

Law of Trade Marks and Passing Off in Singapore BY TAN TEE JIM [Singapore: Thomson Sweet & Maxwell Asia, 2003, lvii + 906 pp. Hardcover: S\$302.40]

THIS book makes a significant contribution to the local legal literary landscape, surveying the common law and statutory regimes which protect the use of signs, in the course of trade, to indicate the source or origin of goods or services. In an area of intellectual property law which has not received as much domestic academic attention as the law of copyright or the law of patents, the author does a commendable

job of mapping out contours of the 1998 *Trade Marks Act* (Cap. 332, 1999 Rev. Ed. Sing.) and the subsidiary legislation which flows from it, as well as the economic tort of passing off that is part of Singapore's common law. In addition, specific chapters in this book have been dedicated to the more esoteric areas related to the trade marks and passing off that may be of special interest to the reader: Chapter 8 deals with Geographical Indications, Chapter 15 deals with Border Enforcement, while Chapter 18 deals with Trade Marks and the Internet. The last chapter deals with the highly current legal issues related to the domain name registration system, webpage linking and the various protocols that have been developed in response to the concerns of proprietors of registered trade marks.

Given the close relationship between English and Singapore systems of trade mark protection, considerable attention is given to case authorities from the United Kingdom and, to a more limited extent, the European law of trade marks (on which the *Trade Marks Act 1994* (U.K.) was modelled). Woven into the author's examination of the relevant legislation and cases in this book is an important expository account of the major international legal instruments which have influenced the development of this area of law in Singapore: the Madrid Protocol, the Paris Convention for the Protection of Intellectual Property, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (T.R.I.P.S.) between World Trade Organisation members countries.

Students and practitioners will find this book a pleasure to read. The author's writing style is lucid and concise, with reproductions of numerous pictures of visual trade marks included to accompany the text. These images serve to reinforce the abstract concepts discussed by the author, as well as to illustrate the factual contexts in which trade mark disputes have arisen—particularly in the area of trade mark registrability and trade mark infringement. Navigating through the eighteen chapters in this book is also facilitated by the author's systematic treatment of the numerous statutory and regulatory provisions in the various pieces of primary and secondary legislation. These provisions are dissected into digestible segments by the author, who methodically interprets the language used in light of its legislative history and the relevant judicial decisions which have dealt with them. A convenient 425-page collection of useful resource materials (primary legislation, secondary legislation, international agreements, etc.) is also included in Appendices, drawing together key reference materials and presenting them to the reader in a readable and accessible typographical format.

While considerable attention has been paid towards explaining the local practices of the Singapore Trade Mark Registry and the trade mark registration procedures which have emerged, the decisions of the Singapore courts are not always analysed with the same degree of detail across the different chapters. More attention could have been given, for example, to the implications of the Singapore Court of Appeal's decision in *CDL Hotels International Ltd. v. Pontiac Marina Pte. Ltd.* [1998] 2 Sing. L.R. 550 on the existence of goodwill arising from pre-trading activities—an important contribution to the tort of passing off that should be of interest to other common law jurisdictions. The dearth of Singapore case law under the 1998 *Trade Marks Act* explains the heavier reliance on U.K. cases, which deal with *in pari materia* statutory provisions from the *Trade Marks Act 1994* (U.K.), to explain the scope of the local legislation. The author opines throughout the book that "it is entirely within our courts' prerogative to follow the UK or the European approach

or to chart their own path by interpreting these provisions in ways best suited to meet local conditions or the circumstances of the case at hand". However, there is not too much said about how, and why, the law in Singapore should develop differently in light of the differences, whatever they may be, between Singapore and these other jurisdictions. Furthermore, while the author makes several references to the U.S.-Singapore Free Trade Agreement (signed on 7 May 2003) which require Singapore to realign its trade mark laws to bring it closer to the approach taken in the U.S., no substantive references were made to U.S. trade mark law to explore its potential impact on Singapore's legal landscape.

This brings us to the unfortunate timing of this book. In less than a year since its publication, a few chapters have been rendered outdated and will have to be rewritten as a consequence of several significant amendments made to the *Trade Marks Act* in July 2004—changes that were introduced pursuant to Singapore's obligations under the U.S.-Singapore Free Trade Agreement. The removal of the visual perceptibility requirement from the trade mark registration criteria opens the door to sound, scent and taste marks: this will require a far more detailed examination of the issue of how to fit these non-visual marks into the registration system than the two-paragraph discussion in Chapter 2. Similarly, the battery of changes to the legal protection given of well known marks in Singapore, which includes an additional level of protection for marks which are well known to the public at large, renders the six-page discussion in Chapter 3 ("Well Known Trade Marks") in need of an extensive overhaul. Other areas which will need to be rewritten in light of the recent amendments to the Act, if a second edition of this book is planned, include the civil remedies available to trade proprietors in cases involving counterfeit goods, border enforcement measures, and the adoption of new defences to trade mark infringement which have been closely modelled after provisions in the U.S. regime.

None of this, however, detracts from the importance of the contribution made by the author towards filling a gap in Singapore's contemporary legal literature. This book will be useful to students, practitioners, in-house counsel and legal professionals who want a quick access to the law of passing off and registered trade marks in Singapore. Businesses and the agencies which advise them on their marketing, branding and sales strategies will also appreciate the practical advice given on obtaining a trade mark registration. Written with a degree of clarity which lawyers are often accused of lacking, this book is successful in penetrating the obscurity that surrounds this area of intellectual property and presenting the law to a wide audience in a highly accessible manner.

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