Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another Suit
[2005] SGHC 225

Case Number : Suit 619/2004, 674/2004

Decision Date : 15 December 2005

Tribunal/Court : High Court

Coram : Andrew Phang Boon Leong J

Counsel Name(s) : Patrick Yap Peck Choon and Prithipal Singh (K L Tan and Associates) for the plaintiff; M Ravindran and Adrian Kwong Sze Ken (Ravindran Associates) for the defendants

Parties : Nation Fittings (M) Sdn Bhd — Oystertec Plc

Tort – Passing off – Plaintiff suing defendants for passing off – Whether defendants selling goods similar to plaintiff's goods – Whether sufficient proof of goodwill belonging to plaintiff – Whether any misrepresentation of defendants' goods as plaintiff's goods – Whether any actual or potential damage to business or goodwill of plaintiff resulting from such misrepresentation

Trade Marks and Trade Names – Infringement – Registered proprietor of trade marks for pipe fittings seizing allegedly infringing pipe fittings – Whether any infringement under s 27 Trade Marks Act – Seized pipe fittings three-dimensional whereas registered proprietor's trade marks two-dimensional – Whether two-dimensional trade marks registered under repealed Trade Marks Act may be considered three-dimensional shape marks as provided for under new Trade Marks Act without need for fresh application for registration as such – Trade Marks Act (Cap 332, 1993 Rev Ed), ss 27, 109, Third Sched para 2(1) Trade Marks Act (Cap 332, 2005 Rev Ed)

Trade Marks and Trade Names – Infringement – Registered proprietor of trade marks for pipe fittings seizing allegedly infringing pipe fittings – Whether registered proprietor making groundless threat of trade mark infringement – Whether defence of actual infringement of trade marks available to registered proprietor – Sections 27, 35 Trade Marks Act (Cap 332, 2005 Rev Ed)

Trade Marks and Trade Names – Invalidity – Grounds for declaring registered trade mark invalid – Whether registered proprietor's trade marks satisfying definition of "trade mark" – Whether registered proprietor's trade marks having any distinctive character – Whether application for registration made in bad faith – Sections 2(1), 7(1)(a), 7(1)(b), 7(6), 23(1) Trade Marks Act (Cap 332, 2005 Rev Ed)

Trade Marks and Trade Names – Revocation – Whether to revoke registered proprietor's trade marks for non-use – Burden of proving use – Minimal use of registered trade marks in pristine form – Whether use of registered trade marks in form differing in elements suffices – Whether any proper reasons for non-use – Sections 22(1), 22(2), 105 Trade marks Act (Cap 332, 2005 Rev Ed)

15 December 2005 *Judgment reserved.*

Andrew Phang Boon Leong J:

Introduction

1 The present case raises, apparently for the first time in the local courts, issues relating to the legal status of shape marks.

2 Shape marks are, as the very term suggests, three-dimensional in nature. Prior to the enactment of the present Trade Marks Act (Cap 332, 2005 Rev Ed) ("TMA" or "the present Act") in 1998, which came into force on 15 January 1999 (with the exception of s 54, which came into force

on 31 October 2000), such (shape) marks could not be registered. Only two-dimensional marks could be registered. However, since the enactment of the present Act, shape marks may be registered.

3 As we shall see, the present proceedings do not relate to shape marks that were registered under the TMA. Hence, an important *threshold* issue that arises is whether or not the registered trade marks that are the subject matter of the present proceedings and that were originally registered under the previous Trade Marks Act (Cap 332, 1993 Rev Ed) ("the previous Act") as two-dimensional marks can now be considered as three-dimensional shape marks for the purposes of the present proceedings.

4 However, I am running a little ahead of the story. Before proceeding to outline and consider the various legal issues raised in the present proceedings, it would be appropriate to set out briefly the relevant factual background.

5 On 27 May 2004, Oystertec Plc ("Oystertec"), a company registered in the UK, obtained (and subsequently executed) a search warrant at the premises of Best Ceramic Pte Ltd ("Best Ceramic"). This raid was executed together with members of the Criminal Investigation Department's Intellectual Property Rights Branch. Best Ceramic is a retailer of, *inter alia*, pipe fittings. Oystertec in fact seized 950 pipe fittings supplied by Nation Fittings (M) Sdn Bhd ("Nation Fittings").

6 Correspondence ensued between the lawyers for Oystertec, Best Ceramic as well as Nation Fittings. Amongst this correspondence was a letter dated 18 June 2004 from Oystertec, through its lawyers, which contained (according to Nation Fittings) a threat of legal proceedings.

7 On 23 July 2004, Nation Fittings commenced legal proceedings (in Suit No 619 of 2004), alleging a groundless threat by Oystertec under s 35 of the TMA. Oystertec's defence was that the threat was not in fact groundless as the sale of the (seized) pipe fittings had infringed its registered trade marks under s 27 of the same Act. These registered trademarks in Class 6 (for "pipe fittings"), of which Oystertec was the registered proprietor, were T81/02113Z and T81/02114H (hereinafter referred to as "TM 113" and "TM 114", respectively, and which can be found at Appendix A to this judgment). TM 113 is in fact the device as used in T81/02114H, but which includes the words "CONEX SANBRA".

8 On 13 August 2004, Oystertec commenced its own set of legal proceedings against Best Ceramic (in Suit No 674 of 2004) for alleged trade mark infringement of TM 113 and TM 114, as well as for alleged passing off. Best Ceramic not only denied such alleged infringement as well as passing off but also counterclaimed for a groundless threat (under s 35 of the TMA) as well as for the revocation of TM 113 and TM 114 under s 22 of the TMA and/or invalidation of these registered trade marks under s 23 of the same Act.

9 On 12 November 2004, Lai Siu Chiu J consolidated both the above actions and ordered that they be heard together. By a subsequent Order of Court dated 21 March 2005, it was ordered that both actions be treated for the purposes of trial as being one action under the (second) Suit No 674 of 2004, with all documents filed or given in either of the two actions mentioned being capable of being used in the consolidated proceedings. These are in fact the actions before the court in the present proceedings. To avoid unnecessary confusion, and consistent with the last-mentioned Order of Court, I will henceforth refer to Oystertec as "the plaintiff" and Best Ceramic as well as Nation Fittings as (collectively) "the defendants".

The issues

10 The issues raised in this case may be classified into two broad categories – those relating to statutory provisions in general and to provisions of the TMA in particular, and those relating to the common law with regard to the law of passing off.

11 In so far as the former category is concerned, it may be classified into five broad issues, as follows:

(a) Whether or not the *transitional provisions* contained in *the Third Schedule of the TMA (applicable by virtue of s 109 of the same Act)* operated to render or "convert" *the plaintiff's two registered marks* (*viz*, TM 113 and TM 114), which were registered as *two*-dimensional marks under the *previous Act*, into *three*-dimensional (*shape*) marks under the present Act, *without* the need for the plaintiff to make a *separate application* under the present Act.

(b) Whether or not *the actions of both defendants* in the present proceedings constitute *trade mark infringement* under *s 27(1) and/or s 27(2) of the TMA*.

(c) Whether or not *the plaintiff's two registered trade marks* ought to be *revoked* on the basis of *non-use* in Singapore under *s 22(1)(b) of the TMA*.

(d) Whether or not *the plaintiff's two registered trade marks* ought to be *invalidated* under *s 23(1) of the TMA*.

(e) Whether the *plaintiff* had made *a groundless threat* under *s 35 of the TMA* and, if so, the appropriate relief that should be accorded to Nation Fittings or any other party.

12 In so far as the latter category is concerned, the relevant issues (at *common law*) centred around the doctrine of *passing off* – in particular, whether Best Ceramic had in fact passed off Nation Fittings' pipe fittings as the plaintiff's.

The relevant provisions of the TMA

13 It would also be appropriate, in my view, to set out, right at the outset of the present judgment, the relevant provisions of the TMA that are in issue, and which were referred to briefly above.

14 Sections 22(1), 22(2), 22(3) and 22(4) read as follows:

Revocation of registration

22.—(1) The registration of a trade mark may be revoked on any of the following grounds:

(*a*) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(*b*) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;

(*c*) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered;

(*d*) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1), use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Singapore includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (*a*) or (*b*) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the 5 year period and before the application for revocation is made.

(4) Any commencement or resumption of use referred to in subsection (3) after the expiry of the 5 year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

15 Sections 23(1) and 23(2) read as follows:

Grounds for invalidity of registration

23.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.

(2) Where the registered trade mark was registered in breach of section 7 in that it is a trade mark referred to in subsection (1) (*b*), (*c*) or (*d*) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

16 Section 23(1) above refers to s 7, which reads as follows:

Absolute grounds for refusal of registration

7.—(1) The following shall not be registered:

(*a*) signs which do not satisfy the definition of a trade mark in section 2 (1);

(*b*) trade marks which are devoid of any distinctive character;

(*c*) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and

(*d*) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1) (*b*), (*c*) or (*d*) if, before the date of application for registration, it has in fact acquired a distinctive character as

a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of —

(*a*) the shape which results from the nature of the goods themselves;

(*b*) the shape of goods which is necessary to obtain a technical result; or

(*c*) the shape which gives substantial value to the goods.

(4) A trade mark shall not be registered if it is —

(*a*) contrary to public policy or to morality; or

(*b*) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(5) A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law.

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

(7) Notwithstanding subsection (2), a trade mark shall not be registered if it contains or consists of a geographical indication in respect of a wine or spirit and the trade mark is used or intended to be used in relation to a wine or spirit not originating from the place indicated in the geographical indication.

(8) Subsection (7) shall apply whether or not the trade mark has, or is accompanied by, an indication of the true geographical origin of the wine or spirit, as the case may be, or an expression such as "kind", "type", "style", "imitation" or the like, and irrespective of the language the geographical indication is expressed in that trade mark.

(9) A trade mark shall not be refused registration by virtue of subsection (7) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either —

(*a*) before 15th January 1999; or

(*b*) before the geographical indication in question is protected in its country of origin.

(10) A trade mark shall not be refused registration by virtue of subsection (7) if the geographical indication in question —

(*a*) has ceased to be protected; or

(*b*) has fallen into disuse,

in its country of origin.

(11) A trade mark shall not be registered in the cases specified in sections 56 and 57.

(12) The Minister may make rules to provide that a sign specified in the rules shall not be registered as a trade mark, or shall not be so registered unless such conditions as may be prescribed are met.

(13) A trade mark shall not be registered if or to the extent that the registration contravenes any rule made under subsection (12).

17 Sections 27(1) and 27(2) read as follows:

Acts amounting to infringement of registered trade mark

27.—(1) 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.

(2) 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 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.

18 Section 35 reads as follows:

Remedy for groundless threats of infringement proceedings

35.—(1) Where a person threatens another with proceedings for infringement of a registered trade mark other than —

(*a*) the application of the mark to goods or to material used or intended to be used for labelling or packaging goods;

(*b*) the importation of goods to which, or to the packaging of which, the mark has been applied; or

(*c*) the supply of services under the mark,

any aggrieved person may bring proceedings for relief under this section.

(2) The relief which may be applied for is any of the following:

(*a*) a declaration that the threats are unjustifiable;

(*b*) an injunction against the continuance of the threats;

(*c*) damages in respect of any loss he has sustained by the threats.

(3) The plaintiff is entitled to the relief referred to in subsection (2) unless the defendant

shows that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark concerned.

(4) If the defendant showed that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark concerned, the plaintiff is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.

(5) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

(6) Nothing in this section shall render an advocate and solicitor liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

19 Section 109 reads as follows:

Transitional provisions

109.—(1) The provisions of the Third Schedule have effect with respect to transitional matters on 15th January 1999.

(2) The Minister may, by order published in the *Gazette*, amend the Third Schedule to make such further transitional provisions as he may consider necessary and expedient.

20 The material part of the Third Schedule reads as follows:

THIRD SCHEDULE

Section 109

TRANSITIONAL PROVISIONS

Introductory

1.—(1) In this Schedule, unless the context otherwise requires —

"existing registered mark" means a trade mark or certification trade mark registered under the Trade Marks Act (Cap. 332, 1992 Ed.) immediately before 15th January 1999;

"the old law" means the repealed Act and any other enactment or rule of law applying to existing registered marks immediately before 15th January 1999.

(2) For the purposes of this Schedule —

(*a*) an application shall be treated as pending on 15th January 1999 if it was made but not finally determined before that date; and

(*b*) the date on which it was made shall be the date of filing under the repealed Act.

Existing registered marks

2.—(1) Any existing registered mark, whether registered in Part A or B of the register kept under the repealed Act, is a registered trade mark for the purposes of this Act.

(2) Any existing registered mark registered as a certification trade mark in the register kept under the repealed Act is a registered certification mark for the purposes of this Act.

(3) Any existing registered mark registered as a series of trade marks in the register kept under the repealed Act is similarly registered in the new register for the purposes of this Act.

(4) In any other case, any note indicating that an existing registered mark is associated with any other mark shall cease to have effect on 15th January 1999.

3.—(1) A condition entered in the register kept under the repealed Act in relation to an existing registered mark immediately before 15th January 1999 shall cease to have effect on that date.

(2) Proceedings under section 39 (3) of the repealed Act which are pending on 15th January 1999 shall be dealt with under the old law and any necessary alteration made to the new register.

(3) A disclaimer or limitation entered in the register kept under the repealed Act in relation to an existing registered mark immediately before 15th January 1999 shall be deemed to be transferred to the new register and have effect as if entered in the register in pursuance of section 30 of this Act.

The legal effect of the transitional provisions under the TMA

21 The main issue which arises in this particular regard is whether or not (as counsel for the plaintiff has argued) TM 113 and TM 114, having been registered as *two*-dimensional marks under the previous Act, can now be treated as *three*-dimensional marks under the TMA by virtue of the transitional provisions in the TMA, *without more*. Mr Prithipal Singh did, at one stage of the proceedings, concede (on behalf of the plaintiff) that this particular issue was a threshold one that the plaintiff had to surmount if its case were to proceed any further. However, he argued that the relevant transitional provisions under the present TMA had "*converted*" the original two-dimensional marks into three-dimensional ones.

22 I bear in mind, from the outset, the irrefutable fact that registration of *three*-dimensional (shape) marks was *not possible* under the previous Act. If the plaintiff is correct in its argument set out in the preceding paragraph, this would mean that *the mere enactment of the present Act* would, *ipso facto*, confer upon the plaintiff *additional rights it did not originally possess under the previous Act, without (and this is the important point) having to satisfy the Registrar of Trade Marks that TM 113 and TM 114 qualify as three-dimensional marks under the present Act*. Put in this form, the proposition, at first blush at least, is startling, to say the least. It would mean that the plaintiff would be able to derive *additional* rights by *simply relying on the repeal of one Act and the enactment of another – again (to emphasise the point) without more*.

23 If the plaintiff is to succeed on this particular issue, it must, in my view, demonstrate that *the clear language and intent* in *the transitional provisions* themselves *confer* such an (additional) right.

24 Counsel for the plaintiff, Mr Patrick Yap, in fact argues that the provisions, on a *literal* reading, confer such a right. As already set out above, s 109 of the TMA (at [19] above) refers to

the transitional provisions set out in the Third Schedule. The relevant provisions in the Third Schedule have also been set out above (at [20]). In particular, para 2(1) is particularly apposite. A close analysis of the precise language used is therefore imperative. The provision itself reads as follows:

> *Any existing registered mark*, whether registered in Part A or B of the register kept under the repealed Act, *is a registered trade mark for the purposes of this Act*. [emphasis added]

25 The definition of an "existing registered mark" is found in para 1(1) of the Third Schedule and has been set out above (at [20]).

26 It would appear at first blush, as counsel for the plaintiff has argued, that a *literal* reading of para 2(1) would suggest that TM 113 and TM 114, registered under the old law as two-dimensional marks, had become registered trade marks "for the purposes of this Act [*viz*, the TMA]".

27 I pause at this juncture to note that a literal reading of the (indeed, any) statutory text could lead to a dry, brittle literalness that does no justice to the enterprise of the law in general and the text concerned in particular. On the contrary, the favoured approach nowadays (and rightly so, in my view) is a purposive approach that is exemplified not only by the case law but also by s 9A(1) of the Interpretation Act itself (Cap 1, 1999 Rev Ed). Indeed, a purposive approach towards the statutory text does not ignore the literal meaning of the text by any means but, rather, complements it by ensuring that the purpose and intent of the statutory text itself is achieved and that any strained and, a fortiori, absurd result is avoided. I should reiterate that the court's interpretation should be consistent with, and should not either add to or take away from, or stretch unreasonably, the literal language of the statutory provision concerned. In other words, the literal statutory language constitutes the broad framework within which the purpose and intent of the provision concerned is achieved. It is imperative, to underscore the point just made, that this framework is not distorted as the ends do not justify the means. Where, for example, it is crystal clear that the statutory language utilised does not capture the true intention and meaning of the provision concerned, any reform cannot come from "legal gymnastics" on the part of the court but, rather, must come from the Legislature itself.

28 Looked at in this light and bearing in mind the principles set out in the preceding paragraph, an alternative – and, in my view, more reasonable as well as persuasive – interpretation of para 2(1) of the Third Schedule of the TMA is as follows: *For the purposes of continuity and (hence) predictability, as well as to avoid the concomitant chaos that would ensue from the conclusion or assumption that trade marks registered under the previous (now repealed) Act had lapsed, para 2(1) provides that such existing trade marks would continue as registered trade marks in the form they were originally registered for the purposes of the (new) TMA*. Indeed, a logistical logjam or even nightmare would be prevented in the process. From a practical perspective, it would have made *no sense* for existing registered trade mark holders to have spent all the time and effort to *re*-register trade marks that were *already* registered under the old law. After all, the TMA was *not* intended to affect *existing* trade marks. If so, what need would there then have been to require re-registration? It would, in my view, have been an exercise in futility. *Hence, trade marks already registered under the old law as two-dimensional marks would be treated as continuing as registered (two-dimensional) trade marks under the TMA without the need for the additional, and practically otiose, step of registration under the TMA*. This was all that was intended, in my view, by the enactment of para 2(1) of the Third Schedule in the TMA. *It was not intended to confer, retrospectively, any additional rights that did not already exist by virtue of registration under the previous Act (which was repealed by the TMA)*. If the position were otherwise, then the procedural requirements under rr 15(2) and 16(5) of the Trade Mark Rules (Cap 332, R 1, 2000 Rev Ed) would be bypassed and be rendered redundant or otiose in a significant number of cases.

29 It is undoubtedly the case that the TMA did in fact provide, in some instances at least, for *new* rights that did *not* exist under the previous Act. Indeed, as I have briefly alluded to at the outset of the present judgment, the new TMA allowed for the *registration* of *three*-dimensional (*shape*) marks. This was previously *not* available under the previous Act. *However*, *such* additional or new rights could *only*, in my view, be attained by *a fresh registration under the TMA*. Indeed, it should be noted that the plaintiff in the instant case has in fact already lodged a fresh registration under the Act for a three-dimensional or shape mark, the outcome of which is still pending.[note: 1] Whilst it could be argued that the plaintiff was hedging its bets, so to speak, in doing so, it would follow, given my interpretation of (especially) para 2(1) of the Third Schedule of the TMA, that this is the *only* way that a valid right in a three-dimensional shape mark could be obtained pursuant to the provisions of the TMA, bearing in mind the fact that it is *a completely new right that never existed under the previous Act*.

30 I should add that even the application for a shape mark under the TMA is itself not merely a formality or a forgone conclusion by any means. Indeed, merely to show an unusual or attractive shape is insufficient: There *must* be *trade mark significance* inasmuch as the shape concerned performs the function of *identifying origin*: see, for example, the English High Court decision of *Yakult Honsha KK's Trade Mark Application* [2001] RPC 39 at [10]. And there are a great many instances where the application for such a (shape) mark has in fact been unsuccessful: see, for example, in addition to *Yakult Honsha KK's Trade Mark Application*, the (also) English High Court decisions of *Interlego AG's Trade Mark Applications* [1998] RPC 69 and *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 890, as well as the English Court of Appeal decision of *Procter & Gamble Ltd's Trade Mark Applications* [1999] RPC 673. Also, whilst it is true that the criteria for assessing the distinctiveness of three-dimensional shapes of product marks are no different from those to be applied to other categories of trade marks, the need (as we have seen) to identify the origin of the product and the need to take into account the perception of the consumers of the goods concerned may in fact have the result that "it *may in practice* be more difficult to establish distinctiveness in relation to a shape of product mark *than a word or figurative trade mark*" [emphasis added]: see the European Court of Justice decision of *Linde AG v Deutsches Patent-und Markenamt* [2003] RPC 45 at [48]. To like effect is the (also) European Court of Justice decision of *Henkel KGAA v Office for Harmonisation in the Internal Market* [2005] ETMR 44 at [38] and the English Court of Appeal decision of *Bongrain SA's Trade Mark Application* [2005] RPC 14. Indeed, in this last-mentioned decision, Jacob LJ, who delivered the judgment of the court, observed thus (at [25]):

> As a matter or principle I do not accept that just because a shape is unusual for the kind of goods concerned, the public will *automatically* take it as denoting trade origin, as being the badge of the maker. At the heart of trade mark law is the function of a trade mark — expressed in Recital 10 of the [European] Directive as an indication of origin. The perception of the public — of the average consumer is what matters. Mr Daniel Alexander Q.C., for the Registrar, helpfully pointed out that the kinds of sign which may be registered fall into a kind of spectrum as regards public perception. This starts with the most distinctive forms such as invented words and fancy devices. In the middle are things such as semidescriptive words and devices. Towards the end are shapes of containers. The end would be the very shape of the goods. Signs at the beginning of the spectrum are of their very nature likely to be taken as put on the goods to tell you who made them. Even containers, such as the fancy Henkel container, may be perceived as chosen especially by the maker of the contents (*e.g*. shampoo) to say "look — here is the product of me, the maker of the contents". But, at the very end of the spectrum, the shape of goods as such is unlikely to convey such a message. The public is not used to mere shapes conveying trade mark significance … [emphasis in original]

31 The preceding paragraph further supports the argument – made above – to the effect that

an "automatic conversion" of a two-dimensional mark into a three-dimensional (shape) mark was not intended by the relevant transitional provisions under the present TMA.

32 However, Mr Yap also argued that his interpretation of the transitional provisions was supported by the decision of Rimer J in the English High Court decision of *Koninklijke Philips NV v Remington Consumer Products Ltd* [2005] FSR 17 ("*Philips 2005*"). In particular, he cited the following passage from Rimer J's judgment (at [13]), as follows:

> One of the significant changes introduced by the Directive and the Act was the extension of trade mark protection to the shape of goods, or to three-dimensional marks. The 452 mark is a *two*-dimensional drawing and was in fact registered in 1993*, before the* [new] *Act* [which is similar to the TMA] *came into force.* It is, *however, common ground* that, *if its registration was valid, it should be treated as also covering a three-dimensional shape*. [emphasis added]

33 In my view, *Philips 2005* is *not* applicable to the present case. In particular, it can, as we shall see in a moment, be distinguished easily from the facts of the present proceedings. Let me elaborate.

34 First, the proposition by Rimer J in the above quotation is *not* the *ratio decidendi* (or even one of the *rationes decidendi*) in *Philips 2005* itself. A close perusal of the passage will reveal that it was "*common ground*" between counsel for *both opposing* parties that the trade mark concerned ("the 452 mark") would, having been registered as a *two*-dimensional drawing, *nevertheless* be treated "as also covering a *three*-dimensional shape". In short, the point was admitted by the defendant in *Philips 2005* and was, hence, *never argued*. Indeed, there was no common intention that even *that* unargued point would have any effect beyond the specific facts of that particular case. It would, in my view, be extremely unwise, therefore, to treat the views of Rimer J as being even highly persuasive – and this is a view that Rimer J, I would hasten to add, might, in all likelihood, have taken himself.

35 Secondly, it is also very significant, in my view, that the trade mark in question (the 452 mark) was in fact *a drawing of* what was *clearly* a *three*-dimensional shape (see Appendix B of this judgment). In other words, the 452 mark in *Philips 2005* was *intended to depict a three-dimensional shape*, *viz*, a shape with *depth and perspective*. Why, then, it might be asked, was it not filed as a three-dimensional shape mark? It was simply because, at *that* particular point in time (*viz*, the time of registration), the law did *not* permit the registration of three-dimensional trade marks, *only two*-dimensional ones (this, it should be noted in more than passing, was *also* the situation in the *Singapore* context in general and the present situation in particular). Hence, the claimant in *Philips 2005* did *the best it could under the circumstances*, which was to register the trade mark *in a manner that depicted its three-dimensional aspects as well*.

36 What has just been mentioned in the preceding paragraph is corroborated by the fact that the 452 mark was *not* the *only* mark registered by the claimant *under the previous UK Act*. On the *contrary*, *two prior existing trade marks* had *already been* successfully registered by the claimant. It is *very instructive*, in my view, that both these last-mentioned trade marks were not only *two*-dimensional drawings (as they, in the very nature of things (here as a depiction in drawings), *had* to be) but were *also represented as such*. In other words, the two prior existing trade marks depicted a *two-dimensional drawing with no depth or shape whatsoever in what was a simple plan view* (and see Appendix C of this judgment). It is of the *first importance* to note that these particular trade marks (in Appendix C) are *very similar in nature and outlook* to TM 113 and TM 114, which are of course the subject matter of the present proceedings (and which are to be found in Appendix A). *All* these shapes (in both Appendix A as well as in Appendix C) have a *common thread*: They are all

representations or depictions *in a two-dimensional manner (ie*, via a *drawing) of (and this is the vital point) what is, in form and substance, a two-dimensional trade mark (as apparently viewed from a plan view)*. There is, in other words, *no representation or depiction of any form in respect of depth or perspective in all the trade marks exhibited at Appendix A and at Appendix C to this judgment.*

37 All this is in *sharp contrast* to the 452 mark in *Philips 2005*. Indeed, this difference in representation or depiction would be immediately obvious to even the average person. My initial view, that there is (as a result) a *significant legal* difference as well, was subsequently driven home by the views of counsel for the defendants, Mr M Ravindran, to very similar effect in his submissions in reply to counsel for the plaintiff's submissions.

38 Thirdly, I also note that, in *Philips 2005*, the claimant concerned applied for registration of the 452 mark under the old UK Act *not long prior to* the coming into force of the *new* Act. This is significant. The claimant in that case applied for registration on *20 April 1993*. This was slightly over a year before the new (UK) Act came into force (on *July 1994*). When we bear in mind the fact that the two trade marks (in *two*-dimensional format and as set out in Appendix C) were registered well before the new Act came into force in July 1994 *and* were *not* relied upon by the claimant, it is clear that the claimant's intention in *Philips 2005* with regard to the registration of the 452 mark on 20 April 1993 was to apply for a trade mark that was *three*-dimensional in nature (see Appendix B), with the at least possible hope that when the *new* Act came into force, there would then accrue (to the claimant) a right in a *three*-dimensional shape mark that was not hitherto possible under the previous law. And, for good measure, the claimant *also* made a *fresh* application under the *new* Act for the re-registration of the *exact same mark* as the 452 mark on *31 October 1994*.

39 The present case is similar, in many ways, to *Philips 2005*. *However*, there are *also* a number of *crucial points of difference* which, as I have pointed out above, serve to *distinguish* the present proceedings from those which obtained in *Philips 2005*. In the circumstances, therefore, the plaintiff's reliance on *Philips 2005* is, with respect, misconceived. *Philips 2005* was decided – and therefore stands – on its own facts.

40 In all this, there are also at least three more *general* lessons that can be learnt. The first is that one has to be very careful about what are central propositions of law on the one hand and what are (in contrast) peripheral or marginal propositions, or even (as was the case here) concessions, on the other.

41 The second more general lesson is this: even if *Philips 2005* is on point (which, as I have just mentioned, it is not), it *does not automatically bind Singapore courts*. On many occasions, the received English law is appropriate to local circumstances and ought to be adopted (see, for example, *CHS CPO GmbH v Vikas Goel* [2005] 3 SLR 202 at [87]). On other occasions, however, the received English law might have to be modified or even discarded altogether. This is premised on two criteria, the application of both of which must be integrated – the need for the principle concerned to be consistent with general reason and logic as well as the need for the principle concerned to be appropriate to the circumstances of Singapore. On occasion, one will be more prominent than the other, although, for the most part, both would have a role to play as the court concerned assesses whether or not the received English law ought to be continued, modified or rejected.

42 The third constitutes one of the central principles in the methodology of the common law. It is that the *facts and context* of each case must be examined closely. This is especially needful where, as here, what appears persuasive at first blush might actually be the precise opposite (as I have found) when the specific factual matrices are examined and compared more closely. The common law system operates by way of a system of analogy, but, for that very reason, one must

ensure that the analogies drawn as well as applied are as accurate as possible.

43 Consistent with the reasons I have given above, I find no conflict between the approach I have adopted in the present case and that adopted in *Philips 2005*, where the point was not definitively decided in the first instance. In any event, as I have pointed out, the nature, intention and purpose of the relevant transitional provisions in the TMA, as well as common sense, the public interest and general considerations of fairness and justice, make it clear, in my view, that a trade mark registered under the previous law does *not*, *ipso facto* and *without more*, confer *additional* rights by virtue of its registration under the (*new*) TMA. I would, nevertheless, be prepared to go so far as to hold *or* at least to leave open the point that if the trade mark concerned had been registered under the *previous* law *with the intention of appropriating a three-dimensional shape mark although it was not then possible and was depicted accordingly*, then it *might be possible* – but that is the *highest* I would put it – for that particular trade mark to confer the *additional* right to a *three*-dimensional shape mark under the *new* Act (*ie*, the TMA), *without* the need for *a fresh application* under the new Act itself. However, this is *clearly not* the case *here*. Both TM 113 and TM 114 were *two*-dimensional trade marks *and* were registered as such. There is *nothing* in the both of them to suggest any intention to appropriate a *three*-dimensional right as such.

44 On this ground alone, and consistent with the plaintiff's own admission or concession (at [21] above), I must find in favour of the defendants.

45 I should add that I am fortified in my decision by the broader consideration to the effect that whilst the court should recognise and give effect to the rights of registered trade mark holders wherever appropriate, it should also bear in mind the fact that such rights should not be permitted to either blatantly or subtly develop into disguised monopolies which stifle or stymie the general public interest and welfare. Put simply, registered trade mark holders ought, except in the face of the clearest indications by the courts or Legislature to the contrary, to be expected to demonstrate the legal basis for the rights they claim – particularly where (as in the present case) the plaintiff is seeking an "expansion" of existing trade mark rights simply by reliance on the transitional provisions of the TMA alone. Before the court affirms such rights, the statutory language and intention here must be clear. However, this is clearly not the case in the present proceedings as I have elaborated upon in some detail above. Indeed, in the House of Lords decision of *Coca-Cola Trade Marks* [1986] FSR 472, it was emphasised (at 474) that the then UK Trade Marks Act (of 1938) (c 22) "was *not intended to confer on* a manufacturer of a container or on the manufacturer of an article *a statutory monopoly* on the ground that the manufacturer has in the eyes of the public established a connection between the shape of the container or article and the manufacturer" [emphasis added]. Although that case considered a different Act, the point of general principle, in my view, remains. In this regard, one might also usefully refer to the observations of Laddie J in the English High Court decision of *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713 ("the *Wagamama* case") at 729, that *did* concern the current UK Act (which is similar to its Singapore counterpart) and where the learned judge referred to the need to *justify* monopolies (reference may also be made to the English High Court decision of *Interlego AG's Trade Mark Applications* ([30] *supra* at 108–110)). Finally, the following observations by Prof David Vaver (who is presently Professor of Intellectual Property and Information Technology Law at the University of Oxford and who is one of the leading scholars in the field worldwide) in "Unconventional and Well-Known Trade Marks" [2005] Sing JLS 1 at 18 should also be noted:

> [D]oes granting greater trade mark rights do anything worthwhile other than reward efforts that would have occurred anyway?
>
> I think not. Traders will always seek to make their products look, feel or smell better to attract or

retain customers. They have plenty of ways to distinguish their products or services through conventional marketing practices. The truly inventive idea or design may deserve a patent or design right if it meets patent or design protection criteria. *To allow trade mark protection in addition for the "unconventional mark" [including shape marks] is to suggest the irrelevance of other protective regimes that were supposedly designed to encourage particular forms of innovation and to let other practices remain free for imitation. Deliberately chosen patent and design policies should not be swept aside by the side wind of trade mark law.*

[emphasis added]

46 A pertinent – and related – point was also raised by Mr Ravindran for the defendants. He argued that even if it were possible for certain two-dimensional marks to be used to enforce rights in relation to a (three-dimensional) shape as argued for by the plaintiff (which argument I have in fact rejected), this should not be permitted with respect to TM 113 and TM 114 as the ambit of the rights in relation to these two marks is not clear at all on the face of the public register – because (as Mr Ravindran, correctly in my view, points out) they do *not*, *inter alia*, make *any claim* for a *three*-dimensional shape or include various representations of every aspect of the shape being claimed. This argument is in fact *ad idem* with the views I have expressed earlier on in this judgment (and see, especially, above at [35] and [43]). Indeed, Mr Ravindran pointed pertinently to the plaintiff's *current application* made *after the filing of the writs in the current proceedings* (application number T04/19069J filed on 4 November 2004), which application the plaintiff's main witness, Mr Thomas Tan ("PW1"), conceded, under cross-examination, would present a *clearer* picture of the ambit of the rights claimed in so far as the plaintiff's pipe fittings are concerned – not least because they are in a *three*-dimensional format with *five* representations of three-dimensional shapes of the said pipe fittings as well (see Appendix D) . Indeed, in his submissions, Mr Ravindran gave a number of actual examples of three-dimensional marks registered under the (present) TMA by persons *already* having two-dimensional marks.[note: 2]

47 The Singapore Trade Mark Register is in fact open for public inspection (see s 68(1) of the TMA). The suggested requirement (set out in the preceding paragraph) that the ambit of rights in relation to registered trade marks (such as TM 113 and TM 114) should be clear on the face of the public register would appear to be both logical and commonsensical. Indeed, as Mr Ravindran has cogently argued in his submissions, any approach to the contrary would impair the very function of the public register itself, which is to enable "other traders … to ascertain with certainty exactly what their competitors (actual or potential) have registered or have applied to register" (see *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 13th Ed, 2001) ("*Kerly's*") at para 2-12; reference may also be made to the European Court of Justice decision of *Sieckmann v Deutsches Patent-und Markenamt* [2003] RPC 38 at [48] and [52]). It is important to reiterate that this approach is in fact consistent with my views with respect to the persuasiveness of *Philips 2005*, as the focus in that particular case was on a clear and unambiguous representation of a three-dimensional mark in the form of the 452 mark, albeit in two-dimensional form (see generally above at [33]–[39]).

48 However, in deference to the very comprehensive arguments proffered by both counsel (who should be commended for their considerable industry and diligence), I will deal with the remaining issues they have raised and argued. In the circumstances, I will not dwell at length on them, except on the few instances where the law concerned is still unclear.

The issue of infringement

Is there a requirement that there be use as a trade mark?

49 Although I have found that the plaintiff's case fails at the threshold, I nevertheless proceed to consider its case with regard to the other issues on the *assumption* that it passes muster under the very first issue.

50 It is important to note, at this juncture, that the legal burden of proof lies throughout on the plaintiff.

51 It is equally important to note that, of the many issues canvassed in the context of *the TMA* (see generally above at [11]), the defendant has to succeed on *just one* issue in order to prevail.

52 It should also be noted that, in so far as issues relating to the *common law* action by the plaintiff in the context of the tort of *passing off* is concerned, all the defendant has to demonstrate is that *one* of the essential elements that must be proved by the plaintiff on the balance of probabilities is missing in order to prevail.

53 So much by way of a brief preamble. Turning, now, to the issue of infringement in general and s 27 of the TMA in particular, there is yet another significant issue of law that is still, as we shall see, *an open question* in both England *and* in Singapore. Simply put, the issue is whether or not, in order to establish a trade mark infringement under s 27 of the TMA (or its UK equivalent), the alleged infringing use by the defendant must *also* constitute *use as a trade mark* in the first instance.

54 Not surprisingly, Mr Yap for the plaintiff argued that such an additional requirement referred to at the end of the preceding paragraph is *not* required. He cited both the views of Jacob J (as he then was) in the English High Court decision of *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 290 ("the *British Sugar* case") and of Aldous LJ in the English Court of Appeal decision of *Philips Electronics NV v Remington Consumer Products Ltd* [1999] RPC 809 at 823, in support of his argument.

55 *However*, Mr Ravindran for the defendants, who (also, not surprisingly) argued for inclusion of such an additional requirement, cited the recent House of Lords decision of *R v Johnstone* [2003] FSR 42 in support of his argument. It is significant, as Mr Ravindran points out, that the House in this particular decision did in fact consider *both* decisions cited by Mr Yap in the preceding paragraph. In other words, the House was cognisant of the contrary view as embodied in both these cases but nevertheless arrived at a *different* decision. I also note that the decision of the House is, in the *UK* hierarchy of courts, one that emanates from the *highest* court of the land.

56 Nevertheless, as Mr Ravindran himself acknowledged in his written submissions, the views of the House in *R v Johnstone* were nevertheless *obiter dicta*, dealing as they did with the criminal provisions of the corresponding UK Trade Marks Act 1994 (c 26) ("the 1994 UK Act"). But a close reading of the decision itself reveals that the issue that concerns the present court, *ie*, whether use as a trade mark is necessary in the context of alleged trade mark infringement, was in fact considered and ruled upon by the House itself.

57 It also seems clear at the moment that, in so far as identical goods or services under the equivalent of *s 27(1)* of the TMA are concerned (this provision being reproduced at [17] above), use as a trade mark *is* required in the *European* context: see the decision of the European Court of Justice in *Arsenal Football Club Plc v Reed* [2003] RPC 9 ("the *Arsenal Football Club* case"). However, the court, in this particular decision, did consider the difficulty posed by the fact that infringement was stated to be in relation to the use of a "sign", as opposed to a "trade mark". It focused, nonetheless, on what it perceived to be the essential function of a trade mark, which "is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him,

without any possibility of confusion, to distinguish the goods or services from others which have another origin" (see *id* at [48]). Indeed, this part – and other parts – of the judgment were cited and applied in *R v Johnstone* (and see [64] below). Not surprisingly, the court held that "the aim of … protection is in particular to guarantee the trade mark as an indication of origin" (at [50]), hence arriving at the decision it did and adopting a narrower view of what constituted infringement under the 1994 UK Act. I do note, however, that this was *not*, apparently at least, the interpretation adopted by the English Court of Appeal in *Arsenal Football Club Plc v Reed* [2003] RPC 39. However, with respect, I prefer the interpretation of Laddie J which the Court of Appeal disagreed with: see *Arsenal Football Club Plc v Reed* [2003] ETMR 36. In any event, it might be argued, on one interpretation at least, that the Court of Appeal did *not* in fact reject the proposition that there must be trade mark use out of hand, interpreting the European Court of Justice in the *Arsenal Football Club* case as having embraced a broader proposition that focuses on "whether the third party's use affects or is likely to affect the functions of the trade mark" (see at [37] of the Court of Appeal judgment). However, I wonder whether a court can escape from the concept of trade mark use as such in this broader context. I should mention that I am also fortified by the interpretation adopted by the House of Lords in *R v Johnstone*, to which I have in fact just referred, as well as by the subsequent European Court of Justice decision of *Anheuser-Busch v Budejovický Budvar, Národní Podnik* [2005] ETMR 27, especially at [64].

58 I should point out at this juncture that the *Arsenal Football Club* case is of no mean importance simply because, as alluded to in the preceding paragraph and as we shall see in a moment, it was endorsed by at least the majority of the law lords in *R v Johnstone*.

59 I note that there are also decisions in jurisdictions other than England which also appear to support the proposition to the effect that use as a trade mark is necessary in the context of alleged trade mark infringement: see, for example, the Scottish Court of Session (Outer House) decision of *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996] FSR 205 ("the *Bravado Merchandising Services* case") and the European Court of Justice decision of *Hölterhoff v Freiesleben* [2002] FSR 52.

60 I note, further, that a similar view has been expressed in a leading local textbook by Mr Tan Tee Jim SC: see generally *The Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 2003) ("*Tan*") at pp 206–212, especially at pp 211–212. The learned author is of the view that such an approach is consistent with the previous law and would avoid any inconsistencies which he lists at p 212 of his work. Since an initial draft of this judgment was prepared, a second edition of this book was published. It would appear that the learned author's views have not changed: see generally *The Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 2nd Ed, 2005) at paras 10.22–10.33, especially at paras 10.32–10.33.

61 The plaintiff concedes, in its reply submissions, that the position in Singapore is in fact open. And so it must be since the UK position, as we have just seen, is also open – a point also acknowledged recently by Laddie J in *Arsenal Football Club Plc v Reed* [2001] RPC 46, especially at [63] and even more recently by Lord Walker of Gestingthorpe in *R v Johnstone* who adopted, as we shall see, a slightly different approach (as to which see [63] below).

62 I am of the view that there ought to be the requirement that there be use as a trade mark in the context of alleged trade mark infringement. I draw support not only from *R v Johnstone* as well as the views of the learned author cited at [60] above but also from the fact that such a requirement will also ensure that the legal protection of the rights of registered trade mark holders is so well-justified that it cannot be said that such holders are exploiting what might otherwise be labelled, in effect, as unnecessary or excessive monopoly rights. After all, trade marks have, in the final analysis,

to do with the *origin* of the goods concerned (and see also [57] above as well as the observations of Laddie J in the *Wagamama* case ([45] *supra*) at 729–730).

63 At this juncture, it would be appropriate to set out, in full, relevant extracts from the judgment of Lord Nicholls of Birkenhead in *R v Johnstone*, if nothing else because it contains reasoning which I adopt and which also supports the approach which I have adopted in the present case. I note that, whilst not disagreeing with Lord Nicholls, Lord Walker, who delivered the other substantive judgment, did not appear to go as far (although it might be usefully noted, nonetheless, that whilst the learned law lord did acknowledge that "[t]he law is … in something of a state of disarray", he nevertheless thought that the exposition of law in the *Arsenal Football Club* case ([57] *supra*) was "still highly material" (see at [85])). More importantly, the remaining three law lords, Lord Hope of Craighead, Lord Hutton and Lord Rodger of Earlsferry, expressly agreed with the judgments delivered by both Lord Nicholls and Lord Walker and must therefore be taken as necessarily endorsing the reasoning of the former law lord as well.

64 In *R v Johnstone*, Lord Nicholls observed thus ([13]–[17]):

> [T]he essence of a trade mark has always been that it is a badge of origin. It indicates trade source: a connection in the course of trade between the goods and the proprietor of the mark. That is its function. Hence the exclusive rights granted to the proprietor of a registered trade mark are limited to use of a mark likely to be taken as an indication of trade origin. Use of this character is an essential prerequisite to infringement. Use of a mark in a manner not indicative of trade origin of goods or services does not encroach upon the proprietor's monopoly rights. …
>
> This fundamental principle, limiting the scope of the rights of the proprietor of a registered trade mark, was well established under the early trade marks legislation. It was carried forward expressly into s.4(1)(a) of the [UK] Trade Marks Act 1938 ('being used as a trade mark'). Section 4(1)(b) muddied the waters a little. The wording of s.4(1)(b) gave rise to an unresolved controversy over whether, and to what extent, this paragraph further extended the rights of a proprietor: see the discussion in *Kerly's Law of Trade Marks*, 12th ed., (1986), pp.263–265 and the authorities cited there. This controversy is now of no more than historic interest.
>
> Against this background I turn to the 1994 Act. Section 10(1) to (3) specifies the acts which constitute infringement, but there is no express statement that the offending use must be use as a trade mark. I would not regard this as sufficient reason to suppose that Parliament intended to depart from such a basic principle. But on this, as so much else in the law of trade marks, it is necessary to look for guidance beyond the confines of the 1994 Act. One of the main purposes of this statute was to implement EEC Council Directive 89/104 of December 21, 1988. This directive, which I shall call 'the trade mark directive', was concerned with harmonising the trade mark laws of member states. Articles 5 and 6 of the directive made provision regarding the rights conferred by a trade mark and the limits of those rights. Sections 10 and 11 of the 1994 Act give effect to these two articles. So authoritative guidance on the interpretation of section 10 now comes from the European Court of Justice.
>
> For some time questions were raised on whether, given its derivation from art.5 of the trade mark directive, non-trade mark use could be caught by ss.10(1) to (3): see *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281, 291, *per* Jacob J., *Philips Electronics NV v Remington Consumer Products* [1998] R.P.C. 283, 311–312, *per* Jacob J., and in the Court of Appeal, [1999] R.P.C. 809, 823, *per* Aldous L.J.. These doubts must now be regarded as laid to rest by the decision of the European Court in the 'football souvenirs' case of Case C-206/01 *Arsenal Football Club Plc v Reed* [2003] R.P.C. 9, para.[1], at 165. The court, at p.171, para.[48], re-affirmed its

characterisation of the purpose of a trade mark in terms which accord with the approach of English law:

> "the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality".

The court [in the *Arsenal Football Club* case] then considered, at p.172, paras.[51–54], the scope of the exclusive right conferred on the proprietor of a trade mark under art.5(1)(a) of the trade mark directive, which corresponds to s.10(2)(a) of the 1994 Act. The court held that the scope of this right is co-terminous with the function of registered trade marks:

> "the exclusive right under Art.5(1)(a) of the Directive was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions. *The exercise of that right must therefore be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods.* The exclusive nature of the right conferred by a registered trade mark on its proprietor under Art.5(1)(a) of the Directive can be justified only within the limits of the application of that article. … The proprietor may not prohibit the use of a sign identical to the trade mark for goods identical to those for which the mark is registered if that use cannot affect his own interests as proprietor of the mark, having regard to its functions. Thus certain uses for purely descriptive purposes are excluded from the scope of Art.5(1)(a) of the Directive because they do not affect any of the interests which that provision aims to protect, *and do not therefore fall within the concept of use within the meaning of that provision*". (emphasis added)

Plainly, s.10 of the 1994 Act is capable of being so construed. In accordance with the *Marleasing* principle (*Marleasing* [1990] E.C.R. I-4135), it should therefore be so construed. *Non-trade mark use is not within s.10(1) to (3)*.

[emphasis added]

65 Section 10 of the 1994 UK Act is, of course, the equivalent of s 27 of the TMA. It will be seen that the reasoning of Lord Nicholls, set out in some detail above, is wholly consistent with the reasoning and approach which I endorse in the present proceedings. I also note the argument by counsel for the claimant which Laddie J considered in *Arsenal Football Club Plc v Reed* ([61] *supra* at [59]) to the effect that use as a trade mark was necessary, although the learned judge felt that a definitive view should be expressed by the House of Lords or, preferably, the European Court of Justice. As we have seen, the former has since (albeit *obiter*) expressed its views in *R v Johnstone*, whilst the latter has expressed in views in the *Arsenal Football Club* case ([57] *supra*).

66 However, in fairness, it is important to consider also the *other* side of the coin. The main authority militating against the view I have preferred is the *British Sugar* case ([54] *supra*), simply because it contains the most detailed reasoning on the point, which reasoning was not, with respect, fully considered in *R v Johnstone* itself. However, I do not, with equal respect, find the reasoning in the *British Sugar* case either persuasive or applicable in the Singapore context. Let me elaborate.

67 In the *British Sugar* case itself, Jacob J referred, first, to s 9(1) of the 1994 UK Act, which reads as follows:

> The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent.
>
> The acts amounting to infringement, if done without the consent of the proprietor, are specified in section 10.

68 The learned judge then considered the argument to the effect that the reference, in s 9(1) above, to the fact that exclusive rights in a trade mark are infringed by *the use of the trade mark* without consent suggests that the general reference to a sign in s 10 of the same Act (which is the equivalent of s 27 of the TMA) is thereby *qualified* so as to import the added requirement (in s 10 of the 1994 UK Act (s 27 of the TMA)) that the alleged infringing use must also constitute *use as a trade mark* before there can be an infringement pursuant to s 10. Jacob J was of the view that *no* such qualification or constraint was necessary; he observed (at 291) thus:

> I see no need to put any gloss upon the language of section 10. It merely requires the court to see whether the sign registered as a trade mark is used in the course of trade and then to consider whether that use falls within one of the three defining subsections. Section 9(1) is really no more than a chatty introduction to the details set out in section 10, itself adding no more than that the acts concerned must be done without consent.

69 Jacob J also noted that there was no equivalent of s 9(1) of the 1994 UK Act in Art 5 of the Directive, the Directive being the material upon which the 1994 UK Act was in fact based. The words, "by the use of the trade mark", are not in the Directive and hence the qualification or constraint argued for at [68] above would *not* apply to the Directive. More importantly, such an argument arguing for such a qualification would therefore be a *departure* from the Directive. The learned judge thought that such an intention to depart from the Directive was "wholly improbable" and therefore rejected it (*id* at 291). The learned judge was also of the view that the reference by the court in the *Bravado Merchandising Services* case ([59] *supra*) to what was said by the responsible Minister in Parliament was inadmissible, for "[w]hat matters is the language of the Directive" (*id* at 292).

70 The equivalent of s 9(1) of the 1994 UK Act is to be found in s 26 of the TMA. The actual language used is slightly different, and is as follows:

> **Rights conferred by registered trade mark**
>
> **26.**—(1) The proprietor of a registered trade mark has the exclusive rights —
>
> (*a*) to use the trade mark; and
>
> (*b*) to authorise other persons to use the trade mark,
>
> in relation to the goods or services for which the trade mark is registered.
>
> (2) The proprietor has the right to obtain relief under this Act for infringement of his trade mark.
>
> (3) The acts amounting to infringement of a registered trade mark are set out in section 27, and references in this Act to the infringement of a registered trade mark shall be construed

accordingly.

71 It is suggested, however, that there is, in *substance*, no difference between s 9(1) of the 1994 UK Act and s 26 of the TMA. The focus is still on the infringement of the exclusive rights of the proprietor of a registered mark *to use (or to authorise others to use) the trade mark concerned*.

72 That being the case, the issue arises as to whether or not the plain language of s 26 read with s 27 of the TMA should be interpreted in the manner Jacob J has suggested in the *British Sugar* case, and which has been set out briefly above (especially at [68]). I would suggest, with respect, that the interpretation of the learned judge ought *not* to be followed. Although the TMA is based on the UK 1994 Act and the UK 1994 Act is, in turn, based on the European Directive, the interpretation of our Act is *not* (unlike the 1994 UK Act) subject to the Directive. What *does* matter is that any interpretation adopted with regard to the issue presently at hand must be consistent with both logic and fairness. As I have pointed out above, the requirement that there be use as a trade mark in the context of infringement under the TMA is both logical and fair (see [62] above). Indeed, in the South African Supreme Court of Appeal decision of *Triomed (Pty) Ltd v Beecham Group Plc* [2003] FSR 27, Harms JA, who delivered the judgment of the court, observed (very pertinently, in my view) thus (at [7]):

> The British Trade Marks Act 1994 (Ch.26) had to confirm to the [European] Directive and its interpretation by the ECJ binds the English courts. *This does not mean that we are bound to follow these authorities nor does our diluted Dutch legacy require of us to submit meekly to a Philips dynasty* [this was a reference to the series of *Philips* litigation]. *The Act remains a South African statute, which must be interpreted and applied in the light of our law and circumstances. Local policy considerations may differ from those applicable in Europe.* The application of rules remains, even in Europe, a matter for local courts and they differ occasionally amongst themselves. [emphasis added]

73 As (if not more) importantly, the *UK position* is itself presently in *a state of flux and uncertainty*. In this regard, I am glad to note that the reasoning in *R v Johnstone* (briefly considered above at [63]–[65], and which I have fully endorsed) buttresses the approach which I have mooted. Significantly, I also note that Jacob J himself was, in the English High Court decision of *Philips Electronics NV v Remington Consumer Products* [1998] RPC 283 at 311–312, at least *open* to *reconsidering* the views which he had expressed in the *British Sugar* case, but did not think that it was necessary in that particular case to decide the point.

74 If I am correct in my views, then applying this requirement (that there be use as a trade mark) to the facts of the present proceedings, it is clear that there was *no evidence* adduced by the plaintiff to the effect that the defendant (here, Best Ceramic) had in fact used the pipe fittings of Nation Fittings *as a trade mark as such*. If so, that concludes the present case in favour of the defendant. However, assuming I am wrong on this particular issue, I now proceed to consider whether the defendant had infringed the plaintiff's mark pursuant to s 27 of the TMA.

Has there been an infringement under section 27 of the TMA?

Whether the marks in question are identical

75 Section 27 of the TMA has already been reproduced above (at [17]).

76 One material issue is whether or not the alleged infringing three-dimensional shape (the ribbed brass compression pipe fitting of Nation Fittings, reproduced at Appendix E, and sold by Best Ceramic)

is *identical* to TM 114 (reproduced, together with TM 113, at Appendix A), the latter of which belongs to the plaintiff. If the former is indeed identical to the latter, then there might be possible infringements by the defendants under *either s 27(1) or s 27(2)(a)* of the TMA.

77 Mr Yap for the plaintiff argued that the ribbed brass compression pipe fitting of Nation Fittings was identical to the ribbed brass compression pipe fitting of the plaintiff. At this juncture, however, it is significant to note that Mr Yap was, in point of fact, comparing the three-dimensional pipe fitting of Nation Fittings with the plaintiff's own *three*-dimensional pipe fitting. However, the latter is *not* the same as *TM 114*, which is a *two*-dimensional representation instead (a point that, incidentally, Mr Ravindran for the defendants pointed out forcefully in his reply submissions). *And* a comparison of the three-dimensional pipe fitting of Nation Fittings with *TM 114* would reveal clearly that these marks are *not identical.* Once again, therefore, in order to move forward on this particular point, the plaintiff had to surmount the initial legal obstacle posed by the transitional provisions (see generally above at [21]–[47]). As I have already argued, the plaintiff in fact fails on this particular issue.

78 However, *assuming for the sake of argument* that the plaintiff can surmount the initial legal obstacle just mentioned, the issue arises as to whether or not *both three*-dimensional pipe fittings (belonging to the plaintiff and Nation Fittings, respectively[note: 3]) are identical. Mr Yap helpfully cited the European Court of Justice decision of *SA Société LTJ Diffusion v Sadas Vertbaudet SA* [2003] FSR 34, where the court opined thus (at [50]):

> The criterion of identity of the sign and the trade mark *must be interpreted strictly*. The *very definition* of identity implies that the two elements compared *should be the same in all respects*. [emphasis added]

79 Reference may also be made to *Tan* ([60] *supra*) at p 202 (at para 10.15 in the latest edition).

80 The criterion of strictness is in fact consistent with the normal English meaning of "identity". For example, the UK Trade Marks Registry decision in *IDG Communication Ltd's Trade Mark Application* [2002] RPC 10 demonstrates the need to adhere precisely to the normal English meaning of "identity".

81 Looked at in this light, I am of the view that the marks concerned in the present proceedings are *clearly not* identical. Let me elaborate.

82 In the first place, unlike the pipe fittings of Nation Fittings, the six ribs around each of the plaintiff's pipe fittings are round and the overall effect is similar to a ship's wheel (and see generally Appendix A). In addition, the effect of the ribs (especially in their impact on the overall profile of the pipe fitting itself) was, compared to the pipe fittings of Nation Fittings, much less pronounced. The six ribs on each of the pipe fittings of Nation Fittings furnished a more pronounced overall profile of the pipe fitting as these ribs were rectangular in shape and were longer than those on the plaintiff's.

83 Secondly, there were, further, 12 flat surfaces in between the (rectangular) ribs of the pipe fittings of Nation Fittings referred to in the preceding paragraph. In contrast, the surface between the six ribs on the plaintiff's pipe fittings was totally round and smooth. This was evident both from visual as well as tactile inspections of the respective pipe fittings.

84 Finally, and as (if not more) importantly, the plaintiff's pipe fittings contained the words "CONEX SANBRA", whereas the pipe fittings of Nation Fittings contained the word "SUNSHINE" instead.

85 I also note that PW1 had admitted that the respective pipe fittings had some slight differences. Mr Yap for the plaintiff emphasises that these differences were really minor ones. However, if, as I have already noted, the very concept of "*identical*" entails a strict interpretation, then even minor differences would suffice.

86 In any event, and for the reasons I have set out above (at [82]–[84]), I am of the view that the differences were more than merely minor ones.

87 However, Mr Yap for the plaintiff argued that the private investigator hired by the plaintiff, Mr Ng Chui Guan ("PW3"), had made a genuine mistake of purchasing pipe fittings of Nation Fittings instead of those of the plaintiff as originally intended. This does not, nevertheless, demonstrate that the respective pipe fittings were *identical*, although they might, conceivably, be *similar* – a point which I consider below. Further, PW3 himself conceded, under cross-examination by counsel for the defendants, Mr Ravindran, that he had in fact made a *careless* mistake.

88 Mr Ravindran also argued, persuasively in my view, that the plaintiff ought not to be comparing the pipe fittings of the respective parties but, rather, the pipe fittings of Nation Fittings with *TM 114*. I have dealt with this point above (at [77]). It suffices to reiterate that the plaintiff can embark on such an approach only if it can succeed on the very first (threshold) argument to the effect that TM 114 and TM 113 are now to be considered as registered trade marks in three-dimensional form – an argument which I have already examined in detail and rejected earlier in this judgment (at [21]–[47]).

Whether the marks in question are confusingly similar

89 If, as I have held, the pipe fittings of the respective parties were not identical, were they, then, "*similar*"? If they were, then this would satisfy the threshold requirement under s 27(2)(*b*) of the TMA (reproduced above at [17]). Infringement of the plaintiff's registered trade mark would then result, *provided that* the pipe fittings of Nation Fittings were, without the consent of the plaintiff, used in the course of trade in relation to (here) *goods* identical with or similar to those for which the plaintiff's trade marks were registered (which would in fact be the case here) *and* "there exists a *likelihood of confusion* on the part of the public". I leave aside, for the sake of argument, the threshold difficulty (already considered above at [77] and [88] which, if accepted, is potentially fatal to the plaintiff's case) to the effect that the comparison of the pipe fittings of the respective parties might not even be appropriate in the first instance.

90 The test laid down in so far as the issue of similarity is concerned is, not surprisingly, less stringent than that which exists with regard to the issue of identity. For example, in the European Court of Justice decision of *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, it was observed (at [27]) that the court has regard to the "average consumer" who is "reasonably well-informed and reasonably observant and circumspect"; it was also observed that "account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind" and that "the average consumer's level of attention is likely to vary according to the category of goods or services in question" (*ibid*). Reference may also be made, in this regard, to the European Court of Justice decisions of *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC 199 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117. It is important to note, however, that these cases adopted a *global* approach towards the issue (the oft-cited "global assessment test"). *However*, this particular approach was in fact *rejected* by Lai Kew Chai J in the very recent Singapore High Court decision of *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR 816 ("the *Polo/Lauren* case").

91 In the *Polo/Lauren* case, Lai J was of the view (at [15]) that the global assessment test was not wholly consistent with the elements set out in s 27(2)(*b*) of the TMA (the text of this provision is reproduced at [17] above). The learned judge was of the view that "[i]t is clear from the plain words of s 27(2)(*b*) that *the likelihood of confusion*, if any, *must be the direct result of the similarity* between the registered mark and the disputed sign and between the goods and services used in relation thereto" and that "[t]he provision does *not* make it an infringement if the likelihood of confusion is caused by *some other factor*" [emphasis added] (see *ibid*). Lai J proceeded to observe that "[n]either does [s 27(2)(*b*)] make similarity merely one among other factors that may be considered" (see *ibid*). Looked at in this light, "[t]his conceptual clarity is lost if we adopt the global assessment test which takes as its ultimate test the question of whether there is a likelihood of confusion" (see *ibid*).

92 Lai J also observed (at [16]) that:

> [U]nder the global assessment test approach, because the likelihood of confusion is the ultimate test for infringement, *other factors* such as the distinctiveness and the reputation of the first trade mark would decide the issue. [emphasis added].

In this regard, the learned judge opined that "if we are not careful to separate the elements required, a strong mark would get protection for a greater range of goods than a weak mark even though the goods under consideration are vastly different and dissimilar" and that "[t]his does not seem either fair or sensible" (see *ibid*). Hence, "[i]f infringement is to be made out, it should be on the basis of *the identity or similarity of the sign to the registered mark and the goods applied thereto*" [emphasis added] (see *ibid*).

93 However, Lai J also observed (at [18]) that "while the global assessment test should be rejected, I am *equally uncomfortable with a strict adherence to old English jurisprudence*" [emphasis added]. Indeed, the learned judge had earlier acknowledged (at [16]) that "while the global assessment test should be rejected, the cases that have followed this approach contain useful *dicta* particularly in respect of how the court should approach the question of whether two marks are similar".

94 The learned judge adopted, in the final analysis, the following approach (at [21]):

> [T]urning to the plain words of s 27(2)(*b*) of the TMA, I find that a proper construction of the provision does not reject the court's discretion in assessing so-called extraneous factors when deciding whether there is a likelihood of confusion. The only thing that the statute calls for is that the likelihood of confusion arises from the similarity. But where the user of a potentially infringing sign has taken pains to distinguish his products from the registered proprietor's good and services, the effect may be that the likelihood of confusion, if any, is merely hypothetical or speculative. This is significant because unlike s 27(1) TMA, s 27(2)(*b*) does not presume that there is a likelihood of confusion. If there is no likelihood of confusion, there can be no infringement: *Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd* [2003] 4 SLR 755 at [12]. Section 27(2)(*b*) TMA also does not forbid the court taking into account various factors in deciding the degree of similarity required in order to find that there exists a likelihood of confusion.

95 It is suggested that there is in fact no inherent contradiction between the global assessment test on the one hand and the more specific approach embodied within the older English jurisprudence on the other hand. In many ways, both are two sides of the same coin. The global assessment approach appears to be the "umbrella doctrine" – a shorthand way, if you like, of expressing the *general* approach to be adopted. Looked at in this light, it is, in the nature of things, phrased at a

relatively high level of generality. However, in order to *implement*, as it were, the global assessment test, there is an obvious need to have regard not only to the particular facts of the case at hand but also to more specific factors that are relevant to such a case. However, I do agree with Lai J that, consistent with the actual language of s 27(2)(*b*), the focus must, in the final analysis, be on factors that centre on a situation where the likelihood of confusion arises from the similarity in question. There will be a conflict between the global assessment test and the English approach only if the former eschews the concept of similarity altogether – which does not appear to me to be the case. Finally, it is further suggested that the approach adopted by Lai J in the *Polo/Lauren* case (as embodied in the quotation set out in the preceding paragraph) supports the approach set out in the instant paragraph. However, although I see no contradiction, in substance, between the global assessment test and the approach embodied in the old English jurisprudence, a definitive view can, and ought only, to be expressed by the highest court in this land, the Court of Appeal. Since this judgment was prepared, I have had sight of a comment on the *Polo/Lauren* case by one of the leading commentators on intellectual property law in Singapore, Assoc Prof Ng-Loy Wee Loon, entitled "The Polo Match in Singapore: England vs Europe?", which will be published in a forthcoming issue of the prestigious *European Intellectual Property Review*. The approach the learned author adopts buttresses the approach suggested in the present judgment. In this learned piece, the author clarifies precisely what the global assessment test entails and confirms that this particular test does not in fact discard the concept of similarity; instead, she observes that "the European approach [which endorses the global assessment approach] urges the tribunal to be less strict in requiring similarity between the goods" compared to the English approach. She is of the view that:

> Naturally, because the question of similarity between goods depends on the facts of each case, it is highly likely that this doctrinal difference in the two approaches will not have a material impact in practice. Two tribunals comparing the same two sets of goods may very well come to the same conclusion on the question of similarity between the goods, even though one tribunal is applying the English approach whilst the other tribunal is applying the European approach and has to be less strict on this issue.

96 Reverting to the facts of the instant case, it seems to me that the pipe fittings concerned, whilst not identical, were similar (it will be noticed that I deal only with the individual pipe fittings as it was clear, on the evidence, that the plaintiff's boxes as well as packages were *clearly distinguishable* from the boxes and packages of Nation Fittings – a point which PW1 himself conceded to be the case). However, *in addition* to the similarity between the pipe fittings, there must exist "a likelihood of confusion on the part of *the public*", and the question arises in this regard as to whether or not, in so far as this particular product is concerned (*viz*, pipe fittings), the "average consumer" has a *specific point of reference or* whether or not the "average consumer" simply means the *general public*.

97 The case law appears to suggest that the "average consumer" need *not*, *depending on the specific facts*, *necessarily mean* the general public. This appears to make good sense since each product is different. Admittedly, some situations might, as in the House of Lords decision of *Reckitt & Colman Products Limited v Borden Inc* [1990] RPC 341 (involving lemon juice in lemon-shaped containers), have potentially the entire general public as its target. On the other hand, other – more specialised – products might only be purchased (if at all) by a more specific cross-section of the public (which will itself conceivably vary in size, depending on how specialised the product is, together with allied factors such as the price charged).

98 In so far as specific (and relevant) case law is concerned, Mr Ravindran for the defendants helpfully referred to a decision I have cited earlier, *viz*, the *Polo/Lauren* ([90] *supra*) case. In this case, Lai Kew Chai J referred, *inter alia*, to the English High Court decision of *In the matter of an Application by the Pianotist Company Ld for the Registration of a Trade Mark* (1906) 23 RPC 774 ("the

Pianotist case"). The learned judge also pointed out (at [37]) that "[t]he *target market* of the plaintiff is the upper middle-class and possibly upwards, and the prices of its goods reflect its sophisticated image" whereas "the defendant *targets* mostly lower-income earners" [emphasis added]. And in the *Pianotist* case itself, Parker J observed thus (at 777):

> You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion — that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods — then you may refuse the registration, or rather you must refuse the registration in that case. [emphasis added]

99 The principles in the *Pianotist* case set out above have been cited with approval time and again in the local context (in addition to the *Polo/Lauren* case, see, for example, the Singapore Court of Appeal decisions of *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 3 SLR 147 at [44] and *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR 177 at [66] ("the *McDonald's* case"), the Singapore High Court decision of *Sime Darby Edible Products Ltd v Ngo Chew Hong Edible Oil Pte Ltd* [2000] 4 SLR 360 at [17], as well as the decision of the Singapore Registry of Trade Marks and Patents in *Samsonite Corp v Montres Rolex SA* [1995] AIPR 244 ("the *Samsonite* case" at 270). Indeed, in the *Samsonite* case itself, it was observed (at 271) by PS Tan (for the Registrar of Trade Marks) thus:

> When I consider the nature and kind of customer who would be likely to buy the goods to which the opponents' marks and the applicants' mark are applied, bearing in mind the opponents' point that both their goods and the applicants' goods are luxury goods, I note that when luxury goods are purchased, it is not like, as Parker J put it in the Pianotist case, 'somebody going and asking for washing soap in a grocer's shop.' Rather, luxury goods are bought after careful inspection and deliberation. Customers of luxury goods belong to a discerning class of purchasers. This would greatly reduce the risk of confusion. [emphasis added]

100 Reference may also be made to the following observations by Laddie J in the *Wagamama* case ([45] *supra* at 732), as follows:

> A judge brings to the assessment of marks his own, perhaps idiosyncratic, pronunciation and view or understanding of them. Although the issue of infringement is one eventually for the judge alone, in assessing the marks he must bear in mind the impact the marks make or are likely to make on *the minds of those persons who are likely to be customers for goods or services under the marks. Not all customers are the same.* It is therefore sometimes of assistance for the court to hear evidence from witnesses who will help him to assess the variety of ways in which *members of the target market* will pronounce the marks and what, to them, will be the visual or phonetic impact of the marks. [emphasis added]

101 More recently, the same judge, in *Arsenal Football Club Plc v Reed* ([61] *supra* at [25]), referred not only to "the relevant sector of the market" but also observed that "what counts is whether there is confusion amongst *that part of public which cares*" [emphasis added] (reference may also be made to the English High Court decision of *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 at 782–783).

102 It is interesting to note that even where the "average consumer" is ostensibly the general public, the courts still take the trouble to ascertain who the target consumers precisely are: see, for example, the Singapore Court of Appeal decision of *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd* [2000] 3 SLR 145 at [46], where, with respect to packages of coffee products, the court considered educated consumers, illiterate consumers as well as Chinese-educated consumers (though *cf* the somewhat different view on this particular issue (of illiteracy) in the (also) Singapore Court of Appeal decision of *Tong Guan Food Products Pte Ltd v Hoe Huat Hng Foodstuff Pte Ltd* [1991] SLR 133 ("*Tong Guan Food Products*") at 143, [30] in the context of passing off (and see also [168] below as well as the House of Lords decision of *William Edge & Sons, Limited v William Niccolls & Sons, Limited* [1911] AC 693, especially at 704–705)).

103 Applying the principles just considered to the present proceedings, the "average consumer" of pipe fittings such as those produced by the plaintiff and Nation Fittings would not potentially be just *any* person but, rather, *plumbers and contractors*, bearing in mind the fact that there might, *occasionally*, be customers who were neither plumbers nor contractors (in fact, PW1 had stated, under cross-examination, that 99% of the plaintiff's pipe fittings were sold – in packets and boxes – to hardware shops which would then, presumably, resell them to plumbers and contractors, as I have just mentioned). If so, this last-mentioned group of customers (who were neither plumbers nor contractors) would *not* be considered "*average* consumers". This would include PW3 and perhaps explain simultaneously why he had in fact made the mistake he did (as to which see [87] above). Even then, it is not unreasonable, in this regard, to expect that the *individual* consumers who were in the "do-it-yourself" mode, and who would therefore purchase such pipe fittings, would in fact be relatively familiar with the various brands as well as specifications and attributes of the pipe fittings generally on offer in the market. Mr Yap for the plaintiff in fact argued – contrary to the views which I have just expressed – that the "average consumer" constituted the general public. He pointed to individual consumers who were in the "do-it-yourself" mode. However, as I have just pointed out, such consumers would in fact constitute the *exception* rather than the rule and would probably not have been misled in any event. Even if some of the individual consumers in the "do-it-yourself" mode were misled (which, as I have just mentioned, was unlikely), these would have been (at most) isolated events which would not have sufficed (and see, for example, the *McDonald's* case at [66]). In any event, one could not, with respect, make the "logical leap" from the proposition that *some* consumers would purchase pipe fittings for their own use to the conclusion that, therefore, the "*average* consumer" of such pipe fittings would be the *general* public. Mr Ravindran, on the other hand, argued that the target consumer in so far as the present proceedings were concerned were plumbers and contractors. For the reasons I have already given, I agree with his characterisation of who the "average consumer" ought to be in the context of the present proceedings.

104 However, if the "average consumer" of pipe fittings comprises plumbers and contractors, this would impact on the criterion of the "likelihood of confusion" which is, as we have seen, one integral criterion in order for trade mark infringement to be established within the scope of s 27(2)(*b*) of the TMA. In other words, it could be argued that *such* consumers would not be likely to be confused by the pipe fittings produced by the plaintiff and by Nation Fittings respectively – despite their similarity. Or, to use the terminology of Andrew Ang J in the recent Singapore High Court decision of *Richemont International SA v Goldlion Enterprise (Singapore) Pte Ltd* [2005] SGHC 208 at [25], it could be argued that there was not "a real prospect" that such confusion would ensue *vis-à-vis* such consumers. And, in the *Polo/Lauren* case ([90] *supra* at [22]), Lai J referred to "whether this likelihood is *a real one or whether it is merely speculative or hypothetical*" [emphasis added]; indeed, the learned judge proceeded to observe thus (*ibid*):

> Where the infringer has taken sufficient steps to distinguish his goods from the plaintiff's such that the likelihood of confusion becomes *a mere possibility*, there is *no* infringement. [emphasis

added]

This is a point to which I now turn in the context of the facts of the present case.

105 Indeed, a factor of *significance* in this regard is the fact that there was evidence led by Mr Ravindran for the defendants to the effect that if the "average consumer" was a plumber or contractor, then he or she would not only be fully aware of the brands of pipe fittings available for sale but would also purchase pipe fittings based on the particular specifications and attributes of the products needed to perform their trade. This particular point is, of course, less relevant (although not wholly irrelevant) to consumers who were neither plumbers nor contractors (*ie*, who were in the "do-it-yourself" mode). However, even in such a situation, we have already seen that it would probably be the case that such consumers would not be wholly ignorant either and, therefore, not likely to be confused (see [103] above).

106 There is, on the facts of the present case, *yet another significant factor*. The *price* of the pipe fittings of Nation Fittings was *significantly lower* than those produced by the plaintiff (some *25%*, according to Mr Thomas Chua Bock Kwee ("DW1") in his affidavit[note: 4] and which was not contradicted by the plaintiff). One could, in my view, go so far as to say that this factor is *virtually decisive* in the context of the present proceedings – simply because it would serve to dispel any likelihood of confusion *even if* the "average consumer" in the present proceedings was construed as covering potential customers going *beyond* the category of plumbers and contractors only.

107 That the price of the product concerned may constitute a relevant or even significant factor is supported directly by the observation of Lai J in the *Polo/Lauren* case (quoted above at [98]). This particular consideration has also been acknowledged in the Singapore High Court decision of *Mechanical Handling Engineering (S) Pte Ltd v Material Handling Engineering Pte Ltd* [1993] 2 SLR 205 ("the *Mechanical Handling Engineering* case") at 221, [66] (*cf* also *Arsenal Football Club Plc v Reed* ([61] *supra* at [41] and the *Arsenal Football Club* case ([57] *supra* at 167, [18], the former being a decision of the English High Court and the latter a decision of the European Court of Justice). Although it is true that the *Mechanical Handling Engineering* case was decided in the context of passing off and involved (not surprisingly) a somewhat different factual context, the *general principle and logic* contained therein would be equally applicable to the present issue of confusion in a statutory context. It is true that Chao Hick Tin J (as he then was), in the (also) Singapore High Court decision of *Pontiac Marina Pte Ltd v CDL Hotels International Ltd* [1997] 3 SLR 726 (affirmed by the Court of Appeal in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550, and which also involved the issue of passing off), did (at [99]) appear to adopt a slightly different view. However, this difference is more apparent than real, inasmuch as the learned judge was referring to a situation where the defendant concerned was utilising *exactly the same product name* as the plaintiff's. It is, of course, obvious that in such a blatant situation, any price differential might not suffice to aid in dispelling the confusion thus generated. More importantly, it also appears that the learned judge was referring to a situation where it was sought to argue an absence of confusion based on the price differential *alone*. In contrast, the situation in the present proceedings is, as we have seen, quite different. I pause here to observe that even in the best case scenario, a price differential would not, generally speaking, be conclusive, although it might (as here) be extremely helpful indeed. The task of the court is, in point of fact, to have regard to *all* the relevant factors in the light of the surrounding circumstances as a whole.

108 Finally, although it was clear that the pipe fittings were sold in loose form, those which were sold in both the plaintiff's as well as Nation Fittings' *packets* were clearly distinguishable simply because the packets were themselves quite distinctive. In so far as the pipe fittings sold in loose form were concerned, there was evidence led by Mr Ravindran for the defendants to the effect that each

brand was sold in different compartments. Further, it appears that the loose pipe fittings of Nation Fittings were also in the *same* compartment as the *packets* of the same pipe fittings. This makes good logical sense since, as already noted above (at [106]), there was a significant price difference between the pipe fittings of the plaintiff and Nation Fittings, respectively, and that it was thus not surprising that the respective pipe fittings were sold in different compartments. This situation is to be contrasted with that which existed in the English High Court decision of *R J Elliott & Co, Ld v Hodgson* (1902) 19 RPC 518 (albeit in the context of passing off), where it was by no means clear that the cigars sold in loose form were clearly distinguishable as being that of the defendant. It is significant, though, that the court held that the plaintiff had no remedy in so far as cigars sold by the defendant in *boxes* were concerned as these boxes were clearly labelled and could therefore be *distinguished* from the plaintiff's boxes.

109 Mr Ravindran's argument on behalf of the defendants to the effect that, in so far as (only) TM 113 is concerned, there has been no infringement as the words therein ("CONEX SANBRA") have not been used at all by the defendants, ought also to be noted. In this regard, he emphasised the importance of the *words* ("CONEX SANBRA") as distinguishing TM 113 from the pipe fittings of Nation Fittings. He cited, for example, a decision of the Singapore Registry of Trade Marks and Patents in *Lee Cooper Group plc v Levi Strauss & Co* [1995] AIPR 457, where it was observed at 501 thus:

> Words 'talk' in trade marks. Thus, if a mark consists of a device in combination with a distinctive word (ie a word of a trade mark nature), it is most likely that it is by the word that the public will normally order goods under the mark. Therefore, where two marks resemble each other to the extent that they each contain a similar device, the overall resemblance between them will generally be lessened if they bear words of a trade mark nature which are entirely different from each other.

110 Mr Ravindran also cited, in this regard, *Kraft Food Holdings, Inc v Société des Produits Nestlé SA* (O/440/02, 23 October 2002) as well as the English High Court decision of *Laura Ashley Limited v Coloroll Limited* [1987] RPC 1.

111 Finally, I note the following comments by Millett LJ (as he then was) in the English Court of Appeal decision of *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 at 288, where the learned judge observed thus:

> Similarity is a matter of degree; and except in the case where there is absolutely no similarity at all between sign and mark (which is not this case) the question is whether the similarity is such as to be likely to cause confusion in the mind of the public. *A degree of similarity is tolerable; the question is whether there is a confusing similarity*. [emphasis added]

112 It is clear, as I have explained above, that there is indeed *no* "*confusing* similarity" in the context of the facts of the present proceedings. I should also observe that PW1 had himself admitted in cross-examination that, apart from PW3, the plaintiff had not in fact adduced any evidence of confusion.

Concluding observations

113 Before I conclude on the issue of infringement, I agree with the views of Laddie J, a judge of considerable experience in such matters, in the *Wagamama* case ([45] *supra*) – and, in particular, with his comments in that case (at 732) to the effect that "[a] judge brings to the assessment of marks his own, perhaps idiosyncratic, pronunciation and view or understanding of them". I also bear in mind his further remarks in the same case (*ibid*) that "[w]hether there has been trade mark

infringement is more a matter of feel than science". However, although all this is very true, it is also the case that the judge is aided (as I have been) by the objective factors present within the case itself, including (here) the actual items concerned, their practical functions, the target or average consumer as well as the general context concerned. And all these factors must be balanced in as commonsensical and as fair a manner as possible. In the circumstances, I have found that there has been no infringement of the plaintiff's trade marks under any of the potentially applicable provisions in s 27 of the TMA.

The issue of use

114 As already mentioned above, this particular issue turns on the interpretation and application of s 22 of the TMA (reproduced above at [14]) – in particular ss 22(1)(*a*) and 22(1)(*b*). In order to succeed, the plaintiff had to prove that TM 113 and TM 114 had in fact been used within the meaning of the provisions just mentioned. In particular, counsel for the defendants argued that it has to be shown that there was the requisite (and genuine) use *within the relevant period*, which was the five-year period preceding the initiation of the revocation action in the present proceedings (*ie*, the five-year period ending 9 June 2004, the revocation application being made on 9 September 2004). Conversely, the defendants would succeed if the opposite were demonstrated to be the case. At this juncture, however, a small caveat is in order. The overall legal (as opposed to the evidential) burden was itself an issue, which is one that I deal with below.

115 The resolution of this particular issue for the purposes of the present proceedings turns, in the main, on the cogency (or otherwise) of *the evidence adduced*. In this regard, Mr Yap for the plaintiff argued that the burden of proof is on Best Ceramic: see the Singapore Court of Appeal decision of *Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd* [1994] 1 SLR 625 ("the *Swanfu Trading* case") at 629, [20]. However, Mr Ravindran for the defendants argued to the contrary, citing s 105 of the TMA, which reads as follows:

> **Burden of proving use of trade mark**
>
> **105.** If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

116 Section 105 (reproduced above) is therefore clear in so far as the burden of proving use of the trade marks concerned in the present case is concerned.

117 Turning to the relevant provisions, it should be noted at this juncture that Mr Yap for the plaintiff argued against the application of s 22(1)*(a)* (reproduced at [14] above) in the context of the present proceedings. He argued that there had been genuine use of both TM 113 and TM 114 within the meaning of that provision and that whilst substantiality of use was a factor, this was not a mandatory requirement as such (citing, *inter alia*, *Kerly's* ([47] *supra*) at para 9-60 as well as the *Swanfu Trading* case ([115] *supra*) at 630, [25] and 632, [32]). Similar arguments are made in so far as s 22(1)*(b)* is concerned (reproduced at [14] above).

118 More specifically, Mr Yap pointed to what he argued were a number of uses in so far as both TM 113 and TM 114 are concerned. These are in relation to various types of cardboard boxes utilised by the plaintiff to pack its products as well as various versions of plastic packaging utilised for its products.

119 Mr Yap argued, further, that there had been genuine use of the buffer stock of pipe fittings and that this was, in and of itself, sufficient to demonstrate that there had been use of both TM 113

and TM 114 during the relevant period.

120 Finally, Mr Yap also pointed to the use of promotional material, which included items such as signboards outside shop fronts, sample boards, mugs, coasters, T-shirts as well as clear files. These relate, in the main, to claims with regard to the use of TM 113 during the relevant period.

121 In reply, however, Mr Ravindran for the defendants argued that TM 114 appeared on the items listed in the preceding paragraphs together with other elements and could not therefore constitute use within the meaning of ss 22(1)(*a*) and 22(1)(*b*) (it should be recalled that TM 114 is a plain mark without any wording (see Appendix A)). In response, Mr Yap argued that such an argument constituted a "red herring", taking the view that the fact that the relevant trade mark appeared was sufficient in and of itself, regardless of the fact that it was surrounded by or incorporated within other elements as well.

122 One key question raised in the present proceedings therefore seems to me to be this: To what extent can a registered trade mark be said to be used if it is incorporated into another mark or is surrounded by other elements and used in conjunction with them? There is here no doubt that TM 114 was in fact present in the various items mentioned above in a *literal or factual* sense. The crucial issue is whether or not the presence of other elements disqualifies the registered trade mark concerned from being considered as having been used in a *legal* sense.

123 Like most other areas and facets of the law, the issue seems to me to turn on the concept of line-drawing. There must, in other words, be a certain point in time when the registered trade mark in question, whilst being used literally, is subsumed within other elements to the extent that it is no longer reasonably recognisable as such. It seems to me that when that particular situation arises, the registered trade mark concerned can no longer, in law, be said to have been used within the meaning of ss 22(1)(*a*) and 22(1)(*b*) of the TMA.

124 The approach outlined in the preceding paragraph is in fact consistent with the thrust of s 22(2) (reproduced above at [14]). In particular, the use of a trade mark can in fact include "use in a form differing in elements". *However*, such elements must be such as they "do *not alter the distinctive character* of the mark in the form in which it was registered" [emphasis added]. Hence, the crucial question for the purposes of the present proceedings is whether or not the use of TM 114 together with and/or in conjunction with other elements is such that such other elements "do not alter the distinctive character of the mark in the form in which it was registered". In many ways, this must be a question of fact and degree. Looked at in this light, and examining the various uses to which TM 114 has been put, it is my view that the focus was really not on these registered trade marks as such but, rather, on the brand (and in many cases the actual word) "Conex". On occasion, TM 114 was used as part of the letter "o" in "Conex" (for example, on at least one of the plaintiff's boxes[note: 5] and two of its packages[note: 6]). It is clear that the focus here is really on the *word or brand* (*ie*, "Conex"). On other occasions, TM 114 formed the frame, so to speak, within which the "Conex" brand was advertised in various forms in words (where the focus was nevertheless still on the word (or brand, rather) "Conex"). In this last-mentioned respect, it might be argued that the mark was more prominent. However, *even here*, it is my view that the *focus* was, as I have just indicated, on the *words* (in particular, on the "Conex" brand). To take one example, one of the plaintiff's packages has this design, where the shape actually frames what is really the crux of the design itself, *viz*, the words "GET IT TOGETHER WITH CONEX".[note: 7] In other words, in all these instances, the "distinctive character of the mark" has, on the facts of the present proceedings, been altered significantly. As I have also mentioned, the *key or primary focus* appears to be on the "Conex" brand (and other related words) rather than the mark itself.

125 Mr Ravindran for the defendants also relied on the UK Registry decision of *In the Matter of Application No 9913 by Viacom International Inc for Revocation of Registration No 1021689 in the Name of Nottingham Group Limited* (O/474/01, 17 October 2001). The registered trade mark in question was "ARNOLD". Following corporate restructuring the mark was then used as "NES Arnold". It was held, *inter alia* (at [18] of the report), that:

> The presentation of NES as the first element in the mark and in upper case letters gives it a degree of prominence and importance within the totality of the mark which cannot fail to make an impression on the viewer.

Hence, the mark was revoked for non-use. Although the facts of each case obviously differ, this particular case merely underscores the general principle to the effect that there comes a point when the mark concerned has been subsumed within the other elements to such an extent that it can no longer be considered to have been used in the context of s 22(1) of the TMA. As I have already pointed out in the preceding paragraph, this was indeed the situation in the present case.

126 If, however, I am wrong with regard to my analysis of this issue (from "subsumption"), I would be prepared to hold that there *was* genuine use of TM 114 and that this would be the case even in so far as the *promotional* products were concerned. In this last-mentioned regard, it is clear that the promotional products were linked, in the final analysis, to the sale of the plaintiff's pipe fittings (see also *Premier Brands UK Ltd v Typhoon Europe Ltd* ([100] *supra* at 807); the Singapore High Court decision of *Nike International Ltd v Campomar Sociedad Limitada* [2005] 4 SLR 76 at [58]; and *Kerly's* ([47] *supra*) at paras 9-56 to 9-57). However, even here, the promotional products appear to relate to the possible use of *TM 113* – to which my attention will turn in a moment. In addition, for promotional products such as the plaintiff's T-shirt,[note: 8] there was in fact no real representation as such of TM 114 (and, *a fortiori*, TM 113) at all (although I note that an invoice was tendered that suggested that such T-shirts were still being received by the plaintiff as late as May 2004[note: 9]).

127 In the circumstances, I find that the defendants succeed on this particular issue (relating to use) in so far as *TM 114* is concerned.

128 Turning to *TM 113*, Mr Ravindran for the defendants argued that there has been no use of that registered trade mark within the relevant period. At this juncture, it will be recalled that TM 113 contains the words "CONEX SANBRA" (see Appendix A). In so far as this particular registered trade mark is concerned, Mr Ravindran argued that none of the items concerned in which TM 113 was allegedly used was used during the relevant period. I would observe that even if such items were possibly used within the relevant period (and assuming that they fell within the purview of both TM 113 as well as TM 114), the same argument canvassed above (especially at [124] and [126]) to the effect that the "distinctive character of the mark" had been altered significantly would apply. There is, for instance, the plaintiff's coaster.[note: 10] The overall shape (exhibiting that of TM 113) constitutes the overall frame, so to speak. However, it is pale yellow in colour. In contrast, the middle of the coaster is dominated by a circular Union Jack logo and surrounding it on the border are the words "TREXCO" and the telephone number (presumably of Trexco). The plaintiff's mug[note: 11] has the same design on one side and another design which has nothing to do with TM 113 on the other. There is also the plaintiff's file folder.[note: 12] Here, the same words and telephone number are once again in the border, except that the centre contains not a Union Jack logo as such but, rather, the word "Genuine" at the top, followed by the word "CONEX" in block capital letters, followed thereafter by the phrase "Compression Fittings" in (smaller) block capital letters. Being embossed on a plastic folder, this particular design is in orange. However, the focus still seemed to me to be upon the brand "Conex", rather than on the shape (in the form of TM 114) as such. There are also two signs of the plaintiffs[note: 13] which were put up at the shopfront of at least one of the hardware stores which

deals in the plaintiff's products. Looking at the photograph of this particular store,[note: 14] what struck me immediately was the fact that the word "Conex" dominated the general appearance of these signs. On one,[note: 15] in fact, the various pipe fittings exhibited were also mounted onto the sign itself. On the other,[note: 16] in addition to photographs of various pipe fittings of the plaintiff, there were also the words "The other element in water supply". However, there were certain boxes of the plaintiff, which appeared not only to contain the TM 113 mark in its pristine form (albeit in very small format, but with the words "Regd. Trade Mark" directly below the mark itself) but also buffer stock of the plaintiff's pipe fittings.[note: 17] However, it should also be noted that one of these boxes had since, as Mr Ravindran pertinently pointed out, been wholly discontinued and had in fact been replaced by new boxes.[note: 18] Be that as it may, Mr Ravindran then proceeded to argue that the main plank in favour of the plaintiff in so far as this particular issue of use was concerned hinged, in the final analysis, on the alleged use of this buffer stock. In this regard, it is true, as Mr Ravindran argued, that the issue of buffer stock itself was not raised in PW1's Affidavit of Evidence-in-Chief but only arose during the course of the trial itself. But even if these difficulties are laid aside (and they are, I might add, not insignificant difficulties), it is clear that such stock is really extremely minimal and (more importantly) the evidence as to the use (and amounts) to which it was put was quite sketchy, to say the least. As PW1 himself pointed out, the buffer stock was very old stock and is clearly not an integral part of the plaintiff's current business. In this sense, this situation can be distinguished from that in the *Swanfu Trading* case ([115] *supra*), where it was *admitted* that the sales were genuine, albeit with regard to leftover stock. Also, whilst minimal use might still pass muster (see, for example, *Re Trade Mark Cameo* (1974) 1 NZIPR 1), such use must be sufficient to indicate that the registered proprietor had a *bona fide* intention to use the mark. This was clearly not the case here, having regard (as already mentioned) to the paucity as well as sketchiness of the evidence adduced. Indeed, in the English High Court decision of *"NODOZ" Trade Mark* [1962] RPC 1, Wilberforce J (as he then was) observed (at 7) that "the fewer the acts relied on the more solidly ought they to be established" (which observation has been expressly stated to be equally applicable to the 1994 UK Act (and, therefore, our own TMA as well): see *Kerly's* at para 9-60, n 31). In the circumstances I find that the defendants succeed on the issue relating to use in so far as TM 113 is concerned as well.

129 Were there, however, "proper reasons" within the meaning of s 22(1) for the non-use of the respective trade marks by the plaintiff? The applicable principles of law here seem to me to be clear. The onus to show that it had proper reasons for not using the trade marks concerned during the relevant period is on the proprietor of the mark. If obstacles to use existed, these must have arisen independently of the will of the said proprietor and ordinary commercial delays in producing a new product bearing the trade mark in question would not constitute a valid excuse: see the English Court of Appeal decision of *"PHILOSOPHY DI ALBERTA FERRETTI" Trade Mark* [2003] RPC 15, especially at [25] as well as the decision of the UK Trade Marks Registry in *INVERMONT Trade Mark* [1997] RPC 125. Indeed, in this last-mentioned decision, *INVERMONT Trade Mark*, Mr M J Tuck pertinently observed thus (at 130):

> As can be seen in any English dictionary, 'proper' is a word with many meanings. But bearing in mind the need to judge these things in *a business sense*, and also bearing in mind the emphasis which is, and has always been placed on the requirement to use a trade mark or lose it, I think the word proper, in the context of section 46 [s 22 of the TMA] means:- *apt, acceptable, reasonable, justifiable in all the circumstances*.
>
> … I do not think the term 'proper' was intended to cover normal situations or routine difficulties. *I think it much more likely that it is intended to cover abnormal situations in the industry or the market, or even perhaps some temporary but serious disruption affecting the registered proprietor's business. Normal delays occasioned by some unavoidable regulatory requirement,*

such as the approval of a medicine, might be acceptable but not, I think, the normal delays found in the marketing function. These are matters within the businessman's own control and I think he should plan accordingly.

[emphasis added]

130 In so far as the present proceedings were concerned, having regard to the analysis already rendered above, none of the principles set out in the preceding paragraph applied. Indeed, there were no proper reasons which I could see that could aid the plaintiff in so far as the issue of use (or, rather, non-use) was concerned.

131 In the circumstances, therefore, I find that grounds therefore exist for the revocation of both TM 113 and TM 114. I will deal with the appropriate order to be made below (at [180]–[181]).

The issue of invalidation

132 The key provision in issue here is s 23(1) of the TMA (reproduced above at [15]). In particular, Mr Ravindran for the defendants argued that TM 113 and TM 114 ought to be invalidated under the provision just mentioned on the ground that they were registered in breach of s 7 of the TMA (also reproduced above at [16]).

133 Mr Ravindran proffered a number of related arguments in respect of this issue pertaining to invalidation. First, he argued that neither TM 113 nor TM 114 satisfied the definition of a trade mark under s 2(1) of the TMA and that the situation thus fell within the ambit of s 7(1)(*a*) of the TMA. A trade mark is defined, under s 2(1), as "any visually perceptible sign capable of being represented graphically and *which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services dealt with or provided by another person*" [emphasis added]. Mr Ravindran argued that product recognition *per se* was insufficient. He cited the following observations by Jacob J in the English High Court decision of *Société de Produits Nestlé SA v Unilever plc* [2002] EWHC 2709 (Ch) at [33], as follows:

> [I]t is not enough to prove the public recognises them [the trade marks concerned] as the product of a particular manufacturer. It must be proved that consumers regard the shape alone as a badge of trade origin in the sense that they would rely upon that shape alone as an indication of trade origin, particularly to buy the goods. If that cannot be proved, then the shape is not properly a trade mark, it does not have a "distinctive character" for the purposes of trade mark law.

134 Mr Ravindran also cited, in a similar vein, the following observations by Laddie J in the (also) English High Court decision of *Yakult Honsha KK's Trade Mark Application* ([30] *supra* at [10]), as follows:

> [T]he fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not … to say, whether it is of memorable appearance, but whether *by itself* its appearance would convey trade mark significance to the average customer. …
>
> … Even were [the Yakult bottle] to be recognised as of different shape to other bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance.
>
> [emphasis in original]

135 Applying the above principles to the facts of the present case, Mr Ravindran argued that it was common evidence that consumers identified the plaintiff's product by the name "Conex", and not by the shapes in TM 113 and (especially) TM 114. He also pointed out that TM 114 was never used on its own (see also generally at [121]–[125] above). Finally, he argued that TM 114 had not been registered in the UK, which is the home country of the plaintiff and that there had also been no evidence that the plaintiff had made any attempt to file this particular mark prior to the filing of the claim in the present proceedings. Mr Ravindran concluded that this suggested that the plaintiff never had any intention to use TM 114 as a trade mark by itself.

136 I am of the view that Mr Ravindran's arguments set out briefly above are persuasive. Unlike the issue of use, s 7(1)(*a*) appears to be referring to (here) TM 113 and TM 114, *as examined alone* (see also *Tan* ([60] *supra* at paras 2.48 and 5.9 of the second edition). So examined, both marks do not seem to be to be able to pass even the relatively low threshold criterion set out in the definition of a "trade mark" in s 2 of the TMA. This is due, in no small part, to the fact that both TM 113 and TM 114 do not even depict a three-dimensional shape mark. And, even if they did, no evidence has been adduced by the plaintiff demonstrating that both these marks were in fact perceived by the "average consumer" (here plumbers and contractors) as a badge of trade origin. Such evidence, always necessary, is especially needful in the light of the fact that an unusual shape alone is insufficient. Hence, the defendants succeed on this particular issue.

137 Secondly, Mr Ravindran argued, on behalf of the defendants, that TM 113 and TM 114 were, in any event, "devoid of any distinctive character" and thus fell within the ambit of s 7(1)(*b*) of the TMA. He relied, in particular, on a statutory declaration filed by PW1 in 1983, wherein PW1, instead of referring to TM 113 and TM 114, had referred to other items instead, comprising items which bore the marks that were incorporated within other elements. Without even going so far, it is clear that if, as I have found, both these marks do not even satisfy the definition of a "trade mark" under the TMA in the first instance, it would follow that they would fall foul of s 7(1)(*b*) as well. And, following from my analysis with regard to the issue of use in an earlier part of this judgment (see especially above at [121]–[125]), it would follow that the plaintiff could not avail itself of the argument (pursuant to s 7(2) of the TMA) that the relevant marks had "in fact acquired a distinctive character as a result of the use made of it". The defendants therefore succeed on this particular issue as well.

138 Thirdly, Mr Ravindran argued that both TM 113 and TM 114 were applied for (in 1981) in bad faith and were therefore in breach of s 7(6) of the TMA (reproduced above at [16]). It is imperative to point out at the outset that an allegation of bad faith is a serious one and a party who alleges bad faith has a correspondingly high standard of proof to satisfy. As Chao Hick Tin JA, delivering the judgment of the court in the *McDonald's* case ([99] *supra* at [78]) very aptly put it:

> An allegation of bad faith is *a serious matter and should not be lightly inferred*. In *"Royal Enfield" Trade Marks* [2002] RPC 24 it was held (at [31]) that:
>
> > An allegation that a trade mark has been applied for in bad faith is a serious allegation. … A plea of fraud should not lightly be made … and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1877-78) L.R. 7 Ch.D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of … bad faith made under section 3(6). *It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference*. [emphasis added]

139 The following observations of Lindsay J in the English High Court decision of *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 (and applied in *Société de*

Produits Nestlé SA v Unilever plc ([133] *supra* at [7]) as well as in *Ferrero Spa's Trade Marks* [2004] RPC 29 at [23]) are also apposite:

> I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances. [emphasis added]

140 Hence, the defendants' task in the present proceedings in proving to this court's satisfaction that there had in fact been bad faith is not a light one at all. It appears that bad faith would be present in the present proceedings if the plaintiff had filed its applications for TM 113 and TM 114 without any intention to use the same as trade marks in the form in which they were registered (see, for example, the English High Court decision of *Betty's Kitchen Coronation Street Mark* [2000] RPC 825). I have already held that there was not in fact use – in the legal sense – of TM 113 and TM 114 (see generally [114]–[131] above). However, this *objective* determination must *not*, in my view, be taken to be a *conclusive* decision *vis-à-vis the plaintiff's intention at the time the applications for TM 113 and TM 114 were filed*. In other words, it might well have been the plaintiff's intention to use these trade marks once they had been registered, *although*, as it turns out, they have been found not to have been used in *law*. Indeed, in so far as TM 114 was concerned, the plaintiff failed not so much because there was no literal use of the mark as such but, rather, because the mark itself was subsumed within the other elements with which it was used (see generally [121]–[125] above). At the very least, therefore, it has *not* been demonstrated to my satisfaction that there was in fact bad faith on the part of the plaintiff when it filed its applications for TM 113 and TM 114 in 1981. I hold, therefore, the plaintiff succeeds and the defendants fail on this particular issue.

141 In the circumstances, I find that the defendants succeed on the first two issues in relation to the argument from invalidation (albeit not on the issue of bad faith) and that they are, consequently, entitled to avail themselves of the provisions of s 23 of the TMA in the context of the present proceedings.

142 Before proceeding to consider the common law action in passing off, I note that Mr Yap for the plaintiff has argued that the defendants are precluded from raising any argument with respect to invalidation based on s 7(3) of the TMA (reproduced above at [16]) because such an argument was never pleaded. Any argument on behalf of the defendants in this particular respect would probably be premised upon the issue of *functionality*. However, Mr Ravindran for the defendants conceded this point from pleading and stated that no reliance would be placed by the defendants on s 7(3). I therefore say no more about this particular issue.

Passing off

Introduction

143 I turn, now, to the *common law* issue relating to the tort of passing off. Put simply, did (as the plaintiff claims) Best Ceramic pass off the pipe fittings of Nation Fittings as the plaintiff's pipe fittings?

144 Before proceeding to answer the question posed in the preceding paragraph, it would be apposite to set out the relevant principles relating to the tort of passing off first.

145 Since the plaintiff alleges passing off on the part of the defendant, the legal burden of proof lies squarely on it.

The elements of the tort of passing off

Introduction

146 In order to succeed in its action for passing off, the plaintiff has to prove the following (*cumulative*) elements:

(a) that there must have been goodwill or business belonging to the plaintiff;

(b) that there had been a misrepresentation by the defendants in the course of trade to either prospective or ultimate customers; and

(c) that damage has resulted (or that the likelihood of damage will arise as a result).

147 The above three elements have been referred to by Lai Kew Chai J in the Singapore High Court decision of *Pan-West (Pte) Ltd v Grand Bigwin Pte Ltd* [2003] 4 SLR 755 at [48] as "[t]he oft-cited trinity of requirements for a passing off action".

148 Lord Diplock did identify the following (oft-cited) "five characteristics" in the House of Lords decision of *Erven Warnink Besloten Vennootschap v J Townend & Sons (Hull) Ltd* [1979] AC 731 ("the *Warnink* case") at 742, as follows: "(1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so" (see also a not dissimilar formulation by Lord Fraser of Tullybelton at 755–756). However, when viewed in their entirety, the three main elements set out in the preceding paragraph may in fact be distilled from this particular formulation.

Goodwill

149 Mr Yap for the plaintiff argued that there must have been goodwill belonging to the plaintiff for the following reasons.

150 First, he argued that all the other approved brass compression pipe fittings had a *hexagonal* shape profile, whereas the plaintiff's pipe fittings had a *ribbed* shape profile.

151 Second, he relied upon sales figures for the years 1975 to 1979 as set out in the statutory declaration by PW1 (at [137] above). In this regard, Exhibit A to the said declaration showed copies of invoices evidencing sales of the plaintiff's ribbed brass compression pipe fittings for the years prior to 1980 (sales having begun in Singapore since 1975). Unfortunately, however, there were no other similar exhibits available. Mr Yap nevertheless pointed to para 25 of PW1's affidavit, listing the sales figures from 1998 to 2004 in pound sterling for the plaintiff's pipe fittings.

152 Third, Mr Yap argued that PW1's company, Trexco, had, throughout the years, been the

exclusive distributor of the plaintiff's pipe fittings in Singapore and had continuously incurred expenses on behalf of the trade mark proprietors (first Conex-Sanbra Limited, then the plaintiff) in advertising as well as promoting the said pipe fittings.

153 In response to the plaintiff's arguments as set out briefly above, Mr Ravindran for the defendants made the following arguments.

154 Firstly, and most importantly in my view, he pointed to the fact that the plaintiff had adduced insufficient evidence of goodwill. It is true that there was no documentary evidence supporting the sales figures in para 25 of PW1's affidavit. It is also true that the only witness called by the plaintiff was in fact PW1. This seemed to me, in fact, to be a general thread – and weakness – in the plaintiff's overall case (see also my observations to like effect at [174] below). There was also, if I may say so, a woeful dearth of documentary or other evidence brought in aid of the plaintiff's case in this particular regard.

155 Secondly, Mr Ravindran argued that if there was any goodwill in Singapore at all, it would be likely to be in relation to the "Conex" brand rather than the shape of the plaintiff's product as such. There was, additionally, an issue raised as to whether or not the plaintiff owned the goodwill in Singapore. However, I do not pursue this last-mentioned issue further as I was satisfied, on the documentary evidence, that the plaintiff's case could not be impugned on this particular point.

156 As a matter of general principle, it is true that the defendant cannot avoid a finding of passing off by the mere fact of showing that its goods are of as good or better quality than the claimant's. Laddie J, in the English High Court decision of *Irvine v Talksport Ltd* [2002] 2 All ER 414, after setting out the proposition just mentioned, proceeded to observe thus (at [34]):

> In such a case, although the defendant may not damage the goodwill as such, what he does is damage the value of the goodwill to the claimant because, instead of benefiting from exclusive rights to his property, the latter finds that someone else is squatting on it.

157 However, this should not deflect the court from the focus at hand – which is whether or not the plaintiff can successfully demonstrate that there is goodwill in its products in the first instance.

158 Reviewing the evidence as a whole, I begin with the proposition that mere sales *without more* are not necessarily coincident with goodwill. That is both logically as well as conceptually coherent. The plaintiff is on more solid ground when it points to the distinctiveness of its own *ribbed* pipe fittings. To this extent, this part of the case (dealing with the common law tort of passing off) is related – particularly in the factual context – to factors that I have already considered in relation to issues arising in the statutory context under the TMA. I have in mind, in particular, the fact that any distinctiveness in so far as the plaintiff's product is concerned came not so much from TM 113 and TM 114 *per se* but, rather, from the "Conex" brand, of which (at least in relation to TM 113) the plaintiff's registered trade mark was a part. However, we must not lose sight of the fact that what are in issue here are TM 113 and TM 114.

159 More to the point, I refer to the argument made earlier (and which I have accepted) that if the "average consumer" was a plumber or contractor, then he or she would not only be fully aware of the brands of pipe fittings available for sale but would also purchase pipe fittings based on the particular specifications and attributes of the products needed to perform his or her trade (see [103]–[105] above). This suggests that the focus is not on the ribbed shape of (here, the plaintiff's) pipe fittings as such which is considered merely functional for the trade and, to that extent, is considered to be generic. Such a factor would, at least arguably, be applicable to consumers other than plumbers

and contractors as well.

160 I find, on the evidence available before me, that the plaintiff has *not* proved sufficiently the element of goodwill necessary to sustain an action in passing off. Nevertheless, in the event that I am wrong in so far as this particular point is concerned, I proceed to consider the other elements necessary before an action in passing off can be successfully established.

Misrepresentation

161 The issue here, simply put, is whether or not Best Ceramic had made a false representation that led or was likely to lead potential and actual customers to believe that the pipe fittings of Nation Fittings were those of the plaintiff. In this regard, "[w]hether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods … is immaterial, as long as they are identified with a particular source which is in fact the plaintiff" (*per* Lord Oliver of Aylmerton in the House of Lords decision of *Reckitt & Colman Products Limited v Borden Inc* ([97] *supra* at 406)). The key element here is that of *deception*: see, for example, *per* Jacob J in the English High Court decision of *Hodgkinson & Corby Ltd v Wards Mobility Services Ltd* [1994] 1 WLR 1564 at 1570 and *per* Robert Walker J (as he then was) in the (also) English High Court decision of *Barnsley Brewery Company Limited v RBNB* [1997] FSR 462 ("the *Barnsley Brewery Company* case") at 467.

162 The following observations by Lord Parker of Waddington in the (also) House of Lords decision of *A G Spalding & Bros v A W Gamage Ld* (1915) 32 RPC 273 at 284 are also instructive:

> [T]he basis of a passing-off action being a false representation by the defendant, it must be proved in each case as a fact that the false representation was made. It may, of course, have been made in express words, but cases of express misrepresentation of this sort are rare. The more common case is, where the representation is implied in the use or imitation of a mark, trade name, or get-up with which the goods of another are associated in the minds of the public, or of a particular class of the public. In such cases the point to be decided is whether, having regard to all the circumstances of the case, the use by the defendant in connection with the goods of the mark, name, or get-up in question impliedly represents such goods to be the goods of the plaintiff, or the goods of the plaintiff of a particular class or quality, or, as it is sometimes put, whether the defendant's use of such mark, name, or get-up is calculated to deceive.

163 And as Graham J aptly put it in the English High Court decision of *Benchairs Limited v Chair Centre Limited* [1974] RPC 429 at 435 (reversed by the Court of Appeal, but not on this point), "[i]f there is no such false representation there can be no passing off, and the mere copying of the shape of the plaintiffs' article is not in itself such a representation"; the learned judge proceeded to observe thus (*ibid*):

> Anyone is entitled, subject to some monopoly or statutory right preventing him, to copy and sell any article on the market, and false representation and passing off only arise when a defendant does something further which suggests that the article which he is selling is that of the plaintiff.

164 And the point emphasised in the above quotation was embodied in the local context in the judgment of K S Rajah JC in the Singapore High Court decision of *Pernod Ricard SA v Allswell Trading Pte Ltd* [1994] 1 SLR 603 ("the *Pernod Ricard SA* case") at 612, [46]. And, as Jacob J put it in *Hodgkinson & Corby Ltd v Wards Mobility Services Ltd* ([161] *supra* at 1574), "[i]t is, I think, precisely because the difficulties of proof are so great that successful cases of passing off based on the shape of the goods are so rare".

165 It is also clear that, whilst a relevant factor that can be taken into account if present, the state of mind of the representor is immaterial (see generally Christopher Wadlow, *The Law of Passing-Off* (Sweet & Maxwell, 3rd Ed, 2004) ("*Wadlow*") at para 5-44, citing the House of Lords decisions of *Office Cleaning Services, Ld v Westminster Window and General Cleaners, Ld* (1946) 63 RPC 39 and *Parker-Knoll Limited v Knoll International Limited* [1962] RPC 265 ("the *Parker-Knoll Limited* case"); see also *per* Laddie J in the *Wagamama* case ([45] *supra* at 733). It would appear that the impact on the persons to whom the misrepresentation is addressed is what matters (see, for example, *per* Lord Devlin in the *Parker-Knoll Limited* case, at 289).

166 I also note that whilst "[i]t is not necessary that there should be any confusion occasioned by the misrepresentation", the proof of confusion is nevertheless "of great evidential value in determining whether or not there has been any misrepresentation": see *per* L P Thean JA, delivering the judgment of the court in the Singapore Court of Appeal decision of *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* ([107] *supra*) at [71] (*cf* also the *Barnsley Brewery Company* case ([161] *supra* at 467)).

167 In so far as this particular issue (of misrepresentation) is concerned, I must state that the evidence already considered in relation to issues arising under the TMA apply (where relevant) here as well. And that evidence, in my view, *negatives* any finding of misrepresentation – bearing in mind that the impact of the alleged misrepresentation is on the "*average consumer*", a point to which I will return shortly. As I have already canvassed the evidence in some detail, a brief summary will suffice.

168 First, the pipe fittings of Nation Fittings are *not identical* to those of the plaintiff (see generally [75]–[88] above). However, I did find that they were similar (see generally [89]–[96] above). Nevertheless – and these are the crucial points in so far as the present issue is concerned – they were neither intended to confuse and mislead, *nor actually resulted in* confusion or (most importantly of all) deception. One critical factor in this particular regard is the fact that the *price* of the pipe fittings of Nation Fittings was *significantly lower* than those sold by the plaintiff (see generally [106]–[107] above and, especially, at [107], where cases dealing directly with passing off are cited). Another is the fact that such pipe fittings are sold as *generic* items – a point that is buttressed by the fact that *the "average consumer" in so far as the alleged misrepresentation in the present proceedings is concerned is either a plumber or contractor* (see, especially, [103] above). Indeed, in so far as the concept of the "average consumer" is concerned, reference may also be made to characteristic (3) in the *Warnink* case (at [148] above) in this regard. I also note that Lord Fraser of Tullybelton also refers to "the minds of the public, *or a section of the public*" [emphasis added] in the same case (at 755). And in a similar vein, in the Singapore Court of Appeal decision of *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* ([107] *supra*), Thean JA, delivering the judgment of the court, referred (at [72]) to the phrase "the relevant section of the public". And, also in the local context, reference may be made to the Singapore Court of Appeal decision of *Tong Guan Food Products* ([102] *supra*) where Yong Pung How CJ, delivering the decision of the court, observed (at 141–142, [24]) thus:

> The law is settled and there is a series of cases for the following propositions from the last century to the present. The test to be applied has been stated in *Newsweek Inc* v *British Broadcasting Corporation* [1979] PC 441 at p 447 which is whether ordinary sensible members of the public would be confused. It is not sufficient that the only confusion would be to a very small unobservant section of society or as Foster J put it recently, if the only person who would be misled would be a moron in a hurry. *It is sufficient that a substantial proportion of persons who are probably purchasers of the goods of the kind in question would in fact be confused*. [emphasis added]

169 The learned Chief Justice in *Tong Guan Food Products* also refers (at 142, [26]) to the necessity for the court "to take into account *the nature of the purchasing public*, the extent of the confusion and the way in which confusion arises" [emphasis added]. It is also significant to note that the (also) Singapore Court of Appeal decision in *Kellogg Co v Pacific Food Products Sdn Bhd* [1999] 2 SLR 651 at [32] endorsed *Tong Guan Food Products* even in the context of alleged infringement under the Trade Marks Act. If so, then this particular decision merely reinforces – in no small way – the principles as well as decisions applied earlier with regard to the likelihood of confusion under the Trade Marks Act (as to which see generally [89]–[112] above).

170 The probable purchasers of the goods (the relevant part of "the purchasing public") involved in the present proceedings, *viz* pipe fittings, are – to re-emphasise this important point – likely to be plumbers or contractors. And I have also dealt earlier on in this judgment with the probable legal status of other possible (and individual) purchasers (who are in the "do-it-yourself" mode) and whom I have found, in any event, *not* to constitute the "average consumer" in so far as the present proceedings are concerned (see generally at [103] above).

171 As (if not more) importantly, I bear in mind the fact that there was clearly evidence led to the effect that the ribs on the plaintiff's as well as Nation Fittings's pipe fittings had *a significant functional value*. This is clear, in fact, from a brochure published by the manufacturers of the pipe fittings marketed by the plaintiff where it was stated that "Conex compression fittings are especially advantageous in retrofit plumbing schemes, in installations where space is confined, or when the use of heat must be avoided and, they are easy to disassemble".[note: 19] As importantly, perhaps, PW1, in his Affidavit of Evidence-in-Chief did (at para 11) state that "[t]he ribs are functional but they also act as a means to distinguish the brass compression pipe fittings manufactured by Oystertec from those manufactured by others". And, in the Statutory Declaration by PW1 (which was affirmed much earlier, on 9 June 1983, to be precise), he states (at para 2) that "[t]he ribs are functional and they also act as a mean [*sic*] for customers to distinguish the Applicants' pipe fittings from those of others". Although PW1 sought to explain away this last-mentioned statement by arguing that there had been a typographical error in this paragraph of the Statutory Declaration and that "functional" meant the facility of distinguishing the plaintiff's pipe fittings from those manufactured by other companies, I did not, with respect, find his explanation convincing. In my view, there has, here, clearly been an acknowledgment of functionality by PW1. *Further*, in the course of giving his testimony, DW1 did testify that the ribs made it much easier to tighten the pipe fittings where concealed pipes were concerned. It is, of course, common knowledge that concealed pipes are far more common now than they were in the past. He also demonstrated – effectively, in my view – how the ribs facilitated such tightening by utilising a hammer and screwdriver to illustrate his point on one of the ribbed pipe fittings. It seemed to me clear that the ribs on the pipe fittings had a clear functional value. Looked at in this light, one must have regard to the following observations by K S Rajah JC in the *Pernod Ricard SA* case ([164] *supra* at 612, [49]–[50]), as follows:

> It is *possible* for passing-off to occur by reason of the similarity of the *shape*, as opposed to the features, *but* where what is sought to be restrained is the copying of the bulb-shape of the plaintiffs' bottle *which has value in use*, as opposed to capricious attributes of shape or colour, *the courts are reluctant to allow a plaintiff to secure a monopoly in a new type or design of goods under the guise of a passing-off action*. …
>
> The primary meaning of the shape of the bottle as bulb-shaped is descriptive. *The plaintiffs face a heavy burden when they seek to prove that a shape which is prima facie functional has acquired a secondary meaning.*
>
> [emphasis added]

172 Hence, I find that there was no misrepresentation by Best Ceramic and that the plaintiff fails with regard to this element of its action for the tort of passing off as well.

Damage

173 I also find that the plaintiff has not furnished the court with sufficient proof of the damage which has allegedly resulted from the claim in passing off.

174 It would certainly have helped if a relevant witness from the plaintiff had in fact testified on this matter (and, it might be mentioned, other matters). However, this was not the case. The words indicated in parentheses refer to the other issues in the present case, particularly those where the plaintiff has been unsuccessful (apart from the first issue with respect to the effect of the transitional provisions of the TMA, which involve questions of law). Yet, when all is said and done, the plaintiff chose to call just one witness, PW1.

175 Mr Yap for the plaintiff argues that a likelihood of damage is sufficient (citing *Wadlow* ([165] *supra*) at para 4-11). Whilst it is the case that the proof of actual damage is not a pre-requisite, it seems to me that more than a mere likelihood of loss has to be proved by the plaintiff. Indeed, Mr Yap also cited, in his submissions, the following observations by Buckley LJ in *H P Bulmer Ltd and Showerings Ltd v J Bollinger SA* [1978] RPC 79 at 95, as follows:

> It is well settled that the plaintiff in a passing off action does not have to prove that he has actually suffered damage by loss of business or in any other way. A *probability of damage* is enough, but the actual or probable damage must be damage to him *in his trade or business*, that is to say, damage to his goodwill *in respect of that trade or business*. [emphasis added]

176 The observations just quoted confirm, in fact, my view that proof of damage must be established as a matter of *probability*, *not* mere possibility. That is in fact consistent with the general civil standard of the need to prove one's case on the balance of probabilities. In this regard, the evidence adduced in the present case by the plaintiff does *not*, with respect, meet with this standard (of probability).

Conclusion on the issue of passing off

177 I find, in the circumstances, that none of the elements of the tort of passing off has in fact been established by the plaintiff, who must therefore fail in its claim under this particular head.

Conclusion

178 Having regard to all the evidence available before the court, I hold, first, that the transitional provisions contained in the Third Schedule of the TMA (and applicable by virtue of s 109 of the same Act) did *not* operate to enable TM 113 and TM 114, which were registered as *two*-dimensional marks under the previous Act, to be treated as *three*-dimensional marks under the present Act for the purposes of the present proceedings. On this (threshold) ground alone, the plaintiff fails in its claim.

179 I also find, in any event, that there had been no infringement of the plaintiff's registered trade marks by either Nation Fittings or Best Ceramic under s 27 of the TMA and that the defendants succeed on this issue as well.

180 I find, further, that the plaintiff had not successfully proved that it had used TM 113 and TM 114 within the meaning of s 22 of the TMA. In the circumstances, I find in favour of Best Ceramic

on this particular issue as well and, consequently, hold that these registered trade marks belonging to the plaintiff ought to be revoked on the basis of non-use, and that, *inter alia*, Best Ceramic is entitled to a declaration to this effect. In this regard, I prefer the view expressed by the UK Trade Marks Registry in *ZIPPO Trade Mark* [1999] RPC 173 to that expressed in the (also) UK Trade Marks Registry in *INVERMONT Trade Mark* ([129] *supra*) to the effect that the Registrar does *not* have discretion under the equivalent of s 22 of the TMA to maintain a mark on the register when grounds for revocation have been established, whether in relation to all, or some, of the goods for which it is registered. The view in *ZIPPO Trade Mark* was, in fact, preferred (on balance) by Neuberger J in *Premier Brands UK Ltd v Typhoon Europe Ltd* ([101] *supra*); indeed, in this last-mentioned case, the learned judge observed, *inter alia*, as follows (at 811):

> [I]t does seem to me somewhat odd if the legislature has specifically provided for no revocation in the event of there being good reason for non-use, but nonetheless has left the Court with a residual discretion, particularly without giving any indication as to what factors should be taken into account when exercising that discretion. Further, consideration of the combined effect of section 46(1)(c) and (d) [of the 1994 UK Act, the equivalent provisions being ss 22(1)(*c*) and 22(1)(*d*) of the TMA] suggest to me that it is more likely that the legislature intended that those two paragraphs were to represent mandatory, rather than discretionary, grounds for revocation. … I also bear in mind that it is not only a privilege for a person to be the proprietor of a registered trade mark, but it represents a monopoly: the Court should not be too ready to perpetuate a monopoly in favour of a person who has not done anything to promote or enjoy it for a period of five years.

181 This approach has in fact been endorsed, in the *local* context, by Belinda Ang Saw Ean J in the Singapore High Court decision of *Reemtsma Cigarettenfabriken GmbH v Hugo Boss AG (No 2)* [2003] 4 SLR 155, especially at [30]–[34] (where, incidentally, *Premier Brands UK Ltd v Typhoon Europe Ltd* was cited). Indeed, the learned judge observes thus (at [31]–[34]):

> 31 There are significant pointers in favour of "may" meaning that, if any of the grounds specified in the sub-s (1) are satisfied, the power must be exercised one way. They are:
>
> (a) In this case, the statutory power conferred on the court (or Registrar) is exhaustive in that registration may be revoked in no other than in four specific grounds for revocation.
>
> (b) Subsection (3) expressly covers the situation where there is no power to revoke even if sub-s (1)(a) or (b) is satisfied. It amounts to an exhaustive statement of the position so far as relevant. There is thus no room for discretion to operate.
>
> (c) There is no "sweeping up" clause to accommodate other grounds.
>
> (d) Subsection (7) is consistent with the absence of discretion. Once the grounds are established in respect of some goods and not the rest, partial revocation is to be ordered.
>
> 32 The conclusion could be tested in another way. Firstly, if there is some unexpressed ground with which the court (or Registrar) could consider, it could only arise by implication as a matter of statutory construction. Section 22(1) states that a registered mark may be revoked on *the following grounds* and four grounds are enumerated. An implication cannot properly be found that goes against the express statement "*the following grounds*". The *expressio unius* rule gives the word "*may*" in s 22(1) the meaning "*may only*". Thus, no provision could be implied to cut down the operation of the specific terms of s 22.

33 Secondly, outside of the grounds specified, the court (or Registrar) has no power and hence no jurisdiction to remove or continue with a registered mark for any other reason like public interest ground.

34 I would add that since the function of a trade mark is to give a proprietor a monopoly when his trade mark is used, there should be no discretion to retain the mark if the grounds are established. If such mark is not used or if there is no intention to use it, it ought to be revoked: see *PHILOSOPHY DI ALBERTA FERRETTI" Trade Mark* [2003] RPC 15; *Imperial Group Ltd v Philip Morris & Co Ltd* [1982] FSR 72; Neuberger J in *Premier Brands* at 811.

[emphasis in original]

182 I find also that TM 113 and TM 114 ought to be invalidated under s 23(1) of the TMA and hold in favour of, *inter alia*, Best Ceramic on this particular issue as well, and who is therefore entitled to a declaration that both TM 113 and TM 114 are invalid pursuant to s 23 of the TMA.

183 In the circumstances, I find – and therefore make a declaration – that the plaintiff has in fact made a groundless and unjustifiable threat under s 35 of the TMA against the defendants. I therefore also grant an injunction restraining the plaintiff, whether by itself, its directors, officers, agents, servants or otherwise, from in any way continuing the making of such groundless and unjustifiable threats against the defendants or against any other party. I further order that the Registrar assess whether (and, if so, how much) damages were sustained by the defendants as the result of such a groundless and unjustifiable threat.

184 Finally, I find that the plaintiff has not proved its claim under the tort of passing off against Best Ceramic.

185 There will therefore be judgment for the defendants, together with the appropriate remedies as set out above. Costs are to be agreed and taxed if not agreed. I will hear the parties at a convenient date if any further consequential or clarificatory orders need to be made.

Judgment for the defendants.

[Editorial Note: Click on the link to the PDF above to see theAppendixes]

[note: 1]See DB 197-199.

[note: 2]See the Defendant's Closing Submissions at pp 29-33.

[note: 3]And see Exhibits PE 1 as well as DE 3 and PE 29 as well as DE 6, respectively.

[note: 4]At para 36.

[note: 5]See Exhibit PE 10.

[note: 6]See Exhibits PE 12 and PE 13.

[note: 7]See Exhibit PE 14.

[note: 8]See Exhibit PE 18.

[note: 9] See Exhibit PE 9.

[note: 10]See Exhibit PE 17.

[note: 11]See Exhibit PE 16.

[note: 12]See Exhibit PE 19.

[note: 13]See Exhibits PE 25 and 26.

[note: 14]See Exhibit PE 20.

[note: 15]See Exhibit PE 26.

[note: 16]See Exhibit PE 25.

[note: 17]See Exhibit PE 11, 27 and 28.

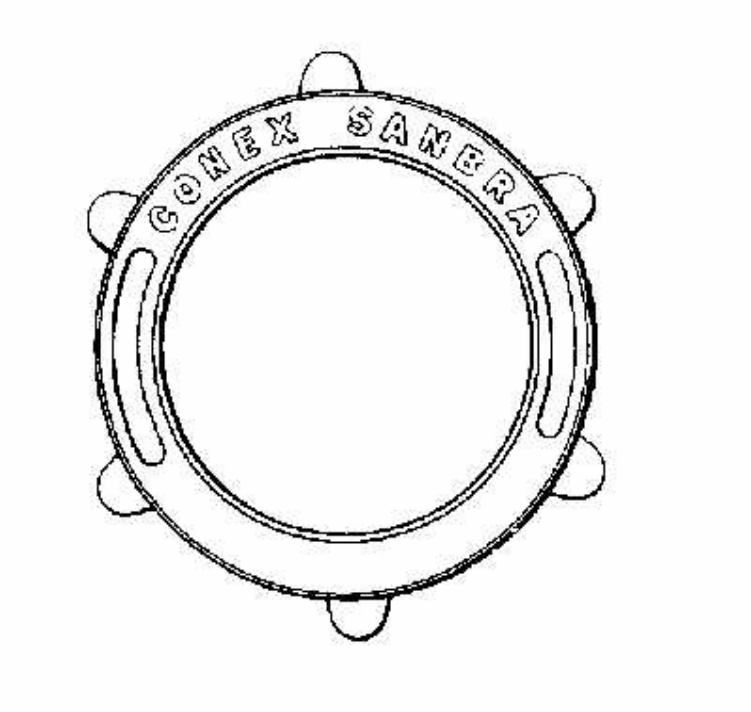
[note: 18]See Exhibit PE 11.

[note: 19]See PB 39.

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APPENDIX A

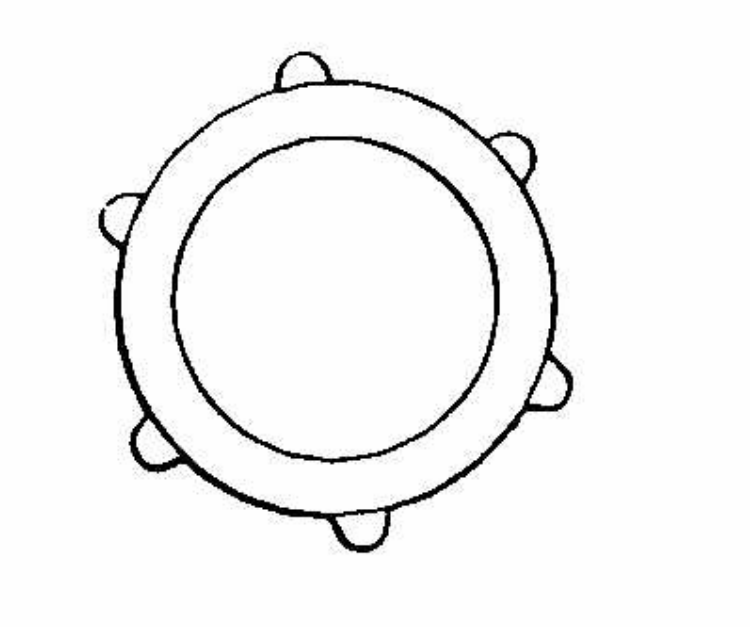
THE PLAINTIFF'S REGISTERED TRADE MARKS



T81/02113Z

("TM 113")

Version No 0: 15 Dec 2005 (00:00 hrs)



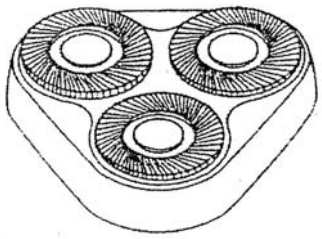
T81/02114H

(“TM 114”)

Version No 0: 15 Dec 2005 (00:00 hrs)

APPENDIX B

THE "452 MARK" IN *KONINKLIJKE PHILIPS NV v REMINGTON CONSUMER PRODUCTS LTD* [2005] FSR 17 ("*PHILIPS 2005*")



Version No 0: 15 Dec 2005 (00:00 hrs)

APPENDIX C

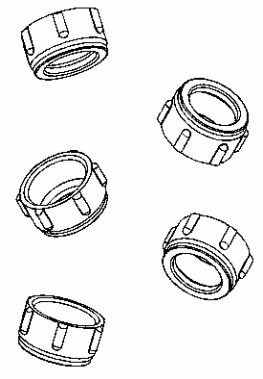
THE TWO-DIMENSTIONAL TRADE MARKS IN *KONINKLIJKE PHILIPS NV v REMINGTON CONSUMER PRODUCTS LTD* [2005] FSR 17 ("*PHILIPS 2005*")



Version No 0: 15 Dec 2005 (00:00 hrs)

APPENDIX D

THE PLAINTIFF'S CURRENT APPLICATION (APPLICATION NUMBER T04/19069J (FILED ON 4 NOVEMBER 2004))



Version No 0: 15 Dec 2005 (00:00 hrs)

APPENDIX E

THE PIPE FITTING OF NATION FITTINGS



Version No 0: 15 Dec 2005 (00:00 hrs)