

Hunter Manufacturing Pte Ltd and Another v Soundtex Switchgear & Engineering Pte Ltd (No
2)
[2000] SGCA 3

Case Number : CA 80/1999
Decision Date : 12 January 2000
Tribunal/Court : Court of Appeal
Coram : Chao Hick Tin JA; L P Thean JA; Yong Pung How CJ
Counsel Name(s) : Jimmy Yim SC and Kelvin Tan (instructed) with Patrick Yap (KL Tan & Assocs) for the appellants in CA 80/99 and the respondents in CA 82/99; Tan Tee Jim SC and Corrine Tan (Allen & Gledhill) for the appellants in CA 82/99 and the respondents in CA 80/99
Parties : Hunter Manufacturing Pte Ltd; Another — Soundtex Switchgear & Engineering Pte Ltd

Civil Procedure – Costs – Principles – Costs of abandoned claim – Costs of dismissed claim – Costs of successful appeal

Designs – Remedies – Infringement of registered design – Order for delivery up – Whether injunction sufficient

(delivering the judgment of the court): In our judgment handed down on 23 December 1999 we allowed the claim of Hunter against Soundtex and granted an injunction in terms of prayer (a)(i) of the statement of claim. We invited counsel to address us on any other reliefs to which Hunter are entitled and on the question of costs here and below. We have since received and considered the submissions of counsel.

The court below held that the defence of innocent infringement was available to Soundtex, and that even if there was infringement of the registered design no damages would be awarded in respect of any infringement up to 12 June 1997 (ie the day on which Soundtex were notified by the solicitors for Hunter that Hunter are the proprietors of the design). We agree entirely. In any event, there was no appeal against this determination. Accordingly, there will be an inquiry as to damages only for infringement of the registered design committed by Soundtex after this date. We so order.

Counsel for Hunter also seeks an order for delivery up on oath and for destruction of all products, goods, documents and other articles and materials, the continued retention, use of or dealing with by Soundtex would offend the injunction. In reply, counsel for Soundtex submits that this relief is not necessary, as the injunction granted is sufficient. We agree. The court has a discretion whether or not to grant such relief and, should it decide to grant it, to limit the extent of such a relief. Such relief is granted not to punish the infringer but to give the necessary protection to the plaintiffs: per Russell J in **Mengenthaler Linotype Co v Intertype Co Ltd** [1926] 43 RPC 381, 382. There is an injunction against Soundtex which they must obey and observe. In so far as they still hold or have any Soundtex boxes in their possession, custody or control, by reason of the injunction they cannot deal with them in any way. It should be borne in mind that the infringement here relates only to the design of the boxes, and in our view, to order the delivery up and the destruction of all these boxes would be giving to Hunter a remedy far beyond what is necessary for their protection. In complying with the injunction, Soundtex should be allowed, if they so wish, to make changes to the boxes in such a way as not to infringe the registered design of Hunter. Alternatively, Soundtex may break up the boxes and use the materials or parts thereof for other purposes.

Costs

We now come to the question of costs. First, the costs below. We set aside the order as to costs made at the conclusion of the trial. The plaintiffs abandoned their claim of passing off four months before the commencement of the trial, and they should bear the costs occasioned by this claim. We so order. Next, ABB's claim was dismissed, and the question is whether in this case there should be an order against them for payment of any costs as a result of such dismissal. We think not. The dismissal of ABB's claim was consequent on the finding that Hunter are the proprietors of the design. There was no separate issue raised as a result of ABB being joined as the co-plaintiff of Hunter, and their joinder did not result in any additional costs to Soundtex in pursuing their defence or counterclaim against Hunter. In the circumstances, we make no order as to costs against ABB. Subject to the order as to costs occasioned by the abandonment of the claim of passing off, we order Soundtex to pay Hunter the costs of the claim and counterclaim.

Next, we turn to the costs of the appeals. Although Hunter and ABB are the appellants in CA 80/99 and the respondents in CA 82/99, the real contest was between Hunter and Soundtex, and none of the orders we have made concerned ABB. We do not think it is appropriate to make an order as to costs in favour of ABB. We order Soundtex to pay Hunter the costs of the appeals. The deposit in court as security for costs in CA 80/99 is to be refunded to the appellants or their solicitors, and the deposit as security for costs in CA 82/99 be paid to Hunter or their solicitors to account of costs.

Outcome:

Order accordingly.

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