⁵³

Another problematic question would be the difference, if any, between innocence to a trade mark offence and lack of actual or constructive knowledge of a copyright offence. Given the potential width of the defence of innocence, it is perhaps only possible to say that the defendant's actual or constructive knowledge would be one factor in showing his innocence, or lack of it.

CONCLUSION (2)²⁵⁴

In this situation, while the copyright owner does not enjoy the dual protection afforded in the first conclusion, he is still in the enviable position of being able to prevent others from using, as a trade mark, a work that is identical with or closely similar to his copyright work.

The substantive provisions of the Trade Marks Act which permit this have already been discussed.²⁵⁵ However, it may be pertinent to examine the possible reasons for giving a copyright owner what, for the purposes of this article, may be described as “indirect” or “negative” trade mark protection.

First, it is possible that the Copyright and Trade Marks Acts are to be perceived as independent and unconnected statutes. This is supported by the fact that neither Act makes express reference to the other, even where,

²⁵³ See Wei, *supra*, note 31.

²⁵⁴ This part of the discussion relates to the second conclusion (being one of four conclusions) expressed under “Consequences of Cumulative Protection”, *supra*, note 201.

²⁵⁵ See the discussion regarding the *AUVI* case, *supra*, notes 167-190 and the accompanying main text.

as has been pointed out, the rights owner may claim protection under both regimes. Further, it is clear that the rights owner does not need to choose between the two intellectual property rights in protecting his work. If this is the intention, it follows that since dual protection is allowed, the possibly less common situation that arose in cases like *AUVI Trade Mark* should also be permitted.²⁵⁶

Secondly, the differing aims of copyright and trade mark protection have also been discussed.²⁵⁷ In an *AUVI*-type situation, there is no possibility of the copyright owner obtaining trade mark protection as he has no goods for which a trade connection may be established. However, this inability should not therefore lead to a situation where anyone else could then produce his own goods using the identical name or logo as a trade mark. Should this be the case, we may see cases where trade marks are selected without the trader needing to put in his own effort to come up with a unique trade mark. He may simply choose to use an attractive logo which someone else has created but who cannot use it in trade. In a way, this can be seen as going against the basic idea of distinctiveness in trade marks – that you cannot adopt as your trade mark something which other traders may legitimately want to use. This type of practice may also go against the basic idea stated in the opening paragraph of this article – that intellectual property rights reward creators for their effort and work.

Is it possible to overcome this concern by arguing that such a trader could never succeed in registering the logo as his trade mark because it would not inherently distinguish his goods? It would appear not, as the question of inherent distinctiveness does not appear to depend on the source of the trade mark.²⁵⁸ It does not seem to matter where or who you got the trade mark from, so long as the trade mark is such that it will distinguish your goods from another's, or for Part B marks, that it is capable of so doing.

In any event, this argument, if successful, would render the prohibition in section 15 of trade marks “contrary to law” otiose. The existence of such a prohibition would therefore seem to make it plain that, if not for reasons for lack of distinctiveness, at least for reasons of copyright infringement, a trader cannot register as his own trade mark a logo which someone else owns, even if that other person has no intention or ability to do so himself.

While such a position may rightly prevent traders from taking a “shortcut” by adopting others’ designs as their own trade marks, it may also disadvantage

²⁵⁶ However, consider the remarks of Pincus J in *Roland v Lorenzo*, *supra*, note 124.

²⁵⁷ See *supra*, notes 25-35 and accompanying main text.

²⁵⁸ Rather, the concern seems to be whether or not other traders may wish to fairly and honestly use the same mark in trade: see the cases cited *supra*, at notes 59-60.

those who claim literary copyright in single words, names or short phrases, when they are compared to those who claim artistic copyright in logos, devices and other designs which may actually incorporate single words, names or short phrases. This is the position highlighted by Conclusion (3).

CONCLUSION (3)²⁵⁹

The difference in the treatment of literary and artistic copyright has already been highlighted earlier in this article.²⁶⁰ What is the effect of this distinction on a trader who may wish to enlist the aid of the provisions of the Trade Marks Act to protect the work in question?

In relation to the registrability of the work, the question of distinctiveness will be dealt with as part of the discussion on Conclusion (4). In this part of the discussion, we shall therefore focus on the “indirect” or “negative” protection under the Trade Marks Act.

It is possible that a copyright owner of an artistic work may be in a superior position as compared to the copyright owner of a literary work. This is because the latter faces the difficulty of acquiring copyright protection in the first place.²⁶¹ If the position is that he cannot claim copyright in a single word, title or short phrase, then he does not seem to be able to stop another person from appropriating that word, title or phrase for his own trade mark, *eg*, on the ground that it will no longer be “contrary to law” *ie*, no copyright infringement, to use that word, title or phrase – there is therefore no room for the prohibition in section 15 of the Trade Marks Act.²⁶²

There are two possible arguments which the “owner” of the work may try to raise to avoid this situation: first, he may argue that even though he has no copyright in the work, neither does the trader using the work as his trade mark. There is thus no possible ground on which the trader can claim to be the “proprietor” of the trade mark and thus be allowed to register it. However, it is unlikely that this argument will succeed, as its consequence, if correct, would be that trade marks which are not copyrighted can never be registered as there is no one entitled to be the “proprietor”. In other words, only trade marks which enjoy copyright or other legal protection could be registered by their owners!

The rationale behind the prohibition against registering another’s

²⁵⁹ This part of the discussion relates to the third conclusion (being one of four conclusions) expressed under “Consequences of Cumulative Protection”, *supra*, note 201.

²⁶⁰ See the section, “Acquiring Cumulative Protection Under Copyright and Trade Mark Legislation”, *supra*, notes 66-136 and the accompanying main text.

²⁶¹ *Ibid.*

²⁶² As in the word marks in *OSCAR Trade Mark*, *supra*, note 163.

copyright work as your own must surely be that where one regime (copyright) extends protection, it cannot be that another regime (trade marks) would openly allow its protection to be given to those who are guilty of copyright infringement.²⁶³ It is difficult to see room for such an objection in a case where the trade mark in question does not even qualify to be protected by copyright law.

Secondly and alternatively, the “owner” may argue that even if the trader’s use of the trade mark is not “contrary to law”, it is still likely to deceive or cause confusion, and therefore still falls foul of the section 15 prohibition. There is no indication in section 15 that the challenge against registration of a trade mark has to be launched by someone who himself has a usable or registrable trade mark. In this respect, all the challenger has to do is show he is an “aggrieved party” in accordance with section 39(1). Although ownership of the copyright in the trade mark itself would clearly suffice, it is apparent from the remarks of Chao J in the *AUVI* case that it is not so limited, nor is the phrase “aggrieved party” to be interpreted in a narrow sense.²⁶⁴ In a situation where the challenger does not himself have a registrable trade mark, therefore, he would have to adduce other evidence, for example, that in using the identical or closely similar word, title or phrase, the trader has tried to confuse the public into thinking that there is some link between the challenger’s literary effort and his product, marketed under a brand name consisting of that literary effort.

If this argument is accepted by the courts, it would then narrow the differences between copyright artistic works and literary works which are not copyright, at least in terms of the “indirect” route for trade mark protection. However, if the “work” in question does not even enjoy any copyright in the first place, nor does its creator intend to use it in trade such as to entitle him to register it as a trade mark, a possible short answer to these arguments would simply be to assert that the creator has done nothing which would permit either copyright or trade marks law to protect him, whether directly or indirectly.

One interesting question which may arise in these circumstances may be the relevance of an action in passing off. The “proprietor” of an unregistered trade mark at common law would be the owner of the goodwill generated by the use of that unregistered trade mark in trade. If the mark in question is not protectable by copyright (*eg*, it is a single word or name), it may be possible for someone other than the common law proprietor to

²⁶³ This point again raises the “practical complexity” of the trade mark/copyright relationship: see *supra*, note 124.

²⁶⁴ *Supra*, note 178 and accompanying main text.

²⁶⁵ However, even the essential particulars of s 10(1)(a), (b), (c) and (d) are only presumptions; thus, if it can be shown that they are actually not distinctive, the presumption would not

attempt to register it as a trade mark (possibly on the ground that it is an invented word and therefore presumed distinctive).²⁶⁵ It may then be possible for the common law proprietor to argue that he is an aggrieved person such that he could assert that, under section 15, allowing the applicant to register and use the same mark, would be likely to deceive or cause confusion.²⁶⁶

CONCLUSION (4)²⁶⁷

At this point, it is proposed to examine whether or not there are differences between registering, as trade marks, artistic works such as logos and drawings which would enjoy copyright protection and literary works such as single words, titles and short phrases or slogans which may find it difficult to get copyright protection.

In order to register a trade mark, the work in question must satisfy the requirements of “trade mark” (as defined in section 2) and distinctiveness (in sections 10 or 11). There have been several English cases which have considered these requirements in relation to short phrases and slogans.

One such case is *Have A Break Trade Mark*²⁶⁸ where the slogan “Have A Break”, having been used as advertisements for the product (chocolate biscuits), was the subject of an application for registration as a trade mark in Part B of the Trade Marks Register.

On the question of whether such a slogan is a “mark” within the definition in the Trade Marks Act, the assistant registrar held that it was, as it constituted “an assembly of words ... [a]lthough a slogan.”²⁶⁹ He went on to find that it could also be a trade mark, as it “has the potential to connect goods with the proprietor in the way that many or indeed most trade marks do in modern conditions.”²⁷⁰ On appeal, Whitford J declined to consider the general issue whether or not slogans were registrable, preferring instead to examine the particular case as one where three words in association were

operate in their favour. Suppose the common law proprietor has built up goodwill in his product – would this render the applicant’s identical trade mark non-distinctive in the sense that it is clearly a mark which other traders would legitimately want to use?

²⁶⁶ This is clearly different from an AUVI situation, where the applicant could be successfully challenged on his right of proprietorship (*inter alia*) by the copyright owner. In this case, however, there is no copyright in the trade mark.

²⁶⁷ This part of the discussion relates to the fourth and final conclusion expressed under “Consequences of Cumulative Protection”, *supra*, note 201.

²⁶⁸ [1993] RPC 217.

²⁶⁹ *Ibid*, at 220.

²⁷⁰ *Ibid*.

²⁷¹ See generally *ibid*, at 227-231.

registrable. He then concluded that, on the evidence, the applicants were using the slogan purely to advertise their chocolate biscuits rather than as a trade mark. It was therefore unregistrable.²⁷¹

A second case is that of *"I Can't Believe It's Yogurt" Trade Mark*.²⁷² The applicants tried to register both the phrase as well as the phrase encapsulated in a speech balloon for yogurt products. The Registrar accepted that "[t]he definition of a mark ... is wide enough to include a phrase or slogan."²⁷³ On appeal, Robin Jacob Esq, QC proceeded on a similar assumption. Additionally, he treated both marks as identical for all practical purposes despite the presence of the visual element of the speech balloon in the second instance, as he considered that it was the phrase that was of prime importance.²⁷⁴

In line with the *"Have A Break"* case, he held that phrases which were used as advertising could not be registrable, but this would not be the case where the phrase functioned as a brand name for the goods. On the facts, the phrase was held to be a trade mark.²⁷⁵

On the question of distinctiveness, the applicants were refused registration in Part A as the phrase did not satisfy the requirements of section 9(1)(d), being a laudatory phrase which directly referred to the character and quality of the yogurt product. It was, however, allowed to be registered in Part B as it was not considered a trade mark which other traders in yogurt products might reasonably want to use.²⁷⁶

A similar test was applied by Whitford J in the *"Have A Break"* case, although he came to the conclusion that the slogan there may be one which other traders may fairly want to use for their own products, and was hence unregistrable in Part B.²⁷⁷

Since the copyright status of the slogans would have had no effect on trade mark registration in both cases, it is not surprising that the courts did not consider this question. However, it is interesting to note that in both cases, the basic question of whether or not such slogans could be considered "marks" in the first place was raised. It is encouraging to note that, without going so far as to pronounce on a general rule, the English courts have not prevented trade mark registration based on the nature of the mark in question.

This difficulty of course does not arise with most device, logo or other

²⁷² [1992] RPC 533.

²⁷³ *Ibid*, at 535.

²⁷⁴ *Ibid*, at 537.

²⁷⁵ *Ibid*.

²⁷⁶ *Ibid*, at 537-540.

²⁷⁷ *Supra*, note 268, at 230-231.

²⁷⁸ See *supra*, note 50 and accompanying main text.

marks that satisfy the legislative definition of “mark” under the Trade Marks Act.²⁷⁸ An interesting point to note is that the definition of “mark” also makes references to “word, letter, numeral or any combination thereof”. This would seem to imply that there ought to have been no difficulty even with the phrases or slogans in both of the above cases, as they should surely be treated as a combination of words.

The definition of “mark” includes single words and letters. The *IQ Trade Mark*²⁷⁹ case seems to show that in cases of letters, notwithstanding that they may be marks, it would be extremely difficult to successfully register them. In that case, Mr M Reynolds, the Registrar, acknowledged that:

[t]here is of course no express prohibition ... on the registration of letters as such ... it has long been held that individual letters are not distinctive and that letters of the alphabet ought to be free for all to use.²⁸⁰

He relied on both Registry practice, as well as distinctiveness, to refuse the application, stating for the former that “I.Q.” was comprised of individual letters with punctuation and therefore was not presented as a word that was clearly pronounceable.²⁸¹ On the latter ground of distinctiveness, he held that “I.Q.” did not satisfy either Part A or Part B requirements.

It therefore appears that where letters, words, phrases or slogans are the subject of an application for trade mark registration, even if they satisfy the court that they are marks within the statutory definition, there may be a further obstacle when the inquiry shifts to the question of its distinctiveness. For Part A registration, given that the presumptions of distinctiveness listed under section 10(1)(a) and (b) would apply only to limited and specific situations, word marks would generally fall to be considered under section 10(1)(c), (d), or (e). In other words, in order to employ the presumption of distinctiveness, the applicant would have to show that his word mark is either invented, or does not directly refer to the product’s character or

²⁷⁹ [1993] RPC 379.

²⁸⁰ *Ibid.*, at 380.

²⁸¹ It is interesting to compare this case with that of *Roland v Lorenzo*, *supra*, note 124, where (as already noted) Pincus J considered that “mere random collection of letters of the alphabet could not be copyright”, unlike the device marks in that case which were “by no means random and were plainly drawn with care, to obtain an effect”. *Quaere* whether or not it can be argued, in trade marks, that even combinations of letters, if carefully and deliberately selected, to obtain an effect, ought to therefore be registrable, barring lack of distinctiveness? However, the presence of full-stops or other punctuation marks between each letter, as in the *IQ* case, which may serve to highlight the individuality of each letter, may still be a problem: see *supra*, note 274, at 381. On a separate point, it should be noted that the Registry practice relied on in this case is not reflected in the requirements of the Trade Marks Act.

quality, or is neither primarily a geographical name or surname. If he cannot do so, he will have to proceed to prove that it is adapted to distinguish his product, both inherently and in fact.

Alternatively, the application could be in Part B, whereupon the court would likely apply the test set out in both the “*Have A Break*” and “*I Can’t Believe It’s Yogurt*” cases.

For non-word marks such as device marks, logos and other drawings and artistic works, where distinctiveness is concerned, with the exception of section 10(1)(a), it is unlikely that any of the other heads of presumed distinctiveness would apply.²⁸² The consequence is that such marks would necessitate the applicant proving that they are distinctive under section 10(1)(e), section 10(2) and section 10(3) for Part A registration. It therefore appears that most trade marks which also enjoy artistic copyright may not benefit from many of the presumptions listed in section 10, while word marks which would not enjoy artistic copyright (and probably not literary copyright as well) would be the more likely beneficiaries of these presumptions.

Of course, should either type of trade mark be the subject of registration in Part B of the Register, the Trade Marks Act makes no distinction between them on the requirement of distinctiveness. The division therefore exists only in respect of registration in Part A.

CONCLUDING REMARKS

From the foregoing discussion, it ought to be clear that it is possible to acquire dual, or cumulative, protection under both the copyright and trade marks regimes in Singapore. At the risk of over-simplification, it would appear that the incidences of actual overlap are likely to be few, being most likely to occur only when trade mark infringement coincides with copying (or reproduction) of the copyright work. In such cases, there may also be some overlap between the criminal provisions in both statutes. In many other respects, such as the aims of both regimes, the difference between each regime’s key requirement of “originality” and “distinctiveness” and the different treatment of “consent” in parallel import cases, both copyright and trademark legislation seem to play different, if complementary, roles. This complementary feature is especially clear in situations such as the *AUVI*

²⁸² The possibility of registering either literary or artistic works such as names and signatures has already been discussed in Part I, *supra*, notes 137-143 and the accompanying main text.

or *Karo Step* situations, where a copyright owner may use trade marks provisions to protect himself from others who may try to use his copyright work in their trade.

However, the current situation is not without its problems. Foremost among these is the different treatment meted out by copyright to artistic and literary works, at least where the subject matter consists of matter that may also be used as trade marks, such as names, slogans, logos and devices. It is respectfully submitted that the current law on this aspect results in it being considerably more difficult for the copyright owner of a purely literary work to benefit from the complementary effect of the copyright and trademark statutes as described above. This is not an entirely satisfactory situation, especially when it is apparent that it may be possible for very simple artistic works, or artistic works which may be partially made up of literary works, to enjoy the duality of protection. However, as discussed above, it would appear that such difficulties are faced mainly by pure word marks which are generally somewhat insubstantial, such as names, single words, titles and short phrases. Given that the degree of stylisation or embellishment required to “convert” a pure literary work to an artistic work (eg, such as a signature or logo) may not be high, the number of affected cases may well be small. Despite this, it is submitted that the time may have come such as to warrant a closer analysis of the relationship between literary and artistic works under copyright, as well as that between the various intellectual property rights.²⁸³

In a case where the owner of a copyright work also seeks to register it as a trade mark, it has already been pointed out that the provisions in the Trade Marks Act which deal with presumed distinctiveness seem to differentiate between literary works such as words and names, and non-literary works. This would seem to imply that at least for this aspect of registrability, the burden may be lighter on owners of literary works who can come within one of the heads of presumed distinctiveness.

On the question of whether simple words and phrases can be a “mark”, several cases have illustrated the difficulty which can face a potential trade mark owner wishing to register letters, single words or short phrases. This situation seems to parallel the difficulty which the same word, words or phrases may have in qualifying for copyright protection.

Aside from the few cases discussed in Part I, the question of cumulative

²⁸³ The problems which may arise given the complexity of these relationships have not gone unnoticed by the judges: see, eg, the remarks of Pincus J in *Roland v Lorenzo* (*supra*, note 124), Lai J in the *Challenger* case, *supra*, note 245, and Whitford J in *Catnic Components v Hill & Smith* [1978] FSR 405 at 427-428.

protection under copyright and trade mark laws seems little discussed, presumably due to the largely different aims of both regimes. However, it is to be hoped that since duality of protection has been recognised to exist,²⁸⁴ some of the problems and issues raised in this article will provide food for thought for both intellectual property lawyers as well as intellectual property rights owners.

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²⁸⁴ *Ibid.*

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