

## IN CONVERSATION WITH JUSTICE DEDAR SINGH GILL

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*This is the first part of a series of interviews that the Intellectual Property Students Association ("IPSA") has conducted with key players of the intellectual property ("IP") field in Singapore. They represent a diversity of views in the field of IP dispute resolution. As the Singapore IP Strategy 2030 Report highlights, Singapore is currently seeking to strengthen its position as a dispute resolution hub for IP disputes. The main purpose of these interviews is therefore to explore and discuss the various strategies that Singapore is intending to employ towards advancing its objectives.*

*IPSA had the honour of interviewing Justice Dedar Singh Gill, who was sworn in to the High Court (SGHC) as Judicial Commissioner in August 2018 and Judge in August 2020. He touches on significant judgements in the IP and Information Technology (IT) domain, the strengths of Singapore's judiciary, and key reforms that are in the process of being implemented.*

**Q1: An interesting feature of Singapore's legal system is the option for the court to appoint *amicus curiae* or court-appointed legal experts. Could you share, for our readers' benefit, how these options have been employed by the courts in IP/IT cases? Could you please discuss unique features of Singapore's system that benefit litigants in IP/IT legal proceedings in Singapore?**

Justice Gill observed that:

“An *amicus curiae* is usually appointed by the Court of Appeal (SGCA) where a case raises a novel or complex question of law, or where the appeal will benefit from specialised legal knowledge. Leading IP academics, such as Professor Ng-Loy Wee Loon and Professor David Llewelyn, were appointed as *amicus curiae* in recent SGCA

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decisions concerning IP law (eg, *Burberry Ltd v Megastar Shipping Pte Ltd*<sup>1</sup>, *Société des Produits Nestlé SA v Petra Foods Ltd*<sup>2</sup>, and *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc*<sup>3</sup>).

At the General Division of the SGHC, junior advocates can also be appointed as young *amicus curiae* (YAC) to assist the court in a similar manner. In the recent case of *Bellingham, Alex v Reed, Michael*<sup>4</sup>, a YAC was appointed to assist the court in interpreting the scope of section 32(1) of the *Personal Data Protection Act 2012*<sup>5</sup>. The appointed *amicus curiae* and YAC will address issues specified by the court, thereby assisting the judiciary in developing the law and enriching local jurisprudence for the benefit of future litigants.

Apart from the *amicus curiae* and YAC schemes, Singapore's judiciary also taps on the expertise of renowned IP practitioners through the Singapore International Commercial Court (SICC). *B2C2 Ltd v Quoine Pte Ltd*<sup>6</sup>, an SICC case involving a contractual dispute arising from a glitch on a currency exchange platform that used deterministic algorithms, was heard by Simon Thorley IJ, a leading Queen's Counsel in the field of IP Law."

**Q2: Singapore enjoys a reputation for a strong rule of law, supported by a highly skilled judiciary that is well regarded internationally. We understand that the General Division of the SGHC has had an IP/IT list since 2002. The list presently features 11 judges (including 3 Judicial Commissioners). In addition, in recent years, the SGCA has handed down a number of important decisions in this field. What do you think are the key strengths of Singapore's**

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<sup>1</sup> [2019] 1 SLR 536 (CA).

<sup>2</sup> [2017] 1 SLR 35 (CA).

<sup>3</sup> [2014] 1 SLR 911 (CA) [*Staywell*].

<sup>4</sup> [2021] SGHC 125.

<sup>5</sup> No 26 of 2012, Sing.

<sup>6</sup> [2019] 4 SLR 17 (HC(I)).

judiciary and legal system in the field of IP/IT? Furthermore, in recent years, there have been substantial developments in Singapore's IP/IT law and the SGCA has handed down a number of significant judgments in this field.<sup>7</sup> Some of these cases were heard by a five-judge panel in the SGCA (instead of the usual three) and *amicus curiae* were appointed. In many of these cases, the SGCA undertook a comparative analysis of the approaches taken in various foreign jurisdictions (eg United Kingdom (UK), European Union (EU), United States (US), to name a few). Would you be able to share your observations and comments in this regard?

Justice Gill noted the three key strengths of the SGCA when it comes to decision-making: (i) sensitivity to the policy considerations underpinning IP regimes; (ii) willingness to adapt the law, where appropriate, to better cater to an increasingly digitised world; and (iii) readiness to review settled positions and change the law where it is desirable as a matter of logic and principle.

(i) Sensitivity to the Policy Considerations Underpinning IP Regimes;

Justice Gill highlighted the SGCA's independent and careful evaluation of the policy considerations that have led to the departure from established positions in the EU, the UK and the US. He demonstrated his point with reference to the landmark case of *Staywell*<sup>8</sup>. He shared that:

“In *Staywell*, after considering the doctrine of initial interest confusion in the US, UK and EU, the SGCA decisively concluded that this doctrine ought not to be introduced into Singapore trade mark law.<sup>9</sup> The effect of introducing this doctrine into Singapore trade mark law, is that confusion which arises initially, but which would have been dispelled by the time of the purchase, can constitute confusion for

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<sup>7</sup> Andrew Phang, Goh Yihan & Jerrold Soh, “The Development of Singapore Law: A Bicentennial Retrospective” (2020) 32:2 Sing Ac LJ 804 at paras 94-100.

<sup>8</sup> *Staywell*, *supra* note 3.

<sup>9</sup> *Ibid* at paras 105-116.

the purpose of sections 8(2) and 27(2) of the *Trade Marks Act*<sup>10</sup>. The court found that this doctrine is inconsistent with the purpose of sections 8(2) and 27(2) of the *TMA*: while the doctrine of initial interest confusion seeks to protect the reputation of a well-known mark, sections 8(2) and 27(2) of the *TMA* are concerned with the origin of goods. Further, if the initial confusion has been dispelled by the time of purchase, the function of the trade mark as a ‘badge of origin’ is not undermined. As a result, the court declined to import the doctrine of initial interest confusion into Singapore trade mark law.”

(ii) Willingness to Adapt the Law, Where Appropriate, to Better Cater to an Increasingly Digitised World; and

On this point, Justice Gill mentioned that:

"In *I-Admin (Singapore) Pte Ltd v Hong Ying Ting*, the court recognised that advances in modern technology make it significantly easier to access, copy, and disseminate confidential information almost instantaneously, often without the plaintiffs’ knowledge.<sup>11</sup> To better protect owners from loss, the court modified its approach towards breach of confidence claims: now, claimants only need to prove that the information possesses the quality of confidentiality and was imparted in circumstances which imported an obligation of confidence. Thereafter, the burden is shifted to the defendant to prove that his conscience is unaffected.<sup>12</sup>"

(iii) Readiness to Review Settled Positions and Change the Law Where it is Desirable as a Matter Of Logic And Principle.

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<sup>10</sup> Cap 332, 2005 Rev Ed Sing [*TMA*].

<sup>11</sup> [2020] 1 SLR 1130 at para 55 (CA).

<sup>12</sup> *Ibid* at paras 61-62.

Justice Gill returned to the case of *Staywell*, a case “emblematic of the judiciary’s willingness to refine the law where necessary”.

Prior to *Staywell*, the court in *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* held that the confusion inquiry requires the court to consider all the circumstances, including extraneous factors which go beyond matters relating to similarity of marks and goods.<sup>13</sup> Guided by the underlying aim of the trade marks regime—to prevent confusion, *Polo* found that the law ought not to extend protection in cases where extraneous matters indicates that the confusion is merely imaginary.

However, Justice Gill pointed out the following:

“In *Staywell*, the court observed that even though the risk of origin-based confusion is the primary interest sought to be protected by trade mark law, the proprietary rights of a trade mark owner must also be vindicated.<sup>14</sup> A liberal approach towards the admissibility of extraneous factors would enable a subsequent trader to enter the market using a trade mark that is very similar to the senior mark and applied to similar if not identical goods, and yet avoid liability by means of an express disclaimer or by selling his goods at a much lower price, on the basis that confusion has been dispelled due to these differentiating steps. Allowing extraneous factors to readily displace a finding of likely confusion would not meaningfully uphold property rights represented by the trade mark.

Accordingly, the court in *Staywell* held that there must be a limit to the range of external factors.<sup>15</sup> Departing from its previous decisions starting with *Polo*, the court held that extraneous factors in the confusion inquiry are only permissible to the extent that they are: (a) intrinsic to the

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<sup>13</sup> [2006] 2 SLR (R) 690 at paras 8, 28-32 (CA) [*Polo*].

<sup>14</sup> *Staywell*, *supra* note 3 at paras 78, 95.

<sup>15</sup> *Ibid* at para 90.

very nature of the goods and/or (b) affect the impact that similarity of marks and goods has on consumers; extraneous factors consisting of differences created by a trader's differentiating steps (eg, pricing differentials and packaging) are impermissible in the confusion inquiry.<sup>16</sup> The change was brought about after a detailed consideration of the case law from the UK and EU.”

Justice Gill also noted Singapore's IP legislation is updated regularly to keep abreast with international developments. For instance, as a result of the *United States-Singapore Free Trade Agreement*<sup>17</sup>, Singapore amended the *TMA* in 2004 to accord a higher standard of protection to well-known trade marks in response to the Joint Recommendation adopted at the 34<sup>th</sup> World Intellectual Property Organisation Meeting.<sup>18</sup> At the same time, Singapore directly imported the definition of “dilution” set out in the *US Trademark Act of 1946* into its local trade mark legislation. Another example would be the enactment of the *Geographical Indications Act*<sup>19</sup> in 2014 as a result of the *European Union-Singapore Free Trade Agreement*<sup>20</sup>, which established a system of registration of geographical indications (GI). More recently, the *GI Act* was further amended in 2020 to improve the running of the GI Registry and provide greater clarity to traders and producers.

**Q3: A key aspect of ensuring Singapore becomes a hub for IP Dispute Resolution is ensuring that such dispute resolution is cost effective. One such mechanism is encapsulated in the proposed reforms to allow for a new “track” that places restrictions on the length of trial, the quantum of damages recoverable, and the amount of costs awarded. While we understand that these reforms are still in the process of being implemented, what would be the key benefits that litigants can look forward to?**

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<sup>16</sup> *Ibid* at para 95.

<sup>17</sup> United States and Singapore, 4 September 2003 (entered into force 1 January 2004).

<sup>18</sup> *Trade Marks (Amendment) Act 2004* (No 20 of 2004, Sing).

<sup>19</sup> No. 19 of 2014, Sing [*GI Act*].

<sup>20</sup> European Union and Singapore, 19 October 2018 (entered into force 21 November 2019).

Justice Gill commented that:

“This new “track” provides a simplified process for IP claims. Modelled after the UK Intellectual Property Enterprise Court (IPEC), this track enables litigants to resolve their disputes in an expeditious and cost-efficient manner. This is significant, given that IP litigation tends, in general, to be more expensive than other types of litigation by virtue of the highly technical nature of the dispute which often calls for expert evidence. It is hoped that the simplified process track will play an important role in ensuring that litigants with more limited budgets can still access justice through the courts, notwithstanding the consolidation of civil IP disputes at the SGHC.

The introduction of this track, alongside existing procedures and timelines that apply to disputes presently on the SGHC IP list, gives litigants control over the costs of proceedings. The Minister of Law has indicated that litigants will generally be able to choose between the simplified process track and the normal track. Litigants with greater financial resources can opt for the normal track while cost-sensitive litigants can choose the simplified process track, which limits the length of proceedings and caps the costs and damages recoverable. Although it is ultimately for the court to decide which court the case is heard, the UK courts generally endeavour to accommodate parties’ agreement to use the IPEC. It remains to be seen if similar weight would be given to parties’ agreements in Singapore.”