

**IN THE GENERAL DIVISION OF
THE HIGH COURT OF THE REPUBLIC OF SINGAPORE**

[2023] SGHC 156

Suit No 600 of 2020 (consolidated with Suit No 96 of 2021)

Between

1. Dr. Who Waterworks Pte Ltd
(formerly known as Cana
Services Pte Ltd)
2. Dr. Who Global Watertech (S)
Pte Ltd
3. Dr. Who Laboratories (S) Pte
Ltd (formerly known as New
Global Fluid Engineering &
Machinery Pte Ltd)

... Plaintiffs

And

1. Dr. Who (M) Sdn Bhd
2. Oo Tim Wee
3. Low Siew Eng
4. Dynamic Watermedia Pte Ltd
(formerly known as Dr. Who
(S) Pte Ltd)

... Defendants

And Between

1. Dr. Who (M) Sdn Bhd
2. Oo Tim Wee
3. Low Siew Eng
4. Dynamic Watermedia Pte Ltd
(formerly known as Dr. Who
(S) Pte Ltd)

... Plaintiffs in Counterclaim

And

1. Dr. Who Waterworks Pte Ltd
(formerly known as Cana
Services Pte Ltd)
2. Dr. Who Global Watertech (S)
Pte Ltd
3. Dr. Who Laboratories (S) Pte
Ltd (formerly known as New
Global Fluid Engineering &
Machinery Pte Ltd)
4. Koh Tiong Gee (Xu Zhongyi)
5. Tan Kim Peng

... Defendants in Counterclaim

JUDGMENT

[Intellectual Property — Trade marks and trade names — Infringement]

[Intellectual Property — Trade marks and trade names — Passing off]

[Contract — Breach]

[Tort — Conspiracy]

[Tort — Detinue]

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This judgment is subject to final editorial corrections approved by the court and/or redaction pursuant to the publisher's duty in compliance with the law, for publication in LawNet and/or the Singapore Law Reports.

Dr Who Waterworks Pte Ltd and others

v

Dr Who (M) Sdn Bhd and others

[2023] SGHC 156

General Division of the High Court — Suit No 600 of 2020 (consolidated with Suit No 96 of 2021)

Dedar Singh Gill J

6–8 September, 14 November 2022

26 May 2023

Judgment reserved.

Dedar Singh Gill J:

1 This case involves a multiplicity of claims and counterclaims spanning intellectual property, contract and tort. They trace their origins to the acrimonious breakdown of the commercial relationship which once existed between the parties and the acts which followed.

Facts

The parties

2 The first plaintiff is a Singapore company currently known as Dr. Who Waterworks Pte Ltd. Incorporated on 19 February 1998,¹ it was initially named

¹ Koh Tiong Gee's Affidavit of Evidence-in-Chief ("Koh's AEIC") at para 7.

Cana Services Pte Ltd before it took on its present name on 26 September 2002.² While parties disagree on the nature of the business which the first plaintiff engaged in prior to the change in its name,³ it is not disputed that the first plaintiff was engaged in the supply of 5-gallon bottled water and the leasing and placement of water dispensers following its name change.⁴ At that point in 2002, the company was jointly operated by Mr Koh Tiong Gee (“Mr Koh”), his wife, Ms Tan Kim Peng (“Mdm Tan”), and Mr Benji Ng Ser Kwei (“Mr Ng”).⁵ The first plaintiff expanded its business in 2003 to include the provision of “bottles of water with label design and personalised branding”.⁶ For simplicity, I shall refer to such bottles of water as “bottled water bearing the customer’s mark”.

3 The second plaintiff, Dr. Who Global Watertech (S) Pte Ltd, was incorporated by Mr Koh on 27 June 2007.⁷ It engaged in the business of supplying and distributing bottled water and took over the segment of the first plaintiff’s business for the provision of bottled water bearing the customer’s mark.⁸

4 The third plaintiff, Dr. Who Laboratories (S) Pte Ltd, was incorporated on 16 April 2008 by Mr Koh for the purposes of research and development.⁹

² Koh’s AEIC at paras 9 and 13.

³ Oo Tim Wee’s Affidavit of Evidence-in-Chief (7 July 2022) (Part 1 of 21) (“Oo’s AEIC 1”) at para 9; Koh’s AEIC at para 11.

⁴ Koh’s AEIC at para 11.

⁵ Koh’s AEIC at para 11.

⁶ Koh’s AEIC at para 17.

⁷ Koh’s AEIC at para 33.

⁸ Koh’s AEIC at para 33.

⁹ Koh’s AEIC at para 38.

This entity subsequently entered into the direct piping sector to support the plaintiffs' other businesses.

5 The first defendant, Dr. Who (M) Sdn Bhd, was incorporated in Malaysia on 11 April 2007 by the second defendant, Mr Oo Tim Wee ("Mr Oo"). According to its business profile with the Companies Commission of Malaysia, the first defendant engages in the business of dealing in mineral and aerated water, and the provision of "integrated logistics services".¹⁰ Mr Oo, Mdm Low Siew Eng ("Mdm Low") (who is the third defendant), Mr Koh, Mdm Tan and the first plaintiff were the initial shareholders of the first defendant. The first plaintiff subsequently sold its shareholding in the first defendant to the remaining shareholders.¹¹

6 The fourth defendant, Dr. Who (S) Pte Ltd, was incorporated in Singapore by the second and third defendants on 17 July 2019.¹² According to its profile provided by the Accounting and Corporate Regulatory Authority ("ACRA"), the fourth defendant's activities include the "wholesale trade of a variety of goods without a dominant product", and "other transportation support activities".¹³ Mr Oo and Mdm Low were the only directors of the fourth defendant at the time of its incorporation.

7 The four defendants and three plaintiffs above are correspondingly the four plaintiffs and three defendants in the counterclaims, in the same order. For

¹⁰ Bundle Part N at p 90; Oo's AEIC 1 at para 21.

¹¹ Oo's AEIC 1 at para 22.

¹² Koh's AEIC at para 74.

¹³ Bundle Part N at p 97.

the purposes of the counterclaims, Mr Koh and Mdm Tan are joined as the fourth and fifth defendants respectively.

8 Two other companies, D’Choice Pte Ltd (“D’Choice”) and New Global Watertech Pte Ltd (“New Global”), were incorporated by Mr Koh in 2007 for the purposes of corporate restructuring.¹⁴ They are however not parties to these proceedings as they ceased business activities in 2017.¹⁵

Background to the dispute

The early years of the parties’ commercial relationship

9 I begin with the change in the first plaintiff’s name in September 2002. Mr Koh, who was serving as the general manager of the first plaintiff at the time, testified that he was the “motivator and main decision-maker to all matters concerning the business of the [first] plaintiff”.¹⁶ This included the change in the company’s name. According to Mr Koh, he conceived of the name “DR. WHO” by himself sometime before 26 September 2002.¹⁷ He states that he thought of the prefix “DR” as it harkened to the idea of “the usual doctor’s advice to drink plenty of water”, and the word “WHO” as the abbreviated form of the “World Health Organisation”.¹⁸ The defendants dispute this fact, insisting instead that the name “DR. WHO” was the creation of the prior owners of the first plaintiff before Mr Koh joined as a shareholder.¹⁹

¹⁴ Koh’s AEIC at paras 33 and 35.

¹⁵ Koh’s AEIC at paras 44 and 72.

¹⁶ Koh’s AEIC at para 12.

¹⁷ Koh’s AEIC at para 12.

¹⁸ Koh’s AEIC at para 12.

¹⁹ Oo’s AEIC 1 at para 19.

10 In any case, following this change, Mr Koh became acquainted with Mr Oo through a mutual friend.²⁰ At that time, Mr Oo was operating a Malaysian company, APlus Water & System Sdn Bhd (“APlus Water”), with his wife, Mdm Low. The company manufactured and supplied bottled water and dispenser services.²¹ The first plaintiff then decided to engage APlus Water for their supply and manufacturing services.²²

11 According to Mr Oo, he was invited by Mr Chan Eng Guan (“Mr Chan”) to invest in the first plaintiff and to become a director in November 2002.²³ Mr Oo agreed. Mr Chan was himself a shareholder and director of the first plaintiff but operated at all times as a sleeping director.²⁴

12 As previously mentioned, the first plaintiff expanded its business in 2003 to include the provision of bottled water bearing the customer’s mark.²⁵ This comprised the supply of bottled water in various sizes (*ie*, ranging from 250ml to 1.5l bottles). This is illustrated by the following examples:²⁶

²⁰ Koh’s AEIC at para 15; Oo’s AEIC 1 at para 8.

²¹ Koh’s AEIC at para 15.

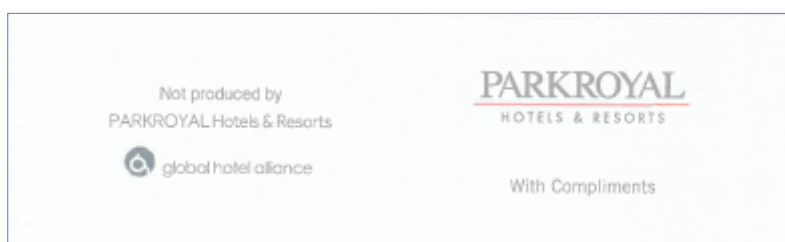
²² Koh’s AEIC at para 15.

²³ Oo’s AEIC 1 at para 10.

²⁴ Koh’s AEIC at para 16.

²⁵ Koh’s AEIC at para 17.

²⁶ Bundle Part S at pp 367 and 384.



13 Mr Koh asserts that he was solely responsible for the genesis of this new business concept. APlus Water assisted in the implementation of this business concept by manufacturing and supplying the bottled water bearing the customer's mark, a role which it undertook from November 2002 to December 2011.²⁷ This service was later transferred from APlus Water to another company owned by Mr Oo and his brother, APlus Food & Beverage Sdn Bhd ("APlus F&B").²⁸

14 In 2003, several shareholders of the first plaintiff, including Mr Ng, relinquished their shares in the company.²⁹ Pursuant to an agreement dated 15 March 2004, Mr Koh acquired a majority shareholding in the first plaintiff after Mr Oo and Mr Chan each transferred a portion of their shareholding to him.³⁰

²⁷ Koh's AEIC at para 19.

²⁸ Koh's AEIC at para 19.

²⁹ Koh's AEIC at para 23.

³⁰ Koh's AEIC at para 24.

On 31 March 2004, Mr Chan exited the first plaintiff, leaving Mr Oo and Mr Koh as equal shareholders.³¹ Mr Koh was also appointed a director of the first plaintiff in March 2004,³² a role which he was hitherto unable to take up due to employment disputes with his previous employer.³³

15 On 17 August 2004, the first plaintiff registered the mark “DR. WHO” in the following classes in Singapore:³⁴

Trade Mark No.	Mark	Class	Goods/Services
T0413722F ³⁵	DR. WHO	39	Delivery of bottled water to homes and offices; water supply services
T0413721H ³⁶	DR. WHO	32	Bottled water [not for medical purposes]; oxygenated water; drinking water; aerated water; waters [beverages] other than for medical purposes

³¹ Oo’s AEIC 1 at para 17.

³² Koh’s AEIC at para 23.

³³ Koh’s AEIC at para 20.

³⁴ Koh’s AEIC at para 26.

³⁵ Bundle Part B at p 120.

³⁶ Bundle Part B at p 119.

I refer to the mark registered in Class 39 as the “DR. WHO services mark” and the mark registered in Class 32 as the “DR. WHO goods mark” (collectively referred to as the “DR. WHO word marks”).

16 Mr Koh and Mr Oo each assert that they were solely responsible for the registration of the DR. WHO word marks. According to Mr Koh, Mr Oo had nothing to do with the registration of the DR. WHO word marks, which were registered on Mr Koh’s sole instructions.³⁷ Mr Oo, on the other hand, testifies that it was he who decided to register the marks.³⁸

17 The first defendant was incorporated in Malaysia on 11 April 2007 to operate as the manufacturing arm of the first plaintiff. According to Mr Koh, this was done as a preparatory step to distance the first plaintiff from its existing suppliers, APlus Water and APlus F&B, due to ongoing disputes between Mr Oo and his brother.³⁹


18 On 29 May 2007, a trade mark was registered in Malaysia in Mr Oo’s name. This trade mark bore the words “DR. WHO” with two decorative “swooshes” at the bottom-right corner of the words (“the DR. WHO swoosh mark”).

Trade Mark No	Mark	Class	Goods
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³⁷ Koh’s AEIC at para 27.

³⁸ Oo’s AEIC 1 at para 20.

³⁹ Koh’s AEIC at para 30.

07009932 ⁴⁰		32	Mineral water; drinking water; oxygenated water (for non-medical use); reverse osmosis water; mineralized water (for non- medical use) and aerated water; fruit drinks and fruit juices; vegetable juices; syrups and other preparations (of non-alcoholic) for making beverages; instant beverage powders for preparations of non-alcoholic drinks and beverages
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⁴⁰

Bundle Part B at p 159.

19 Mr Koh’s evidence is that he had created the DR. WHO swoosh mark by himself, and that he and Mdm Tan had agreed that the Malaysia-registered mark was to be registered in the name of the first defendant. However, they only discovered that the DR. WHO swoosh mark was registered in Mr Oo’s name sometime in 2016. Conversely, Mr Oo testifies that Mr Koh was at all times fully aware that the mark was registered in his name.⁴¹

20 From 2007 to 2008, four companies were incorporated for the purposes of the corporate restructuring and expansion of the first plaintiff’s business: the second plaintiff, D’Choice, New Global and the third plaintiff. Pursuant to the restructuring exercise, the first plaintiff was made the holding company of these preceding companies (collectively, “the Dr. Who Group”).⁴² The first plaintiff continued its business of supplying 5-gallon bottled water and bottled water bearing the customer’s mark. It placed orders for bottled water bearing the customer’s mark with New Global and APlus F&B,⁴³ while supplying the second plaintiff with bottled water, dispenser services and bottled water bearing the customer’s mark.⁴⁴ Sometime in January 2012, the first plaintiff began ordering bottled water bearing the customer’s mark from the first defendant and ceased orders from APlus F&B.⁴⁵

21 In 2012, Mr Koh engaged a brand-strategy consultant. This resulted in the development of the slogan “Bringing smiles to your world” (“the Slogan”) and a trade mark based on the words “DR. WHO”. The mark comprised the

⁴¹ Oo’s AEIC 1 at para 37.


⁴² Koh’s AEIC at para 40.

⁴³ Koh’s AEIC at paras 35-36.

⁴⁴ Koh’s AEIC at para 37.

⁴⁵ Koh’s AEIC at para 41.

term “DR. WHO” with four water droplets in a quatrefoil shape at its top-right corner (“the DR. WHO quatrefoil device mark”). The mark was registered in the first plaintiff’s name in Singapore on 19 October 2012 in the following classes:

Trade Mark No.	Mark	Class	Goods/Services
T1215741I ⁴⁶		11	Water treatment units
		40	Treatment of water

The breakdown in the parties’ relationship – the First Malaysian Suit and the Deed


22 In 2013, cracks began to form in the business relationship between Mr Koh and Mdm Tan (“the Kohs”) and Mr Oo and Mdm Low (“the Oos”). The deterioration in relations was precipitated by disputes over, *inter alia*, each party’s remuneration and the Kohs’ employment of their relatives.⁴⁷ This culminated in the initiation of a suit by the Kohs against the Oos in Malaysia on 6 September 2016 (“the First Malaysian Suit”). The suit involved the claim by the Kohs that the Oos had wrongfully made unilateral attempts to increase the salary which Mdm Low received from the first defendant.⁴⁸

⁴⁶ Bundle Part B at p 121.

⁴⁷ Koh’s AEIC at paras 51-60; Oo’s AEIC 1 at paras 44-60.

⁴⁸ Koh’s AEIC at para 59; Oo’s AEIC (Part 3 of 21) at OTW-15, p 2.

23 Three days after the commencement of the First Malaysian Suit, on 9 September 2016, Mr Oo registered in Malaysia a mark containing the words “DR. WHO” with the quatrefoil-water droplet design element affixed at the top-right hand corner (“the Malaysian DR. WHO quatrefoil device mark”):⁴⁹

Trade Mark No.	Mark	Class	Goods/Services
2016066646 ⁵⁰		32	Mineral water; flavoured mineral water; mineralized water (for non-medical use); drinking water; flavoured waters; oxygenated water (for non-medical use); reverse osmosis water; aerated water; energy drinks

Mr Koh’s evidence is that, at the time, he was unaware that Mr Oo had registered the mark.⁵¹

⁴⁹ Oo’s AEIC 1 at para 38.

⁵⁰ Bundle Part B at p 152.

⁵¹ Koh’s AEIC at para 81.

24 The Kohs and the Oos were eventually able to reach a settlement regarding the First Malaysian Suit and recorded the terms of their agreement in a deed of settlement dated 13 February 2017 (“the Deed”). The parties to the Deed were, on one hand, the Dr. Who Group and the Kohs; and on the other, the first defendant and the Oos. The Deed essentially envisaged a parting of ways between the Oos and the Kohs in terms of the shareholdings and directorships they each held in the Singaporean and Malaysian companies.⁵² This was due to, as the recital of the Deed termed it, “irreconcilable disputes and differences” between the parties.⁵³ Pursuant to the Deed, the Kohs became the only shareholders and directors of the first to third plaintiffs, New Global and D’Choice, while the Oos became the only shareholders and directors of the first defendant.

25 The Deed also governed the intellectual property held by the respective companies. Pertinently, Clause 2.3 of the Deed dealt with the “rights of ownership of “DR. WHO” marks”, and provided as follows:

2.3 Exclusive Rights of ownership of “DR. WHO” marks in Singapore, Malaysia and in other jurisdictions and Mutual Co-existence Rights

- (1) The mark “DR. WHO” is a trademark registered in Singapore and Malaysia. The Kohs and [the Dr. Who Group (including the first plaintiff)] shall be entitled to own and use the mark “DR. WHO” in Singapore and in any other jurisdiction (apart from Malaysia) in the sole discretion of the Kohs, and the Oos and [the first defendant] shall be entitled to own and use the mark “DR. WHO” in Malaysia and in any other jurisdiction (apart from Singapore) in the discretion of the Oos.

⁵² See Bundle Part I at pp 83ff (Clause 1.1); Agreed Bundle of Documents (“ABD”) at pp 31-32, Clause 1.

⁵³ Bundle Part I at p 83.

- (2) Neither party shall use the DR. WHO trademark in the other Party's Country without the prior written approval of each party.
- (3) [Mr Oo, Mdm Low and/or the first defendant] shall not, without the prior written approval of [the Dr. Who Group] whether directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Singapore bearing or under the "DR. WHO" mark registered in Malaysia and/or by way of passing off.
- (4) [Mdm Tan, Mr Koh and/or the Dr. Who Group] shall not, without the prior written approval of [the first defendant] whether directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Malaysia bearing or under the "DR. WHO" mark registered in Singapore and/or by way of passing off.
- (5) The Restraint Clauses in Sub-clauses (3) and (4) above are not intended to hinder competition but are necessary for the purpose of protecting [the Dr. Who Group] and [the first defendant's] business, intellectual property and goodwill.

The events following the Deed

26 After the settlement, the plaintiffs continued to place orders for bottled water bearing the customer's mark from the first defendant.⁵⁴

27 On 29 October 2018, Mr Oo registered in Malaysia two marks that comprised the words "DR. WHO" in Classes 16 and 35 respectively (collectively, "the Malaysian DR. WHO word marks"):⁵⁵

Trade Mark No	Mark	Class	Goods/Services

⁵⁴ Koh's AEIC at para 73.

⁵⁵ Oo's AEIC 1 at paras 39-40.

2018072778 ⁵⁶	DR. WHO	16	Advertising posters; advertising publications; photographs; paper cards (blank) for recording data; envelopes; business cards; paper bags; packaging materials made of cardboard; paper boxes; printed forms; booklets; books; leaflets; letterhead paper; paper for letterhead paper; writing paper; note pads; pamphlets; leaflets; stickers; paper tags; user manuals (in the form of printed matter); company magazines; catalogues; newsletters; periodicals; brochures; gift stationery
2018072780 ⁵⁷	DR. WHO	35	Advertising by mail order; online advertisement on a computer network; presentation of goods on communication media;

⁵⁶ Bundle Part B at p 221.

⁵⁷ Bundle Part B at p 222.

			business management; business administration; retail & franchise services; business merchandising display services; business advisory services; the bringing together for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise website in the global communications network
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28 Sometime in late 2018, Mr Koh came to learn from one of the Dr. Who Group’s customers that the first defendant was supplying bottled water bearing the customer’s mark to a competitor of the plaintiffs, Global Water Solutions Pte Ltd (“Global Water”).⁵⁸ The first plaintiff decided to engage DP Quest Investigation Consultancy Pte Ltd (“DP Quest”) to conduct surveillance on the first defendant’s activities in Singapore.

29 DP Quest’s findings were contained in a report dated 6 December 2019 (“the PI Report”). The report made the following findings:

⁵⁸ Koh’s AEIC at para 76.

(a) On 28 March 2019, a truck with vehicle registration number JTF 7514 bearing a trailer (“Vehicle A”) was seen driving into the first plaintiff’s premises at 24 Chin Bee Road. As evident from the photograph below, on Vehicle A was the sign “DR. WHO” with four water droplets in a quatrefoil design on its top right corner (“the DR. WHO quatrefoil device sign”), followed by the first defendant’s contact details, e-mail “drwho@drwho.com.my” and website “www.drwho.com.my”.⁵⁹



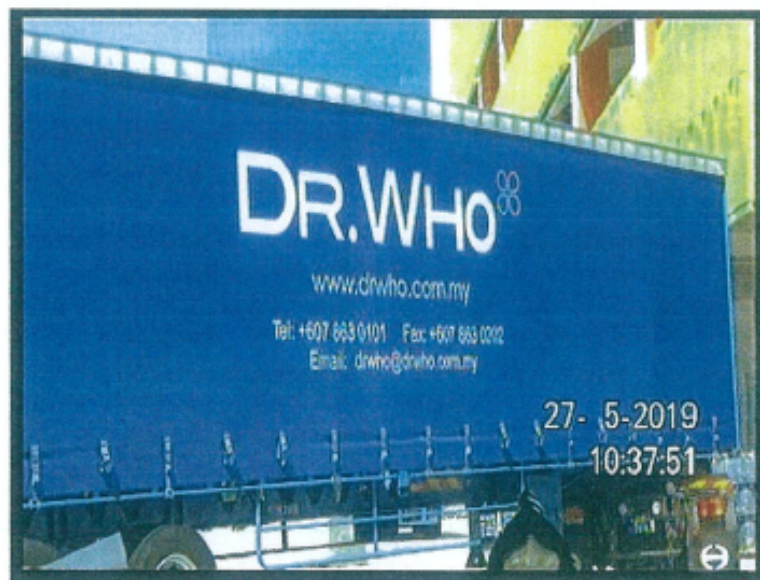
(b) On 10 April 2019, Vehicle A was seen at Global Water’s premises at 1 Venture Avenue (“Global Water’s old premises”). It contained as its cargo empty bottles with labels bearing either the words “Hydr8” or “Royal”.⁶⁰ There were no clear photographs provided of the allegedly infringing signs on Vehicle A on this occasion.

⁵⁹ Koh’s AEIC at p 1617.

⁶⁰ Koh’s AEIC at p 1621.

(c) On 7 May 2019, a truck with vehicle registration number JRU 617 (“Vehicle B”) was seen at Global Water’s old premises. According to the PI Report, the first defendant’s name, the “Dr WHO logo and Malaysian contact details” were displayed on the truck, although there were no photographs showing that these allegedly infringing signs were clearly displayed on Vehicle B.⁶¹

(d) On 27 May 2019, Vehicle A was seen picking up boxes containing empty bottles with the label “Hydr8” from Global Water’s old premises. Vehicle A bore the same allegedly infringing signs as it did when it was sighted on 28 March 2019. This is evidenced by the following photograph provided by the PI Report.



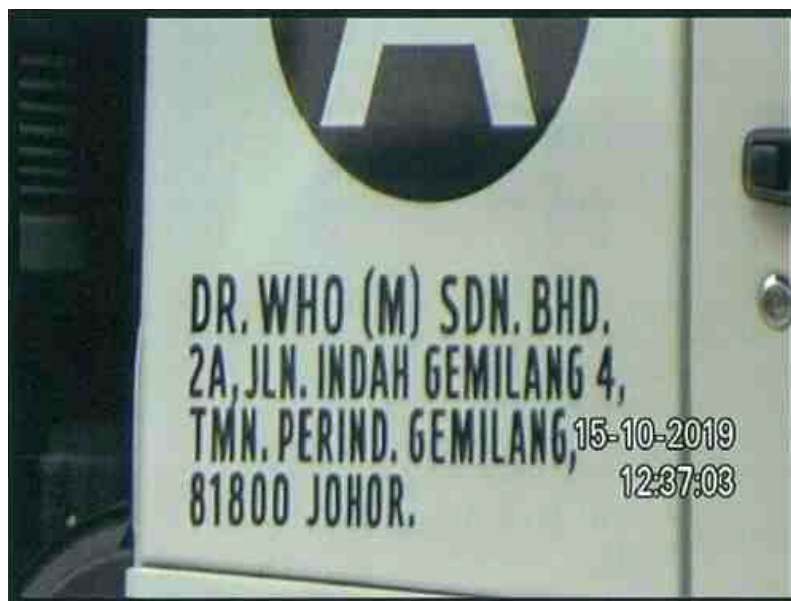
(e) On 15 October 2019, Vehicle A was seen parked at Global Water’s premises at 35 Pioneer Road North (“Global Water’s new

⁶¹ Koh’s AEIC at p 1625.

premises”).⁶² Empty “Hydr8” bottles were loaded onto Vehicle A. On this particular occasion, the PI Report showed that the DR. WHO quatrefoil device sign was also used on the polo shirt worn by Vehicle A’s driver (“Driver A’s Attire”). It was also revealed that the first defendant’s name was displayed on the side of Vehicle A and that the “www.drwho.com.my” sign was painted on the front of Vehicle A. The following photographs presented in the PI Report confirm these findings.



⁶² Koh’s AEIC at p 1632.



30 I also observe that Mr Koh alleges in his affidavit the use of multiple infringing signs on Vehicles A and B which are not directly evidenced by the PI Report. For instance, he asserts that the attire of Vehicle A's driver bore various infringing signs on 28 March 2019 and that the plaintiffs' website

address (“www.drwhohub.com”) was displayed on Vehicle B on 7 May 2019.⁶³ Neither the findings of the PI Report nor the photographs therein corroborate these assertions.⁶⁴

31 In addition to Vehicles A and B, Mr Koh’s evidence is that two other vehicles with vehicle registration numbers JNY 3452 and JSX 5217 respectively also bore the following details:⁶⁵ the DR. WHO quatrefoil device sign, the Slogan, the “www.drwho.com.my” sign, the first defendant’s e-mail and contact numbers and the plaintiffs’ e-mail.⁶⁶ I refer to these vehicles as “Vehicle C” and “Vehicle D” respectively, and all four of these commercial vehicles collectively as “the Commercial Vehicles”.

32 As a result of the PI Report and Mr Koh’s “connections... in the market”,⁶⁷ Mr Koh discovered that the first defendant was selling bottled water bearing the customer’s mark to the following companies in Singapore after the signing of the Deed:

- (a) Picco Enterprise Pte Ltd;
- (b) Global Water;
- (c) Royal JC Pte Ltd;
- (d) GSH Marketing (S) Pte Ltd; and

⁶³ Koh’s AEIC at pp 60 and 63.

⁶⁴ Koh’s AEIC at pp 1616-1620.

⁶⁵ Koh’s AEIC at p 61.

⁶⁶ Koh’s AEIC at p 61.

⁶⁷ Koh’s AEIC at para 79.

(e) Hock Leong Teck Kee Pte Ltd.

33 Mr Oo does not deny that the first defendant had in fact sold bottled water to the aforementioned companies but maintains that he was entitled to do so under the Deed as long as he did not use the “DR. WHO” mark.⁶⁸ Mr Oo also testified that, in addition to the above companies, the first defendant supplied bottled water to one Field Catering & Supplies Pte Ltd.⁶⁹ It is undisputed that none of the bottles supplied to these companies bore the mark “DR. WHO” or any of the marks in issue in these proceedings.

34 On 7 August 2019, the first plaintiff, through its solicitors, proceeded to send to the companies listed at [32] above letters of demand, asking that they refrain from engaging the first defendant for the sale of bottled water in a manner which would amount to passing off or a breach of the Deed.⁷⁰ A letter of demand was also sent to the defendants on the same day, alleging that they were liable for passing off⁷¹ and trade mark infringement of the DR. WHO word marks and the DR. WHO quatrefoil device mark by the use of identical or similar marks on their vehicles, and were in breach of the Deed.⁷² The first defendant replied on 29 August 2019 denying any liability.⁷³ Meanwhile, the Oos had incorporated the fourth defendant, DR. WHO (S) Pte Ltd, in Singapore on 17 July 2019.

⁶⁸ Oo’s AEIC 1 at para 76; Defence and Counterclaim at para 87.

⁶⁹ Oo’s AEIC 1 at para 77.

⁷⁰ Koh’s AEIC at para 79; p 1099.

⁷¹ Koh’s AEIC at p 1120.

⁷² Bundle Part A at p 150; Koh’s AEIC at p 1114.

⁷³ Bundle Part A at p 154.

35 Although, as observed at [26], the plaintiffs continued their orders for the manufacturing of bottled water from the first defendant, these orders were gradually reduced. This resulted in the plaintiffs entering into various transactions with other manufacturers, which are summarised as follows:

(a) On 10 June 2019, the second plaintiff entered into a distribution agreement with a Malaysian company, Water Revelation Sdn Bhd (“WRM”), and its Singaporean arm, Water Revelation (S) Pte Ltd (“WRS”). These two companies were in the business of bottling and distributing pure drinking water respectively.⁷⁴ Under this agreement (“the Distribution Agreement”), the second plaintiff was to print labels (for the purpose of affixing them on bottled water) and deliver them to WRM’s premises in Malaysia.⁷⁵ WRM would apply these labels to bottled water, which it then supplied to the second plaintiff for the onward distribution of the same to the second plaintiff’s customers in Singapore. Mr Koh’s evidence is that the first and second defendants had knowledge of the Distribution Agreement through a conversation he had with Mr Oo.⁷⁶ Mr Oo’s evidence, on the other hand, is that no such conversation took place. According to Mr Oo, he came to learn of the Distribution Agreement on 21 July 2020, when carton boxes bearing the DR. WHO word marks and the DR. WHO quatrefoil device mark containing bottled drinking water were seen loaded up on a vehicle with registration number JGW6630.⁷⁷

⁷⁴ Bundle Part EE at pp 332ff; Koh’s AEIC at para 238.

⁷⁵ Bundle Part EE at pp 332ff (see clause 4).

⁷⁶ Notes of Evidence (6 September 2022) at p 36.

⁷⁷ Oo’s AEIC 1 at para 213(a).

(b) Jasinpack Sdn Bhd (“Jasinpack”), from 13 February 2017 to 18 August 2020, printed and supplied labels bearing the DR. WHO word marks to the second plaintiff.⁷⁸

(c) Win Smith Sdn Bhd (“Win Smith”), from 2019 to 2020, printed and supplied labels bearing the DR. WHO word marks and the DR. WHO quatrefoil device mark to either WRM on the second plaintiff’s account, or directly to the second plaintiff.⁷⁹

(d) Profile Label Sdn Bhd (“Profile Label”), from 13 February 2017 to 18 August 2020, printed and supplied labels bearing the DR. WHO word marks to WRM on the second plaintiff’s account.⁸⁰

(e) Lian Huat Sdn Bhd (“Lian Huat”) and Ornapaper Sdn Bhd manufactured carton boxes that bore the DR. WHO word marks and the DR. WHO quatrefoil device mark and the plaintiffs’ contact details.⁸¹ These boxes were supplied to WRM on the second plaintiff’s account.

36 In early 2020, the Kohs accessed the “www.drwho.com.my” website and discovered that it contained, amongst other things:⁸²

- (a) the title “DR. WHO (M) Sdn Bhd”;
- (b) a banner which bore the DR. WHO quatrefoil device sign;

⁷⁸ Oo’s AEIC 1 at para 209(A)(i)(g)–(j) and para 213(c).

⁷⁹ Oo’s AEIC 1 at para 209(A)(i)(k), para 213(b)(i) and pp 3035-3064.

⁸⁰ Oo’s AEIC 1 at para 209(A)(i)(l),

⁸¹ Oo’s AEIC 1 at paras 209(A)(l)–213(f); see Notes of Evidence (6 September 2022) at p 121 lines 1 to 23.

⁸² Koh’s AEIC at para 93(p); ABD at pp 147 to 148.

- (c) an image of a building bearing the DR. WHO quatrefoil device sign;
- (d) the first defendant's contact details and address; and
- (e) a link to the first defendant's Facebook page ("the DR. WHO (M) Facebook page"). The DR. WHO (M) Facebook page also bore the same details listed in the preceding sub-paragraphs, as well as a link to another website belonging to the defendants, "www.drwho.asia".

37 Between January and March 2020, the Kohs also came to learn that the IKEA stores at 60 Tampines North Drive ("IKEA Tampines") and 317 Alexandra Road ("IKEA Alexandra") were selling 500ml cartons of drinking water bearing the sign "DRICKSVATTEN" ("the Cartons").⁸³ Mr Oo's evidence is that the fourth defendant had an agreement with IKEA for the sale of the Cartons that began sometime in January 2019.⁸⁴ As the following photograph demonstrates, the Cartons also bore, at the bottom in fine print, the following:

- (a) the sign "Dr. Who (M) Sdn Bhd" and the first defendant's address in Malaysia;
- (b) the first defendant's telephone number, fax number and e-mail; and
- (c) the "www.drwho.asia" website.

⁸³ Koh Tiong Gee's Affidavit dated 3 July 2020 at paras 60(p)–(q).

⁸⁴ Notes of Evidence (7 September 2022) at p 43.



38 According to Mr Koh, up till around November 2019, IKEA had ordered bottled water bearing its mark, known then as “Syretsattvatten”, from the second plaintiff.⁸⁵ It thus came as a surprise to him to see the first defendant’s name and contact details on the Cartons sold at IKEA Alexandra and IKEA Tampines.

39 The Kohs also accessed the “www.drwho.asia” website. This website had a similar design to the “www.drwho.com.my” website, save that its meta-title bore the name of the fourth defendant and had, at the bottom of the

⁸⁵ Koh’s AEIC at para 93(r).

webpage, the following notice: “© 2020 DR. WHO (S) PTE LTD”.⁸⁶ To elaborate, meta-titles do not “appear” in the content of the webpage itself. Instead, they set out the “topic” of the webpage and often appear as text in the “tab” of a web browser and as part of search engine results.

The commencement of the present suit and related proceedings

40 Armed with the discoveries above, the plaintiffs commenced the present proceedings on 3 July 2020, asserting that the defendants were liable for, *inter alia*, the tort of passing off, trade mark infringement and breach of the Deed. The plaintiffs also filed HC/SUM 2651/2020 (“SUM 2651”) on the same day, seeking an interim injunction to restrain the defendants from, amongst other things:

“directly or indirectly supplying and causing to be supplied bottled water and [bottled water bearing the customer’s mark] to any person or entity in Singapore by way of passing off as and for the [plaintiffs’] business and/or goods and services”.

The plaintiffs were granted the order HC/ORC 3678/2020 on 8 July 2020 (“the Interim Injunction”),⁸⁷ which provided that:

1. An injunction is granted to restrain the [defendants], whether by themselves or by their servants or agents or any of them otherwise howsoever from:

a. directly or indirectly supplying and causing to be supplied bottled water and [bottled water bearing the customer’s mark] to any person or entity in Singapore by way of passing off as and for the [plaintiffs’] businesses and/or goods and services;

b. passing off or attempting to pass off the [first and fourth defendants’] businesses as and for the [plaintiffs’] businesses by the use of the words “DR. WHO”, the [DR. WHO word marks] ... or the [DR. WHO quatrefoil device

⁸⁶ Bundle Part E at p 387.

⁸⁷ HC/ORC 3678/2020.

mark] ... or any other colourable imitation of the same or otherwise howsoever;

c. passing off or attempting to pass off by manufacturing, advertising, marketing, selling, offering for sale, supplying, importing, exporting, distributing bottled water or [bottled water bearing the customer's mark] by reference to or the use of the words "**DR. WHO**", the [DR. WHO word marks] or the [DR. WHO quatrefoil device mark] or any colourable imitation of the same not being the bottled water or [bottled water bearing the customer's mark] of the [plaintiffs] as for the bottled water or [bottled water bearing the customer's mark] of the [plaintiffs] or as being connected to or associated with the [plaintiffs].

...

2. Further to Order 1 above, an injunction is granted to restrain the [first and fourth defendants], whether by themselves or by their servants or agents or any of them or otherwise howsoever from infringing the [DR. WHO word marks] ..., [DR. WHO quatrefoil device mark] ... and any other mark that is identical with or similar to the said marks.

[emphasis in the original]

41 After the grant of the Interim Injunction, the plaintiffs' solicitors wrote to IKEA on 13 July 2020, and, making reference to the Interim Injunction, asked that IKEA "immediately cease and desist from all dealings that concern the sale of [the Cartons]".⁸⁸ IKEA, following discussions with the Oos and their solicitors, proceeded to suspend deliveries from the first defendant on 20 July 2020.⁸⁹ Existing Cartons that remained on display at IKEA stores had references to the words "DR. WHO" redacted.⁹⁰ IKEA also placed fresh orders for water contained in 500ml cartons from the first defendant with new packaging that

⁸⁸ Bundle Part A at p 277.

⁸⁹ Chng Kim Chuan's Affidavit of Evidence-in-Chief (12 July 2022) ("Chng's AEIC") at p 185.

⁹⁰ Chng's AEIC at p 218.

made no reference to the first defendant, the “www.drwho.asia” website or its contact details.⁹¹

42 On 16 July 2020, the plaintiffs’ solicitors wrote to the Registrar of Companies seeking that the Registrar direct the fourth defendant to change its name pursuant to s 27(2) of the Companies Act (Cap 50, 2006 Rev Ed). On 7 August 2020, the fourth defendant received a letter from ACRA directing the fourth defendant to change its name.⁹² The fourth defendant complied, and its name was therefore changed from “DR. WHO (S) Pte Ltd” to “Dynamic Watermedia Pte Ltd” on 20 April 2021.⁹³

43 On 31 July 2020, the defendants’ solicitors sent a letter of demand to the plaintiffs,⁹⁴ alleging that the plaintiffs had (by the various transactions at [35] above) infringed the Malaysian DR. WHO word marks and the Malaysian DR. WHO quatrefoil device mark. According to Mr Koh, it was through this letter that the plaintiffs first came to learn of the registration of the Malaysian DR. WHO word marks and the Malaysian DR. WHO quatrefoil device mark by Mr Oo.

44 On 14 August 2020, the plaintiffs sought leave to apply for an order of committal against the Oos for alleged breaches of the Interim Injunction in HC/SUM 3410/2020 (“SUM 3410”). These breaches involved, amongst other things, the defendants’ failure to take steps to totally remove the use of the sign “DR. WHO” on the “www.drwho.com.my” website, the “www.drwho.asia”

⁹¹ Chng’s AEIC at p 227.

⁹² Oo’s AEIC 1 at para 158.

⁹³ Koh’s AEIC at p 3009.

⁹⁴ Koh’s AEIC at KTG-10, pp 1135-1140; ADB at p 1298.

website and the DR. WHO (M) Facebook page, and the continued display of the Cartons at the premises of IKEA from the date of the Interim Injunction to 1 August 2020.⁹⁵

45 On 16 August 2020, the defendants commenced legal proceedings against the first plaintiff and its manufacturers as listed at [35] above (“the Second Malaysian Suit”) for essentially the same causes of action as the counterclaims in the present suit.⁹⁶ The defendants were granted an injunction in the Second Malaysian Suit against the second plaintiff, WRM and Lian Huat, restraining them from infringing the Malaysian trade marks registered in Mr Oo’s name until the disposal of those proceedings (“the Malaysian Injunction”).⁹⁷

46 The defendants entered their appearance in the present suit on 17 August 2020. On 19 August 2020, the plaintiffs were granted leave in SUM 3410,⁹⁸ and they proceeded to file HC/SUM 3602/2020 (“SUM 3602”) on 25 August 2020 seeking an order that the Oos be committed to prison for contempt.

47 On 11 September 2020, the defendants proceeded to file their defence and counterclaim. Amongst other claims in their counterclaim, the defendants’ case is that from the date of the Deed (13 February 2017) to August 2020, the plaintiffs had placed orders for the supply of bottled water and the printing of labels and carton boxes which bore signs identical to the Malaysian DR. WHO

⁹⁵ Koh Tiong Gee’s Affidavit dated 14 August 2021 at Section B.

⁹⁶ Oo’s AEIC at para 215.

⁹⁷ Oo’s AEIC at para 220.

⁹⁸ See Minute Sheet dated 19 August 2020.

word marks and the Malaysian DR. WHO quatrefoil device mark with various companies in Malaysia in breach of the Deed.

48 On 14 September 2020, the defendants also filed HC/SUM 3928/2020 (“SUM 3928”), which was an application to set aside the Interim Injunction. The defendants took the position that the plaintiffs had wrongfully sought the Interim Injunction to force IKEA to cease selling the Cartons, as the Cartons were characterised as *cartons of water* rather than *bottled water* and therefore were not covered by the injunction.

49 SUM 3602 and SUM 3928 were heard together on 19 October 2020, 25 January and 1 February 2021.⁹⁹ Mr Oo and Mdm Low were jointly fined \$3,000 for failing to comply with the Interim Injunction. A variation of the Interim Injunction (“the Variation Order”) was also ordered on 1 February 2021 in the following terms:¹⁰⁰

1. [The Interim Injunction] is not set aside but varied as follows:

- a. the [first defendant] is at liberty to continue the supply of the tetrapak water to IKEA, (Ikano Pte Ltd) so long as the words “DR. WHO” do not appear anywhere on the packaging;
- b. the [first defendant] is also at liberty to continue to supply bottled water to their customers in Singapore provided that the bottles do not contain the [DR. WHO word marks] with or without the [DR. WHO quatrefoil device mark] in any form but they are allowed to have the [first defendant’s] name as the manufacturer/supplier of their customers’ water...

50 On 12 March 2021, the plaintiffs filed HC/SUM 1182/2021, which was an *ex parte* application for leave to commence committal proceedings, citing

⁹⁹ See Minute Sheets dated 19 October 2020, 25 January 2021, and 1 February 2021 respectively.

¹⁰⁰ Oo’s AEIC at para 86.

the defendants’ continuing failure to take any action to remove the mark “DR. WHO” from the “www.drwho.com.my” website, the “www.drwho.asia” website and the DR. WHO (M) Facebook page, amongst other things. Leave was granted on 23 March 2021, and the plaintiffs filed HC/SUM 1827/2021 (“SUM 1827”) seeking a committal order against the second and third defendants. On 7 June 2021, SUM 1827 was heard and dismissed.

51 With this background set out, I turn to the parties’ cases proper.

The parties’ cases

The plaintiffs’ claims

52 The plaintiffs advance five heads of claim against the defendants. The plaintiffs’ arguments under each head of claim are summarised as follows:

- (a) First, the plaintiffs claim that the first and fourth defendants have infringed the DR. WHO word marks and the DR. WHO quatrefoil device mark.¹⁰¹ They assert that the first and fourth defendants infringed the DR. WHO word marks and DR. WHO quatrefoil device mark by the use of identical or similar signs on: (i) the first defendant’s Commercial Vehicles and on Driver A’s Attire; (ii) the display of the “www.drwho.asia” website on the Cartons on sale at IKEA Alexandra and IKEA Tampines; (iii) the content of the defendants’ websites; (iv) the content of the DR. WHO (M) Facebook page; and (v) the incorporation of the fourth defendant with a name “identical with or similar to the DR. WHO word marks and/or the DR. WHO quatrefoil device mark”. It is averred that these signs were used in relation to

¹⁰¹ PWS at para 92.

“goods or services identical with or similar to” those which the DR. WHO word marks and DR. WHO quatrefoil device mark are registered for. The plaintiffs submit that there is a likelihood of confusion as to the origin of the goods and services in question, which constitutes an infringement under s 27(2) of the TMA.¹⁰²

(b) Second, the plaintiffs claim that the first and fourth defendants are “liable for the tort of passing off”. They argue that goodwill in their business exists vis-à-vis persons in Singapore who did business with the plaintiffs, and that the words “DR. WHO” and their trade marks are identifiers which are associated with their goodwill.¹⁰³ The plaintiffs submit that the first and fourth defendants had, by using the words “DR. WHO” and other signs in Singapore, committed various acts which amounted to misrepresentations that the defendants’ goods and/or business were the plaintiffs’ or were otherwise associated with the plaintiffs.¹⁰⁴ The plaintiffs submit that three heads of damage are applicable: the tarnishment of their goodwill, the likelihood of damage should the defendant get into financial, legal or other trouble and the loss of exclusivity or erosion of distinctiveness to their goodwill.¹⁰⁵ In addition, the plaintiffs plead an additional head of damage in their Statement of Claim: the loss of sales.¹⁰⁶

¹⁰² PWS at para 93.

¹⁰³ PWS at paras 25ff.

¹⁰⁴ PWS at paras 41ff.

¹⁰⁵ PWS at para 87.

¹⁰⁶ Statement of Claim (Amendment No. 3) (“SOC”) at para 56.

(c) Third, the plaintiffs claim that the defendants were, by virtue of their alleged acts of passing off, in breach of Clauses 2.3(2) and 2.3(3) of the Deed.¹⁰⁷

(d) Fourth, the plaintiffs claim that the defendants had conspired to injure the plaintiffs by incorporating the fourth defendant and by passing off the fourth defendant's goods and services and their business as connected to the plaintiffs' business.¹⁰⁸

(e) Fifth, the plaintiffs claim that the first defendant had wrongfully detained certain labels belonging to the second plaintiff ("the Labels"). This allegedly led to losses of \$16,565.39.¹⁰⁹

53 The defendants deny the claims stated above.¹¹⁰

The defendants' counterclaims

54 The defendants' counterclaims may be summarised as follows:

(a) First, the defendants claim that the plaintiffs and the Kohs had, by their use of signs identical or similar to the Malaysian DR. WHO quatrefoil device mark and the Malaysian DR. WHO word marks in Malaysia, through the procuring of bottled drinking water¹¹¹ and the manufacture and printing of labels and boxes for bottled water from

¹⁰⁷ PWS at p 12 (Header D), paras 76, 85, 88.

¹⁰⁸ PWS at para 96.

¹⁰⁹ PWS at para 98.

¹¹⁰ Closing Submissions for the 1st to 4th Defendants (by original action) and 1st to 4th Plaintiffs (by counterclaim) dated 31 October 2022 ("DCS") at p 45, para 3(a)–(e).

¹¹¹ Defence and Counterclaim at pp 33-34.

manufacturers other than the first defendant, acted in breach of Clause 2.3 of the Deed.¹¹²

(b) Second, the plaintiffs and the Kohs had unlawfully conspired to injure the defendants by using the DR. WHO word marks and the DR. WHO quatrefoil device mark in Malaysia in breach of the Deed and the Malaysian Injunction.¹¹³ As part of this unlawful conspiracy, the plaintiffs brought the present suit with the intention of damaging the defendants' business.

(c) Third, the first defendant claims that the second plaintiff owes it an outstanding amount of \$143,665.80 following the first defendant's supply of bottled water to the second plaintiff from January to May 2020.¹¹⁴

(d) Fourth, the plaintiffs and the Kohs had wrongfully interfered with the defendants' business with IKEA by demanding that IKEA cease and desist from the sale of the Cartons.¹¹⁵ According to the defendants, the use of the first defendant's corporate name ("DR. WHO (M) SDN BHD") or the defendants' website ("www.drwho.asia") did not amount to the use of the plaintiffs' marks.¹¹⁶ There was thus no basis for the plaintiffs' actions.

¹¹² DCS at p 18.

¹¹³ DCS at p 56.

¹¹⁴ DCS at p 14ff.

¹¹⁵ DCS at p 16ff.

¹¹⁶ DCS at p 18.

55 The plaintiffs deny the counterclaims above.¹¹⁷ The plaintiffs argue that they were justified in commencing the present suit and requesting IKEA to cease the sale of the Cartons. In addition, they take the position that the plaintiffs' acts in Malaysia did not constitute breaches of the Deed as Clause 2.3 of the Deed only prohibits the supply, and not the manufacture, of bottled water by the plaintiffs in Malaysia.¹¹⁸

Issues to be determined

56 For the plaintiffs' claim, the following issues arise for my determination:

- (a) whether the defendants have infringed the plaintiffs' DR. WHO word marks and the DR. WHO quatrefoil device mark;
- (b) whether the defendants have committed the tort of passing off ;
- (c) whether the defendants have breached the Deed;
- (d) whether the plaintiffs' claim for unlawful conspiracy to injure is made out; and
- (e) whether the defendants have wrongfully detained the Labels.

57 With respect to the defendants' counterclaim, I will address the following issues:

- (a) whether the plaintiffs have breached the Deed;

¹¹⁷ PWS at para 99.

¹¹⁸ PWS at para 120.

- (b) whether the defendants' claim for unlawful conspiracy to injure is made out;
- (c) whether the second plaintiff is liable to the first defendant for the sum of \$143,665.80; and
- (d) whether the plaintiffs and the Kohs have wrongfully interfered with the defendant's business with IKEA.

58 I deal with each issue in turn, beginning with the plaintiffs' claim in trade mark infringement.

Claim 1: Infringement of the plaintiffs' trade marks

59 The plaintiffs' claims for trade mark infringement are premised upon s 27(2) of the TMA,¹¹⁹ which states as follows:

Acts amounting to infringement of registered trade mark

27.— ...

(2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign where because —

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public.

60 For a claim of trade mark infringement to succeed under s 27(2) of the TMA, the plaintiff must prove the following elements:

¹¹⁹ PWS at paras 89ff.

- (a) use by the defendant(s) within Singapore’s territory (or, in cases where the allegedly infringing signs are found on websites, that consumers within Singapore have been “targeted” by these websites);
- (b) in the course of trade;
- (c) in a trade mark sense;
- (d) without the consent of the plaintiff(s);
- (e) a sign which is identical or similar to the registered mark;
- (f) in relation to goods or services identical or similar to those for which the mark is registered; and
- (g) a likelihood of confusion on the part of the public.

If, for the purposes of requirements (e) and (f), there exists an identity between the sign and the mark as well as between the respective goods or services, then the claim for trade mark infringement will be made out under s 27(1) of the TMA and there is no need for the plaintiff to satisfy requirement (g) pertaining to a likelihood of confusion on the part of the public.

61 The plaintiffs raise five instances of alleged trade mark infringement:

- (a) The collective use of the DR. WHO quatrefoil device sign, the “www.drwho.com.my” sign and the “www.drwhohub.com” sign on the Commercial Vehicles and the use of the DR. WHO quatrefoil device sign on Driver A’s Attire;¹²⁰

¹²⁰ SOC at pp 33-41.

- (b) The use of the “www.drwho.asia” sign on the Cartons displayed for sale at IKEA Alexandra and IKEA Tampines;¹²¹
- (c) The use of the DR. WHO quatrefoil device sign, the copyright notice “© DR. WHO (S) PTE LTD” (“the Copyright Notice”), the meta-title “DR. WHO (M) SDN. BHD.” on the “www.drwho.com.my” website¹²² and the meta-title “DR. WHO (S) PTE LTD” on the “www.drwho.asia” website;¹²³
- (d) The use of the DR. WHO quatrefoil device sign and the “Dr Who Malaysia” sign on the DR. WHO (M) Facebook page;¹²⁴ and
- (e) The use of the corporate name “DR. WHO (S) Pte Ltd” by the fourth defendant.¹²⁵

62 Before addressing these instances of infringement, I deal with three material aspects of the plaintiffs’ case.

63 First, despite the plaintiffs’ claims, no attempt was made in their submissions to compare (a) the goods or services in relation to which the various allegedly infringing signs were used with (b) the specifications that the DR. WHO quatrefoil device mark is registered for. The DR. WHO quatrefoil device mark is registered in respect of “water treatment units” in Class 11 and “the treatment of water” in Class 40.¹²⁶ In the context of infringement proceedings,

¹²¹ SOC at pp 43-45.

¹²² SOC at pp 40-41.

¹²³ SOC at pp 44-45.

¹²⁴ SOC at p 41, para (n).

¹²⁵ SOC at p 45.

¹²⁶ SOC at pp 11-12.

the task of the court is to engage in a comparison between the actual goods or services in relation to which the allegedly infringing signs were used, and the specifications of the trade mark(s) on the other: *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2013] 1 SLR 531 (“*Sarika*”) at [46]. The burden therefore lies with the plaintiffs to prove that the infringing signs were used in relation to goods or services similar or identical to either “water treatment units” or “the treatment of water”.

64 The plaintiffs’ submissions on this matter are, however, regrettably threadbare. They amount only to an unsubstantiated assertion that such similarity or identity of goods or services exists vis-à-vis the DR. WHO quatrefoil device mark and the infringing signs simply by way of the fact that both the plaintiffs and the defendants are “suppliers of bottled water with label design and personalised branding”.¹²⁷ I cannot accept this assertion. There is no evidence to show that the defendants had used the various signs in relation to the supply of “water treatment units”, “the treatment of water” or any other similar goods or services. Accordingly, the plaintiffs fail to discharge their burden of proof in relation to the similarity of goods or services registered under the DR. WHO quatrefoil device mark. The infringement claims in relation to the DR. WHO quatrefoil device mark must therefore be dismissed in their entirety.

65 Second, I deal with the plaintiffs’ infringement claim in relation to the DR. WHO services mark, which is registered in respect of the “delivery of bottled water to homes and offices” and “water supply services” in Class 39. The plaintiffs do not explain the similarity between this specification and the

¹²⁷ PWS at para 92.

defendants’ actual use of the allegedly infringing signs. Instead, the plaintiffs simply state in their submissions that:¹²⁸

“The field of activities of the Plaintiffs and the Defendants are exactly the same in that *both are in the business of supply of bottled water with personalised branding in Singapore*; the Defendants’ conduct in the acts of misrepresentation as stated at paragraphs 41 to 79 above would inevitably cause and/or is likely to cause confusion to the relevant sector of the public.”

[emphasis added]

For the avoidance of doubt, nothing in “paragraphs 41 to 79” in the plaintiffs’ submissions deals with this issue either.

66 There is no evidence before me to show that the defendants were offering such delivery services (or any other similar services) to the public in Singapore under the allegedly infringing signs. For instance, the PI Report indicates that Vehicle A was seen at the first plaintiff’s office address¹²⁹ and Global Water’s old and new premises¹³⁰ while Vehicle B was present at Global Water’s old premises.¹³¹ However, the PI Report only captures the loading of *empty bottles* onto Vehicle A while it was present at Global Water’s premises on multiple occasions.¹³² This cannot be classified as the delivery of bottled water by these vehicles under the signs. The plaintiffs also do not direct me to content in the “www.drwho.com.my” and “www.drwho.asia” websites which indicates that such services were indeed offered by the defendants.

¹²⁸ PWS at para 81.

¹²⁹ Koh’s AEIC at p 65.

¹³⁰ Koh’s AEIC at para 79; pp 64-67.

¹³¹ Koh’s AEIC at p 63.

¹³² Koh’s AEIC at pp 1621, 1631 and 1632.

67 In addition, it appears disingenuous for the plaintiffs to point to the delivery made by Vehicle A to the premises of the first plaintiff under the signs as infringing use. This delivery, as admitted by the plaintiffs, was only made *pursuant to the orders the plaintiffs had placed*.¹³³ Plainly, the use of the signs on Vehicle A would have been with the consent of the plaintiffs. There could therefore have been no confusion on the plaintiffs' end regarding this delivery. I emphasise that this is a case where there is no evidence of the defendants offering such delivery services at all. The analysis may differ, however, if the defendants were in fact offering those services to the public and the plaintiffs simply placed (or caused to be placed) orders as evidence that such services were being offered. Instead, the delivery here was made pursuant to the longstanding commercial arrangement between the parties.¹³⁴ It would therefore be unfair to refer to this instance as evidence that the defendants had delivered bottled water to customers in Singapore. For these reasons, the plaintiffs have not proved that the allegedly infringing signs have been used in relation to identical or similar services as the specification which the DR. WHO services mark is registered for.

68 Third, I accept that the plaintiffs did not consent (expressly or impliedly) to the use of the various signs listed at [61] by the defendants ("the complained-of acts"). The defendants argue that under the provisions of the Deed, they were "at liberty" to supply bottled water in Singapore as long as it did not contain the "word marks, DR WHO".¹³⁵ While not expressly articulated, this alludes to the argument that the plaintiffs had consented to the use of certain signs, such as the "www.drwho.asia" sign and the fourth defendant's name on the Cartons,

¹³³ Notes of Evidence (6 September 2022) at p 62 line 21 to p 63 line 1.

¹³⁴ Oo's AEIC 1 at p 70.

¹³⁵ DCS at p 5.

because such use was not *expressly prohibited* by the Deed. If such consent had been given, then liability cannot attach to the complained-of acts under s 27(2) of the TMA, which requires the use of a sign “without the consent of the proprietor of the trade mark”. This may also amount to a defence against the plaintiffs’ claim in passing off, assuming other conditions are met: see Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 5th Ed, 2016) (“Wadlow”) at paras 9-106–9-108. In my view, however, a finding of such consent is not borne out by a proper interpretation of Clause 2.3 of the Deed.

69 Two competing interpretations of Clause 2.3 present themselves. The first interpretation is that Clause 2.3(2) provides for a distinct contractual obligation from Clauses 2.3(3) and 2.3(4). These provisions are reproduced below for ease of reference:

(2) Neither party shall use the DR. WHO trademark in the other Party’s Country without the prior written approval of each party.

(3) [Mr Oo, Mdm Low and/or the first defendant] shall not, without the prior written approval of [the Dr. Who Group] whether directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Singapore bearing or under the “DR. WHO” mark registered in Malaysia and/or by way of passing off.

(4) [Mdm Tan, Mr Koh and/or the Dr. Who Group] shall not, without the prior written approval of [the first defendant] whether directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Malaysia bearing or under the “DR. WHO” mark registered in Singapore and/or by way of passing off.

Under the first interpretation, the phrase “use the DR. WHO trademark” seems to refer to the use of *any mark* bearing the words “DR. WHO”. This follows from the fact that the surrounding provisions (Clauses 2.3(3) and 2.3(4)), which provide the context, make express reference to a “registered” mark – specificity

which is conspicuously absent in Clause 2.3(2). Assuming Clause 2.3(2) provides for a distinct contractual obligation from Clauses 2.3(3) and 2.3(4), the word “use” in Clause 2.3(2), as further elaborated at [203] below, should also be understood to include acts involving the “DR. WHO trademark” *beyond* the direct or indirect supply of bottled water referenced in Clauses 2.3(3) and 2.3(4). On this reading of Clause 2.3, the complained-of acts, *eg*, the defendants’ use of the DR. WHO quatrefoil device sign, the “www.drwho.asia” sign and the fourth defendant’s name on the Commercial Vehicles, the Cartons and the websites, would ostensibly fall foul of Clause 2.3(2). In the absence of clear indications to the contrary, the plaintiffs could not have consented to acts which amount to a breach of the Deed. Liability under s 27(2) of the TMA may therefore still attach to the complained-of acts.

70 Under the second interpretation, Clause 2.3(2) is qualified by Clauses 2.3(3) and 2.3(4). This views Clauses 2.3(3) and 2.3(4) as circumscribing the specific instances of “use” which are prohibited under the Deed. In other words, Clauses 2.3(3) and 2.3(4) serve as *explanations* of Clause 2.3(2). The interpretation of the word “use” in Clause 2.3(2) is thus narrowed to the *supply* of bottled water bearing or under the registered trade marks and/or by way of passing off. Adopting this interpretation of Clause 2.3(2) read with Clause 2.3(3), however, leads to the same conclusion that there was no consent provided by the plaintiffs. The wording of Clause 2.3(2), read with Clause 2.3(3), only serves to *restrict* the defendants from carrying out certain acts. Even if the complained-of acts are not strictly prohibited by the contractual scope of Clause 2.3(2) read with Clause 2.3(3), it does not follow that the Deed goes further to provide consent for the defendants to use other signs containing the words “DR. WHO” or to use the registered trade marks on goods or services besides the “supply” of bottled water. The Deed does not, in

its terms, provide any form of express consent or reflect which forms of conduct the parties have agreed to be *permissible*. Pertinently, the defendants also do not plead or argue for any specific construction of Clauses 2.3(2) and/or 2.3(3). They have not, for example, argued that the plaintiffs have impliedly consented to the defendants' use of the various signs in Singapore by way of an implied term or otherwise. In these circumstances, I am of the opinion that the Deed does not provide consent for the defendants to use the various signs listed at [61]. As such, liability under s 27(2) of the TMA is not excluded and the lawfulness of the complained-of acts falls to be assessed by the general law governing trade mark infringement and passing off in Singapore. It is therefore clear that *regardless* of which interpretation of Clause 2.3 is taken, the plaintiffs have not provided any form of consent to the complained-of acts, which form the basis of the plaintiffs' present claims for trade mark infringement and passing off.

71 Given the analysis in the preceding paragraphs, the following sections shall proceed to address the plaintiffs' claims pertaining to each alleged instance of infringement only with respect to the DR. WHO goods mark.

Infringement Claim 1: The Commercial Vehicles and Driver A's Attire

72 The following signs were allegedly used:

- (a) The DR. WHO quatrefoil device sign on the Commercial Vehicles and on Driver A's Attire;¹³⁶

¹³⁶ SOC at paras 45(a)(i) and 45(a)(iv).

- (b) The “www.drwho.com.my” sign on the Commercial Vehicles;¹³⁷
and
- (c) The “www.drwhohub.com” sign on Vehicle B.¹³⁸

According to the plaintiffs, these signs infringed the DR. WHO goods mark.

Use of the allegedly infringing signs

73 As canvassed at [60], for a claim of trade mark infringement to succeed, the trade mark proprietor must establish (a) the use of an infringing sign within Singapore’s territory, (b) in the course of trade, (c) in a trade mark sense and (d) without the consent of the proprietor.

74 On the first requirement, the plaintiffs need to prove that the allegedly infringing signs were used in Singapore pursuant to the definition of “use” found in the TMA. Section 27(4) of the TMA provides:

- (4) For the purposes of this section and sections 28, 29 and 31, a person uses a sign if, in particular, the person —
 - (a) applies it to goods or the packaging thereof;
 - (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
 - (c) imports or exports goods under the sign;
 - (d) uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or
 - (e) uses the sign in advertising.

¹³⁷ SOC at para 45(a)(ii).

¹³⁸ SOC at para 45(d)(1)(iii).

The plaintiffs argue, presumably relying on s 27(4)(e) of the TMA, that the collective use of the signs on the Commercial Vehicles and Driver A’s Attire amounts to use in “advertising”.¹³⁹

75 I do not accept that the allegedly infringing signs on Vehicles C and D were used in Singapore. The requirement that the signs need to be used in Singapore stems from the fact that trade mark rights are territorial in nature. As such, use of a sign *outside* of Singapore generally cannot constitute an infringement under our local trade mark regime. Unlike Vehicles A and B, nothing in the evidence before me indicates that Vehicles C and D entered Singapore. The only evidence relating to Vehicles C and D is contained in the following paragraph of Mr Koh’s affidavit of evidence-in-chief:¹⁴⁰

93...

(b) Subsequently, [Vehicle A] was seen driving towards Woodlands Checkpoint for entry to Johor Bahru, Malaysia between about 0950hrs to about 1018hrs, and arrived at the 1st Defendant’s registered address **at No.2A, Jalan Indah Gemilang 4, Taman Perindustrian Gemilang, Ulu Tiram, 81800 Johor, Malaysia** at about 1434hrs. Between about 1657hrs to 1709hrs, workers at **the [first defendant’s] premises** [at] were seen loading carton boxes... onto [Vehicle A]. **Further, two vehicles with Malaysian registration nos. JNY 3452 and JSX 5217 [ie, Vehicle C and Vehicle D] bore various signs on the vehicles...**

[emphasis added in bold]

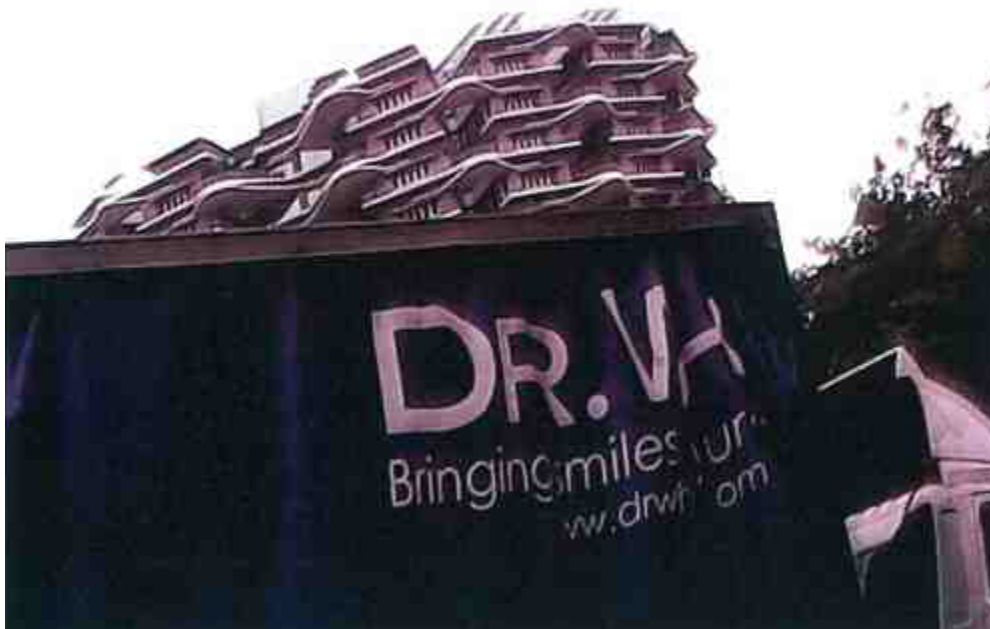
Mr Koh’s evidence does not show that Vehicles C and D were sighted *in Singapore*. Instead, it suggests that these vehicles were sighted at the first defendant’s premises in Malaysia. The absence of evidence means that the

¹³⁹ PWS at para 72.

¹⁴⁰ Koh’s AEIC at pp 60–61; para 93(b).

plaintiffs have failed to prove the use of the allegedly infringing signs on Vehicles C and D in Singapore.

76 I am also not convinced by the plaintiffs’ evidence that the allegedly infringing signs were used in a trade mark sense on Vehicle B. The requirement of trade mark use concerns how the sign interacts with and is represented on goods: *Burberry Ltd v Megastar Shipping Pte Ltd and anor* [2019] 1 SLR 536 (“*Burberry*”) at [34]. According to the PI Report, Vehicle B was only sighted once on 7 May 2019 at Global Water’s old premises over a roughly six-month surveillance period.¹⁴¹ Only the following two photographs of Vehicle B were included in the report:



¹⁴¹ Koh’s AEIC at pp 63-64.



77 These photographs show that the allegedly infringing signs, namely the DR. WHO quatrefoil device sign, the “www.drwho.com.my” sign and the “www.drwhohub.com” sign (which reflected the *plaintiffs’* website), were displayed on Vehicle B in an *incomprehensible* manner. This means that consumers who encountered the vehicle would not have been able to make out either the DR. WHO quatrefoil device sign, which sets out the name of the defendants’ undertaking, or the other two signs, which comprise the websites on which the relevant goods were displayed. Consumers would not have been directed to either the “www.drwho.com.my” website or the “www.drwhohub.com” website, and thus would not have seen the goods which the defendants and the plaintiffs are offering for sale. In other words, not only were the signs effectively not represented on any goods, but there was also no clear depiction of any source which consumers could be brought home to.

Accordingly, the manner in which these signs were represented on Vehicle B rendered them incapable of being used in a trade mark sense.

78 Nevertheless, I am satisfied that the allegedly infringing signs were used in advertising on Vehicle A in Singapore. Vehicle A was sighted at Global Water’s old¹⁴² and new premises¹⁴³ as well as the first plaintiff’s registered office address.¹⁴⁴ Vehicle A would have been visible to the general public as it would have spent periods of time on the roads travelling between Singapore and Malaysia. The placement of the signs on Vehicle A therefore served to advertise the goods which these signs were used in relation to, which were displayed in the website reflected in the “www.drwho.com.my” sign. These signs were clearly used in the trade mark sense, as they served to denote the trade origin of the goods.

79 I do not, however, accept that the sign on Driver A’s Attire was used in Singapore for the purposes of advertising under s 27(4)(e) of the TMA. This is because the sign was placed on the *back* of Driver A’s Attire and would not be visible to members of the public viewing Vehicle A while the truck was moving on the road. According to the PI Report, the driver only dismounted at Global Water’s new premises to load empty bottles onto Vehicle A¹⁴⁵. The private investigator from DP Quest (“the PI”) did not observe the driver interacting with

¹⁴² Koh’s AEIC at pp 63-64.

¹⁴³ Koh’s AEIC at pp 66-67.

¹⁴⁴ Koh’s AEIC at pp 1616, 1620 and 1631.

¹⁴⁵ Koh’s AEIC at p 1632.

anyone.¹⁴⁶ The driver returned to the defendants’ premises in Malaysia promptly after the empty bottles were loaded.¹⁴⁷

80 There is no evidence on the present facts that the sign on Driver A’s Attire was intended to be displayed to *any* segment of the public in Singapore or, indeed, that any individual other than the PI (who was conducting surveillance) even saw the sign. Based on these facts, I am satisfied that the sign on Driver A’s Attire was not used in advertising pursuant to s 27(4)(e) of the TMA.

81 As the defendants do not seriously contest that the signs on Vehicle A have been used in advertising in the course of trade, I now turn to address the identity or similarity between the signs and the registered mark.

Identity/Similarity of the signs used

82 At this stage of the inquiry, the comparison is made between the mark as registered and the sign(s): see James Mellor *et al*, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 16th Ed, 2018) (“*Kerly’s*”) at para 16-071; *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) at [50]. This is done without consideration of any external matter: *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide, Inc and anor* [2014] 1 SLR 911 (“*Staywell*”) at [20]. Three aspects of similarity are relevant: visual, aural and conceptual similarity. These aspects, however, are not to be treated as a mechanistic formula but involve the relative weighing of each aspect against the others. Similarity between the mark and the

¹⁴⁶ A. M. Navin’s Affidavit of Evidence-in-Chief dated 12 July 2022 (CD Rom video footage).

¹⁴⁷ Koh’s AEIC at p 1634.

sign may thus be made out even if not all three aspects of similarity are made out: *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another and another appeal* [2013] 2 SLR 941 (“*Hai Tong*”) at [40(a)]. This exercise is undertaken from the viewpoint of the average consumer who would exercise some care and a measure of good sense in making his or her purchases: *Hai Tong* at [40(c)]. This average consumer will also be deemed to be reasonably well-informed, reasonably observant and circumspect: *Calvin Klein, Inc and anor v HS International Pte Ltd and others* [2016] 5 SLR 1183 at [50(b)]. On the present facts, the comparison to be made is between the allegedly infringing signs and the DR. WHO goods mark.¹⁴⁸

(1) The DR. WHO quatrefoil device sign

83 I begin my analysis with the DR. WHO quatrefoil device sign which was present on Vehicle A. The comparison here is between the following:



Figure 1: The DR. WHO quatrefoil device sign

and



Figure 2: The DR. WHO goods mark

84 I first assess the distinctiveness of the DR. WHO goods mark. The distinctiveness of a mark refers to its ability to serve as a badge of origin for specific goods or services: *Hai Tong* at [28]. It plays an integral role in the

¹⁴⁸ Koh’s AEIC at para 26.

marks-similarity inquiry. A mark which bears greater distinctiveness will enjoy a higher threshold before a competing sign will be considered dissimilar to it: *Staywell* at [25]. Distinctiveness may arise either because the words used in a mark are completely inventive and meaningless or because even though they may have a meaning, they are used in a way that is completely arbitrary vis-à-vis the goods or services in question: *Hai Tong* at [31].

85 With regard to the DR. WHO goods mark, I am satisfied that “DR. WHO” is a purely inventive term that is made up and has no meaning at all. The word “DR.” is a prefix accorded to individuals who serve as doctors; the word “WHO” is an interrogative pronoun used typically in questions to enquire on the identity of a person. Taken together, the term “DR. WHO” bears no meaning by itself, as “WHO” appears to be used as a proper noun (the last name of a doctor) rather than as an interrogative pronoun. While the term “DR. WHO” may call to mind a popular television series, this has no discernable correlation to bottled or drinking water. The DR. WHO goods mark is therefore distinctive in so far as it is capable in effectively distinguishing the origin of the goods in question. It follows that the threshold to find that an allegedly infringing sign is *dissimilar* to the DR. WHO goods mark is high, and the distinctiveness of this mark will be accordingly integrated in the marks-similarity analysis which follows in this judgment (see *Staywell* at [30]).

86 One can hardly argue that the DR. WHO quatrefoil device sign is not similar to the DR. WHO goods mark (and the defendants rightly did not argue so). Apart from aural identity, the registered mark and the sign are also visually similar. Both the dominant components of the registered mark and the sign comprise the term “DR. WHO” in block letters. The slight differences in terms of font are also immaterial as the registration of a word in block letters covers the use of that word in any clearly legible form of lettering: *Sarika* at [24] citing

Morny Ld's Trade Marks, in the Matter of (1951) 68 RPC 131 at 149–150. The presence of the quatrefoil-droplet device also does not militate against similarity when the mark and the sign are observed in totality as the element only appears as a relatively small and simple symbol at the end of the sign and is likely to be perceived only as a decorative element: see *Hai Tong* at [62(e)(i)]–[62(e)(vi)].

87 On conceptual similarity, the court must consider the ideas which lie behind or inform the mark or sign in question: *Hai Tong* at [70]. It is not immediately apparent what concepts the term “DR. WHO” may impart, though the prefix “DR.” may bring forth the concept of medical doctors and/or healthcare. I do not consider that the quatrefoil-droplet element present in the DR. WHO quatrefoil device sign adds or changes the conceptual nature of the sign. As both the sign and the mark are made up of the same term “DR. WHO”, they must logically contain the same concepts. I find, therefore, that there is conceptual similarity between the DR. WHO quatrefoil device sign and the DR. WHO goods mark.

88 In the round, the DR. WHO quatrefoil device sign and the DR. WHO goods mark are similar.

(2) The “www.drwho.com.my” sign

89 I turn now to the “www.drwho.com.my” sign which was used on Vehicle A.¹⁴⁹ The comparison here is between the following:

www.drwho.com.my

Figure 3: The “www.drwho.com.my” sign

and

¹⁴⁹ SOC at para 45(a)(ii).



Figure 4: The DR. WHO goods mark

90 The plaintiffs’ case is that the “www.drwho.com.my” sign is similar to the DR. WHO goods mark. The plaintiffs do not elaborate on this assertion of similarity, though it is presumed that it is the use of the term “drwho” that the plaintiffs take issue with.

91 Given that the “www.drwho.com.my” sign relates to a website address, an understanding of how the average consumer perceives the constituent “parts” of a website address (*ie*, domains) will be helpful in deciding if the “www.drwho.com.my” sign and the DR. WHO goods mark are similar. To this end, I borrow the helpful explanation in Christopher Morcom, Ashley Roughton & Thomas St Quintin, *The Modern Law of Trade Marks* (LexisNexis, 5th Ed, 2016) at para 17.9:

Domain names can themselves be broken down into constituent parts. A top-level domain (‘TLD’) identifies the most general part of the domain name in an internet address. A TLD is either a generic top-level domain such as ‘com’, which is short for ‘commercial’, or ‘edu’ for ‘education’ and so on. In addition a TLD may be a country code, such as ‘uk’ for the United Kingdom or ‘ie’ for Ireland. Also a domain name will contain a second-level domain (‘SLD’) which identifies the specific and unique administrative owner associated with an Internet Protocol address. To take an example, in the URL <http://www.bbc.com>, the word ‘bbc’ is the SLD and the ‘com’ is the TLD.

In the course of my analysis, I will adopt the acronyms for top-level domains (“TLDs”) and second-level domains (“SLDs”) used in the excerpt above.

92 Beginning with visual similarity, the dominant component of the “www.drwho.com.my” sign is its SLD, *ie*, “drwho”. This follows from the fact

that the SLD identifies the “specific and unique administrative owner” associated with the address. Here, the SLD is visually similar to the DR. WHO goods mark. Both are made up of the same letters comprising the term “DR. WHO”. The fact that the SLD comprises letters in the lower-case while the DR. WHO goods mark comprises entirely capitalised letters is immaterial as a word mark registered in block letters covers the use of the relevant words in all legible forms of lettering and must not be confined to the mark’s representation in block capital letters: *Sarika* at [24]. The absence of the full-stop after the letters “dr” in the sign is also irrelevant. This is because full-stops (or dots) in a website address serve to separate subdomains. In other words, the functionality of the website address necessarily prevents the inclusion of the full-stop (or the dot). For the same reason, the lack of a space between the letters “dr” and “who” does not make a material difference, as a website address cannot function with an intervening space.

93 I am also not of the view that the TLD in the “www.drwho.com.my” sign (*ie*, “.com.my”) displaces the visual similarity between the dominant components of the sign and the mark. Some guidance may be gleaned from the English cases which deal with the infringement of registered trade marks by website addresses. In *Argos Ltd v Argos Systems Inc* [2017] EWHC 231 (Ch), the English High Court accepted at [8] and [37] that the infringing sign “Argos” used in the form of a website address (“www.argos.com”) was similar to the registered mark “ARGOS”. Similarly, in *Tesco Stores Ltd v Elogicom Ltd and anor* [2006] EWHC 403 (Ch) (“*Tesco*”), the English High Court held at [33] that signs in the form of website addresses, including “www.tesco2u.co.uk”, “www.tescodiet.com” and “www.tesco-jersey.com”, were similar to the registered marks “Tesco” and “Tesco.com”. These cases support the finding that the focus in a website address is on the SLD. It follows that the mere addition

of a TLD or the use of a different TLD will typically be insufficient to render a sign comprising a website address dissimilar (visually or otherwise) to a registered mark (assuming such similarity is already established with the SLD). Therefore, despite the difference occasioned by the TLD in the “www.drwho.com.my” sign, it is my view that this sign is visually similar to the DR. WHO goods mark.

94 Similarly, the SLD of the “www.drwho.com.my” sign (“drwho”), which comprises its dominant component, is aurally identical to the DR. WHO goods mark. This is so because the five-letter term “drwho” cannot be comprehended in any other reasonable manner except to denote the words “DR. WHO”. While the TLD of the “www.drwho.com.my” sign adds a further aural component, I do not find this to be a significant difference, as evidenced from the conclusions made in the English cases above. The sign therefore bears aural similarity with the DR. WHO goods mark.

95 On conceptual similarity, I reiterate my finding above that the term “DR. WHO” appears not to have any inherent meaning but evokes the concepts of medical doctors or healthcare given the use of the prefix “DR”. Both the dominant components of the “www.drwho.com.my” sign (*ie*, its SLD “drwho”) and the DR. WHO goods mark share this conceptual feature. As no other ideas or concepts are contained within the sign and the mark, I find them to be conceptually similar.

96 For these reasons, I am satisfied that the “www.drwho.com.my” sign and the DR. WHO goods mark are similar.

Identity/Similarity of goods

97 Given my findings above that the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign are similar to the DR. WHO goods mark, I now consider whether these two signs were used in relation to goods identical or similar to those for which the mark is registered.

98 But what goods were the signs used in relation to? It bears emphasising that for the purposes of trade mark infringement, the signs must be used as indications of origin. This is because the inherent function of trade marks is to bring consumers home to the source of the goods or services in question: see *Nation Fittings (M) Sdn Bhd v Oystertec plc and another suit* [2006] 1 SLR(R) 712 at [62]. The underlying legal principle is therefore that a sign is used in relation to goods or services if an average consumer perceives the sign to be applied in that manner: *Kerly’s* at paras 16-038 and 16-040.

99 On the facts, Vehicle A bore the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign.¹⁵⁰ The “www.drwho.com.my” sign was displayed directly beneath the DR. WHO quatrefoil device sign. The average consumer viewing the signs would therefore understand that the actual goods which were being advertised under these two signs were those found on the website reflected in the “www.drwho.com.my” sign. Upon entering the website, one would see that the signs in fact related to the provision of water in various receptacles with or without customised labels. In my view, the fact that the average consumer needs to carry out an additional act (*ie*, accessing the website) does not prevent him or her from understanding that the signs on Vehicle A were used in relation to the goods found on the website. The average consumer

¹⁵⁰ SOC at para 45(a).

possessing a measure of good sense (*Hai Tong* at [40(c)]) would be exposed to some degree of transit advertising and would therefore recognise that the speed at which vehicles move may not afford consumers enough time to peruse the goods offered for sale under the signs. Instead, the placement of a website alongside a sign *directs* consumers to access the website in order to gain information on the particular goods offered under the sign.

100 The question, then, is whether the goods (as reflected on the website) are similar or identical to the goods for which the DR. WHO goods mark is registered – Class 32 (for bottled water [not for medical purposes]; oxygenated water; drinking water; aerated water; waters [beverages] other than for medical purposes). The “www.drwho.com.my” website indicates that the defendants are “a key player in the drinking water industry” and that their “core business revolves around customised branding of PET bottles, Tetra Pak and aluminum [*sic*] cans based on individual clients’ requirements”. These goods are identical to the goods in respect of which the DR. WHO goods mark is registered. Given this identity between the goods in question, there is no further need to consider whether they are similar or the extent of their similarity: *Staywell* at [42] citing Susanna Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2012) at paras 28.354 and 28.358.

Likelihood of confusion

101 At this stage of the inquiry, what has to be established is a likelihood of confusion as to the origin of the goods in question. Confusion may either be direct, where the mark(s) and the sign(s) are mistaken for each other by the average consumer, or indirect, in which the similarities lead the average consumer to form the mistaken view that they originate from the same or linked undertakings: *Kerly’s* at para 16-091; *Hai Tong* at [73]. This inquiry is

undertaken from the same viewpoint as that for the inquiry on mark-similarity – that of the average consumer: *Hai Tong* at [40(c)]. The likelihood of confusion that is required is that to be expected amongst a substantial portion of the relevant public. This need not amount to a majority but must go beyond a “de minimis” level: *Hai Tong* at [78(e)] citing *Sarika* at [57]. The relevant public comprises the actual or potential purchasers of the goods in question, and those who deal with these goods: Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 3rd Ed, 2022) at para 21.5.27. This will include the actual or potential purchasers of the goods of the plaintiff and the defendant: see *Digi International v Teraoka Seiko Co, Ltd* [2021] SGHC 165 (“*Digi*”) at [174].

102 In *Staywell*, the Court of Appeal held at [95] that the factors that may generally be taken into account in this inquiry are those intrinsic to the nature of the goods or services and/or which affect the impact that the similarity of the marks and the goods/services has on the consumer. The court proceeded to set out a non-exhaustive list of these factors at [96]:

- (a) Factors relating to the impact of mark-similarity on consumer perception:
 - (i) degree of similarity of the mark themselves;
 - (ii) the reputation of the marks;
 - (iii) the impression given by the marks; and
 - (iv) the possibility of imperfect recollection of the marks.
- (b) Factors relating to the impact of goods/services-similarity on consumer perception:

- (i) the normal way in or the circumstances under which consumers would purchase goods/services of that type;
- (ii) the price of the goods/services (as opposed to the price disparity between the competing goods);
- (iii) the nature of the goods/services and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers; and
- (iv) the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase.

103 I assess the likelihood of confusion arising from the use of the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign on Vehicle A (as displayed below).



The relevant public here will comprise consumers who have seen the signs and visited the “www.drwho.com.my” website. These consumers may be categorised into two further classes: (a) the potential end users of the plaintiffs’ and the defendants’ goods as well as (b) traders who are potential customers of the plaintiffs and the defendants (see, eg, *Hearst Holdings Inc v AVELA Inc* [2014] EWHC 439 (Ch) at [72]–[75]). The level of attention and care paid by the average consumer in each class will differ based on the knowledge, experience and purchase involvement of the relevant class: *Kerly’s* at para 3-016. While traders are likely to pay a higher degree of attention and care toward their purchases, this does not, on the present facts, affect the analysis pertaining to the confusion inquiry.

104 I take as a starting point my findings above that the DR. WHO goods mark is similar to the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign. The likelihood of confusion arises upon the average consumer in both classes viewing the goods for sale on the website reflected in the “www.drwho.com.my” sign. These goods, as mentioned at [100], are identical to the goods which the DR. WHO goods mark is registered for. The home page of the “www.drwho.com.my” website also indicates that the defendants’ undertaking serves clientele in both Singapore and Malaysia. At this point, the relevant public will be under the impression that the goods which are advertised under the signs originate from the *Malaysian branch* of the undertaking operating under the registered mark.

105 Taken together, these factors would point the average consumer from each class of the relevant public to the proprietor of the DR. WHO goods mark in Singapore as the source of the goods advertised under the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign, as reflected on the website. Given that the high degree of similarity between the mark and the signs

as well as the identity of the respective goods are sufficient to lead to a likelihood of confusion, there is no need for me to consider the other factors laid out by the Court of Appeal in *Staywell* at [96].

106 Accordingly, the plaintiffs’ claim that the use of the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign on Vehicle A constitutes infringement of the DR. WHO goods mark succeeds under s 27(2) of the TMA.

Infringement Claim 2: The Cartons sold at IKEA Alexandra and IKEA Tampines

107 I turn to the next category of the infringement claims, *ie*, the Cartons offered for sale at IKEA Alexandra and IKEA Tampines.¹⁵¹ The plaintiffs’ pleaded claim here pertains solely to the display of the “www.drwho.asia” sign at the bottom of the Cartons.¹⁵² For ease of reference, I reproduce a photograph of one of the Cartons here:

¹⁵¹ Koh’s AEIC at paras 93(t)-(u).

¹⁵² PWS at paras 51, 54 and 92. Notes of Evidence (6 September 2022) at p 31 lines 14 to 17.



Use of the allegedly infringing sign

108 As previously stated at [60], the trade mark proprietor must establish (a) use of the infringing sign within Singapore’s territory, (b) in the course of trade, (c) in a trade mark sense and (d) without the consent of the proprietor. Here, the “www.drwho.asia” sign was applied directly to the Cartons which were sold in Singapore – this fulfils the requirement of use under s 27(4)(a) of the TMA. I have also accepted at [68] that the application of this sign was done without the consent of the plaintiffs.

109 I am of the opinion that the “www.drwho.asia” sign was used in the course of trade. The phrase “in the course of trade” refers to the alleged infringer’s trade and simply means that the alleged infringer used the sign for commercial purposes rather than for non-commercial purposes: *Burberry* at [30]. In short, this covers any economic activity involving the use of the goods. This position echoes that in the UK, which requires use in the context of a commercial activity with a view to economic advantage, and not as a private matter: *Kerly’s* at para 16-033. The learned authors of *Kerly’s* provide a further explanation at para 16-035 that it is no answer to an allegation of infringement that the purpose of the mark is to show a business connection with a foreign manufacturer entitled to use the mark in their own country, and not with the local owner of the mark.

110 Here, the evidence demonstrates that the sign was used in the course of trade. On the Cartons, the sign was listed in the fine print under the section of the text that, from top to bottom, begins with “Distributed by” and includes other information pertaining to the first defendant.¹⁵³ This identified the first defendant as the distributor of the Cartons and directed consumers to the first defendant’s website to obtain further information on its business. The Cartons were also the subject of the commercial contract between IKEA and the fourth defendant. Given these circumstances, it is clear that the “www.drwho.asia” sign was used in the course of trade.

111 Whether the sign was used in a trade mark sense also warrants some analysis. This turns on whether the sign was used “as a trade mark”, in that it indicates that the origin of the goods is the trade mark proprietor: *Burberry* at [32]. I make two points on this issue.

¹⁵³ Koh’s AEIC at p 1862.

112 First, the fact that the “www.drwho.asia” sign may not have been used as a primary identifier of the Cartons does not prevent the sign from denoting the trade origin of the Cartons. Indeed, secondary or even third-level product identifiers can function as trade marks if they indicate to the consumer that the product in question originates from a particular undertaking: *Richemont International SA v Da Vinci Collections Pte Ltd* [2006] 4 SLR(R) 369 at [14]. As such, even though the Cartons may be primarily identified by the signs printed on the front of the Cartons (“DRICKSVATTEN” and the “IKEA” logo),¹⁵⁴ this does not detract from the use of the “www.drwho.asia” sign in denoting trade origin and being used in a trade mark sense.

113 Second, the fact that the sign was used in a trade mark sense is evident from the larger context surrounding its use. The sign was applied to the Cartons together with the text “Distributed by” as well as various pieces of information regarding the defendants’ undertaking. This indicates to the average consumer that the “www.drwho.asia” sign is related to the undertaking stated as the distributor. Moreover, in the absence of further details regarding the manufacturer of the Cartons, the indicated distributor would be taken to be the trade origin of the Cartons. The average consumer would have therefore understood the source of the Cartons to be the distributor, *ie*, the undertaking using the “www.drwho.asia” sign.

Similarity of the sign used

114 In terms of the website reflected in the “www.drwho.asia” sign, the comparison here is between the following:

¹⁵⁴ Koh’s AEIC at p 1864.

www.drwho.asia

Figure 5: The “www.drwho.asia” sign

and

DR. WHO

Figure 6: The DR. WHO goods mark

115 The analysis follows a similar course as that regarding the “www.drwho.com.my” sign at [89]–[96] above. The visually dominant aspect of the domain name is the SLD “drwho”, which shares visual similarity with the DR. WHO goods mark. The SLD and the DR. WHO goods mark also share a common aural component (“doctor who”).

116 In terms of conceptual similarity, the dominant component of the domain name comprised in the “www.drwho.asia” sign (*ie*, the SLD “drwho”) on one hand, and the DR. WHO goods mark on the other bring forth identical concepts as I have observed above in relation to the “www.drwho.com.my” sign (at [95] above). At the same time, the TLD of the “www.drwho.asia” sign (“.asia”) suggests that the domain name is one registered in or targeted at users in Asia. While this is not a concept which the DR. WHO goods mark imports, it does not detract from the conceptual similarity which the dominant components of the mark and the sign share. Indeed, the idea of a business with a regional presence in Asia may well include a business operating in Singapore.

117 Assessing the three aspects of similarity holistically, I find that the “www.drwho.asia” sign is similar to the DR. WHO goods mark.

Identity/Similarity of goods

118 It is clear that the “www.drwho.asia” sign was used in relation to the Cartons. As such, the comparison must be made between this actual use and the specification for which the DR. WHO goods mark is registered. As the Cartons are receptacles for drinking water, I accept that the “www.drwho.asia” sign was used in relation to “drinking water”. There is therefore an identity of goods between the Cartons and the specification of the DR. WHO goods mark.

Likelihood of confusion

119 I turn to the confusion inquiry. The similarity of the sign and the mark as well as the identity of the goods supplied under them favour a finding of a likelihood of confusion.

120 In addition, as alluded to earlier at [102], extraneous factors may be considered if they inform the court as to how the similarity of marks and goods will likely affect the consumer’s perception as to the source of the goods. Permissible factors include the purchasing practices and degree of care paid by the consumer when acquiring goods of the sort in question: *Staywell* at [95]. The question here is whether these factors support a finding of confusion among a substantial portion of the relevant public (see [101]).

121 With respect to the Cartons, I accept that the relevant public likely consisted of three main segments. The first segment consisted of customers who purchased the Cartons to satisfy their immediate need (*ie*, to quench their thirst). These customers unlikely paid much attention to the source of the Cartons. The second segment consisted of customers who were inclined to pay a higher degree of attention to the sign affixed to the Cartons. These customers were more concerned with the quality of the drinking water as indicated by the source

on the Cartons, because such quality had the potential to affect their health directly. The third segment comprised customers who purchased the Cartons to satisfy a future need (*ie*, for future consumption). These customers were more likely to peruse the signs on the Cartons because of the simple fact that they were in possession of these Cartons for a longer period of time.

122 In my view, the customers who made up the second and third segments would have formed a sufficiently substantial portion of the general body of customers that patronised IKEA Tampines and IKEA Alexandra. In other words, the average consumer likely paid a high degree of attention to the Cartons, including the “www.drwho.asia” sign and the other information under the heading “Distributed by”. When they saw the sign on the Cartons, they would have understood the source of the Cartons to be the undertaking which was using the sign. Consumers would likely have confused this undertaking with the proprietor of the DR. WHO goods mark. Even if the consumers entered the website reflected in the sign, the reference on the home page to “clientele around Malaysia and Singapore” would have reinforced the incorrect impression that the undertaking using the “www.drwho.asia” sign on the Cartons was linked to the proprietor of the DR. WHO goods mark. For these reasons, I am satisfied that a likelihood of confusion has been made out among the relevant public and the plaintiffs’ DR. WHO goods mark has been infringed by the defendants’ use of the “www.drwho.asia” sign on the Cartons.

Infringement Claim 3: The “www.drwho.com.my” and “www.drwho.asia” websites

123 The plaintiffs claim that the use of the DR. WHO quatrefoil device sign,¹⁵⁵ the Copyright Notice (“© 2020 DR. WHO (S) PTE LTD”),¹⁵⁶ the meta-title (“DR. WHO (S) PTE LTD”)¹⁵⁷ on the “www.drwho.asia” website and the meta-title (“DR. WHO (M) SDN. BHD.”) on the “www.drwho.com.my” website infringed the DR. WHO goods mark. I address the elements of the claim in turn.

Use of the allegedly infringing signs

124 One of the main issues pertaining to the use of the allegedly infringing signs on the websites is whether these signs have been used in Singapore.¹⁵⁸ As V K Rajah JA observed in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 (“*Amanresorts*”) at [52], citing the famous observations of Jacob J in *800-FLOWERS Trade Mark* [2000] FSR 697 (“*800-FLOWERS*”):

... More importantly, it must be noted that although the Internet has the potential to be used for giving goods, services and businesses instant exposure across the entire world, it does not follow that any small, dinky business can set up a website and then claim that it has gained worldwide recognition. The Internet’s power of exposure is only a *potential* power... [In *800-FLOWERS*], ... Jacob J observed very sensibly (at 705):

Mr Hobbs [counsel for the applicant] submitted that any use of a trade mark on any website, wherever the owner of the site was, was potentially a trade mark infringement anywhere in the world because website use is in an omnipresent cyberspace: that placing a trade mark on a website was ‘putting a tentacle’ into the computer user’s premises. I questioned this with an

¹⁵⁵ PWS at para 53.

¹⁵⁶ Koh’s AEIC at para 93(v)(viii).

¹⁵⁷ SOC at pp 41 and 45.

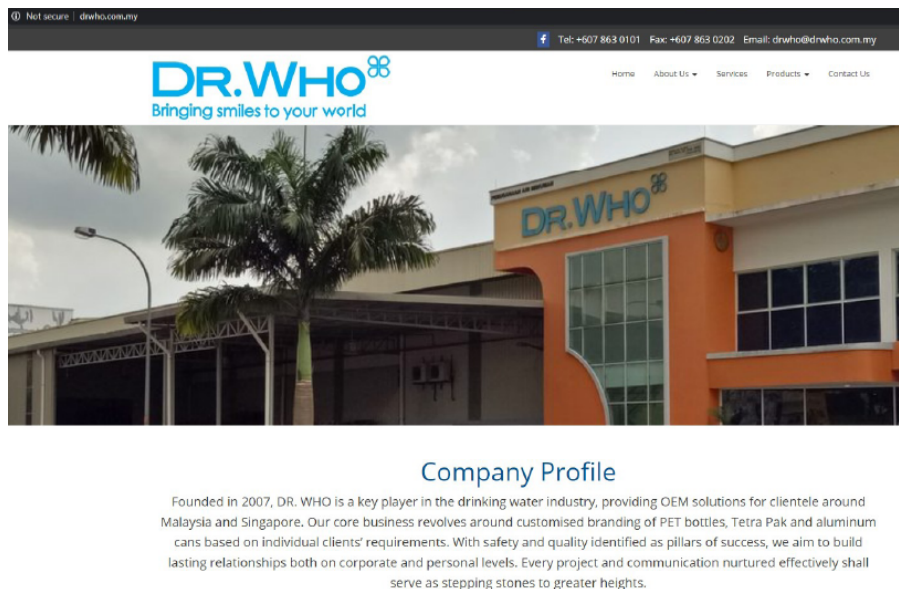
¹⁵⁸ This was briefly alluded to at PWS at para 60.

example: a fishmonger in Bootle who puts his wares and prices on his own website, for instance, for local delivery can hardly be said to [be] trying to sell the fish to the whole world or even the whole country. And if any web surfer in some other country happens upon that website he will simply say ‘this is not for me’ and move on. For trade mark laws to intrude where a website owner is not intending to address the world but only a local clientele and where anyone seeing the site would so understand him would be absurd. So I think that *the mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world.*

[emphasis added]

125 While the Court of Appeal’s observations were made in the context of a claim in passing off, it was acknowledged that this principle also applied in the trade mark context (see *Amanresorts* at [53]). In other words, evidence of (a) the existence of the websites featuring allegedly infringing signs or (b) mere access of the websites by consumers in Singapore will be insufficient to show that consumers in Singapore have been targeted by the websites, and thus that the signs on these websites have been “used” in Singapore. The courts search for something more, such as direct encouragement or advertisement toward these consumers. Relevant factors include the geographical areas to which the proprietor of the website is willing to supply the goods, the nature and size of the trader’s business, the characteristics of the relevant goods or services and the number of visits made to the website by consumers in the jurisdiction: *Merck KGaA v Merck Sharp & Dohme Corp and ors* [2017] EWCA Civ 1834 at [166]–[170]. The plaintiffs must therefore show that the allegedly infringing signs on the “www.drwho.com.my” and the “www.drwho.asia” websites have targeted consumers in Singapore in this manner.

126 The evidence at hand supports the finding that the two websites have indeed targeted consumers in Singapore. The home pages of the two websites are identical and are displayed as follows:



127 For ease of reading, I set out the text under the header “Company Profile” here:

Founded in 2007, DR. WHO is a key player in the drinking water industry, *providing OEM solutions for clientele around Malaysia and Singapore. Our core business revolves around customised branding of PET bottles, Tetra Pak and aluminum [sic] cans based on individual clients’ requirements.* With safety and quality identified as pillars of success, we aim to build lasting relationships both on corporate and personal levels. Every project and communication nurtured effectively shall serve as stepping stones to greater heights.

[emphasis added]

128 This excerpt appears to invite and boast of “clientele” not just in Malaysia, but *also in Singapore*. In my view, the average consumer in Singapore looking at these websites and having regard to this text would understand that

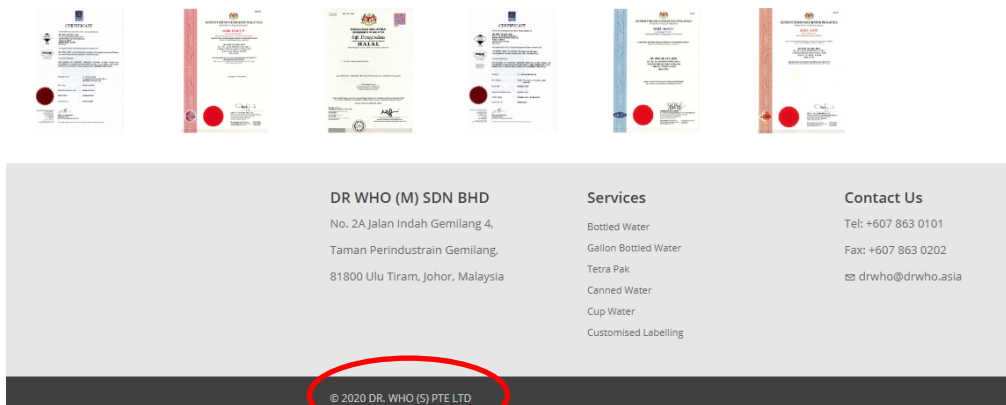
the provision of “OEM solutions” and “customised branding of PET [polyurethane] bottles, Tetra Pak and aluminum [*sic*] cans” was being offered to customers in Singapore. The “www.drwho.com.my” website would have been brought to the attention of consumers in Singapore through its display on Vehicle A, which entered Singapore at various junctures in 2019. Similarly, consumers in Singapore would have encountered the “www.drwho.asia” website through its placement on the Cartons.

129 While the TLD “.my” may have indicated to the average consumer in Singapore that the “www.drwho.com.my” website was *prima facie* targeted at consumers in Malaysia, the fact that the home page alludes to clientele *in Singapore* and Malaysia would have dispelled such preliminary notions. The TLD “.asia” in the “www.drwho.asia” website further supports the view that the defendants operated in *both* Singapore and Malaysia. As such, the consumer would have understood the defendants to be willing to sell their goods to Singapore consumers. I am therefore convinced that the two websites targeted consumers in Singapore by offering the defendants’ goods to them. This means that the allegedly infringing signs on the websites were thus “used” for the purposes of s 27(4)(b) of the TMA through the offering of goods under these signs.

130 Another pertinent issue is whether these signs have been used in the “trade mark sense”. I take the view that the Copyright Notice did not constitute such use. The Copyright Notice appeared at the bottom of the “www.drwho.asia” and the “www.drwho.com.my” websites in relatively small font:¹⁵⁹

¹⁵⁹ PWS at p 26.

Our Certifications

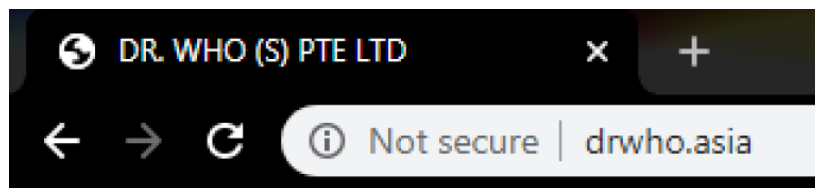


131 The Copyright Notice was presumably used to declare that ownership over the copyright in the websites’ content belonged to the entity “DR. WHO (S) PTE LTD”. But that, alone, does not speak to the trade origin of any goods. The work in which the copyright subsists is *distinct* from the goods which the allegedly infringing signs are used in relation to. Similarly, in *Reed Executive plc and another v Reed Business Information Ltd and others* [2004] EWCA Civ 159 (“*Reed v RBF*”), Jacob LJ considered whether the use of a copyright notice “© [YEAR] REED BUSINESS INFORMATION LTD” on the website owned by the defendant infringed the plaintiff’s word mark “Reed”. Jacob LJ expressed doubt as to whether the copyright notice could constitute a badge of origin (at [93]):

The only purpose of the use was to make an explicit claim to copyright. Although this is not required to ensure copyright protection under UK law or those of other Berne Convention countries, such a claim is necessary for US (and possibly other) laws. The use was not intended to have the effect of designating origin and was kept as minimal as possible, serving as it did, no trade or promotional purpose. For much of the time the use was at the bottom of the homepage which in practice meant that the user had to scroll down to see it at all. It would have been no interest to either jobseekers or employers, the “average consumers” of the site.

132 For this reason, I dismiss the plaintiffs’ infringement claim in relation to the use of the Copyright Notice on both websites. In any case, the Copyright Notice has, at the time of this judgment, been amended to reflect the name of the first defendant.

133 On the contrary, the two meta-title signs as well as the DR. WHO quatrefoil device sign would have been viewed by the average consumer as denoting the source of the goods listed on the websites. The meta-title of the “www.drwho.asia” website appeared as follows:¹⁶⁰



It is noted that at the time of this judgment, the meta-title of the “www.drwho.asia” website has been changed to “DR. WHO (M) SDN BHD”. The analysis will, however, proceed with respect to its earlier meta-title, “DR. WHO (S) PTE LTD”, as that remains the plaintiffs’ pleaded case. On the other hand, the “www.drwho.com.my” website possessed, at all times, the meta-title, “DR. WHO (M) SDN. BHD.”.¹⁶¹

134 Meta-titles serve as the titles of the two websites and are displayed on the Internet browser’s “tab”. As such, they denote the trade origin of the goods or services provided by the website: see the decision by Richard Arnold QC (as he then was) in *LEMANS* [2004] Lexis Citation 4105 at [47]. In the same way, the DR. WHO quatrefoil device sign headlined the home pages of both websites

¹⁶⁰ PWS at p 26.

¹⁶¹ PWS at para 7(b).

within the webpages themselves. The DR. WHO quatrefoil device sign together with the respective meta-title would have been displayed at the same time and would have been viewed together by consumers accessing the websites. These signs would therefore have been understood as being used in relation to the goods offered on those websites, which were set out further down on the home pages. This is sufficient to constitute use of the signs in a trade mark sense as they indicated the source of those goods.

Identity/Similarity of the signs used

(1) The DR. WHO quatrefoil device sign

135 I repeat my finding on the similarity between the DR. WHO quatrefoil device sign and the DR. WHO goods mark made at [83]–[88] above.

(2) The meta-title sign on the “www.drwho.asia” website

136 The comparison is between the following:

DR. WHO (S) PTE LTD

Figure 7: The meta-title sign on the “www.drwho.asia” website

and

DR. WHO

Figure 8: The DR. WHO goods mark

137 I find that this meta-title is visually similar to the DR. WHO goods mark as both contain the words “DR. WHO” in block letters. The dominant component of this sign (“DR. WHO”) is also aurally and conceptually identical

to the DR. WHO goods mark. The only difference in the addition of “(S) PTE LTD” in the meta-title sign does not alter the analysis.

138 Considering the sign and the registered mark holistically, I find that the meta-title sign (“DR. WHO (S) PTE LTD”) which was used on the “www.drwho.asia” website is similar to the DR. WHO goods mark.

(3) The meta-title sign on the “www.drwho.com.my” website

139 The comparison is between:

DR. WHO (M) SDN. BHD.

Figure 9: The meta-title sign on the “www.drwho.com.my” website

and

DR. WHO

Figure 10: The DR. WHO goods mark

140 The only differences between this meta-title and the one found on the “www.drwho.asia” website above are in the letters “S” and “M” as well as the change from “PTE LTD” to “SDN. BHD.”. I do not find these differences material for the similarity analysis between the sign and the DR. WHO goods mark. The dominant component of the meta-title sign on the “www.drwho.com.my” website remains “DR. WHO” and, for the same reasons above, is similar to the DR. WHO goods mark.

Identity/Similarity of goods

141 As the average consumer would perceive both the DR. WHO quatrefoil device sign and the meta-title signs to be applied to the goods offered on the

websites, the comparison here is between those goods and the specification in respect of which the DR. WHO goods mark is registered. Following the analysis in [97]–[100], there is an identity of these respective goods.

Likelihood of confusion

142 I am persuaded that a likelihood of confusion on the part of the relevant segment of the public exists vis-à-vis the allegedly infringing signs on the two websites. I accept that the relevant public here will comprise members of the general public in Singapore who have visited the two websites. As articulated at [103] above, this will include two separate classes: (a) the potential end users of the plaintiffs’ and the defendants’ goods as well as (b) traders who are potential customers of the plaintiffs and the defendants. The average consumer from each class will pay a different level of attention and care toward their purchasing activity based on their respective knowledge, experience and purchase involvement: *Kerly’s* at para 3-016. As the analysis in the following paragraphs will demonstrate, the higher level of attention and care which will likely be paid by the traders does not, on the present facts, affect the confusion inquiry.

143 First, the dominant components of all three signs comprise the words “DR. WHO”. These elements are similar to the DR. WHO goods mark. As such, the average consumer from both classes is likely to believe that the goods offered under the meta-title signs, “DR. WHO (S) PTE LTD” and “DR. WHO (M) SDN. BHD.”, as well as the DR. WHO quatrefoil device sign originate from the same undertaking as the proprietor of the mark or a company related to this proprietor. This is especially so since (a) the average consumer in the first class is unlikely to be familiar with the full corporate name of the company which owns the registered DR. WHO goods mark in Singapore, and (b) the

average consumer in the second class, being traders, will likely assume that there is a corporate link between the entity using the signs and the proprietor of the DR. WHO goods mark.

144 Second, not only are the goods offered on the websites under the signs identical to the goods for which the DR. WHO goods mark is registered, the purchasing practices and the degree of care paid by the customers also do not detract from a finding of confusion. Even for the average consumer in the second class, who is likely to expend a higher degree of care in the course of his or her purchasing activity, the identity in goods offered and the similarity in marks used will indicate that the goods offered for sale under the signs on the websites originate from the proprietor of the DR. WHO goods mark (or a related undertaking).

145 For these reasons, I accept that a likelihood of confusion exists among the relevant public across both classes. The use of the meta-title signs, “DR. WHO (S) PTE LTD” and “DR. WHO (M) SDN. BHD.”, and the DR. WHO quatrefoil device sign on the defendants’ “www.drwho.com.my” and “www.drwho.asia” websites therefore infringed the DR. WHO goods mark.

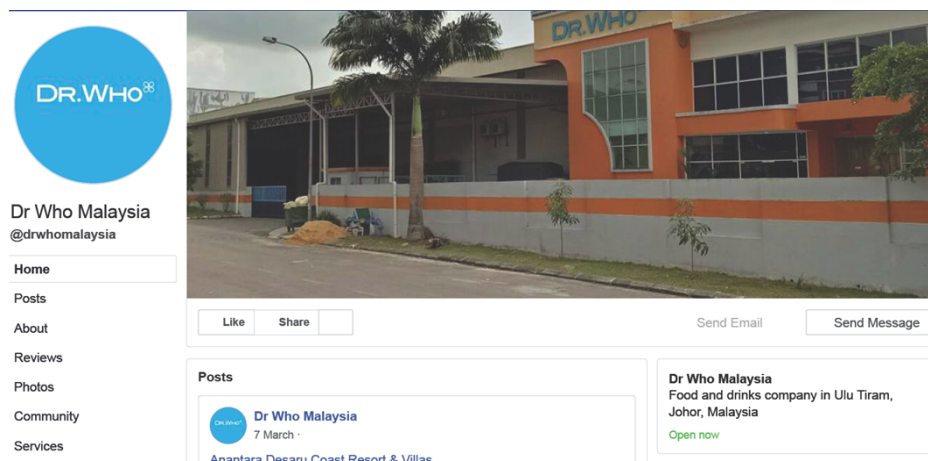
Infringement Claim 4: The content of the DR. WHO (M) Facebook page

146 I turn to assess the plaintiffs’ infringement claim in relation to the allegedly infringing signs used on the DR. WHO (M) Facebook page.¹⁶² Here, as with the content of the “www.drwho.com.my” and “www.drwho.asia” websites, the preliminary question that arises is whether the signs present on the

¹⁶² PWS at para 66.

DR. WHO (M) Facebook page (*ie*, the DR. WHO quatrefoil device sign and the “Dr Who Malaysia” sign) were “used” in Singapore.

147 In my judgment, this must be answered in the negative. There appears to be no evidence of content on the DR. WHO (M) Facebook page targeting consumers in Singapore, unlike the “www.drwho.com.my” and “www.drwho.asia” websites. The content of the DR. WHO (M) Facebook page does not appear to market or advertise any goods to consumers in Singapore – only references to Malaysia are made. In particular, the page describes “DR. WHO Malaysia” as a “[f]ood and drinks company in *Ulu Tiram, Johor, Malaysia*” [emphasis added]:¹⁶³



148 In fact, the plaintiffs’ own evidence regarding how they discovered the DR. WHO (M) Facebook page points away from any use in Singapore of the DR. WHO quatrefoil device sign and the “Dr Who Malaysia” sign. According to the plaintiffs, they were not actively directed to the DR. WHO (M) Facebook page in any way. Nor could they adduce evidence demonstrating that consumers

¹⁶³ Bundle Part E at p 391.

in Singapore were being so directed. Instead, the plaintiffs entered the specific words “ikea dricksvatten” (being the name of the Cartons sold) into the Google search engine and found images of the Cartons. It was only when they took the further step of clicking on these images that they discovered the images were posted on the DR. WHO (M) Facebook page:¹⁶⁴



Other than this particular search result on the Google search engine, there was little evidence to show that the DR. WHO (M) Facebook page was brought to the attention of consumers in Singapore. Unlike the websites, the existence of the Facebook page was not reflected on the Cartons or Vehicle A. While a link to the DR. WHO (M) Facebook page was placed on the “www.drwho.asia” and the “www.drwho.com.my” websites, this does not mean that the Facebook page “targeted” consumers in Singapore. For one, the link on these websites took the form of a small icon placed on the websites’ banner. This indicates that only a small proportion of users in Singapore who are visiting these websites will be re-directed to the Facebook page. More importantly, the Facebook page *itself*

¹⁶⁴ Koh’s AEIC at paras 93(y)-(z).

does not directly encourage or advertise the defendants' goods to consumers in Singapore.

149 In my view, to say that the DR. WHO quatrefoil device sign and the “Dr Who Malaysia” sign were used *in Singapore* is wholly artificial. One ostensibly territorial “link” is the display of the Cartons as a result of the specific search on Google, but it would be very odd to find that the sole act of uploading images of the Cartons on the DR. WHO (M) Facebook page amounts to the targeting of Singapore consumers. This is especially so given that it is not immediately apparent from the images alone that the Cartons were sold in Singapore. The placement of the link on the websites is also insufficient to show that consumers in Singapore have been targeted for the reasons above. Accordingly, I find that the plaintiffs' infringement claim regarding the use of the allegedly infringing signs on the DR. WHO (M) Facebook page fails.

Infringement Claim 5: The fourth defendant's name (“DR WHO (S) Pte Ltd”)

150 The final claim I deal with is whether the use of the fourth defendant's corporate name “DR WHO (S) Pte Ltd” constituted infringement of the DR WHO Goods Mark. The fourth defendant was incorporated in Singapore on 17 July 2019 under the name “DR. WHO (S) Pte Ltd”,¹⁶⁵ until its name was changed to Dynamic Watermedia Pte Ltd on 20 April 2021.¹⁶⁶ I clarify here that when I refer to “the fourth defendant's name”, I refer to the name it bore from the time of its incorporation to 20 April 2021.

¹⁶⁵ Koh's AEIC at para 93(2); pp 2001-2004.

¹⁶⁶ Koh's AEIC at para 188.

Use of the allegedly infringing sign

151 The plaintiffs argue that the fourth defendant’s name was used as a sign on several instances. For one, they take issue with the use of the words “DR. WHO (S) PTE LTD” in the Copyright Notice and the meta-title on the “www.drwho.asia” website.¹⁶⁷ This use has already been addressed above. In addition, they argue that the very incorporation of the fourth defendant under the name “DR. WHO (S) PTE LTD” constitutes an infringing act.¹⁶⁸ This argument begs the question of whether such “use” of a corporate name was in relation to goods or services.

152 The European Court of Justice (Grand Chamber) in the case of *Céline SARL v Céline SA* Case C-17/06, [2007] ECR I-7041 stated at [21] that the use of a company name solely to identify a company is insufficient to amount to use in relation to goods or services. Instead, the company name must be used in a manner which establishes a link between the company name and the goods or services offered by the company, as assessed from the perspective of the average consumer (see *Kerly’s* at para 16-038).

153 On the facts, the fourth defendant’s name was used in at least one instance as the fourth defendant entered into a contract with IKEA for the supply of the Cartons.¹⁶⁹ The plaintiffs do not dispute the existence of this contract, although it was not tendered in evidence. I do not think that the fourth defendant’s name was used purely for the purposes of identifying the fourth defendant. For instance, the allegedly infringing sign, in the form of the fourth defendant’s name, appeared on a goods return form, which was a commercial

¹⁶⁷ PWS at para 65.

¹⁶⁸ PWS at para 83.

¹⁶⁹ Oo’s AEIC 1 at para 105.

document evidencing the supply of goods by the fourth defendant to IKEA.¹⁷⁰ This was *not* a situation where the fourth defendant's name was used with respect to an inactive company and therefore was only found on a central register for the purposes of identifying that company. It would, in my view, make for an odd state of affairs if the use of a corporate name without any corresponding business activity can be said to be use in relation to any goods or services. Here, I am satisfied that the use of the fourth defendant's name was in relation to the goods it offered to IKEA (the Cartons). The use of the corporate name on the contract (the existence of which is not disputed) would also have constituted the sale of goods under the sign "DR. WHO (S) PTE LTD" pursuant to s 27(4)(b) of the TMA.

Similarity of the sign used

154 The plaintiffs assert that the corporate name "DR. WHO (S) PTE LTD" is similar to the DR. WHO goods mark. This was not seriously contested by the defendants. I agree with the plaintiffs. Given that the fourth defendant's name is identical to the meta-title sign on the "www.drwho.asia" website, I repeat the analysis conducted earlier at [137]–[138].

Identity/Similarity of the goods

155 As the fourth defendant's name was used in the sale of the Cartons to IKEA, I find that the use of the name "DR. WHO (S) PTE LTD" was in relation to goods identical to those which the DR. WHO goods mark is registered for.

¹⁷⁰ Bundle Part I at p 214.

Likelihood of confusion

156 In my view, the use of the fourth defendant’s name leads to a likelihood of confusion. As the fourth defendant has clearly engaged in some form of business activity, the relevant segment of the public in this case would include actual and potential purchasers of the goods offered for sale by the plaintiffs and the fourth defendant (see *Digi* at [174]). This group may well comprise persons who consult the company’s register (see *Bayerische Motoren Werke AG v BMW Telecommunications Ltd and another* [2019] EWHC 411 (“*Bayerische*”) at [16] and [18]). Given the similarity between the fourth defendant’s name and the DR. WHO goods mark, as well as the identity of the goods in question, the relevant segment of the public would likely be confused as to the source of the goods offered for sale under the fourth defendant’s name (which was used as a sign).

157 Accordingly, the plaintiffs’ claim pertaining to the use of the fourth defendant’s name as an infringing sign succeeds.

Summary of findings

158 To summarise my findings on the infringement claim:

- (a) The first defendant’s use of the DR. WHO quatrefoil device sign and the “www.drwho.com.my” sign on Vehicle A infringes the DR. WHO goods mark.
- (b) The first defendant’s display of the “www.drwho.asia” sign on the Cartons infringes the DR. WHO goods mark.

- (c) The first defendant’s display of the DR. WHO quatrefoil device sign and the two meta-title signs on the “www.drwho.com.my” and “www.drwho.asia” websites infringes the DR. WHO goods mark.
- (d) The use of the fourth defendant’s name “DR. WHO (S) Pte Ltd” infringes the DR. WHO goods mark.

Remedies

159 The plaintiffs seek the following remedies:¹⁷¹

- (1) an injunction to restrain the [first defendant], whether by itself or by its servants or agents or any of them or otherwise howsoever from infringing the [DR. WHO word marks, the DR. WHO quatrefoil device mark] and any other mark that is identical with or similar to the said marks;
- (2) an order for delivery up of all products, printed or written matter, packaging and all other articles in the power, possession custody and/or control of the [first defendant], its servants and/or agents, the use of which would be in breach of the foregoing injunction;
- (3) an inquiry as to damages suffered by the [first plaintiff], or at the [first plaintiff’s] option, an account of profits;
- (4) an order for payment of all sums found due upon taking such inquiry or account; and
- (5) Further and/or in the alternative, at the election of the [first plaintiff], statutory damages under Section 31(5) of the TMA for trade mark infringement upon taking of the inquiry.

160 Injunctive relief is generally available to plaintiffs whose trade mark rights have been infringed upon. Such relief is however contingent on some threat or probability that the infringement will be commenced, continued or repeated: *Kerly’s* at para 22-066. Here, several of the infringing acts above had, at the time of trial, been remedied. For instance, it is not disputed that the

¹⁷¹ SOC at pp 79-80.

defendants had repainted their vehicles.¹⁷² The display of the “www.drwho.asia” sign on the Cartons had been entirely redacted¹⁷³ and, in any case, IKEA had stopped displaying the Cartons for sale on 5 August 2020.¹⁷⁴ Instead, a fresh order by IKEA for cartons of water without any signs identical or similar to the trade marks in issue had been fulfilled by the defendants.¹⁷⁵ The fourth defendant’s name had also been changed to “Dynamic Watermedia Pte Ltd”.¹⁷⁶

161 Nevertheless, the “www.drwho.asia” and “www.drwho.com.my” websites which still display the infringing DR. WHO quatrefoil device sign and the meta-title sign (“DR. WHO (M) SDN BHD”) may be discovered by consumers in Singapore through basic Internet searches. Upon entering these websites, consumers would labour under the misconception that the defendants operate in Singapore and that their goods bear a link to the plaintiffs. Given this state of affairs, I find it appropriate to grant a general injunction to restrain the defendants from infringing the plaintiffs’ registered trade marks in Singapore (see *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1484 (Ch) at [14]).

162 I find the plaintiffs’ prayer for an order for the delivery up of the vehicles and/or the Cartons under s 33(1) of the TMA to be completely unmeritorious. This is for the simple reason that the infringing signs are no longer placed on the relevant articles. The Commercial Vehicles have been repainted; the defendants have also ceased production of the Cartons. There is therefore no subject matter for such an order to attach to. In any event, such an order would

¹⁷² PWS at para 102.

¹⁷³ Koh’s AEIC at para 149.

¹⁷⁴ Koh’s AEIC at para 150.

¹⁷⁵ Oo’s AEIC 1 at para 143; Chng’s AEIC at para 33.

¹⁷⁶ Koh’s AEIC at para 188; pp 3030-3033.

have constituted a disproportionate measure given that less onerous means of remedying the infringing acts were available (and had, indeed, been carried out): see s 33(2) read with s 34(2)(a) of the TMA. I am thus satisfied that there are no grounds for such an order to be made, and that the plaintiffs may be adequately compensated through damages or an account of profits.

163 Pursuant to ss 31(2) and 31(5) of the TMA, I order an inquiry as to damages in relation to the acts of infringement summarised at [158] above. In the alternative, the plaintiffs may elect for an account of profits.

164 I clarify at this point that the plaintiffs are not entitled to statutory damages. Section 31(5) of the TMA provides as follows:

Action for infringement

31.— ...

(5) In any action for infringement of a registered trade mark where the infringement involves the use of a counterfeit trade mark in relation to goods or services, the claimant is entitled, at the claimant's election, to —

(a) damages and an account of any profits attributable to the infringement that have not been taken into account in computing the damages;

(b) an account of profits; or

(c) statutory damages —

(i) not exceeding \$100,000 for each type of goods or service in relation to which the counterfeit trade mark has been used; and

(ii) not exceeding in the aggregate \$1 million, unless the claimant proves that the claimant's actual loss from such infringement exceeds \$1 million.

This remedy was introduced in 2004 pursuant to Singapore's obligations under Art 16.9.5 of the US-Singapore Free Trade Agreement (6 May 2003). By making this an available remedy against infringers who use counterfeit trade

marks, difficulties in proving actual losses or in obtaining an account of profits may be overcome: *Singapore Parliamentary Debates, Official Report* (15 June 2004) vol 78 at col 113 (Prof S Jayakumar, Minister for Law).

165 The wording of s 31(5) of the TMA makes it clear that plaintiffs may elect for this remedy *only* in cases involving “the use of a counterfeit trade mark”. The burden therefore lies on the plaintiffs in this case to show that a “counterfeit trade mark” (as defined in s 3(6) of the TMA) has been used by the defendants. This burden has not been discharged. The plaintiffs have not alleged, either in their pleadings or in their submissions, that the defendants have used a “counterfeit trade mark”. In fact, the plaintiffs make entirely no reference to a “counterfeit trade mark” or its definition in s 3(6) of the TMA. Their claim for statutory damages¹⁷⁷ therefore rests on the assumption that a proprietor of a trade mark is entitled to statutory damages in every instance of trade mark infringement. This cannot be correct. As the plaintiffs have failed to address me on whether a “counterfeit trade mark” has been used – which is an essential pre-requisite for the award of statutory damages under s 31(5) of the TMA – I find that the plaintiffs are not entitled to such an award. It is necessary for me to decide definitively on this issue here so as to *preclude* subsequent arguments – at the inquiry for damages or otherwise – that I have impliedly accepted that a “counterfeit trade mark” has been used or that statutory damages are applicable to the present case.

Claim 2: Passing off by the defendants

166 I turn next to the plaintiffs’ claim in the tort of passing off. To establish an action under the tort of passing off, the plaintiff must prove the “classic

¹⁷⁷ SOC at p 79.

trinity” of goodwill, misrepresentation and damage (see *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) at [27]–[28], citing *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 at 499; *Amanresorts* at [37]):

(a) The existence of goodwill in its business. Goodwill in a passing off action is not concerned specifically with the mark used by the trader. Rather, it is concerned with the *trader’s business as a whole*: *Tuitiongenius Pte Ltd v Toh Yew Keat* [2021] 1 SLR 231 (“*Tuitiongenius*”) at [83]; *Singsung* at [32]–[34].

(b) The misrepresentation that the goods, services or business of the defendant are those of the plaintiff or closely connected with the plaintiff: *Wadlow* at para 1-15; *The Singapore Professional Golfers’ Association v Chen Eng Waye and others* [2013] 2 SLR 495 (“*SPGA*”) at [20]. This typically entails the use of some element by the defendant, such as a name, mark, get-up or other sign, which is deceptively similar to that of the plaintiff: *Wadlow* at para 1-16. To this end, the “distinctive” nature of the plaintiff’s badge or identifier and its association with the plaintiff’s goodwill will be relevant considerations. The court must then consider, amongst other facts, whether there is such a similarity between the element that is being used by the defendant on the one hand and the plaintiff’s badge or identifier on the other such that it is sufficiently likely that the relevant sector of the public will be deceived or confused into thinking that the defendant’s goods, services or business are those of the plaintiff or emanate from a source that is linked to the plaintiff.

(c) Damage occasioned or is likely to be occasioned to the plaintiff’s goodwill from the misrepresentation: *Tuitiongenius* at [101].

167 I shall deal with each element in turn.

Goodwill

168 It is trite that the tort of passing off seeks to protect the goodwill of the plaintiff’s business as a whole, rather than an invasion of the mark(s) used: *Wadlow* at para 3-6; *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 (“*CDL Hotels*”) at [45]. For this reason, our courts have, for analytical clarity, dealt with whether a trader’s goodwill is associated with certain names, signs or get-ups at the subsequent stage of determining whether there has been a misrepresentation: see *Hai Tong* at [115]. Goodwill, in turn, is defined as the power of attraction which draws customers to buy the trader’s goods: *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [81] citing *The Commissioners of Inland Revenue v Muller & Co’s Margarine, Limited* [1901] AC 217 at 224. This goodwill refers to the goodwill in the business *as a whole*, and not specifically in the constituent elements (the mark, logo or get-up) that the business uses: *Singsung* at [34]. Goodwill typically takes the form of clients or customers within the jurisdiction for the goods or services of the plaintiff: *Starbucks (HK) Ltd v British Sky Broadcasting* [2015] UKSC 31 at [47]. This may be limited to particular sectors of the public, as long as these sectors are not so small as to be negligible: *Amanresorts* at [44].

169 The relevant date to determine the existence of goodwill is the date on which the defendants commenced their alleged acts of passing off: *CDL Hotels* at [34]. The plaintiffs submit that this date is 28 March 2019, being the date of

the first alleged act of passing off (*ie*, when Vehicle A was first seen in Singapore).¹⁷⁸ I agree.

170 The plaintiffs submit that they possessed goodwill in their business vis-à-vis those in Singapore who did business with them as well as the sectors of the public in respect of which the plaintiffs had conducted significant advertising activities and procured sales. In addition to the general public, these sectors included schools, government agencies, hotels, banks, retail stores and corporate offices.¹⁷⁹

171 The defendants do not contest the fact that the plaintiffs’ possessed goodwill in their business in Singapore. In light of the evidence before me, I agree that such goodwill exists. The plaintiffs have adduced evidence of their respective annual revenues from 2017 to 2019,¹⁸⁰ as well as the revenue gained under their identifiers for the same period.¹⁸¹ Various brochures and evidence of the plaintiffs’ advertising efforts were also exhibited,¹⁸² which led to an expenditure of about \$116,361.89 from 2016 to 2019.¹⁸³ The plaintiffs’ “www.drwhohub.com” website received substantial views, or “hits”, in Singapore each year since 2009.¹⁸⁴ A record of the first and second plaintiffs’ customers for the sale of bottled water bearing their customers’ marks, spanning

¹⁷⁸ PWS at paras 23-24.

¹⁷⁹ Koh’s AEIC at para 90.

¹⁸⁰ Koh’s AEIC at para 88. For the first plaintiff, see Koh’s AEIC at pp 1141ff. For the second plaintiff, see Koh’s AEIC at pp 1212ff. For the third plaintiff, see Koh’s AEIC at pp 1316ff.

¹⁸¹ SOC at paras 28-29; pp 22-23.

¹⁸² Bundle Part K at pp 434-439; Koh’s AEIC at para 89(g).

¹⁸³ Koh’s AEIC at para 89(n); KTG-10 at pp 1582-1587.

¹⁸⁴ SOC at pp 24-25.

the above-mentioned sectors, was also adduced and is unchallenged.¹⁸⁵ Given this evidence demonstrating the plaintiffs' business presence and the customers which they have in Singapore, it is clear that goodwill exists in the plaintiffs' business.

172 For completeness, I also address the suggestion which arose at several points in Mr Oo's evidence that he shared in the goodwill of the plaintiffs by virtue of his contributions while he was a shareholder in the first plaintiff.¹⁸⁶ I must reject this suggestion. Despite any contributions that Mr Oo may have made in the early years of the first plaintiff's development (an assertion which, in any case, was heavily contested by Mr Koh), it is trite that goodwill ultimately vests *in the business*. The business here refers to the Dr. Who Group (or that of its constituent companies) and not Mr Oo. The defendants also did not put forth any arguments pertaining to the potential assignment of the goodwill in the plaintiffs' business. As such, this contention cannot stand.

Misrepresentation

173 The preliminary issue to be considered for this requirement is whether the plaintiffs' identifiers are distinctive of the plaintiffs' goods: see *Singsung* at [70]. If so, then the plaintiffs will need to establish (a) that there was a misrepresentation made by the defendants through the use of elements which are identical or similar to the identifiers and (b) that actual confusion or a likelihood of confusion arose from this.

¹⁸⁵ Bundle Part K at pp 467-486.

¹⁸⁶ Defence and Counterclaim at paras 124-126.

Distinctiveness of the plaintiffs' identifiers

174 I am satisfied that the plaintiffs' identifiers¹⁸⁷ are distinctive of the goods offered by the plaintiffs and/or the plaintiffs' business itself. These identifiers include the words, "DR. WHO", which are used in the names of all three plaintiffs, and the DR. WHO word marks, which are used in the course of the plaintiffs' business of supplying and delivering bottled water bearing the customer's mark. The distinctiveness of these identifiers is evident not only from my earlier finding at [85] that the DR. WHO goods mark is inventive and thus inherently distinctive of the plaintiffs' goods, but also from the consistent application of the identifiers on the extensive advertising which the plaintiffs have carried out in Singapore. The plaintiffs have also adduced evidence to show that substantial revenue has been earned under the identifiers since 2017.¹⁸⁸ This evidence is sufficient in my view to establish that the public would associate these identifiers with the plaintiffs' goods, services and/or business in Singapore.

Misrepresentation giving rise to confusion or a likelihood of confusion

175 It must be proved in each case that a false representation was made. This may be carried out expressly but will, more commonly, be made impliedly through "the use or imitation of a mark, trade name, or get-up with which the goods of another are associated in the minds of the public or of a particular class of the public": see *CDL Hotels* at [70] citing *A G Spalding & Bros v A W Gamage Ltd* (1915) 32 RPC 273 at 284. This misrepresentation must be made to the relevant sector of the public, which would typically refer to the actual or

¹⁸⁷ SOC at para 40.

¹⁸⁸ SOC at para 40(b); Koh's AEIC at para 88(b).

potential customers of the goods or services in question *or* the ultimate consumers of these goods or services: see *Wadlow* at para 5-120.

176 On the present facts, the defendants’ use of elements similar to the plaintiffs’ identifiers amounts to a misrepresentation that the defendants’ goods and/or business were the plaintiffs’ or were economically linked to the plaintiffs. Specifically, the plaintiffs point to five distinct acts of misrepresentation:

- (a) The defendants’ use of the words “DR. WHO” through the display of the first defendant’s name, its e-mail (“drwho@drwho.com.my”) and the “www.drwho.asia” website on the Cartons.¹⁸⁹
- (b) The defendants’ use of the “www.drwho.asia” and the “www.drwho.com.my” websites.
- (c) The defendants’ use of the words “DR. WHO” on the DR. WHO (M) Facebook page, titled “DR. WHO Malaysia – Ulu Tiram, Johor, Malaysia | Facebook”.
- (d) The defendants’ use of the corporate name “DR. WHO (S) PTE LTD”.
- (e) The defendants’ use of the words “DR. WHO” on the Commercial Vehicles through the display of the DR. WHO quatrefoil device sign, the “www.drwho.com.my” website, the first defendant’s e-mail address and its contact details taken together with the elements on the “www.drwho.com.my” website.

¹⁸⁹ PWS at paras 48ff.

177 These misrepresentations must have the effect of giving rise to actual confusion or a likelihood of confusion before they may be actionable under the tort of passing off: *Amanresorts* at [77]. This involves a consideration of all the relevant circumstances, which may include the following factors: (a) the strength of the public’s association with the plaintiff’s identifiers, (b) the similarity of the plaintiff’s and the defendant’s respective elements, (c) the proximity of the parties’ respective fields of business, (d) the characteristics of the market and (e) the defendant’s intention (*SPGA* at [54] citing Lionel Bently & Brad Sherman, *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at p 760). These factors aid the court’s evaluation as to whether there is a likelihood that the relevant sector of the public may be left with the mistaken impression that the defendants’ goods and/or business are in fact the plaintiffs or are economically connected in some way with the plaintiffs.

178 I now consider whether each of the alleged misrepresentations above gives rise to actual confusion or a likelihood of confusion.

(1) The use of signs on the Cartons

179 The plaintiffs argue that a likelihood of confusion is established here because the use of the “www.drwho.asia” sign on the Cartons would lead the relevant public in Singapore to associate such branding with the plaintiffs’ goods.¹⁹⁰ I agree. I have explained at [122] above how the “www.drwho.asia” sign on the Cartons will give rise to a likelihood of confusion for the purposes of the plaintiffs’ trade mark infringement claim. Moreover, when the first defendant’s name and its details are considered together with the “www.drwho.asia” website on the Cartons, they suggest to the public that the

¹⁹⁰ PWS at para 52.

Cartons originate from either the Malaysian branch of the plaintiffs’ business or an entity otherwise economically linked to the plaintiffs. This is because the first defendant’s name is similar to the common component across the names of the plaintiffs – “DR. WHO”. I therefore accept that this constitutes an actionable misrepresentation made to the relevant sector of the public for the purposes of passing off. In this instance, the relevant sector of the public will be the general public patronising IKEA Tampines and IKEA Alexandra, as the ultimate consumers of the goods in question (bottled water bearing the customer’s mark).

(2) The use of the “www.drwho.asia” and the “www.drwho.com.my” websites

180 The plaintiffs submit that the relevant public viewing these websites’ names and their content would be under the false impression that the goods and/or the business of the first defendant were associated with the plaintiffs.¹⁹¹ I agree with the plaintiffs’ arguments on this point. The names of both websites are similar to the DR. WHO goods mark (see [96] and [117]). The content of both websites also indicates that the defendants offer the same goods as the plaintiffs. Moreover, following from my findings at [126], the misrepresentation here would have been made to the relevant sector of the public *in Singapore*, as the ultimate consumers of the plaintiffs’ and the defendants’ goods or services in Singapore would have been targeted by these websites. An actionable misrepresentation is thus made out.

(3) The use of signs on the DR. WHO (M) Facebook page

181 I do not accept that the content found on the DR. WHO (M) Facebook page constitutes an actionable misrepresentation. This is for the simple reason

¹⁹¹ PWS at para 64.

that the misrepresentation was neither made to any actual or potential customers or ultimate consumers of the relevant goods or services in question *in Singapore*. As observed at [149], consumers in Singapore were not targeted by the DR. WHO (M) Facebook page. Logically, such a misrepresentation (even if it exists) cannot affect the plaintiffs' goodwill in any way: see *Amanresorts* at [73].

(4) The use of the corporate name "DR. WHO (S) PTE LTD"

182 The plaintiffs submit that the incorporation of the fourth defendant under the name "DR. WHO (S) PTE LTD" on 17 July 2019 amounted to an actionable misrepresentation to its actual and prospective customers that the fourth defendant's business was associated with the plaintiffs.¹⁹² In this regard, it avers that the letter "(S)" in the fourth defendant's name referred to Singapore (in contradistinction to the first defendant's name, "DR. WHO (M) SDN BHD", where the "(M)" is presumed to refer to Malaysia).

183 In my view, the use of the fourth defendant's name "DR WHO (S) Pte Ltd" gives rise to an actionable misrepresentation for substantially the same reasons I set out at [156]. This misrepresentation would have been made to the actual and potential customers of the plaintiffs and the defendants (such as IKEA), which would include individuals consulting the company's register (see *Bayerische* at [16]). In my view, these individuals would have associated the fourth defendant's name with the plaintiffs' business.

¹⁹² PWS at paras 44-45.

(5) The use of signs on the Commercial Vehicles

184 Finally, the plaintiffs argue that the use of the term “DR. WHO” on the Commercial Vehicles amounted to a misrepresentation that the first defendant’s business was connected to that of the plaintiffs.¹⁹³ They rely on the findings of the PI Report in establishing such use. As in the case of the trade mark infringement claim, the plaintiffs have not shown that Vehicles C and D had entered Singapore at any material time. The alleged misrepresentations were therefore not made to any potential or actual customers or ultimate consumers of the relevant goods or services in Singapore. The passing off claim vis-à-vis the elements used on Vehicles C and D must accordingly fail. In the same vein, the allegedly infringing signs on Vehicle B were incomprehensibly presented and therefore cannot amount to misrepresentations to the relevant sector of the public. As such, my analysis will be targeted at Vehicle A.

185 In my judgment, the following elements used on Vehicle A, taken together, amount to a misrepresentation that the plaintiffs’ business was connected to that of the first defendant. The largest and most prominent sign on the vehicle, *ie*, the DR. WHO quatrefoil device sign, is similar to the DR. WHO goods mark. This mark is associated with the plaintiffs’ business in Singapore. The relevant sector of the public here comprises the general public in Singapore who sees the sign and enters the “www.drwho.com.my” website. This includes the potential customers and ultimate consumers of the plaintiffs’ goods or services. When these individuals enter the “www.drwho.com.my” website, they will be presented with the defendants’ signs (such as the meta-titles) bearing the words “DR. WHO”. Coupled with the fact that the goods offered on the website are identical to those offered by the plaintiffs, the relevant public would

¹⁹³ PWS at para 72.

understand the goods offered on the website to originate from the plaintiffs or an entity associated with the plaintiffs.

Damage

186 A claim in passing off seeks to protect the plaintiff against damage caused to the goodwill attached to its business by way of the defendant's misrepresentation(s). The test for damage in passing off cases is thus either "actual or probable damage" to the plaintiff's goodwill: *Amanresorts* at [94].

187 In their submissions, the plaintiffs rely on the following heads of damage: (a) the tarnishment of the plaintiffs' goodwill in their business, (b) the loss of exclusivity or erosion of the distinctiveness to their goodwill and (c) the likelihood of damage to the plaintiffs' goodwill should the first defendant get into financial, legal or other trouble.¹⁹⁴ I deal with each head of damage in turn.

188 First, I am not of the view that the defendants' conduct will tarnish the goodwill in the plaintiffs' business. Tarnishment occurs when the business, goods or services of the defendant are of a worse quality than those of the plaintiff or have some other undesirable characteristic. As a result of the defendant's conduct, consumers will believe that the plaintiff is the source of such poor quality or undesirable business, goods or services: *Amanresorts* at [98]. Here, there is no evidence that the quality of the defendants' goods or services was unsatisfactory. In fact, no evidence regarding the quality of the defendants' goods or services has been adduced at all. Given that the plaintiffs themselves have been relying on the goods of the defendants for many years, I

¹⁹⁴ PWS at para 87.

do not take the view that tarnishment will occur as a result of the defendants’ conduct.

189 Second, it is doubtful if the loss of exclusivity or erosion of the distinctiveness of a plaintiff’s mark or get-up in a claim for passing off is an accepted head of damage under Singapore law. In *Amanresorts*, the Court of Appeal opined at [127]–[128] that such a head of damage appears to be simply a “recast” of other heads of damage such as “tarnishment”. Moreover, the recognition of such a head of damage may lead to the “fallacy that the property which is being protected is the name or mark or get-up itself, rather than the goodwill in the claimant’s business”: *Amanresorts* at [127] citing Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 3rd Ed, 2004) at para 4-44.

190 The plaintiffs have curiously pleaded the loss of exclusivity or the erosion of distinctiveness to the *goodwill* of their business.¹⁹⁵ It is unclear what the distinctiveness of the plaintiffs’ goodwill refers to. In any case, I echo the observation of the learned author in *Wadlow* at paras 4-17–4-18 that the mere tendency of the public to treat the plaintiffs’ and the defendants’ goods and/or businesses as associated does not *ipso facto* constitute damage. On the contrary, it is only proof that there has been a misrepresentation which has led to confusion (see *Amanresorts* at [124]). I therefore do not accept this head of damage.

191 Third, the plaintiffs argue that there is a likelihood of damage to their goodwill should the first defendant “get into financial, legal and/or other trouble”. To this end, the plaintiffs adduce a traffic summons addressed to a

¹⁹⁵ SOC at p 51; PWS at para 87.

driver employed by the first defendant but which was mistakenly sent to the plaintiffs' address.¹⁹⁶

192 This head of damage protects a plaintiff from being associated with a defendant who has found itself in trouble with the law or in financial distress. It assumes that the likely result would be that people who knew of the existence of the defendant may think that the plaintiff had a connection with the defendant and therefore decide against patronising the business of the plaintiff. Based on the pronouncements in local case law, it appears that some evidence is required to show that such “evil days” may befall the defendant: *Doctor’s Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193 at [76]; *Amanresorts* at [105].

193 In my view, the evidence adduced by the plaintiffs is insufficient to demonstrate that this head of damage applies on the present facts. The traffic summons was not made known to the general public and would therefore not have affected the decisions of the relevant sector of the public (see [170]) to patronise the plaintiffs’ business in Singapore. Other than this single incident, there was no indication that the defendants were likely to face any form of legal or financial trouble. I therefore reject the plaintiffs’ allegation of damage on this head as it is not sufficiently supported by the evidence.

194 While I have rejected the applicability of the three heads of damage stated in the plaintiffs’ submissions, I note that the plaintiffs have also pleaded the loss of sales as an additional head of damage in their Statement of Claim.¹⁹⁷ Given the association between the goods and businesses of the plaintiffs and the

¹⁹⁶ SOC at p 51.

¹⁹⁷ SOC at p 52.

defendants resulting from the defendants' misrepresentations to the relevant sector of the public, I accept that there exists a likelihood of damage in the form of some loss of sales suffered by the plaintiffs in Singapore. As such, the plaintiffs' claim for passing off succeeds with respect to this head of damage.

Summary of findings

195 In sum, the plaintiffs' claim for passing off succeeds. In particular:

- (a) The plaintiffs possess goodwill in their business;
- (b) The defendants have made misrepresentations resulting in a likelihood of confusion through the following acts:
 - (i) The use of the "www.drwho.asia" sign on the Cartons;
 - (ii) The use of the "www.drwho.com.my" and "www.drwho.asia" websites;
 - (iii) The use of the corporate name "DR. WHO (S) PTE LTD"; and
 - (iv) The use of the words "DR. WHO" and the other signs on Vehicle A taken together with the elements on the "www.drwho.com.my" website; and
- (c) There exists a likelihood of damage in the form of the loss of sales for the plaintiffs.

Remedies

196 In the light of the above, I order an inquiry as to damages in relation to the plaintiffs' claim. I clarify that this inquiry is intended to ascertain the

damage suffered by the plaintiffs *beyond* that which they have suffered (and will therefore claim) under their action for trade mark infringement regarding the same acts of the defendants.

197 In addition, the plaintiffs seek an injunction to restrain the fourth defendant from passing off or attempting to pass off its business for the plaintiffs', or from making any representation that its business or goods are in any way associated with or connected to the plaintiffs.¹⁹⁸ They also ask for an order for the delivery up of all items which, if used, would be in breach of the injunction.

198 I repeat my earlier observation at [160] that several of the acts complained of have since been remedied. Yet, given the continued operation of the "www.drwho.asia" and the "www.drwho.com.my" websites, I think it appropriate to grant an injunction to restrain the defendants from advertising, offering for sale, selling or supplying any goods or services under or bearing the mark "DR. WHO" or any other mark so nearly resembling "DR. WHO" as to cause confusion in Singapore. For the same reasons stated at [162], I do not find an order for delivery up necessary here.

Claim 3: Breach of the Deed by the defendants

199 The plaintiffs submit that the defendants have breached Clauses 2.3(2) and 2.3(3) of the Deed because they have "directly or indirectly supplied or caused to be supplied bottled water to entities in Singapore by way of passing off".¹⁹⁹ They take issue with the same acts of the defendants as for their claim in passing off (see [176]). The remedies which are being sought by the plaintiffs

¹⁹⁸ Statement of Claim dated 3 July 2020 at p 85.

¹⁹⁹ PWS at para 88.

under this claim are also largely similar to those sought in their claims for trade mark infringement and passing off.²⁰⁰

200 On the other hand, the defendants argue that the Deed allowed them to supply bottled water to customers in Singapore as long as they did not use the “DR. WHO” mark registered in Malaysia.²⁰¹ They also take the position that the Deed did not restrict the use of the words “DR. WHO” in the registration of a company name or as part of email addresses, websites or social media platforms in Singapore and Malaysia.²⁰²

201 The scope of Clause 2.3(2) turns on the interpretation of the word “use”. For convenience, Clauses 2.3(2) to 2.3(4) provide as follows:

(2) Neither party shall use the DR. WHO trademark in the other Party’s Country without the prior written approval of each party.

(3) [Mr Oo, Mdm Low and/or the first defendant] shall not, without the prior written approval of [the Dr. Who Group] whether directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Singapore bearing or under the “DR. WHO” mark registered in Malaysia and/or by way of passing off.

(4) [Mdm Tan, Mr Koh and/or the Dr. Who Group] shall not, without the prior written approval of [the first defendant] whether directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Malaysia bearing or under the “DR. WHO” mark registered in Singapore and/or by way of passing off.

202 The contextual approach which the courts take in contractual interpretation seeks to objectively ascertain the common intention of the parties, even if this might occasionally yield an understanding that departs from the

²⁰⁰ SOC at pp 73-77.

²⁰¹ DCS at p 5; Defence and Counterclaim at para 79.

²⁰² Defence and Counterclaim at paras 80-82; DCS at p 5.

literal meaning of the words used in the contract: *Sembcorp Marine Ltd v PPL Holdings Pte Ltd and anor* [2013] 4 SLR 193 (“*Sembcorp*”) at [34]. Yet, interpretation must nevertheless “assign to the *language of the text* the most appropriate meaning which *the words* can legitimately bear”: *Sembcorp* at [28] citing *Equitable Life Assurance Society v Hyman* [2002] 1 AC 408 at 458. In other words, one must begin with the ordinary meaning of the text.

203 In the present case, the word “use”, on a plain reading, lends itself to a broad range of acts. The difficulty in defining the term is perhaps apparent from the definition accorded in *Black’s Law Dictionary* (Bryan A. Garner gen ed) (Thomson Reuters, 11th Ed, 2019), which, in a rather circular fashion, defines use as “to make use of or to employ something”. It may perhaps be useful to understand the phrase in relation to s 27(4) of the TMA, which provides that one “uses a sign” if, amongst other acts, it is applied to goods or the packaging thereof (s 27(4)(a)), used in advertising (s 27(4)(e)) or used on various types of commercial documents (s 27(4)(d)). I stress, however, that I refer to s 27(4) of the TMA purely by way of illustration (as opposed to *interpreting* the word “use” as referring to the categories listed under s 27(4)). In my view, the plain ordinary reading of the word “use” may encompass the acts of *manufacturing, printing or supplying*, as long as there is some ascertainable way the “DR. WHO trademark” is employed.

204 Given this ordinary meaning of “use”, there are two possible ways of construing the ambit of the term “use” in relation to Clauses 2.3(3) and 2.3(4) of the Deed, as canvassed at [69]–[70] above. The first way is to see Clauses 2.3(3) and 2.3(4) as separate from Clause 2.3(2), such that the word “use” may be interpreted as referring to a larger ambit of activities which goes beyond the “supply” of bottled water, such as manufacturing. Such use will cover *any mark* containing the words “DR. WHO” as Clause 2.3(2), unlike

Clauses 2.3(3) and 2.3(4), does not confine the contractual obligation to “registered” marks. The second is to view Clauses 2.3(3) and 2.3(4) of the Deed as exclusively circumscribing the specific instances of “use” which are prohibited under the Deed. The plaintiffs aver that the second interpretation is to be preferred and that the word “use” in Clause 2.3(2) *only* refers to the act of supplying bottled water as set out in Clauses 2.3(3) and 2.3(4).

205 I favour the second interpretation of Clause 2.3(2). As a clause should not be considered in isolation but in the context of the whole document (see *Travista Development Pte Ltd v Tan Kim Swee Augustine and others* [2008] 2 SLR(R) 474 at [20]), I look to the surrounding provisions of the Deed to establish its context. Pertinently, Clause 2.3(5) refers only to Clauses 2.3(3) and 2.3(4) as the “Restraint Clauses”. It goes on to provide that these two clauses are “not intended to hinder competition” but are necessary for the purposes of protecting the businesses of both the plaintiffs as well as the defendants. It is telling that Clause 2.3(5) does not include Clause 2.3(2) as part of the “Restraint Clauses” despite the fact that Clause 2.3(2) clearly fetters both parties from using the “DR. WHO trademark” in the other party’s territory without prior approval. In my view, this supports an interpretation that Clauses 2.3(3) and 2.3(4) elucidate the specific instances which are prohibited under Clause 2.3(2). The elaboration found in Clauses 2.3(3) – “directly or indirectly, supply or caused to be supplied bottled water to any other person or entity in Singapore bearing or under the “DR. WHO” mark registered in Malaysia and/or by way of passing off” – therefore serves as a comprehensive definition of the term “[using] the DR. WHO trademark” in Clause 2.3(2) for the purposes of regulating the conduct of the Oos and the first defendant. In other words, Clause 2.3(2) prevents the Oos and the first defendant from supplying bottled water to any person in Singapore either (a) bearing or under the DR. WHO

swoosh mark and the Malaysian DR. WHO quatrefoil device mark or (b) by way of passing off. This interpretation is, in my view, in line with the parties' intention to mutually co-exist in Singapore and Malaysia as it is broad enough to restrict not only the outright use of the parties' registered trade marks in each other's territory, but also the use of other marks which may amount to passing off.

206 Such an interpretation is also consistent with the commercial reality of the parties' bargain. Reference to such evidence is permissible under the modern approach to contextual interpretation in so far as it is relevant, reasonably available to all parties and relates to an obvious context, with the paramount object of ascertaining what the parties ultimately agreed upon (see *Y.E.S. F&B Group Pte Ltd v Soup Restaurant Singapore Pte Ltd (formerly known as Soup Restaurant (Causeway Point) Pte Ltd)* [2015] 5 SLR 1187 at [30]–[42]).

207 It is undisputed that, prior to the Deed, the first defendant was the manufacturing arm for the first plaintiff, and that the first plaintiff had ordered bottled water bearing the customer's mark from the first defendant.²⁰³ This arrangement continued *up until 2019* (when the plaintiffs signed the Distribution Agreement with WRM and WRS for the same services).²⁰⁴ To my mind, it would not have made commercial sense for the parties to have intended to impose such a broad restriction of “use” of the “DR WHO trademark” so as to shut-off use of the mark in relation to activities *outside* of their main scope of business, *ie*, the supply of bottled water. This would have effectively hamstrung the plaintiffs' business, given that they procured the manufacturing of their bottled water primarily from Malaysia (initially from the first defendant,

²⁰³ Koh's AEIC at para 41.

²⁰⁴ DCS at p 49.

followed by WRM *etc*) and continued to do so even after the conclusion of the Deed. The prohibition against the “use” of the “DR WHO trademark” should therefore be restrictively interpreted alongside Clauses 2.3(3) and 2.3(4) of the Deed to restrict the “supply” (rather than the manufacturing *etc*) of bottled water.

208 For this reason, I find that the scope of “use” in Clause 2.3(2) is coterminous with the limitation against the supply of bottled water by the defendants under the conditions laid out in Clause 2.3(3). As such, the analysis will proceed in determining whether Clause 2.3(3) has been breached because of the defendants’ acts.

209 Clause 2.3(3) of the Deed prevents the Oos and the first defendant from directly or indirectly supplying (or causing the supply of) bottled water to any person in Singapore (a) bearing or under the “DR. WHO” mark registered in Malaysia and/or (b) by way of passing off.²⁰⁵ I shall deal with each limb of Clause 2.3(3) in turn.

210 The first limb restricts the direct or indirect supply of bottled water bearing or under the “DR. WHO” trade mark registered in Malaysia. At the point the Deed was entered into, the DR. WHO swoosh mark and the Malaysian DR. WHO quatrefoil device mark had been registered in Malaysia.²⁰⁶ In my view, the defendants have not directly or indirectly supplied (or caused the supply of) bottled water to any person in Singapore bearing or under these registered trade marks.

²⁰⁵ Bundle Part I at p 89.

²⁰⁶ Oo’s AEIC 1 at pp 14-15.

211 As observed at [33], the plaintiffs have not adduced any evidence to show that any of the bottles supplied by the first defendant to its customers in Singapore bore any of the “DR. WHO” trade marks registered in Malaysia (*ie*, the DR. WHO swoosh mark or the Malaysian DR. WHO quatrefoil device mark).²⁰⁷ The Cartons supplied by the fourth defendant did not bear these marks either. In addition, even if the Malaysian DR. WHO quatrefoil device mark was used on Vehicle A as well as the defendants’ websites, such use was not in relation to the direct or indirect supply (or causing of supply) of bottled water. Instead, the defendants could only be said to have *offered* bottled water for sale under the Malaysian DR. WHO quatrefoil device mark as consumers were only directed to the defendants’ websites. There is no evidence that any supply of bottled water had taken place. As such, I find that the defendants are not in breach of the first limb of Clause 2.3(3).

212 Turning to the second limb of Clause 2.3(3), the defendants are prohibited from directly or indirectly supplying bottled water in Singapore by way of passing off. As I have found the first limb to be inapplicable, this means that the defendants will only be in breach of Clause 2.3(3) in so far as the plaintiffs’ claim for passing off succeeds with respect to the supply of bottled water in Singapore. Given my findings above on the plaintiffs’ claim for passing off, I accept that Clause 2.3(3) of the Deed has been breached through the sale of the Cartons to IKEA by the fourth defendant and the use of the fourth defendant’s name. Although the fourth defendant is not a party to the Deed, Mr Oo and Mdm Low were the only directors of the fourth defendant at all material times. I am therefore satisfied that the sale of the Cartons to IKEA by the fourth defendant amounts to the *indirect* supply of such water by Mr Oo and

²⁰⁷ Oo’s AEIC 1 at paras 76-77; Koh’s AEIC at para 79, pp 1099-1121.

Mdm Low. The use of the fourth defendant's name in this transaction also constitutes such supply. While I have found that the other acts by the defendants set out at [195(b)] amount to passing off, they do not constitute a breach of Clause 2.3(3) because they are not in relation to the direct or indirect supply or causing of supply of bottled water. The plaintiffs' claim under Clause 2.3(3) therefore succeeds only with respect to the defendants' supply of bottled water in Singapore by way of passing off.

213 Despite my finding that this claim succeeds, I take the view that no additional remedies should be awarded to the plaintiffs. Where the law affords a plaintiff multiple (cumulative) remedies in respect of the same conduct of a defendant, the plaintiff cannot pursue any other remedy after he has fully recouped his loss: *Lim Teck Cheng v Wyno Marine Pte Ltd* [1999] 3 SLR(R) 543 ("*Lim Teck Cheng*") at [29]–[30] citing *Tang Man Sit v Capacious Investments* [1996] AC 514 at 521. This principle applies even where the remedies flow from distinct causes of action applicable to the same conduct of the defendant.

214 In this case, I am satisfied that the quantum of damages which the plaintiffs may recover for the contractual breach of the Deed will be the same as that which the plaintiffs are entitled to under the tortious claim in passing off (vis-à-vis the same conduct of the defendants). I first acknowledge the differences in rationale behind an award of damages for the breach of a contract and the commission of a tort. These nuances were helpfully articulated by the Court of Appeal in *PH Hydraulics & Engineering Pte Ltd v Airtrust (Hong Kong) Ltd and anor* [2017] 2 SLR 129 ("*PH Hydraulics*") at [69]:

... although damages for the breach of a contract and for the commission of a tort are both meant to compensate the plaintiff, they nevertheless serve different remedial purposes. Compensation for a breach of contract is meant to put the

aggrieved party in the same situation as if the contract had been performed – what is being protected is usually referred to as the “expectation interest” or the “loss of a bargain”. On the other hand, compensation in tort is meant to restore the aggrieved party to the position it would have been in had the tort not been committed.

Slight differences also exist with regard to the availability of punitive damages and the respective principles governing the remoteness of damages in contract and in tort: *PH Hydraulics* at [70]–[74].

215 These nuances, however, make no difference in the present case. Here, the compensation required to put the plaintiffs in the same situation as if the contract had been performed would be exactly the same as the compensation required to restore the plaintiffs to the position they would have been in had the tort not been committed. This is because the commission of the tort of passing off, *ie*, the use of the “www.drwho.asia” sign on the Cartons and the use of the fourth defendant’s name, involves the precise acts which constitute the breach of the Deed. As such, given that the loss suffered by the plaintiffs here will already be fully recouped by way of the remedies granted for the claim of passing off, there is no further need for me to order an inquiry as to damages or other relief for the purposes of this claim.

Claim 4: The defendants’ unlawful conspiracy to injure the plaintiffs

216 I now turn to the issue on unlawful conspiracy. To succeed in this claim, it must be shown that (*EFT Holdings Inc and anor v Marinteknik Shipbuilders (S) Pte Ltd and anor* [2014] 1 SLR 860 at [112]):

- (a) there was a combination of two or more persons to do certain acts;

- (b) the alleged perpetrators had the intention to cause damage or injury to the plaintiff by those acts;
- (c) the acts were unlawful;
- (d) the acts were performed in furtherance of the agreement; and
- (e) the plaintiff suffered a loss as a result of the conspiracy.

217 The plaintiffs submit that there was an agreement by the Oos to injure the plaintiffs by incorporating the fourth defendant, and that the fourth defendant had joined the conspiracy upon incorporation by virtue of the Oos' directorship and shareholding in the same.²⁰⁸ In particular, the unlawful acts complained of refer to the acts of passing off committed by the defendants.²⁰⁹

218 Similar to the plaintiffs' claim for the breach of the Deed, the success of this claim is dependent on the finding that the defendants' conduct constitutes passing off. I take the view that there is no need for me to decide this issue because the plaintiffs have not established that they have suffered any distinct loss beyond that which they are claiming for their passing off claim. This is apparent from the plaintiffs' submissions, which complain that the nature of the harm suffered by the plaintiffs was the "dece[ption of] members of the... public [in] believing that the [defendants'] business is connected and/or similar to the plaintiffs' business".²¹⁰ The plaintiffs also sought relief which was materially similar to that sought under its passing off claim.²¹¹

²⁰⁸ PWS at paras 94-96.

²⁰⁹ PWS at para 94.

²¹⁰ PWS at para 94.

²¹¹ SOC at pp 105-107.

219 It therefore appears to me that there is no further interest that the plaintiffs are seeking to protect under this claim which has not already been addressed by their (successful) passing off action. Even if the plaintiffs succeed on unlawful conspiracy (because the claim of passing off succeeds), they will not be able to recover anything *in addition* to the remedies already granted for the claim of passing off: see *Lim Teck Cheng* at [29]–[30]. On the other hand, if the plaintiffs had failed on their claim for passing off, their arguments on unlawful conspiracy would have collapsed. For these reasons, it is unnecessary for me to make any findings on this claim.

Claim 5: Wrongful detention of the Labels by the defendants

220 The second plaintiff claims against the first defendant for the wrongful detention of the Labels.²¹² The second plaintiff had pre-supplied the Labels to the first defendant with the second plaintiff’s customers’ marks. The first defendant was to affix the Labels on bottles of water which it would then supply to the second plaintiff pursuant to a purchase order between the two parties dated 1 June 2020.²¹³ Sometime before 3 June 2020, the first defendant had informed the second plaintiff that it would not fulfil the second plaintiff’s purchase order dated 1 June 2020.²¹⁴ By way of an e-mail sent on 3 June 2020, Mdm Tan demanded the return of the second plaintiff’s Labels which were held by the first defendant.²¹⁵ The second defendant responded with an e-mail on 4 June 2020 stating that the Labels “[had] been prepared and [were] available for collection as requested”.²¹⁶ Mr Koh states that this answer was “mischievous

²¹² PWS at para 98.

²¹³ SOC at para 71; Set Down Bundle at p 788.

²¹⁴ Set Down Bundle at p 791.

²¹⁵ Koh’s AEIC at para 229; p 3074.

²¹⁶ Koh’s AEIC at para 230.

and misleading” as all travel from Singapore to Malaysia was restricted by way of the Movement Control Order in force in Malaysia at that time. While Mdm Tan sent a further e-mail on 8 June 2020 to clarify matters, no reply was forthcoming up until 17 June 2020. The plaintiffs assert that they were left no choice but to order additional labels to fulfil their contractual obligations to their customers. This order was subject to a minimum order quantity, which resulted in the plaintiffs ordering more labels than they required. In all, the second plaintiff allegedly incurred losses amounting to \$16,565.39. This comprised \$15,450.79 as the “value of the [second plaintiff’s] labels” and \$1,114.60 as the value of the additional labels purchased by the second plaintiff.²¹⁷

221 The first defendant, in response, argues that the plaintiffs were being unreasonable. It highlights, in this regard, that it had sent a letter through its solicitors in Malaysia on 17 June 2020 (“the 17 June 2020 Letter”) which, amongst other things, contained the first defendants’ offer to transport the Labels upon the second plaintiff’s payment of RM2,000.²¹⁸ In addition, the defendants argue that the plaintiffs have failed to prove that any loss was suffered as they adduced no evidence that the Labels were received from or supplied from any of the second plaintiff’s suppliers.²¹⁹

222 I understood the claim in the plaintiffs’ pleadings for “wrongful detention” as a reference to the tort of detinue. Regarding the latter, the claim lies at the suit of the person who has a right to immediate possession of goods against a person who is in possession of the goods and who, upon proper demand and without lawful excuse, fails or refuses to deliver them

²¹⁷ Set Down Bundle at p 802.

²¹⁸ Defence and Counterclaim at para 180; Koh’s AEIC at p 3083.

²¹⁹ Defence and Counterclaim at para 178.

up: *Simgood Pte Ltd v MLC Shipbuilding Sdn Bhd and others* [2016] 1 SLR 1129 (“*Simgood*”) at [159]. In particular, a proper demand is essential for an action in detinue. It is only when the defendant refuses to deliver up the goods in the face of such demand that it becomes wrongful for the defendant to retain the goods: *Simgood* at [161].

223 I accept that the plaintiffs had the right to the immediate possession of the Labels after the defendants informed them that the defendants would be unable to fulfil their orders. This is not disputed by the defendants. I also accept that a proper demand was made by way of Mdm Tan’s e-mails on 3 and 8 June 2020.

224 It is however unclear whether the first defendant had *refused* to deliver up the Labels to the second plaintiff. The first defendant had indicated on 4 June 2020 that the labels were “ready for collection”;²²⁰ this, to my mind, constitutes an attempt at making arrangements to return the Labels to the second plaintiff. In Mdm Tan’s e-mail on 8 June 2020, she also asked the second defendant to “arrange for the [Labels] to be transported to [the plaintiffs]” and that they were “willing to pay all reasonable cost relating to the transportation of the [Labels]”. The second defendant responded to this e-mail through its solicitors, stating that it *was* willing to transport the Labels in exchange for a RM2,000 transportation fee.²²¹ Given that the parties appeared to still be working out the relevant arrangements even on 17 June 2020, there was therefore no refusal on the second defendant’s end to return the Labels. In addition, the plaintiffs did not indicate a timeframe within which the second defendant had to respond by in Mdm Tan’s e-mail on 8 June 2020. They have also failed to direct me to

²²⁰ Koh’s AEIC at p 3074.

²²¹ Koh’s AEIC at p 3083.

evidence which reflects the effects of the Movement Control Order in force at that time. For these reasons, I do not accept that the first defendant had refused to deliver up the Labels to the second plaintiff.

225 Even if the first defendant had refused to deliver up the Labels to the second plaintiff, it is unclear what losses the second plaintiff had suffered. The second plaintiff did not adduce evidence showing (a) the contractual timelines which the second plaintiff was bound to vis-à-vis its customers, (b) the value at which the second plaintiff bought the Labels and (c) the value at which the second plaintiff bought the additional (replacement) labels.²²² Instead, the second plaintiff only produced the invoices which it issued to the second defendant for payment regarding the Labels and the alleged costs incurred to obtain the additional labels.²²³ As such, even if the tort was made out, the second plaintiff has failed to prove its loss.

Counterclaim 1: Breach of the Deed by the plaintiffs

226 The defendants submit that the plaintiffs acted in breach of the Deed, in particular Clause 2.3(2). For convenience, I reproduce Clause 2.3 here:

2.3 Exclusive Rights of ownership of “DR. WHO” marks in Singapore, Malaysia and in other jurisdictions and Mutual Co-existence Rights

- (1) The mark “DR. WHO” is a trademark registered in Singapore and Malaysia. The Kohs and [the Dr. Who Group (including the first plaintiff)] shall be entitled to own and use the mark “DR. WHO” in Singapore and in any other jurisdiction (apart from Malaysia) in the sole discretion of the Kohs, and the Oos and [the first defendant] shall be entitled to own and use the mark “DR. WHO” in Malaysia and in any other jurisdiction (apart from Singapore) in the discretion of the Oos.

²²² Notes of Evidence (6 September 2022) at p 21 line 16 to p 22 line 2.

²²³ Koh’s AEIC at p 3079; Set Down Bundle at p 802.

- (2) Neither party shall *use the DR. WHO trademark* in the other Party's Country without the prior written approval of each party.
- (3) [Mr Oo, Mdm Low and/or the first defendant] shall not, without the prior written approval of [the Dr. Who Group] whether directly or indirectly, *supply or caused to be supplied* bottled water to any other person or entity in Singapore bearing or under the "DR. WHO" mark registered in Malaysia and/or by way of passing off.
- (4) [Mdm Tan, Mr Koh and/or the Dr. Who Group] shall not, without the prior written approval of [the first defendant] whether directly or indirectly, *supply or caused to be supplied* bottled water to any other person or entity in Malaysia bearing or under the "DR. WHO" mark registered in Singapore and/or by way of passing off.
- (5) The Restraint Clauses in Sub-clauses (3) and (4) above are not intended to hinder competition but are necessary for the purpose of protecting [the Dr. Who Group] and [the first defendant's] business, intellectual property and goodwill.

[emphasis added]

227 In this regard, the defendants point to the plaintiffs' various acts of entering into the Distribution Agreement with WRM (see [35(a)]), procuring drinking water from Malaysian suppliers,²²⁴ and the manufacturing and printing of labels and boxes bearing marks which are similar to or identical to any of the "DR. WHO" marks registered in Singapore.²²⁵ They argue that Clause 2.3(2) is not qualified by Clauses 2.3(3) and 2.3(4), as the former restricts the use of trade marks registered in Singapore *and* Malaysia, while the latter prohibits the use of trade marks registered in Singapore *or* Malaysia by the plaintiffs and defendants respectively.²²⁶

²²⁴ DCS at p 5.

²²⁵ DCS at pp 7-8 and 48.

²²⁶ DCS at pp 51-53.

228 The plaintiffs’ defence is as follows. They submit that the proper interpretation of the word “use” in Clause 2.3(2) of the Deed is that it does not prohibit the first plaintiff from the *manufacture* in Malaysia of bottled water bearing marks identical to the DR. WHO quatrefoil device mark and DR. WHO word marks.²²⁷ Instead, Clause 2.3(2) only prohibits the *supply* of bottled water bearing such marks, as set out in Clause 2.3(4). According to the plaintiffs, they have never supplied, sold or distributed bottled water bearing the “DR. WHO” trade marks in Malaysia.²²⁸

229 I repeat my finding above at [205]–[208] that the proper interpretation of Clause 2.3(2) is to view Clauses 2.3(3) and 2.3(4) of the Deed as *exclusively* circumscribing the specific instances of “use” which are prohibited under the Deed. As such, the term “use the DR. WHO trademark” in Clause 2.3(2) refers to the supply of bottled water under the conditions in Clauses 2.3(3) and 2.3(4) respectively. Specifically, Clause 2.3(4) of the Deed prevents the plaintiffs from directly or indirectly supplying (or causing the supply of) bottled water to any person in Malaysia (a) bearing or under the “DR. WHO” mark registered in Singapore and/or (b) by way of passing off. I reiterate that this interpretation is consistent with the parties’ intention to mutually co-exist in Singapore and Malaysia. Clauses 2.3(3) and (4) are broad enough to restrict not only the outright use of the parties’ registered trade marks in each other’s territory, but also the use of *other* marks which may amount to passing off. This, in my view, overcomes the defendants’ objections that the references in Clauses 2.3(3) and 2.3(4) to trade marks registered in Malaysia *or* Singapore respectively render the contractual prohibitions in these clauses too narrow to be coterminous with the scope of “use” in Clause 2.3(2).

²²⁷ PWS at paras 120-130.

²²⁸ PWS at para 126.

230 Having adopted the above interpretation, I now apply my findings to the facts. I find that the second plaintiff is not in breach of Clause 2.3(4) as a result of engaging in the various transactions set out at [35] above. It is undisputed that the plaintiffs did not *supply* bottled water to “any other person or entity in Malaysia”. The evidence instead shows that, under the Distribution Agreement, they had procured the services of WRM in the manufacturing of bottled water, the affixing of the plaintiffs’ customers’ marks on these bottles and the delivering of the bottles to the plaintiffs.²²⁹ In particular, WRM was responsible for the affixing of the customised labels on bottles of water, which would then be delivered to the plaintiffs for their onward distribution in Singapore. The bottles were allegedly transported in carton boxes affixed with the plaintiffs’ marks.²³⁰ In my judgment, such acts did not fall foul of Clause 2.3(4) regardless of the signs which were used on the bottles or their packaging as they were not used in relation to the supply of bottled water to customers in Malaysia. Moreover, such acts did not interfere with the defendants’ business of supplying bottled water bearing the customer’s mark to their customers within the defendants’ territory (Malaysia). The intended objective of the “Restraint Clauses” in Clause 2.3, *ie*, to protect the parties’ respective “business[es], intellectual property and goodwill”, has not been violated.

231 Given my finding above that the plaintiffs have not directly or indirectly supplied or caused to be supplied bottled water to any person or entity in Malaysia, Clause 2.3(4) of the Deed is not breached by the plaintiffs. There is therefore no need for me to consider the further questions of whether the supply of bottled water (a) was bearing or under the “DR. WHO” trade marks registered in Singapore and/or (b) amounted to passing off.

²²⁹ Bundle Part EE at p 333.

²³⁰ Oo’s AEIC 1 at p 84.

232 For the avoidance of doubt, I clarify that my findings above relate only to the issue of whether the defendants’ contractual claim regarding the breach of the Deed has been made out. This issue is *distinct* from the issues of whether the plaintiffs’ acts in Malaysia amount to trade mark infringement or passing off under Malaysian law. Those issues rightfully remain for determination by the Malaysian courts.

Counterclaim 2: The plaintiffs’ unlawful conspiracy to injure the defendants

233 The requisite elements for the tort of unlawful conspiracy have been laid out at [216] above. The defendants argue that the alleged breach of the Deed by the plaintiffs constitutes the unlawful act in this case.²³¹ Given my earlier finding that the defendants’ claim regarding the breach of the Deed fails, this claim must fail accordingly.

Counterclaim 3: The plaintiffs’ non-payment of \$143,665.80 for goods supplied by the defendants

234 The defendants claim that the plaintiffs owe them \$143,665.80 for the supply of bottled drinking water for the period of January to May 2020.²³² The plaintiffs do not dispute both the existence and the quantum of this debt.²³³ As such, I find that the second plaintiff is liable to the first defendant for the sum of \$143,665.80.

²³¹ DCS at pp 9 and 56.

²³² DCS at p 14.

²³³ Koh’s AEIC at para 227; Notes of Evidence (6 September 2022) at p 6.

Counterclaim 4: Wrongful interference with the defendants’ business

235 The defendants submit that the plaintiffs have wrongfully and/or improperly interfered with the defendants’ business with IKEA. They argue that the plaintiffs were not justified in asking IKEA to cease the sale of the Cartons as the Malaysian DR. WHO word marks and the Malaysian DR. WHO quatrefoil device mark were not printed on the side of the Cartons.²³⁴ The defendants also point to the Variation Order on 1 February 2021 and claim that by virtue of this variation, they were entitled to put the name of the first defendant, “DR. WHO (M) SDN BHD”, as well as the defendants’ website on the Cartons.²³⁵

236 To establish the tort of wrongful interference with trade, the defendants must show that (*Paragon Shipping Pte Ltd v Freight Connect (S) Pte Ltd* [2014] 4 SLR 574 at [83]):

- (a) the plaintiffs have committed an unlawful act affecting a third party;
- (b) the plaintiffs acted with an intention to injure the defendants; and
- (c) the plaintiffs’ conduct in fact resulted in damage to the defendants.

237 In my view, the defendants have failed to make out their claim in unlawful interference with trade. First, the defendants have not shown that the plaintiffs’ act of requesting IKEA to stop its sale of the Cartons was an unlawful act. This request was made in July 2020 in line with the terms of the Interim

²³⁴ DCS at pp 16-18.

²³⁵ DCS at p 17.

Injunction. Second, the defendants have failed to prove that the plaintiffs acted with an intention to injure the defendants. On the basis of the evidence before me, I am satisfied that the plaintiffs acted with the legitimate intention of protecting their goodwill.

238 For these reasons, I dismiss the defendants' claim for unlawful interference with trade.

Conclusion

239 In the light of the foregoing, I order an assessment of damages in relation to the plaintiffs' successful claims for trade mark infringement and passing off. I also order that the sum of \$143,665.80 is to be awarded to the second defendant as a result of its successful claim regarding its sale of bottled drinking water to the plaintiffs. I dismiss the other claims and counterclaims brought by the parties.

240 Finally, I make some brief remarks on the manner in which both sides have chosen to run their case. This matter, as I noted in the opening paragraph of this judgment, comprises a multiplicity of claims and counterclaims. While parties are entitled to advance their cases as they see fit, there was really no need for such undue bulkiness here. The plaintiffs, for example, pleaded a claim for unlawful conspiracy alongside a claim for passing off vis-à-vis the same conduct of the defendants. Generally speaking, there is nothing inherently problematic with this approach. Indeed, where several causes of action may be applicable to a single factual matrix, it may be strategic for a plaintiff to plead every cause of action ostensibly available to it since it may only succeed on some but not others. The remedies afforded to the plaintiff may also differ for each applicable cause of action.

241 On the present facts, however, the plaintiffs' claim for unlawful conspiracy was *entirely premised* on the success of the plaintiffs' claim for passing off. Pertinently, there were also *no additional remedies* which were sought by the plaintiffs under their claim for unlawful conspiracy which were not asked for under their passing off claim. In other words, the bringing of the claim for unlawful conspiracy was completely superfluous. If their claim on passing off failed, so too would their claim on unlawful conspiracy; if their claim on passing off succeeded, they would get nothing more from their claim for unlawful conspiracy. The defendants fell into the same error, pleading a claim for unlawful conspiracy which was entirely premised on their claim for the breach of the Deed and pursued the same remedies for what was essentially the same loss.

242 A kitchen-sink approach of the sort employed by both parties not only wastes judicial resources, but also risks distracting from the true dispute(s) at play. Parties should distance themselves from the misconception that one's prospects of success will always increase in proportion to the number of claims or allegations that one makes (see *Xia Zhengyan v Geng Changqing* [2015] 3 SLR 732 at [100]). This is especially so where, as in the present case, the claims are based on the same conduct, the remedies sought are identical and the success

of the claims are interdependent. As such, I shall take the above into consideration when I hear the parties separately on costs.

Dedar Singh Gill
Judge of the High Court

Rakesh s/o Pokkan Vasu, Winnifred Gomez and Farhan Tyebally
(Gomez & Vasu LLC) for the plaintiffs and defendants in
counterclaim;
Anand s/o K Thiagarajan (AKT Legal Chambers) for the defendants
and plaintiffs in counterclaim.