Singsung Pte Ltd and another *v* LG 26 Electronics Pte Ltd (Trading as L S Electrical Trading) and another
[2015] SGHC 148

Case Number	: Suit No 238 of 2012
Decision Date	: 29 May 2015
Tribunal/Court	: High Court
Coram	: George Wei JC (as he then was)
Counsel Name(s)	: Adrian Tan Gim Hai, Ong Pei Ching and Loh Jien Li (Morgan Lewis Stamford LLC) for the plaintiffs; Philip Ling (Wong Tan & Molly Lim LLC) for the defendants.
Parties	: SINGSUNG PTE LTD — SEE LAM HUAT — LG 26 ELECTRONICS PTE LTD (Trading as L S Electrical Trading) — SEE LAM SENG

Intellectual property – Passing off – Copyright

Tort – Defamation – Malicious falsehood

[LawNet Editorial Note: The appeal to this decision in Civil Appeal No 135 of 2015 was allowed by the Court of Appeal on 23 May 2016. See [2016] SGCA 33.]

29 May 2015 Judgment reserved.

George Wei J:

1 In Suit No 238 of 2012, the plaintiffs commenced proceedings and claimed against the defendants on the grounds of passing off, copyright infringement and defamation. The defendants counterclaimed for malicious falsehood and groundless threats of a copyright infringement action. The present trial is bifurcated, and I am only concerned with liability at this stage. In full recognition that this judgment is of substantial length and complexity, I add a glossary of the key acronyms used in the judgment for the reader's convenience in an appendix at the end of the judgment.

The background to the claims

2 A large number of factual disputes and issues was raised by the parties. Instead of setting out all my factual findings here, I set out only a brief summary of the main events leading up to the dispute. I will discuss my specific factual findings in greater detail where relevant to the legal issues before me.

3 The dispute between the parties has a long history, going back well over 15 years. At trial, the parties' recollections of the dates and details of many material events were often inconsistent or hazy.

S H Econ Electrical Trading

4 See Lam Huat ("the 2nd Plaintiff") and See Lam Seng ("the 2nd Defendant") are brothers. Sometime in 1998, the 2nd Defendant started a sole proprietorship under the name of S H Econ Electrical Trading ("S H Econ"). [note: 1] In 2001, S H Econ was converted into a partnership in the

names of the 2nd Defendant and his other brother, See Lam Quee ("SLQ"). [note: 2] In reality, S H Econ was a partnership between the 2nd Plaintiff and the 2nd Defendant. Although the 2nd Plaintiff was not formally named as a partner, SLQ's shares and interest in the partnership were held on trust for the 2nd Plaintiff. [note: 3] The brothers entered into this complicated arrangement because the 2nd Plaintiff was being sued by a creditor, and he did not want the legal dispute to jeopardise the business. [note: 4]

5 It appears that S H Econ was (at least initially) in the business of acquiring outdated and/or second-hand electrical and household products in Singapore and Malaysia for resale to customers overseas. [note: 5] It is unclear how the partnership was run. The role played by each partner in the partnership was never clearly explained to the court. No written partnership agreement of any sort has been adduced in evidence.

6 The start of the new millennium witnessed a number of significant events. Apart from the conversion of S H Econ into a partnership, the 2nd Defendant and SLQ purchased three shop houses in Singapore ("the Shop Houses"). Legally, the 2nd Defendant and SLQ each held a 50% share in the Shop Houses as tenants-in-common. [note: 6] However, beneficially, SLQ held his share of the Shop Houses on trust for the 2nd Plaintiff. [note: 7] The brothers entered into this arrangement also because the 2nd Plaintiff was worried that any property in his name might be subject to seizure by the same creditor mentioned above. [note: 8]

7 Disputes eventually arose between the brothers over the invoices and accounts of S H Econ. Whilst the evidence as to when the said disputes started is hotly contested and confused, it is clear that by 2005, the relationship between the 2nd Plaintiff and 2nd Defendant had deteriorated. [note: 9] On 9 November 2007, the 2nd Defendant commenced Originating Summons No 1652 of 2007 ("OS 1652/2007") [note: 10] against the 2nd Plaintiff and SLQ to liquidate the Shop Houses, and for an account of monies due to the partners from the S H Econ business. OS 1652/2007 was settled before the actual hearing, set for June 2008. [note: 11]

8 The S H Econ partnership was subsequently dissolved. The date of S H Econ's dissolution is unclear. The 2nd Plaintiff claims that the dissolution happened in 2007. The 2nd Defendant however asserts that S H Econ was only dissolved in 2009. I note in passing, that in all probability, the 2nd Plaintiff and the 2nd Defendant effectively ceased working together sometime around 2007, but the S H Econ partnership was only legally dissolved in January 2009. [note: 12]

Singsung Pte Ltd

9 Either way it is clear that in April 2006, before the dissolution of the S H Econ partnership, the 2nd Plaintiff incorporated Singsung Pte Ltd ("the 1st Plaintiff"). [note: 13] The name "Singsung" was chosen by the 2nd Plaintiff. The 1st Plaintiff was in the business of selling new electrical and household equipment. Whilst the plaintiffs assert that some of these new products were sold in Singapore to Singapore-based customers for use in Singapore, it is apparent that the vast majority of the sales were to trade buyers who exported the products overseas. [note: 14] Further, whilst the plaintiffs assert that their trade buyer customers come from a variety of African and Asian countries, it appears that most of the new products were acquired by foreign trade buyers for sale to end users (or consumers) in Africa. In particular, the evidence adduced by the parties related *only* to end users from the Republic of Cameroon ("Cameroon"). As such, where the foreign markets in which the plaintiffs' and defendants' products are sold become relevant, my discussion will mainly centre on the

market in Cameroon.

10 The 2nd Plaintiff's position is that the business of the 1st Plaintiff belongs solely to him. In particular, the said business was never a part of S H Econ's business. This is so even though there are invoices which suggest that at least some of the 1st Plaintiff's business operations in 2007 were being conducted through S H Econ. The plaintiffs claim that the 1st Plaintiff's business was conducted in that way purely as a matter of convenience. The question as to whether S H Econ had any interest in the 1st Plaintiff will be discussed later in connection with the plaintiffs' claim for passing off.

LG 26 Electronics Pte Ltd

11 In October 2007, the 2nd Defendant registered L S Electrical Trading ("the 1st Defendant") as a sole proprietorship. [note: 15] Initially, the 1st Defendant dealt only in the purchase and re-sale of *second-hand* electrical goods. However, the 1st Defendant soon expanded into the business of purchasing and selling *new* electrical and household products to foreign trade buyers for export to consumers in Africa and elsewhere. In January 2009, the 1st Defendant, LG26 Electronics Pte Ltd (trading as L S Electrical Trading), was legally incorporated. [note: 16] The brand name adopted by the 2nd Defendant was "LS". The long and short of the evidence is that the brothers had gone their separate ways and were now effectively competitors.

The parties' products

12 The 1st Plaintiff's first line of new products appears to have been DVD players. Subsequently, it expanded its range of products to include television sets, rice cookers, electric kettles, blenders, floor fans and gas stoves. [note: 17]

13 The 1st Plaintiff's business model involves sourcing its products from manufacturers in China. Typically, the 2nd Plaintiff would visit the Chinese factories and examine the range of products the factories had. The products were often displayed in the premises of the factories, or were set out in the factories' catalogues. [note: 18] I pause here to note that it is helpful to determine whether these Chinese factories are original *equipment* manufacturers ("OEMs"), or original *design* manufacturers ("ODMs"). Whilst these are not legal terms but trade terms, and whilst the legal principles of intellectual property law do not depend on these categories, an appreciation of the factual differences between these two types of manufacturers is helpful. To be clear, I use the terms OEM and ODM in this judgment purely for convenience and expediency.

14 An OEM generally refers to a manufacturer who produces component parts for another manufacturer, who then incorporates the component parts into its products. The final products are sold under the second manufacturer's brand name. For example, where a United States computer manufacturer orders the hard disk drives installed inside its computers from a Chinese disk manufacturer, the latter is an OEM.

15 However, consider the following example: Company A designs and manufactures a product, which is sold to Company B. Company B then releases and sells the product into the market under its own brand. In this example, Company A is not an OEM, but an ODM.

16 There can be many variants of the factual pattern described above, and the exact relationship between Company A and Company B will depend on the particular facts. In some cases, Company B may be permitted to request certain design alterations or modifications. In other cases, Company A may design and produce the product under its own brand. Subsequently, it may enter into an

arrangement with Company B whereby Company B can apply its own brand to the product under some form of reseller arrangement.

17 In the present case, it appears that the Chinese factories were in the position of being ODMs because they designed and manufactured the 1st Plaintiff's products. In many cases, the Chinese factories offered numerous different models of a particular product line. The models were of different sizes, surface designs and decoration, or technical features. Customers such as the 1st Plaintiff ordered the model(s) of their choosing, and in some cases, asked for changes to particular aspects of the product. This included requests relating to the packaging.

18 The question as to who owns the intellectual property rights in the design and technology of the products (if any) depends on the facts of each case. *Prima facie*, any industrial design right will likely belong to the ODM. Any technology invented or developed by the ODM will also likely belong to him. In other words, going back to the example I gave above, *prima facie*, Company A owns the intellectual property rights in the design and technology of the products that it designs and manufacturers and then sells to Company B.

19 However, the question whether Company B acquires rights over the design and technology will depend on whether these have been assigned or licensed (any type of licence) by Company A to Company B. It also depends on whether Company B brought in any intellectual property of its own to the products. The question as to whether the ODM (*ie*, Company A) has lost the right to sell the chosen models to other customers, including competitors of Company B, also must depend primarily on the *agreement reached between the parties*. In some cases, Company A may agree to sell the selected range of products exclusively to Company B. In other cases, there may be no express restriction or other limitation placed on Company A's right to sell the same range of products to other customers. Further, questions may arise over the legal rights in respect of changes or alterations made at the request and/or instruction of Company B.

20 It should also be kept in mind that the position is rendered even more complex by the range of different intellectual property rights that may exist in relation to the products. Even if Company A owns the industrial design rights in a product, this does not mean that Company B cannot acquire goodwill over aspects of the product's get-up in a particular market. Such goodwill would enable Company B to claim protection over those aspects of get-up under the tort of passing off.

21 In the present case, it is clear that the 2nd Plaintiff would visit the Chinese ODMs and place a bulk order for the products of his choosing. Depending on the factory and the type of product, some degree of customisation of the product and the packaging was possible. I give some examples of the customisation requested by the 2nd Plaintiff.

(a) In the case of the DVD players, the plaintiffs were able to secure some changes to the number of ports provided at the back of the player. Additionally, the plaintiffs were allowed to make suggestions in respect of the design of packaging. [note: 19]

(b) In the case of television sets, the plaintiffs requested that a sticker be placed on the screen, setting out key features or functions of the product. [note: 20]

(c) The 1st Plaintiff's brand "SINGSUNG", the statement "Made in Singapore", and the Plaintiff's warranty card was also affixed to some of the 1st Plaintiff's products and packaging. [note: 21]

22 To sum up the above discussion, whilst the plaintiffs could and did request for some changes to the products they ordered from the Chinese manufacturers, it is clear that the plaintiffs were *not* the manufacturers of the products. Neither can they be properly regarded as the designers of the products, save in the manner that I have briefly alluded to (*ie*, by making small alterations and additions to the products). They were in a loose sense resellers who have applied their own brand to the acquired products. The brand names were affixed or applied in China by the ODMs. The evidence that some of the Chinese manufacturers may have assigned the intellectual property rights over the design and technology embodied in the products to the plaintiffs is unclear, and will be referred to later. Indeed, as will be seen and discussed in more detail below, the Chinese manufacturers were, in general, prepared to sell their product range to any trade buyer.

23 Aside from requesting changes to the appearance of the packaging, and on some occasions, requesting minor changes to the product, the main effort expended by the 2nd Plaintiff was to be found in his selection of particular models from a product line which he thought would be attractive to the overseas trade buyers, and in particular the African trade buyers. On all accounts, it appears that the 1st Plaintiff's business was rather successful, chalking up substantial sales to trade buyers from Africa. [note: 22]

The plaintiffs' grievances

24 Essentially, the core of the plaintiffs' complaint against the defendants is that they chose to shadow the business of the 1st Plaintiff. The 2nd Plaintiff (through the 1st Plaintiff) moved into the business of acquiring *new* electrical and household products for sale to overseas trade buyers first. The defendants decided to follow suit even though they started their business with the sale of second-hand equipment. They also moved into new products.

25 One of the plaintiffs' biggest grievances is clearly that the products chosen by the defendants were essentially identical to those chosen by the 2nd Plaintiff and sold by the 1st Plaintiff. For example, if the plaintiffs purchased and started selling electric kettles with a particular pattern and shape, the defendants would follow suit and place orders for the same or similar kettles. Sometimes, the Chinese manufacturer selected by the defendants turned out to be the same as the one who supplied the goods to the 1st Plaintiff. [note: 23]

26 The export market targeted was also the same, namely, overseas trade buyers from, in particular, Cameroon. [note: 24]

27 At this point, I note again that the evidence does not establish that the plaintiffs are the designers of the products they chose. As will be seen, a huge range of kettles were designed by the Chinese manufacturers and displayed or set out in catalogues for wholesale buyers to choose from. On the whole, the evidence is that these Chinese design manufacturers would sell their products to any wholesale merchant. If exclusivity was required, this would have to be contractually provided for.

28 Complaint was also made that in some cases, the defendants did not just choose the same or a similar *product*, but they also used similar *packaging* (*eg*, the cartons in which the products were presented for sale to retail customers). This was so in the case of the DVD players and televisions. In the case of the televisions, the defendants did not merely choose similar television models; they also requested similar stickers. [note: 25]

29 Whilst it is clear that the defendants decided to "shadow" the 1st Plaintiff's business, I should stress that the *brand name* affixed to the 1st Defendant's new products is completely different from

the 1st Plaintiff's. The 1st Plaintiff's brand is "SINGSUNG". The 1st Defendant's brand is "LS".

30 After placing the bulk orders, the shipments would arrive in Singapore, where they were stored in warehouses. The 1st Plaintiff had a shop at 38/39 Upper Weld Road Singapore. The defendants' shop was next door, at 36/37 Upper Weld Road. [note: 26] The evidence was that trade buyers would visit Singapore and attend at the shop premises (and elsewhere) for discussion and selection of products. After orders were placed, the consignment would be loaded into containers and shipped to the trade buyers' home country, where they would eventually be on-sold by the trade buyers to retail shops and end users.

31 That said, the evidence as to how *exactly* the placement of orders with the Chinese manufacturers, the shipment to Singapore, and sale to trade buyers from Africa were carried out, was in dispute. In particular, the defendants' general position is that the goods merely transited through Singapore, and then went straight on to Africa. [note: 27] This formed the basis of their submission that any goodwill enjoyed by the 1st Plaintiff (if at all) is only so enjoyed in Africa.

32 The plaintiffs complain that even if the trade buyers were not confused over the origin of the LS products that they selected in Singapore, the end-buyers (consumers) in Cameroon would be confused. Given the products had the same or similar design, members of the public in Cameroon would purchase "LS" products under the impression that they were connected in some way with the 1st Plaintiff and the SINGSUNG brand. [note: 28] The complaint is that the defendants were effectively copying the business of the 1st Plaintiff.

The claims and issues

33 The plaintiffs' main cause of action is founded on passing off. Without going into the details, the claim is in respect of goodwill asserted in the "get-up" and certain design aspects of the following products belonging to the 1st Plaintiff: DVD players, television sets, rice cookers, electric kettles, electric blenders, electric floor fans and gas stoves. The following issues arise in respect of this claim:

(a) Is there goodwill in the claimed badges or indicators of origin?

(b) Was there a misrepresentation by the defendants likely to cause confusion? Specifically, can there be liability for passing off in Singapore where the confusion (assuming this is proved) in respect of the goods supplied from Singapore arises solely or mainly in an *overseas market*, and not in Singapore? I note here that there is no claim before me that while the tort of passing off was committed in another country, the foreign tort is actionable in Singapore under applicable principles of private international law: on this point, see Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* vol 2 (Sweet & Maxwell, 3rd Ed, 2014) ("*Tan Tee Jim*") at paras 19.314–19.322.

(c) Has there been damage, or is there likely to be damage, to the 1st Plaintiff's goodwill?

34 In addition, the plaintiffs claim copyright over some pictures on the packaging of the DVD players, the start-up screen built into the DVD players, the design of a sticker, a logo and a floral pattern. By logo, what is referred to is the phrase "Rotary Rotatory" set out in a cursive font. The following issues arise in relation to the copyright infringement claim:

(a) Is there any copyright subject matter over which the plaintiffs can claim ownership?

(b) If there is, are the defendants liable for copyright infringement in Singapore?

35 I note that the defendants deny copyright infringement, and counterclaim for losses arising from the plaintiffs making groundless threats of a copyright infringement action.

36 The 2nd Plaintiff also proceeds against the 2nd Defendant in the tort of defamation. The 2nd Plaintiff claims that the 2nd Defendant defamed him when the latter made remarks to a visiting trade buyer describing the 2nd Plaintiff as, *inter alia*, a cheat. These are the issues which I have to decide in relation to defamation:

(a) Did the 2nd Defendant utter the words alleged?

(b) If he did, do the words spoken by the 2nd Defendant bear a defamatory meaning?

(c) If the words do bear a defamatory meaning, do the defences of justification or qualified privilege apply?

37 The defendants, on the other hand, counterclaim for malicious falsehood. They allege that the 2nd Plaintiff made disparaging remarks about the quality of the 1st Defendant's products to a trade buyer. The principal issues here are whether the disparaging statement was true, whether it was made maliciously, and whether it has resulted in special damage.

38 I note that no claim has been brought for registered trade mark infringement. There is also no claim in respect of registered design rights or patent rights.

The witnesses

39 At trial, 11 witnesses gave evidence. Given the large number of factual and legal disputes, as well as the length of the cross-examination, I propose to set out a brief summary of the main areas of evidence covered by each witness. Where relevant, portions of the evidence will be discussed in more detail later in the judgment.

Plaintiffs' witnesses

40 See Lam Huat: the 2nd Plaintiff was the principal witness for the plaintiffs. His evidence traversed the background to the dispute, as briefly set out above. In particular, he gave evidence on:

(a) how he came to select the products that are the subject matter of the dispute;

(b) his visits to the factories and manufacturers in China; and

(c) the inputs he claimed to have made in respect of the packaging and get-up of the products in dispute, including design changes to the number of ports on the DVD players, his requests for warranty cards, stickers, and so forth.

41 The thrust of his evidence was that he spent considerable time and effort selecting products he thought would appeal to end users. [note: 29] The models or products that he selected were of high quality. The end users (in Cameroon) were familiar with the "SINGSUNG" brand and associated it with high quality products from Singapore. The products generally bore the statement "Made in Singapore", even though the products were essentially designed and made in China. In some cases, Singapore warranty cards in SINGSUNG's name were provided even though the end user in Cameroon had no effective recourse against the plaintiffs should the 1st Plaintiff's products turn out to be defective.

The end user's only recourse was to bring the defective product back to the retail shop in Cameroon. His evidence was that customers in Cameroon associated Singapore with high quality products, and that "SINGSUNG" had acquired a good reputation in that market. [note: 30]

42 Huang Bao Yu ("HBY"): HBY was a marketing representative from the Chinese manufacturer that supplied blenders to the plaintiffs. Her evidence primarily concerned a catalogue of products that the Chinese manufacturer made available to its customers. The catalogue sets out a broad range of blenders from which the customer could make a selection. The 1st Plaintiff was one such customer. The witness testified that the catalogue sets out the whole range of blenders offered, and that the Chinese manufacturer designed all the products. [note: 31] The witness also gave evidence on her company's business dealings and relationship with the defendants, as well as the defendants' requests for blenders of a particular design and warranty cards.

43 Serene Chew Wanlin ("SEC"): SEC is an arts management student. The 1st Plaintiff briefly employed her as an administrative assistant from January to July 2010. Her evidence mainly concerned her role in assisting the 2nd Plaintiff develop designs for the packaging of the DVD players and the sticker for a range of television sets that the plaintiffs had sourced from Chinese manufacturers.

44 Guy Emmanuel Ntoudam ("GEN"): GEN is a businessman from Douala, Cameroon. He is in the import and retail-goods business. Products that he sources from overseas include DVD players, television sets, electric blenders, floor fans and gas stoves of the SINGSUNG brand. These are obtained from the plaintiffs in Singapore. This witness gave evidence of the market in Cameroon, the competition in Douala between SINGSUNG branded products and LS appliances, as well as the alleged confusion that had arisen amongst the end consumers. [note: 32] The witness also testified that he made several visits to the defendants' shop in Singapore in September 2011, during which the 2nd Defendant made derogatory remarks about the 2nd Plaintiff.

45 Chen Yongxiu ("CYX"): CYX was employed by the 1st Plaintiff as a quality control manager. She was based at the 1st Plaintiff's office in Shenzhen, China. Her evidence traversed the 2nd Plaintiff's working visits to factories in China and the inputs made by the 2nd Plaintiff on design tweaks to various products purchased from those factories. Her evidence touched on nearly all the disputed products: the DVD players, television sets, electric kettles, blenders and rice cookers. She also gave evidence on the competition from and alleged copying by the defendants.

Defendants' witnesses

46 See Lam Seng: the 2nd Defendant was the main witness for the defence. His evidence traversed the same ground as the 2nd Plaintiff, and included testimony on the business of S H Econ, the split between the brothers, and the development of the 1st Defendant's business (including his role in selecting products from the Chinese manufacturers). The general tenor of his evidence was that he would look for particular models or designs from the Chinese manufacturers based on requests from customers.

47 Dong Li ("DL"): DL was an employee of the 1st Defendant and was based in Hong Kong. Her job was to place and process orders for products (in particular the television sets, rice cookers, and blenders) selected by the defendants with the Chinese ODMs. This included making requests for certain design changes as well as warranty cards.

48 See Nam Hai ("SNH"): SNH was a brother of the 2nd Plaintiff and the 2nd Defendant. His

evidence concerned his own business dealing with second-hand electrical goods and his relationship with the defendants. He also gave evidence on the breakup of the partnership at S H Econ, and testified that he helps out at the 1st Defendant's shop.

49 Talla Simplice Adolphe ("TSA"): TSA was a trader from Cameroon. His evidence touched on the nature of the market in Cameroon for electrical household products and "famous" brands such as "SONY", "SAMSUNG" and "LG". [note: 33] This witness also gave evidence on the presence of Singapore brands such as "SINGSUNG", "LS" and "Sole Star" in the African market. The witness explained his business dealings with the plaintiffs and the defendants, and testified as to why he eventually decided to place orders with the defendants. This witness also gave evidence of disparaging remarks allegedly made by the 2nd Plaintiff about the quality of the 1st Defendant's goods. [note: 34]

50 Phang Ti Hui ("PTH"): PTH is a Singapore businessman who accompanied the 2nd Defendant on some of his trips to China. The purpose of those trips was to purchase DVD players and television sets for the 1st Defendant's business. His evidence touched on the extent to which the Chinese manufacturers offered customization of the products and packaging.

An overview of the plaintiffs' claims

51 Before I turn to consider each issue in detail, an overview of the plaintiffs' claims may be helpful given the large number of issues before the court.

Passing off

52 The plaintiffs' claim in passing off is primarily based on the allegation that the defendants copied the design, get-up and packaging of the 1st Plaintiff's products in manufacturing their own products. There is no allegation that the defendants used the 1st Plaintiff's brand ("SINGSUNG") as such (save possibly in some warranty cards). Indeed, it is not disputed that the brand chosen and used by the 1st Defendant on its products (*ie*, "LS") is completely different from the 1st Plaintiff's brand. To be absolutely clear, the plaintiffs' passing off claim is not based on goodwill in its brand name "SINGSUNG", but in the get-up described below.

53 I now identify and describe (where possible) the specific get-up and packaging of each of the 1st Plaintiff's products that are the subject matter of the present dispute, and which the plaintiffs claim are the generators of goodwill:

(a) Packaging of DVD Player Model A ("DVD A"). I shall call this the "White Get-Up". This refers to the use of a white carton box depicting, amongst other things, a photographic image of a modern living room and guitars.

(b) Packaging of DVD Player Model B ("DVD B"). I shall call this the "Blue Get-Up". This refers to the use of a blue carton box depicting, amongst other things, an image of the actual DVD player. The evidence suggests that there were in fact a number of versions of DVD B sourced by the plaintiffs and on-sold to African importers.

(c) Start-up screen of DVD A and DVD B. This refers to an image that appears on the television when the DVD player is turned on. The image comprises snow-capped mountains set against a blue sky with white clouds.

(d) Warranty card on DVD A and DVD B. This refers to the warranty card provided with the SINGSUNG DVD players.

(e) Design of the back panel of DVD A and DVD B.

(f) Stickers on DVD A and DVD B. The sticker is placed on the front panel of DVD A and DVD B, setting out key functions and attributes of DVD A and DVD B, such as "USB Download Function" and "32 Digital Game".

(g) Sticker on television sets. The design and placement of a sticker on the television screen, setting out key features and attributes of the television, such as "Rotary Rotatory", and a symbol indicating that the TV can swivel 90 degrees. The phrase "Rotary Rotatory" also appears on the packaging of the television set.

(h) Floral pattern on the rice cooker. There is a floral pattern design on the side of the rice cooker. It is noted that whilst the 1st Plaintiff and the 1st Defendant dealt with a range of rice cookers, the plaintiffs' claim was in respect of "model no RC-18L".

(i) In relation to the electric kettles, the plaintiffs referred to the shape and design of five different electric kettles, each with its own get-up. The plaintiffs described these five kettles as possessing the "Domed-Get-up", the "Pitcher Plant Get-Up", the "White Curved Kettle Get-Up", the "Penguin Kettle Get-Up", and the "Metallic Get-Up".

(j) In relation to the electric blenders, the plaintiffs referred to the shape and design of three different electric blenders. Each of these blenders possesses its own get-up, and has been described by the plaintiffs as the "White and Grey Get-Up", the "Black and White Get-Up" and the "Black Stainless Steel Get-Up".

(k) Get-up of the electric floor fans. This refers to a particular model of fans, CRSF-18A, which contain a round plastic base made in the shape of a car steering wheel.

(l) Get-up of the gas stoves. This refers to the design of gas stove GS-88, comprising features like an embossed horse-shoe shape bearing the SINGSUNG brand, as well as a gold coloured burner rimmed by a circular chrome support pot.

I refer to this collectively as "the SINGSUNG Get-Up".

54 I repeat the observation I made above, that all of the above products were designed and made in China by ODMs.

55 The plaintiffs adduced evidence of its substantial sales in Singapore to overseas trade buyers, as well as some sales to Singapore-based customers. The defendants deny that any sales to Singapore-based customers exist. However, even taking the plaintiffs' evidence at face value and at its highest, it is clear that the 1st Plaintiff's sales to Singapore-based customers is very significantly less than its sales to wholesale buyers from Africa. These wholesale buyers ordered products from the 1st Plaintiff in Singapore for export and sale to consumers overseas.

56 The plaintiffs also assert that the defendants had used similar expressions in marketing or advertising their rival products. In particular, the plaintiffs point out that the phrase "*Rely on us, as amongst the FINEST, we offer the MOST affordable prices*" can be found in both English and Swahili in the 1st Plaintiff's catalogue. [note: 35] This phrase is also found in the LS catalogue. [note: 36] In

response, the 2nd Defendant asserts that he did not intend to copy the 1st Plaintiff's catalogue, and that he used it for reference only. [note: 37] I should point out that the plaintiffs have not asserted any rights in the phrases as such. Instead, they merely rely on the alleged use of the phrases as *evidence* of the defendants' intention to copy the 1st Plaintiff's business and to cause confusion.

57 The passing off claim, as it developed during the course of the hearing, appears to be founded on two different submissions. First, the plaintiffs' claim that the defendants have passed off their products as being those of the 1st Plaintiff. Second, the plaintiffs' claim that defendants have passed off their business as being associated with or connected with the 1st Plaintiff. What has not been clearly pleaded in my view, however, is the *exact form* of the passing off. Given the 1st Plaintiff is not a direct retailer, but is more a wholesale trade buyer in Singapore which sells its products to middlemen who export the products to other countries, precisely identifying the relevant market in which passing off is claimed to have taken place is crucial. I elaborate on this below.

Copyright

58 The plaintiffs' copyright claim is advanced on the basis of the following works:

(a) The "White Get-Up" picture comprising a DVD player, guitar and a sitting room. As mentioned previously, this is found on the packaging of DVD A.

(b) The "Blue Get-Up" picture comprising the picture of a DVD player. As mentioned previously, this is found on the packaging of DVD B.

(c) The sticker pasted on the television sets.

(d) The phrase "Rotary Rotatory" in cursive font found on the sticker and the packaging of the television sets.

(e) The floral pattern on the rice cookers.

(f) The start-up screen linked to the DVD players.

59 The plaintiffs assert that the above works attract copyright protection as *original artistic works* in Singapore. There is no claim to literary copyright or any other type of copyright subject matter. [note: 38]

Defamation

60 The claim of defamation is a claim by the 2nd Plaintiff against the 2nd Defendant, based on certain words spoken by the 2nd Defendant to GEN. According to the 2nd Plaintiff, the 2nd Defendant had said that:

(a) the 2nd Plaintiff cheated the 2nd Defendant;

(b) the 2nd Plaintiff was a "big Ali Baba man";

(c) the 2nd Plaintiff was "a very crazy man"; and

(d) the 2nd Plaintiff was "very dangerous."

61 In addition, there is an allegation that the 2nd Defendant uttered words to the effect that the 1st Plaintiff had sold some defective DVD players and TV sets. Apart from having to resolve the factual dispute as to whether the 2nd Defendant did indeed speak the words described above, the question arises as to whether those words are defamatory, and if so, whether the defence of justification and/or qualified privilege applies. Now that I have set out broadly the claims made by the parties, I turn to analyse the plaintiffs' first claim: passing off.

Passing off

The plaintiffs' pleaded case

62 As alluded to above, the plaintiffs' pleaded case for passing off is somewhat unclear. The lack of clarity, in my view, mainly stemmed from insufficient attention to the territorially-specific nature of any passing off claim.

63 It is well established that for a passing off claim to succeed, a plaintiff needs to prove goodwill, misrepresentation, and damage: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 at [36] ("*Novelty v Amanresorts*"). It is also well established that the goodwill must exist, and the misrepresentation must take place, in the relevant jurisdiction or market with which the particular court is concerned. So, before a Singapore court, it must ordinarily be established that goodwill exists in Singapore for a passing off claim in Singapore to succeed: *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and another and another appeal* [2014] 1 SLR 911 at [130]. Likewise, goodwill must exist in the United Kingdom ("the UK") for a passing off action in the UK to succeed: *Tan Tee Jim* at para 19.144 and *Starbucks (HK) Limited and anor v British Sky Broadcasting Group PLC and others* [2015] UKSC 31 ("*Starbucks (HK)*"). I state at the outset that there are qualifications to this principle, one of which is crucial to this case, and which I will discuss in greater detail below.

64 It follows that a plaintiff pursuing a passing off claim involving foreign elements needs to plead his case very precisely. It is insufficient for a plaintiff to state that his brand name or get-up (or whatever he claims to be a generator of goodwill) has generated goodwill. It is essential that he pleads and proves that the goodwill he owns exists in the relevant jurisdiction. It is also essential that he pleads and proves that a misrepresentation has taken place in the relevant jurisdiction.

65 In the present case, the plaintiffs have failed to plead essential details about their passing off claim in the statement of claim. While the plaintiffs assert in their statement of claim that the SINGSUNG Get-Up has "gained goodwill", [note: 39] and that it "denotes to the trade and public that the Singsung Products are of the 1st Plaintiff", [note: 40] they never once specify which "trade and public" they refer to, or *where* the SINGSUNG Get-Up has "gained goodwill". Much is left for the court to infer based on the evidence the plaintiffs present and the arguments they employ.

66 Indeed, the language used in the pleadings on misrepresentation was also vague on this issue. I quote portions of the plaintiffs' statement of claim to illustrate my point: [note: 41]

> 27. The 1st Defendant's distribution, sale, offering for sale and/or dealing in the Offending Products bearing get-up and stickers identical or confusingly similar to the Singsung Products in meaning and commercial impression is calculated to deceive and/or mislead the *trade and public* and has in fact deceived and/or misled the *trade and public* into believing that the Offending Products originate from and are somehow associated with those of the 1st Plaintiff ...

27A. Further and in the alternative, by reason of the foregoing, the Defendants have passed off the business of the 1st Defendant as and for that of the 1st Plaintiff, or has confused the *trade and public* into thinking that the business of the 1st Defendant is associated with that of the 1st Plaintiff, when that is not the case.

[emphasis added]

67 It can be seen that the reader is left uncertain as to *where* the misrepresentation has taken place. In particular, it is wholly unclear which "trade and public" is deceived, misled or confused.

68 I bring up this point about pleadings because it is particularly pertinent for a plaintiff in a case with facts which involve domestic and foreign markets to be sensitive to the territorial nature of a passing off claim, and plead its claim(s) precisely. Here, there are several markets and jurisdictions potentially involved—Singapore, Cameroon, and all other markets to which the 1st Plaintiff's products are exported. As such, without clear pleadings, the court will have real difficulty evaluating the plaintiffs' passing off claim.

69 Nevertheless, notwithstanding the lack of clarity in the pleadings, the plaintiffs eventually developed their case as we drew to the end of trial. In their closing submissions, the plaintiffs remained somewhat unclear about the jurisdiction in which they claim goodwill exists. They state that "Singsung has the requisite goodwill" in their closing submissions, [note: 42] but clearly, that is not sufficiently particularised. Some clarity may however be sought from the way the plaintiffs describe the misrepresentations they claim have taken place. They claim firstly, that the defendants confused the traders that visited the 1st Defendant's shop in Singapore; [note: 43] and secondly, they claim that the ultimate consumer in Africa is also confused. [note: 44] Using the plaintiffs' own words, "passing-off is likely to occur at the point of sale, and even post-sale, to the ultimate consumer". [note: 45]

70 From the above, I believe it may be reasonably deduced that the plaintiffs' passing off claim (in brief) is two-fold:

(a) First, passing off takes place straightforwardly in Singapore because goodwill in the SINGSUNG Get-Up exists in Singapore, and trade consumers/customers who buy directly from the plaintiffs and defendants are deceived or confused by the similar get-up on the defendants' products. I call this the straightforward passing off claim.

(b) Second, passing off takes place in Singapore because by selling their infringing products to overseas trade buyers in Singapore, the defendants put into circulation "instruments of deception". This second claim is supported by proof that goodwill exists in Cameroon (rather than Singapore), and that there is confusion there between the plaintiffs' and defendants' products because of the similar get-up.

71 It is on the basis of the above two claims (so characterised) that I shall proceed. I note that while the language of "instruments of deceptions" cannot be found in the pleadings, in fairness to the plaintiffs, such an argument is made in their closing submissions at paras 89–93. I shall discuss the law and the evidence in relation to each of the above two claims separately.

Interaction between the tort of passing off and other intellectual property protection

72 Before discussing the passing off claim any further, it may be helpful to briefly explore the

interaction between the tort of passing off and other intellectual property protection (such as copyright and industrial design protection). In particular, given that several different intellectual and industrial property rights can be claimed in respect of a single product, it is crucial to have a clear understanding of the distinctions between the various available rights. This would help to bring into sharper focus the aim of the law of passing off, as well as provide a helpful context for the subsequent discussion on passing off and the dispute that has arisen between the parties.

73 Passing off is not concerned with product design as such. Depending on the design in question and the surrounding circumstances, a design might be protected by registration under the Registered Designs Act (Cap 266, 2005 Rev Ed). Registered design law is concerned with the protection of industrial designs. This includes protecting the appearance of articles of manufacture where the said appearance, in whole or in part, is chosen because of the visual statement that is made.

74 In some cases, it may also be possible to assert copyright in industrial design drawings, sketches, sculptures, models, works of artistic craftsmanship or engravings. These works can constitute original artistic works protected under copyright law. I note that while in the early days, copyright in an artistic work was thought to be concerned *only* with works of art, it has long since been established that "artistic works" can include works like engineering drawings which serve a purely functional purpose.

75 The law has long been concerned to maintain the line between registered design and copyright laws. Extensive and complicated provisions now exist to limit the copyright protection given to designs that are capable of protection under the registered design system. If the law was otherwise, the carefully crafted checks and balances woven into registered design law could be circumvented by a proprietor's decision not to register the industrial design, and to rely on copyright instead. Indeed, these issues have provoked considerable academic discussion.

76 Different rights under the tort of passing off and trade mark law may also come into play where product get-up and shape are concerned. Both the get-up and shape of a product (which may be the subject matter of the tort of passing off and registered trade mark law), as well as the industrial (or registered) design of a product, are primarily concerned with *visual appearance*.

77 However, and crucially, the difference between passing off and registered design rights lies in the function that the appearance of the product performs: is the get-up or shape serving the role of an *indicator of trade origin* (to distinguish the goods from one trade source from those from another trade source), or is it simply there to make an *"aesthetic" contribution* via the visual statement it makes?

78 A designer may select a particular design feature (such as a specific pattern, ornamentation, colour combination, or shape) because the said feature would be, in the designer's judgment, attractive to his customers. A customer who selects a product for its design may do so because the design is pleasing to the eye, or because the design is "functional" and makes the article easy to use. Indeed, I have no doubt that considerable thought is often expended to make the design of an article aesthetically pleasing, yet simple and functional.

79 However, the aesthetic or functional value of a product design is not the concern of passing off. Regardless of the effort and skill put into coming up with the design feature, the said feature does not automatically become an *indicator of trade origin*. What is necessary for passing off is proof that the public perceives the design feature to be an indicator of a particular trade origin. The design feature must interact with the customer in such a way that it provides the customer with an indicator of origin.

80 To better understand what it means to perform the function of being an indicator of trade origin, we may pause to consider the role of brand names. The primary function or value of appending a brand name onto a product is usually not to make the product look nice or functional. The fundamental importance of a brand name resides in its role as an indicator of trade origin.

81 From the above discussion, it should be clear that the tort of passing off is *exclusively* concerned with protecting goodwill generated through the use of indicia of trade origin. It is not concerned with protecting product design for its aesthetic or functional value. If this were not so, the tort of passing off would be encroaching into areas that are within the purview of industrial design law.

82 It should be noted that alongside the common law of passing off is a registration system for protecting trade marks, which directly protects indicia of trade origin. Under s 2(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the TMA"), a "trade mark" is defined as:

> ... [A]ny sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person ...

83 A "sign" is defined in s 2(1) of the TMA as including: "any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof".

84 At this juncture, I note in particular that the protection trade mark law gives to the *shape* of an article is very limited. Whilst the shape of an article can amount to a "sign", it is necessary to show that the "sign" is capable of distinguishing goods or services in the course of trade from those of any other person. Signs that are highly descriptive of the goods or services in question may be rejected because they lack distinctiveness, *ie*, the capability to distinguish competing brands in the market place. Some shapes may be excluded from registration as a trade mark because it lacks distinctiveness.

85 Moreover, even if the shape of a product is found to possess the capability to distinguish, s 7(3) of the TMA sets out important exclusions to the protection of shapes. It provides that:

> (3) A sign shall not be registered as a trade mark if it consists exclusively of —
>
> (a) the shape which results from the nature of the goods themselves;
>
> (b) the shape of goods which is necessary to obtain a technical result; or
>
> (c) the shape which gives substantial value to the goods.

86 Similar statutory provisions in the UK and Europe have produced a considerable body of case law and academic discussion. Whilst it is not necessary to discuss these developments, the point is that the law has acted with considerable caution in conferring protection on the shape of an article by means of trade mark registration.

87 The reluctance to grant trade mark protection to the shape of products is an outworking of the legislative policy of not easily granting monopolies over particular designs and features of goods. Indeed, the policy considerations discussed in the UK and Europe are rooted in the concern to ensure that trade mark law does not operate in an anti-competitive manner.

88 This anti-competitive concern has been recognised in Singapore as well. In *Nation Fittings (M) Sdn Bhd v Oystertec Plc and another Suit* [2006] 1 SLR(R) 712, Andrew Phang J (as he then was) adopted a narrow interpretation of certain statutory transitional provisions concerning whether a registered two-dimensional mark could be treated as a three-dimensional mark under the TMA. The learned judge expressed the view that an overly expansive approach to granting proprietors trade mark protection might lead to the development of disguised monopolies that may stifle or stymie the general public interest and welfare.

89 In the present case, the plaintiffs do not claim protection of the get-up and design features as "signs" under the TMA. The claim is based solely on the tort of passing off. Nevertheless, it is apparent that similar policy concerns relating to competition arise. The tort of passing off is not about protecting design for the sake of design. Passing off is concerned with preventing unfair competition and is squarely centred on protecting goodwill established by the use of indicia of trade origin in the market place. Bearing these concerns in mind, I now proceed to discuss the law on passing off.

Law on the tort of passing off

General principles

90 The basic principles of the tort of passing off are well established. The tort is concerned with protecting the goodwill of a trader in his brand name and other indicia or badges of origin. The tort also seeks to ensure transparency in the market place so that another trader does not, whether by design or accident, sell his goods or services in a manner that causes members of the public to be confused as to their origin. That said, passing off is not a tort based simply on confusion or deception; nor has it developed into an action that targets unfair competition *simpliciter*. Notwithstanding the considerable developments in the tort over the past century, such as the recognition of shared goodwill, deception as to quality, inverse passing off and the broader approaches to determining the likelihood of deception and damage (especially where the plaintiff and defendant are not in direct competition as such), the tort remains true to its origin, which is to *protect the goodwill belonging to the trader*.

91 In *Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Ltd and another* [1979] 1 AC 731 ("the *Advocaat* case"), a seminal decision on the tort of passing off from the House of Lords in England, Lord Diplock held (at 742) that there were five elements in an action for passing off. These are: (a) a misrepresentation; (b) made by a trader in the course of trade; (c) to prospective customers of goods and services supplied by him; (d) which is calculated to injure the business or goodwill of another trader (in the sense that the injury is a reasonably foreseeable consequence); and (e) which causes actual damage, or (in a *quia timet* action) is likely to cause damage, to a business or goodwill of the trader by whom an action is brought.

92 Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] 1 WLR 491 ("*Reckitt*") at 499D–H reformulated the above statement of law in the *Advocaat* case, as follows:

> The law of passing off can be summarised in one short general proposition—no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a ***goodwill or reputation*** attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying "get-up" (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the

> get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a ***misrepresentation*** by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff ... Thirdly, he must demonstrate that ***he suffers or, in a quia timet action, that he is likely to suffer damage*** by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.
>
> [emphasis added in bold italics]

93 The three elements identified by Lord Oliver in the tort of passing off, *ie*, goodwill, misrepresentation, and damage, have been followed and applied consistently by the Singapore courts: see in particular *Novelty v Amanresorts* at [36]; *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 at [109]; and *Golden Season Pte Ltd and others v Kairos Singapore Holdings Pte Ltd and another* [2015] 2 SLR 751.

94 Indeed, in accordance with this tripartite framework, the plaintiffs' first, and in my view, more straightforward passing off claim, is founded on the following premises:

(a) The SINGSUNG Get-Up (described at [53] above) enjoys goodwill in Singapore.

(b) There was a misrepresentation such that the trade buyers who directly purchased the 1st Defendant's products were deceived or are likely to have been deceived as to the origin of the defendants' goods.

(c) As a result of the deception, the plaintiffs' goodwill in Singapore is damaged.

Instruments of deception

95 However, as mentioned at [70(b)] above, the plaintiff has a second passing off claim that does not (ultimately) depend on goodwill or confusion in Singapore as such. Indeed, I recognise that there is a *second type of passing off* that does not depend on the defendant actually deceiving or confusing its direct consumers, but that is premised on the defendant having circulated "instruments of deception". As the learned author of Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 4th Ed, 2011) ("*Wadlow on Passing Off*") at para 5-134 puts it:

> ... The classic definition of passing-off in terms of a misrepresentation made to customers or consumers is applicable without difficulty only to retailers. Businesses higher up the chain of distribution, such as manufacturers or importers, are, however, liable for passing-off in their own right under a doctrine known as "instruments of deception". In its most basic form, this states that primary liability for passing-off attaches to the business actually responsible for goods which are inherently likely to deceive ultimate purchasers or consumers. ...

96 Under the doctrine of "instruments of deception", passing off can be committed where instruments of deception are supplied to a third party, even if the third party (the trade buyer or middleman) is not deceived or confused. It is no defence for a manufacturer to say that the retailer to whom he sold his products is not deceived. A manufacturer who sells products which enable retailers to make false representations to others can be liable in passing off. Passing off arises if the plaintiff shows that the ultimate consumers would be confused into thinking that they are acquiring the products of the plaintiff: James Mellor *et al*, *Kerly's Law of Trade Marks and Trade Names* (Sweet

& Maxwell, 15th Ed, 2014) ("*Kerly*") at para 18-232.

97 On one view, the tort of passing off is complete when the goods are supplied to the wholesaler or retailer, although the actual deception of customers and consequent damage may not occur until later, or at all: *Wadlow on Passing Off* at para 5-134, *Tan Tee Jim* at para 19.306. A plaintiff therefore need not prove that the "instruments of deception" actually reached ultimate consumers who were confused. It only need show that the goods were supplied, or put into circulation. On the other hand, *Kerly* at para 18-233 is of the view that an instrument of deception is a misrepresentation waiting to happen which only needs to be exposed to the ultimate consumer for the tort of passing off to be complete. Whilst it is not essential that the question as to whether passing off is complete by the mere act of supplying an instrument of deception to a middleman (who is not himself deceived) is decided in the present case, I am of the view that the claim is better seen as one brought on a *quia timet* basis.

98 I also note that passing off may take place and be actionable in the home jurisdiction even if the instruments of deception supplied in that jurisdiction are to be subsequently *exported* by the trade buyer: *John Walker & Sons Ltd and others v Henry Ost & Co Ltd and another* [1970] 1 WLR 917. In such a case, some authorities suggest that what must ultimately be proved is that there is goodwill in the mark in the sense that the mark is distinctive of the plaintiff in the *foreign market* and misrepresentation has arisen in the *foreign market*. As stated in *Wadlow on Passing Off* at para 5-152:

> ... Under the doctrine of instruments of deception the tort of passing-off is complete when deceptive goods are exported from or disposed of in England, even though they may be destined for a foreign market. It is necessary to prove that the goods are such as would deceive ultimate purchasers in that market. *The claimant must therefore prove that his mark (etc.) is distinctive in that market and that the defendant's conduct is calculated to deceive there.* These are purely relevant as matters of fact: the claimant does not have to prove that the defendant's conduct infringes any local law. ... [emphasis added]

99 While it may seem counter-intuitive that passing off is also considered to have occurred in Singapore despite the fact that the actual market where distinctiveness is ultimately in issue and where the misrepresentation exists is an overseas market (*ie*, Cameroon in this case), the view may be taken that this makes sense because the wrong lies in circulating "instruments of deception" which *enable a middlemen or retailer to pass off his goods in another market*. As long as the instruments of deception are supplied in a particular jurisdiction, the tort on one view takes place and is completed in that jurisdiction. At the very least, it is sufficient for a *quia timet* action to be brought in the jurisdiction where the instruments are supplied. The question remains, however, whether it is necessary to also show that the instruments supplied are instruments of deception in both the home jurisdiction (where the action is brought) as well as the overseas market. This is discussed below at [144].

100 The tortious wrong underlying this form of passing off and the grant of relief is the *supply of instruments of deception.*

101 I turn now to the meaning of an "instrument of deception". In *British Telecommunication plc and another v One in a Million Ltd and others* [1999] 1 WLR 903, Aldous LJ helpfully explained at 920D–F that:

> ... Whether any name is an instrument of fraud will depend upon all the circumstances. A name which will, by reason of its similarity to the name of another, *inherently lead to passing off is*

such an instrument. *If it would not inherently lead to passing off, it does not follow that it is not an instrument of fraud. The court should consider the similarity of the names, the intention of the defendant, the type of trade and all the surrounding circumstances.* If it be the intention of the defendant to appropriate the goodwill of another or enable others to do so, I can see no reason why the court should not infer that it will happen, even if there is a possibility that such an appropriation would not take place. If, taking all the circumstances into account the court should conclude that the name was produced to enable passing off, is *adapted to be used for passing off* and, if used, is likely to be fraudulently used, an injunction will be appropriate. [emphasis added]

102 From the above passage, it is clear that there are instruments which would "inherently lead to passing off", and goods which may not "inherently lead to passing off", but may nevertheless be "adapted to be used for passing off". As the learned author of *Wadlow on Passing Off* states at para 5-141, goods which are "inherently deceptive" are goods which carry indicia so close to what is distinctive of the claimant that the public is bound to be deceived unless specific remedial or differentiating measures are taken. On the other hand, where the goods supplied fall just short of being inherently deceptive, but nevertheless can easily, by means of a misrepresentation of the retailer, become deceptive, the supplier may still be liable if he provided the goods with the *intention* that they will be passed off by retailers. In such a case, the supplier's liability flows from the doctrine of joint tortfeasorship (with the retailer).

103 Take for example the South African decision in *Omega, Louis Brandt et Frère SA and Another v African Textile Distributors* (1982) (1) TPD 951 ("*Omega*"). The case involved rights over the well-known trade mark "OMEGA" for watches in South Africa. The plaintiff's basic complaint was that the defendant was selling watches branded "HOMEGAS". Traders (hawkers) who bought the watches for retail sale were able to remove the alphabets "H" and "S" with the result that the watches now bore the "OMEGA" brand. The hawkers sold these altered watches to members of the public. The South African court had to decide whether the defendant (as a wholesaler) was liable in passing off for supplying "HOMEGAS" watches when these watches were not instruments of fraud *per se*. The brand "HOMEGAS" was not so close to "OMEGA" as to be likely to cause deception *on its own*. There was evidence, however, that the defendant knew that some of the hawkers removed the letters "H" and "S". The defendant also sold a special tool for removing the watch crystals, thereby aiding the hawkers in altering the brand embossed on the watch face. There was also evidence that the defendant had used the same technique in respect of watches bearing other brands. The Transvaal Provincial Division court, on appeal, granted a temporary interdict (injunction). There was *prima facie* evidence that the defendant knew that some of its customers were in the habit of removing the letters "H" and "S", and that the maker of the watches had deliberately chosen the "HOMEGAS" brand for this purpose. Even though the defendant did not put the "OMEGA" brand on its watches, the court accepted that the defendant was aware of what the hawkers were doing. In these circumstances, the court, citing English authorities, held that the plaintiff was entitled to an interlocutory injunction.

104 In *Omega*, the defendant put into the hands of the retailers a product which, whilst not an instrument of deception in its own right, could be converted into an instrument of fraud by a simple operation. Indeed, the defendants supplied the product with the knowledge that some of its retail customers were doing that. Given evidence that the defendant also sold a device used to facilitate the brand conversion (removal of the watch crystal), together with the similar-fact evidence that the defendant had done this on several previous occasions (in respect of other well-known brands), it was not surprising that interlocutory relief was granted. Whilst the South African court did not set out in detail the legal principles it relied on, it is apparent that a case of *prima facie* liability had been established on the basis of joint tortfeasorship (more specifically, assisting the commission of a tort), rather than on the basis of primary infringement: *Omega* at 57A; and *Wadlow on Passing Off* at

para 5-148.

105 Having said all that I have said above, I also acknowledge that there are hardly any goods in existence which cannot be used in a deceptive manner by someone determined to do so: *Wadlow on Passing Off* at para 5-147. For this reason, the evidence of the surrounding circumstances is critical where we are dealing with goods that are not instruments of deception in their own right. Important considerations a court must take into account include:

(a) how close the alleged spurious goods are to being regarded as instruments of fraud in their own right (in respect of the indicia of trade origin);

(b) the relationship between the supplier and the retailers;

(c) whether the supplier has knowledge that the goods supplied are being used deceptively;

(d) whether the supplier has provided any other assistance to his customers to convert the goods into instruments of fraud; and

(e) whether the supplier has encouraged the retailers to acquire his goods for the purpose of passing off.

106 I now summarise a number of general principles which may be gleaned from the above discussion on instruments of deception and the law of passing off.

(a) First, supplying an instrument of deception is but one method of committing the tort of passing off. The elements of the tort must still be satisfied, *ie*, a plaintiff must show there is goodwill, there would be a misrepresentation when the ultimate consumers purchase the goods, and there is or would be damage or the likelihood of damage to goodwill, albeit in a foreign market if the instruments of deception are to be exported. The key question in cases where the instrument of deception is intended to be exported to a foreign market is whether the relevant indicia of origin has acquired a reputation (distinctiveness) such that there is a likelihood of deception in that market. If the plaintiff does not have goodwill in the relevant market, there is no question of passing off being committed via instruments of deception (or in any manner at all). Further, the alleged instrument of deception must relate to the indicia of trade origin the use of which has generated the plaintiff goodwill. Passing off is not a tort founded on deception or confusion *simpliciter*. It is, and has always been, founded on goodwill. In *Cadbury-Schweppes Pty Ltd and others v Pub Squash Co Pty Ltd* [1981] 1 WLR 193 ("*Cadbury-Schweppes*"), the plaintiff's business was clearly affected by the entry of the defendant's goods into the same market. The claim failed because the defendant did not copy any indicia of trade origin which had become part of the goodwill of the product. The defendant's products, while substantially the same both in terms of the actual product, the packaging, and the marketing, were not instruments of deception because the claimed get-up, *etc*, had not become part of the goodwill in the product.

(b) Second, assuming goodwill, once the defendant supplies a middleman with an instrument of deception in relation to that goodwill, the plaintiff (owner of the goodwill) will have the right to an injunction even if the middleman has not completed the tort by selling the deceptive goods to the public. In such a case, an injunction on a *quia timet* basis may be granted.

(c) Third, assuming goodwill, primary liability for passing off can arise where the defendant supplies inherently deceptive products to the middleman to commit passing off. However, if the defendant also had knowledge that the middleman intends to use those means to commit passing

off, the defendant will also be liable as a joint tortfeasor for the acts of passing off committed by the middleman or retailer. For example, if X supplies to Y labels bearing the plaintiff's trade mark for chilli sauce and containers on which the labels are to be affixed, on the understanding and knowing and intending Y to apply the labels and fill the containers with his own chilli sauce for sale to customers, there is no doubt that X and Y are joint tortfeasors.

(d) Fourth, assuming goodwill and proof that the defendant has supplied an instrument of deception to a middleman, liability will arise even if the deceptive goods are intended for sale and are in fact sold to consumers in an overseas market. Of course, it is necessary to show that customers in that foreign country are deceived or likely to be deceived as to the trade origin of the goods. In such a case, provided the transaction between the defendant and the middleman takes place in Singapore, the law regards the tort as being committed in Singapore (and actionable in some cases on a *quia timet* basis). That said, even if the circumstances are such that the tort is wholly committed overseas (*ie*, it is a foreign tort), the possibility remains of bringing a suit in Singapore under the rules of private international law.

(e) Fifth, liability can still arise where the goods which, whilst not instruments of deception in their own right, are near instruments of deception and have been supplied in circumstances (*eg*, with the requisite knowledge and intent) such as to render the supplier a joint tortfeasor with the retailer who uses the goods to commit passing off. In the present case, there is no evidence that the defendants' direct customers (*ie*, the middlemen) have used the defendants' goods to commit passing off. On the evidence before the court, no action for passing off has been brought against any of the defendants' customers or indeed, any retailers of "LS" branded products.

Goodwill

107 I next consider the law on goodwill. In *The Commissioners of Inland Revenue v Muller & Co's Margarine Limited* [1901] AC 217 at 223–224, the House of Lords defined goodwill as "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom...". The Singapore Court of Appeal in *Novelty v Amanresorts* at [39] took a similar approach and identified two essential features of goodwill:

> ... First, it is the association of a good, service or business on which the plaintiff's mark, name, labelling, *etc* (referred to generically as the plaintiff's "get-up") has been applied with a particular source. Second, this association is "an attractive force which brings in custom" ...

108 Not only must a plaintiff prove that it has a business with customers, it must also show the marks, get-up, or design (or whatever it may be) that the plaintiff desires to protect is an "attractive force" (much like a magnet) which brings custom to that business.

109 Practically, a plaintiff seeking to establish that it owns goodwill must prove that the public recognises use of the claimed brand name, logo, colour scheme, get-up, slogan, shape, *etc*, as serving the purpose of an indicator of origin. The public must regard goods or services with the claimed mark as coming from a particular source (manufacturer, retailer, service provider and so forth). Applying this principle to the present case, the plaintiffs bear the burden of proving that the SINGSUNG Get-Up has generated goodwill on the part of the Singapore public (or at least a section of it). To be clear, the mark or get-up *etc*. must be attached to the goods or services by association such that these are recognised by the public as distinctive specifically of a plaintiff's goods or services.

110 Goodwill is usually established by evidence of use, advertising expenditure promoting the indicia

of origin, as well as market surveys. The law of passing off frequently protects the brand name of the product, given that it is usually quite easy to establish that the brand name is an indicator of origin and hence generates goodwill. However, this does not mean that the shape or get-up of a product (being an aspect of the product itself), or the advertising slogans used with it, can never be protected by the tort of passing off. What it does mean is that the court will examine the evidence on these other aspects of the product with care before deciding whether customers (the market) recognise these features as being distinctive of the plaintiff.

111 At this juncture, I note that courts have been cautious in the face of claims that get-up, product design or slogans (rather than the brand name) have become generators of the goodwill of a business. Given that the plaintiffs' claims in this case relate to precisely that, I shall discuss in slightly more detail the case law on the extent to which the shape and get-up of a product, or even certain slogans used by the business to advertise the product, can be part of the goodwill, and hence protected under the law of passing off.

1 1 2 *White Hudson & Co v Asian Organisation Ltd* [1965] MLJ 186 (Privy Council on appeal from Singapore) is a well-known case where the plaintiff succeeded in establishing goodwill in the colour of packaging of the product. Despite the fact that the plaintiff and the defendant had different brand names, the plaintiff succeeded in his claim for passing off based on his use of red paper wrapping for cough sweets. The evidence showed that members of the public in Singapore at that time usually referred to the plaintiff's sweets as "red paper wrapped sweets" in Chinese, rather than by its English brand name, "Hacks". This finding was supported by evidence that the plaintiff's Singapore customers at that time were not fluent in English, and hence used the colour of the wrapper to identify the product.

113 Yet another case where goodwill was found to subsist in the shape of a container for a product is the House of Lord's *Reckitt* decision. The plaintiff sold fresh, natural lemon juice in a lemon-shaped container with a green screw top and a label attached to the neck. The plaintiff had, for 30 years, been the only manufacturer using this type of container and get-up. The plaintiff's brand name was "JIF". The defendant also sold fresh lemon juice in a similarly shaped and coloured container, with a label attached to the neck containing its brand name "REALEMON". The defendant challenged, among other things, the existence of goodwill in the shape and colour of the lemon juice container. The get-up was said to be descriptive of the product both in terms of shape and colour. The trial judge, Court of Appeal and House of Lords in the UK found that the shape of the container had acquired a secondary meaning that was distinctive of the plaintiff. The trial judge had found that many members of the public (*eg*, housewives) would buy the defendant's product thinking that it was the plaintiff's. On this basis, Lord Oliver found that the shape of the container was a generator of goodwill. The shape did more than just indicate that the container contained lemon juice. It indicated that the container contained "JIF" lemon juice. The shape and get-up had become associated in the minds of substantial numbers of the relevant public exclusively with JIF lemon juice.

114 There are, of course, many cases where the claim that the shape of a product enjoys goodwill has failed. The plaintiff in the English case *Hodgkinson & Corby Ltd and another v Wards Mobility Services Ltd (No 1)* [1994] 1 WLR 1564 sold a cushion for preventing sores on wheel chair bound individuals. The plaintiff claimed that the cushion had "a striking and memorable shape", and that the shape of the cushion was protected as part of the goodwill. Goodwill in this case was asserted over the shape of the product, rather than a container. The brand name of the plaintiff's cushion was "Roho". The defendant made a "look alike" under the brand "Flo'tair". The action for passing off failed. The court was of the view that customers bought the cushion for what it was. They did not rely on the shape as an indicator of trade origin.

115 Another decision is the English High Court decision in *Yakult Honsha KK's Trade Mark Application* [2001] RPC 39 ("the *Yakult* case"). In this case, the applicant tried to register the shape of a bottle used to contain cultured milk as a trade mark. *The court held that the average consumer was likely to conclude that the shape of the bottle in question was nothing more than a bottle of fairly ordinary shape. There was no evidence in the sales promotion efforts that effort was made to specifically promote the shape of the bottle as having trade mark significance. There was nothing to suggest that at date of the application, the applicant had done anything to educate the public that its cultured milk bottles had trade mark significance. There was also no evidence that the public had learned of such significance (ie, treated the shape of the bottle as an indicator of trade origin) apart from the applicant's marketing efforts. Laddie J noted (at [10]) that learned counsel*, Mr Simon Thorley QC, had rightly conceded that the fact that a container is unusual or attractive does not, *per se*, mean that the public will view and rely on it as an indicator of origin. The relevant question is not whether the public recognises the container on seeing it a second time, or in other words, whether it is memorable. The relevant question is "whether by itself its appearance would convey trade mark significance to the average customer."

116 Whilst the court's remarks in the *Yakult* case were made in the context of a registered trade mark, the general principle is broadly similar in a passing off action. In the law of trade mark what is protected is the trade mark. In the case of passing off what is protected is the goodwill enjoyed by the plaintiff in his goods or services. To succeed in passing off, the plaintiff must show that the name, get-up, shape, *etc*, has become distinctive in the market in that the public associate the name, get-up, shape, *etc*, exclusively with the plaintiff. If so, the feature is a generator of goodwill and is protected in the sense that it is a part of the goodwill. Whilst registered trade mark is concerned with protecting a trade marks as a species of property, the tort of passing off is concerned with protecting goodwill as a species of property.

117 Reference can also be helpfully made to the decision of FA Chua J in *Malaysia Dairy Industries Pte Ltd and another v Yakult (Singapore) Pte Ltd* [1979-1980] SLR(R) 211. This case also concerned the shape of the bottle used for a cultured milk drink. The plaintiff (owner of the "VITAGEN" brand) applied for an interlocutory injunction against the defendant, who used a similarly shaped bottle for its cultured milk drink. The application was denied because, *inter alia*, the court was not satisfied that the shape of the Vitagen container had become (by use or otherwise) associated exclusively with the plaintiff's lactic acid drink such that that the use of a similarly shaped bottle would be understood by the trade and public in Singapore as meaning that the goods were the goods of the plaintiff and no one else's. On the facts (as they appeared at the interlocutory stage), Chua J found that the respective brand names ("YAKULT" and "VITAGEN") were more important than the shape. The brand names had featured prominently in the advertising, but the advertising neither emphasised the shape of the container, nor taught the public that they could identify the product by the shape of the container. The shape of the bottle therefore did not generate goodwill.

118 Just as the courts exercise care where goodwill is claimed in respect of the shape of a product, care is also exercised where goodwill is claimed in respect of advertising slogans or the image of a product or service.

119 In *Cadbury-Schweppes*, the Privy Council, on appeal from Australia, found that the plaintiff had not established that the get-up and the slogan used to market the product was part of the goodwill or had generated goodwill. The plaintiff's product was a soft drink based on lemon squash. It was launched with a heavy advertising campaign, which promoted the soft drink as a masculine alternative to beer. The plaintiff's brand name was "Solo". The drink was sold in green and yellow cans with a medallion type label similar to ones commonly found on beer cans. The advertising campaign stressed the theme of ruggedness and the great outdoors. Slogans used included: "Just Like the great old Pub

Squashes of Yesteryear". The plaintiff's claim was that the defendant took advantage of the new market opened up by the plaintiff. The defendant made a similar lemon squash drink under the brand "Pub Squash", used a can of similar colour with a medallion label, and promoted its drink with similar advertising themes of heroic masculinity and "stalwart men".

120 The passing off action failed. The parties had completely different brand names, and the plaintiff was not able to show that the advertising themes, slogans, or the can colour played a part in generating goodwill. The court found that the slogans were not distinctive of plaintiff (in the sense of an exclusive association). It followed that there was no misrepresentation in the sense required by passing off. In response to the argument that the acts of the defendant were unfair as they were taking advantage of a new market that had been opened up by the plaintiff, the Privy Council held (at 200F–G):

> ... [C]ompetition must remain free: and competition is safeguarded by the necessity for a plaintiff to prove that he has built up an 'intangible property right' in the advertised descriptions of his product: or, in other words, that he has succeeded by such methods in giving his product a distinctive character accepted by the market. A defendant, however, does no wrong by entering a market created by another and there competing with its creator. The line may be difficult to draw: but unless it is drawn, competition will be stifled. ...

121 The Privy Council noted (at 205H) that if the law did not draw the line, the danger is that "[t]he new, small man would increasingly find his entry into an existing market obstructed by the large traders already well known as operating in it". These are sentiments that I fully agree with.

122 The above cases show that whilst it is possible to claim that descriptive get-up, shapes or colour of products, or advertising slogans have acquired a secondary signification (as an indicator of trade origin), the court will scrutinise such claims carefully. Importantly, a claimant must prove that a substantial portion of the members of the public do indeed view the claimed generators of goodwill as distinctive of the plaintiff. This is a question of *fact*. Sufficient evidence is needed to convince the court that such a factual conclusion is merited.

123 The final point I make in relation to goodwill for now is that the task of establishing goodwill in words or marks that are *essentially descriptive* of a product or service is tricky, but not impossible. This is illustrated by cases such as *Frank Reddaway and Frank Reddaway & Co Limited v George Banham and George Banham & Co Limited* [1896] AC 199 ("*Reddaway*"); *Mechanical Handling Engineering (S) Pte Ltd v Material Handling Engineering Pte Ltd and another* [1992] 3 SLR(R) 365; *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and another and another appeal* [2000] 2 SLR(R) 214; *Lifestyle 1.99 Pte Ltd v S$1.99 Pte Ltd (trading as One.99 Shop)* [2000] 1 SLR(R) 687; and *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459.

124 Bearing the above cases, policy considerations, and principles in mind, I turn now to consider the plaintiffs' straightforward passing off claim.

Straightforward passing off claim

125 As stated at [94] above, the plaintiffs' straightforward passing off claim is based on the following premises:

(a) The SINGSUNG Get-Up (described at [53] above) enjoys goodwill in Singapore.

(b) There was a misrepresentation such that the trade buyers who directly purchased the 1st

Defendant's products were deceived or are likely to have been deceived as to the origin of the defendants' goods.

(c) As a result of the deception, the plaintiffs' goodwill in Singapore is damaged.

Goodwill in Singapore

126 As discussed above, in order to prove goodwill in Singapore, a plaintiff must prove that it has business within jurisdiction, and that its mark or get-up is an attractive force that brings in custom. The latter requires proof that the mark or get-up is an attractive force in the minds of the public. By attractive force, I stress again that it is not enough that the public finds the get-up aesthetically attractive or functionally useful.

(1) Proof of business within jurisdiction

127 In determining whether the 1st Plaintiff enjoys goodwill in Singapore, the first thing I must consider is whether there is proof of a business within jurisdiction: Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore*, (Sweet & Maxwell, 2nd Ed, 2014) ("*Law of Intellectual Property of Singapore*") at section 17.4. I note in passing the recent decision of the UK Supreme Court in *Starbucks (HK)*, and its review of case law on whether it was still necessary to establish a business within jurisdiction before goodwill can be found to subsist. In Singapore, as the law currently stands, it is clear that goodwill requires proof that the plaintiff has business activity in Singapore. Reputation alone is not sufficient. That said, it may be sufficient if there is substantial pre-business activity such as heavy advertising campaigns intended to familiarise the public with the product or service (see the views in *Staywell* and *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975, and compare *Starbucks (HK)*).

128 Whilst there remains some uncertainty over what constitutes sufficient business or trading activity such as to be capable of forming the basis of a claim to goodwill in law, I am of the view that the plaintiffs have established that they have a sufficient business in Singapore.

129 Evidence was given of the sales volume that the 1st Plaintiff has achieved in Singapore. The sales volume to overseas trade buyers, such as GEN, is considerable. Whilst there is some dispute and uncertainty as to how and where the plaintiffs dealt with the overseas trade buyers, I am satisfied that overseas trade buyers have placed significant orders with the 1st Plaintiff in Singapore. For this reason, I have no doubt that the 1st Plaintiff has established a business within jurisdiction on which he can try to mount a claim for goodwill in its indicators of trade origin. Whether all the claimed features of get-up, *etc*, are in fact relevant as generators of the goodwill is another matter.

130 In coming to the decision that the 1st Plaintiff has sufficient business within jurisdiction, I took into account the decision of Judith Prakash J in *Future Enterprises Pte Ltd v Tong Seng Produce Pte Ltd* [1997] 3 SLR(R) 797 ("*Future Enterprises*"). In that case, the plaintiff, a Singapore company, manufactured coffee in Singapore for export and sale to overseas markets (in particular, Russia). The plaintiff's products were not available anywhere in Singapore. There was no evidence of any "local sales". In other words, the plaintiff had no local consumers—its end users were all overseas. Indeed, the court found (at [36]) that there was no evidence of any export trade community in Singapore among which the plaintiff's brand enjoyed goodwill. In these circumstances, it is not surprising that the court concluded (at [42]) that the plaintiff had not proven that it enjoyed a sufficient reputation and goodwill in Singapore to found an action for passing off.

131 In the present case, there is evidence that the overseas trade buyers (from Cameroon, *etc*)

attended at the 1st Plaintiff's shop in Singapore. As overseas trade customers coming to Singapore, they are still customers *in Singapore*. Products were selected and orders were placed in Singapore. Furthermore, in the present case, unlike *Future Enterprises*, there is evidence of some sales to local, Singapore-based customers. Whilst the sales volume to Singapore customers is very much smaller, I am satisfied that the plaintiffs have sufficient business in Singapore on which they can mount a claim to goodwill. What is critical is whether the plaintiffs are able to establish reputation in the claimed get-up, *etc*. In coming to this conclusion, I am also assisted by the remarks of Lord Neuberger in *Starbucks (HK)* at [52] that goodwill requires proof of customers within jurisdiction as opposed to people in jurisdiction who happened to be customers elsewhere. Even though the UK Supreme Court maintained the view that reputation alone was insufficient to found an action for passing-off, Lord Neuberger accepted that it may be sufficient if there was a booking office within jurisdiction whereby people within jurisdiction obtained the right to receive the plaintiff's services abroad. Whilst this statement was made in respect of hotel services, the statement must be applicable to goods as well. In the present case, the 1st Plaintiff has a real business presence in Singapore with actual customers doing business in Singapore (although the latter are predominantly whole sale buyers from overseas).

(2) SINGSUNG Get-Up being an indicator of trade origin in Singapore

132 Besides proving that the 1st Plaintiff has a sufficient business in Singapore, the plaintiffs must also prove that the SINGSUNG Get-Up is perceived to be an indicator of trade origin (distinctive of the first plaintiff) in Singapore. This is a question of fact and evidence.

133 On the whole, the evidence of sales to Singapore-based customers was thin. There was some evidence of sales statistics to Singapore-based customers. However, there was no further evidence to prove that those statistics related to Singapore-based end user consumers. In fact, the defendants strongly disputed that the 1st Plaintiff had any Singapore-based end user consumers. In any event, even assuming that the 1st Plaintiff did make sales to Singapore-based end user consumers, the statistics show that the volume of such sales was much smaller.

134 Most crucial to my mind, however, is the complete absence of evidence that the local buyers had come to associate the SINGSUNG Get-Up exclusively with the plaintiffs. No Singaporean customer gave evidence on any of these matters. I thus find myself compelled to conclude that there is no basis for a finding that the SINGSUNG Get-Up is regarded as distinctive of the 1st Plaintiff among members of the Singapore public.

135 Of course, goodwill in the SINGSUNG Get-Up need not be enjoyed in the eyes of the public at large. It can be sufficient for goodwill to exist among a small section of society or a class of the public: *Novelty v Amanresorts* at [44]. The plaintiffs could perhaps argue that the SINGSUNG Get-Up enjoyed goodwill in Singapore among the small group of trade buyers who purchased the 1st Plaintiff's goods. Indeed, it is clear that the 1st Plaintiff did have a number of overseas trade buyer customers. However, it seems that most of these trade customers (*eg*, GEN) were aware that the 1st Plaintiff and 1st Defendant are separate companies competing in the same line of products. They are familiar with the two brand names, and are fully aware of the similarity in the parties' products. In any case, there was insufficient evidence of confusion on the part of the trade customers. Whilst two trade buyers from Cameroon gave evidence of their buying trips to Singapore, it does not appear that either placed reliance on the *get-up* of either the plaintiffs' or defendants' products as indicators of trade origin.

136 As such, it cannot be said that these trade customers treat the SINGSUNG Get-Up as an indicator of trade origin. It would be foolish to do so, given that they know the 1st Plaintiff and the 1st Defendant carry similar (and occasionally near-identical) products.

137 Perhaps, the most that can be said, and indeed very fairly said, is that goodwill exists in the "SINGSUNG" brand. However, this is very different from stating that the SINGSUNG Get-Up is treated as an indicator of trade origin, and hence generates goodwill. In my view, there is simply no evidence that the SINGSUNG Get-Up is treated as an indicator of trade origin by any sector of the public in Singapore. I thus find that goodwill does not exist in the SINGSUNG Get-Up, even in the eyes of this small group of trade customers.

Misrepresentation and damage in Singapore

138 Given my conclusion that the SINGSUNG Get-Up does not enjoy goodwill in Singapore, the straightforward passing off claim must fail. It is unnecessary for me to consider misrepresentation and damage.

139 Nevertheless, I point out that given the prominence of the 1st Plaintiff's and 1st Defendant's different brands on their respective products, and given that there can be no claim to illiteracy on the part of the 1st Plaintiff's and 1st Defendant's overseas trade buyers, it is highly unlikely that any trade buyer would be confused.

Passing off based on instruments of deception

140 As mentioned above, there is a second type of passing off claimed—that based on the doctrine of instruments of deception. As discussed, a plaintiff must show that a defendant did supply the alleged instruments of deception, and that the products are indeed instruments of deception. The latter involves either showing that the goods are inherently deceptive, or if they fall just short of being inherently deceptive, showing that the defendant knew or intended that the goods be adapted by the retailer for the purposes of passing off.

141 In this case, it is not in dispute that the alleged instruments of deception have been supplied by the defendant. The only question is whether the 1st Defendant's products which are in question are instruments of deception. At this point, I reiterate the following points which I made above:

(a) If the plaintiff does not have goodwill in the relevant jurisdiction, there is no question of passing off being committed via instruments of deception (or in any manner at all).

(b) The alleged instrument of deception must relate to the indicia of trade origin in respect of which the plaintiff has goodwill. In other words, the deception alleged must arise in respect of the mark, get-up *etc*. which has become exclusively associated with the plaintiff.

142 The important preliminary question is the identity of the relevant jurisdiction. Where an alleged instrument of deception is supplied to a trader in Singapore for use in an export market, is it necessary to establish that the plaintiff enjoys goodwill in Singapore and that the instrument supplied is *also* an instrument deception in Singapore? I have found that whilst goodwill subsists in the SINGSUNG brand, there is no evidence that the get-up is treated as an indicator of origin by any sector of the public in Singapore. It follows that there is no evidence that the products were instruments of deception in Singapore. It may be thought that in such a case, it is not necessary to consider whether the get-up is seen as distinctive of the plaintiff in the export market (Cameroon). Even if it is treated as such in the overseas market, it may be suggested that this makes no difference given that they are not instruments of deception in Singapore, where the suit is brought. Indeed, whilst the UK Supreme Court in *Starbucks (HK)* was not dealing with a case of exports of instruments of deception, it was said at [53] that the English court in a passing off action in the UK had to be satisfied that the plaintiff's business has goodwill within its jurisdiction.

143 The difficulty, however, is the decision of the English High Court in *Modus Vivendi plc v Keen (World Marketing Ltd)* (5 July 1995) (unreported) ("*Modus Vivendi*"). In that case, a passing off action was brought in the UK in respect of cans of butane gas made in England and exported for sale in China. The claim was based on similarities in the get-up and not brand names. Lightman J, in finding for the plaintiff (after a ten-day trial), commented:

> ... It is perhaps somewhat surprising that a trial as to the existence of Ronson's goodwill in China and as to whether customers in China have been misled by [the defendant] should be tried in England according to principles of English law, and that there has been no trial before a court in China or (at this trial) any references to the law of China. But this is because [the defendant's cans] were manufactured in England and sold to [the defendant's] exclusive distributor in Hong Kong for onward sale to and in China, and in these circumstances, if Ronson's allegations are true, since 'the instruments of deception' (Keen's cans) were put into circulation in this jurisdiction, under English law the tort of passing-off has been committed in England, though the damage, in respect of which compensation is sought ... has been suffered outside the jurisdiction ie. in China. ...

144 The facts and issues concerning the get-up in *Modus Vivendi* are considered at [224]–[225] below. What is significant is that the court, in deciding for the plaintiff, focused its discussion primarily on the market in China. Specifically, the court considered whether the plaintiff's get-up were indicators of origin in China and protected by goodwill in that market. There was no consideration as to whether the get-up was regarded as an indicator of origin (associated exclusively with the plaintiff) in the UK market. What was said was that the Ronson brand name enjoyed substantial goodwill in the UK for its products which included cans of butane gas refills. That said, the focus was on whether goodwill in the cans and a misrepresentation (constituted by the defendant's get-up and cans) existed in China. The problem, however, is that what is required is that the instruments supplied in jurisdiction are instruments *of deception*. It may be argued that it is also necessary to establish that the supplied goods are instruments of deception in the country of supply where the suit is brought. After all, goodwill is territorial in nature. It may be that the court in *Modus Vivendi* proceeded on the basis that the get-up was indeed also associated exclusively with Ronson (although this was not expressly mentioned) in the UK. Given the importance of this point and the submissions, I will in the paragraphs that follow ([147]–[219]), examine the position of the get-up, *etc*, in Cameroon with a view to determining whether these were associated in that market exclusively with the 1st Plaintiff such as to make the goods supplied instruments of deception in that market. To be clear, I state at the outset that even if it is not necessary to show that the supplied instruments are instruments of deception in the country of supply and where the suit is brought (Singapore), this makes no difference on the actual facts to my final decision since I am (for reasons discussed below) of the view that any goodwill that the Plaintiffs enjoyed in Cameroon does not in any case protect the get-up.

145 In this case, following *Modus Vivendi*, the relevant jurisdiction in question is Cameroon. This is where the alleged "instruments of deception" (*ie*, the 1st Defendant's products) were exported and allegedly caused confusion. While there was some assertion that the 1st Plaintiff did export its products to other foreign markets, the evidence on the goodwill in the SINGSUNG Get-Up related only to the Cameroon market. As such, I confine any findings I make to that market.

146 I shall first consider if the SINGSUNG Get-Up enjoys goodwill in the Cameroon market in the sense that the get-up has become associated exclusively in the minds of the public with the 1st Plaintiff. If it does, I then consider if the 1st Defendant's products are instruments of deception in that they effectively misrepresent themselves to be the 1st Plaintiff's goods to the public in Cameroon.

Goodwill in Cameroon

147 It is undisputed the 1st Plaintiff's products are sold in Cameroon. The key question is therefore whether the SINGSUNG Get-Up has acquired a reputation and distinctiveness in Cameroon.

148 I first broadly explain my conclusions on the evidence relating to whether the SINGSUNG Get-Up is viewed as an indicator of trade origin in Cameroon. I then go into detail on the evidence presented on each aspect of the SINGSUNG Get-Up. It might be helpful (again) for me to state upfront, that I ultimately conclude that the plaintiffs have not provided sufficient evidence to justify a factual finding that members of the public in Cameroon view the SINGSUNG Get-Up as distinctive of the 1st Plaintiff. Indeed, there is no basis for finding that the 1st Defendant's get-up amounts to a misrepresentation. This, to my mind, is fatal to the plaintiffs' claim for liability under the doctrine of instruments of deception.

149 The plaintiffs' evidence that the SINGSUNG Get-Up has generated goodwill consists mainly of assertions by the 2nd Plaintiff and GEN (the plaintiffs' customer who imported the 1st Plaintiff's goods into Cameroon) that end user purchasers (*eg*, housewives) in Cameroon were not fluent in English, and would therefore identify the 1st Plaintiff's products by reference to the get-up and design rather than by its brand name "SINGSUNG". [note: 46] In other words, according to the plaintiffs' evidence, the brand names played no role in distinguishing the 1st Plaintiff's and 1st Defendant's products.

150 No end users from Cameroon gave evidence on this. No survey was carried out on the Cameroon market to find out how the public there perceives the "SINGSUNG" brand name or the SING-SUNG Get-Up. Indeed, aside from the 2nd Plaintiff's and GEN's bare assertions, there is no corroborative evidence that the average consumer in Cameroon was unable to identify competing products by their brand names.

151 The plaintiffs' customer, GEN, did give evidence that he had personally been confused on one occasion when he saw what appeared to be a DVD player in a white carton in Douala. [note: 47] The evidence, however, was hard to follow. It appears that he saw the carton from some distance and on the basis of what is perhaps best described as a glancing encounter. No other details were provided. No corroborative evidence was provided on confusion. As such, I gave little weight to this evidence.

152 Further, the mere fact that the plaintiffs' sales may have dropped with the entry of the defendants into the market does not mean that confusion had taken place. Competition, even lawful competition, will naturally have an impact on market share.

153 On the contrary, TSA for the defendants testified that the brand name was important to customers in Cameroon. [note: 48] TSA gave evidence that well-established brands such as "SAMSUNG" and "LG" have entered Cameroon. These brands were said to be more expensive than Singapore brands such as SINGSUNG and LS. [note: 49]

154 As such, given the state of the evidence, I ultimately find that the plaintiffs have failed to prove that the SINGSUNG Get-Up generated goodwill in Cameroon. I find that there is insufficient evidence to show that the Cameroonian public viewed the SINGSUNG Get-Up as distinctive of the 1st Plaintiff. I also find that there is insufficient evidence to prove that the brand names "SINGSUNG" and "LS" bore little or no significance in the Cameroon market. This is a point to which I shall return to below.

155 At this juncture, I would like to acknowledge that as in *Cadbury-Schweppes*, I have little doubt

that the 2nd Defendant took advantage of the plaintiffs' efforts in developing the market in Africa for new electrical products that were made in China but sold from Singapore. I also have no doubt that the fury and irritation felt by the 2nd Plaintiff was real when he discovered that his own brother, the 2nd Defendant, had become his competitor and shadow. Moreover, the defendants may well have made use of the 2nd Plaintiff's effort and labour in selecting what he thought were desirable and saleable electrical and household products by ordering products that were similar or identical to the 1st Plaintiff's products. However, as Walton J said in *Harrison and Starkey v Polydor* [1977] FSR 1 (albeit a copyright case on moral rights), quoting Lord Evershed MR: fury, even justifiable fury, is not a cause of action. The plaintiffs have not been able to prove what is most critical in this case—that the SINGSUNG Get-Up is part of the goodwill.

156 The following paragraphs ([157]–[219]) set out a more detailed assessment of the evidence in respect of each aspect of the SINGSUNG Get-Up, and further explain my ultimate finding that the SINGSUNG Get-Up is not a generator of goodwill.

(1) DVD Players

157 The plaintiffs assert goodwill in the packaging of the DVD players, as well as other features of its product design.

158 In relation to DVD A, I have already briefly described the White Get-Up (at [53(a)] above). The White Get-Up consists of a carton containing the DVD player, which is white in colour. On the carton, there is an image depicting a modern living room and guitars. An image of a DVD player also appears together with a brief description of the main features of the DVD player, which include: "USB Download"; "5.1 Channel DVD Player"; "32 Digital Gaming"; and "Anti-shock". The brand name "SINGSUNG" is prominently displayed, as is the "SAFETY MARK". (The "SAFETY MARK" certifies that certain household electrical, electronic and gas products meet the specified safety standards set by Singaporean authorities; these controlled goods require such certification before they can be sold in Singapore: see the SPRING Singapore website at http://www.spring.gov.sg/Building-Trust/Raising-Confidence/Pages/raising-confidence-overview.aspx (last accessed on 28 May 2015)). The 2nd Plaintiff claims he designed the White Get-Up with the help of his in-house graphic designer, CYX. [note: 50] DVD A was obtained from a Chinese ODM known as Shenzhen Yinke Technology Development Co Ltd. [note: 51]

159 I have likewise already briefly described the Blue Get-Up on DVD B (at [53(b)] above). The Blue Get-Up refers to the use of a blue box carton, on which is an image of a DVD player as well as the SINGSUNG brand clearly marked on the carton. [note: 52] The evidence established that there was, in fact, a number of models of DVD B sourced by the plaintiffs and on-sold to African importers. During the hearing, the 2nd Plaintiff gave evidence of a number of different models under the DVD B range: DHI, DHII and DHIII. The get-up and size of the cartons for DHII and DHIII were slightly different from DHI, which is the model depicted in the statement of claim. [note: 53] The 2nd Plaintiff also gave evidence of his contributions to certain design changes to the packaging (made with the assistance of SEC). [note: 54] DVD B was obtained from a Chinese ODM known as Shenzhen Longge Electronics Ltd. [note: 55]

160 Leaving aside the lack of specific, corroborative evidence that members of the public would associate the White Get-Up and the Blue Get-Up exclusively with the 1st Plaintiff for the moment, it seems to me that neither the White Get-Up nor the Blue Get-Up were exceptionally attention-grabbing or memorable. They were fairly typical choices for DVD player packaging. In my view, this makes it far harder (though not impossible) for the plaintiffs to prove that the White Get-Up and the

Blue Get-Up acquired a secondary meaning.

161 Indeed, on this point, I note that the 2nd Plaintiff himself accepted in cross-examination that the packaging of most DVD players would include a photograph or image of the DVD player. [note: 56] When asked whether blue was a common colour for the packaging of DVD players, the 2nd Plaintiff's only response was that no other DVD player packaging came in the *shade* of blue he chose for his cartons, as well as with the exact design he selected. [note: 57] I note also that whilst GEN, a witness for the plaintiffs from Cameroon, initially took the position that DVD B was the only DVD player sold in a blue carton at the time when it was introduced, under further cross-examination, it became apparent that there were other DVD players from other retailers marketed in blue cartons although the exact shade of blue and overall design of the said cartons were different. [note: 58] Further, the 2nd Plaintiff agreed that the blue colour used for DVD B (in particular, DHI), was different from the blue used on the packaging of the LS DVD player. However, he insisted that the blue was not very different. [note: 59]

162 It bears repeating that a prominent feature of the 1st Plaintiff's DVD player packaging is the "SINGSUNG" brand. In fact, in cross-examination, the 2nd Plaintiff asserted many times that the "SINGSUNG" brand was famous or well-known (of course, he was also quick to add the caveat that consumers in Africa purchased products based on its overall design and appearance, not based on its brand). In my view, the brand name appended on the DVD player packaging is clearly the most obvious and self-evident trade mark. If the 1st Plaintiff is to establish that the get-up (which comprises commonplace features) has acquired a secondary meaning and hence generates goodwill, clearer evidence is needed.

163 Even leaving aside the complete lack of evidence from actual customers, there is no evidence that the 1st Plaintiff spent time and money in promoting the White Get-Up and the Blue Get-Up as an indicator of trade origin, as distinct from promotion of the brand "SINGSUNG". Whilst the 2nd Plaintiff gave evidence of the 1st Plaintiff's advertising in African countries and elsewhere [note: 60], the advertisements do not underscore the White Get-Up and Blue Get-Up as indicators of trade origin. The White Get-Up and Blue Get-Up are not actually depicted on the various advertisements exhibited in the 2nd Plaintiff's affidavit; [note: 61] the advertisements mainly contain the "SINGSUNG" brand, and on occasion, pictures of the actual DVD players (rather than their packaging). Indeed, as counsel accepted in the *Yakult* case, the fact that a design or get-up is memorable (which I am not convinced is even proven in this case) does not mean that it is memorable in the *trade mark sense*. Whilst this is of course a registered trade mark decision the general point is that a memorable design is not necessarily a generator of goodwill in the tort of passing off. Without evidence that customers view the design or get-up as an indicator of trade origin, or at the very least, evidence that *significant* advertising and marketing efforts promote the claimed feature as an indicia of trade origin, a court would find it difficult to conclude that the claimed get-up is relevant to the goodwill that is the concern of passing off.

164 The 2nd Plaintiff also gave evidence of the time, effort and care he put in to make certain changes to the design of the DVD players. In particular, he claims to have come up with the idea of the start-up screen, although he accepts that it was a designer from the Chinese manufacturer he placed orders with who actually reduced the idea into visual form. [note: 62]

165 The 2nd Plaintiff also claimed to have requested the following additions or changes to the DVD players and/or their packaging [note: 63]:

(a) Provision of additional ports on the DVD players.

(b) Provision of a karaoke and power button on the front left panel.

(c) A safety sticker to be placed on the rear panel.

(d) The use of a black and silver colour scheme.

(e) Painting the screws fixed on the body of the DVD black, together with the application of small black dots on the rear panel to create a dotted panel effect.

(f) A sticker for the front panel which provided information on key features such as "USB-Download".

(g) A warranty card, the terms of which are said to have been penned by the 2nd Plaintiff's wife with the assistance of an unnamed individual. [note: 64]

166 Even if I were to accept the 2nd Plaintiff's evidence on the requested additions or changes in its entirety, it is hard to see how this can help the plaintiffs make out a case for goodwill either in respect of each individual addition or change, or in terms of the impact made by the changes and additions as a whole.

167 I repeat my observation (at [160] above) that many of the features of DVD A and DVD B are ordinary and commonplace on DVD players sold by a variety of retailers. The use of a black and silver colour scheme, and the application of tiny black dots to create a dotted effect on the back panel, appears to be commonplace in the industry. During cross-examination, the 2nd Plaintiff was shown pictures of Samsung and Sony DVD players with a similar number and placement of ports, as well as a similar use of a dotted back panel (in the case of the Sony DVD). [note: 65] The response of the 2nd Plaintiff was that the precise positioning of the ports were not the same, and the size of the dots were different. [note: 66]

168 It may well be that the precise number and positioning of ports, power cables, and safety marks, *etc*, will differ between models and brands. However, in my view, this is not a significant distinguishing factor in the eyes of consumers; the number or positioning of ports and cables is unlikely to be something a consumer remembers a DVD player by. If so, this makes it less likely that the changes and additions made by the 2nd Plaintiff will be taken by consumers to be an indicator of trade origin. Adding ports on the back panel or changing the position of a button may improve functionality or appearance. However, it does not follow that the functional or aesthetic changes have become exclusively associated with the plaintiffs in the mind of the public.

169 The fact that the 2nd Plaintiff expended time and effort and was proud of his contribution to the customisation of the SINGSUNG DVD players does not go anywhere near establishing goodwill in these features. I do not accept that the differences in the precise positioning, location, number of ports, *etc*, is something that will be taken by the public as a badge of trade origin. In any case, the plaintiffs' pleaded case does not include a claim that the various features of the DVD player itself (as opposed to its box packaging) bear goodwill.

170 Based on this evidence, I am unable to conclude that a member of the Cameroonian public would treat the White Get-Up or the Blue Get-Up as exclusively associated with the 1st Plaintiff. Neither the substantial sales achieved by the 1st Plaintiff, especially to overseas trade buyers, nor

the fact that the 1st Plaintiff expended effort in choosing the White Get-Up and Blue Get-Up, means that these features have come to be associated exclusively with the 1st Plaintiff as an indicator of trade origin. In coming to this conclusion, I stress again that there is almost no evidence (aside from the assertions of the 2nd Plaintiff and GEN) that customers in Cameroon (or indeed in Singapore or anywhere else) associate the White Get-Up and Blue Get-Up exclusively with the 1st Plaintiff. Whether customers like the look and feel of the product is not the concern of passing off.

(2) Warranty cards

171 The plaintiffs also complained that the defendants had copied the wording of the 1st Plaintiff's warranty card. This warranty card was found on a number of the 1st Plaintiff's and 1st Defendant's products, including the DVD players and the blenders. The evidence was that the 1st Plaintiff and 1st Defendant provided warranty cards largely to buttress the impression in the minds of the consumers that the products were made or sourced from Singapore. It is clear that the end-buyers in Cameroon had no recourse to the 1st Plaintiff or 1st Defendant should they discover that the products were defective. Neither provided repair services in Cameroon. Indeed, I note that the strategy of both parties was to create the appearance that the products were made in Singapore and that they were of the standard and quality associated with Singapore-originated goods. This appears to be the reason why the products were marked as being made in Singapore, and why the Singapore "SAFETY MARK" was also applied.

172 I should state upfront, that the plaintiffs have not asserted goodwill in the warranty cards as such; rather, it claims that the warranty cards constitute evidence of an intention on the part of the defendants to pass off the 1st Defendant's products or business as connected with the 1st Plaintiff. Nevertheless, for completeness, I will also consider whether the warranty card could possibly be related to the goodwill.

173 The provision of a warranty card can hardly be regarded as unusual or exceptional. The 2nd Plaintiff accepts this—at trial, he conceded that all electrical products are normally sold with a warranty card. [note: 67] Even if the defendants' products came with an identically worded warranty card, the plaintiffs must demonstrate that members of the public would see the warranty card as exclusively associated with the plaintiffs. Once again, there was no evidence of this. The fact that a warranty card is important does not mean that it is part of or relevant to the goodwill which is the concern of passing off. Much will depend on what the warranty card states.

174 The position may well be different if 1st Defendant had applied the 1st Plaintiff's brand ("SINGSUNG") on its warranty card. If they did, the complaint, properly framed, would be that the 1st Defendant had used the 1st Plaintiff's brand ("SINGSUNG") to market and sell its products.

175 To be clear, there is some evidence that the sample warranty cards provided to the Chinese manufacturers by the 2nd Defendant belonged to the 1st Plaintiff. In cross-examination, the 2nd Defendant was asked to compare the warranty cards for the "SINGSUNG" and "LS" DVD players. [note: 68] The warranty cards in evidence contained identical wording. While the 1st Defendant's warranty card did set out the names "LS Electrical Trading" and "LS Dealer", it also included the statement that defective products would be repaired by the "SINGSUNG" dealer.

176 The 2nd Defendant's explanation for this is that the warranty card was provided by the factory. The 2nd Defendant, upon seeing the 1st Plaintiff's warranty card, accepted it for use on his own products and instructed the factory to replace the "SINGSUNG" name with the "LS" name on the card. [note: 69] The mention of "SINGSUNG" in the warranty card was not intended by the defendants,

and is there only because of a mistake made by the factory. At this juncture, I must mention that I have doubts about the credibility of this evidence. In cross-examination, the 2nd Defendant accepted that the Chinese ODM which purportedly offered him the "SINGSUNG" warranty cards is New Sun Factory. However, as learned counsel for the plaintiffs point out, the plaintiffs did not manufacture any of their goods at New Sun Factory. The 2nd Defendant did not deny this. [note: 70] If so, it is difficult to see how the story that the factory was the one who provided the 1st Plaintiff's warranty card as a sample can be true.

177 In the case of warranty cards attached to the mixers and blenders, DL's evidence was that while the defendants provided a sample warranty card to the Chinese manufacturer, the Chinese manufacturer was also instructed to remove the "SINGSUNG" name and to replace it with the "LS" name. [note: 71] It is not clear, however, whether this instruction was carried out. I see no reason to doubt this evidence.

178 I now make several points in respect of the warranty cards.

179 First, whilst the plaintiffs claimed to have drafted the wording of the warranty card for the DVD players, the evidence on this is thin. The 2nd Plaintiff's wife, who allegedly penned the words on the warranty card with some help, did not give evidence. There was also no evidence from the Chinese ODMs on the origins of the warranty card.

180 Second, even accepting that the plaintiffs (or rather, the 2nd Plaintiff's wife) did draft the warranty cards, the plaintiffs are not asserting any copyright in the warranty card. Instead, the plaintiffs' claim is that the defendants intentionally copied the plaintiffs' warranty cards in order to draw a connection between the 1st Plaintiff and 1st Defendant in the mind of end user buyers.

181 Given the number and variety of copyright claims made in this action, it is perhaps a little surprising that no assertion was made to literary work copyright over the warranty card. After all, the 2nd Plaintiff's evidence is that his wife (with the assistance of an unnamed third person) was the author of the wording on the warranty card. Of course, none of my remarks should be taken to be deciding whether a claim to copyright in the warranty cards would succeed. The issue is not before me. It is the plaintiffs' prerogative to decide on the rights it wishes to assert in litigation. Given that it does not assert copyright in the warranty cards, I make no further comment on the warranty card in respect of copyright.

182 Third, I do not think that a warranty card *per se* (without the brand) in this case is an indicator of trade origin. I note in any case that this was not pleaded by the plaintiffs.

183 Finally, whilst there is evidence that the defendants provided the 1st Plaintiff's warranty card as a sample to the Chinese manufacturers, or were aware that the manufacturers were going to use the 1st Plaintiff's warranty card as a template, I am satisfied (on balance) that the defendants did instruct the manufacturers to remove the "SINGSUNG" name and replace it with references to "LS". Any trace of "SINGSUNG" on the 1st Defendant's warranty cards was probably a result of a mistake. The defendants wanted to compete in the same market with the same or similar range of products under their own brand name (no doubt, taking advantage of the plaintiffs' efforts to develop the Cameroon market). I am not satisfied that the defendants intended to pass off their products as that of the 1st Plaintiff's. In my view, the evidence suggests that the defendants intended to compete hard in their own name. The warranty cards are therefore not evidence of an intention to pass off the 1st Defendant's goods as the 1st Plaintiff's.

184 For completeness, I note that the plaintiffs have not pleaded or relied on goodwill in the

"SINGSUNG" name as such. Therefore, any claim that passing off arises because of the mistaken mention of "SINGSUNG" in the defendants' warranty cards is not properly before me in this case.

(3) Television Sets

185 I turn now to the passing off claim in relation to the television sets. Before moving on, I clarify that the plaintiffs are not asserting that goodwill resides in the *packaging* of the television sets. Instead, the plaintiffs' main claim is that the sticker on the television set as well as the phrase "Rotary Rotatory" (which is found in the sticker and the front housing of the television set) is what helps generate the goodwill.

186 The 1st Plaintiff's and the 1st Defendant's television sets are both from the Jinpin Factory in China [note: 72]. The 2nd Plaintiff selected particular television models (all using cathode ray tube technology) from the range offered by the ODM in China. The television models chosen all had screens that were able to swivel 90 degrees on the base plate.

187 In this regard, I make clear that the plaintiffs do not have any rights over the idea, concept, or technology behind the rotation feature. Even if they were the first to bring such a television set to Singapore, and the first to market such a television set in Cameroon, they do not thereby acquire an exclusive right to sell the product, just as the plaintiff in *Cadbury-Schweppes* did not have exclusive rights to a lemon squash drink marketed to the theme of heroic masculinity.

188 Of course, to be fair to the plaintiffs, they have never claimed monopoly rights over television sets with the ability to rotate 90 degrees on their base. Rather, they assert goodwill over the sticker (as described above) and the phrase "Rotary Rotatory" which they say they coined.

189 The sticker placed on the screen of the 1st Plaintiff's television set is the crux of the plaintiffs' passing off claim in relation to the television sets. The sticker bears the phrase "Rotary Rotatory", as well as three symbols depicting gears, cathode ray tubes, and the side profile of the TV. Together with the symbols, certain information is set out on the sticker: "90 degrees Rotatable"; "100% Brand New Picture Tube with 3 years warranty"; "Terms and Conditions apply"; and "Ultra slim". The "SINGSUNG" brand appears in yellow lettering at the bottom of the sticker, together with the word "Singapore".

190 The plaintiffs assert that the sticker was conceived and designed by SEC. They also claim that the stickers are important in promoting sales to end user buyers. [note: 73] This is because the television sets would usually be displayed (without packaging) in shops; as such, the stickers are important in persuading end user customers in Cameroon to purchase the product.

191 However, the key question is whether the sticker or the phrase "Rotary Rotatory" is, as the plaintiffs assert, an indicator that the television originated from the 1st Plaintiff. In my view, even leaving aside the dispute as to whether the sticker was in fact designed by SEC (or by the Chinese manufacturers), there is little to no independent evidence that consumers refer to the sticker or the phrase "Rotary Rotatory" as an indicator of a particular trade origin.

192 I have no doubt that the sticker conveys some useful information. That said, while there is no direct evidence on this, I am prepared to take judicial notice of the fact that the placement of informational stickers on the screens of television sets that are on display in retail shops is commonplace (at least in Singapore). Also, the information provided on the 1st Plaintiff's television sticker is quite ordinary. The only unusual aspect of the sticker is the phrase "Rotary Rotatory" which, together with the gear symbols and the words "90 degrees Rotatable", informs potential customers

that the television set can swivel on the base. These phrases and images are descriptive; they describe graphically, and by words, a key attribute of the television set.

193 In this regard, I accept that goodwill can arise in commonplace features or descriptive phrases and images. Slogans have been protected before under the tort of passing off. However, as mentioned earlier, if the plaintiffs are to establish that commonplace or descriptive features have acquired a trade mark meaning, there must be evidence that members of the public have come to associate the phrase or feature exclusively with the plaintiffs, as an indicator of trade origin. In the present case, I am unable to conclude that there is sufficient evidence to establish goodwill in the sticker or the phrase "Rotary Rotatory". The fact that the 1st Plaintiff had sold substantial television sets does not mean that the phrase (being essentially descriptive) must be treated as associated exclusively with the 1st Plaintiff.

194 No retail customer gave evidence that he/she treated the sticker and the phrase "Rotary Rotatory" as an indicator of trade origin, or that the sticker and the phrase had become associated exclusively with the 1st Plaintiff. No evidence was provided to show that the sticker and phrase had been promoted in a trade mark sense (that is as a badge of recognition) to customers, and that such advertising had succeeded. Whilst there is evidence that the plaintiffs did spend on advertising their product range, there is little to suggest that the stickers and phrase were underscored as being an indicator of trade origin. No doubt, the sticker did include the "SINGSUNG" brand name. But if that is what renders the sticker an indicator of trade origin, the defendants rightly point out that they used an entirely different brand name on their sticker (*ie*, "LS"). I should add that in passing off cases, even if it may not be necessary to produce evidence of actual confusion, such evidence can be helpful in cases where the claim to goodwill is marginal and heavily disputed.

195 Thus, whilst subject to the discussion below on origination, I am prepared to accept that the plaintiffs expended time and effort in conceiving the "Rotary Rotatory" phrase and the particular design of the sticker, I am unable to conclude that plaintiffs have established goodwill in the sticker or in the phrase "Rotary Rotatory". In my assessment, most customers are likely to regard the sticker as providing useful information, and nothing more. This is fatal to the plaintiffs' passing off claim in respect of the television sets.

(4) Rice cookers

196 I turn next to the passing off claim in respect of the rice cookers. The body of the 1st Plaintiff's rice cooker in question is white. On one side, there is a floral pattern design in black and pink. Its operating panel is on the front face of the rice cooker, and the brand "SINGSUNG" appears on the operating panel.

197 In this case, the plaintiffs assert that goodwill subsists in the floral pattern. It is undoubtedly the case that the pattern is part of the design of the product; but it will be recalled that passing off does not protect product design *per se*. Under cross-examination, the 2nd Plaintiff accepted that the floral pattern was selected by him out of many patterns that were available in the catalogue of the Chinese ODM. [note: 74] The 2nd Plaintiff also accepted that the Chinese factory supplied rice cookers to buyers from all over the world. [note: 75] It thus seems that the 1st Plaintiff is not the exclusive seller of rice cookers with such a floral design. This substantially reduces the plausibility of the claim that the floral design is associated exclusively with the 1st Plaintiff.

198 Moreover, the plaintiffs have not been able to provide any positive evidence to establish that its end users regarded the floral pattern as exclusively associated with the 1st Plaintiff. Without such evidence, the plaintiffs' claim that the floral design is a generator of goodwill, and hence its claim for

passing off in respect of the rice cookers, must fail.

(5) Electric kettles

199 The plaintiffs assert goodwill in the get-up of five different electrical kettle models. This get-up is described at [53] above as the Domed-Get-up, the Pitcher Plant Get-Up, the White Curved Kettle Get-Up, the Penguin Kettle Get-Up and the Metallic Get-Up. The plaintiffs' brand name appears on the body of the kettles.

200 All of the designs were designed and purchased from an ODM in China. Once again, the 2nd Plaintiff accepts that the manufacturer sold its products to any buyer. [note: 76]

201 No claim was made to goodwill in the packaging of the product. Indeed, under cross-examination, the reason for this became clear. Whilst the defendants had selected and sold the same range of kettles, the packaging it used was entirely different. [note: 77] Moreover, I note in passing that the 1st Defendant's "LS" brand was appended on each of its kettles. Of course, this is not of concern to me at this juncture because the issue I am dealing with now simply is whether the plaintiffs have established goodwill in the design of the kettles.

202 Whilst the plaintiffs have asserted goodwill over the design of five different kettle models, it will be sufficient for me to explain my decision with reference to just one model. The reasoning I adopt in respect of all five kettle models is substantially the same. I therefore now only describe one kettle model in more detail.

203 The Penguin Kettle Get-Up comprises a white plastic body with a white plastic curved handle, and a blue on-off button near the top of the handle. The base of the kettle is broader than the top. The spout (according to the plaintiffs) has a beak like appearance. At the lower front centre, there is a large purplish-blue translucent window shaped in the form of a large step-pyramid. The window carries markings for the water level. The docking station is round and white in colour. The capacity is 1.7 litres. The brand "SINGSUNG" is clearly visible near the bottom of the kettle (just above where the base sits into the docking station).

204 Once again, the tenor of the 2nd Plaintiff's evidence is that he spent time selecting the kettle designs (from those available at the Chinese manufacturers). He chose models which he considered to be nice or saleable. I repeat again that I do not doubt that the 2nd Plaintiff exercised great care in selecting the kettle models. I can therefore understand why he now complains that the defendants chose similar or almost identical kettle models for their own business.

205 It may well be (but I make no decision on this) that some aspects of the kettle designs may be protectable in Singapore by means of design registration. However, any such rights are unlikely to belong to the plaintiffs in any case because they are clearly not the designer. And, in any case, that is not relevant to the case before me, and the question I must decide is whether the said get-ups are indicators of trade origin that have become exclusively associated with the 1st Plaintiff.

206 I have noted the 2nd Plaintiff's assertion that the designs of the kettles are distinctive because the plaintiffs have spent money advertising them in Africa. [note: 78] But this begs the question, distinctive in what sense? Even if the public recognises the product, and has even come to like or recognise the specific designs, it does not follow that the design is recognised as an *indicator of a particular trade origin*. Proof of this is required for a passing off claim to succeed. As discussed earlier in this judgment, if the law on passing off did not require proof of such, the consequences would be

startling; the tort of passing off would become a convenient, unrestricted avenue for unregistered design protection.

207 It is stressed that if advertising is the basis for the claim to goodwill, it is necessary to demonstrate that the public has been taught, through the advertising, to recognise the advertised get-up or design elements as indicators of trade origin. For example, in *Reckitt*, the evidence established that the relevant public regarded natural lemon juice marketed in lemon-shaped containers as an indication the product was made by a particular source. Far more had to be proved above and beyond the fact that the design was recognised and regarded as a likeable design.

208 As such, on the evidence before me, I am not able to conclude that goodwill has been established over the Penguin Kettle Get-Up, or indeed, any of the claimed kettle get-ups.

(6) Electric blenders

209 In respect of the electric blenders, the plaintiffs assert goodwill in the shape and design of three different electric blenders, each with its own get-up. The get-ups are described at [53] of this judgment as the White and Grey Get-Up, the Black and White Get-Up, and the Black Stainless Steel Get-Up. No claim was made to goodwill in the packaging of the blenders. Again, this is understandable given that the cartons and packaging the 1st Defendant used for its blenders were different.

210 The evidence establishes again that like the other products sold by the 1st Plaintiff, a Chinese ODM manufactured the blenders. The models offered by the Chinese ODM are depicted in a catalogue.

211 The 2nd Plaintiff asserts that he requested that the colour of the control panel to be changed to grey, and that the dials be coloured black. He also denies that these changes were merely part of the standard colour variants offered by the factory. [note: 79]

212 Even if I were to accept that all of the 2nd Plaintiff's assertions are true, I am still of the view that the colours chosen by the 2nd Plaintiff are unremarkable, especially in the trade mark (passing off) sense. The complaint was that the 2nd Defendant had selected the same blender models and designs, and that this would lead customers to assume that the plaintiffs and defendants were essentially "two brands under one roof".

213 However, short of proof that in the eyes of the end users or consumers, the White and Grey Get-Up, the Black and White Get-Up, and the Black Stainless Steel Get-Up have become associated exclusively with the 1st Plaintiff, and are treated as indicators of trade origin, the plaintiffs' claim for passing off cannot succeed. In this case, such evidence is lacking. While I sympathise with the plaintiffs' complaint that the defendants are selling the exact same range of products as the plaintiffs, and in fact may very well be deliberately choosing or selecting the same or similar models of products chosen by the plaintiffs, the plaintiffs simply have no remedy for this in the law of passing off.

(7) Electric floor fans

214 The plaintiffs' passing off claim for electric floor fans was made in respect of the fan model, CRSF-18A. The main design feature said to be a repository of goodwill is the round plastic base of the fan, made in the shape of a car steering wheel. No claim was made to goodwill in any aspect of the fan's packaging.

215 I do not think that it is necessary for me to embark on a detailed discussion of the electric floor fans. It suffices for me to state that as with the previous products I discussed, the passing off claim

in relation to the electric floor fans must fail because the plaintiffs have not proven that the design of the fan is associated exclusively with the 1st Plaintiff, or that it is perceived by consumers to be an indicator of trade origin.

(8) Gas stoves

216 The plaintiffs refer to the design of gas stove GS-88, comprising an embossed horse-shoe shaped device bearing the "SINGSUNG" brand, as well as gold coloured burners rimmed by circular chrome support pots. Like the other of the 1st Plaintiff's products, the gas stove was sourced from a manufacturer in China.

217 Under cross-examination, the 2nd Plaintiff was shown a catalogue from the Chinese factory setting out several gas stove models with similar horse-shoe shaped devices on which a brand could be marked or embossed. [note: 80] The difference is that unlike the 1st Plaintiff's chosen model, the horse-shoe shaped device depicted on the models in the catalogue was inverted. Whilst I accept once again that the 2nd Plaintiff put in time and effort in selecting the model GS-88, I am unable to conclude that the plaintiffs enjoyed goodwill in the claimed get-up simply because there is no evidence that customers viewed the get-up as an indicator of trade origin.

(9) Conclusion on goodwill in Cameroon

218 In light of the above discussion, I find that the SINGSUNG Get-Up does not assist in generating goodwill in Cameroon. It follows that the claim to passing off based on instruments of deception must fail for there is no goodwill in the claimed indices of origin to which the deception can relate.

219 To be clear, the finding that there is no goodwill in the SINGSUNG Get-Up in Cameroon is a finding of fact for the purpose of determining passing off in Singapore under Singapore law. It is not a finding of law under the laws of Cameroon. The key finding of fact is that there is insufficient evidence that customers in Cameroon treat the SINGSUNG Get-Up as distinctive of the plaintiffs. Indeed, my earlier finding bears repeating: the get-up is not even associated exclusively with the 1st Plaintiff in the minds of the public in Singapore.

Misrepresentation in Cameroon

220 Given my finding that there is no goodwill in the SINGSUNG Get-Up in Cameroon, it is not strictly necessary for me to consider if there is misrepresentation or a likelihood of confusion in Cameroon. Nevertheless, it is appropriate to deal with one of the submissions made by the plaintiffs in support of their position that there was indeed misrepresentation to, and confusion among, the consumers in Cameroon.

221 The plaintiffs submit that consumers in Cameroon are not literate in English and thus do not rely on the brand names "SINGSUNG" and "LS". This means that the different brand names appended prominently on the 1st Plaintiff's and 1st Defendant's products/packaging do not reduce the likelihood of confusion.

222 The plaintiffs relied on *Johnson & Johnson v Uni-Charm Kabushiki Kaisha (Uni-Charm Corp)* [2007] 1 SLR(R) 1082 at [9] for the proposition that as a general rule, it is assumed that non-English speaking audiences would pay little attention to verbal or textual, as opposed to visual, similarity. The court made this comment in the context of trade mark registration opposition proceedings.

223 In this judgment, I do not have to decide whether a general rule to that effect in registered

trade mark law is also part of the law of passing off in Singapore. However, even if it is, I am of the view that the assumption made by the rule cannot possibly be applicable in *every* case. Whether it does apply must depend on the facts and circumstances of each case, including the nature of the verbal and textual indicia as compared to the asserted visual indicia of origin. In this regard, there is a big difference between simple textual brand names such as "SONY", "SAMSUNG", "ROLEX" or indeed, "SINGSUNG", and lengthier textual indicia such as a slogan. In this day and age of consumerism, the flat world, and international trade and marketing, it cannot be assumed that non-English speaking members of society in Singapore (or elsewhere) place no or little significance on simple textual brand names.

224 The plaintiffs also relied on the English decision of Lightman J in *Modus Vivendi*. This case, it will be recalled, concerned a passing off action relating to the plaintiff's cans of cigarette lighter refill fuel. The plaintiff's cans were marketed in a particular get-up, and were exported from Scotland to China. Significant features of the plaintiff's get-up included: (a) the bright yellow background; (b) the red cap; (c) the red swirling flame; (d) black and red writing on the can; (e) a rectangle with writing below the flame; and (f) the name "RONSON" written in yellow against the middle of the flame. The defendant used a similar get-up on its cans, but used its own trade mark. The defendant's trade mark was wholly different from the plaintiff's trade mark.

225 A significant reason that the plaintiff's claim succeeded is that the public in China relied upon the get-up on the cans, rather than the trade mark written in western script, bearing in mind that the majority of the Chinese population could not read English. This is not surprising given that Chinese script, being based on characters, is entirely different from language based on the alphabet. That said, the court's finding of actionable misrepresentation did come on the back of its holding that by 1989, the plaintiff had already developed *substantial goodwill in the get-up of the cans in China*. Its sales in China were substantial, and there was already fairly heavy advertising of the product and in particular, its get-up.

226 It is clear that the *Modus Vivendi* decision was reached on its own facts. The decision was not based solely on the finding that Chinese consumers do not (or cannot) rely on the brand names on the cans. It was crucial that the get-up which was copied was heavily advertised and was found to generate goodwill. Therefore, while the decision is good authority for the proposition that get-up *can* be a generator of goodwill, it is not authority for the proposition that get-up *is always* a generator of goodwill when consumers cannot read the English brand name or trade mark.

227 I note that in *Modus Vivendi* the English High Court after stating the proposition of law that the plaintiff must establish a goodwill/reputation attached to the goods in the mind of the relevant purchasing public by association with the identifying get-up such that the get-up is recognised by the relevant sector of the public as distinctive of the plaintiff, focused its discussion on goodwill in China (not UK). The court found that substantial goodwill subsisted in the get-up in China. An actionable misrepresentation was found because the defendant had adopted a similar get-up with the result that the consumer in China would assume they were Ronson products. It is to be noted that the court did not expressly decide whether the goodwill in UK also extended to the get-up (although it did recognise that the Ronson brand enjoyed goodwill for butane gas cans in UK). Nevertheless, even if *Modus Vivendi* is correct in concentrating on the market in China (as to which see above at [143]–[144]) the case does not assist the Plaintiffs on the facts before me.

228 In the present case, I am not satisfied that members of the public had been taught (through advertising or otherwise) to recognise any part of the SINGSUNG Get-Up as indicia of origin. Indeed, it bears repeating that the defendants' trade buyer from Cameroon stated that Cameroonian consumers recognised famous brands such as "SAMSUNG".

229 I note also the plaintiffs' submission that there are decisions from South Africa, Uganda and Kenya that have noted the problem of illiteracy. However, be that as it may, the fact remains that there is no evidence before me (aside from the assertion of GEN) on the scale and depth of English illiteracy in Cameroon. The fact that the population may not be fluent in English does not mean they cannot or do not take cognisance of simple textual brand names. Far more evidence of the market in Cameroon, the customers, and their perception of the products is needed for a court to reach that conclusion.

230 Finally, I note also that the two traders from Cameroon who gave evidence (GEN and TSA) testified in French. These two traders have some basic understanding of English. Whilst there is no evidence before me whether the average consumer in Cameroon is familiar with Swahili and French, I take judicial notice of the fact that the French alphabet is largely the same as the English alphabet. The only point that I make is that if the plaintiffs are to make good the assertion that the average customer in Cameroon is unable to or will find it difficult to identify products by reference to English brand names, clearer evidence is necessary.

231 In stating this, I accept that it is not necessary to prove *actual confusion* in the market place to succeed in a passing off action. Nevertheless, there must be sufficient evidence or a sufficient basis for the court to come to the conclusion that the misrepresentation (assuming this is established) is *likely* to cause confusion. Ordinarily, this means confusion in the sense that the goods being supplied by the defendant are thought to originate from the plaintiff. However, passing off can also arise where members of the public are deceived (or likely to be deceived) into thinking that there is a *trade or commercial connection* between the defendant's goods and the plaintiff's goods. Whilst the precise limits of the latter form of passing off has yet to be fully developed by the courts in Singapore, the general principle has been accepted. Even so, on the evidence, I am not satisfied that there is a sufficient likelihood that the customers will draw such a connection. I thus make no further comments on the legal principles applicable to passing off and trade association or connection.

Other ways of proving goodwill

232 My finding that the SINGSUNG Get-Up does not enjoy or generate goodwill in Singapore and in Cameroon is based largely on the lack of evidence that the relevant public views the said get-up as an indicator of the 1st Plaintiff's trade origin. I find it necessary to deal with two other submissions made by the plaintiffs in support of their claim to goodwill. These arguments were not based on there being direct evidence showing that the SINGSUNG Get-Up was viewed as an indicator of trade origin. Instead, the plaintiffs argued that:

(a) evidence of deliberate copying and an intention to deceive proves goodwill in that which is copied; and

(b) the use of the plaintiffs' marketing materials proves goodwill in that which is replicated in the marketing materials.

Relevance of the intention to deceive in determining goodwill

233 While I have found that the *evidence* does not bear out the proposition that the SINGSUNG Get-Up bears goodwill in either Singapore or Cameroon, the plaintiffs have nevertheless suggested in their submissions that the inadequate evidence of goodwill may not be fatal *if* they can prove that the defendants deliberately copied the SINGSUNG Get-Up, and intended to deceive consumers by so copying.

(1) Was there an intention to deceive?

(1) Was there an intention to deceive?

234 The threshold question is obviously a factual one—was there even deliberately copying and/or an intention to deceive on the part of the defendants?

235 "Copying" that takes the form of a decision to compete in exactly the same market with the same goods is not, on its own, evidence of an intention to pass off or deceive. The latter involves an intention to represent to consumers that one's goods are associated with, or come from, another trader. Two shops selling "SAMSUNG" television sets may well display and sell identical models. This does not mean that the second shop intends to pass off its business as that of the first shop's or vice versa.

236 In the present case, what has been shown is that the defendants decided to enter the same market and to acquire the same range of products for sale. Both the plaintiffs and the defendants purchased their products from ODMs in China, and sold and marketed the products under their respective brands. There is evidence that the 2nd Plaintiff put in effort to choose and customise some of the products he purchased from the Chinese manufacturers, and that the defendants followed suit and purchased the same customised products.

237 The 2nd Defendant denies that his intention was to deceive or pass off his goods or business as being connected with the plaintiffs. The plaintiffs submit that this must be false given evidence that the defendants chose and ordered products that were similar or identical to those of the plaintiffs in terms of features, colour, and general appearance.

238 Having considered the evidence, I find that the defendants did not intend to deceive customers or pass off their goods as being those of the plaintiffs, notwithstanding the conscious decision to choose the same range of products and models. The evidence suggests that the defendants have never represented to potential customers that they are the manufacturer or distributor of the plaintiffs' goods, or are otherwise associated with the plaintiffs. The evidence also suggests that this is a case where the defendants intended to compete directly against the plaintiffs in the same market and with the same range of products. Even if they had deliberately chosen similar products or packaging, the fact remains that the 1st Defendant's packaging (unlike the defendant's packaging in *Telmak Teleproducts (Australia) Pty Ltd v Coles Myer Limited* [1989] FCA 272 ("*Telmak*") (see below at [243]–[254])) always prominently displayed its own "LS" brand.

239 With this finding, it is unnecessary for me to further explore the law on whether evidence of a defendant's intention to deceive may lead or contribute to a finding of goodwill in the plaintiff's claimed get-up. Nevertheless, in case I am wrong on my factual conclusion that there is no intention to deceive, I shall proceed to consider if an intention to deceive is relevant in showing that the get-up generates goodwill.

(2) Law on an intention to deceive in relation to goodwill

240 The legal question before me is this: if a plaintiff fails to adduce direct evidence that goodwill subsists in its claimed get-up or mark, can evidence that a defendant copied the said get-up or mark with the intention to deceive consumers into believing that its products are in some way associated with the plaintiff, lead or contribute to a finding of goodwill? In other words, is proving an intention to deceive on the part of the defendant another way of proving goodwill where direct evidence of goodwill has proven lacking?

241 This question arises from the plaintiffs' submissions. There was some suggestion from the plaintiffs' submissions that deliberate copying and an intention to deceive on the part of the

defendants is evidence that that which is deliberately copied (*ie*, the SINGSUNG Get-Up) has goodwill. I note this point was made in their closing submissions under the heading of both "Goodwill" [note: 81] and "Misrepresentation" [note: 82].

242 The key authorities relied on are the Federal Court of Australia's decision in *Telmak*, as well as a passage in *Wadlow on Passing Off* at para 8-003. Given the plaintiffs' substantial reliance on *Telmak*, I shall now set out and discuss the decision in some detail.

243 In *Telmak*, the plaintiff marketed a type of frying pan described as a "dry-fry" pan. The frying pan was designed in a manner to minimise the amount of oil required. The frying pan was sold in boxes which prominently set out the words "dry-fry convection oven pan with lid" in a particular lettering. The brand "Telmak" was also set out on the boxes. The plaintiff ran a substantial advertising campaign to promote the product. Sometime after the plaintiff started selling its "dry-fry" pans, the defendant also started to sell dry-fry pans. The defendant's pans were imported from Taiwan. The parties' pans were similar in size and shape, but the defendant's pans were of a different colour. The defendant's pans were cheaper and marketed in boxes of a similar size to that of the plaintiff's. The same words that appeared on the plaintiff's boxes also appeared on the defendant's boxes. No brand appeared on the defendant's box packaging at all.

244 The plaintiff's passing off claim was based on the similarity in the parties' packaging. In particular, the plaintiff claimed that the words "dry-fry convection oven pan with lid" had become distinctive of Telmak.

245 At first instance, Gummow J (as he then was) found that the words were not distinctive. On appeal, the plaintiff submitted that goodwill resided not in the words *per se*, but in the size, the style, and the precise order in which the words were set out on the packaging of a substantially similar product. The plaintiff asserted that during the two years of marketing, this aspect of the get-up had become distinctive of its product.

246 Crucially, the plaintiff in *Telmak* had also suggested in its submissions that the defendant had, on its own packaging, *deliberately copied* the words "dry-fry convection oven pan with lid", as well as the particular way it appeared on the plaintiff's packaging. According to the plaintiff, evidence of deliberately copying by a defendant strongly compelled the conclusion that the get-up copied possessed goodwill. Its submission (as reproduced at [36] of the dissenting judgment) was that when an experienced retailer knowingly marks a product with a name and the get-up of a name which is exactly identical with the name and get-up of the market leader, the only inference was that it was doing so because it perceived some advantage, namely, that consumers would associate its products with that of the market leader. As the majority summarised (at [20] of the majority judgment), the plaintiff also submitted that it was unnecessary for it "to show the existence of a distinctive association" if it proves that the defendant intended to deceive members of the public into believing that its pan was Telmak's. Thus, according to the plaintiff in *Telmak*, by deliberately using a similar get-up, the defendant was liable for passing off. If this argument is correct, the plaintiffs in the present case may have a case for goodwill existing in the SINGSUNG Get-Up on the basis that the defendants deliberately copied significant portions of the said get-up.

247 The appeal was allowed on a split decision. I first explain the dissenting judgment.

248 The dissenting judge accepted (at [12] of his dissenting judgment) that in some cases, goodwill may be established in ordinary descriptive words and phrases. However, he added that these cases are unlikely to be numerous. On the facts, the dissenting judge was not persuaded that the words "got-up in the way which has been described are sufficiently distinctive of the Telmak product

to warrant a finding that Telmak has goodwill or reputation in them ..." (see [15] of the dissenting judgment).

249 Most important, for our present purposes, are the comments made by the dissenting judge on the legal implications of a factual finding that the defendant deliberately copied the plaintiff's get-up to deceive consumers. The dissenting judge held (at [43] of the dissenting judgment) that the finding of a deliberate intention to deceive was only relevant to the question "whether the applicant for relief has established a misrepresentation"; it "will not assist an applicant to establish goodwill or reputation". The dissenting judge went on to remark that "[i]f its evidence does not establish reputation, no amount of dishonesty on the part of a respondent will take the applicant's case over the line". In other words, the learned dissenting judge was of the view that deliberate copying or an intention to deceive was *irrelevant* to establishing goodwill. Proving goodwill through direct evidence is a burden the plaintiff (or applicant for relief) has to bear. Only after crossing this hurdle will evidence that the defendant intended to deceive be relevant to show that there was misrepresentation.

250 The majority, however, allowed the appeal. The majority accepted (at [21]) that there was no evidence that either members of the public or people in the trade distinctively associated the words "dry-fry convection oven pan with lid" with Telmak; it held that the defendant was entitled to use the said descriptive words (at [30]).

251 The majority also accepted (at [22] of the majority judgment) the principle that proof of deliberate copying does not necessarily establish a case of passing off. Deliberate copying, the majority stated, whilst of "powerful evidentiary value", still requires an assessment of the whole of the evidence as to whether the plaintiff has established a misrepresentation. Nevertheless, the majority went on to find passing off on the basis of goodwill in the *visual lay-out* of the words on the packaging. The get-up, according to the majority at [25], comprised the particular lay-out of the words in a form created by or on behalf of the plaintiff, and applied to the promotion of its product. Given the volume of sales of the product in that packaging, and the "extensive advertising of those pans in those boxes", it was reasonable to treat that lay-out as part of the Telmak product's goodwill. It is not the words that are protected, but the use of the words in that particular lay-out.

252 Having decided the issue of goodwill, the majority turned to the issue of misrepresentation and likelihood of deception. It held that the question was one of fact. The similarities in get-up relied on were: (a) the size and shape of the boxes; (b) the words used by way of description; and (c) the size and layout of the lettering conveying the description (see *Telmak* at 68). The first similarity was dismissed as being explainable by the defendant's desire to have an appropriately sized package for the efficient packaging of its product. The second similarity was not relevant because the words were not distinctive of the plaintiff. The third similarity, however, was relevant. The majority had already found that there was goodwill in the specific lay-out of the words and lettering.

253 The majority stated that the question of misrepresentation was, on the facts, finely balanced. On the one hand, the court took into account the similar sized package, the identical lettering, and the evidence of deliberate copying; against that, was the presence of substantial dissimilarities in the get-up as a whole, such as the pictures used and the remainder of the wording. In such a finely balanced case, what tilted the case in favour of liability for the majority was both the defendant's deliberate choice to copy the description and the lay-out of the description, but also the defendant's continued insistence that it had the right to continue to use the words in that particular style of lettering. The majority's disapproval of the defendant's conduct was evident. Indeed, I note that at the start of the majority judgment, the observation was made that whatever the result, the facts did not reflect well on the defendant's conduct. The end result was that the plaintiff was granted an

injunction restraining the defendant from using the words "dry-fry convection oven pan with lid" in lettering substantially similar to the lettering for those words used by plaintiff on any of its products or packaging.

254 Ultimately, *Telmak* turned on a close analysis of the overall facts. The majority accepted that, leaving aside the conduct of the defendant, the case on misrepresentation was finely balanced. The first instance judge and the dissenting judge on appeal found against the plaintiff on the basis that whatever the conduct of the defendant, goodwill had not been established. The majority on appeal disagreed. In finding goodwill in the specific lettering and style of the words "dry-fry convection oven pan with lid" used by the plaintiff, the majority relied on the volume of sales and extensive advertising of the product in the packaging with the claimed get-up. For this reason, the majority found that it was reasonable to treat that lay-out as part of the Telmak product's goodwill. The finding of goodwill was the plank on which the majority then proceeded to consider the second element of passing off: misrepresentation and the likelihood of deception.

255 A number of points arise from *Telmak*. Passing off is not founded on confusion or deception alone. It stands on the bedrock of a property right over goodwill and the badges of origin which have generated the goodwill. It is only if goodwill is established that the question of misrepresentation and likelihood of confusion arises.

256 On goodwill, *Telmak* establishes that words which are *prima facie* descriptive (and hence not distinctive) can, through exclusive use, promotion and advertising, acquire a secondary meaning or exclusive association with the plaintiff. This was so in *Reddaway*, as mentioned earlier. Importantly, *Telmak* does not support any proposition that deliberate copying or an intention to deceive, always contributes or assists in a *finding of goodwill*. The minority judgment expressly denied this, while the majority was equivocal on this point, and was only willing to state that deliberate copying assists at the "misrepresentation" stage of the inquiry.

257 At this juncture, I point out that the distinction between the elements of goodwill and misrepresentation in the tort of passing off must be kept in view. Whilst an intention to pass off by copying the features in dispute is relevant to assessing the likelihood of confusion, it will be rare that proof of such an intention is sufficient on its own to establish goodwill. Indeed, the distinction between deliberate copying and an intention to pass off must also be borne in mind. Deliberately copying (in the sense of a decision to compete in the same market or market segment with the same range of goods), as in the present case, may take place for reasons that are unrelated to an intention to pass off. The defendant may have deliberately decided to compete in the same market as the plaintiff after the plaintiff developed the market or showed that the market exists and is profitable. This however does not mean that the defendant intended to pass off its products as being the plaintiff's. Specific evidence of the latter (beyond deliberate copying in the sense that is referred to above) is necessary.

258 Indeed, I note that whatever view is taken of the *Telmak* decision, it is clear that the key finding of fact that led to goodwill in that case was the extensive advertising of the product in the packaging bearing the get-up (lay-out) in question. In the present case the evidence as to advertising is not such as to enable me to draw any conclusion as to whether the get-up (especially of the packaging) formed a significant component of the advertisements.

Use of the plaintiffs' marketing materials

259 The plaintiffs have also argued that the defendants' reliance on the 1st Plaintiff's marketing materials demonstrates goodwill in the SINGSUNG Get-Up. While this argument was not expressly

made, for the sake of completeness, I shall assume that the plaintiffs intended this to be another alternative way of demonstrating goodwill (besides offering direct evidence that consumers actually viewed the SINGSUNG Get-Up as an indicator of the 1st Plaintiff's trade origin). I shall now consider if this is so.

260 The key case cited by the plaintiffs in relation to this point is *Momentum Creations Pte Ltd v Tan Eng Koon (trading as De Angeli)* [2003] 1 SLR(R) 342 ("*Momentum Creations*"). According to the plaintiffs, the case stands for the proposition that a defendant who relies on the plaintiff's sales material in its own marketing demonstrates that the plaintiff enjoys goodwill in the products or get-up contained in the sales material.

2 6 1 *Momentum Creations* concerned furniture sold by the plaintiff under the "OM" trade mark. Evidence was tendered showing that the defendant's sales representatives had made representations to customers that the defendant was the distributor of "OM" products. The sales representatives had shown "OM" advertisements and brochures to potential customers. Four items of furniture sold by the defendant were similar to "OM" products. The defendant was essentially representing that he was the maker or supplier of "OM" furniture when selling the four items in question.

262 Passing off in this case succeeded because of the use of the "OM" mark in promoting the defendant's goods. I must clarify that this is not a case where the court found that the *design of the four items* enjoyed goodwill. Instead, the goodwill that was interfered with was the goodwill which subsisted in the "OM" trade mark. The defendant used the plaintiff's advertisements and brochures in order to ride on the goodwill in the "OM" trade mark. The passing off was in substance a form of inverse passing off.

263 In the present case, whilst there is some evidence that the defendants had based its brochure and warranty card on the 1st Plaintiff's brochure and warranty card, I am unable to conclude that the defendants had thereby represented that they were dealers in the 1st Plaintiff's products or were the makers of the 1st Plaintiff's products such as to ride on the goodwill in the "SINGSUNG" name. The evidence as to how the catalogue was used and whether the warranty card (with the erroneous "SINGSUNG" reference) was actually used or corrected is thin. *Momentum Creation* can easily be distinguished on the ground that in the present case, the defendants did not represent itself to be the 1st Plaintiff in its brochures. While the defendant in *Momentum Creations* used the plaintiff's "OM" brochures, the defendants in this case manufactured their own brochures with their own "LS" brand.

264 Moreover, while this is a technical point, I must mention that the plaintiffs have not pleaded a claim to passing off based on the "SINGSUNG" mark. There is no claim to goodwill in the "SINGSUNG" name before me. The claim before me is based on goodwill in the SINGSUNG Get-Up only.

265 Thus, to conclude this section, I do not find that the slim evidence of the defendants' use of the 1st Plaintiff's brochures or warranty card warrants a finding that there is goodwill in the SINGSUNG Get-Up.

Summary of my findings on passing off

266 The claim for passing off is based on the alleged similarities in the get-up, design and other features of the 1st Plaintiff's and 1st Defendant's competing products. It is not based on the parties' brand names.

267 In relation to the straightforward claim for passing off in Singapore, I find first that Singapore consumers/customers do not view the SINGSUNG Get-Up as an indicator of the 1st Plaintiff's trade

origin. In particular, the following reasons were crucial to my finding:

(a) The existence of actual sales to Singapore consumers is thin, and at best, small in volume.

(b) There was no evidence on how Singapore consumers viewed the SINGSUNG Get-Up.

(c) The evidence suggests that the trade buyers were very aware that the 1st Plaintiff and 1st Defendant ran separate businesses that sold similar products. They are therefore unlikely to have treated the SINGSUNG Get-Up as indicators of trade origin. Further, the plaintiffs adduced no evidence that the trade buyers treated the SINGSUNG Get-Up as indicators of trade origin, or that they were confused.

268 Moreover, I find that even if goodwill did exist in Singapore, the brand names "SINGSUNG" and "LS" are likely to have negated any possibility of confusion.

269 In relation to the passing off claim based on the instruments of deception doctrine, I find that while the 1st Defendant clearly did put into circulation the alleged instruments of deception, there was no passing off. My conclusion is mainly based on the following findings:

(a) The 1st Defendant's goods that were supplied in Singapore were not instruments of deception in Singapore as there was no evidence that the public in Singapore regarded the SINGSUNG Get-Up (as distinct from the actual brand names) as a badge of origin distinctive of the 1st Plaintiff.

(b) The SINGSUNG Get-Up does not enjoy goodwill in Cameroon. My finding is premised primarily on the fact that there was simply insufficient evidence that the consumers in Cameroon viewed the SINGSUNG Get-Up as an indicator of trade origin (exclusively associated with the 1st Plaintiff).

(c) Further, it is not unlikely that the brand names "SINGSUNG" and "LS" may still serve to distinguish the plaintiffs' and defendants' goods. It is not a general rule that brand names in the English lettering will not be relied upon by consumers who are English illiterate. Much depends on the complexity of the English word or phrase and the overall circumstances.

270 I also reject the plaintiffs' submissions that goodwill exists by virtue of the defendants' alleged deliberate copying, deception, or use of the 1st Plaintiff's marketing materials. In my view, the lack of proper evidence of goodwill is fatal to the plaintiffs' claim for passing off.

Copyright infringement

271 As mentioned at [58] of this judgment, the plaintiffs' copyright claim is advanced based on the following works.

(a) The "White Get-Up" picture comprising a DVD player, guitar and a sitting room. This is found on the packaging of DVD A.

(b) The "Blue Get-Up" picture comprising the picture of a DVD player. This is found on the packaging of DVD B.

(c) The sticker pasted on the television sets.

(d) The "Rotary Rotatory" logo found on the sticker and the packaging of the television sets.

(e) The floral pattern on the rice cookers.

(f) The start-up screen linked to the DVD players.

272 In the paragraphs that follow, I shall consider if the plaintiffs own copyright in any of the above works, and if so, whether the defendants have infringed the plaintiffs' copyright.

The White Get-Up

273 The plaintiffs' claim to own copyright in the White Get-Up rests on the assertion that the 2nd Plaintiff designed the said get-up. I start by discussing the facts relating to the 2nd Plaintiff's role in the design of the White Get-Up. I then discuss the law on the ownership of copyright, and finally consider if the 2nd Plaintiff (or the plaintiffs together) can be said to be owner(s) or exclusive licensees of the copyright in the White Get-Up. Most of the relevant law will be discussed in detail under this section. The principles distilled will then be applied to the other claimed original artistic works.

Evidence on the White Get-Up

274 The 2nd Plaintiff testified that he designed the White Get-Up together with "workers" from the Chinese ODM sometime in early 2007. [note: 83] The witness clarified that what he did was to describe the general idea to a designer from the Chinese ODM. In short, according to the 2nd Plaintiff, the ideas behind the design belonged to him, but the actual picture in terms of the expression of the artistic elements, was developed and reduced to material form by the manufacturer's designer on the 2nd Plaintiff's instructions. [note: 84] I note that no witness from the Chinese manufacturer gave evidence on the origination of the picture, but the defendants did not offer evidence to the contrary.

275 What is not clear from the evidence of the 2nd Plaintiff, however, is the extent to which he provided detailed feedback on the artistic elements of the White Get-Up (such as perspective, details, arrangement and visual impact). CYX, the 1st Plaintiff's quality control manager, testified on behalf of the plaintiffs. Her evidence was that during their visit to the Chinese manufacturer, the 2nd Plaintiff informed the ODM's designer that it was important to have a design that was evocative of a consumer lifestyle and that showcased the fact that DVD players were modern conveniences to be enjoyed in the comfort of home. Following that request, the designer created a draft sketch to which the 2nd Plaintiff requested minor amendments. [note: 85]

276 On the whole, I accept the 2nd Plaintiff's evidence that he did come up with the idea behind the White Get-Up, and had also provided feedback on the images. I am also satisfied that the Chinese ODM's designer was responsible for executing the idea and producing the actual picture. I find no reason to doubt CYX's evidence on the extent of the 2nd Plaintiff's involvement in the design of the White Get-Up either.

Ownership of copyright in the White Get-Up

277 Section 30(2) of the Copyright Act (Cap 63, Rev Ed 2006) ("the CA") states that "the author of a literary, dramatic, musical or artistic work shall be entitled to any copyright subsisting in the work".

278 The CA does not set out a general definition of authorship. However, it is clear that copyright is concerned with protecting original expression of ideas, and not ideas themselves. A clever original

idea does not attract copyright on its own; what does attract copyright is the original *expression* of the idea. This distinction between the idea and its expression is well-established and much discussed in copyright law. Indeed, this distinction permeates much of copyright law: from authorship, originality, the meaning of expression and subsistence of copyright, all the way to infringement and remedies.

279 One issue that frequently arises is whether a claim to authorship can be made out based on contributions to the idea upon which the work is built. Take for example the well-known decision *Kenrick & Co v Lawrence & Co.* [1890] 25 QB 99 ("*Kenrick*"). In that case, X came up with the idea of having a "user friendly" voting card; it consisted of using a simple line drawing of a hand marking a cross within a box so as to help illiterate voters understand how their vote was to be recorded. X could not draw and asked an employee to execute the idea and produce the voting card coupon. X also gave directions for some changes to be made to the position of the hand in the first draft. The court eventually found that copyright did subsist in the drawings (notwithstanding the simplicity of the work), but commented (in passing) that X could not claim to be the sole author of the drawing. His contributions to the artistic expression were limited to the suggestions he made. At most, X might have enjoyed a claim to be a joint author with the employee.

280 Usually, where a court is faced with facts such as those in *Kenrick*, it does not matter whether X is the sole or joint author of the design, or if he even is an author at all. This is because the drawing is executed by an employee in the course of his employment, and hence, s 30(6) of the CA confers the copyright ownership on the employer. The point remains, however, that just because a person has conceived what he considers to be a clever and useful idea does not mean he becomes the author of the artwork in which those ideas are expressed. This is so even if he has made some suggestions and voiced some criticism on drafts. Authorship depends on the *nature and extent of contribution that person makes to the actual expression reduced to material form*.

281 There are many cases in which courts have found that the person who contributed to the idea behind the work was not the author of the eventual work as expressed in material form, for example:

(a) In *Tate v Fullbrook* [1908] 1 KB 821, P conceived of the general idea for a comic play. The idea and the dramatic situations were communicated to a script writer who then composed the dialogue in accordance with P's ideas. The Court of Appeal was unanimous in finding that P was not the author of the work. In this regard, Vaughan Williams LJ stated at 826 that whilst it was true that the plaintiff had suggested the general idea, that did not "make the plaintiff the author of the sketch either alone or jointly with [the script writer]".

(b) In *Wiseman v George Weidenfeld & Nicolson Ltd and Donaldson* [1985] FSR 525 and *Donoghue v Allied Newspapers Limited* [1938] Ch 106, the English courts found that the litigant in question did not become an author or even a joint author of a work under copyright law despite his contribution to the idea behind the work and his participation in discussions and offering feedback.

282 On the other hand, one case in which a person succeeded in establishing a claim to joint authorship is *Najma Heptulla v Orient Longman Limited* [1989] 1 FSR 598 ("*Heptulla*"). That was an interlocutory decision of the Indian High Court in New Delhi. An individual was persuaded to write an "autobiography" on the basis that a certain professor would undertake as much of the writing as possible. It took two years to write the book. In those two years, the individual would describe his experiences to the professor, who would take down detailed notes. Draft chapters were prepared and discussed at length with the individual. It was accepted (at least for interlocutory purposes) that the individual concerned requested numerous amendments and alterations. After the first draft of the

book, the individual required some 30 pages of "a personal character" to be deleted. The individual was also involved in vetting subsequent drafts. The court found that the individual and the professor were joint authors and hence, joint owners of copyright in the autobiography.

283 Indeed, I note that the concept of joint authorship (and hence ownership) is well-established. In *Levy v Rutley* (1870-71) LR 6 CP 523 ("*Levy*"), Byles J held (at 528) that if a work had been originally written by two persons in prosecution of a pre-concerted joint design, both might be joint authors of the whole work even though each was responsible for different parts of the work. From this, it followed that if two persons with a common design collaborated to produce a work, they could be regarded as joint authors. On the assumed facts, the court found that there was evidence of a pre-concerted joint design to write the book in question. Further, it appeared that the other individual had read every word of the manuscript and had made alterations, additions, omissions and corrections.

284 Joint authorship is also a concept that is firmly part of the copyright law of Singapore: Susanna H S Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) at para 06.045. Section 7(2) of the CA states that a "work of joint authorship" refers to:

> ... [A] work that has been produced by the collaboration of 2 or more authors and in which the contribution of each author is not separate from the contribution of the other author or contributions of other authors ...

Whether a person's contribution is sufficient to justify the conclusion of joint authorship depends on the circumstances of each case. The task involves an assessment of the quantity and especially the quality of the contribution made by the said person. For the contribution to be relevant, it must be "authorial" in nature and must relate to the *expressive* elements of the work. This could refer to the literal expressive elements of the work, or the non-literal, structural, expressive elements such as contribution to the details of the plot, characters, and situations in a novel.

285 The decision of Laddie J in *Fylde Microsystems Ltd v Key Radio Systems Ltd* [1998] FSR 449 ("*Fylde Microsystems*") is also instructive. The plaintiff and defendant co-operated in designing software to be used in radios. The plaintiff claimed that it wrote the program which was installed in the defendant's radios for retail sale. It appears that the plaintiff and defendant cooperated closely in designing the software. There was also continual refinement and improvement of the software. The evidence was that over a five year period, the plaintiff and defendant spent many hours discussing the software and what it was to do. The plaintiff stated that this was to be expected because the software was designed as "specialist bespoke software to be supplied to a technically sophisticated customer": *Fylde Microsystems* at 456. According to the plaintiff, it was almost inevitable that such a customer would be intimately involved in monitoring the software as it is developed and suggesting what its functions should be.

286 In Laddie J's opinion, two matters in relation to authorship had to be addressed (see *Fylde Microsystems* at 456). First, it was necessary to determine whether the putative author had contributed "the right kind of skill and labour". If he had, then it was necessary to decide whether his contribution was big enough to justify a finding of joint authorship. Laddie J noted that the latter issue in particular is a matter of fact and degree.

287 Laddie J described the skill and labour contributed by the defendant as falling into five categories: (a) fixing and reporting faults and bugs; (b) making a functional contribution by way of setting the specification for what the software was to do; (c) making a contribution by suggesting what was causing some of the common faults (but without contributing the software solution); (d)

providing the technical information on the characteristics of the hardware into which the software fitted and with which it had to cooperate; and (e) setting the parameters and timings within the software. He concluded that these contributions, whilst time consuming and of value, did not amount to contributions to the *authorship* of the software.

288 Another case relevant to our current discussion is *Robin Ray v Classic FM Plc* [1998] FSR 622. The plaintiff was engaged to advise the defendant (a radio station) on its classical composition repertoire and to catalogue its music library. The plaintiff produced five documents with proposals for the classification as well as a catalogue. Subsequently, in an action for copyright infringement, issues relating to the authorship and ownership of the copyright in the five catalogues and the database arose. In deciding that the defendant was not a joint author of the catalogues and database, Lightman J made the following points:

(a) A joint author is one who collaborates with another author in the production of a work, who as author provides a significant creative input, and whose contribution is not distinct from that of the other author.

(b) A joint author must contribute to the production of the work and create something protected by copyright which finds its way into the finished work.

(c) Copyright exists, not in ideas but in the written expression of ideas. A joint author must participate in the writing and share responsibility for the form of expression in the work.

(d) A joint author must do more than contribute ideas to an author.

(e) A joint author must be an author or creator of the work in question; it is not enough that he thought up the plot of a play, or made suggestions for a comic routine to be included, or passed on his reminiscences to a ghost writer.

(f) Even if there is a division of labour between the two parties, there is no joint authorship if one alone is entirely responsible for the skill and labour of the *authorship* of the book.

(g) There is no restriction on the way in which a joint author's contributions may be funnelled into the finished work, and there is no requirement that each of the authors must have exercised penmanship.

(h) There must, however, be something which approximates to penmanship, namely, a direct responsibility for what actually appears on paper.

289 Finally, I consider the English High Court case *Hadley* v *Kemp* [1999] EMLR 589. This is a case concerning musical work copyright in pop songs and a claim of joint authorship by a pop band that performed the pop songs. Park J was of the view that in order for a person to be a joint author of a musical work, four elements had to be satisfied: (a) the claimant must have made a contribution; (b) the contribution must have been significant; (c) the contribution must have been original; and (d) it must have been a contribution to the creation of a musical work. The court held that a contribution in terms of mere performance or interpretation of the musical work was not enough.

290 The principles which arise from the above cases can be summarised as follows:

(a) First, authorship always requires a contribution to the *expression* of the work.

(b) Second, the mere fact that there is a pre-concerted joint design to produce a book or a work does not necessarily make each party to that design a joint author.

(i) While the court in *Levy* did hold that the writing of a work in accordance with a pre-concerted joint design could result in the work being one of joint authorship, this was said in the context of both parties having contributed to the *writing* of the work. For example, a publisher who enters into a pre-concerted joint design to produce a book will not ordinarily qualify as a joint author of the work notwithstanding the pre-concerted design and his contributions to the book in the form of type-setting, *etc*.

(ii) In *Heptulla*, the subject of the biography had made substantial contributions to the expression of the work. He read each line and made numerous alterations and changes to the work. At least for interlocutory purposes, it appeared that he had done more than to merely communicate basic raw ideas or information.

(c) Third, whilst authorship is linked to expression, the law accepts that "expression" for copyright purposes includes both literal and non-literal expressive elements.

(d) Fourth, intellectual contributions in the form of criticism (such as detection of errors) are unlikely to be sufficient unless the criticisms involve a substantial contribution to the expression.

(e) Fifth, whilst in many cases, an author will actually be the person who reduces the work to material form, there will be cases where this will not be so. For example, it is clear that an amanuensis is not an author.

291 In the present case, the evidence as to the quality and quantity of the 2nd Plaintiff's contribution to the White Get-Up was thin. As described above, we only have the testimony of the 2nd Plaintiff himself, as well as CYX, one of his employees. While I accept that the idea and the basic elements of the White Get-Up came from the 2nd Plaintiff, I am not satisfied that the 2nd Plaintiff contributed enough to be considered an author or joint author of the White Get-Up. In my view, he made no contribution to the White Get-Up as actually expressed; his contributions were limited to the broad ideas behind the White Get-Up, and did not extend to any aspect of its actual expression.

292 In coming to this conclusion, I do not doubt that the 2nd Plaintiff took pride in his idea and expended effort to procure packaging that he thought would appeal to buyers. This is not enough, however, to establish his claim to authorship. On this ground, I find that the 2nd Plaintiff is not the owner of the copyright in the White Get-Up under the CA.

Copyright infringement actions in the context of joint ownership

293 If the 2nd Plaintiff had proven more substantial contributions to the *expression* of the White Get-Up, a finding of joint authorship may have been possible. If this were the case, I would have had to consider whether a joint author (as a joint owner) can bring an action for copyright infringement without the other joint owners. Of course, this question is merely academic given that I have found that neither of the plaintiffs is, on the facts, a joint owner of the copyright in the White Get-Up. For this reason I make no further comments.

Exclusive license or assignment of ownership to the White Get-Up

294 Having found that the plaintiffs are not joint authors of the White Get-Up, it follows that if the plaintiffs' copyright claim in respect of the White Get-Up is to succeed, it must be based on an

assignment of ownership or the grant of an exclusive licence to the copyright by the owner of the said copyright.

295 On the facts as I have found it, the author of the White Get-Up is the designer from the Chinese ODM. There is no evidence as to the relationship between that designer and the Chinese ODM. Whilst he may well have been an employee, there is also the possibility that he was an independent consultant. It is thus unclear to me who the *owner* of the copyright in the White Get-Up is.

296 In any case, assuming for the sake of argument that the owner of the copyright is the Chinese ODM (*ie*, that the designer was an employee), the plaintiffs submitted a copy of what was said to be an agreement between the 1st Plaintiff and the Chinese ODM (dated 5 January 2007) into evidence. This agreement was said to effect an assignment of, or the grant of an exclusive license in, the copyright in the White Get-Up to the 1st Plaintiff. The document sets out the following statement: [note: 86]

> All the artwork of DVD-339K series, white coloured box, external box and panel sticker etc that SINGSUNG Pte Ltd ordered from my company are designed by SINGSUNG. My company is committed to and assures that the artwork design will not be given for use by other clients.

297 The meaning of this statement and the context it was made is unclear. Indeed, the document on its own does not even appear to be set out as a contract. It merely sets out the above bare statement, very much like a declaration. The plaintiffs also did not plead or submit that foreign law applies to the issues of the effectiveness of an assignment of intellectual property rights (if any) or the contractual validity or construction of the document that they were relying on. I will accordingly apply principles of Singapore law in the absence of any assertion or argument to the contrary. Whilst there is no legal requirement that any particular formula of words must be used to effect an assignment or the grant of a copyright license, the words that are used must objectively be capable of being understood as effecting such.

298 On one interpretation, the statement may be regarded as an admission of some design contribution of the plaintiffs to the White Get-Up, but I am unable to conclude on this basis alone that the 2nd Plaintiff was the author or joint author of the White Get-Up. With respect, what I am concerned with is who is/are the author(s) of the White Get-Up *in fact*; the Chinese manufacturer's *statement or opinion* that the 1st Plaintiff "designed" the White Get-Up cannot take the plaintiffs very far (unless further evidence is adduced as to the meaning the Chinese manufacturer ascribed to "design"). It is clear on the plaintiffs' own evidence that the 2nd Plaintiff only conceived and discussed the idea behind the White Get-Up with the designer. It was the designer who reduced those ideas into material form. In this "loose" sense, the 2nd Plaintiff could be considered, as the statement says, a "designer" of the White Get-Up. However, this is insufficient to give rise to a finding that the 2nd Plaintiff is the author of the White Get-Up for the purposes of determining copyright ownership.

299 I must next consider if the statement could be interpreted to be an assignment of, or a grant of an exclusive license to the White Get-Up. Under cross-examination, the 2nd Plaintiff testified that the manufacturer told him that it would not supply the DVD players of his chosen design to anyone else. [note: 87] The only evidence for this is the statement referred to above. It is thus to the interpretation of the above statement that I now turn.

300 In my view, the statement does not purport to assign or transfer any proprietary rights to the 1st Plaintiff. One possible interpretation of the statement may well be that the ODM had *contractually*

promised not to supply the DVD players or the packaging with the White Get-Up design to other persons. This could be implied from the second sentence in the quote at [296] above that "[m]y company is committed to and assures that the artwork design will not be given for use by other clients".

301 However, this does not in law or in fact amount to an assignment of, or the grant of an exclusive licence to, the copyright in the White Get-Up. In my view, the statement reads like a personal undertaking by the Chinese manufacturer and can at most only give the plaintiffs a contractual claim against the ODM. There can be no reasonable interpretation of the statement that treats the Chinese manufacturer as having granted the plaintiffs an assignment or exclusive licence.

302 I thus find that on the evidence before me, there was neither an assignment of the copyright in the White Get-Up, nor was there a grant of an exclusive license to the plaintiffs to use the White Get-Up. It follows that the plaintiffs' claim that its copyright in the White Get-Up was infringed must fail because they do not have any proprietary rights to the said copyright. To be clear, I recognise that the question whether an exclusive licensee is to be treated as acquiring a proprietary interest is unclear. However, this is not a matter that needs to be decided in the present case.

Does copyright subsist in the White Get-Up in Singapore?

303 In the event that I am wrong and the 2nd Plaintiff is to be regarded as an author or joint author of the White Get-Up, the claim for copyright infringement, properly pleaded, may well succeed. I first discuss whether copyright subsists in the White Get-Up in Singapore assuming that the 2nd Plaintiff is an author/joint author of the White Get-Up.

304 The picture created for the box packaging of DVD Player A is an original artistic work. There is no evidence that the expressive elements were copied or taken from any pre-existing work. Even if the picture comprises relatively simple artistic elements, this is not a ground for denying originality.

305 Section 27(1)(*a*) of the CA provides that copyright shall subsist in an original, unpublished artistic work in Singapore if the author was a qualified person at the time the work was made. If the work is published, s 27(2) of the CA provides that copyright subsists or continues to subsist if the first publication took place in Singapore, if the author was a qualified person at the time of first publication, or if the author was a qualified person at his death if he died before the first publication.

306 As a result of regulations promulgated under s 184 of the CA, the CA has been applied to cover works and other copyright subject matter emanating from most countries of the world. The current position is succinctly set out by Professor Ng-Loy Wee Loon in *Law of Intellectual Property of Singapore* at para 6.3.10:

> (a) An unpublished work now enjoys copyright in Singapore if at the time when the work was made, the author was a citizen or resident of Singapore or another country which is a member of the Berne Union or the World Trade Organisation ("WTO").
>
> (b) A published work now enjoys copyright in Singapore if the work was first published in Singapore or a member country of the Berne Union or the WTO, or if at the time when the work was first published (or at the time of the author's death), the author was a citizen or resident of Singapore or a member country of the Berne Union or the WTO.

307 It follows that the White Get-Up enjoys copyright in Singapore as an original artistic work. If the 2nd Plaintiff is regarded as the author or joint author of the work, his status as a Singapore

citizen/resident at the time when the work was made is sufficient for the work to acquire copyright in Singapore. In any case, China is a member of the Berne Union (July 1992) and the WTO (December 2001). Assuming the designer or author was a Chinese citizen or resident at the time the work was first published, the White Get-Up will attract copyright in Singapore. In these circumstances, there is no need to consider the place of first publication.

Assuming copyright belongs to the plaintiffs, did the defendants infringe the plaintiffs' copyright in the White Get-Up?

308 Again, operating on the assumption that I am wrong about the plaintiffs' ownership of copyright in the White Get-Up, and given my finding that copyright can subsist in the White Get-Up in Singapore, I now briefly discuss whether the defendants' actions would have constituted copyright infringement.

309 Section 26(1)(*b*)(i) of the CA sets out the exclusive right of a copyright owner to reproduce the artistic work in a material form. Where a defendant reproduces the work without the licence of the copyright owner, he infringes the owner's copyright. Infringement does not require that the artistic work was exactly copied. It is sufficient if a substantial part of the copyright has been taken.

310 Copyright infringement can arise in a number of different ways. In brief, the first, sometimes referred to as primary infringement, arises pursuant to s 31 of the CA when a defendant does, in Singapore, and without licence, any of the acts comprised in the copyright. The second, sometimes referred to as secondary infringement, occurs when a defendant imports infringing articles into Singapore for trade purposes and/or sells the infringing copies in Singapore: see ss 32 and 33 of the CA.

311 The provisions governing liability for secondary infringement under ss 32 and 33 are complex, especially so in the case of imported articles. Where s 32 is asserted in respect of the *importation* of an infringing article without the licence of the copyright owner, the relevant copyright owner for the purpose of deciding whether the importation was without licence is the person who is entitled to make the article in the *country into which it has been imported* (*ie*, in our present case, Singapore): s 25(2) of the CA.

312 In addition, the importer under s 32 of the CA must *know or ought reasonably to know* that the imported article *was made without the consent* of the copyright owner. The identity of the copyright owner for the purpose of deciding whether the article was made without consent is set out in s 25(3) of the CA—it refers to the *copyright owner in the place of making* (*ie*, in our present case, China). If such a copyright owner exists, then it is the copyright owner in that place whose consent is relevant so far as the making of the imported article is concerned. If there is no copyright owner in the place of making, it will be the owner of the copyright in Singapore whose consent is relevant. It follows that liability under s 32 of the CA will often require an examination of who the owner of the copyright in the place of making is, and whether that person consented to the making of the imported article.

313 Where s 33 of the CA is asserted to catch the *sale* of imported articles in Singapore, it is necessary to show that the imported article was made *without the consent of the copyright owner*. Liability here does not depend on the defendant being the actual importer into Singapore. The provisions are directed at any person who is selling the imported articles. Once again, the relevant copyright owner is the copyright owner in the *place of making* unless there is no copyright owner in the place of making; in that event, the relevant copyright owner is the copyright owner in Singapore.

314 In the present case, it appears that the ODM in China with whom the defendants had placed

the order (a different ODM from that which produced the 1st Plaintiff's DVD A) reproduced the White Get-Up picture on the box packaging of the defendants' LS DVD 336A1. Whilst the evidence could have been clearer, no license seems to have been obtained by the defendants for such reproduction. A comparison between the plaintiffs' White Get-Up and the picture appearing on the defendants' box packaging reveals almost identical images. [note: 88] In fact, under cross-examination, the 2nd Defendant accepted that the White Get-Up had been copied. [note: 89] The 2nd Defendant's explanation was that the White Get-Up had been used by S H Econ on its packaging for DVD players. Any rights in the White Get-Up therefore belonged to the S H Econ partnership, and being a partner, he was entitled to use the White Get-Up as well.

315 It will be recalled that the 2nd Plaintiff started the 1st Plaintiff and the business of dealing in new electrical products before the S H Econ partnership was terminated. The 2nd Plaintiff's evidence is that some orders (business of the 1st Plaintiff) were initially processed through S H Econ for business or administrative convenience. [note: 90] I accept this evidence. I also accept that this did not mean that S H Econ or the 2nd Defendant had acquired any rights in respect of the 1st Plaintiff's business. Thus, the 2nd Defendant's "defence" that he was entitled to use the White Get-Up because of its history in relation to S H Econ cannot stand. In light of this, I now assess whether there would have been copyright infringement if the plaintiffs had owned the copyright in the White Get-Up.

316 Based on the above facts, primary infringement has not occurred in Singapore. It is clear that the reproductions of the White Get-Up took place in China. What the defendants did was to place an order for the products in China, and import them into Singapore for sale to overseas trade buyers. The requirement that the reproduction must be done in Singapore in order for primary copyright infringement to take place (see s 31 of the CA) is therefore not fulfilled.

317 However, a good case might have been made that the defendants were secondarily liable for copyright infringement under s 32 of the CA. The defendants did import the DVD players with the White Get-Up from China into Singapore for the purposes of sale. The evidence suggests that the articles were not made with the consent of the copyright owner in Singapore (or indeed China). It therefore follows that the defendants would be liable under s 32 of the CA provided it is established that they knew or ought reasonably to have known that the articles were made without the consent of the copyright owner.

318 Similarly, the defendants are likely to have been liable for copyright infringement under s 33 of the CA because they did sell the infringing DVD players (in its packaging) in Singapore.

319 Nevertheless, I repeat that the action for copyright infringement in the White Get-Up fails because the plaintiffs have not established that they are the owners of the copyright in Singapore or the holders of an exclusive licence.

The Blue Get-Up

320 A picture of DVD B and the Blue Get-Up is set out in an annexure to the plaintiffs' statement of claim. The plaintiffs' main complaint is that the defendants used the Blue Get-Up on its own box packaging for the 1st Defendant's DVD players.

321 I now describe the Blue Get-Up in some detail. [note: 91] The box is presented in a shade of blue. The brand name "SINGSUNG" appears at the top left corner of one long side. In the centre there is a photograph of the actual DVD player to be found inside the box. On the other long side, the words "Beware of Counterfeit Products" appears in cursive script at a top centre position. At the

bottom left, the words "3-year warranty" appears. At the bottom right side, the words "Power Compatible" (in cursive script), the model number DHI, and the words "DVD PLAYER" appear in plain bold font.

322 According to the 2nd Plaintiff, he decided on a blue colour theme for the box packaging. The ODM in China then produced a version of the DHI box which was tweaked by him. After this, SEC joined the 2nd Plaintiff in China and she stayed on for about seven months. During this time, SEC, on instructions from the 2nd Plaintiff, made some further adjustments to the Blue Get-Up. These included changing the uniform blue colour so that there was a subtle gradient (shading) in the blue colour moving from bottom left to top right, as well as making some adjustment to the placement of the brand and wordings.

323 I must first clarify exactly what is being asserted as an original artistic work. Based on the pleadings and the plaintiffs' closing submissions, it is relatively clear that copyright is being asserted only in the photograph of the DVD player, which is one part of the Blue Get-Up, rather than in the Blue Get-Up as a whole. [note: 92] Whilst the 2nd Plaintiff may have expended effort in selecting a blue shade, it appears that the core plank of the claim is in respect of the photograph of the DVD player.

324 During cross-examination, the 2nd Plaintiff asserted that he conveyed the idea of using a photograph of the actual DVD player on the box packaging of the DVD Player to the Chinese manufacturer. Whilst it is not clear who the actual photographer was, it appears that the parties have proceeded on the basis that the photograph was either taken by someone from the manufacturer, or that the manufacturer arranged for the photograph to be taken. [note: 93]

325 The agreement between the 1st Plaintiff and the Chinese manufacturer of DVD Player B includes the following provision: [note: 94]

> Artwork of the entire order of packaged colored boxes (blue), external box, panel sticker of the entire machine etc, are designed by Party A's company and the exclusive rights of the external appearance belong to Party A. Party B shall not provide the design (including artwork color, typesetting, contents, wordings etc) for the use of other clients.

326 I am prepared to proceed, at least for the moment, on the basis that the photograph enjoyed copyright in Singapore on the grounds that: (a) the photograph was an original artistic work and (b) that a connecting factor to secure copyright in Singapore was satisfied (*ie*, the personal status of the author). In making this observation, I note that the defendants assert that the photograph lacked originality because most DVD players come in cartons bearing a picture of the DVD player. This is misconceived. A photograph of a natural scene or a man-made object owes its originality to the skill and effort of the photographer. The fact that photographs of the scene or man-made object are common place is irrelevant. Artistic merit is also irrelevant.

327 Assuming copyright subsists, I next consider the issue of copyright ownership. Section 30(5) of the CA confers the copyright in a commissioned photograph on the commissioner. Whilst the 2nd Plaintiff has asserted that he acquired the copyright in the photograph in Singapore under s 30(5), there is very little evidence on the actual circumstances under which the photograph was taken and provided. This is important because a commissioner can only rely on s 30(5) if the agreement to take the photograph is for valuable consideration. On the evidence before me, it appears that whilst the 2nd Plaintiff asked for photographs to be taken or provided for use as part of the Blue Get-Up, no consideration was specifically provided for the taking of the photograph (if that was in fact what happened). Neither party addressed this point. Nevertheless, I am prepared again, for the moment, to

proceed on the basis that the requirements of s 30(5) were met, such as to vest the copyright in the photograph in the 2nd Plaintiff.

328 If copyright did subsist in the photograph in Singapore, and if the 2nd Plaintiff was entitled to claim the copyright under s 30(5), the 2nd Plaintiff may be able to rely on the provisions dealing with secondary infringement and imported articles (as discussed earlier).

329 The difficulty which the 2nd Plaintiff faces on the facts, however, is that neither the defendants nor the defendants' manufacturer in China appear to have copied his photographs. I make a number of points on this. First, the 2nd Plaintiff accepted under cross-examination that it was normal or common for the packaging of DVD players to set out a photograph of the DVD player. Second, it appears that the picture or photograph of the DVD players on the defendants' alleged infringing copies are not reproductions of the plaintiffs' photographs. As such, there is no copyright infringement because it is not copyright infringement to use the idea of photographing a particular scene. If the defendants or their manufacturer had taken their *own* photograph of the same DVD player, there can be no copyright infringement.

330 In this case, it appears that the defendants did not copy the plaintiffs' photograph. I observe that the actual DVD players depicted in the parties' photographs were of different models. [note: 95] That being so, it is clear that the plaintiffs' photographs could not have been taken by the defendants for their own use. What the defendants did was to take or use the same idea of a blue background on which a picture of a DVD player would be displayed.

331 In coming to this conclusion, I have noted the plaintiffs' point that there was some evidence that one of the defendants' customers provided a photograph of DVD B to the plaintiffs, and that this was passed on to the defendants' factory in China. [note: 96] Be that as it may, the photograph provided is not in evidence. Moreover, for the reasons stated above, it does not appear that the defendants or their manufacturer had actually copied that photograph.

332 Therefore, even if the 2nd Plaintiff had established his right to copyright in the photograph, the action for infringement fails.

333 For the sake of completeness, I will consider the possibility that the "Blue Get-Up Picture" may have been a reference to the Blue Get-Up as a whole. In other words, I shall consider if any copyright infringement arises from the alleged copying of the Blue Get-Up as a whole.

334 It seems to me that the key artistic element taken (or borrowed) from the Blue Get-Up, colour aside, was the photograph of the actual DVD player. The blue colours of the defendants' boxes, whilst similar, were in a different shade of blue. The defendants' brand name was different, and the model numbers used were different. The picture of the DVD is also different.

335 Whilst I accept that copyright can subsist in very simple works, it is also an established principle that where the work is so simple that it barely qualifies for protection, nothing but an exact reproduction will amount to the "substantial taking" that is required for infringement. In *Kenrick*, Wills J held (at 102) that "the mere choice of subject can rarely, if ever, confer upon the author of the drawing an exclusive right to represent the subject" and that whilst the most mechanical representation of the commonest object may enjoy copyright, "nothing short of an exact literal reproduction of the drawing" will amount to infringement. This is an eminently sensible approach to take given the distinction drawn by copyright law between an idea and the expression of the idea. In the present case, even if the Blue Get-Up as a whole is an original artistic work, I do not think there is sufficient copying of the Blue Get-Up as a whole to justify a finding of copyright infringement.

336 For the above reasons, the action for infringement in relation to the Blue Get-Up fails.

The sticker pasted on the television sets and the "Rotary Rotatory" logo

337 Copyright has not been claimed over the phrase "Rotary Rotatory" as an original *literary* work. Instead, in their statement of claim, the plaintiffs claim that the sticker as a whole, and the "Rotary Rotatory" logo (phrase) on its own, constitute original *artistic* works. [note: 97]

Subsistence and ownership of copyright

338 It will be recalled that a key feature of the 1st Plaintiff's television sets is that the screen could swivel 90 degrees on the base plate. Both SEC and the 2nd Plaintiff testified that the sticker was designed by SEC on the instructions of the 2nd Plaintiff for placement on the screen of the television sets. The sticker bore the phrase "Rotary Rotatory" in cursive script, as well as three symbols (simple drawings) depicting gears, cathode ray tubes and the side profile of the television set. Together with the symbols, the following information is set out in the sticker: "90 degrees Rotatable"; "100% Brand New Picture Tube with 3 years warranty"; "Terms and Conditions apply"; and "Ultra slim". The "SINGSUNG" brand appears in yellow lettering at the bottom of the sticker together with the word "Singapore". The phrase "Rotary Rotatory" also appears on the housing of the television, above the screen. The plaintiffs refer to this phrase as a logo.

339 During cross-examination, SEC gave evidence that the phrase was chosen because it conveyed the essential information in a rhythmic manner. A cursive font was chosen so that the appearance of the phrase matched the flexibility of the television sets (the ability to rotate the screen towards the viewer). [note: 98] The witness went on, however, to state that the phrase was the "name of the television" and that it was not "exactly part of the sticker design". [note: 99] When asked to clarify what she meant, the witness repeated that what she had in mind was to choose a phrase, by way of naming the television, to best convey the rotating feature of the model. [note: 100]

340 On balance, I accept SEC's evidence on how the sticker was conceived and developed. Whilst I find that the "Rotary Rotatory" logo (phrase) is not an artistic work in its own right (as will be explained later), I find that the simple line drawings and the arrangement of the elements on the sticker as a whole constitutes an original artistic work. As SEC explained, she wanted to "use simple, easily recognisable images to represent each special feature" of the television set. [note: 101] The defendants dispute that SEC is the author of the sticker or the "Rotary Rotatory" logo. They submit that the sticker (and the phrase) was created by the Jin Pin factory, and argue that it was absurd for SEC to claim to have come up with a word-dominated sticker given her evidence that the intended consumers were largely illiterate. Whilst there is something to be said for this, given that there is no evidence from the Jin Pin factory, I accept the evidence of SEC. There is no evidence to suggest that SEC copied the images from some other work. I therefore find that the sticker is an original artistic work as a whole. I also find that its author is SEC.

341 Section 30(6) of the CA provides that where a work is made by an author pursuant to the terms of his employment under a contract of service, copyright vests in the employer. In the present case, even though no written contract of employment was signed, it is clear that SEC was an employee of the 1st Plaintiff at the time when she conceived and developed the drawings. [note: 102] There is no requirement that the contract of service must be in writing. The fact that SEC decided to gain some work experience before starting or completing tertiary education, or that she only worked for a short time, does not alter the fact that she was an employee. Her evidence, which I accept,

was that she started at the 1st Plaintiff doing administrative work, but moved into design work because she had an interest in that field. Indeed, the evidence establishes that at the time of the hearing, SEC was a final year student at LASALLE College of the Arts. Accordingly, I find that the 1st Plaintiff is the owner of the copyright that subsists over the drawings in the sticker.

342 To be clear, I do not find that copyright subsists in the stylised "Rotary Rotatory" logo (phrase) on its own, whether as an original artistic work or literary work (although the latter has not in any case been claimed). I shall now explain the reasons for this finding.

343 A literary work is a work that is intended to offer information, pleasure or instruction to a reader in the form of literary enjoyment. The significance of a literary work resides in the sequence and the meaning conveyed by the words or notation to the reader. An artistic work, on the other hand, is essentially concerned with visual appearance. The line between the two can of course be hard to draw. Penmanship is admired not just for its informational content; as in the case of Chinese calligraphy scrolls, visual styling can be just as important. Moreover, artistic work is not confined to works of fine art. Corporate logos, comprising just a few alphabets, set out in a stylised form, can be protected as artistic works especially when used in conjunction with some pictorial device. Indeed a signature, which of course comprises, a name, can enjoy copyright as a type of drawing and artistic work. Words and phrases can also be built into or form part of an artistic work (drawing or painting). Consider, for example, a painting of a cat where the image is formed by words and sentences of various lengths, or a map which contains drawings and textual information which can be read. Such images may be treated both as an artistic work and as a literary work (possibly as a compilation of works): Nicholas Caddick *et al*, *Copinger and Skone James on Copyright* vol 1 (Sweet & Maxwell, 16th Ed, 2013) at para 3-57.

344 In *Elwood Clothing Pty Ltd v Cotton On Clothing Pty Ltd* [2008] FCA 447 at [16]–[17], the Federal Court of Australia at first instance held that the question whether something is a drawing depends on whether it is (at [15]) "designed to convey 'semiotic' meaning (ie to be read as text) or rather a visual look and feel (ie to be understood as a design)". The decision was upheld on appeal by the Full Federal Court at [2008] FCAFC 197. Thus, words and slogans which are stylised and set out with a pictorial device in a particular colour combination may be regarded as an artistic work on the whole for the way in which the various elements have been selected and arranged for the sake of visual appearance.

345 Notwithstanding the examples of cases where corporate logos, *etc*, have been held to enjoy copyright as a species of artistic work, care is needed before reaching the conclusion that two words presented in an ordinary cursive script are to be regarded as an artistic work in its own right. This requires an assessment of the importance of the visual impact over and above the semiotic meaning. Did the author intend the work to be appreciated for its visual appearance? How do members of the public view the words? Ultimately this is a question of judgment for the court. In my view, the phrase "Rotary Rotatory", even considering the particular font it is presented, is not an artistic work. The evidence is that the phrase "Rotary Rotatory" was chosen as a name to convey a specific meaning to the viewer (potential customer). It was not chosen as part of the *design* of the sticker. Even though consideration was given to visual appearance, more effort was expended in coming up with the specific words and the intended meaning, rather than the design. Whilst this may not be a conclusive factor on its own, I add that there was no evidence that ordinary persons appreciated the words (or phrase) for their visual appearance.

346 What remains is the question whether the phrase can be protected as a species of literary work. To have the literary content of the logo protected requires an assertion of literary work copyright. The use of literary copyright to protect words, titles and slogans has long given rise to its

own problems in copyright law. However, there is no need to examine these problems here since no claim to literary work copyright has been put forward.

Was there an infringement of the plaintiffs' copyright?

347 Given my finding that copyright subsists in Singapore in the sticker as a whole as an artistic work, liability for infringement will arise if the artistic work is reproduced without the licence of the copyright owner. Where the alleged infringing copy is made outside Singapore and then imported into Singapore for sale, the importer will be liable for secondary infringement under ss 32–33 of the CA in the circumstances which have been summarised at [310]–[313] of this judgment. I now consider the evidence that was given on this issue.

348 The evidence shows that the 2nd Defendant paid a visit to the same ODM in China, the Jin Pin factory, from whom the plaintiffs had obtained their television sets. The 2nd Defendant's own evidence on this is as follows:

(a) During his visit, he chose rotating television models from a catalogue. [note: 103]

(b) He requested that the manufacturer add the phrase "Rotary Rotatory" to the body of the television set and on the stickers to be pasted on the television set. [note: 104] He wanted stickers so that the television set would not look so plain and because many other brands such as SAMSUNG included stickers. [note: 105]

(c) Whilst the evidence could have been clearer, it seems that the 2nd Defendant's position is that he came across the 1st Plaintiff's sticker on a television set whilst he was visiting the Chinese manufacturer's factory. [note: 106] This was also when he saw the phrase "Rotary Rotatory" on the 1st Plaintiff's television sets.

(d) He then asked the manufacturer to provide the same stickers and to use the same phrase, but to change the company name or logo.

(e) The manufacturer agreed to provide the sticker. For this reason, the 2nd Defendant was of the view that the sticker could not have belonged to the 1st Plaintiff. [note: 107]

349 The evidence over the circumstances surrounding the 1st Defendant's orders for television sets from the Jin Pin factory, and in particular, whether the Jin Pin factory was confused or deceived by the 2nd Defendant into thinking that the 2nd Defendant and the 2nd Plaintiff were business partners, was hotly contested. [note: 108] What is clear is that two bulk orders were placed by the defendants. After the first bulk order, it appears that the Jin Pin factory refused to accept further orders from the 1st Defendant. [note: 109]

350 According to the 2nd Plaintiff, this was because he had complained to the Jin Pin factory about its dealings with the defendants. [note: 110] According to the 2nd Defendant, the reason was that the Jin Pin factory chose to stay with the plaintiffs because the 2nd Defendant was not prepared to guarantee a minimum number of orders. The plaintiffs also asserted that the defendants placed a second bulk order with the manufacturer by using a third party to conceal his identity. However, DL, a witness for the defendants, asserted that the second order was placed in this manner at the request of the Jin Pin factory. [note: 111] The reason why the Jin Pin factory would make such a request was unclear. According to the 2nd Defendant, it may have been because the Jin Pin factory was still keen

on his business notwithstanding the complaints of the plaintiffs. [note: 112] Either way, the defendants later decided to place orders for television sets from a different Chinese manufacturer. The phrase and stickers were not used on those television sets. [note: 113]

351 On balance, I accept the plaintiffs' version of what happened between the defendants and the Jin Pin factory, their Chinese ODM. The evidence of DL, the defendants' witness, was hard to follow on this point. Her statement that the sales staff at the Jin Pin factory did not refuse to take the order and that the defendants had found the sales service was bad does not explain why the Jin Pin factory required the second order to be placed through another company. [note: 114] It is more likely that the Jin Pin factory decided not to deal further with the defendants after discovering the history of the relationship between the 2nd Plaintiff and the 2nd Defendant. Thereafter, the defendants concealed their true identity in placing the second order for television sets from the Jin Pin factory.

352 The evidence being as it is, I find that the stickers made for the defendants' television sets reproduced a substantial part of the 1st Plaintiff's sticker. In my view, while primary copyright infringement cannot be established because the reproduction took place in China not Singapore, the defendants nevertheless did infringe the 1st Plaintiffs' copyright under ss 32 and 33 of the CA by importing and selling television sets with the sticker in Singapore. I now explain my conclusion in a bit more detail.

353 It will be recalled that liability under ss 32 and 33 of the CA for secondary infringement depends ultimately on establishing that the imported article was made without the consent of the copyright owner. It is also necessary to show that the defendant knew or ought reasonably to have known that the imported article was made without consent. I have found that the 1st Plaintiff is the owner of the copyright in Singapore. The question as to whether the sticker enjoys copyright in China is not one that has been addressed by either party. Indeed, even if the sticker is protected by copyright in China, no arguments or submissions have been made as to who is the owner of the copyright in China. Nevertheless, given my findings on the origination of the sticker and its design in Singapore, I am prepared to proceed on the basis that the 1st Plaintiff is also the owner of the copyright (if any) in China. If this is wrong, in that Chinese law does not confer copyright on the sticker in question, the "copyright owner" at the relevant parts of ss 32 and 33 of the CA will, as I previously explained, then refer back to the copyright owner in Singapore.

354 It is clear to me on the facts that the defendants never received the 1st Plaintiff's consent to reproduce the stickers and licence to import the stickers into Singapore. Further, I find that at least by the second order of television sets, the defendants knew or ought to have known that consent to the making of the stickers would not be given. This finding is assisted in large part by my previous finding that the defendants deceived the Jin Pin factory about its identity when placing its second order.

355 The position in relation to infringement *at the time of the first order of television sets and stickers* is trickier. The 1st Plaintiff clearly did not licence the importation or consent to making of the defendants' television sets with stickers substantially the same as that of the plaintiffs (save for the fact that the brand name was changed) at any time. However, the crucial point of difference is as follows. It is wholly unclear whether the 2nd Defendant, at the time of the first order of televisions sets, realised or ought reasonably to have known that the Jin Pin factory did not have the right to produce the sticker for the defendants. After all, the Jin Pin factory was the same ODM from whom the plaintiffs were obtaining their television sets and stickers. Given this lack of clarity, I am not satisfied that it is established on a balance of probabilities that the defendants knew or ought reasonably to have known that the making of these stickers was without the consent of the

copyright owner at the time the first order was placed and brought into Singapore. It follows therefore that whilst liability has been established in relation to the defendants' *second* order, importation and sale of television sets, the claim fails in relation to the first.

The floral pattern on the rice cookers

356 The plaintiffs assert copyright in the floral pattern on the side of the 1st Plaintiff's rice cooker (Model RC-18L). [note: 115] The 2nd Plaintiff's evidence was that when he visited the manufacturer in China, this particular rice cooker model was selected out of the numerous models and patterns which were available.

357 I can deal briefly with this claim to copyright. In my view, it must fail for the following reasons:

(a) First, it is clear that the floral pattern was designed by the Chinese manufacturer and was one of many (thousands) that were available for selection. [note: 116] There is no claim that the design came from the plaintiffs. The fact that the 2nd Plaintiff took the time and effort to select the model and floral pattern does not make him an author or designer of the pattern. As such, the plaintiffs do not own the copyright by virtue of authorship.

(b) Second, the plaintiffs have not been granted an exclusive license to the floral pattern, nor have they been assigned the copyright in the floral pattern. The plaintiffs claim that certain unnamed employees at the manufacturer's factory assured the 2nd Plaintiff that the selected pattern would not be offered to other customers from Singapore. First, there is no corroborative evidence that such a promise was made. Second, even if I assume the promise was made, the evidence, even at its highest, does not come close to establishing an assignment of the copyright, or the grant of an exclusive licence in the copyright, to the plaintiffs. A contractual (or non-contractual) promise not to supply the floral design to other Singaporean customers does not amount to an assignment of the copyright, or the grant of an exclusive licence in the copyright.

The start-up screen linked to the DVD players

358 The start-up screen refers to an image that appears on the television screen when the DVD player is switched on. The image features a snow-capped mountain against a background of a blue sky with the word "SINGSUNG" in the centre and a shining star behind the letter "I".

359 Copyright in the start-up screen is claimed as a copyright to the artistic work. There is no claim to cinematograph film copyright. The plaintiffs' complaint is that the defendants' DVD players generated a similar start-up screen. The key difference in the defendants' start-up screen is that the name "SINGSUNG" is replaced with the 1st Defendant's brand. The 2nd Plaintiff's evidence on the development of the start-up screen was brief. In summary, he conceived the idea for the start-up screen and conveyed the idea to the designer at the Chinese factory, but it was the factory designer who reduced the idea into a visual form. [note: 117]

360 On the basis of this evidence, and based on the legal principles discussed earlier on authorship and ideas, I am unable to conclude that the 2nd Plaintiff has a valid claim to be the author or joint author of the start-up screen image. As such, he does not own any copyright in the start-up screen. Moreover, there is no evidence of any assignment or grant of exclusive licence of the copyright in the start-up screen to the plaintiffs.

361 As such, the plaintiffs' copyright infringement claim in respect of the start-up screen fails.

Conclusion on copyright infringement

362 For the reason set out above, all the plaintiffs' claims for copyright infringement fail, save for the claim in respect of the sticker on the second order of television sets placed by the 1st Defendant.

Defamation

363 The claim for defamation specifically relates to an assertion that the 2nd Defendant defamed the 2nd Plaintiff. [note: 118] For clarity, I note that neither the 1st Defendant nor the 1st Plaintiff is directly involved in this claim. The alleged defamation arises out of certain words spoken by the 2nd Defendant to GEN, a customer of the plaintiffs from Cameroon. The said defamatory words were allegedly uttered on *three occasions* at the 1st Defendant's shop premises, and occurred within a span of two weeks.

(a) On the first occasion, the 2nd Defendant apparently told GEN that the 2nd Plaintiff and one "Mei Lan" had worked together to "Ali Baba" him and to take his money. The 2nd Defendant further allegedly said that the 1st Plaintiff had sold defective televisions to a customer from Cameroon named TSH and that as a result, TSH switched to purchasing products from the defendants.

(b) On the second occasion, the 2nd Defendant allegedly told GEN that the DVD players exported by the 1st Plaintiff to Nigeria, Tanzania and Cambodia, all had problems.

(c) On the third occasion, the 2nd Defendant allegedly repeated the claim that the 2nd Plaintiff had cheated him previously, and stated that the 2nd Plaintiff was "a big Ali Baba man", "a very crazy man", and was "very dangerous."

364 The general principles governing the law of defamation are well-settled. To successfully claim for defamation, a plaintiff must show that there is: (a) a statement bearing a defamatory meaning; (b) publication to a third party; and (c) reference to the plaintiff. Having shown this, the burden will then be on the defendant to prove that it has a defence.

365 In the present case, defences aside, the main issues that arise in relation to the 2nd Plaintiff's claim for defamation are as follows:

(a) whether the alleged statements were in fact spoken at all; and

(b) if they were so spoken, whether the words bear the alleged defamatory meaning.

I note that if the words were spoken, there is no dispute (save in one area) that the words made reference to the 2nd Plaintiff.

Whether the 2nd Defendant made the alleged statements to GEN

366 The 2nd Defendant admits saying to GEN that the 2nd Plaintiff had "Ali Baba" him and cheated him previously. The 2nd Defendant also accepts that he made the remark that the 2nd Plaintiff was "a very crazy man". [note: 119] The 2nd Defendant however denies having told GEN that the 2nd Plaintiff:

(a) had worked with Mei Lan to take his money;

(b) had cheated him of his money;

(c) had caused SINGSUNG to sell defective DVD players to customers in Nigeria, Tanzania and Cambodia;

(d) had caused SINGSUNG to sell defective televisions despite knowing that the products had problems;

(e) was "very dangerous"; and

(f) was a "big Ali Baba man".

367 Having reviewed the evidence and submissions, I find that the 2nd Defendant did tell GEN that the 2nd Plaintiff had "Ali Baba" him and cheated him on the first occasion. I also find that the 2nd Defendant told GEN that the 2nd Plaintiff was "a very crazy man" on the second occasion. I make the above findings on the basis that the 2nd Defendant himself accepts that he said the above words to GEN on the respective occasions.

368 The 2nd Defendant accepts that he did mention something about the 1st Plaintiff's television sets (first occasion) and DVD players (second occasion) being defective. However, he claims that he was merely repeating what he had been told by some of the 1st Plaintiff's customers. Moreover, these complaints were directed at the 1st Plaintiff, and not at the 2nd Plaintiff. On this basis, it was argued that these words were not in their ordinary and natural meaning defamatory of the 2nd Plaintiff.

369 In my view, none of the points above precludes (at this stage) the statements about allegedly defective televisions sets and DVD players from being actionable in this case. The fact that the 2nd Defendant may have merely been repeating a statement that he had heard does not change the fact that the statements were made, and that they could be defamatory. While the 2nd Defendant might attempt to assert the defence of justification, this is not a matter for this stage of the inquiry.

370 Moreover, on the point that the words were not directed to the 2nd Plaintiff (but only to the 1st Plaintiff), a defamatory statement which at face value is directed at a company can also be found to be directed at or defamatory of the office holders or particular individuals within the company's management: *Gatley on Libel and Slander* (Alastair Mullis & Richard Parkes eds) (Sweet & Maxwell, 12th Ed, 2013) ("*Gatley*") at para 7.13. Much will depend on the circumstances, the context, and how an ordinary reader will interpret the statement. In my assessment of the evidence, given the context of the meetings, an ordinary person in the position of GEN would infer that the statements about the defective television sets and DVD players were directed at both the plaintiffs.

371 That said, I note that it is not clear what the *exact words* said in respect of the defective DVD players and television sets are. I accept that the 2nd Defendant did state (even if only by way of repeating what he had been told) that the 1st Plaintiff had sold defective television sets and DVD players. However, it is not clear whether the 2nd Defendant stated that the plaintiffs *knowingly* sold the defective products. The implications of this will be seen later in the judgment.

372 Finally, I find that the 2nd Defendant did say that the 2nd Plaintiff was "very dangerous" and a "big Ali Baba man" on the third occasion. While the 2nd Defendant denies making any of these statements, I accept GEN's evidence that the 2nd Defendant did indeed make the above statements to him. [note: 120]

373 Thus, in summary, I find that the 2nd Defendant did make the following statements about the

2nd Plaintiff to GEN:

(a) that the 2nd Plaintiff had "Ali Baba" him and cheated him (first occasion);

(b) that the 2nd Plaintiff was a "crazy man" (second occasion);

(c) that he was told that the plaintiffs had sold defective DVD players (second occasion) and television sets (first occasion)—though I qualify this factual finding by noting that the evidence does not allow me to make a determinative finding on what exactly was said by the 2nd Defendant in this regard; and

(d) that the 2nd Plaintiff was "very dangerous" and a "big Ali Baba man" (third occasion).

Whether the words uttered bear a defamatory meaning

374 Words are considered defamatory if they: (a) lower the plaintiff in the estimation of right-thinking members of society generally; (b) cause the plaintiff to be shunned or avoided; or (c) expose the plaintiff to hatred, contempt or ridicule: Gary Chan Kok Yew & Lee Pey Woan, *The Law of Torts in Singapore* (Academy Publishing, 2011) ("*The Law of Torts in Singapore*") at para 12.014.

375 The question whether certain words are defamatory is ordinarily resolved on the basis of the natural and ordinary meanings of the words or phrases. In *Chan Cheng Wah Bernard and others v Koh Sin Chong Freddie and another appeal* [2012] 1 SLR 506 ("*Chan Cheng Wah*") at [18], the Court of Appeal set out the principles applicable to the construction of words based on their natural and ordinary meanings:

(a) the natural and ordinary meaning of a word is that which is conveyed to an ordinary reasonable person;

(b) as the test is objective, the meaning which the defendant intended to convey is irrelevant;

(c) the ordinary reasonable reader is not avid for scandal but can read between the lines and draw inferences;

(d) where there are a number of possible interpretations, some of which may be non-defamatory, such a reader will not seize on only the defamatory one;

(e) the ordinary reasonable reader is treated as having read the publication as a whole in determining its meaning, thus "the bane and the antidote must be taken together"; and

(f) the ordinary reasonable reader will take note of the circumstances and manner of the publication.

376 *Gatley* at para 2.28 helpfully lists out instances of words held to be defamatory. These include words such as "rogue and rascal", "crook", "dishonest", and even "hypocrite". Much of course depends on the circumstances and context in which the words are uttered. It may not always be defamatory to call a person a "rascal".

377 In the present case, I am satisfied that the ordinary and natural meanings of the words uttered by the 2nd Defendant listed at [373(a)], [373(b)] and [373(d)] of this judgment are defamatory. As the plaintiffs submit and the 2nd Defendant acknowledged in cross-examination, "Ali Baba" is a well-

known fictional character famous for being a thief and a cheat. [note: 121] The expression "Ali Baba", together with the statement that the 2nd Defendant had been cheated, suggests that the 2nd Defendant had been the victim of some serious wrongdoing on the part of the 2nd Plaintiff. This is especially so as those statements were coupled with other statements that the 2nd Defendant had been cheated of money and that the 2nd Plaintiff was "very dangerous". Even if, as the defendants submit, this last statement is to be read in the context of the alleged quarrels which the 2nd Plaintiff is said to have had with some customers, [note: 122] I am of the view that an ordinary person at the third occasion/meeting (where such sentiments are repeated) would have understood the statement as meaning that the 2nd Plaintiff was dishonest. These aspersions on the 2nd Plaintiff's character would most certainly lower the 2nd Plaintiff in the "estimation or right-thinking members of society", and even cause him to be "shunned and avoided".

378 In the case of the statements concerning the sale of defective DVD players and television sets to overseas customers (*ie*, the statements described at [373(c)] of this judgment), the position is less clear. As a preliminary point, I note that the plaintiffs' closing submissions on defamation are centred almost entirely on the 2nd Defendant's allegations that the 2nd Plaintiff is a "cheat", a "crazy man", and an "Ali Baba man". Little was made of the statements to do with the 1st Plaintiff's alleged sale of defective products. In any case, the 2nd Defendant admits that he had informed GEN that a number of the 1st Plaintiff's customers had told him that some of the 1st Plaintiff's television sets and DVD players were defective or had problems. [note: 123] In their closing submissions, however, the plaintiffs submit that the 2nd Defendant had said that the 2nd Plaintiff had *caused* the 1st Plaintiff to sell defective DVD players and television sets. This seems to impute some sort of fault on the 2nd Plaintiff's part.

379 The distinction between the parties' version of the defamatory statements is important. To say that a customer alleges that a company has sold defective products in the past is not necessarily defamatory. Much depends on the context and circumstances. But to say that a company or person has deliberately or knowingly sold defective products is quite a different matter. Whilst the evidence as to what was said could have been clearer, on balance, I do not accept that the words spoken, in their ordinary and natural meaning, bear the meaning that the 2nd Plaintiff *caused* the 1st Plaintiff to sell defective products. There certainly is no basis in the evidence for me to find that the 2nd Defendant said or uttered words that the 2nd Plaintiff had knowingly, deliberately, dishonestly or unscrupulously caused the 1st Plaintiff to sell defective products. As such, I find that the words spoken by the 2nd Defendant in relation to what customers had allegedly said about the 1st Plaintiff's defective products are not defamatory. To be clear, I do find that the 2nd Defendant stated that the 1st Plaintiff had sold defective television sets and DVD players and/or that some players had problems. On balance, I am not satisfied, however, that the words were defamatory in the circumstances. Electrical goods may be defective or have problems for many reasons. In any case, I note that there is some evidence which supports the 2nd Defendant's claim that some of the television sets indeed had problems or were defective.

Defences

Justification

380 A defamatory statement is presumed to be false. The burden of proof falls upon the defendant to plead and show that the defamatory statement is true. The meaning that must be proven true is that which the relevant statement is held to bear. The defence will not succeed if a materially less serious meaning is proven to be true. In short, it is the imputation contained in the words which has to be justified, not the literal truth of the words: *Chan Cheng Wah* at [43].

381 That said, it is established law that the defendant need only prove the "sting" of the charge. In this way, the law provides some leeway for exaggeration and error. The Court of Appeal in *Chan Cheng Wah* at [44] accepted the following position laid down by Burrough J in *Edwards v Bell* (1824) 1 Bing 403 at 409:

> ... it is sufficient if the substance of the libellous statement be justified; it is unnecessary to repeat every word which might have been the subject of the original comment. As much must be justified as meets the sting of the charge, and if anything be contained in a charge which does not add to the sting of it, that need not be justified.

382 In the case of the statements concerning the sale of defective DVD players and television sets, I have decided (see above) that no defamatory meaning has been established. Justification is therefore not relevant. However, I note in passing that at least for the television sets, there is evidence that a consignment of televisions sold by the 1st Plaintiff to TSA (a trade buyer from Cameroon and a witness for the defendants) was defective. [note: 124] There is however no evidence that the DVD players sold to the 1st Plaintiff's customers were defective or had problems. Given the lack of certainty as to what exactly was said, I am of the view that the 2nd Defendant has justified the gravamen of the statement in any event.

383 In the case of the statements bearing the defamatory meaning that the 2nd Plaintiff is a cheat and was dishonest, the 2nd Defendant's defence of justification is based on facts that arose a long time back when the 2nd Plaintiff and the 2nd Defendant were partners at S H Econ. It will be recalled that disputes between the brothers arose over invoices and accounts of S H Econ. By around 2005, the relationship between the 2nd Plaintiff and the 2nd Defendant had deteriorated to such a degree that the 2nd Defendant brought a lawsuit in connection with the Shop Houses purchased by the 2nd Defendant and SLQ (another brother) and for an account of monies due to the partners from the S H Econ business. The lawsuit commenced by the 2nd Defendant against the 2nd Plaintiff and SLQ in 2007 was settled before trial. The S H Econ partnership was then subsequently terminated (although the date of termination is unclear). It will also be recalled that the 2nd Defendant claims that the business of selling new (as opposed to second-hand) products, or more specifically, "SINGSUNG" products, was started before the S H Econ partnership was terminated.

384 Under cross-examination, the 2nd Defendant accepted that in the settlement agreement, there was no mention of the 2nd Defendant having any rights in or connected with the business of the 1st Plaintiff. [note: 125] The 2nd Defendant's explanation of this in cross-examination was hard to follow. On balance, it appears that his main point was that he had no choice but to accept that he had no interest in the business of the 1st Plaintiff because the family was upset by the dispute and wanted the parties to move on. [note: 126]

385 As I have explained at [315] of this judgment, I accept that the 1st Plaintiff's business belongs entirely to the 2nd Plaintiff. It has never belonged (even in part) to the S H Econ partnership. As such, in my view, there is no basis in the evidence for calling the 2nd Plaintiff a cheat, or accusing him of dishonesty. The "negative experience" which the 2nd Defendant had from his time in the S H Econ partnership with the 2nd Plaintiff does not come close to justifying the defamatory sting of his words. The defence of justification therefore fails.

Qualified privilege

386 The learned authors of *The Law of Torts in Singapore* at para 13.061 state that qualified privilege may arise in one or more of the following cases:

(a) where the defendant has an interest or duty to communicate information and the recipient has the corresponding interest or duty to receive the information ("the Interest-Duty Limb");

(b) where the defendant makes a statement with a view to protecting his or her self-interests; or

(c) where the supposed defamatory statements are fair and accurate reports of parliamentary and judicial proceedings.

387 In *Chan Cheng Wah*, the Court of Appeal (at [86]) accepted the following explanation of the defence of qualified privilege as found in a previous edition of *Gatley on Libel & Slander* (Patrick Milmo & W V H Rogers eds) (Sweet & Maxwell, 11th Ed, 2008) at para 14.1:

> There are circumstances in which, on grounds of public policy and convenience, less compelling than those which give rise to absolute privilege, a person may yet, without incurring liability for defamation, make statements of fact about another which are defamatory and in fact untrue. These are cases of qualified privilege ... For a very long time these cases primarily concerned communications of a 'private' nature, commonly arising out of the necessities of some existing relationship between the maker of the statement and the recipient. Protection was granted if the statement was 'fairly warranted by the occasion' (that is to say, fell within the scope of the purpose for which the law grants the privilege) and so long as it was not shown by the person defamed that the statement was made with malice, i.e. with some indirect or improper motive, which was typically established by proof that the defendant knew the statement to be untrue, or was recklessly indifferent as to its truth ...

388 In the present case, the qualified privilege defence pleaded relates to the Interest-Duty Limb described at [386(a)] above. Qualified privilege under this limb arises when it can be shown that the defendant has an interest or duty, whether legal, social or moral, to communicate the information, and the recipient has the corresponding interest or duty to receive the information: *The Law of Torts in Singapore* at para 13.063.

389 Reciprocity of duty (between the communicator of the defamatory article and the recipient) is essential. In *Bashford v Information Australia (Newsletters) Pty Ltd* (2004) 204 ALR 193 ("*Bashford*"), the High Court of Australia stated at [63] that:

> ... the court must consider all the circumstances and ask whether *this* publisher had a duty to publish or an interest in publishing *this* defamatory communication to *this* recipient. It does not ask whether the communication is for the common convenience and welfare of society. It does not, for example, ask whether it is for the common convenience and welfare of society to report that an employee has a criminal conviction. Instead, it asks whether this publisher had a duty to inform this recipient that the latter's employee had been convicted of a particular offence and whether this recipient had an interest in receiving this information. That will depend on all the circumstances of the case. **Depending on those circumstances, for example, there may be no corresponding duty and interest where the conviction occurred many years ago or where it could not possibly affect the employment.**
>
> [emphasis added in bold]

390 The defence of qualified privilege is defeated by malice. Malice arises where it is shown that the defendant made the communication notwithstanding that he knows that the statement is false or is reckless as to the truth of the statement. Malice will also arise where the defendant has a genuine

or honest belief in the truth of the statement but makes the statement for improper motives or purposes falling outside the occasion of qualified privilege. In many cases this will involve showing that the defendant made the statement for the dominant purpose of injuring the plaintiff: *Lim Eng Hock Peter v Lin Jian Wei and another and another appeal* [2010] 4 SLR 331 at [38]. The burden of showing malice falls on the plaintiff.

391 In the present case, I am of the view that the defence of qualified privilege fails for the two reasons:

(a) First, I do not find that the 2nd Defendant has an interest or duty to communicate the information to GEN, who had no sufficient interest to receive this information.

(b) Second, I find that the 2nd Defendant made the statements with malice.

392 On the first point, whilst qualified privilege may arise under the Interest-Duty Limb even if the recipient did not request for the information, the court must examine the importance of the interest to be protected, the urgency of the communication, and the nature of the relationship between the "defamer" and the recipient. In particular, the court should consider whether it is a relationship founded on trust and reliance: *Gatley* at para 14.34.

393 In the present case, by no stretch of the imagination can it be said that the relationship between the 2nd Defendant and GEN is founded on trust or reliance. In my view, based on the evidence, the 2nd Defendant was keen to develop a business relationship with GEN. GEN is merely a potential customer making enquiries as to the defendants' products. There was no sufficient existing relationship of trust and reliance (or any other sort of relationship) between the 2nd Defendant and GEN to ground a finding of qualified privilege under the Interest-Duty Limb. The 2nd Defendant cannot be said to have had an interest or duty to communicate the defamatory information to GEN.

394 Moreover, I do not think that there is a sufficiently important interest to be protected, or any urgency in communicating the information, such as to privilege the defamatory communications. The statement that the 2nd Plaintiff (his competitor) was an "Ali Baba man" who had cheated him (or behaved dishonestly) related to old events which were long settled. The statements were uttered by the 2nd Defendant over the course of three meetings he had with GEN in late September/early October 2011. Viewed broadly, the discussions were in the context of possible business dealings between the 2nd Defendant and GEN. [note: 127] By this time, the events which led to the partnership breakup and the dispute over the S H Econ accounts were many years old. The law suit commenced by the 2nd Defendant (OS 1652/2007) was settled in 2008, with both parties agreeing to go their separate ways. In view of the above, I find that GEN did not have any important interest in knowing about the 2nd Plaintiff's alleged dishonest behaviour which took place so long ago (see *Bashford* at [63], quoted at [389] above). Moreover, given GEN had been dealing with the 2nd Plaintiff without issue for quite a while already, there is no plausible case that there was any urgency in communicating what the 2nd Defendant communicated to GEN.

395 Secondly, I find in any case that 2nd Defendant made the defamatory statements with malice. This defeats the possibility of raising the defence of qualified privilege.

396 Even if the 2nd Defendant genuinely believed that he was cheated by his brother and former business partner, there has been no finding on this and the evidence before me of cheating as opposed to a bitter dispute over accounts is thin. Moreover, the events occurred many years past and were settled. At most, the 2nd Defendant might have explained that he was a former partner of the 2nd Plaintiff and that the partnership had broken up over a business dispute over accounts. To go

on to assert that the 2nd Plaintiff is a cheat and an "Ali Baba Man" or a "big Ali Baba man", *etc*, strongly suggests an intention to injure the 2nd Plaintiff for reasons of personal spite. The fact that GEN continued to do business with the 2nd Plaintiff and did not change his own view of the 2nd Plaintiff is not a defence. [note: 128]

397 For the reasons above, I find that the defence of qualified privilege fails.

Conclusion on the claim for defamation

398 It follows that the claim for defamation succeeds in respect of the statements that the 2nd Defendant made, referred to at [373(a)], [373(b)] and [373(d)]. Whilst the 2nd Plaintiff submits that this is a case where aggravated damages are to be awarded, it is my judgment that this is not an appropriate case for the award of aggravated damages. Given the background of the dispute, the fact that the statements were oral, the very limited scope of the circulation, and the fact that GEN did not change his view of the 2nd Plaintiff and continued to do business with him, I am of the view that normal compensatory damages are sufficient recompense for the injury to reputation.

399 In any case, I note that the action has been bifurcated. Thus, I say no more other than that damages are to be assessed at a later date.

The counterclaim for malicious falsehood

400 According to the defendants, sometime in or around 2010, the 2nd Plaintiff obtained a DVD player distributed and sold by the 1st Defendant. [note: 129] The defendants claim that the 2nd Plaintiff dismantled the DVD player in the presence of customers of both parties, pointed to some internal parts and components, and remarked that they were of "poor quality." This is the factual basis upon which the defendants' counterclaim for malicious falsehood rests.

401 The tort of malicious or injurious falsehood, whilst related to defamation, is governed by its own set of principles. Some of these principles are similar to those that govern the tort of defamation, but there are key differences.

402 The principles governing the tort of malicious falsehood are found in the common law as well as s 6(1) of the Defamation Act (Cap 75, 2014 Rev Ed) ("the DA").

403 Under common law, to succeed in a claim for malicious falsehood, the plaintiff must prove that:

(a) the defendant published to third parties words which are false;

(b) the words refer to the plaintiff or his property or his business;

(c) the words were published maliciously; and

(d) special damage has followed as a direct and natural result of their publication.

See *WBG Network (Singapore) Pte Ltd v Meridian Life International Pte Ltd and others* [2008] 4 SLR(R) 727 at [68], approved by the Court of Appeal in *Low Tuck Kwong v Sukamto Sia* [2014] 1 SLR 639 at [102].

404 Section 6(1) of the DA sets out the circumstances in which it is *not necessary to plead and prove special damages* in an action for malicious falsehood:

Slander of title, etc.

6.—(1) In any action for slander of title, slander of goods or other malicious falsehood, it shall not be necessary to allege or prove special damage —

(*a*) if the words upon which the action is founded are calculated to cause pecuniary damage to the plaintiff and are published in writing or other permanent form; or

(b) if the said words are calculated to cause pecuniary damage to the plaintiff in respect of any office, profession, calling, trade or business held or carried on by him at the time of the publication.

405 Whilst the disparaging statement does not have to identify the plaintiff personally, there must be a sufficient (even if indirect) reference to him or his interests. Moreover, the authorities clearly establish that under the tort of malicious falsehood, the *claimant* bears the burden of establishing the falsity of the statement: *DHKW Marketing and another v Nature's Farm Pte Ltd* [1998] 3 SLR(R) 774 at [28]; *Challenger Technologies Pte Ltd v Dennison Transoceanic Corp* [1997] 2 SLR(R) 618 at [68]. Indeed, this is a key difference between the tort of malicious falsehood and defamation.

406 In support of their submission that it is the 2nd Plaintiff who must prove the truth of his statement, the defendants rely on the earlier case *Sin Heak Hin Pte Ltd and another v Yuasa Battery Singapore Co Pte Ltd* [1995] 3 SLR(R) 123 ("*Yuasa*"). In *Yuasa*, the plaintiff's action for malicious falsehood succeeded in respect of the defendant's statements that the plaintiff's "Yuasa" branded batteries were "illegal imitations" and that the defendant would not be responsible for the quality of the imitation batteries. After stating its finding that the plaintiff's batteries were authentic "Yuasa" batteries, the court held (at [73]) that:

> ... In relation to quality, there is the additional point that the defendant had not put the batteries which it said were the plaintiffs' batteries through any form of test to ascertain their quality. Therefore the aspersion on the quality of these batteries which appeared in the circular had no basis in fact.

407 This is the crucial passage upon which the defendants rely. With respect to learned counsel's submissions, in my view, the court in *Yuasa* was not holding that the burden of proof was on the defendant to establish the truth of its statements. The finding in respect to the quality disparagement in that case must be seen in the context of the main allegation that the plaintiff's batteries were imitation Yuasa batteries. The court found on the facts that the batteries were indeed genuine, and not imitations. The plaintiff had already discharged its burden of proving *prima facie* that the statements were false; the ball was hence in the defendant's court to prove otherwise. In these circumstances, it is likely that the court was merely holding that the *evidential* burden shifted onto the defendant to justify its quality allegations. Indeed, my interpretation is strengthened by the fact that the above statements made by the learned judge at [73] was preceded by her clear holding at [70] that the burden was on the plaintiff to prove that the defendant's statement was false.

408 In addition, I note that malice is an element of liability under the tort of malicious falsehood, rather than a matter that defeats certain defences such as qualified privilege and fair comment in the tort of defamation.

409 Coming to the defendants' counterclaim for malicious falsehood, the critical issues that have to be decided in the present case are:

(a) whether and what statements were uttered;

(b) whether the statements are false;

(c) whether the statements were uttered maliciously; and

(d) whether special damage arose as a result.

410 I first consider the evidence on the statements uttered by the 2nd Plaintiff about the 1st Defendant's products. In his affidavit of evidence-in-chief ("AEIC"), the 2nd Plaintiff admitted that he had dismantled samples of the 1st Defendant's products. This was said to have been done out of curiosity. Subsequently, under cross-examination, the 2nd Plaintiff denied dismantling the DVD player in the presence of customers and making the comment that certain components were of inferior quality.

411 The chief witness for the 1st Defendant on this issue was its customer from Cameroon, TSA. In his AEIC, TSA stated that he had personally witnessed the 2nd Plaintiff dismantling the 1st Defendant's DVD player. Under cross-examination, the witness explained that the 2nd Plaintiff dismantled the DVD player at the 1st Plaintiff's office. In my view, the evidence as to what exactly happened is confusing. It is not clear who was present when the 2nd Plaintiff allegedly disparaged the 1st Defendant's goods, nor is it clear the number of occasions on which this took place.

412 What is clear is that in 2010, TSA visited Singapore with the intention of looking for business in connection with television sets. [note: 130] The 2nd Plaintiff met the witness at the airport, and brought to the 1st Plaintiff's office, where he stayed for about two weeks. [note: 131] It was during this visit that the witness saw dismantled DVD players on the 2nd Plaintiff's desk, and heard the 2nd Plaintiff comment on the poor quality of some of the internal components. When asked if he could recall what the components were and the words actually used by the 2nd Plaintiff, the witness, whose oral evidence was given in French, stated that he could try to recall the words spoken by the 2nd Plaintiff in English. The witness then explained in (broken) English: [note: 132]

> ... It---the two DVD supposed on top of the table of [the 2nd Plaintiff]. When I arrived in the morning, he say, er, er, [TSA], see, my brother the follow me---my brother follow my product. You see, this one is LS1, the lousy one. This one is, er, Singsung … He make, er, er, er, cheap---cheaper---and---and I don't know how to explain in English. He make a, er, halo---halo one. The one with no good. It one buy DVD in some market, you must check very well. You can't see the cable. It's different until open. Load the memory card, you see, Its not the same, This one is---Singsung is strong one. This one is, er, er, er, not strong one. You see the eyes, it's different. But he don't speak English very well ...

413 It is apparent that neither the 2nd Plaintiff nor TSA spoke English well, and that there was significant room for miscommunication. Nevertheless, I am satisfied that the evidence on the whole supports the view that the 2nd Plaintiff had indeed dismantled a DVD player and made comments on the "lousy quality" of some of the component parts. Other comments made were to the effect that some of the components were cheaper and that the 1st Plaintiff's product was stronger. On balance, I accept that the 2nd Plaintiff did utter the words complained of to TSA. Whether other customers were present is much less clear and I make no finding in this respect.

414 I note that in his AEIC, [note: 133] the 2nd Plaintiff attempted to justify his comments about the 1st Defendant's products. In particular, he explained that when he dismantled the 1st Defendant's

DVD player he found that the remote control sensors were not as sensitive as those used in the 1st Plaintiff's DVD player, and the audio and video cables were thinner, less durable and likely to result in more image loss. He also asserted that because the 1st Defendant used lower quality raw materials, its production costs were lower. Whilst the 2nd Plaintiff's analysis of the 1st Defendant's DVD player was quite clearly set out in some detail in his AEIC, it does not appear that the specific words of analysis offered to the court in the AEIC are the words that were uttered to TSA. I accept that what is important is the truth of the *substance* of what was said to TSA; the fact that the 2nd Plaintiff did not use exactly the same words and phrases may not matter. Nevertheless, the evidence as to what the 2nd Plaintiff said to TSA (as described above) leads me to the conclusion that the substance of what was actually said to and understood by TSA was that the 1st Defendant's DVD component parts (or some parts) were cheaper, "lousy" and not as strong.

415 In any case, as I previously stated, the law clearly establishes that the burden lies on the defendants in this case (the claimants in the counterclaim) to prove that the 2nd Plaintiff's statements are false. Therein lies the difficulty that the defendants face. I note that there is no evidence before the court on whether the 2nd Plaintiff's statements are false. Indeed, the question arises as to how the truth or falsity of statements such as "this is the lousy one" (in comparison to another product) is to be determined in an objective manner. Moreover, the question also arises as to whether the recipient of the information (TSA in this case) took the 2nd Plaintiff seriously given the context his statement was made in (that is, as a competitor trying to sell his products and win customers).

416 These difficulties bring out an important point. The tort of malicious falsehood is not intended to, and cannot, serve as a vehicle for testing the relative merits of competing products in the market place. It is for this reason that the law is cautious where a complaint arises in the context of comparative advertising. A distinction must be drawn between mere puff and statements that are intended to be taken seriously and whose truth and falsity can be objectively assessed. A statement that Brand X (infant food) is more nutritious and healthier than Brand Y begs the question: in what sense and will this statement be taken seriously? In *Timothy White v Gustav Mellin* [1895] AC 154, Lord Herschell LC found (at 160) that the advertisement in question was puffing, perhaps extreme puffing. Even so, the action failed. Malicious falsehood cannot be founded on an allegation that one product or service is superior to or better than another. If the law were otherwise, the court's decision would effectively become a judicial endorsement of a particular brand or product in the market place.

417 The position is different where the statement is specific and objectively provable to be either true or false. In such a case, a reasonable man may well be of the view that the statement is meant to be taken seriously. For example, in *De Beers Abrasive Products Ltd and others v International General Electric Co of New York Ltd and another* [1975] 1 WLR 972, the defendant circulated a pamphlet comparing in great detail the respective performance of the plaintiff's and the defendant's diamond-abrasive product. The pamphlet claimed to set out "laboratory developments" and the "application laboratory's comparative studies" of the two products. It concludes that the plaintiff's product was inferior based on certain "tests". In these circumstances, the court found that a case for malicious falsehood might be made out because of the way the pamphlet was dressed up. The court's reasoning at 981H–982B is worth setting out:

> ... It appears to me that, where the interested parties are presented with what purports to be a proper scientific test, properly carried out by the 'application laboratory'—whatever that is—they must be intended by the persons who furnished them with this information to take it all very seriously indeed. Such a report framed as the present report is framed cannot be dismissed in any way as a mere idle puff. It may well be of course that that is all in fact it is; but, if so, then the

> defendants have only themselves to blame for having dressed up a stupid old moke as a thoroughbred Arabian stallion.
>
> If traders take the time and trouble to dress up their advertising material in this manner, then I think they must stand by it; and, if it contains, as in the case here, statements in disparagement of the plaintiffs' goods and if, further, on investigation those statements prove to be false and the plaintiff can show malice, the precise constituents of which for present purposes I think it is better not to investigate, it appears to me that they must answer for it.

418 In summary, it can be seen that whether or not a reasonable person will treat the statement seriously depends on the *nature of the statement* (especially whether it appears to be reasonably provable as true or false) and the *circumstances in which it is made*. To be clear, the question as to whether a statement is objectively provable as true or false is distinct from the question whether a reasonable person will take the statement seriously. Even so, the fact that there did not appear to be reasonable grounds for an objective determination must at the least be an important factor in deciding how the reasonable person is likely to regard the statement. In the present case, statements were made by the 2nd Plaintiff during the course of what is perhaps best described as a general, broad-brush, "one-to-one comparison." The statements when uttered were not supported by any material setting out an independent analysis of the price, strength or quality of the components.

419 In these circumstances, I have great difficulty in coming to the conclusion that a reasonable person would take the 2nd Plaintiff's statements seriously. Leaving aside the uncertainty over what was actually said, I am of the view that the reasonable person would regard the statements recounted by TSA as mere puffing.

420 In any event, even if a different view is formed, the action still fails because there is no evidence supporting the allegation that the claims were false. Indeed, even at trial, there was no independent evidence or analysis of the quality of the 1st Defendant's DVD players. The word "lousy" is defined in *The New Oxford Dictionary of English* as including the meaning "very poor or bad". That said, the word "lousy" is generally used informally. In what sense were the components "lousy"? What does it mean to say that the component in Brand A is stronger than the component in Brand B? Whilst the statement that the 1st Defendant's component parts are cheaper than the 1st Plaintiff's is capable of being objectively proven true or false, no such evidence was before the court. Thus, even if the 2nd Plaintiff did cast a specific disparagement on the remote control sensors, there is no evidence before me on the truth or falsity of the disparagement.

421 For these reasons, I find that the counterclaim for malicious falsehood fails. In these circumstances, it is unnecessary to determine whether the words were uttered maliciously.

The counterclaim for groundless threats of copyright infringement proceedings

422 The defendants' counterclaim under s 200 of the CA for the making of a groundless threat to sue for copyright infringement is based on a letter sent by the plaintiffs' solicitors on or about 11 April 2011 to the defendants. In the said letter, the plaintiffs' solicitors demanded that the defendants cease and desist from their alleged infringement of the 1st Plaintiff's copyright in the White Get-Up Picture, the Blue Get-Up Picture, the television sticker, the "Rotary Rotatory" logo, and the floral pattern on the rice cooker.

423 Section 200 of the CA provides:

> **Groundless threats of legal proceedings**

200.—(1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding in respect of an infringement of copyright, then, whether the person making the threats is or is not the owner of the copyright or an exclusive licensee, a person aggrieved may bring an action against the first-mentioned person and may —

(*a*) obtain a declaration to the effect that the threats are unjustifiable;

(*b*) obtain an injunction against the continuance of the threats; and

(*c*) recover such damages, if any, as he has sustained,

unless the first-mentioned person satisfies the court that the acts in respect of which the action or proceeding was threatened constituted, or, if done, would constitute, an infringement of copyright.

(2) The mere notification of the existence of a copyright does not constitute a threat of an action or proceeding within the meaning of this section.

(3) Nothing in this section shall render an advocate and solicitor liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4) The defendant in an action under this section may apply, by way of counterclaim, for relief to which he would be entitled in a separate action in respect of an infringement by the plaintiff of the copyright to which the threats relate and, in any such case, the provisions of this Act with respect to an action for infringement of a copyright are, with the necessary modifications, applicable in relation to the action.

424 From the above, it seems that once a claim for copyright infringement fails, the "successful" defendant will have a *prima facie* claim under s 200 of the CA for groundless threats of copyright infringement proceedings, assuming such threats were previously made. Earlier, I held that the plaintiffs' claims for copyright infringement failed, save that the defendants' use of stickers similar to the 1st Plaintiff's stickers on the second order of television sets imported into Singapore constitutes one instance of copyright infringement. I therefore find that the counterclaim under s 200 of the CA succeeds save for the counterclaim in respect of the sticker and the second order of television sets. The defendants are entitled to the relief prayed for in the counterclaim (save in respect of the stickers on the second order of television sets).

425 I note that the plaintiffs have not sought to argue that the counterclaim under s 200 of the CA is defeated because the threat was made in good faith with an honest belief that the act complained of amounted to an infringement of copyright. Australian case law in this context is generally against a defence based on good faith and an honest belief: see *SW Hart & Co Pty Ltd v Edwards Hot Water Systems* (1980) 30 ALR 657 and *Avel Pty Ltd v Multicoin Amusements Pty Ltd* (1990) 97 ALR 19. Whilst it is not necessary for me to decide this point because it was not pleaded, I note that the language of s 200 of the CA supports the view that the *only defence* available to a defendant who threatens copyright infringement proceedings is proof that the other party *actually* infringed his copyright (or would infringe if the act was done).

Overall Conclusion

426 For the reasons discussed above, my overall conclusion is as follows:

(a) The plaintiffs' claim for passing off fails in its entirety.

(b) The plaintiffs' claims for copyright infringement fails, save for the claim in respect of the stickers on the second order of television sets from the Chinese manufacturer. Damages or an account of profits (at the plaintiffs' election) are to be assessed for the copyright infringement.

(c) The 2nd Plaintiff's claim for defamation succeeds. Damages are also to be assessed in respect of the defamation.

(d) The 1st Defendant's counterclaim for malicious falsehood fails.

(e) The defendants' counterclaim for groundless threats of copyright proceedings succeeds, save in the case of the stickers on the second order of television sets.

427 In addition, the court grants the defendants the following reliefs:

(a) A declaration that the threat of legal proceedings against the defendants for copyright infringement by the 1st Plaintiff are unjustifiable, save in the case of the claim made in respect of the stickers on the second order of television sets.

(b) An injunction to restrain the plaintiffs from continuing or further making such threats, save in the case of the claim made in respect of the television stickers on the second order of television sets.

(c) Damages to be assessed.

428 Unless costs are agreed, I shall hear the parties on costs.

429 The history behind the dispute goes back many years and has resulted in several rounds of litigation. The present hearing lasted 16 days and covered a broad range of issues in intellectual and industrial property and defamation. Some of the issues on passing off are relatively new in Singapore. The heart of the dispute concerned the African market (especially Cameroon market) for household electrical products. On all accounts that market has proven lucrative. The evidence is clear that well-known South Korean and Japanese brands compete in that market. The parties have chosen to enter the African market (and elsewhere) with products made in China and supplied to wholesale buyers from Africa under the brand names they have chosen, SINGSUNG and LS. The parties' products are sold with statements that the goods were made in Singapore, and in some cases, with Singapore quality marks. Whilst some features may cause a raised eyebrow, no issue was raised before me in respect of the parties' business models. I therefore make no further comment.

430 Given the somewhat peculiar nature of the dispute and the substantial issues of fact and law that have arisen, as well as the detailed arguments presented by counsel, the court expresses its gratitude to counsel for the courtesy and respect shown during the course of the hearing and the submissions.

Appendix: Glossary of Terms

Abbreviation	Reference
S H Econ	S H Econ Electrical Trading, original partnership between the 2nd Plaintiff and the 2nd Defendant which has since been dissolved

2nd Plaintiff	See Lam Huat
2nd Defendant	See Lam Seng
SLQ	See Lam Quee, brother of the 2nd Plaintiff and 2nd Defendant
1st Plaintiff	Singsung Pte Ltd
1st Defendant	LG26 Electronics Pte Ltd (trading as L S Electrical Trading)
ODM	Original design manufacturers
OEM	Original equipment manufacturers
HBY	Huang Bao Yu, marketing representative from the Chinese manufacturer that supplied blenders to the plaintiffs
SEC	Serena Chew Wanlin, employee of the 1st Plaintiff
GEN	Guy Emmanuel Ntoudam, trade buyer from the Republic of Cameroon
CYX	Cheng Yongxiu, employee of the 1st Plaintiff
DL	Dong Li, employee of the 1st Defendant
SNH	See Nam Hai, brother of the 2nd Plaintiff and 2nd Defendant
TSA	Talla Simplice Adolphe, trade buyer from the Republic of Cameroon
PTH	Phang Ti Hui, Singapore businessman who visited the ODMs in China with the 2nd Defendant
DVD A	The 1st Plaintiff's DVD Player Model A
DVD B	The 1st Plaintiff's DVD Player Model B
SINGSUNG Get-Up	The get-up and packaging of the 1st Plaintiff's products that the plaintiffs claim generate goodwill

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[note: 1] 2nd Defendant's AEIC at [7], [10]; 2nd Plaintiff's AEIC at [25].

[note: 2] 2nd Defendant's AEIC at [10]; 2nd Plaintiff's AEIC at [38].

[note: 3] 2nd Defendant's AEIC at [10].

[note: 4] 2nd Plaintiff's AEIC at [25].

[note: 5] 2nd Defendant's AEIC at [11].

[note: 6] 2nd Plaintiff's AEIC at [39].

[note: 7] 2nd Plaintiff's AEIC at [40].

[note: 8] 2nd Plaintiff's AEIC at [37].

[note: 9] 2nd Defendant's AEIC at [13]–[15]; 2nd Plaintiff's AEIC at [27]–[29]; NE Day 1 page 39 lines 18–24.

[note: 10] 2nd Defendant's AEIC at [16]; 2nd Plaintiff's AEIC at [61].

[note: 11] 2nd Plaintiff's AEIC at [65].

[note: 12] 2nd Defendant's AEIC at [10]; 2nd Plaintiff's AEIC at [62]; Plaintiffs' Closing Submissions at [12].

[note: 13] 2nd Plaintiff's AEIC at [4].

[note: 14] Statement of Claim (Amendment No 3) at [13].

[note: 15] 2nd Plaintiff's AEIC at [5].

[note: 16] 2nd Plaintiff's AEIC at [5].

[note: 17] 2nd Plaintiff's AEIC at [58], [73].

[note: 18] 2nd Plaintiff's AEIC at [73].

[note: 19] 2nd Plaintiff's AEIC at [103]–[118].

[note: 20] 2nd Plaintiff's AEIC at [119]–[125].

[note: 21] 2nd Plaintiff's AEIC at [102].

[note: 22] 2nd Plaintiff's AEIC at [94]–[96].

[note: 23] Plaintiffs' Closing Submissions at [104].

[note: 24] 2nd Defendant's AEIC at [22], [29].

[note: 25] Plaintiffs' Closing Submissions at [105(c)].

[note: 26] 2nd Plaintiff's AEIC at [58], [70]; 2nd Defendant's AEIC at [8].

[note: 27] Defendants' Closing Submissions at [49].

[note: 28] Plaintiffs' Closing Submissions at [130]–[135].

[note: 29] 2nd Plaintiff's AEIC at [82], [98].

[note: 30] 2nd Defendant's AEIC at [96]–[99].

[note: 31] NE Day 1 page 13 lines 19–26.

[note: 32] GEN's AEIC at [11]–[16]; NE Day 5 page 13 lines 2–24.

[note: 33] NE Day 14 page 54 lines 23–28.

[note: 34] NE Day 15 page 10 lines 5–32.

[note: 35] Statement of Claim (Amendment No 3) at [14A].

[note: 36] Statement of Claim (Amendment No 3) at [23E].

[note: 37] NE Day 11 page 42 lines 25–32.

[note: 38] Statement of Claim (Amendment No 3) at [16]–[22].

[note: 39] Statement of Claim (Amendment No 3) at [13].

[note: 40] Statement of Claim (Amendment No 3) at [14].

[note: 41] Statement of Claim (Amendment No 3) at [27]–[27A].

[note: 42] Plaintiffs' Closing Submissions at [39].

[note: 43] Plaintiffs' Closing Submissions at [109].

[note: 44] Plaintiffs' Closing Submissions at [130].

[note: 45] Plaintiffs' Closing Submissions at [140].

[note: 46] GEN's AEIC at [11]–[17].

[note: 47] NE Day 5 page 21 line 23–page 23 line 9.

[note: 48] NE Day 14 page 51 line 26–page 52 line 1, page 53 line 12.

[note: 49] NE Day 14 page 54 lines 23–24.

[note: 50] 2nd Plaintiff's AEIC at [106]–[108].

[note: 51] 2nd Plaintiff's AEIC at [106].

[note: 52] Statement of Claim (Amendment No 3) at [8], Annex B.

[note: 53] Defendants' Closing Submissions at [78(b)]; NE Day 3 page 38 lines 16–21; NE Day 4 page 16 lines 6–12, page 18 lines 4–21, page 21 lines 13–14.

[note: 54] 2nd Plaintiff's AEIC at [116].

[note: 55] 2nd Plaintiff's AEIC at [116].

[note: 56] NE Day 3 page 33 lines 16–20.

[note: 57] NE Day 3 page 34 lines 3–7.

[note: 58] NE Day 6 page 32 lines 10–15, page 33 line 23–page 34 line 32.

[note: 59] NE Day 3 page 42 lines 22–26.

[note: 60] 2nd Plaintiff's AEIC at [85]–[91].

[note: 61] 2nd Plaintiff's AEIC at Exhibits SLH-12 to SLH-15.

[note: 62] 2nd Plaintiff's AEIC at [109]; CYX's AEIC at [17]; NE Day 2 page 57 line 26–page 58 line 5.

[note: 63] 2nd Plaintiff's AEIC at [107]–[108]; CYX's AEIC at [14]–[16].

[note: 64] Statement of Claim (Amendment No 3) at [6]–[8]; 2nd Plaintiff's AEIC at [101]–[102].

[note: 65] NE Day 3 page 5 lines 22–32.

[note: 66] NE Day 3 Page 8 line 7–page 9 line 21.

[note: 67] NE Day 3 page 17 lines 17–20.

[note: 68] NE Day 9 page 53 line 9–page 54 line 27.

[note: 69] NE Day 9 page 57 lines 3–16.

[note: 70] NE Day 9 Page 54 line 31–page 55 line 6.

[note: 71] NE Day 13 page 9 line 26–page 50 line 18.

[note: 72] Plaintiffs' Closing Submissions at [35]; CYX's AEIC at [25].

[note: 73] 2nd Plaintiff's AEIC at [122].

[note: 74] 2nd Plaintiff's AEIC at [127].

[note: 75] NE Day 7 page 34 lines 27–29.

[note: 76] NE Day 7 page 44 lines 6–8.

[note: 77] NE Day 7 page 44 lines 9–18.

[note: 78] NE Day 7 page 40 lines 1–10.

[note: 79] 2nd Plaintiff's AEIC at [136].

[note: 80] NE Day 7 page 74 line 30–page 75 line 11.

[note: 81] Plaintiffs' Closing submissions at [46]–[56].

[note: 82] Plaintiffs' Closing submissions at [74]–[88].

[note: 83] NE Day 2 page 45 lines 1–11.

[note: 84] NE Day 2 page 46 lines 3–12, page 48 line 25–page 50 line 11.

[note: 85] CYX's AEIC at [15]–[21].

[note: 86] CYX's AEIC at page 310.

[note: 87] NE Day 2 page 50 lines 24–31.

[note: 88] Statement of Claim (Amendment No 3) at Annex A.

[note: 89] NE Day 9 page 27 line 20–page 28 line 11.

[note: 90] NE Day 1 page 41 line 30–page 43 line 23.

[note: 91] Statement of Claim (Amendment No 3) at Annex B.

[note: 92] Plaintiffs' Closing Submissions at [160]; Statement of Claim (Amendment No 3) at [17], [30].

[note: 93] NE Day 3 page 34 lines 13–20.

[note: 94] 2nd Plaintiff's AEIC at [117].

[note: 95] Defendants' Closing Submissions at [363]–[365].

[note: 96] Plaintiffs' Closing Submissions at [162].

[note: 97] Statement of Claim (Amendment No 3) at [18]–[19].

[note: 98] NE Day 4 page 58 lines 17–32.

[note: 99] NE Day 4 page 59 lines 7–9.

[note: 100] NE Day 4 page 64 lines 13–29.

[note: 101] NE Day 4 page 56 lines 24–25.

[note: 102] NE Day 4 page 36 lines 20–28.

[note: 103] NE Day 10 page 34 lines 17–20; NE Day 13 page 10 lines 20–29.

[note: 104] NE Day 10 page 36 lines 23–26.

[note: 105] NE Day 10 page 40 lines 6–10.

[note: 106] NE Day 10 page 41 line 32–page 42 line 3.

[note: 107] NE Day 10 page 43 lines 26–31.

[note: 108] NE Day 10 page 48 line 30–page 51 line 31.

[note: 109] NE Day 10 page 48 lines 10–16.

[note: 110] 2nd Plaintiff's AEIC at [162]

[note: 111] NE Day 13 page 14 line 31–page 15 line 2.

[note: 112] NE Day 10 page 52 lines 12–30.

[note: 113] NE Day 10 page 55 line 19–page 56 line 11.

[note: 114] NE Day 13 page 15 lines 6–31.

[note: 115] Statement of Claim (Amendment No 3) at [12].

[note: 116] 2nd Plaintiff's AEIC at [127]; NE Day 7 page 32 lines 24–31.

[note: 117] NE Day 2 page 57 line 26–page 58 line 5.

[note: 118] Statement of Claim (Amendment No 3) at [41].

[note: 119] Defence and Counterclaim (Amendment No 4) at [23(f)], [23(h)], [23(j)].

[note: 120] GEN's AEIC at GEN-2, which contains GEN's Statutory Declaration made on 31 October 2011.

[note: 121] Plaintiffs' Closing Submissions at [176], [212].

[note: 122] Defendants' Closing Submissions at [403]

[note: 123] Defence and Counterclaim (Amendment No 4) at [23(f)], [23(h)].

[note: 124] NE Day 14 page 62 line 27–page 63 line 5.

[note: 125] NE Day 9 page 19 lines 6–10.

[note: 126] NE Day 9 page 17 line 29–page 18 line 7.

[note: 127] GEN's AEIC at GEN-2, which contains GEN's Statutory Declaration made on 31 October 2011.

[note: 128] NE Day 6 page 31 line 21–page 32 line 9.

[note: 129] Defence and Counterclaim (Amendment No 4) at [44].

[note: 130] NE Day 15 page 3 line 14–21.

[note: 131] NE Day 15 page 15 lines 5–24, page 16 lines 16–20.

[note: 132] NE Day 15 page 73 lines 12–22.

[note: 133] 2nd Plaintiff's AEIC at [213].

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