

Law of Trade Marks and Passing Off in Singapore (3d ed) BY TAN TEE JIM [Singapore: Sweet & Maxwell, 2014. vol I and II, xciv + 890 pp and lxxvi + 1018 pp. Hardcover: S\$481.50]

The long awaited third edition to Tan Tee Jim SC's comprehensive text on trade mark law in Singapore has finally arrived. It has been nearly a decade since the publication of the previous edition of this leading text. Drawing on applicable case law and legislation, the author provides a succinct and full discussion on the law of trade mark in Singapore. The significant developments in Singapore and elsewhere make this work timely and invaluable to all who are engaged in the area of trade mark law and practice. As noted by the author in the preface, some of the recent Singapore court decisions have necessitated an almost complete re-writing of a number of chapters in the work. By careful consideration and critical examination, the author elucidates the changes brought about by legislation and case law. Written by an eminent author and Senior Counsel with a wealth of knowledge and experience in this field, his 'ring-side' viewpoints offer an invaluable dimension to the commentaries on the leading decisions in this area.

The Singapore *Trade Marks Act* (Cap 332, 2005 Rev Ed Sing) is modelled after the equivalent legislation in the United Kingdom ("UK"). As the decisions of the European Court of Justice ("CJEU") are part of the law of the UK, the author appreciates the influence of CJEU decisions on our laws (see para 1.039). In this respect, this book provides a helpful analysis of the pertinent UK and CJEU cases. Their significance can be seen in the Singapore Court of Appeal decision in *City Chain Stores v Louis Vuitton Malletier* [2010] 1 SLR 382 (CA), where Chao Hick Tin JA states at [15] that:

[W]hile the courts in Singapore are not bound by the rulings of the [CJEU], the fact remains that s 27 of the [Singapore] Act was taken from s 10 of the 1994 UK Act and thus the scheme of things set out in the Directive would be relevant in interpreting s 27 of the [Singapore] Act.

Notwithstanding the obvious continental influence on our laws, the author must be commended for advocating the development of an “indigenous or autochthonous” trade mark system in Singapore. This may indeed be crucial to the legitimacy of a legal system within a multi-cultural society like Singapore. Our system may need to strike a more careful balance between private and public interests especially over trademarks with different forms of expression and graphic representation that reflect the rich diversity in race, language and religion. Let us take the example of marks that “may be contrary to... morality”. Whilst the European jurisprudence on this issue may be instructive, the cause for an autochthonous approach would have been far better served by a more incisive exposition on its degree of applicability to the Singapore context.

The content of this book is no doubt comprehensive. It begins by tracing the historical roots on the use of trade marks, citing examples of wall paintings in ancient Egypt depicting the branding of cattle, as well as, markings on potteries found in prehistoric sites near ancient Corinth more than 4000 years ago. The main body of this 1000 page work covers topics such as:

- Definition and function of a trade mark;
- Grounds for registration and the procedure and practice;
- Different types of marks;
- Dealings in registered trade marks including licensing and assignments;
- Defences including exhaustion of trade mark rights;
- Infringement, groundless threats of infringement, defences and remedies;
- Offences and border enforcement; and
- Madrid Protocol.

As it would be impossible to do justice to this work with a short review, I would only highlight a few chapters for comments.

- Chapter 4: “Well-known Trade Marks”. The protection of “well-known trade marks”, or what the author describes as “juggernaut marks”, has become increasingly important to brand owners in the age of “consumerism and globalisation”. Yet, its definition and scope remain highly elusive and was described by the Singapore Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR 216 (CA) as one “akin to engaging in a game of Chinese Whispers.” In this respect, it may perhaps have been useful to provide a historical account of the basis upon which “well-known trade marks” had received international recognition under Article 6bis of the *Paris Convention for the Protection of Industrial Property*, 20 March 1883, last revised at Stockholm, 14 July 1967, 828 UNTS 305. These historical developments together with an exposition of the concept of “dilution” at the Lisbon Conference 1958 would have been an excellent complement to the author’s expansive treatment on the evolution of “dilution” under United States (“US”) law. Nonetheless, the author’s cogent

discussion of this topic, especially his insightful analysis of the decision of *Novelty Pte Ltd v Amanresorts Ltd* offers greater clarity to this hitherto confusing state of the law.

- Chapter 5: “Geographical Indications”. The author’s coverage of the protection of geographical indications is relatively brief. This is explicable due to Singapore’s transition towards an enhanced regime of protection for geographical indications arising from the conclusion of the Singapore-European Union Free Trade Agreement (“EUSFTA”) in September 2013. Singapore’s Parliament recently passed the Geographical Indications Bill (Sing, Bill No 13 of 2014) on April 14, 2014, which will be implemented in three main stages corresponding to the European Union’s ratification of the EUSFTA. Notwithstanding its brevity, the author succinctly highlighted the salient features of the new regime.
- Chapter 6: “Registration Procedure and Practice”. In this chapter, the author’s wealth of experience and insights into the practice of trade mark law is highly evident. Through critical comments and analysis, the author carefully expounds his viewpoints where they differ from the court decisions. The comparative analysis of the UK practices, as well as, the inclusion of references to the relevant local subsidiary legislation and practice directions, will prove to be invaluable to practitioners in this field.
- Chapter 12: “Likelihood of Confusion on the Part of the Public”. The author justifiably devotes an entire chapter to this important concept of trade mark law. Of notable mention is his thorough analysis of the “global” assessment and “extraneous” factors that are relevant to the determination of this issue. In addition, he also examines the notions of “initial interest confusion” and “post-sale confusion”. Whilst these are largely US doctrines, they appear to have gained some support in the UK and CJEU case law. The question of whether they should form part of Singapore law receives a thorough review by the author in a manner that enables readers to easily grasp the intricacies in this significant area of trade mark law.

It concludes with an analysis of the interface between trade mark law and new technologies, particularly, the internet and the emerging prevalence of social media. The author has also included in the appendices helpful summaries of the list of cases on the Singapore Domain Name Dispute Resolution Policy.

As the next edition is likely to be much more voluminous, the publishers may have to consider producing the 600 pages of appendices in a separate volume for ease of handling and reference.

Finally, it may perhaps be permissible to highlight two minor suggestions for consideration in the next edition of this impressive work: First, it would truly be a far more authoritative work if the author canvasses a broader range of academic viewpoints—especially on emerging issues where there is less judicial guidance or key issues that are more debatable. Second, (perhaps) the inclusion of a new chapter on alternative dispute resolution of trademarks.

In conclusion, this comprehensive and authoritative book succinctly captures the Singapore landscape on trade mark law. This reviewer would highly recommend it as essential reading for all who are engaged in the law and practice of trade mark in Singapore. In echoing the words of the Honourable Chief Justice Sundaresh Menon

of the Supreme Court of Singapore in the Foreword to this edition, Tan Tee Jim SC is to be warmly congratulated on “this outstanding achievement”.

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