

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1993] SGHC 298

Suit 2310/1990

Between

Pernod Ricard SA
Another

... Plaintiff

And

Allswell Trading Pte Ltd

... Defendant

GROUND S OF DECISION

Tort — Passing off — Misrepresentation or confusion

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Pernod Ricard SA and Another v Allswell Trading Pte Ltd

[1993] SGHC 298

Suit 2310/1990
K S Rajah JC
17 December 1993

1 Cur Adv Vult

2 This is an action for passing-off and the question is whether the defendants' orange drink 'Purdy's' will be purchased by members of the public as being or associated with the plaintiffs' orange drink 'Orangina' because of the bulb-shaped bottle, textured surface sleeve, etc.

3 The plaintiffs claim:

(1) an injunction restraining the defendants from passing off any product which is not the plaintiffs' Orangina product as and for the plaintiffs' product and, in particular, from manufacturing, or causing to be manufactured, importing, distributing, advertising for sale, offering for sale or selling the Purdy's product in bottles, containers or packaging bearing the get-up substantially identical with or misleadingly or deceptively similar to the Orangina;

(2) an order for delivery up, or destruction under supervision of the plaintiffs, of products the manufacture, importation, distribution, advertisement for sale, offer for sale or sale of which by the defendant would be a breach of the injunction;

(3) full discovery;

(4) damages or, at the plaintiffs' option, an account of profits;
and

(5) interest and costs.

4 The first plaintiff is a company incorporated under the laws of France. The second plaintiff is a company incorporated under the laws of the State of Delaware, United States of America and is a wholly-owned subsidiary of the first plaintiff.

5 The defendants are a company incorporated in Singapore. It has a paid-up capital of \$2. The two directors are married to each other.

6 **Orangina**

7 In 1936, a concentrated orange juice product was manufactured, distributed and sold in bulb-shaped bottles by one Leon Beton under the mark 'Orangina' ('Orangina product'). Leon Beton incorporated the company Campagnie Francaise des Produits Orangina ('CFPO') in 1952 which manufactured and sold the Orangina product.

8 In 1984, the first plaintiff acquired the company selling CFPO, thereby gaining ownership of the reputation and goodwill of the Orangina product, and created a division within the company called Orangina International Company to co-ordinate the manufacture and marketing of the Orangina product. After 1985, Orangina International Company and the second plaintiff developed an international market for the Orangina product by advertising, promoting, offering for sale and selling the Orangina product outside France.

9 The Orangina product sold in Singapore has the following features:

- (a) The Orangina bottle is bulb-shaped.
- (b) The entire exposed area of the Orangina bottle has a textured surface.
- (c) The Orangina bottle has a plastic neck sleever which cuts off just below the screw cap.

10 The Orangina product with the above get-up has been extensively advertised, promoted, offered for sale and sold in Singapore by the plaintiffs since 1986. The plaintiffs say they have acquired, and enjoy, a substantial reputation and goodwill in Singapore and internationally of the Orangina product in the above get-up and Orangina has become known in the trade and to the public in Singapore and internationally as signifying the product of the plaintiffs. Orangina is now available in cans and PET bottles which are not bulb-shaped.

11 **Purdy`s in the market**

12 In early August 1990, the defendants offered for sale an orange-based drink in bulb-shaped bottles. Legal action was threatened on the ground that the get-up was substantially identical with the plaintiffs` product or misleadingly or deceptively similar to the get-up of the Orangina product. The defendants withdrew the product, but have now introduced `Purdy`s` after making a few changes.

13 The plaintiffs claim that the defendants had wrongfully sold, passed off, or participated in the sale and passing-off, or caused, enabled or assisted others to pass off their product as and for the Orangina product and is still offering for sale and/or causing to be offered for sale the Purdy`s product.

14 The plaintiffs are unable to give particulars of all the specific acts of passing-off committed by the defendants and seek to recover damages and an

account of profits in respect of each and every act of passing-off where the defendants had deceived and misled the trade and public into believing that the Purdy's product is, or is associated with, the Orangina product.

15 The plaintiffs' sales and marketing manager's evidence is that the Orangina product has been sold in the bulb-shaped bottle since 1936 and that Orangina product has been sold in its present shape since 1936. The Orangina product has been sold in Singapore in its present get-up since its first introduction in Singapore, and was sold in Singapore for five years before the defendants introduced the Purdy's product.

16 The sale of the Orangina product in the bulb-shaped bottle has been substantial. About 2,833,284 Orangina products had been sold in the subject get-up in Singapore by December 1990. In 1990, a total of 237,300 Orangina products in the subject get-up was sold. The plaintiffs produced the range of get-up for orange beverages, to which the Orangina product belongs. The defendants added four products making a total of 27 such items.

17 Fifteen of the 27 items were packaged in cans, six in plastic containers and six in glass bottles. Of the six items packaged in glass bottles, Green Spot bottles are now not available in glass bottles in Singapore. The Sunkist Orange product is not regarded as being within the same class of goods as it is a concentrated syrup and not a beverage.

18 **Orange beverages in bottles**

19 The only orange beverage products in the market packaged in bottles apart from the plaintiffs' and defendants' products are Lucozade, Spring Valley, Sunraysia and Granini orange products. The bottles are not bulb-shaped and do

not have a plastic neck sleeve. They all bear a paper label on the main body of the product. The defendants' get-up of the Purdy's product has the closest resemblance to the plaintiffs' Orangina product, which, the plaintiffs say, is distinct and the defendants are cashing in on the distinctive get-up and the reputation and goodwill in the get-up of the plaintiffs' bottle.

20 The five attributes of Orangina

21 The plaintiffs say that their distributors and bottlers all over the world are educated by way of a video presentation on the five attributes of the Orangina product. One of the five attributes is the bottle. The video presentation shows that the bottle is the brand symbol notwithstanding the availability of the beverage in cans. Mr Wolfgang Haf, the accounts director of Dentsu Young & Rubicam, the advertising company in charge of the plaintiffs' advertising efforts in Singapore, testified that his company had been involved in the promotion of the plaintiffs' product since its launch in November 1985, and that, although he was personally involved from 1989, the marketing strategy has remained consistent since 1985 in using the shape of the bottle as the key focus of the plaintiffs' marketing efforts.

22 Mr Wolfgang Haf said that the bottle is unique in its form and shape and is clearly recognizable at the point of sale or when advertising. Mr Haf's advertising efforts were channelled towards the creation of the strongest possible association in the minds of the public between what he called 'the highly distinctive packaging' and the product content.

23 A variety of promotion items and promotional material were tendered as exhibits in court, and there is evidence of contests organized in newspapers to create awareness of the product and to create further awareness of the get-up.

Between 1985 to November 1992, over \$3m was spent on promoting and, the plaintiffs say, the focus of advertisements was on the distinctive get-up. Publication in newspapers, television and cinemas for the length of time the Orangina product has been in the market has effectively achieved the plaintiffs' purpose of creating an association in the minds of the public of the get-up and the plaintiffs' product and its contents.

24 Mr Leroy McCully, a consumer, gave evidence that he mistook the defendants' product to be the plaintiffs' product, and that Purdy's was bought in the mistaken belief that he was purchasing Orangina. He left me with the impression that he was not all that enthusiastic over the shape of the bottle or Orangina and just wanted an orange drink. He was aware that it was not Orangina before him but, nevertheless, consumed it.

25 Linda Chu, the plaintiffs' sales and marketing manager, admitted that although the shape of the bottle is constant, the sleeve might not be present. In France, the Orangina product has no sleeve and has only a bottle cap.

26 **Defence**

27 The defendants' case is that the Orangina product does not have the distinctive get-up claimed by the plaintiffs. Orangina is not the only bulb-shaped bottle for orange or orange-based drinks in the Singapore market that has a textured surface on the entire exposed area of the bottle, nor is it the only bottle with a plastic neck sleeve which cuts off just below the screw cap. The plaintiffs market and sell the Orangina drink in bulb-shaped bottles, cans and one-litre PET bottles, and the get-up of the 'Purdy's' product is substantially different from the get-up of 'Orangina'.

28 The liquid of the Purdy's product is a rich orange colour and different from the Orangina product which is a pale yellow colour. The colour and design of the label and trade mark logo of the Purdy's product is completely different and distinct from that of the Orangina product. The label on the Purdy's product is green but the label on the Orangina product is blue. Purdy's product has the word 'Purdy's' on it distinguishing it from the Orangina product. The Purdy's bottle has a shorter neck and a squat base with a fuller round bulb, whereas the bottle of the Orangina product is a slimmer bottle with a longer neck and a more slender bulb shape. A photograph was produced showing the two products on sale to make the point that the bulb-shaped bottles look, and are, different so that there cannot be deception and the public misled.

29 The Purdy's product is sold in 235ml bottles and the Orangina product is sold in 200ml bottles. The orange juice of the Purdy's product contains 30% juice and is a still drink. The orange drink of the Orangina product contains 12% juice and is tangy and carbonated. The products are different from each other and the get-up of the Purdy's product was adopted and used by the defendants in good faith without reference to the get-up of the Orangina. The Purdy's product is not calculated to mislead nor can it lead to the defendants' product being passed off as an Orangina product. If the proof of the pudding is in the eating, then the puddings here will taste different.

30 The defendants deny having passed off or sold any goods as being or as for the plaintiffs' goods and no person could reasonably be expected to be deceived or led to believe that the Purdy's product was the plaintiffs' Orangina product or in any way associated with the Orangina product because of the differences in the get-up.

31 **Differences in get-up**

32 There are three differences in the get-up between the `Orangina bulb-shaped bottle with blue sleeve` (P2) sold in Singapore and `Orangina with bottle cap as sold in France` (P3):

- (1) one has a sleeve, the other does not have a sleeve;
- (2) one has a label, the other does not have a label; and
- (3) one has a screw cap, the other does not have a screw cap.

33 There are also differences in the get-up between P2, the Orangina bottle with a paper label and screw cap, and P4, which has a neck sleever and a label on the belly of the bottle. The plastic sleever on P2 is a legal requirement and sets out the ingredients in the product and is functional. Orangina is available in cans and in plastic PET bottles (1.25 litres). The bulb-shaped bottle and cans were introduced around the same time in November 1985/1986. In 1987, a one-litre glass bottle was introduced but was withdrawn at the end of 1987 or early 1988. In 1990, the Orangina PET bottle was introduced. The Orangina cans on sale today are in blue 325ml can which have a different logo.

34 The exhibits used to promote the reputation of the Orangina product have some minor differences:

- (1) There is no blue sleever on the Orangina-shaped plastic lamp (P31), the button pin of Orangina with an on/off flashing capacity (P32), the plastic toy top with spring mechanism (P34), the Orangina collar pins (P35), the Orangina racquet bag (P36), and the glass featuring the bulb-shape of Orangina is very French (P37);
- (2) There is no screw cap on the Orangina-shaped plastic lamp (P31);
- (3) The Orangina magnet (P33) and Orangina collar pins do not have a textured surface;

(4) The Great Orangina Cash Flow Promotion required cans and PET bottles to be purchased in one transaction but there was no requirement to buy bulb-shaped bottles.

35 **Names and shapes**

36 The defendants produced materials which they say promote the brand name Orangina rather than the Orangina product in the bulb-shaped bottles:

(1) The Orangina Sweep has no bulb-shaped bottle in the Cold Storage retail chain promotion to encourage consumers to buy more Orangina. There are two logos of Orangina but no bulb-shaped bottle is shown. The product displayed is the Orangina can.

(2) ***The Straits Times*** dated 26 March 1992 shows PET bottles of Orangina being advertised and no bulb-shaped bottles.

(3) ***The Straits Times*** dated 6 November 1992 shows Orangina being advertised in two PET bottles. No bulb-shaped bottle was advertised.

(4) ***The Straits Times*** dated 24 October 1992 advertises two PET bottles of Orangina. No bulb-shaped bottle was advertised.

37 **Video commercials**

38 The three video commercials, the defendants say, promote the brand Orangina, rather than the Orangina product in the get-up of the bulb-shaped bottle, for the following reasons:

(1) Both the `Waiter animation` commercial and the `Restaurant` commercial feature a bulb-shaped bottle with no blue sleeve, and the PET bottle was also displayed.

(2) The `Swing` commercial features a bulb-shaped bottle with no blue sleeve. The Orangina can and Orangina PET bottle were displayed at the end of the commercial.

(3) All three commercials show a bulb-shaped bottle with a blue label on the belly of the bottle.

(4) The get-up of P2 does not appear in all the commercials and the get-up of the bulb-shaped bottle as in P4 also appears.

39 Mr Wolfgang Haf said that the key focus of the marketing efforts of the plaintiffs is the bulb-shaped bottle but the `Water skiing` commercial shows a bulb-shaped bottle and 1.0 litre glass bottle which is bulb-shaped at the top. This 1.0 litre glass bottle has been taken over by the plastic PET bottle with a different shape and the get-up for the PET bottle has taken over the 1.0 litre glass bottle.

40 The `Restaurant` commercial shows the bulb-shaped bottle with the blue label around the belly of the bottle. The bottle in this commercial has, in fact, the same get-up as in P4. Mr Wolfgang Haf has admitted that it is different from P2 in two ways:

(1) there is an embossed glass inscription on P2; and

(2) the neck labels are different.

41 In his evidence, Mr Wolfgang Haf also accepted that the `Redeem a gift` promotion involved the exchanging of six Orangina pull rings or six labels from the bulb-shaped bottle or three labels from the PET bottle for a prize. The bulb-shaped bottle is, therefore, not the main emphasis in this promotion.

42 Mr Wolfgang Haf accepted that three of the five prizes in the promotion featured the bulb-shaped bottle but the plastic toy with the spring mechanism is in the shape of the bulb-shaped bottle without the blue label or sleeve. The Orangina racquet bag which is shaped like a bottle has no blue sleeve/label. The button pin of Orangina with on/off flashing capacity has no blue label/sleeve or screw cap as it is an artist's version.

43 In re-examination, Mr Wolfgang Haf said that the public would be able to identify the button pin (P32), the plastic toy (P34) and the racquet bag (P36) as Orangina because the name Orangina was on each of the exhibits but no evidence was adduced to say that the public perception would be that P32, P34 and P36 would be so identified without the word `Orangina` on them.

44 The `The New Paper/Orangina Mind Games` made use of the bulb-shaped bottle, but the snappy slogan was `Shake the bottle, wake the taste`. The evidence of Mr Wolfgang Haf went some way to support the defendants` contention that the orange drink Orangina is better, if not equally well, known by its sing-song name `Orangina` which is available in bulb-shaped bottles, cans and PET bottles.

45 **Issues**

46 The issues before me were:

(1) Whether the plaintiffs have a reputation and goodwill in respect of the Orangina orange drink as marketed in the get-up comprising:

- (a) the bulb-shape of the bottle;
- (b) the orange textured surface on the bottle; and
- (c) the plastic neck sleever with Orangina and the logo.

(2) Whether there has been misrepresentation by the defendants by their sale of the Purdy`s orange drink in its get-up:

- (a) the bulb-shaped bottle with a bigger belly;
- (b) the textured surface of dots; and
- (c) the green screw on cap and sleever with the name `Purdy`s`.

(3) Whether loss and damage has been suffered by the plaintiffs as a result of the misrepresentation.

47 **Law**

48 In *Erven Warnink Besloten Vennootschap & Anor v J Townend & Sons (Hull) Ltd & Anor* , Lord Diplock said (at p 742):

*My Lords, **AG Spalding & Bros v AW Gamage Ltd** 84 LJ Ch 449, and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing-off: (1) a misrepresentation, (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so. ...*

49 The question whether the plaintiffs have a reputation and goodwill in the `Orangina` orange drink in the bulb-shaped bottle with the textured surface and the plastic neck sleeve requires an examination of two main elements:

- (1) reputation; and
- (2) goodwill.

50 **Reputation**

51 The plaintiffs must show that the orange drink in bulb-shaped bottles has become distinctive of the plaintiffs` goods and that the get-up is understood by the trade and the public in this country as meaning that the goods are the plaintiffs` goods because the plaintiffs, by using and making known the get-up in relation to their goods have caused the plaintiffs to be associated or identified with the orange drink in bulb-shaped bottles and have acquired a quasi-proprietary right to the exclusive use of the get-up, which right is invaded if any person uses the same or some deceptively similar get-up in relation to goods not of the plaintiffs` manufacture because it would induce customers to buy goods

not of the plaintiffs' manufacture as goods of the plaintiffs' manufacture, thereby diverting to himself orders intended for and rightfully belonging to the plaintiffs. (See p 353 para 16-10 of **Kerly's Law of Trade Marks and Trade Names** for a definition of reputation, and para 2.02 of Wadlow's **The Law of Passing-Off** (1990 Ed) for a definition of goodwill.)

52 The action for passing off at common law originally grew out of the action for deceit, and, like the action for deceit, required a false representation made fraudulently, but differed from it in that the persons deceived were the plaintiff's customers rather than the plaintiff himself. The action at common law was extended to cases where the defendants' customers were not themselves deceived but the defendants sold fraudulently marked goods to retail dealers with the express purpose of the goods being resold to ultimate purchasers as the plaintiffs' goods. Equity's protection was based on a right of property as against relief of law based on fraud.

53 In **Schweppes Ltd v Gibbens**,² at pp 606-607 (HL), Lord Halsbury LC expressed the view that, if persons are so careless that they do not treat the label fairly but take the goods without sufficient consideration and without reading what is written plainly on them, they cannot be said to be deceived because they do not care what they are getting. A competing trader may adopt a get-up similar to that of the plaintiff's product not in order to pass-off his goods as the plaintiff's but in order to impliedly represent to the public that his goods are similar to, or a substitute for, the plaintiff's, thus competing in, and taking advantage of, a market created by the plaintiff's efforts; this is legitimate so long as he does not thereby represent his product as the plaintiff's.

54 In **John Haig & Co Ltd v Forth Blending Co and Paterson**,³ the petitioner had sold a brand of whisky in distinctively shaped bottles known as

`three-pinch decanters` but which had come to be known as `Dimple` bottles and this brand was commonly asked for as `Dimple` whisky. The respondent was restrained from selling whisky not blended by the petitioner in `Dimple` bottles for consumption in the UK even though the respondent`s labels were quite different to the petitioner`s labels.

55 In ***Reckitt & Colman Products Ltd v Borden (No 3)*** ,⁴ an injunction was granted restraining the use of plastic simulated lemon-shaped containers but in ***John Haig & Co Ltd v Brooks & Bohm (Wine Shippers) Ltd*** ,⁵ Roxburgh J refused an injunction as the defendant`s bottles had no actual depressions and the plaintiff had not shown there was any likelihood of the public buying by the shape of the defendant`s bottles. And in ***Coca-Cola Co v AG Barr & Co Ltd*** ,⁶ an injunction was refused as the respondent`s drink was of a different colour to the petitioner`s though the bottles were of the same shape. In this case, the orange drinks are of a different colour.

56 **Simulation protection**

57 Leonard J, in the High Court of Hong Kong in ***Kemtron Properties Pty Ltd v Jimmy`s Co Ltd*** , dealt with the ambit of the protection given to a trader against simulation of his product by a rival trader.

58 The plaintiffs in that case marketed the Mistral fan in Hong Kong under a United Kingdom patent registered in Hong Kong. The defendant also marketed an almost identical fan known as the Koolaire. The court concluded that the fans were almost identical and that the defendant`s fan was a copy of the plaintiffs`. The only distinguishing feature was that the defendant`s fan bore the name Koolaire instead of the name Mistral which appeared on the plaintiff`s fan. The plaintiffs sought to restrain the defendant from selling the Koolaire fan.

The substantial questions to be tried were the two issues of patent infringement and passing-off. The question of patent infringement posed no problem but the allegation of passing-off became the contentious issue.

59 The learned judge said that the courts have repeatedly said that copying alone is not passing-off. Any trader is free to copy and sell the product of another provided it does not result in infringement of copyright or patent, or of a registered trade mark or design, and provided that the copies do not directly or indirectly represent that the product is that of the plaintiffs, by copying a get-up distinctive of the plaintiffs`. The two requirements of distinctiveness and misrepresentation, not simple misappropriation, are regarded as basic requirements of the action. The customers must buy the product thinking that it is the plaintiffs` because the get-up has become identified in their minds with the plaintiffs` goods and, even where the defendant puts his name on the goods, it will not be enough, if a customer thinks that it is the product of the plaintiffs.

60 The manufacturers of Purdy`s and the plaintiffs are competing traders. The director of the defendants` company, Mr Jirasak, gave evidence. He is a shrewd businessman. He was not interested in expensive litigation but in legitimate business, even if it required cutting things fine, provided it was proper. The defendants may have taken advantage of a market created by the plaintiffs` efforts in creating a market for orange juice but there is a difference between a drink that emphasizes the natural and healthy drink and the fizzy fun drink of the plaintiffs.

61 **Court`s duty**

62 The court`s duty is to have regard to the characteristics which are common to the trade. Bulb-shaped bottles are used to sell drinks of various kinds

and by those in the trade selling the better orange drinks. Its use as such is unobjectionable. The defendants have not copied all the features of the get-up of the plaintiffs' bottle.

63 **Shape and passing-off**

64 It is possible for passing-off to occur by reason of the similarity of the shape, as opposed to the features, but where what is sought to be restrained is the copying of the bulb-shape of the plaintiffs' bottle which has value in use, as opposed to capricious attributes of shape or colour, the courts are reluctant to allow a plaintiff to secure a monopoly in a new type or design of goods under the guise of a passing-off action. (See *William Edge & Sons Ltd v William Niccolls & Sons Ltd.*)

65 The primary meaning of the shape of the bottle as bulb-shaped is descriptive. The plaintiffs face a heavy burden when they seek to prove that a shape which is prima facie functional has acquired a secondary meaning. There is no question of fraudulent intent because the product was withdrawn when challenged and changes made to the get-up, even when the defendants were of the opinion that bulb-shaped bottles have been in use from ancient times.

66 Confusion which arises as a result of a new competitor selling a type of goods which previously was sold by the plaintiffs is not regarded in law as arising from a representation made by the defendants. The trader who simply copies the attributes of the plaintiffs' goods which gives some benefit for use is not treated in law as thereby making a representation. It arises only when there is an adoption of a distinguishing combination of features, each of which is a utility which can amount to passing off. In this case, the screw caps are different in colour. Purdy's stands out as a name. The texture on the bottle, its round belly

and the different colour of the drink make the defendants' bulb-shaped bottle 'Purdy's' distinctive.

67 Bulb-shaped bottles have ancient origins. I accept the photograph that was produced to show that the products, when displayed for sale, can be distinguished. The term 'get-up' has never been clearly defined and it is in the vagueness of the concept that the principal confusion in the area lies, but the courts are more ready to find passing off where there is clear evidence of deliberate copying as in the Mistral fan case⁷ because the issue becomes one of unfair competition and the defendant seeking to reap where he has not sown.

68 **Exhibits**

69 When the plaintiffs' exhibits of its orange juice in bulb-shaped bottles are compared, P2 has a dark blue screw cap, blue sleeve and is described as a 'sparkling citrus juice drink'. The texture of the orange has been reproduced on the surface of the bottle and the name 'Orangina' appears on the screw cap with the logo of an orange peel that is artistic and appealing.

70 The words '*Orangina a la pulp du fruit gazeifie*' is embossed on the glass and the name Orangina in capital letters appear in white against the dark blue background of the sleeve.

71 Four bottles of the plaintiffs' Orangina product were produced:

P2: Orangina bulb-shaped bottle with dark blue sleeve and screw-on cap, etc;

P3: Orangina bulb-shaped bottle as sold in France with a bottle cap and without a sleeve;

P4: Orangina bulb-shaped bottle with a paper label and blue screw-on cap without a sleeve;

P51: Orangina in bulb-shaped bottle with a light blue cap.

72 The colour of the drink, the bulb-shaped bottle and texture are consistent features but the get-up cannot be said to consist only of the bulb shape of the bottles.

73 When the defendants' product, Purdy's (P5), is placed alongside the range of the bottles, the blue and green sleeves and the different colours of the drinks stand out so that no man can say you passed 'Purdy's' for 'Orangina'. The photograph of the plaintiffs' and defendants' products on the shelf (P30) is decisive.

74 The plaintiffs have run their case by seeking to establish goodwill and reputation in the name Orangina in the bulb-shaped bottle as the get-up in which they have reputation and goodwill in orange drinks. The name Orangina has been widely advertised locally and large sums have been spent in promoting it. Its sales are substantial since its introduction here in 1985 and its sales figures have increased. There is no dispute on that score but it is the plaintiffs' claim that the bulb-shaped bottle is distinctive in design and appearance and forms part of the get-up that is in issue.

75 In **Williams v Bronnley**,⁹ Fletcher Moulton LJ as he then was, said:

... The get-up of an article means a capricious addition to the article itself - the colour, or shape, it may be, of the wrapper, or anything of that kind; but I strongly object to look at anything that has a value in use as part of the get-up of the article. Anything which is in itself useful appears to me rightly to belong to the article itself. For instance, supposing the firm had been, say for 20 years, the only firm to sell wooden chairs in which the natural wood was simply varnished, and not painted at all, that would not give them the slightest right to complain of a person putting on the market chairs simply varnished, even though they

have been the only persons who had sold them for so long that such chairs might at first be supposed to be their manufacture. The reason is that the newcomer has not in any way imitated the get-up; he has only produced an article. ...

76 An external examination shows differences: the contents are different in colour and in quantity. When placed side by side for sale, their differences stand out.

77 The question of recognition by 'the relevant members of the trade' has not been stressed in this case and the question is one of recognition by the public. In *John Haig & Co Ltd v Forth Blending Co and Paterson*,¹⁰ Lord Hill Watson set out a number of legal propositions. Proposition 5, at p 261, contains this sentence:

... No trader, by adopting and using a particular style of get-up, thereby acquires a right to prevent a rival or second trader using the same or a similar get-up, unless the get-up of the first trader has become so associated in the minds of the public with the first trader's goods as to be distinctive of the goods of the first trader and of no other. ...

78 Where the 'get-up' consists of characteristics of the product itself, such as the shape and colour of the article itself, such proof is not easy because the common law leans against the recognition of a monopoly right. The plaintiffs' task to establish such a right is particularly difficult where, as here, the distinctiveness claimed for the product itself in some degree involves a copy of, or supposed resemblance to, some pre-existing artistic style in bottles.

79 A distinctive feature of an article which has utility may be a feature of get-up lawful to copy but, as *Kerly* (10th Ed, at p 420) has observed, 'courts have shown themselves astute to reject attempts to prevent copying of goods under the guise of passing-off action', whilst giving relief where the copying of

a combination of features, each of them utilitarian, amounts to the appropriation of get-up.

80 In ***Reckitt & Colman Products Ltd v Borden Inc & Ors***,¹¹ at p 499, Lord Oliver of Aylmerton said:

Although your Lordships were referred in the course of the argument to a large number of reported cases, this is not a branch of the law in which reference to other cases is of any real assistance except analogically. It has been observed more than once that the questions which arise are, in general, questions of fact. Neither the appellants nor the respondents contend that the principles of law are in any doubt. The law of passing-off can be summarized in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognized by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is, in fact, the plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers, or, in a quia timet action, that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

81 Thus, the three issues in the instant case, leaving aside the issue of fraud which is now no longer material, were and are as follows:

(i) Have the respondents proved that the get-up under which their lemon juice has been sold since 1956 has become associated in the minds of substantial numbers of the purchasing public specifically and exclusively with the respondents' (or Jif) lemon juice?

(ii) If the answer to that question is in the affirmative, does the get-up under which the appellants proposed to market their lemon juice in all or any of the Mark I, Mark II or Mark III versions amount to a representation by the appellants that the juice which they sell is 'Jif' lemon juice?

(iii) If the answer to that question is in the affirmative, is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' lemon juice in the belief that it is the respondents' Jif juice?

82 The three questions that I must ask and answer are:

(i) Have the plaintiffs proved that the get-up under which their orange drink has been sold in Singapore since 1985 has become associated in the minds of substantial numbers of the purchasing public specifically and exclusively with the plaintiffs' Orangina in bulb-shaped bottles?

(ii) If the answer to that question is 'yes', does the 'get-up' under which the defendants propose to market Purdy's, in their version of bulb-shaped bottle, amount to a representation by the defendants that the orange drink which they sell is the fun drink which must be associated with the plaintiffs' product Orangina sold in bulb-shaped bottles?

(iii) If the answer to the second question is 'yes', is it, on a balance of probabilities, likely that, if the defendants are not restrained, a substantial number of members of the public will be misled into purchasing the defendants' orange drink named 'Purdy's' in bulb-shaped bottles in the belief that it is the plaintiffs' orange drink 'Orangina' in bulb-shaped bottles?

83 In my judgment, the plaintiffs have proved that their orange drink Orangina has been sold in Singapore since 1985. It is available in bulb shaped bottles, cans and PET bottles. 'Orangina' has become associated in the minds

of the public as a French soft drink and its singsong name has goodwill and reputation.

84 I am unable to find that there is a likelihood of the public buying the defendants' Purdy's orange juice, in its bulb-shaped bottles, as Orangina or that it will become associated in the minds of substantial members of the public as being the plaintiffs' product for it does not have, inter alia, the French flair stressed in the video commercials.

85 The defendants' Purdy's orange juice, in its bulb-shaped bottles, has a shape, colour and a get-up that is distinct. I find that there is no misrepresentation and 'Purdy's is not likely to be passed off as Orangina', notwithstanding the evidence of Mr Le Roy.

86 It is not likely, on a balance of probabilities, for substantial members of the public in Singapore to be misled into purchasing the health drink 'Purdy's' when they want the fun drink 'Orangina'.

87 I am unable to say that the defendants' orange juice, with pretensions to being a natural orange juice, in the Purdy's bulb-shaped bottle get-up, will be associated with the plaintiffs 'Orangina' in bulb-shaped bottles in the public mind.

88 The plaintiffs' claim is dismissed with costs.

89 ***Plaintiffs' claim dismissed.***

Pernod Ricard SA and Another v Allswell Trading Pte Ltd

[1993] SGHC 298

K S Rajah JC

Genevieve Tan and Jason Chan (Allen & Gledhill) for the plaintiffs
Patrick Yap (KL Tan & Associates) for the defendants
