Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd
[2003] SGHC 250

Case Number : Suit 1442/2002, RA 89/2003, 90/2003

Decision Date : 20 October 2003

Tribunal/Court : High Court

Coram : Lai Kew Chai J

Counsel Name(s) : G Radakrishnan (Khattar Wong & Partners) for the plaintiffs; Tan Tee Jim SC (counsel) and Khor Wee Siong (Khor Thiam Beng & Partners) for the defendants

Parties : Pan-West (Pte) Ltd — Grand Bigwin Pte Ltd

Trade Marks and Trade Names – Defence – Exhaustion of rights – Implied consent – Whether defendants could rely on defence of implied consent under s 29(1) of the Trade Marks Act (Cap 332, 1999 Rev Ed) where infringing product not a parallel import – Whether plaintiffs' failure to object to registration of identical trade mark in foreign jurisdiction amounted to implied consent – Whether plaintiffs' earlier import and sale of products bearing trade mark of infringing product in Singapore amounted to implied consent

Trade Marks and Trade Names – Defence – Use of proprietor's trade mark for purpose of identifying proprietor's goods – Trade Marks Act (Cap 332, 1999 Rev Ed) s 27(6)

Trade Marks and Trade Names – Infringement – Whether alleged infringing trade mark identical or similar to plaintiffs' trade mark – Trade Marks Act (Cap 332, 1999 Rev Ed) s 27

Trade Marks and Trade Names – Passing off – Whether requirements of passing off met – Whether any defence applicable

These are two appeals from the Registry that came before me. The first appeal is RA 89/2003 which is the defendants' appeal against an order for summary judgment made by the learned Assistant Registrar. The second appeal, RA 90/2003 is the plaintiffs' appeal on the matter of costs. I dismissed the first appeal and allowed the second appeal. I set out my reasons for doing so.

2 The plaintiffs' claim is for trade mark infringement and passing off, in respect of, inter alia, the KATANA GOLF trade mark and kG Logo (T97/099241). In the Statement of Claim, the plaintiffs prayed for the following:

> "1. An injunction to restrain the defendants, whether by itself, its servants or agents or any of them or otherwise howsoever from doing the following acts or any of them, that is to say, infringing the plaintiffs' trade mark registration T97/099241 for the mark KATANA GOLF and kG logo as shown in the Schedule ("the Trade Mark") by manufacturing, purchasing, importing, exporting, possessing for any purpose of trade, distributing, selling, offering for sale or advertising for sale gold clubs bearing the trademark KATANA or any other mark substantially similar or colourably imitative of the Trade Mark (hereinafter "the Infringing Mark") or cause, enable or assist others to infringe as described above.
>
> 2. An injunction to restrain the defendants, whether by itself, its servants or agents or any of them or otherwise howsoever from doing the following acts or any of them, that is to say, passing off by manufacturing, purchasing, importing, exporting, possessing for any purpose of trade, distributing, selling, offering for sale or advertising for sale golf clubs or any other golfing articles bearing the mark KATANA which clubs or articles are not the goods of the plaintiffs as and for the goods of the plaintiffs or as being connected to or associated with the plaintiffs by the use of, on, with or in connection with the goods in the course of trade the mark KATANA or any other mark confusingly or deceptively similar or cause enable or assist others to pass off as

described above.

3. Delivery up to the plaintiffs and/or its solicitors for destruction all articles bearing the Infringing Mark that are in the possession, custody or control of the defendants, its servants or agents or any of them, the continued retention and/or intended use of which would be a breach of the injunctions prayed for.

4. Full discovery on all the defendants' acts of trade mark infringement and passing off.

5. An inquiry as to the damages suffered by the plaintiff or at its option an account of the profits made by the defendants from all the accts of trade mark infringement and passing off and payment by the defendants to the plaintiff of all sums found due upon the taking of such inquiry or account.

6. Costs.

7. Interest."

The Trade Mark

3 The plaintiffs are the registered proprietor of the Singapore series mark KATANA Golf and kG Logo (T97/099241), for the following goods in class 28:

"Golf clubs; golf putters and irons; golf apparatus; golf clubs shafts, grips, heads, covers and head covers; golf balls; golf gloves; golf bags; golf bag travel covers; sporting bags; bags adapted for carrying sporting articles; all included in Class 28."

4 There is a Japanese word appearing in the mark, which, as is apparent from the certificate of registration, means "Sword".

5 The plaintiffs' series mark has been registered since 1997. The registration is not without conditions. The certificate of registration clearly states that the registration shall give no right to the exclusive use of the word "GOLF" and the letters "kG".

6 From the first affidavit of Mr Loh Ah Joo (managing director of the plaintiffs), it is clear that the plaintiffs have been selling golf clubs bearing its trade mark since 1997. I had the opportunity to examine sales invoices and receipts over the period of October 1997 to July 2002. There can be no doubt that the trade mark is in current use in Singapore.

The Defendants' activities

7 The defendants are the plaintiffs' competitor. It also sells golf clubs. On its pleading the defendants imported 6 drivers bearing the trade mark KATANA. This trade mark was registered in Japan by one Umeda Shokai KK, in August 2000. It is not a trade mark that is registered in Singapore. The plaintiffs were justified to take objection to the sale and advertisement in Singapore of the drivers bearing Umeda's KATANA trade mark, by reason of its own registration in Singapore.

8 In this case the driver in question was known as the 55ATi, which is not made by the plaintiffs. There was also evidence that the plaintiffs had also sold, at one point in time, golf clubs bearing Umeda's KATANA trade mark, as a distributor and retailer of golf clubs.

9 The plaintiffs hired a private investigator who obtained a trap purchase of this driver, bearing

the KATANA trade mark. This is not in dispute. The defendants also did not deny the importation or sale of the 55ATi driver in Singapore.

Charge of trade mark and infringement

10 The plaintiffs commenced proceedings against the defendants over its sale of the 55ATi driver in Singapore, arguing that the Umeda trade mark "KATANA" infringed its trade mark (T97/099241) under section 27(1) and (2) of the Trade Marks Act ("TMA").

11 Section 27(1) TMA provides that "A person infringes a registered trade mark if, *without the consent of the proprietor* of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered." Section 27(2) TMA provides that "A person infringes a registered trade mark if, *without the consent of the proprietor* of the trade mark, he uses in the course of trade a sign where because (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or (b) the sign is similar to the trade mark and is used in relation to the goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public." (my emphasis)

12 The language between the two sub-sections is clear and differentiated. The first subsection is what I would describe the most straightforward of trade mark infringements: the use (as defined under subsection (4)) of an identical trade mark in relation to identical goods or services. The second subsection envisages the scenario where an identical or similar trade mark is used in relation to identical or similar goods or services; in either situation the plaintiffs have to demonstrate a likelihood of confusion on the part of the public.

13 Yet the two subsections share a common phrase: an infringement of rights will only arise where the given activity of infringement takes place "without the consent of the proprietor." This is common to primary infringements of intellectual property laws. It is here that the defendants has attempted to argue that defence applies in this instance, under section 29(1) TMA. It is the first issue that I had to address in this appeal brought against the learned Assistant Registrar's decision to order summary judgment against the defendants. The second issue is one of implied consent, albeit this is also related to section 29(1) TMA. Although I was given to understand that the defendants abandoned another defence based on section 27(6) TMA, but in their reply submissions they canvassed the point again.

14 At the outset I would also make the additional point that within the language of section 27 TMA, it is of paramount clarity that "the proprietor" must refer to the proprietor or registered owner of the trade mark infringed against. It also follows that the trade mark complained against must a trade mark that is registered in the Singapore register of trade marks (see further section 2(5) TMA).

15 When deciding whether a case of infringement falls under the first or second subsection of section 27 TMA, regard must first be had to the identity or similarity of the alleged infringing trade mark, with the trade mark in Suit. This is a significant determination, because if the signs and the trade marks are found to be similar and not identical, then the determination moves to section 27(2) TMA, which requires the determination of a likelihood of confusion.

16 The plaintiffs were correct to point out that 'Katana' was the essential element of their trade mark (see exhibits LAJ-3, LAJ-4 and LAJ-10 of the affidavits of Mr Loh Ah Joo dated 4th February 2003 and 4th March 2003). In making this determination I would discount the disclaimer of 'golf' and 'kG' from the registered trade mark. What remains is the logo and work 'KATANA'. With these fetters to

the plaintiffs' trade mark registration, there is no need, as the defendants contended, for the plaintiffs to have obtained a separate registration for the word mark 'KATANA'.

17 The question was whether the sign that was used by the defendants on its clubs could be said to be identical to the plaintiffs' trade mark for the purposes of a determination of infringement under section 27(1) TMA. The distinctive and dominant components of the plaintiffs' trade mark is the word 'KATANA' (see *SA Societe Diffusion v SA Sadas [2003] FSR 1 at 8-11*). This has been reproduced in terms. In determining the identity of signs with the trade mark in Suit, case law has also alluded to the feature that the defendants' signs do not have to be exactly the same in order to be considered identical for the purpose of the UK equivalent provision (section 10(1) UK Trade Marks Act). This was held in *Aktiebolaget Volvo & Anor v Heritage (Leicester) Limited [2000] FSR 253*, where the Defendants' use of the signage 'Independent Volvo Specialist' (my emphasis) did not render it non-identical to the registered trade mark 'VOLVO'.

18 This being the case, if the defendants had, without the consent of the plaintiffs proprietor, advertised, offered for sale and selling, another party's (Umeda's) golf clubs which bear the identical sign 'KATANA', this amounted to trade mark infringement under section 27(1) TMA.

19 I would also make the observation that the identity of the trade marks appeared to have been conceded by the defendants. In paragraph 18 of the defendants' Skeletal Submissions it was written that "Additionally, in the present case, the defendants' trade mark is in law and in fact identical with or substantially similar to 'the registered trade mark'".

20 For these reasons I concluded that the plaintiffs had established its case for infringement under section 27(1) TMA.

21 Against this the defendants raised two defences under sections 29(1) and 27(6) TMA. I shall deal with each in turn.

Section 29(1) TMA

22 Section 29(1) provides that "Notwithstanding Section 27, a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market, whether in Singapore or outside Singapore, under that trade mark by the proprietor of the registered trade mark or with his express or implied consent (conditional or otherwise)". Section 29(2) goes on to provide that subsection (1) does not apply "where the condition of the goods has been changed or impaired after they have been put on the market, and the use of the registered trade mark in relation to those goods is detrimental to the distinctive character or repute of the registered mark."

23 Subsection 29 TMA encapsulates the "exhaustion of rights" defence, which is applicable to parallel imports. Once the express or implied consent of the proprietor of the trade mark is obtained to put goods bearing the said trade mark to market in Singapore or out of Singapore, thereafter they travel freely. To facilitate the free movement of goods and services in the modern world, an exhaustion of rights provision such as that seen in section 29 TMA prevents the proprietor of the trade mark to subsequently use his proprietary rights to prevent a parallel import from entering the country, or the subsequent sale and dealings of the same.

24 Section 29 is moreover a restricted defence. It only applies where one is dealing with the genuine goods of the trade mark proprietor. Subsection (2) withdraws the protection given by the TMA to parallel importers upon the proprietor showing that the parallel imports have been impaired or have changed character such that the use of the trade mark on the goods would be detrimental to

the distinctive character or repute of the registered trade mark.

25 I did not see any credible triable issue raised under section 29 TMA to justify the matter going for trial. In the first place the 55ATi golf club is not a parallel import. If the plaintiffs in these proceedings was Umeda Shokai KK, the owner of the Katana trade mark in Japan, then it would necessitate further consideration of whether the registered proprietor had expressly or impliedly consent to his golf clubs being first put to market. He would thereafter be unable to assert his rights against importation and sale in Singapore under section 29 TMA, subject at all times to the conditions of subsection (2).

Implied Consent

26 The defendants argued that a triable issue could be raised by the implied consent of the proprietor of the Trade Mark in Suit, the series mark registration KATANA Golf and kG Logo (T97/099241) that is owned by the plaintiffs. At the very outset I would make the observation that the reference to the consent of the proprietor, whether under section 27 or 29 TMA, must refer to the consent of the plaintiffs in this case.

27 This led me first to consider 'implied consent' in relation to the 'exhaustion of rights' defence. I could not understand how any argument could be sustained that the 55ATi golf club is a parallel import of the plaintiffs' golf club. It was not manufactured by the plaintiffs, nor did it bear the plaintiffs' trade mark. The plaintiffs were in a position to give their express or implied consent over the use of their series trade mark in Singapore (or elsewhere where there is an overseas registration), in relation to their own drivers and clubs. The infringing 55ATi did not form part of the stable of these clubs and drivers. Hence this was not the scenario where section 29 would even apply, since it could not be the law that every defendants to summary trade mark infringement proceedings could raise section 29 TMA in a context that did not deal with parallel imports, and expect the issue to go to trial as a result.

28 This appeared to be the position suggested by the authorities that were relied on by the defendants.

29 In *Castrol Limited v Automative Oil Supplies Limited [1983] RPC 315*, the plaintiffs granted a licence to their related company in Canada to manufacture motor oil under the 'Castrol' trade mark. The licence precluded the sale of the oil outside Canada. The tins of motor oil also bore the following notice:

> "Manufactured in Canada under licence from Castrol Limited. No licence is granted or is to be implied by the sale or supply of this container under or in relation to any patent trade mark or copyright of or owned by Castrol anywhere in the world outside Canada."

30 There was reason for this territorial separation, as the oil which was sold in Canada was different from that sold in the UK. Use of the wrong grade would adversely affect consumption. The defendants imported and sold in the UK motor oil manufactured by the Canadian licensee, bearing the above notice. It tried to rely on the now repealed section 4(3)(a) of the UK Trade Marks Act 1938, which was in pari materia with section 45(3)(a) of Singapore's repealed Trade Marks Act, and provided as follows:

> "The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of the trade mark as aforesaid by any person -

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or a registered user…has at any time, expressly or impliedly, consented to the use of the trade mark….manifested by signs, action or facts, or by inaction, silence, or other conduct which raises a presumption that the consent has been given."

31 In *Castrol* the defendants were unable to establish an express or implied consent to the sale of the Canadian oil in the UK. The licence agreement and the physical differences between the products showed, in no uncertain terms, that such consent had been withheld (see pp 323-324). The facts in the present case were quite different. It had never been suggested that the 55ATi driver was made under any licence granted by the plaintiffs. If at all it was a case where a parallel importer was successfully sued for trade mark infringement, under a different legislative regime. By contrast, in this case, the defendants were not even a 'parallel importer' of the plaintiffs' golf clubs in the first place.

32 The defendants also relied on the well known decision of *Revlon Inc v Cripps & Lee Limited [1980] FSR 85*. The plaintiffs sued for the infringement of the registered trade mark, "Revlon Flex", arising from the importation into the UK of hair shampoos bearing the said mark. The mark had been applied to goods in the US by the parent company of the registered proprietor in the UK. No conditions attached to these goods restricting importation and sale in any particular jurisdiction. The goods were homogenous, in that they bore the legend "Revlon/New York-London-Paris". The defendants came into these goods after their manufacture was discontinued in the US. They imported them into the UK. The plaintiffs in this instance could not prevent the defendants from selling the goods in the UK. The subsidiary must be taken to have consented to the parent company's use of the trade mark. The court recognised that the parent company, Revlon Inc, had the power to over-rule any objection that a subsidiary could raise, by virtue of its control over it. In the context of *Revlon* we were talking about goods that were manufactured by the multinational Revlon group, which were then moved into the parallel importer's jurisdiction. I failed to see that any parallel can be drawn with the present case, especially when the "Revlon Flex" trade mark had been exploited as part of an international exercise, and used to indicate that the goods to which it was applied originated from the Revlon group.

33 The defendants also relied on the decision of *Betts v Willmott (1871) LR 6 Ch App 239*, specifically the following passage (at 245), where Lord Hatherley LC said:

"It comes within the doctrine of leave and licence…Unless it can be shewn…that there is some clear communication to the party to whom the article is sold, I apprehend that inasmuch as he has the right of vending the goods in France….he transfers with the goods necessarily the licence to use them wherever the purchaser pleases. When a man has purchased an article he expects to have control of it and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his licence to sell the article, or to use whatever he pleases as against himself."

34 In *Betts* we were considering parallel imports within the statutory regime of patents, where different exclusive rights accrued to the patentee. As I alluded to earlier, the position was quite different in the present case, where the 55ATi driver was not even a parallel import when taken in the context of the plaintiffs' trade marks and golf clubs. They were manufactured by a party other than the plaintiffs. I failed to see how a triable issue was even raised by this argument.

35 The defendants did not argue to my satisfaction that triable issues were raised under section 29 TMA. The requirements of that section did not begin to apply in this case, because:

(a) the mark on the defendants' clubs was not the plaintiffs' trade mark;

(b) the defendants' club was not put out to market in Japan under the plaintiffs' trade mark.

(c) The defendants' club was *not* put on the market in Japan by the plaintiffs, or with its implied consent.

(d) The defendants' club was made by the registered proprietor of the Umeda Trade Mark in Japan, which was not a subsidiary or an associated company of the plaintiffs.

36 Within the larger analysis of infringement under section 27 TMA, the defendants submitted that triable issues were disclosed by the "…inaction, silence and/or conduct on the part of the plaintiffs which shows or raises a presumption that consent has been given." On closer inspection, their arguments did not bear scrutiny.

37 First, they said that Umeda Shokai registered the Katana trapezium trade mark in Japan for golf clubs, and the plaintiffs must have known this since January 2000. Yet they never objected to the Japanese registration, and registered their own Katana KG trade mark in Japan.

38 I failed to see how the plaintiffs' conduct viz. the Umeda trade mark in Japan was in any way relevant to an infringement action which it brought in Singapore, concerning their own Katana KG trade mark, that was registered in Singapore. Using this territorial registration, the plaintiffs were entitled to object to the use of identical or similar trade marks, such as the Umeda trade mark, in Singapore.

39 Second, by way further expansion of the first argument, they said that the Katana trapezium trade mark had been used by Umeda Shokai in Japan for its golf clubs for a number of years with the plaintiffs' knowledge, yet the plaintiffs did not, and still do not object to such use. Why should the plaintiffs object to Umeda Shokai's registration and vice versa, if the parties were happy, for whatever reason, that their trade marks were to co-exist in Japan?

40 The defendants then argued that the clubs made and sold by Umeda Shokai, were initially put on the market in Japan by Umeda. The defendants then argued that the clubs (specifically the 55ATi drivers) had been put in the market in Japan with the plaintiffs' implied consent. I do not see how the plaintiffs were in a position to provide any implied consent, since it was not the proprietor of the Umeda trade mark.

41 This would be the case even if the plaintiffs imported and sold golf clubs bearing the Umeda trade mark in Singapore, which was in the evidence before me. They bought these clubs from Umeda and promoted and sold these clubs in Singapore as a distributor. The defendants then argued that the plaintiffs by this conduct consented to or condoned the sale in Singapore of the golf clubs which bore the Umeda trade mark, that was identical or similar to the plaintiffs' trade mark. Therefore the defendants must be allowed to continue with their own importation and sale of clubs bearing the Umeda trade mark.

42 If at all, the defendants had misunderstood the operative consent in this situation. I agreed with the plaintiffs' argument that when the plaintiffs sold the Umeda golf clubs, they were happy to do so notwithstanding its own registration of the trade mark in Suit, namely, the KATANA Golf and kG Logo series mark (T97/099241). Under sections 27(1) and (2) TMA the plaintiffs' acts of sale did not amount to an infringement because, as the registered proprietor of the Singapore registered trade mark, they consented to their own sale of the Umeda clubs. The defendants could not sell the

Umeda clubs because they did not have the plaintiffs' consent to do so, the plaintiffs being the registered proprietor of KATANA Golf and kG Logo series mark.

43 To have agreed with the defendants would be tantamount to re-writing trade mark law, and expand the defence of implied consent to one where the consent could be given by one other than trade mark proprietor in Singapore. This could not be correct.

44 I agreed with Kerly's Law of Trade Marks, where it is stated in para 13-12:

> "it should be no answer to an allegation of infringement that the purpose of the mark is to show a business connection with a foreign manufacturer entitled to use the mark in his own country, and not with the British owner of the mark."
>
> (see also *4711 (1953) 70 RPC 235*; *Everglide [1964] RPC 37 at 42*)

Section 27(6) TMA

45 It was originally thought that the defendants were not going to take this up in this appeal, but in the course of argument the defendants submitted on it. It could be despatched quickly. Section 27(6) TMA provides:

> "Nothing in subsections (1) to (5) shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or licensee, but any such use otherwise than in accordance with honest practices in industrial and commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to the distinctive character or repute of the trade mark."

46 This section did not apply. It only concerned the use of a proprietor's trade mark for the purposes of identifying the goods as being those of the proprietor. Typically it would arise in the context of comparative advertising. The defendants were not using the Umeda trade mark to identify the 55ATi driver as a club of the plaintiffs.

47 There was also a fundamental incongruity about running defences under section 29(1) TMA and section 27(6) concurrently, as the defendants had done. It was not possible to argue that under section 27(6) TMA the defendants were using Umeda's trade mark to identify the 55ATi driver as a club belonging to the plaintiffs and in the same breadth also argued that the plaintiffs had given implied consent to the use of the Umeda trade mark on a driver that did not belong to the plaintiffs.

Claim in Passing Off

48 In the alternative, the plaintiffs' claim in passing off would also succeed. The of-cited trinity of requirements for a passing off action (goodwill, misrepresentation and damage) clearly applied: *CDL Hotels International Ltd v Pontiac Marina Pte Ltd [1998] 2 SLR 550*. From the evidence before me (principally trade and advertising) they had demonstrated goodwill in the business relating to the sale by the plaintiffs in Singapore of golf clubs bearing the trade mark in Suit.

49 The plaintiffs argued that the defendants' use in Singapore of the Umeda Trade Mark on the 55ATi driver was a misrepresentation that driver was the plaintiffs' club or was in someway connected to or associated with the plaintiffs. I concluded that a misrepresentation did arise from the defendants' activities, since the defendants' 55ATi driver was not supplied by the plaintiffs. It did not

belong to the plaintiffs' stable of clubs.

50 Finally on the issue of damage, the defendants' actions had caused or were likely to cause damage to the plaintiffs in terms of lost sales or the diversion of business. Evidence of actual damage to the plaintiffs was not required, even if it would be preferable. In this case the plaintiffs at the very least had suffered the loss of sale of 6 of its own clubs (assuming the defendants only imported 6 clubs as presented in their evidence). I was also prepared to hold, after examining the golf clubs in question, that the distribution of the 55ATi driver so marked would, in the circumstances of the case, be likely to result in a likelihood of confusion. This finding would similarly found an infringement under section 27(2) TMA, if the defendants' sign was similar, as opposed to being identical to the plaintiffs' trade mark.

51 On these facts, the acts of the defendants sufficiently constituted the tort of passing off.

52 In response to the substantial claim for passing off, the defendants again relied on the defence of parallel importation, citing the *Castrol* and *Revlon* decisions, discussed above. *Castrol* concerned physical differences between products, and the explicit withholding of consent, which were both inapplicable to present facts. The case of *Revlon* was distinguishable on the basis that the sources of the goods were companies within the same corporate group. Moreover the reputation and goodwill that was generated by the sale of the products in the UK, as packaged, could potentially extend to any goods of the same genre dealt with by the multinational Revlon group trading in a number of jurisdictions. There was therefore no misrepresentation as to the commercial origin of these products, or their class and quality. It was held that the defendants' sale of Revlon Flex products, inspite of the American origins of the products, could not constitute passing off.

53 What was also noteworthy about *Revlon* was the observation by Templeman LJ (as he then was), that the purchaser of Revlon Flex in London or New York or elsewhere relied on the international reputation of the multinational Revlon group. No purchaser knew or indeed cared about whether the product was made in Wales by a Venezuelan company or in New York by a Delaware corporation (see pp 115-116). In the present case, the plaintiffs and the defendants were separate and distinct entities. The golfing fraternity would be keen to know the origins of, to take an example, the 55ATi driver. The plaintiffs would be equally anxious to avoid any suggestion that the 55ATi derived from them, in view of their own products bearing their proprietary trade mark.

54 These principles were also applied in *Sin Heak Hin Pte Ltd & Anor v Yuasa Battery Singapore Co Pte Ltd [1995] 3 SLR 590*. The plaintiffs sold car batteries in Singapore. These batteries were made by a Chinese company under licence from Yuasa Corp of Japan. Yuasa Corp had a Singapore subsidiary, making car batteries in Singapore under licence from Yuasa Corp of Japan. The Singapore subsidiary published an advertisement implying that the plaintiffs were passing off. The plaintiffs sued for trade libel and the defendants counterclaimed for passing off. It was held that the sale in Singapore of batteries made in China under licence from Yuasa Corp of Japan could not constitute passing off because the goods were legitimate goods made with the consent of the licensor. Yuasa Corp had goodwill in the business of Yuasa batteries in Singapore. Even if legitimate goods in China came into Singapore through unauthorised sources there could still be no passing off. If the Japanese parent could not maintain an action for passing off, its subsidiary in Singapore would similarly fail in such an action. In the present case, I could not see how this case was of any assistance to the defendants. Judith Prakash J endorsed the following passage from para 202 of 49 Halsbury's Laws of England (4th Ed, Reissue), which I reproduce *in extenso*:

> " 'Parallel imports' means strictly the importation and sale by others of goods originating from the owner of industrial property rights in parallel with his own importation of such goods whether

carried out by himself or through authorized agents, but is used more generally to describe the importation and sale by third persons of goods obtained in another country which originate from an international company or group irrespective of whether the company or group satisfies the market in the United Kingdom by imports from that country.

The importation and sale in the United Kingdom of the plaintiffs' goods bearing the marks under which the plaintiffs have allowed them to be sold in a foreign country does not generally amount to passing off, since no misrepresentation is involved as to the origin of the goods. Attempts by plaintiffs to argue that the sale of goods bearing a manufacturer's mark impliedly represents that the goods has passed through the accustomed channels of supply have been rejected by the courts, as has an attempt to sever and assign the goodwill of the business importing the goods into the United Kingdom from the goodwill of the business carried on in the country of origin. It generally makes no difference that the imported goods originate not from the same legal person who supplies the goods to the market in the United Kingdom but from another member of the same group of companies, since in modern trading conditions customers will usually neither know nor care which company within a group is responsible for the sale of the goods, the commercial origin of which is indicated by marks used by the group as a whole…It is probable that goods which are manufactured to which marks are applied under licence stand in the same position as goods actually made by a member of the group of companies."

55 As I had already found that the 55ATi golf clubs could not strictly be 'parallel imports', according to decided cases and the definition proffered above, the defendants did not succeed in arguing that there was no misrepresentation.

56 For the above reasons, the learned Assistant Registrar was correct to hold that plaintiffs were entitled to judgment. The defendants' appeal (RA 89/2003) against that order was dismissed with costs fixed at SGD5,000.00.

RA No. 90/200357

This was the plaintiffs' appeal on the issue of costs. Two applications for summary judgment were before the learned Assistant Registrar. The first application was taken by the plaintiffs on its claim, the other by the defendants on their Counterclaim (a threats action). The hearings took one afternoon, lasting almost 3 hours. Written submissions were tendered. The learned Assistant Registrar awarded SGD2,500.00 and reasonable disbursements. Taking the complexity of the arguments before the learned Assistant Registrar, and the pleadings, affidavits and submissions filed, I allowed the appeal against this order, and ordered the defendants to pay the plaintiffs the sum of SGD8,000.00 in respect of the hearing below.

Defendants' appeal in RA89/2003 dismissed
Plaintiffs' appeal in RA90/2003 allowed

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