IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1994] SGHC 184

Suit 277/1990, 278/1990, 279/1990, 280/1990, Consolidated

Between

Risis Pte Ltd

… *Plaintiff*

And

Polar Gems Pte Ltd

… *Defendant*

GROUNDS OF DECISION

Designs — Registered designs

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Risis Pte Ltd v Polar Gems Pte Ltd and Others

[1994] SGHC 184

Suit 277/1990, 278/1990, 279/1990, 280/1990, Consolidated
Warren Khoo L H J
16 July 1994

1 Cur Adv Vult

2 The claim in these consolidated suits is for infringement of a design registered under the 1949 Registered Designs Act of the United Kingdom made applicable in Singapore by our United Kingdom Designs (Protection) Act (Cap 339). The design concerned is what is said to be a depiction of the national flower of Singapore, an orchid known as dendrobium Vanda Miss Joaquim. The registration number, for the record, is 1031278. The design was registered in respect of its application `to an ornamental piece for use in the construction of a fashion accessory, such as a pendant, brooch or earring.`

3 The defence, apart from disputing infringement, is that the registered design was not new or original within the meaning of the United Kingdom Act. There is a further alternative defence of innocent infringement.

4 The plaintiffs are manufacturers and distributors of Singapore gifts, meaning mementos and souvenirs with a touch of Singapore, of particular attraction to tourists. Among their better known products are gold plated orchids marketed under the Risis label. Although in some instances the real natural

flower is used for such products, that is not the case in regard to the articles with which these proceedings are concerned. They are merely gold plated objects with the appearance of an orchid, said to be that of the national flower.

5 The defendants, except for Han Chang, are retailers operating outlets in shopping centres and at tourist spots. Among the things they were selling were gold plated ornamental orchids, that is to say, again, gold-plated objects of varying sizes with the appearance of an orchid. Like the plaintiffs` products, these objects were incorporated as part, no doubt the essential part, of jewellery items like earrings, bracelets, sliders, pendants and so forth. Han Chang is essentially a manufacturer of such products. In early 1990, the plaintiffs discovered that the defendants were selling products which they considered to be infringing their registered design. They decided to take legal action. The plaintiffs` witness Mr Tan Eng Soon was put in charge of the matter. The plaintiffs conducted trap purchases at the premises of the defendants (except Han Chang). They then took out these actions, obtained an interim injunction and Anton Piller order against each of the defendants, including Han Chang. The Anton Piller order was executed and articles considered to be infringing the registered design were seized. In the case of Han Chang, the rubber moulds for making the products were also seized. Samples of the products, and the rubber moulds, were produced in court, so were the articles bought in the trap purchase exercise.

6 **The plaintiffs` evidence**

7 Mr Tan Eng Soon, manager of the plaintiffs in charge of the materials & business development department, testified that the plaintiffs` predecessor was Setsco Pte Ltd. Setsco was a subsidiary of SISIR. Setsco started manufacturing and selling ornamental orchids in 1976 under the Risis label,

Version No 1: 29 Oct 2026 (23:45 hrs)

Risis, be it noted, being SISIR spelt in reverse. Setsco used easily 40 to 50 varieties of orchids. They used the natural flowers and applied a gold plating to them. Setsco did not keep any records as to the actual varieties used nor were there any attempts at registration. In 1981, Vanda Miss Joaquim was declared the national flower of Singapore. From 1982 Setsco started producing and marketing an ornament of the national flower. The real flower was not used because a gold plated Vanda Miss Joaquim would be too big for use as a personal ornament. Setsco, instead, came up with its own interpretation and conception of the national flower. The code used by Setsco for this product was RJ-001. Mr Tan managed to produce one sample of the flower sold by Setsco (exh P-22). This sample represents the prior art for the purpose of these proceedings on the issue of novelty.

8 It would appear from Mr Tan`s evidence that a decision was taken in 1985 to have the business of Setsco taken over by the plaintiffs. In his own words, Setsco was `hived off` and the plaintiffs took over the manufacture and distribution of Setsco`s products in August 1985. The plaintiffs, however, did not produce ornaments of Vanda Miss Joaquim at that time.

9 On 23 December 1985 they applied for the registration of the subject design, based, Mr Tan says, on their interpretation of the national flower. Mr Tan`s evidence is that the plaintiffs started producing and selling ornaments of the registered design only in 1986, possibly at the end of 1986. Samples of the plaintiffs` products allegedly fashioned to the registered design were produced as exhs P-3 to P-6.

10 **Similarities and differences**

Version No 1: 29 Oct 2026 (23:45 hrs)

11 I now turn to examine the differences and similarities in the plaintiffs` and defendants` products, P-22 and the registered design. For the products, I look particularly at the larger samples as the features are more easily seen. In any comparison between the products, including P-22, and the registered design, one is comparing a three-dimensional object with a two-dimensional presentation. However, in so far as the relevant aspect of registered design presentation is what is described as the rear view, this is not a very significant difficulty, as one can see the reverse side of the products as well.

12 To enable the ensuing observations to be intelligible, and for this purpose only, the registered design (two of three views), P-22 and samples of the plaintiffs` and defendants` products are reproduced by photocopy in the Appendix to this judgment. For the defendants` products, one of the pieces of exh P-16 has been selected. It is large enough for the features to be easily seen, and it appears to be by and large similar in appearance to the larger pieces of the defendants` products in general. For the plaintiffs` products, exh P-3 for similar reasons (substituting `plaintiffs` for `defendants`) has been selected. The photocopies of the products do not represent their exact sizes. I must add also that in making the comparisons involving the physical objects, I of course look at the objects themselves rather than the photocopies.

13 I state my general conclusions first and then go into the details. First, it can be fairly stated that on the features of similarities and differences with which we are concerned, there is a fair degree of similarity between the plaintiffs` products and the defendants` products. Second, there is little or no significant similarity between the plaintiffs` product and the registered design or P-22. Third, there is little or no significant similarity between the defendants` products and the registered design or P-22. Fourth, there is a significant similarity between the registered design and P-22. Finally, following from the above, there

Version No 1: 29 Oct 2026 (23:45 hrs)

is a significantly greater degree of similarity between the plaintiffs` and defendants` products on the one side, than there is between either the plaintiffs` products or the defendants` products and either the registered design or P-22.

14 The relevant indicators of similarity and differences are the shape of the petals, the spacing between the petals, the size of the petals in relation to the object as a whole, the positioning of the top side petals and the bottom side petals, and finally the general shape and appearance and what I would call the visual `feel` of the object as a whole.

15 By `top side petals` I mean the pair of petals on either side of the object just below the petal at the top. By `bottom side petals` I mean the pair on either side of the object below the `top side petals.`

16 **Plaintiffs` vs defendants` products**

17 I start with a comparison between the plaintiffs` and defendants` products on the one hand and the registered design and P-22 on the other. In the first place, in both the plaintiffs` and defendants` products, the top petal and the two upper side petals are clearly separated, so by and large are the two top side petals from the bottom two. This separation is not evident in the registered design (except to a limited degree on one side) and evident in P-22 only between the top and the two top side petals. Secondly, both the plaintiffs` products and the defendants` products are slightly, but perceptibly, elongated, while the registered design and P-22 are more rounded. Thirdly, in both the plaintiffs` and defendants` products, the lower two side petals are set a little back from the top two, so that the top petals slightly, but noticeably, overhang the bottom two, giving rise to the `overlapping` feature which was referred to in evidence. In the registered design, that is not evident. In P-22, there is `overlapping`, but it is in

Version No 1: 29 Oct 2026 (23:45 hrs)

reverse; the top side petals overhang on the rear, rather than the front, side of the lower side petals. Fourthly, the petals in both the plaintiffs` products and defendants` products are smaller relative to the whole object and are not as full and rounded as those in the registered design and P-22. Finally, and this is perhaps a little more subjective, because of the slightly elongated (as opposed to rounded) shape and the greater space between the petals, and because of the smaller petals, the plaintiffs` and defendants` products have a lighter or more spacious feel about them and are not so ponderous as the registered design or P-22.

18 I should now say something about the comparison between P-22 and the registered design. Some of the points have already been obliquely referred to above.

19 **P-22 v registered design**

20 As I said, it is not easy to make comparisons between a three-dimensional object like P-22 and a two-dimensional representation such as the rear view of the registered design. However, to the extent it is possible to do so, the following similarities may be noted. Firstly, both have a generally rounded shape, in contrast to the slightly more elongated shape of the plaintiffs` and defendants` products. Secondly, the petals are similarly shaped in P-22 and the registered design; the two top side petals have a generally rounded shape in both, and the two lower side petals have a slightly elongated shape in both. The top petal in each is not as rounded as the top side petals. The top petal in one bears some resemblance with the top petal of the other, particularly when contrasted with the top side petals. Thirdly, in contrast to either the defendants` products or the plaintiffs` products, there is less space between the petals in both

Version No 1: 29 Oct 2026 (23:45 hrs)

P-22 and the registered design than between those in both the plaintiffs` and the defendants` products.

21 There are differences that should be pointed out. Firstly, there is considerably more spacing between the top petal and the top side petals in P-22 than there is in the design. Secondly, there is an overlapping of the bottom two side petals over part of the top side petals, a feature which is not evident to any extent in the registered design. Thirdly, the shape of what is referred to as the lip of the orchid, ie the piece that hangs down from the centre between the two bottom petals, is somewhat different; it is more pointed in the design than in P-22.

22 **P-22 v registered design: Mr Tan`s evidence**

23 Mr Tan purported to give evidence of the differences between P-22 and the registered design. He said (omitting counsel`s questions):

> *A: If you look at orchids, they all have five petals, one lip. What differ are the details of the petals and the lip*
>
> The shape of the registered design is longish. The top two petals overlap the bottom two. The indentations of the lower lip and the triangle shape are very much representative of the Vanda Joaquim. They are also the main features distinguishing it from the Setsco sample ... .
>
> I ... maintain that the lip is totally different. Even the overall shape - one is roundish and one is longish.

24 It seems to me, on a review of the evidence, the exhibits and the registered design, that when Mr Tan was referring to the registered design in the evidence set out above, he was probably referring to the plaintiffs` products which he claimed to have been manufactured to the registered design, rather than the registered design. I say this for the following reasons. His reference to the two top petals overlapping the lower two is apparent only when one looks

Version No 1: 29 Oct 2026 (23:45 hrs)

at the samples of the plaintiffs` products. The registered design, in all the three views presented in the registration document, does not show this feature clearly or, indeed, at all. His reference to the registered design being longish as opposed to P-22 being roundish only makes sense if one looks at the plaintiffs` sample products. It does not make sense when one looks at the rear view, the relevant view, of the registered design in the registration documents.

25 **The governing principles**

26 In judging novelty and infringement, the eye is the judge about the similarities and differences. However, it is the general impression of an object as a whole that may be more important. In this respect, I respectfully accept what Lloyd-Jacob J said in :1

> *... it has to be remembered that examination of design cannot reasonably be expected to be upon the basis of persons using measuring callipers and the like. The comparison must depend upon the mental picture carried away by a person having seen an article to which the registered design has been applied who on seeing another article will pose to himself the questions: `have I seen that before or is that something different?*

27 In , floral wallpaper designs were compared by hanging up the respective papers side by side in the court so that they could be inspected by the judge both close up and at a distance of four or five yards. Romer J gave consideration to what would be the effect if they were seen at different times or looked at from a little distance off. He found that there was sufficient similarity as to make it impossible to distinguish the one from the other in so far as the general public, as opposed to the expert in the trade, would see it.

28 In the instant case, I would imagine that the typical customer of the kind of objects with which I am concerned, apart from a man buying one as a gift for a lady friend or relative, is probably a lady who has had some experience with

Version No 1: 29 Oct 2026 (23:45 hrs)

buying and using costume jewellery. I imagine that she would have an eye for a fair amount of detail in the object, which she will inspect before buying. In addition to the general appearance of the object seen at a distance, she would probably look at it at closer range, perhaps at a book-reading distance. One is judging things that are quite different from the wall paper designs which Romer J had to judge, or the design of a textile fabric as in .3

29 Applying what I think should be the proper way of making comparisons in this case, I now deal with the issue of novelty. I can dispose of it very briefly. I have already noted the similarities and the differences between P-22 and the registered design. A fair conclusion is that the registered design was an evolution of P-22, rather than a duplicate of it or something differing in minor detail from it. On this view of the matter, I would, on the whole, be happier to conclude that there is some novelty in the registered design when compared with P-22, rather than to conclude that there is none except in minor detail. I would, therefore, conclude that the defendants, who has the burden on this issue, have not established a case that the registered design was not new or original within the meaning of s 1(2) of the Registered Designs Act.

30 **Infringement**

31 On the issue of infringement, it seems to be quite clear that the defendants` products differ significantly from the registered design in the particulars which I have set out above.

32 The plaintiffs claim as a novelty the shape and configuration of the article shown in the representations reproduced above. In their counsel`s submission, they claim that the features of shape and configuration that are

Version No 1: 29 Oct 2026 (23:45 hrs)

protected include the way the petals overlap, veins and curvature of the petals and the proportionality of the petals.

33 In dealing with the plaintiffs` claim, one has to bear in mind that the plaintiffs` design is based on a common object.

34 In , a registration for a garden sprayer was found not to be infringing having regard to the prior art position. Astbury J observed:

> *If people will take out designs such as this for articles of this character they can only expect to prevent infringement when the article complained of is in substance identical.*

35 In , the registered design was in respect of latex moulds for producing fruit-shaped wax candles. Brandon LJ, speaking about objects in common use, eg fruit and vegetables, says:

> *... while it may be possible to have an original design of a mould for an apple or an original design for a mould for an orange, the degree of originality must be of a restricted kind. All moulds of oranges have a great deal in common and what they have peculiar or original will be very limited.*

36 He goes on to say:

> *It follows from that that, even assuming that there is a valid registrable design, another manufacturer may produce an article which will not involve infringement of that design, provided that it differs even in comparatively small aspects from it. The defendants` moulds only have to be marginally different, perhaps, in some respects from the plaintiffs` moulds in order to escape the stigma of infringement. It is, of course, a matter of degree but one does have a situation where there may be various moulds produced by various manufacturers which have much in common but have also enough distinguishing them to prevent any possibility of infringement, even assuming valid registered designs in respect of one or more of them.*

37 On the basis of the principles enunciated in these cases, and having regard to the differences between their products and the plaintiffs` registered

design which I have pointed out above, I find that the defendants have not infringed the plaintiffs` registered design.

38 **Conclusion**

39 I would on these grounds dismiss the plaintiffs` claim and allow the defendants` counterclaim for damages to be assessed.

40 The defendants shall have costs of the claim and counterclaim on the basis that any costs incurred in common between the two should, of course, be charged only once.

41 ***Order accordingly.***

Warren Khoo L H J

Tan Tee Jim and Geraldine Lim (Allen & Gledhill) for the plaintiffs
Jeffrey Beh (YM Jumabhoy & Co) for the defendants

Version No 1: 29 Oct 2026 (23:45 hrs)