IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1999] SGHC 186

Suit 498/1996

Between

Alteco Chemical Pte Ltd

… *Plaintiff*

And

Chong Yean Wah trading as
Yamayo Stationery
Manufacturer

… *Defendant*

GROUNDS OF DECISION

Copyright — Authorship; Copyright — Infringement; Tort — Passing off; Trade Marks and Trade Names — Infringement

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Alteco Chemical Pte Ltd v Chong Yean Wah trading as Yamayo Stationery Manufacturer

[1999] SGHC 186

Suit 498/1996
G P Selvam J
13 July 1999

1 The principal cause of action in this case is a claim for passing-off in respect of the get-up for the display and sale of 3g super glue in tubes. For good measure, claims for infringement of copyright and registered trademarks were tacked on. The principal relief sought was a perpetual injunction. For good measure an inquiry as to damages or an order for account of profits was added.

2 ***The passing-off claim***

3 the plaintiffs, a Singapore company, is an offspring of a Japanese company called Alpha Techno Ltd (`Alpha Techno-Japan`). When this suit was brought, Alpha Techno-Japan had for some time been manufacturer of super glue in small tubes, not unlike toothpaste tubes one finds in airplanes and hotels. There was one difference, however. the screw cover of the glue tube was long and conical. Twelve of the tubes were mounted on a hangable rectangular display card with perforations to form 12 sections, each tube to be sold individually. This would enable each section with a tube to be torn off with ease. Each section was called a `tube-card`. The pack of tubes and the display card

constituted the `SG-12 get-up`. The 12 tube-cards formed the bottom two-thirds of the display card. The top one-third was devoted to advertisement.

4 The SG-12 get-up was described as follows:

> *The centre piece of the get-up was a small tube containing 3g glue. On the surface of the tube appeared the trademark `ALTECO` and a yellow square on a white background with the words `SUPER GLUE` in red lettering. The tube was attached to a rectangular card (`the tube-card`) with a pin and sealed in transparent plastic. The tube-card was black with the words SUPER GLUE in red in a yellow square in the centre of the card. The trademark ALTECO appeared at the top left hand of the tube card. On the reverse side of the tube card appeared various instructions on how to use the glue. The tubes were mounted on three vertical and four horizontal rows - that is 4 x 3 making 12. On the display card was printed the picture of a hand squeezing the tube of glue. In addition there were four coloured boxes. On each individual box there appeared pictures of a cup and saucer, a toy car, a handbag and belt. Further there appeared on the surface of the display card next to the blue background on a black background on the other top half the words SUPER GLUE in yellow lettering and the following phrases in small white lettering:*
>
> *`For PLASTICS-METAL-WOOD-RUBBER-PAPER & LEATHER`*
>
> *`Cyanoacrylate adhesive`*
>
> *`NET.3g`*
>
> *`ALTECHO CHEMICAL PTE LTD`*

5 It was further asserted by the plaintiffs that the SG-12 get-up was produced and used in Singapore by Alpha Techno-Japan before 1990 and for six years prior to the action (1996) by the plaintiffs. According to them the get-up when it first made its advent was unique. For the six years before the action (1996), they had substantial local and export sales to Asean, Africa and Middle-East countries. They gave a tabulation of their sales during that period as follows:

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Period	Quantity	Value in S$	Quantity	Value in S$
5/90-4/91	153,588	77,933	5.7m	2.5m
5/91-4/92	137,748	70,816	1.2m	4.5m
5/92-4/93	138,576	70,218	3.1m	5.2m
5/93-4/94	52,416	27,619	15.3m	5.7m
5/94-4/95	39,168	22,934	20.1m	6.6m
5/95-12/95	14,976	10,416	16.5m	5.3m

6 ***Singapore*** **Overseas** In addition the plaintiffs said that they spent money on promoting the glue by advertising the SG-12 get-up. In the result they acquired a substantial and valuable goodwill in the business relating to the manufacture and sale of glue in the SG-12 get-up. They further claimed to be owners of Registered Trademarks Nos 5117/93 and 5118/93 in respect of the tube-card, and also the owners of the copyright in the SG-12 get-up pursuant to assignments from Alpha Techno-Japan.

7 The plaintiff went on to aver that the defendant, a lady by the name of Chong Yean Wah, passed off glue in tubes as that of the plaintiffs or as being connected or associated with the plaintiffs`. It was further asserted that their registered trademarks and copyright were infringed by the defendant. The thrust of their case in short was that she had copied and used their SG-12 get-up to palm off her glue in tubes as those of the plaintiffs. The defendant carried on her trade under the trade name `Yamayo Stationery Manufacturer`.

8 ***The passing-off claim***

9 on that premise the plaintiff sought an injunction to restrain the defendant, her servants and agents from dealing with her glue in respect of the alleged passing-off, infringement of registered trademarks and infringement of

copyright. The plaintiffs gave the following particulars in support of their allegation that the defendant was a wrong-doer.

> *Particulars of Passing-Off*
>
> (i) The defendant has made and/or sold and still makes and sells glue in a get-up similar to the plaintiffs` SG-12.
>
> (ii) The similarity between the infringing get-up and the plaintiffs` SG-12 get-up amounts to a misrepresentation by the defendant in the course of trade to prospective customers of her (sic), such as retailers or shopkeepers, or ultimate purchasers of the glue that her glue is that of the plaintiffs` or is connected to or associated with the plaintiffs.
>
> (iii) The similarity is sufficient to deceive ultimate purchasers or cause them the mistaken belief that the defendant`s glue in the infringing get-up is that of the plaintiffs` or is connected to or associated with the plaintiffs.
>
> (iv) The deception or mistaken belief of the ultimate purchasers is particularly acute overseas where the rate of literacy is low and therefore the get-up of the glue plays an important part in deciding which glue to buy.

10 The plaintiffs then set out particulars of several display cards of the defendant bearing the trademark `Yamayo`. They attached a coloured photocopy of one such display card to the statement of claim. I shall write more about this later.

11 ***The infringement of registered trademarks claim***

12 Secondly, the plaintiffs said that they were the registered proprietors in Singapore of two trademarks. The first was No 5117/93 in Class I in respect of adhesive substances used in industry. The other was No 5118/93 in Class 16 in respect of adhesive for stationery. The subject matter of both trademarks was the same. Both registrations were effective from 8 July 1993 for 10 years. The

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defendant, it was alleged, had infringed trademarks in respect of the get-up and caused confusion and deception of the public. I shall write more about this later.

13 ***The infringement of copyright claim***

14 Thirdly, the plaintiffs asserted that they owned the artistic copyright in the work identified as SG-12 get-up for Singapore. The plaintiffs derived their copyright by virtue of an assignment on 22 August 1994 from the original owner, Alpha Techno-Japan. The plaintiffs further said that the defendants infringed their copyright by reproducing the get-up and by advertisements. I shall write more about this later.

15 ***The defences***

16 The defendant made a series of denials. Indeed, denials were the principal plank of her defence. She said that the SG-12 get-up was not distinctive or peculiar to the plaintiffs and would not admit that Alpha Techno-Japan had used the SG-12 get-up in Singapore. She said also that not all those products bearing the trademark `Yamayo` were hers. Those with the trademark `HI-TECH` on the tube and `Made in Japan` at the back of the tube-card were imitations of her own get-up. Her only positive case was that a design similar to the SG-12 get-up was first created and published not by Alpha Techno-Japan but by a company by the name of Gordon Brothers Co Ltd of Taiwan in 1987, two years before the alleged creation by Alpha Techno-Japan. The defendant had in Singapore a design similar to the plaintiffs` SG-12 get-up. Further, the get-up was common to the trade and she gave a list of other eight products she intended to rely on. Several positive points the defendant proposed to advance in her submissions were not pleaded. Elementary rules of justice and

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convenience require a defender to specifically plead and place on record before trial all matters which make the plaintiffs` claim not maintainable. The defendant must not cast about for points as the plaintiffs` case develops and then spring surprise points in closing submission. Regrettably, the defendant did not adhere to this rule of essential justice.

17 ***The plaintiffs` evidence***

18 The evidence of the plaintiffs was that the SG-12 get-up was first used by the plaintiffs` parent company in Japan, that is by Alpha Techno-Japan. The plaintiffs` first witness, Mr Koichiro Nogami, asserted in his evidence that the SG-12 get-up was conceived by him sometime in late 1985 or early 1986. Alpha Techno-Japan had since 1983 been selling the 3g glue tubes in a single card (`the SG-2 get-up`). Imitators from Taiwan made it tough for them. So, to save costs, he came up with the novel idea of selling the same tube of glue by a composite card exhibiting a pack of 12 tubes in a spread out display. However, because the SG-2 get-up had already acquired a reputation he decided to retain the same tube-card design but in a much larger pack of 12 tubes. This would also save costs as less card or paper was needed. His input was conveyed to the marketing people who worked closely with a design agency (`Fujita Sangyo`) to come up with the SG-12 design. The predominant purpose of the SG-12 get-up was, therefore, to distinguish Alpha Techno-Japan`s product by a striking display. In my view they did an admirable job of it. Nogami`s evidence was as clear as it was compelling on that score as well as on other points. The veracity of his evidence could be seen from the fact that the SG-12 get-up retained many of the features of the established SG-2 get-up such as the hand holding a black and white glue tube, the flash with the words `Super Strong`, the words `SUPER GLUE` in bold red letters with a yellow line against a black background and the

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other words in white lettering. Artistically, yellow and red leap to the eye from the strong black background. As a piece of commercial artwork and catchy advertisement it was unimpeachable.

19 Nogami also said that the SG-2 get-up was created in 1983 and the SG-12 get-up in 1986. The year 1989 for the SG-12 get-up in the copyright assignment document was an error and it was corrected to 1986. The fact that it was a mistake was corroborated by documents showing the existence of the SG-12 from 1986 onwards. His evidence was unimpeached. I accepted his evidence as a reflection of the truth that Alpha Techno-Japan was the originator of the SG-2 get-up in 1983 and the SG-12 get-up in 1986.

20 The second witness of the plaintiffs, Mr Tan Kia Siong [commat] Jackson Tan, said in his evidence that the plaintiffs, Alteco Chemical Pte Ltd of Singapore, started manufacturing glue in Singapore in the SG-12 get-up in January 1990 and the first sales in Singapore were in July 1990. from then the plaintiffs had made use of the SG-12 get-up in local and export sales. The sales figures as set out in [para] 4 established that the plaintiffs had substantial goodwill and reputation in the SG-12 get-up from 1990.

21 In so far as Singapore was concerned, the plaintiffs sold their product in the SG-12 get-up to their exclusive distributor Mopi Pte Ltd (`Mopi`) up till 1991 and later to other trade purchasers such as Rexim, Tong Kah, Kim Tat Seng, T H Industrial Supply and Tongyu. Between 1990 and 1995, sales improved tremendously.

22 The plaintiffs also advertised the SG-12 get-up in Singapore and overseas. According to Jackson Tan, these were not the only advertisements.

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The distributor Mopi had also advertised. In addition the SG-12 get-up display cards were displayed in shops themselves. This was the best advertisement.

23 ***The defendant`s evidence***

24 The defendant said in her affidavit that she started the use of her get-up (`Yamayo get-up`) in 1993 and then at the trial changed it to 1992. She also said that her limited company Yamayo Chemical Pte Ltd (`Yamayo Ltd`) had been using the get-up in 1991. Whichever date is taken, it was a date after the plaintiffs had established their goodwill and reputation in Singapore from early 1990.

25 The defendant did not deny that her first get-up might have been copied from the plaintiffs` SG-12 get-up. Although she went over it with a fine-tooth comb and came up with some differences in the minor details of her get-up and the SG-12 get-up. But she never seriously challenged that her `design` was similar to the SG-12 get-up. Indeed, in attempting to challenge Alpha Techno-Japan`s and the plaintiffs` ownership of the SG-12 get-up, she asserted in her defence, perhaps unwittingly, that her design was similar to the SG-12 design. Thus she has been caught in her own trap, hoist by her own petard on the issue of similarity. She said Yamayo Ltd first used the get-up in 1991. Yamayo Ltd is a company of which the defendant was a director in charge of its management and a one-third shareholder. Her husband, KF Wang (a Taiwanese), was the general manager. She claimed that she had no local sales although she manufactured her product in her get-up in Singapore. Hers was essentially an export trade.

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26 The defendant said that her former employee, Patrick Tan, designed her Yamayo get-up. She sprung this for the first time at the trial notwithstanding that two affidavits were filed by her knowing very well that the history of the origin and use of her get-up were material to the case. Patrick Tan was not called. The defendant further said Patrick Tan derived the Yamayo get-up from another card obtained from Taiwan sometime in 1991. This also came up only at the trial. The defendant further said that Yamayo Ltd took the idea for the Yamayo get-up from advertisements of similar products in Taiwan. She exhibited an advertisement of a KUDOS get-up by Wan Hsiung.

27 It would be convenient to dispose of the infringement claims and then move on to the passing-off claim, and I shall consider the copyright claim first.

28 ***Copyright***

29 The SG-12 get-up without the glue tubes to my mind is unquestionably an artistic work conferring copyright. It was the work of a hand of art and not the product of pedestrian labour. in this case Alpha Techno-Japan engaged a design agency in Japan, Fujita Sangyo, to create a get-up, and a printer to printset it for mass production. It would be preposterous to even suggest that what a design agency created after being commissioned to create and what others so eagerly copied was not a piece of artistic work. The copyright Act (Cap 63, 1988 Ed) defines `artistic work` as a drawing whether the work is of artistic quality or not. Alternatively, any work of artistic craftmanship is `artistic work` within the meaning of that expression as used in the Copyright Act.

30 **Copyright ownership issue**

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31 In her closing submission the defendant raised an issue as to whether Alpha Techno-Japan were in the first place the owners of the copyright in the SG-12 get-up. She had not raised the ownership issue expressly in the pleadings. The Copyright Act by s 130 provides in effect that if a defendant does not put in issue the question of the plaintiffs` ownership of the copyright, there shall be a presumption that the plaintiff is the owner of the copyright in question. This provision being procedural applies to all actions commenced in Singapore irrespective of where the copyright was created.

32 In addition, O 18 r 8 of the rules of court provides that

> *a party must in any pleading subsequent to a claim plead specifically any matter*
>
> (a) which he alleges makes the claim not maintainable, or
>
> (b) which, if not specifically pleaded, might take the opposite party by surprise.

33 The combined effect of those two provisions makes it plain and patent that if the defendant intended to raise an issue as to the plaintiffs` ownership, she ought to have done it specifically. It means that she should have explicitly put the plaintiffs` and Alpha Techno-Japan`s ownership in issue. Her failure to do so entitled the plaintiff to throw the book at her. Nonetheless, I shall deal with the ownership issue because the plaintiffs led some evidence on the question of ownership of the copyright. It was not in dispute that a Japanese copyright is valid in Singapore.

34 The defendant relied on s 30(2) of the Copyright Act. It provides that `the author of an artistic work shall be entitled to any copyright subsisting in the work`. She put forward the theory that Fujita Sangyo was the author. Alpha

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Techno-Japan, in other words, was not the author and, therefore, not the owner of the copyright in the SG-12 get-up, with the result that the plaintiffs could not found a claim on it. I could not agree with that contention for the reasons that follow.

35 For openers, s 30 of the Copyright Act does not apply to copyrights created outside Singapore because the provision cannot have extraterritorial operation. But since the defendant did not squarely put ownership in issue but merely denied the plaintiffs` assertions, the plaintiffs did not plead and produce evidence of Japanese law on the point. So I have to decide the issue on the basis of Singapore law. The section does not define the word `author` which became part of the glossary of copyright law at the primitive stage of copyright law when copyright was recognised only in writing. At that time it meant a writer of books albeit it was later extended to a maker or originator of artistic work who was an individual. It was intended to protect the interest of the writer if he legitimately laid claim to copyright. But times have changed. So has the temper of the law. This is an age where artwork is often a result of teamwork and computer graphics. Often, and particularly in cases where an agency is commissioned to do a get-up or advertisement, the author has absolutely no interest in the get-up or advertisement. Given that scenario, it is often difficult, if not impossible, for an individual `author` to make a claim to copyright or identify him. This is conspicuously so when a corporate or unincorporated body undertakes to materialise an idea into an artistic work or computer graphics. the individual(s) art worker(s) are not identified or identifiable.

36 In this case, it was Nogami who conceived of the SG-12 get-up in its abstract form. He then conveyed it to the marketing personnel of Alpha Techno-Japan. They worked closely with the design agency, Fujita Sangyo. The word

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`agency` means that Fujita Sangyo was not a single person. When the agency handed over the finished product they had no profit to reap from its use. Their only interest was their fee. The work then had to be print-set for a prototype and then mass printed. That was how the SG-12 get-up was conceived, materialised and put into the production line. The finished product with the tubes would be completed in the manufacturer`s factory. In those circumstances it would be impossible to identify a single person who could lay a claim to the copyright of the final work. In the result, common sense and the principles of common law as well as equity (constructive trust) combine to hold that the only `author` who could lay a rightful claim to copyright in the final product was Alpha Techno-Japan. They were the ones who made the arrangements and paid for the creation of the get-up. That would be the modern meaning to the word `author`. In the law of passing-off the term `trader` is widely interpreted to include a person engaged in a professional, artistic or literary occupation. Likewise, having regard to the purpose of copyright law, the term `author` should be widely interpreted to include the only person whose interest it was intended to protect. In the result Alpha Techno-Japan was the originator and commissioner and therefore the author of the SG-12 get-up. In those circumstances it would be preposterous for Fujita Sangyo to claim copyright in the get-up. This court would not grant Fujita Sangyo an injunction to restrain Alpha Techno-Japan from using the get-up to market the product without the leave and licence of Fujita Sanygo. The intention of the parties is the only determinant of ownership. Common law would imply such an intention as an implied term. Equity would imply a constructive trust against Fujita Sangyo.

37 In this regard **Harold Drabble v Hycolite Manufacturing Co** [1928] 44 TLR 264 is eminently instructive. Harold Drabble Ltd, advertising agents, and Mr Harold Drabble, their managing director, brought the action against Mr

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George Edward Heyl (t/a the Hycolite Manufacturing Co) and the Morning Post Ltd, for an injunction to restrain the defendants from infringing the plaintiffs` copyright in an advertisement prepared by the plaintiffs to advertise the goods of the Hycolite Manufacturing Co by inserting such advertisement in the ***Morning Post*** without the plaintiffs` consent.

38 The action raised the question whether the copyright in the advertisement belonged to the agent who prepared it, or to the person who commissioned it. It was decided by Astbury J that there was no original literary work. even if there was such a work the plaintiffs had by contract rendered it impossible for the court to grant any injunction to restrain the defendants from publishing the advertisement. The report accurately and aptly extracts from the decision the following legal proposition:

> *Where an advertisement agent prepares an advertisement on instructions and information given to him by the advertiser, the Court will, in the absence of evidence to the contrary, draw the inference that it was the intention of both parties that the copyright in the advertisement should belong to the advertiser.*

39 The only inference I could make on the facts of this case is that it was intended by both parties that Alpha Techno-Japan was the author and owner of the copyright in the design. The purpose of the artwork was such that the agency could derive no profit or royalty from it. Fujita Sangyo was legally bound to hand it over to Alpha Techno-Japan and transfer the title to the latter. Alpha Techno-Japan, accordingly, was entitled to the ownership, use and benefit of it.

40 **The copyright infringement issue**

41 The defendant then argued that no infringement in Singapore was proved and sprang the surprise submission that her get-up was substantially

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different from the SG-12 get-up. This contention was diametrically opposite to what she had asserted in her defence: `The defendant is the proprietor in Singapore of a design similar to SG-12 design`. The proper conclusion to be derived from that statement in the defence was that her design infringed in Singapore the copyright of Alpha Techno-Japan and the plaintiffs because of the simple fact that it was similar to the plaintiffs` get-up. In addition, and in any event, it is my finding that taken in totality the defendant`s design was substantially similar to SG-12 design and that hers was got up in Singapore well after the plaintiffs` made its advent in Singapore. I shall amplify on this.

42 The appropriate test for infringement of copyright that can be extracted from decided cases is as follows:

> *Infringement is imitation of an original work. In respect of infringement it is the quality rather than the quantity of material that is important. Imitation, therefore, need not be exact in the mathematical sense. There is infringement if either the whole of the subject of the copyright is reproduced or if a substantial part of such subject is reproduced, a question of fact. In determining whether there is reproduction, the Court is entitled inter alia to take into account whether the alleged infringement comes so near the original as to suggest the latter to the mind of the people seeing it. In the latter event, if it is also shown or can properly be inferred that the defendant has directly or indirectly appropriated the result of the plaintiffs` labour in producing the work in which he is entitled to copyright, infringement is clearly established. Appropriation is a question of fact. Finally, in determining the issue of infringement each work is taken in totality and the effect it would have in the perception of the ordinary consumer at a given time and place. See* ***Antocks Lairn Ltd v I Bloohn Ltd*** *[1972] RPC 219 at 222 and* ***Ladbroke (Football) Ltd v William Hill (Football) Ltd*** *[1964] 1 WLR 273 at p 276.*

43 Applying the above test, if one, particularly an illiterate person or one who could not read English, saw the plaintiffs` get-up and saw the defendant`s get-up a few day later, he would be bound to mistake the defendant`s product

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for the plaintiffs. The defendant`s Yamayo get-up was a substantial duplication in terms of size, shape, colour and content. Taken in totality there was virtual reproduction and that was infringement. The infringement took place in Singapore as it was put together in Singapore and the uttering emanated in Singapore.

44 ***Infringement of trademark***

45 Now I deal with the claim based on infringement of trade mark. The trade mark, rather the trade marks, comprised a black rectangle with a yellow square within it. It was the tube-card without the tube. The square was bordered with a red line. The word `ALTECO` appeared at two places. Alpha Techno-Japan obtained the registration of the trademarks, and then on 22 August 1994 assigned them to the plaintiffs. The registration related back to 8 July 1993. The plaintiffs` rights with respect to the trademarks therefore began only on 22 august 1994.

46 The defendant never opposed the registration. Having slept for almost five years, she suddenly woke from her deep slumber and sought to challenge the registration of the trade marks on the grounds that:

47 (a) A design similar to the SG-12 get-up was first created and first published by Gordon Brothers Industrial Co Ltd of Taiwan in 1987, which was two years before Alpha Techno-Japan.

48 (b) The SG-12 design was similar to her own design.

49 This basis of the challenge failed to weigh with me altogether. On this, there was clear evidence for me to make the following findings: The

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registrations were in respect of colour limitation. The colour combination leapt to the eye and was most distinctive. There could be no doubt that the Registrar of Trade marks formed the same view when deciding to register the mark. When the trademarks first appeared in Singapore there was no one else in Singapore with a similar mark. It follows, therefore, that in Singapore the plaintiffs` side had a lead and theirs were the only marks for their kind. In the circumstances no question of commonality can arise.

50 As to the question of infringement the essential features of the trademark were blatantly copied by the defendant and therefore constituted clear infringement by her. To use the appropriate term of art the trademark used by the defendant so closely resembled that of the plaintiffs as to be calculated to deceive potential customers. Further, the defendant`s assertion that her product was not marketed in Singapore, assuming it to be true, carried no weight. if, however, human senses determine that there is an infringement of the mark in the country where the legitimate trademark is registered, the fact that the infringing article has not left Singapore does not afford a defence to the defendant. More so if the plaintiff is also an exporter. This is because the cause of action is completed by the act of infringement. The purpose of the trade mark Act is directly to protect the trade mark and its owner, and indirectly domestic as well as export trade. It is of fundamental importance that the legitimate export trade of this trading nation is given adequate and proper protection. See **Re Neostyle Manufacturing Co`s Trade Mark (1903) 20 RPC 803, James Minifie Co v Edwin Davey & Sons** [1933] 43 CLR 349 and **Tan Chiew Chua v Tan See Wei** [1991] AIPR 121.

51 ***Passing-off - some general observations***

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52 The adjudication of the passing-off claim will follow in the footsteps of Lord Mansfield: extract the essential principles of law and then apply them to the facts. it would be salutary to start with some general observation on the law of passing-off. The law of passing-off was conceived in the 18th century in the day of Lord Mansfield when trade was the mother of money. The law was settled in the early 19th century in the day of Lord Eldon, who readily granted injunctive relief in trade mark cases to suppress competing deceivers filching authentic traders` marks and customers. The court of equity was also prepared to prevent deceivers who stole other traders` customers by representing their goods or businesses as those of the honest traders. Protection of legitimate traders by that time became one of the primary functions of the court of equity. Equity developed the injunctive remedy and the ancillary remedy of the accounts for profits in order to protect the trader who expended money and labour to develop his trade as well as the public who developed a faith in the goods of such a trader. Since then equity has played an important role in the metamorphosis of the law of passing-off and the granting of injunctions in intellectual property cases.

53 ***Defining `passing-off`***

54 The concept of passing-off was stated succinctly a century and a half ago by Lord Langdale MR in **Perry v Truefitt** [1842] 49 ER 749 at p 752:

> *A man is not to sell his own goods under the pretence that they are the goods of another man.*

55 A decade and a half later Lord Cranworth restated it lucidly thus in **Farina v Silverlock** [1856] 43 ER 1214 at p 1216:

> *Anyone who has adopted a particular mode of designating his particular manufacture, has a right to say, not that other persons*

> *shall not sell exactly the same article, better or worse, or an article looking exactly like it, but they shall not sell it in such a way as to steal his trade-mark, and make purchasers believe that it is the manufacture to which that trade-mark was originally applied.*

56 In recent times Lord Oliver, Lord Jauncey, Lord Diplock and Lord Fraser have all expounded their erudition of the conception in different diction. Nourse LJ notably said in ***Consorzio Del Prosciutto Di Parma v Marks & Spencer plc*** (` ***Parma Ham*** `) [1991] RPC 351 (CA) at p 368 that although the speeches of Lord Diplock and Lord Frazer in **Warnink v Townend & Sons** [1979] AC 731 were of the highest authority, in his experience, they did not give the same degree of assistance in analysis and decision as the classical trinity of essentials which constituted the conception. Nourse LJ stated the classical trinity in simple syllables:

57 (1) a reputation (or goodwill) acquired by the plaintiff in his goods, name, mark etc.

58 (2) a misrepresentation by the defendant leading to confusion (or deception), causing

59 (3) damage to the plaintiff.

60 I propose to guide myself by the classical trinity of Nourse LJ.

61 The central feature of a cause of action founded on copyright and registered trademark is infringement. That is not so in a passing-off action. In a passing-off action the central theme is deception or misrepresentation. The other two, though essential, are of ancillary importance. The cause of the action may arise from an imitation of the name, mark, get-up or direct misrepresentation by

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words. In addition, to the concise classical trinity, there is a galaxy of peripheral case-law which has added flesh and blood to that conception.

62 ***Peripheral principle No (1): the meaning of `goodwill`***

63 In one sector of the galaxy the pronouncement in the last century that `the claimant must actually have commenced business before he can claim good` that, however, is no longer an inflexible rule today. It is notably so when the authentic producer seeks the equitable remedy of an injunction and account of profits. If trading is insisted on, it would make an ass of the law, for a rogue trader could foil and frustrate at will the efforts of a manufacturer who expends huge amounts of money in erecting the get-up of a product and an institutional advertisement before the actual start of business. The rival may imitate that get-up with impunity and launch his sales before the legitimate trader and thereby defeat a passing-off action on the ground that the originator has not acquired goodwill by actual trading. In present times, in cases whenever a demand has been created by advertising, and better still if there are actual sales, the law will recognise it as sufficient reputation spawning potential goodwill and grant an injunction, and add to it the ancillary remedy of account of profits: see **Turner v General Motors (Australia) Pty Ltd** [1929] 42 CLR 352, **WH Allen & Co v Brown Watson Ltd** [1965] RPC 191 and **CDL Hotels International Ltd v Pontiac Marina Pte Ltd** [1998] 2 SLR 550 . Further, the question of whether there is acquisition of reputation and goodwill will be determined by common sense current at the time of decision. Subject to that gloss, trading, however short it may be, is sufficient to establish goodwill. See ***Sheraton Corp of America v Sheraton Motels Ltd*** [1964] RPC 202 and **Stannard v Reay** [1967] rpc 589. In the result, where there has been no trading, the appropriate remedy is an injunction and, if the circumstances warrant, an order for account of profits.

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Where there has been actual trading and therefore actual goodwill, the appropriate remedies are an injunction to restrain future passing-off and an inquiry as to damages.

64 ***Peripheral principle No (2): damage***

65 On the question of damage the correct law is as follows:

> *Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods as those of the plaintiff which are not the plaintiff`s it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would; while even if there is no direct loss of sales (as where plaintiff and defendant are not in direct competition) the confusion between the two suppliers puts the plaintiff`s goodwill at risk. There is indeed some authority for the proposition, that any unauthorised appropriation of or profit from another`s business goodwill or professional reputation or business goodwill, inasmuch as it deprives the plaintiff of the opportunity to exploit his goodwill himself if nothing else. But this doctrine is by no means firmly established, and where the plaintiff is not a trading business especially, he may well be required to establish a likelihood of actual financial loss from the defendant`s actions. Thus it has been held that the assumption of a name, or an address, similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him - for instance, by delaying his letters - is not actionable unless it is shown to be calculated to injure him in his business. No action lies at the suit of any private person for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General. In a passing-off action the court is not concerned with the truth or falsity of statements in the defendant`s advertisements except so far as they tend to induce the belief that the defendant`s goods or business are the plaintiff`s.*

66 Additionally

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> *erosion of distinctiveness is a form of damage to goodwill which may be sufficient to maintain an action, provided the damage is actually caused by the misrepresentation.*

67 See ***Kerley`s Law of Trade mark and Trade Names*** (12th ed, 1986) and **First Supplement** [1994] at para 16-04.

68 In equity, that is when injunctive remedy is sought, it is unnecessary to prove actual damage. It is sufficient if the likelihood of damage is established. The court can infer the likelihood of damage in appropriate circumstances. Where the defendant`s goods compete with the plaintiffs` in the same market both domestic and export, the likelihood of damage will be readily inferred.

69 ***Peripheral principle No 3: exporting the instruments of deception***

70 Now I move on to an important facet of the law of passing-off. It concerns sales for export to, or passing-off in, foreign markets. In such cases, the tort can be viewed from three distinct aspects: (i) exporting the finished product; (ii) exporting the instruments of deception; and (iii) committing the palming off in a foreign territory with no linking-act in the country of origin.

71 In the first case, the passing-off occurs when a local competitor exports the spurious goods to a foreign market where the palming off will be done by the importer in that country. In such a case the commission of the tort is complete within the territory since the finished product is ready for export. Such form of passing-off may be refrained by injuncting the supply and export of the goods from the territory. the law of the place where the palming off will be perpetrated is utterly irrelevant.

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72 ***Passing-off by exporting instruments of deception*** occurs when the instruments of deception are sold to a middleman calculated to assist a deception in a foreign market. Here, the finished product makes appearance not within the territory but in the foreign country. Once again, the foreign law is irrelevant because the supply of the instruments of deception is a tort on its own. what will happen in the foreign country is ignored in determining whether the tort has been committed.

73 ***Foreign passing-off*** occurs when production and palming off occur in a foreign country and nothing happens in the land of the forum. In such a case, as all the factors are foreign, foreign law becomes very material. It must be shown by the claimant that it is actionable by the law of the country where the palming-off takes place. The proposition of private international law that foreign law is prima facie presumed to be same as the law of the forum does not apply.

74 Normally, items (i) and (ii) are combined and treated as one category. This places an unnecessarily difficult hurdle for the plaintiff to overcome. My taxonomy alleviates the difficulty and is conducive to clear thought. Be that as it may, the spring source of the principle governing items (i) and (ii) was the following statement by Lord Watson in **R Johnston & Co v Archibald Orr Ewing & Co** [1882] 7 App Cas 219 at p 231:

> *no man, however honest his personal intentions, has a right to adopt and use so much of his rival`s established trade-mark as will enable any dishonest trader, into whose hands his own goods may come, to sell them as the goods of his rival.*

75 On all three items there is a useful analysis and statement of the law both by counsel and Forster J in **John Walker & Sons Ltd v Henry Ost & Co Ltd & Anor** [1978] RPC 489.

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76 ***Peripheral principle No 4: protecting get-up***

77 In the beginning the protection was in respect of name and mark because it was in respect of those two factors that the legitimate trader had developed his reputation and goodwill. With the passing of time, the manufacturer-trader invented the concept of get-up to advertise and flourish his goods with the view to expanding his market both territorial and extra-territorial. The principal objective of erecting a given get-up at one level is to identify, distinguish and create a favourable `image` of the product and its manufacturer. At another level its purpose is to advertise - that is to say to attract, inform and persuade people and thus create and expand goodwill. That being its purpose, the creation of a get-up inevitably must combine art, consumer psychology and advertisement techniques. In the circumstances, where a manufacturer places importance to the get-up of this product, the name and mark are not its predominant features. The get-up itself becomes the predominant feature of the product. It must, nonetheless, be kept in mind that what the consumer pays the price for is not the get-up but the product; the function of the get-up is to develop the reputation of the product not the get-up itself.

78 Thus in the landmark get-up case, **William Edge & Sons Ltd v William Niccolls & Sons Ltd** [1911] AC 693 (HL), the get-up of the product in the shape of the product itself (laundry blue with a stick in it) was held to have identified the plaintiffs` goods. In another landmark case the get-up of lemon juice in the form of life-sized, lemon-shaped plastic containers was held to have given a trading reputation to the product.

79 **Tavener Rutledge v Specters Ltd** [1959] RPC 83 and 355 (CA) is a good parallel to the present case. sweets were sold in the get-up of decorated

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tins. An action was brought against the defendant who also sold sweets in a colourable imitation of the get-up. The action was launched on the basis of passing-off, infringement of trademark and infringement of copyright. The claim succeeded on all three counts

80 ***Peripheral principle No 5: the test for misrepresentation***

81 Much of what has been said on the test for infringement of copyright applies to passing-off. In addition I would repeat here what I said in **Ken Ken Food Manufacturing Pte Ltd v Wong Hiong Wah** [1996] AIPR 113:

> *In deciding whether there was an illegitimate imitation of a product one must look at the get-up as a whole. Where there were a number of features, their cumulative and predominant effect and not individual features should be considered. It was useless to compare the points of similarity one by one. What must be looked at as the most important consideration was what caught the eye generally. Colours in a get-up may constitute an important part of it.*

82 In the appropriate case, the following test laid down in **MI & M Corp & Anor v A Mohamed Ibrahim** [1964] MLJ 392 FC may afford an alternative approach:

> *The test to be applied is whether a person who sees the one trade mark in the absence of the other trade mark and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark is the same as the other of which he has a general recollection. This recollection test is to be applied having regard to the sort of people who would buy the goods and the circumstances in which they buy.*

83 There are bound to be differences between the genuine and spurious get-up. But a passing-off case is not to be decided by looking for subtle difference which one does not ordinarily see or recall.

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84 ***The decision***

85 The defendant proposed to resist the claim for passing-off on the grounds that: the plaintiffs did not have sufficient goodwill in the SG-12 get-up, there was no misrepresentation by her, there was no proof of damage and there was delay. I reject all the arguments. I shall take them in stages. What follows should be understood in the context of the law I have outlined.

86 The defendant was unable to convincingly deny the fact that the plaintiffs` get-up was copied by her. I find without any reserve that the defendant did substantially imitate the plaintiffs` SG-12 get-up. For this purpose it did not matter whether the copy was direct or from another copy. Filching from a filcher is filching a fortiori.

87 The defendant said some of the imitations relied on by the plaintiffs were not hers. I will assume that those `Yamayo` get-ups with `HI-TECH` and `made in Japan` indorsement were not hers. To my mind what matters is that the get-up that was admittedly hers was admittedly similar to the plaintiffs`.

88 As to commonality of the get-up at the material time, in so far as Singapore was concerned, no one other than the plaintiff was using the SG-12 get-up. The defendant said there were many others doing so in Taiwan, but in so far as Singapore was concerned there were no other filchers. The defendant did not produce any evidence of use by any other party of the SG-12 get-up in Singapore. As a matter of fact the get-up was therefore not common to the glue in tube trade in Singapore.

89 In asserting that there were many get-ups similar to the SG-12 get-up and therefore the SG-12 get-up was common to the trade, she was begging the

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question. The issue was whether the SG-12 get-up was distinct and whether it was the fore-runner in Singapore. Taiwan was another story because according to the plaintiffs, the Taiwanese themselves were imitators of the SG-2 and SG-12 get-ups. The defendant asserted the plaintiffs` get-up was common to the trade in Singapore without proving that the others were not imitators of Alpha Techno-Japan`s SG-12 get-up. Her purported proof was postulated to depend on the conclusion that they were all around at the same time. The plaintiffs` proof was otherwise, namely that their get-up was the fore-runner in the market.

90 The defendant produced a brochure of Gordon Brothers, more particularly a product numbered S-88 and by the testimony of Lu Shao Hung from Taiwan tried to show that the SG-12 get-up was not distinctive of the plaintiffs. S-88 was a get-up, however, similar not to SG-12 but to the SG-2 get-up. One compares apples with apples and not oranges. The SG-2 get-up was in the market from 1983 and according to Nogami, the Taiwanese were imitating his art and it was to fight them that he came up with the SG-12 get-up. And it was to fight a follower of Taiwanese imitators of the SG-12 get-up that this action was brought.

91 The defendant also said in court that she discontinued the use of the Yamayo get-up in 1993 but surprisingly she still continued to advertise the deceptive get-up right up to February 1996. Her explanation was that she was too lazy and it cost too much money to change the slides for the advertisements. I found it hard to believe that for three years after she had allegedly stopped using the deceptive get-up, she still continued to advertise it. She said she would produce the invoice of the artwork agency for the change of design but in the end produced the invoice of the printer which did not show any change of design

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in 1993. It followed therefore that the defendant continued to manufacture and sell glue in the deceptive get-up.

92 The defendant also said that though the Yamayo`s get-up, both the old and new, were made in Singapore she did not however sell them in Singapore and therefore there was no passing-off. But to sue a defendant for the tort of passing-off it is sufficient if the manufacturing and exportation took place in Singapore. In any event she did not produce all the evidence in relation to sales. There was evidence of some sales in the Singapore market. That was enough for the plaintiff to succeed. The rest goes to quantum.

93 Given the similarity in the get-ups, there can be no argument as to the likelihood of damage. In fact, the plaintiffs` have proved that they have suffered damage in so far as Singapore was concerned as well as overseas sales. Whilst the loss may not be entirely attributable to the defendant, the use and continued use by the defendant of her get-up whether old or new was unquestionably likely to cause damage to the plaintiffs.

94 The defendants` last ditch defence was that the plaintiffs were guilty of delay. This point was not pleaded. It was not pursued in her affidavit evidence-in-chief. The plaintiffs` witnesses were not cross-examined on it. In short it was not investigated at the trial by me. It was a sort of Parthian shot as it was only raised in the closing submission. I should, therefore, reject it out of hand. The plaintiffs, however, answered it in their submission by drawing my attention to the relevant facts. Time ran only after the discovery of her wrongful acts. As she herself said her principal her principal market was overseas. The plaintiffs discovered her sales in Singapore and overseas only in 1995. In September 1995 their instructed solicitors to write to her. Notwithstanding the letter she decided

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to resist the plaintiffs` claims. In the circumstances they had to assemble the evidence and seek the necessary advice. In these circumstances the commencement of the action in March 1996 was entirely justified.

95 Finally, the defendant argued that deception had not been proved. In law it not necessary to establish actual deception. Likelihood of deception is sufficient and it may be inferred from the circumstances of the case. The circumstances of this case clearly support such an inference. For instance, likelihood of deception will be inferred if it shown that the plaintiffs` distinctive name, mark or get-up has acquired a reputation in a given market and there is substantial similarity suggesting a common source. The defendant relied on the facts of the ***R Johnston v Archibald Orr Ewing*** case which concerned the use of different names for the same class of goods. that was a case of the past century. I am required to decide this case not by the law and trade practices that obtained at the dusk of the 19th century but the law and practices that obtain at the dawn of the 21st century. I hold that the defendant most clearly misrepresented her goods as those of the plaintiffs. For all these reasons the following consequences shall follow: she shall be restrained as prayed, there shall be an inquiry as to the damages and shall be mulcted in costs.

96 **Outcome:**

97 Plaintiffs` claims allowed.

G P Selvam J

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Alteco Chemical Pte Ltd v Chong Yean Wah trading as Yamayo Stationery Manufacturer [1999] SGHC 186

G Radakrishnan (Rada & Associates) for the plaintiffs
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