The Singapore Professional Golfers' Association *v* Chen Eng Waye and others [2012] SGHC 113

Case Number : Suit No 290 of 2011

Decision Date : 24 May 2012

Tribunal/Court : High Court

Coram : Tan Lee Meng J

Counsel Name(s) : Tan Tee Jim SC / Jeremiah Chew (Lee & Lee) for the plaintiff; Wun Rizwi / Ow Shi Jack (RHT Law LLP) for the defendants.

Parties : The Singapore Professional Golfers' Association — Chen Eng Waye and others

Tort – Passing Off

[LawNet Editorial Note: The appeal to this decision in Civil Appeal No 72 of 2012 was allowed by the Court of Appeal on 20 February 2013. See [2013] SGCA 18.]

24 May 2012 Judgment reserved.

Tan Lee Meng J:

1 The Singapore Professional Golfers' Association, the plaintiff, also uses the shortened form of its name, "Singapore PGA", and its initials, "SPGA". It instituted the present proceedings against the 1st defendant, Mr Chen Eng Waye ("Mr Chen"), the 2nd defendant, Mr Chen Xiangyi, Roy ("Mr Roy Chen") and the 3rd defendant, Singapore Senior PGA LLP, with respect to the defendants' alleged unauthorised use of the name "Singapore Senior PGA LLP" and the initials, "SSPGA". The defendants asserted that the 3rd defendant was entitled to use the name "Singapore Senior PGA LLP" and initials "SSPGA".

Background

2 The plaintiff is a non-profit golfing association managed by an elected executive committee comprising qualified and experienced coaches and touring professionals. It was registered under the Societies Act (Cap 311, 1985 Rev Ed) in 1973 and its objectives include the promotion of the game of golf and fostering of good relations with local and regional golfing associations. According to the plaintiff's website, 150 professional golfers are currently registered with it. Of these, 110 golfers are locals and the remaining 40 are overseas associate members.

3 Mr Chen, a professional golfer, was a member of the plaintiff for around 1 year and 9 months. He was certified as a teaching professional by the United States Golf Teachers Federation in September 1999. He was suspended by the plaintiff for 12 months on 12 July 2007 because he participated in a golf tournament not sanctioned by the plaintiff at the Jurong Country Club from 24-25 May 2007. Five months later, he wrote to the plaintiff on 10 December 2007 to terminate his membership. On 31 January 2008, the plaintiff accepted his resignation.

4 Almost three years later, on 25 November 2010, Mr Chen and his son, Mr Roy Chen, registered "Singapore Senior PGA LLP" as a limited partnership. According to the defendants, Singapore Senior PGA LLP was formed with the following objectives:

(a) to provide certification testing for senior amateurs in Singapore to give them an opportunity to qualify as senior professional golfers;

(b) to provide opportunities for senior professional golfers to compete actively in golfing tournaments; and

(c) to organise golfing tournaments exclusively for senior professional golfers in Singapore.

5 It is pertinent to note that in professional golfing, a distinction is made between senior and non-senior golfers. Senior professional golfers are aged 50 years and above and senior professional golf tournaments are only open to senior professional golfers.

6 In January 2011, the 3rddefendant advertised on its website that it would be conducting a Senior Professional Qualifying Test ("Senior Pro-test") exclusively for senior golfers at Palm Villa Golf and Country Club on 22-23 March 2011. An entry form was furnished on the said website. According to the defendants, between 1 February 2011 and 5 March 2011, 9 persons registered for this Senior Pro-test.

7 Before the 3rd defendant announced its intention to hold its Senior Pro-test, the plaintiff had no separate qualifying test for senior professional golfers. However, after the 3rd defendant advertised its qualifying test for seniors, the plaintiff announced in February 2011 that it would be conducting a new test exclusively for golfers aged 50 and above between 9 March 2011 and 10 March 2011 to enable the successful applicants to qualify for a newly created separate category of membership for senior professionals.

8 On 1 March 2011, the plaintiff's solicitors, Lee & Lee, issued a "cease-and-desist" letter to the defendants, asking them to stop using "Singapore Senior PGA" as the name of the 3rd defendant and to change that name to one which was not identical or similar to the plaintiff's name. The plaintiff also required the defendants to publish an apology in the English and Chinese newspapers and to pay damages and costs to it.

9 On 21 March 2011, the defendants' then solicitors, KhattarWong, replied, saying that the plaintiff had no goodwill as it did not engage in senior professional golfing activities at the material time. The defendants' solicitors added that the plaintiff's name "was devoid of distinctive character" and had not become distinctive through use. Consequently, the allegation of misrepresentation was denied.

10 Although the defendants did not agree with the position adopted by the plaintiff, they cancelled the Senior Pro-test planned for March 2011.

11 In the meantime, the 3rd defendant successfully applied for the following trademarks in Singapore, which were registered on 4 April 2011 and are still subsisting:

Trade Mark	**Trade Mark No**
SINGAPORE SENIOR PGA	T1104241C



T1104240E

(As a series of marks)

12 The registration of the above-mentioned trademarks was not opposed by the plaintiff and there was no evidence of any steps taken by the plaintiff to invalidate the said marks.

13 On 25 April 2011, the plaintiff instituted the present action against the defendants for passing off. In its Statement of Claim, the plaintiff sought the following:

(1) An injunction to restrain the Defendants (whether acting by themselves, their officers, servants or agents or any of them or otherwise howsoever) from doing any of the following acts:

(a) passing off, attempting to pass off, causing, enabling, assisting and/or authorising others to pass off

(i) the 3rd Defendant and any entity as and for the Plaintiff; or

(ii) any event or activity as and for the Plaintiff's or as associated with or connected to the Plaintiff by using the name "Singapore Senior PGA" or any name or mark which is identical with or confusingly similar to the names and marks "The Singapore Professional Golfers' Association", "Singapore PGA" and/or "SPGA".

(b) Carrying out any event or activity or providing any goods or services under or by reference to the name "Singapore Senior PGA" or any name or mark which is identical with or confusingly similar to the names and marks "The Singapore Professional Golfers' Association", "Singapore PGA" and/or "SPGA".

(2) A mandatory injunction requiring and directing the Defendants (whether acting by themselves, their officers, servants or agents or any of them or otherwise howsoever) to take all necessary steps to immediately terminate the registration of the 3rd Defendant or change the registered name "Singapore Senior PGA LLP" to another name which is not identical with or similar to the names and marks "The Singapore Professional Golfers' Association", "Singapore PGA" and/or "SPGA".

(3) An order of delivery-up or destruction upon oath of all printed or written matter, packaging, labels or other materials or articles in the possession, custody or control of the Defendants, the use of which would be a breach of either of the foregoing injunctions;

(4) An inquiry as to damages or, at the Plaintiff's option, an account of profits and an order for payment of all sums found due upon making the inquiry or account.

The law on passing off

The law on passing off

14 In an action for passing off, the plaintiff must prove the existence of the so-called "classical trinity", namely goodwill, misrepresentation and damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491, 499 ("*Reckitt*"), Lord Oliver of Aylmerton explained:

> The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' ... Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff ... Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

15 It follows that in the present case, the plaintiff must establish that it has goodwill, that the defendants misrepresented that the 3rd defendant was or is connected with it and that it has suffered or is likely to suffer damage as a result of the misrepresentation.

Goodwill

16 The tort of passing off is intended to protect goodwill. In *Star Industrial Company Limited v Yap Kwee Kor* [1974-1976] SLR(R) 581, Lord Diplock explained (at [8]) that a "passing-off action is a remedy for the invasion of a right of property not in the mark, name or get-up improperly used, but in the business or goodwill likely to be injured by the misrepresentation made by passing off one person's goods as the goods of another".

17 As for what goodwill entails, in *The Commissioners of Inland Revenue v Muller & Co's Margarine Limited* [1901] 1 AC 217, Lord MacNaghten explained at 223-224:

> What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing that distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.

18 In *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216, ("*Amanresorts*"), the Court of Appeal noted that as goodwill is the bedrock of the tort of passing off, what the plaintiff's goodwill consists of must be properly defined so that the boundaries of the protection which may be claimed by the plaintiff can be determined. The court added (at [44]) that while goodwill can be limited to particular sections of the public "which can be small so long as they are not negligible", if goodwill exists only amongst such a small section, it would "mean that, while goodwill exists in this country, it exists only in relation to that small group and not to the entire public at large".

19 In the game of golf, there is a clear distinction between amateur golfers, *professional* golfers and *senior* professional golfers. An overwhelming number of golfers are amateurs. A very small group

of golfers turn professional in the sense that they make their living from golfing activities. The great majority of professional golfers teach amateur golfers, run golf clubs and sell golfing equipment. A much smaller and more well-known group of professional golfers live on prize money earned in professional golf tournaments. A "senior" professional golfer is one who has reached the age of 50. The plaintiff is a professional golf association with a very small group of around 150 members. The 3rd defendant was set up to cater for a more exclusive group of professional golfers aged 50 and above.

20 The plaintiff contended that its name, as well as the shortened form, "Singapore PGA", and initials "SPGA", had acquired goodwill in Singapore in relation to golf-related activities. It pointed out that it had been carrying out various golf-related activities pursuant to its objectives since 1973. It had organised many golf tournaments, seminars, courses and tests that have received media coverage. Its name and logo were often used and displayed in relation to these activities. The plaintiff also pointed out that its members had flown its flag by participating in several regional golf tournaments in recent years. Finally, the plaintiff asserted that it is recognised as the official association governing golf professions in Singapore and is the only body in Singapore recognised by the Asian Tour as the sanctioning body for professional golf in Singapore and that such recognition indicates the reputation and goodwill that it had generated over the years.

21 The defendants submitted that even if the plaintiff had some goodwill in golfing activities, it had no goodwill in relation to the activities of *senior* professional golfers at the relevant date, which it took to be January 2011, when the 3rd defendant advertised its Pro-test for March 2011. The plaintiff retorted that the relevant date should be 25 November 2010, the day the 3rd defendant was set up. Whichever date is chosen, the fact remains that the plaintiff had some goodwill in relation to golfing activities on both dates and it was not necessary to confine the plaintiff's goodwill to non-senior professional golfers' activities for two reasons. First, the defendants' assertion that the 3rd defendant was "catering for a section of the public not catered for by the plaintiff" was not correct. Admittedly, the plaintiff's sole witness and vice-president, Mr Dean Tan, agreed during cross-examination that before the 3rd defendant came onto the scene, the plaintiff did not have a separate category of membership for senior professional golfers, did not organise Pro-tests exclusively for senior professional golfers and did not recruit persons aged 50 and above as "senior" professionals. However, the plaintiff did arrange for its senior members to take part in senior professional golf tournaments. Secondly, in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 ("*CDL Hotels*"), LP Thean JA reiterated (at [63]) that it is well settled that the parties in a passing off action need not be in mutual competition and may be engaged in different trades. Thus, in *Annabel's (Berkeley Square) Limited v G Schock* [1972] RPC 838, a well-known London club, known as Annabel's Club, obtained an injunction against an escort agency trading under the same name.

22 I thus find that the plaintiff had a measure of goodwill in relation to professional golfing activities.

Misrepresentation

23 While the plaintiff may have some goodwill in golfing activities, it faced insurmountable problems in proving the second requirement in an action for passing-off, namely misrepresentation. It is for the plaintiff to prove "a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or service of the plaintiff" (*per* Lord Oliver in *Reckitt* at p 499). The approach in *Reckitt* was endorsed by the Court of Appeal in *CDL Hotels* (at [44]). In *Amanresorts*, the Court of Appeal pointed out (at [75]) that the alleged misrepresentation must be analysed from the perspective of the actual or potential customers "who have goodwill in the plaintiff's get-up".

24 When considering whether or not an alleged misrepresentation is deceptive, much depends on whether the name or mark sought to be protected is "fanciful" or descriptive. The law is more likely to protect a highly distinctive name or mark, such as "LEGO", a fanciful name for children's toys (see *Lego System Aktieselskab v Lego M Lemelstrich Ltd* [1983] 9 FSR 155), than a word mark comprising common English words like "colourful children's toys".

25 On the other hand, where descriptive words have been used as a name, *slight* differences between the names of the plaintiff and the defendant may suffice to defeat a claim of passing off. Otherwise, the party with the earlier descriptive name will have a monopoly of ordinary words and the courts are reluctant to allow such a monopoly. In *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39 ("*Office Cleaning Services*"), where the plaintiff, Office Cleaning Services, failed to prevent the use by a rival company of the name "Office Cleaning Association", Lord Simmons explained (at 43):

> So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some members of the public will be confused whatever the differentiating words may be…. It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. *The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where the trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.*
>
> [emphasis added]

26 In short, a trader who uses a descriptive name for his business must settle for a lower degree of legal protection for the name than if he had adopted a more distinctive name.

27 The position is different where a name or mark which is *prima facie* descriptive has subsequently acquired a secondary meaning in the sense that it has become exclusively associated with the plaintiff and is thus distinctive of the plaintiff's business. In *Lifestyle 1.99 Pte Ltd v S$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 ("*Lifestyle 1.99*"), the Court of Appeal explained (at [27]):

> A name or mark which is *prima facie* descriptive will only be protected if it can be shown to have acquired a secondary meaning, namely, it has become distinctive of the plaintiff's business. "Distinctive" is a term of art in the law of passing off and bears a meaning at variance with that in everyday use. In relation to a name or mark, it denotes the goods of the plaintiffs to the exclusion of other traders.

28 It follows that for the purpose of determining whether the plaintiff in the present case can complain of misrepresentation by the defendants, the first question to be considered relates to whether the plaintiff's name is descriptive. If the name is descriptive, two other questions arise, namely whether the descriptive term has subsequently become distinctive by acquiring a secondary meaning and if not, whether there are small differences between the names of the plaintiff and the third defendant.

Whether the plaintiff's name is descriptive

29 The words "professional", "golfer" and "association" in the plaintiff's name are ordinary words

found in an English dictionary. The addition of the geographical term "Singapore" to the words "Professional Golfers' Association" does not, without more, alter the descriptive nature of the plaintiff's name. If the plaintiff's name is descriptive, its shortened forms and initials, namely Singapore PGA and SPGA respectively, were also not distinctive when the plaintiff was set up in 1973. In the context of the sale of goods, Lord Herschell said in *Frank Reddaway and Frank Reddaway & Co Limited v George Banham and George Banham & Co, Limited* [1896] 1 AC 199 ("*Reddaway")* (at 212) that where "the name of a place precedes the name of an article sold, it *prima facie* means that this is its place of production or manufacture" and is descriptive. Admittedly, there are situations where the name of a town or country has become distinctive of a produce (see, for instance, *Huntley and Palmer v The Reading Biscuit Company Limited* (1893) 10 RPC 277) but in the present case, there was no assertion that "Singapore" has become distinctive for the plaintiff's activities.

30 Although its name is clearly descriptive, the plaintiff contended that it is not. In its closing submissions, it put its case as follows at para 76:

> In Singapore, the Plaintiff uses "Singapore PGA" and "SPGA". These names not only distinguish the Plaintiff from a similar association in another country *but are also distinctive of the Plaintiff.* In other words, although the initials "PGA" may be said to be descriptive, the use of the word "Singapore" and the letter 'S" as a prefix and in conjunction with "PGA", renders the said names "Singapore PGA" and "SPGA" *inherently distinctive* of the Plaintiff.
>
> [emphasis added]

31 The plaintiff's claim that its name has "inherent distinctiveness" is without any substance. When first used, a descriptive name is not inherently distinctive. Admittedly, there are some terms which may lie somewhere between a fanciful term and a purely descriptive term. In *CDL Hotels*, the Court of Appeal accepted (at [68]) that in the context of a development complex in Singapore comprising "Millenia Tower", "Millenia Walk" and a super deluxe "five-star" hotel, the Ritz Carlton, Millenia Singapore, the term "Millenia" lay somewhere in between a fancy term and a descriptive term and was "perhaps closer to being highly fanciful rather than obviously descriptive". However, the plaintiff's name "The Singapore Professional Golfers' Association" is not in the least bit fanciful.

32 The plaintiff sought to rely on the registration by the defendants of two trade marks, namely "Singapore SPGA" and the 3rd defendant's logo which prominently features the initials "SSPGA". It argued that the fact that the defendants managed to register their trade mark "Singapore Senior PGA" and the 3rd defendant's logo indicates that the registered name and logo are distinctive because s 7(1)(b) of the Trade Marks Act (Cap 332, Rev Ed 2005) ("TMA") provides that a ground for refusal to register a trade mark is that it is "devoid of any distinctive character". The plaintiff added that it follows that its name must also be distinctive as it is "highly similar to, if not identical" to the 3rd defendant's name. Apart from the fact that the plaintiff's name is not identical to the defendant's name, the court is not bound to hold that a plaintiff's name is distinctive merely because the defendant had registered a slightly different name as a trade mark. It cannot be overlooked that s 23(1) of the TMA provides that the registration of a trade mark may be declared invalid on the ground that it was registered in breach of s 7 of the said Act. Furthermore, s 23(4) of the TMA provides that the registration of a trade mark may be declared invalid on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

33 When cross-examined on whether "Singapore PGA" and "SPGA", the shortened forms of the plaintiff's name, describe what the plaintiff does, its vice-president, Mr Dean Tan conceded as follows:

Q So am I correct to say that the plaintiff is a registered society set up as an association for professional golfers.

A Yes.

Q [W]ould you agree that the names and/or marks "SPGA" and "Singapore PGA" describe what the plaintiff does?

A Yes.

34 Furthermore, Mr Dean Tan agreed that "PGA" is a common term that appears in the trademarks of many golf-related goods and services. When cross-examined, he testified as follows:

Q [W]ould you agree that these trademarks which have been registered by several different parties for both golf and non-golf related goods and/or services all incorporate the term "PGA"?

A Yes.

Q So would you therefore agree that the common element in all these trademark registrations is the term "PGA"?

A Yes.

....

Q In that case, would you not agree that … more than one party is capable of owning or having rights to a trademark which incorporates the term "PGA"?

A Yes.

35 I thus find that the plaintiff's name consists of ordinary words and is descriptive. In view of this, a question arises as to whether the plaintiff's name has acquired a secondary meaning. The burden of proving a secondary meaning lies with the plaintiff.

Whether the plaintiff's name has acquired a secondary meaning

36 Some largely descriptive words have been proven to have acquired a secondary meaning. These include "CAMEL HAIR" for machinery belting (see *Reddaway*) and "MOTHERCARE" for clothes for children and expectant models (see *Mothercare UK Ltd v Penguin Books Ltd* [1988] RPC 113). However, as a general rule, proving that a descriptive name has acquired a secondary meaning is an uphill task. In *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326 ("*Cellular Clothing*"), Lord Halsbury explained (at 336) in the context of the sale of goods as follows:

> [W]here you are dealing with a name which is properly descriptive of the article the *burden is very great* to shew that by reason of your using that name descriptive of the article you are selling, you are affecting to sell the goods of somebody else ....
>
> [emphasis added]

37 In *Lifestyle 1.99*, the Court of Appeal reiterated (at [34] and [37]) that proving a secondary

meaning for descriptive words is a "very great burden" and a "difficult" task. In this case, the respondent, S$1.99 Pte Ltd, was the owner of a chain of retail shops operating under the name "One.99 Shop", which was registered with the Registry of Businesses on 1 December 1995. The main characteristic of the shops was that all its goods were sold at $1.99 each. From April 1997 to February 1998, the sales amounted to slightly more than $3.5m. In the year ending February 1999, the annual sales had almost doubled to $6.9m. The appellant was incorporated on 8 September 1998 and at its "Lifestyle 1.99" outlets, most of the goods were sold at $1.99 as well. The Court of Appeal held that "One.99" was a descriptive term, bearing in mind that the respondent's business was the selling of goods at $1.99. Although evidence was tendered that the respondent's advertising expenses amounted to $23,000 in 1997 and $29,000 in 1998 and that this was rather significant as every item in its shops was sold at $1.99, the Court of Appeal did not accept that the descriptive term "One.99" had acquired a secondary meaning. As such, it held that the use by the appellant of the word "Lifestyle" in its name was sufficient to distinguish that name from the respondent's name and the question of passing off by the appellant did not arise.

38 In the present case, the plaintiff made no serious attempt to prove that its name has acquired a secondary meaning and become distinctive after it was first used. In its closing submissions, the plaintiff, who erroneously claimed that its name was inherently distinctive, added as follows:

> This *inherent distinctiveness* is fortified or strengthened by the fact that there has been extensive use of the names since 1973 in relation to the Plaintiff's golf-related activities.
>
> [emphasis added]

39 It requires more than a self-serving uncorroborated bald assertion by the plaintiff that its name has acquired a secondary meaning to prove distinctiveness as a descriptive name does not become distinctive solely because it has been in use for a long time. Mr Dean Tan claimed in his affidavit of evidence-in-chief ("AEIC") at para 16 that the plaintiff is recognised by "world-wide professional golfing bodies at the official association governing golf professionals (including senior professionals over 50 years)". The only document furnished by him in his AEIC to support his claim on recognition by "world-wide professional golfing bodies" was a letter dated 5 April 2001 from one Mr Kyi Hla Han ("Mr Kyi"), the executive chairman of the Asian Tour, which itself claimed to be the sanctioning body for professional golf in Asia. Although Mr Kyi stated that the Asian Tour recognised the plaintiff as the sanctioning body for professional golf in Singapore, this solitary letter does not prove that "world-wide" golfing bodies accord the plaintiff the status it claimed for itself and, in any case, Mr Kyi was not called as a witness to prove the contents of his said letter. Mr Dean Tan also produced a letter from the Singapore Golf Association dated 7 March 2011 welcoming the plaintiff as an affiliate body. Again, this polite letter does not prove the world-wide recognition that the plaintiff claims to have. After all, the Singapore Golf Association's many other affiliates include other Singapore golfing bodies, such as the Singapore Senior Golfers Society, the Society of Singapore Golfers and the Singapore Ladies Golf Association.

40 Admittedly, the plaintiff has been around since 1973 but it is worth noting that in *Office Cleaning Services*, Lord Simmons explained that while the court "will undoubtedly take into consideration long user of a descriptive name", it "will not forget that, since it is descriptive, small differences may suffice". The position is illustrated by the decision of the House of Lords in *Cellular Clothing*. In that case, the appellant claimed to have invented or put on the market for 10 years shirts and underwear for men that were woven in a particular manner and marketed under the name "cellular cloth". The respondent sold cotton and woollen goods which were recently described as "cellular". Their Lordships held that the word "cellular" was an ordinary English word which appropriately and conveniently described the cloth out of which the goods sold by the respondent

were manufactured. In their Lordships' view, the word "cellular" had not acquired a secondary or special meaning so as to denote only the goods of the appellant.

41 The plaintiff relied on *Reddaway*, where a descriptive term was held to have become distinctive. However, that case, which concerned the name given to the appellant's belts for driving machinery, namely "Camel Hair Belting", may be distinguished as there was ample proof that the descriptive words had acquired a secondary meaning. Apparently, in the machinery belting trade, manufacturers used different animal names to describe their belts to distinguish their own products from those of their competitors. From 1879, the appellant described their belts as "Camel Hair Belting" while its competitors described their belts as, *inter alia*, "buffalo belting", "yak belting" and "crocodile belting". The respondent, a former employee of the appellant, started to manufacture his own belts in 1889. Initially, he called his belts "Arabian belting" but after he formed a company in 1891, he described his company's belts as "Camel Hair Belting". Although the term "Camel Hair Belting" was a descriptive term, the appellant furnished evidence that owing to the excellence of its products, its belting became widely known all over the world as "Camel Hair Belting". There was evidenced that the appellant's belts were advertised as "Camel Hair Belting" and were ordered, sold and invoiced as such. The jury found that "Camel Hair Belting" meant belting made by the appellants, as distinguished from belting made by other manufacturers. In these circumstances, the House of Lords held that the respondent could not continue to use the term "Camel Hair Belting" for his belts. Lord MacNaghten explained the whole merit of the respondent's use of "camel hair belting" lay in its duplicity. At his factory, the belting may be construed as belting made of camel's hair but abroad it meant the appellant's brand of belting.

42 Unlike the appellant in *Reddaway*, who furnished adequate evidence that its "Camel Hair Belting" had acquired a secondary meaning, the plaintiff in the present case made a bald assertion that its name is distinctive without furnishing proper evidence of this. No witness was called to corroborate Mr Dean Tan's assertion regarding the alleged distinctiveness of the plaintiff's name. Newspaper reports did mention the plaintiff occasionally but the many reports on the success of professional golfers within its ranks that were furnished by the plaintiff primarily focused on the achievements of the golfers in question and had nothing to do with the distinctiveness of the plaintiff.

43 The plaintiff also relied on the decision of Tay Yong Kwang J ("Tay J") in *The Chinese Calligraphy Society of Singapore v Khoo Seng Kong* [2008] SGHC 121 ("*Chinese Calligraphy Society*") to buttress its claim of distinctiveness but the facts of that case are quite different from those in the present case. In that case, the plaintiff society was set up in 1969 to promote, maintain and improve Chinese calligraphy in Singapore. In 1993, the National Arts Council ("NAC") leased the building located at 48 Waterloo Street to the plaintiff under the NAC's Arts Housing Scheme. The plaintiff named the said building "Singapore Calligraphy Centre" but the name displayed on the exterior of the building was "Singapore Calligraphy Centre (1995)". The plaintiff used public donations and NAC grants to restore and reconstruct the building. Over the next decade, many of the Centre's activities were publicised in local and international Chinese and English language media. In April 2005, the defendant registered a business called "Singapore Calligraphy Centre" with the stated aim of "calligraphy promotion". Tay J, who accepted that the name of a building at which one's business is carried out could have goodwill, pointed out that the Singapore Calligraphy Centre had been identified in the local media as the "first home" of the plaintiff. He found that although the name of the plaintiff's building was descriptive, the said building had acquired goodwill and by using the *same* name, the defendant was guilty of passing off. He added that the fact that the defendant, who was a member of the plaintiff for over two decades, had parted with the plaintiff in less than amicable circumstances, raised doubt about his good faith in using the same name as the plaintiff's building. In these circumstances, he understandably granted an injunction to restrain the defendant from passing off his firm as the plaintiff, or his goods, services or activities as the plaintiff's or as associated with or

connected thereto. In short, while Tay J was satisfied in *Chinese Calligraphy Society* that the name of the plaintiff's building had become distinctive, I was not satisfied in the present case that the plaintiff had proved that their name had acquired a secondary meaning to make it distinctive.

44 The plaintiff also referred to a number of other cases in which injunctions against passing off were ordered without attempting to explain just how the decisions in question advanced their case. In *Reddaway*, Lord MacNaghten aptly pointed out (at 220) that cases of this sort must depend upon their particular circumstances and the facts of one case are little or no guide to the determination of other cases. To begin with, the plaintiff's reliance on *British Legion v British Legion Club (Street) Ld* (1931) 48 RPC 555 was totally unjustified as there was ample evidence in that case of the distinctiveness of the name of the plaintiff, the Royal British Legion (the "Legion"), a world famous charity, which was suing a non-charity for passing off. The Legion, which is the United Kingdom's leading charity for those who have served or are serving in the British Armed Forces and their dependents, was founded in 1921 and had at the material time more than 3,400 branches in England and Wales alone and many branches in other parts of the United Kingdom and in the colonies. Its patron is the British monarch and it is famed for its "poppy" day, during which appeals are made for donations to its cause. More pertinent to the passing off action, the Legion had a very extensive network of social clubs throughout the United Kingdom and Ireland and around the world. It had been successful in preventing other clubs from using the words "British Legion" in their titles. Despite this, the defendant set up a social club called "British Legion Club (Street)" in a place called "Street" in the County of Somerset. In these circumstances, Farwell J, who said that the British Legion "had become known to almost everyone in this island and in most parts of the world", granted an injunction against the defendant. His Lordship explained that while no one who goes to the defendant's club and sees the sign "British Legion Club (Street) Ltd" over the door would suppose that they were going to the headquarters of the Legion, they would assume that the defendant's club was connected in some way with the Legion. As a charity, the Legion must be above any suspicion of impropriety and if the defendant ran into difficulty, this would embarrass the charity. The background of the Legion, its thousands of branches and its extensive network of social clubs all across Britain must be borne in mind to understand why the defendant was barred from using the name "British Legion Club Street". In the present case, the plaintiff caters for a very small group of professional golfers and is in no position to compare itself with a well-known charity that has a nation-wide cluster of social clubs bearing its famous name.

45 Finally, the plaintiff referred to two cases involving professional bodies for accountants and doctors. The first, *Society of Accountants and Auditors v Goodway and London Association of Accountants Limited* [1907] 1 Ch 489 ("*Society of Accountants*"), can be distinguished on the ground that the court in that case was dealing not with descriptive words but with fanciful words, and different rules apply to fancy terms. In that case, the plaintiff society recommended its members to adopt as their professional designation the use after their names of the term "incorporated accountant". One of the issues in this case was whether the defendant accountant, who was not a member of the plaintiff, could be allowed to use the designation "incorporated accountant". Warrington J found that although "incorporated" and "accountant" were ordinary words, "incorporated" meant "united in a legal body" and to speak of an individual accountant as united in a legal body was ridiculous. Thus, he found that the term "incorporated accountant" was a fancy term. In any case, it is important to note that Warrington J found that by 1905, that section of the public who had dealings with accountants understood that the designation "incorporated accountant" had come to mean a member of the plaintiff. It was in this context that his Lordship held that the plaintiff was entitled to an injunction against the said unauthorised use by the defendant. An injunction was also granted to restrain the association to which the defendant belonged from advertising that its members were entitled to use the said designation. In contrast to the facts of *Society of Accountants*, the term "The Singapore Professional Golfers' Association" is not a fancy term and, as

has been mentioned, there is insufficient evidence that this term had acquired a secondary meaning.

46 In the second case, *British Medical Association v Marsh* (1931) 48 RPC 565, there was also ample evidence of distinctiveness. Maugham J described the plaintiff, whose initials are "BMA", as "an exceedingly well-known Association" with no less than 35,000 duly qualified doctors as members and as "a body that represents the opinion of the medical profession as a whole". The defendant set up two drug stores in London. He had the letters "BMA" within a triangle in a shop window under the words "Drug Stores". Furthermore, he displayed a card in the window stating "We guarantee that all reproductions of patent medicines are prepared strictly to the analyses of the *British Medical Association*". Although the defendant claimed that the term "BMA", as used by him, referred to the initials of persons connected with the company, Maugham J unsurprisingly held that the defendant was carrying on its drug store business in such a way as to represent to the public that his businesses were connected with the British Medical Association. Consequently, an injunction was granted against the defendant to ensure that members of the public were not deceived into thinking that his stores were in any way connected to the plaintiff.

47 The decision in *British Medical Association* may be distinguished on the facts. What was in issue in that case was the right of the plaintiff to stop the defendant from using identical initials, namely "BMA". In the present case, the names and initials of the plaintiff and 3rd defendant are not identical. Furthermore, there was ample evidence in *British Medical Association* of the distinctiveness of the term "BMA". Such evidence was sorely lacking in the present case.

48 I thus hold that the plaintiff did not establish that their name had acquired a secondary meaning to make it distinctive.

Whether there are differences between the two names

49 As the plaintiff's name is descriptive and there was no proof that it has acquired a secondary meaning, the relevant question to ask is whether or not there are slight or minor differences between the plaintiff's name and that of the 3rd defendant. The rule that minor differences would suffice to distinguish one name or mark from another in the case of descriptive names or marks was endorsed by the Court of Appeal in *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd* [2000] 2 SLR(R) 214 ("*Super Coffeemix*").

50 The plaintiff's Mr Dean Tan totally undermined the foundation of the plaintiff's case on passing off when he conceded during cross-examination that there were minor differences between the names of the plaintiff and the 3rd defendant. The relevant part of the proceedings is as follows:

> Q So, when you compare "SPGA" and "Singapore Senior PGA", is there a major difference or a minor difference?
>
> A To me, it's a *minor difference*.
>
> Q …. Okay, between "Singapore PGA" and Singapore Senior PGA"? …. Is there a major difference or a minor difference?
>
> A *Minor difference*.
>
> Q Between the term "Singapore Professional Golfers Association" and "Singapore Senior PGA", is there a major or minor difference?

A *Minor difference*.

[emphasis added]

51 In its closing submissions, the plaintiff accepted that there are minor differences between its name and that of the 3rd defendant. That there are differences between the two names is obvious as the words "Senior" and "LLP" in the 3rd defendant's name are not found in the plaintiff's name. Apart from these differences, the defendants had taken additional measures to distinguish the 3rd defendant's business from that of the plaintiff. They submitted the following chart to illustrate that the 3rd defendant had adopted a different business entity, a different logo and a different domain name:

	Plaintiff	**3rd Defendant**
Type of organisation	Registered Society	Limited Liability Partnership
Logo		
Website address	www.sinpga.org	www.singaporeseniorpga.com

52 It is noteworthy that the names of many of the golfing bodies in Singapore do not have more differences than those between the plaintiff and the 3rd defendant. While the plaintiff complained that the words "Senior" and "LLP" in the 3rd defendant's name were insufficient to distinguish its name from that of the latter, there was already in existence a "Singapore Golf Association" or "SGA" when the plaintiff adopted the name "The Singapore Professional Golf Association" in 1973. The Singapore Golf Association, which advertises itself as the "national body for the sport of golf", accepted the plaintiff as an affiliate member. Another affiliate member of the SGA is "Singapore Ladies Golf Association" or "SLGA". Finally, there are the Singapore Senior Golfers Society, and the Society of Singapore Golfers, both of which are affiliate members of the Singapore Golf Association.

53 The question of misrepresentation arises when a representation is confusing to the relevant persons. The fact that the parties are engaged in the same trade or provision of services is a relevant factor in determining whether or not there is confusion. However, apart from the bald assertion by its sole witness, Mr Tan, the plaintiff furnished no evidence of any confusion arising from the 3rd defendant's name. In contrast, when cross-examined, the defendants' witness, Mr Kwong Kok Hong, an assistant golf coach at the Golfer's Place Golf Academy, testified when cross-examined that he would not assume that the plaintiff and the 3rd defendant were the same body. He said as follows:

Q … Assuming SSPGA, the 3rd defendant conducts a test and you sit for the test and you pass the test, would you call --- wouldn't you not call yourself also "I'm also certified by SSPGA?

….

A Yes.

Q *So isn't it possible that in that situation, people may think that your certification by SSPGA is a certification by SPGA* …. Isn't it possible in that situation?

A *No. To my understanding, no*.

[emphasis added]

54 Admittedly, in *Parker-Knoll Limited v Knoll International Limited* [1962] RPC 265, Lord Devlin said (at 291-292) that the judge's decision does not depend solely or even primarily on instances of actual deception even though such evidence may be useful and the court "must in the trust to its own perception into the mind of the reasonable man". In *Amanresorts*, the Court of Appeal endorsed Lord Devlin's approach and reiterated (at [80]) that "the court is entitled to consider whether the average reasonable person, with characteristics reflective of the relevant section of the public as identified under the examination of goodwill, is likely to be confused by the defendant's misrepresentation".

55 The relevant question here is whether those in Singapore with goodwill towards the plaintiff would believe that Singapore Senior PGA LLP is somehow connected with the plaintiff. When considering whether there might be confusion, relevant factors include the type of market for the plaintiff's services, the manner in which the plaintiff's services are marketed and the characteristics of those with goodwill towards the plaintiff. In truth, persons with goodwill towards the plaintiff are in a very different position from persons with an imperfect recollection of the brand or packaging of coffee or chocolate found on supermarket shelves. It has often been said that the place of business of a professional golfer is the golf course and practice range. As such, a professional golfer or an amateur golfer who is seriously considering whether or not to turn professional is likely to be knowledgeable about the game, other professional players, the golf circuit and the professional bodies that they are going to join. Apart from professional golfers and amateurs who want to become senior professional golfers and others with goodwill towards the plaintiff would, even if "imperfect recollection" is taken into account, be able to realise that the plaintiff is different from the 3rd defendant. I do not believe that such a person will be confused when there are sufficient differences between the names and logos of the two bodies. The comment in *Super Coffeemix* by the Court of Appeal (at [63]) that "in the context of a population which is becoming more literate, there would not be any real difficulties to differentiate" in the circumstances of that case is applicable to a case such as this.

Allegation of bad faith

56 In their closing submissions, the plaintiff referred at para 116 to the defendants' lack of good faith in choosing and using the 3rd defendant's name. While intention to pass off is not a prerequisite to the defendants' liability, bad faith will make it easier for the plaintiff to prove its case on passing off.

57 The plaintiff relied on *Chinese Calligraphy*, where Tay J mentioned that the circumstances under which the defendant in that case left the plaintiff society raised doubt about the defendant's good faith in using the same name as the plaintiff's well-known building. The plaintiff pointed out that Mr Chen was its member for 1 year and 9 months and that he had resigned from the plaintiff under less than amiable circumstances, after having been suspended for participating in a golf tournament not sanctioned by it. However, each case must be decided on its own facts. In *Chinese Calligraphy*, Tay J also found that the defendant lacked credibility for while he claimed that the use by him of the name "Chinese Calligraphy Centre" was not confusing, he had objected to the registration by the plaintiff society's president of the name "Chinese Calligraphy Centre (1995)". In fact, several months after the said registration, he wrote to the regulatory authority to protest that the name "Chinese Calligraphy

Centre (1995)" would inevitably cause confusion to the public and affect the operations of his own business. This showed that the defendant's assertions in court about the absence of confusion between his name and that of the plaintiff's building were completely lacking in candour. All these facts led the judge to question the defendant's lack of good faith.

58 It does not follow that there is bad faith on the part of every defendant who sets up a competing body having resigned from the plaintiff. In his AEIC, Mr Dean Tan alleged at para 22 that the defendants' actions were also intended to spite the plaintiff for Mr Chen's suspension. Apart from the fact that the suspension in question occurred nearly 3 years ago, Mr Chen explained that in choosing the name of the 3rd defendant, he sought to emulate the practice in Thailand and Hong Kong, where senior professional golfers' bodies are called the "Thailand Senior Professional Golfers Association" and the "Hong Kong Senior Professional Golfers' Association Limited" respectively. It is worth noting that in Hong Kong, the Hong Kong Senior Professional Golfers' Association Limited co-exists with The Hong Kong Professional Golfers' Association while in Thailand, the Thailand Senior Professional Golfers Association co-exists with the "Professional Golf Association of Thailand". Mr Chen added that the deliberate use of "Senior" was intended to identify the target market of the 3rd defendant, which is golfers aged 50 years and above. Bad faith is a very serious allegation and the plaintiff failed to adduce any evidence of Mr Chen's malice. After taking all circumstances into account, I find that the plaintiff's allegation of bad faith was not proven.

Conclusion on misrepresentation

59 For the reasons stated, I find that the plaintiff did not prove that there was any misrepresentation on the part of the defendants.

Damage

60 As I have found that there was no misrepresentation by the defendants, the third requirement in a passing off action, namely damage suffered by the plaintiff, need not be considered.

Conclusion

61 The plaintiff's action against the defendants is dismissed with costs.

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