IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1992] SGHC 66

Motion in Suit No 2669 of 1991

Between

Great Wall (Importers & Exporters) Pte Ltd
Great Wall Audio Pte Ltd

… *Plaintiff*

And

Golden Link Development Pte Ltd

… *Defendant*

GROUNDS OF DECISION

Version No 1: 11 Sep 2026 (01:05 hrs)

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Great Wall (Importers & Exporters) Pte Ltd and Another v Golden Link Development Pte Ltd

[1992] SGHC 66

Motion in Suit No 2669 of 1991
Chua F A J
18 March 1992

1 **Judgment:**

2 **GROUNDS OF JUDGMENT**

3 The plaintiffs' claim, inter alia, is for an injunction restraining the defendants from passing off or attempting to pass off cordless telephone sets bearing the trade mark "COMO", which do not have any connection in the course of trade with the plaintiffs, as the plaintiffs' goods.

4 The plaintiffs filed a Notice of Motion seeking the following orders:

5 1. The defendants, whether by themselves, their directors, officers, servants or agents or any of them or otherwise howsoever be restrained and an injunction is hereby granted restraining them from doing the following acts, that is to say, passing off or attempting to pass off, causing, enabling, or assisting to pass off cordless telephone sets not having any connection in the course of trade with the plaintiffs as and for the plaintiffs' goods by the use of the trade mark

"COMO" trade mark on the said goods or by any other means until after the trial of this action or until further order.

6 2. The costs of this application be costs in the cause.

7 The affidavit of Sun Chap Ting, the Managing Director of the first plaintiffs and a Director of the second plaintiffs, insofar as it is relevant to this Motion, is to this effect:

8 The first plaintiffs were incorporated in 1974 and are in the business of selling car radio and cassette players and television sets. The first plaintiffs sell extensively the aforesaid goods under the trade mark "COMO" both locally and abroad to Malaysia and Thailand.

9 The second plaintiffs were incorporated in 1983 and are in the business of selling, inter alia, car radio and cassette players, television sets and one piece extension telephone sets. Since their incorporation the second plaintiffs have been selling extensively the aforesaid goods under the trade mark "COMO" in conjunction with the first plaintiffs in Singapore and to Malaysia, Thailand and Indonesia.

10 In December 1986, the plaintiffs commenced the use of the "COMO" trade mark on cordless telephone sets. These cordless telephone sets could not be sold within Singapore without the approval from Telecoms Singapore, but could be re-exported. The plaintiffs sold to two companies in Singapore the "COMO" cordless telephone sets for re-export to countries in Asia, India, Sri Lanka, Europe, Middle East, Africa and the Persian Gulf. The plaintiffs submitted monthly sales returns to Telecoms Singapore accounting for the

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export to the aforesaid countries. The submissions of these monthly returns were a requirement of Telecoms Singapore.

11 On 4 August 1987, the second plaintiffs filed an application to register "COMO" as a trade mark in respect of telephones, telephone apparatus and equipment, radio and car stereos, television, video in Class 9 in their own name under Application No 3709/87 to hold for the joint benefit of the first and second plaintiffs. The said application is still pending. This arrangement was formalised by an Agreement dated 28 March 1989 made between the first and the second plaintiffs.

12 The plaintiffs have a wide range of "COMO" brand telephones for sale. In May 1988 and January 1989 the first plaintiffs obtained the approval of Telecoms Singapore to sell in Singapore the "COMO" cordless telephone sets model COMO 1000 and COMO 1000 DX.

13 Since the commencement of the first plaintiffs' use of the trade mark "COMO" on cordless telephone sets in December 1986 to October 1991, the first plaintiffs have imported and sold 86,240 sets. The plaintiffs have sold their cordless telephone sets in Singapore for the past five years amounting to S$9,005,039.22.

14 The plaintiffs have also extensively advertised their products and have expended the sum of S$155,410.00 for the past five years.

15 The second plaintiffs have applied for and obtained the registration of the "COMO" trade mark in China, South Korea, France, Thailand and Burma.

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16 The first plaintiffs' associates, Santo Corporation have applied to register the "COMO" trade mark in Japan. The application is still pending. In anticipation of registration, Santo Corporation have agreed to assign all rights in respect of the "COMO" trade mark in Japan to the first plaintiffs and an Agreement to assign was entered into between Santo Corporation and the first plaintiffs in August 1991.

17 The plaintiffs have always been careful to protect their common law rights in the "COMO" trade mark in Singapore. The second plaintiffs published a Warning Notice in the 23 January 1988 issue of the Straits Times. A response to the Warning Notice came from Associated Enterprise Inc of Japan (AEI). Their solicitors wrote to the second plaintiffs demanding the withdrawal of the second plaintiffs' claim to the "COMO" trade mark. The second plaintiffs refused to withdraw their claim to the "COMO" trade mark and no further action was taken by AEI.

18 In or about September 1988, the plaintiffs discovered that Fontel Electronic was selling telephone sets bearing the plaintiffs' "COMO" trade mark. It was discovered that Fontel Electronic obtained the infringing goods from a distributor Wahgo International Corporation Pte Ltd and Wahgo International Corporation Pte Ltd revealed that the infringing goods were obtained from AEI.

19 On or about 24 July 1991 the plaintiffs discovered that telephones bearing the "COMO" trade mark were being imported by the defendants. A trap purchase was made by the plaintiffs' agents who purchased from the defendants a "JAPAN COMO Model No 5000 MKII" for S$220 and a "JAPAN COMO model No 90000" for S$740.

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20 The Motion came before me on 11 February 1992. Defendants' counsel raised this preliminary objection: the plaintiffs' solicitors were acting in conflict of duty/interest as solicitors in acting for the plaintiffs in this action.

21 Defendants' counsel informed me that he had not heard from the Law Society.

22 The defendants' grounds for the objection said defendants' counsel were set out in the affidavit of Jenna Leong, General Manager of the defendant company. She deposed that as long ago as 18 September 1991 the plaintiffs' solicitors Drew & Napier had been put on notice of their being in conflict of interest and duty in acting for the plaintiffs and she exhibited copies of correspondence between the defendants' solicitors and the plaintiffs' solicitors on the matter.

23 In their first letter of 18 September 1991 the defendants' solicitors said that it had come to the defendants' knowledge that Drew & Napier were acting for Yugen Kaisha Como of Japan in their application (No S/5005/91) filed on 17 May 1991 in the Singapore Registry of Trade Marks & Patents to register "JAPAN COMO" as a trade mark in Class 9 and the instructions to make the application were given to Drew & Napier by T Sato, a patent attorney from Tokyo, pursuant to a Power of Attorney given to him by AEI, clients of the defendants' solicitors, Peter Chua, Sobaran & Partners. The defendants' solicitors expressed the view that in the circumstances there was a conflict of interest in Drew & Napier acting for Yugen Kaisha Como in the aforesaid application and for the first plaintiffs in the alleged passing off of "COMO" telephones in Singapore. The defendants' solicitors asked for the views of Drew

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& Napier on an urgent basis and in any event not later than 4.00pm on Friday, 20 September 1991.

24 Drew & Napier promptly replied on 19 September 1991, confirming that they filed a trade mark application in the name of Yugen Kaisha Como in Class 9 for the trade mark "JAPAN COMO" on the instructions of a Japanese patent firm but not the T Sato that was mentioned by defendants' solicitors. Drew & Napier further stated that they were not instructed about the involvement of AEI in the application and that that was the first time they had knowledge of it. Drew & Napier further stated that in view of the dispute between AEI and the first plaintiffs they would cease to act for Yugen Kaisha Como in their trade mark application No S/5005/91 and that they were informing the Japanese patent attorney of this immediately.

25 By their letter of 20 September 1991, the defendants' solicitors asked Drew & Napier to confirm that they would also cease to act for the first plaintiffs.

26 In their reply the same day, Drew & Napier asked the defendants' solicitors to let them know why they should cease to act for the first plaintiffs.

27 On 23 September 1991, the defendants' solicitors gave the following reply:

28 Re Alleged Passing Off of "COMO" Telephones in Singapore

29 As we understand it, you have acted for Great Wall (Importers & Exporters) Pte Ltd ("Great Wall") as long ago as early 1989.

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30 In 1991, you received instructions to apply to register "JAPAN COMO" from a party who were themselves an agent of and further, instructed by our client, Associated Enterprises Inc.

31 After we put you on notice of the conflict of interest and duty in your acting for both said parties, you suddenly decided that you owed a greater duty and responsibility to your first client, Great Wall.

32 A corollary of your decision was that you held a lesser duty to your second client.

33 With the utmost respect, we disagree.

34 We submit that you also owe an equally compelling duty to Yugen Kaisha Como ("YKC") as you do to Great Wall, having been put in confidence by YKC in their application to register a mark that is the same, if not substantially and materially the same, as the mark that Great Wall is claiming to be owners of, to the exclusion of all others.

35 Again with respect, we contend that it is therefore not appropriate for you to continue acting for YKC in the latter's said application and for Great Wall in the above matter.

36 On 25 September 1991 Drew & Napier replied to the defendants' solicitors stating that "In the matter between Associated Enterprises Inc and our clients, Great Wall (Importers & Exporters) Pte Ltd we are not in conflict". Drew & Napier said that they would be transferring the file of Yugen Kaisha Como's trade mark application to the defendants' solicitors.

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37 On 26 September 1991 the defendant's solicitors replied that they disagreed with the stand taken by Drew & Napier and said that as the issue at hand involved professional ethics they proposed to refer the matter to the Law Society for the latter's views.

38 The very same day Drew & Napier wrote the following letter to the defendants' solicitors:

39 Re Passing Off of COMO Telephones in Singapore

40 As we have stated in our earlier letter of 25 September 1991, there is no question about our firm being in any conflict of interest in respect of our clients, Great Wall (Importers & Exporters) Pte Ltd claim against your clients, Associated Enterprises Inc ("AEI"). Our clients claim against your clients is in passing off. We have never acted for AEI in any matter relating to our clients' said claim nor are we in possession of any confidential information about AEI.

41 Please let us know whether your clients are prepared to give an undertaking to stop the export, sale and distribution of telephones and other electrical/electronic devices with the name "Como", failing which we have instructions to take action against your clients.

42 In respect of your new clients, Yugen Kaisha Como, we no longer have any conflict of interest in respect of their trade mark application and that matter rests here. We must reiterate that at no material time was there any information nor suggestion that Yugen Kaisha was related to your clients, Associated Enterprises Inc. Further we find it very strange that Yugen Kaisha is allegedly merely an agent of your client in the registration of the mark "Japan Como". As

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you know, an agent is not the proprietor of the mark and has no locus to apply for registration.

43 If you wish to refer the matter of whether we are in conflict of interest in respect of our clients' claim against your clients, AEI to the Law Society, you are at liberty to do so.

44 The defendants' solicitors then wrote to the Law Society on 5 October 1991. On 7 Oct 1991 the Executive Director of the Law Society informed the defendants' solicitors that the matter would be referred to the Chairman, Rules & Etiquette Committee, for his attention and that the Committee's decision would be conveyed in due course.

45 On 25 October 1991 Drew & Napier wrote to the defendants' solicitors asking for an immediate reply to para 2 of their letter of 26 September 1991 as they had instructions to commence proceedings.

46 On 31 October 1991 the defendants' solicitors wrote to Drew & Napier stating that the defendants took objection to Drew & Napier continuing to act for the first plaintiffs; that to date they had not received a substantive response from the Law Society and ended the letter in these words:

47 If your client is adamant about commencing proceedings in the meantime, we are instructed to request that they engage another firm of solicitors, in place of yourselves, to undertake such proceedings.

48 On 2 November 1991 Drew & Napier wrote to the defendants's solicitors that until the defendants obtained a substantive response from the Law Society confirming the defendants' position that Drew & Napier were in conflict, Drew

& Napier remained on record as solicitors for the first plaintiffs and asked defendants' solicitors to continue to address all further correspondence to them.

49 Murgiana Haq, a partner in Drew & Napier and the solicitor responsible for trade mark registration matters, filed an affidavit in reply to the affidavit of Jenna Leong. Her affidavit is to this effect:

50 She has knowledge of the facts pertaining to Trade Mark Application No S/5005/91 for the trade mark "JAPAN COMO" in Singapore.

51 Messrs Takahashi, a trade mark and patent firm in Tokyo, Japan, instructed Drew & Napier by letter dated 9 May 1991, to file two trade mark applications, one of which was "JAPAN COMO". The application was to be filed in the name of Yugen Kaisha Como, a Japanese Corporation, and the goods to be covered by the application were "transceiver, cordless telephone". The letter was signed by Yasuo Takahashi, Patent Attorney.

52 The application was filed with the Registrar of Trade Marks, Singapore, and Application No S/5005/91 with the official filing date of 17 May 1991 was issued. Between that date and the transfer of the application to Messrs Peter Chua, Sobaran & Partners on 25 September 1991, there was no development in this application. All the instructions received from Messrs Takahashi were contained in their letter of 9 May 1991 and save for Drew & Napier's letter of 14 May 1991 advising them on a minor amendment to the specification of goods to be filed, there were no further instructions from Messrs Takahashi.

53 Drew & Napier were not instructed of any connection between the Applicant, Yugen Kaisha Como and AEI. It was only after Drew & Napier received the defendants' solicitors' letter of 18 September 1991 that Drew &

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Napier became aware of the connection between Yugen Kaisha Como and AEI. As soon as Drew & Napier became aware of this association, they immediately replied to defendants' solicitors that they would cease to act for Yugen Kaisha Como in their trade mark application and they took the necessary steps to transfer their file to defendants' solicitors.

54 Drew & Napier did not receive any confidential information from Yugen Kaisha Como or their trade mark attorney Messrs Takahashi in the matter of the trade mark application and no information about Yugen Kaisha Como's business or its connection with AEI was given to Drew & Napier.

55 The main contention of the defendants was that Drew & Napier received confidential information when they filed the trade mark application for Yugen Kaisha Como. The defendants, however, had not adduced any evidence what was the confidential information received by Drew & Napier. The affidavit of Murgiana Haq positively stated that Drew & Napier were not in possession of any confidential information.

56 I was satisfied that Drew & Napier were not in possession of any confidential information and I found that there was no conflict of interest or duty in Drew & Napier acting for the plaintiffs.

57 I said that I would proceed to hear the Motion. Defendants' counsel applied for an adjournment so that the defendants could file an affidavit on the merits. I refused to grant an adjournment.

58 The Motion before me dealt with a claim between the plaintiffs and the defendants. The preliminary objection raised by the defendants was against Drew & Napier. On the authorities, the proper approach for the defendants, if

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they felt that Drew & Napier were in a position of conflict, was to institute proceedings against Drew & Napier and apply for an injunction to restrain Drew & Napier from acting in this matter. It was not open to the defendants to raise this as an issue in the present proceedings which were between the plaintiffs and the defendants and did not concern Drew & Napier.

59 The plaintiffs' solicitors had sent two letters to the defendants' solicitors, one on 24 January 1992 and the other on 25 January 1992 giving them notice that if the defendants' preliminary objection was overruled they would ask for the interim injunction.

60 To grant the adjournment would prejudice the plaintiffs. The application for adjournment was another attempt by the defendants to delay the hearing of this Motion.

61 I made an order in terms of prayers 1 and 2 of the Motion. I also ordered that the defendants pay the costs of their application on the preliminary objection.

Chua F A J

Dedar Singh (Drew & Napier) for the plaintiffs
Lam Wai Seng (Peter Chua, Sobaran & Partners) for the defendants

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