

Fragrance Foodstuff Pte Ltd v Bee Cheng Hiang Hup Chong Foodstuff Pte Ltd  
[2002] SGHC 142

**Case Number** : Suit 141/2002

**Decision Date** : 09 July 2002

**Tribunal/Court** : High Court

**Coram** : Lai Siu Chiu J

**Counsel Name(s)** : Tan Tee Jim SC and Elaine Tan ( Allen & Gledhill ) for the plaintiffs; Wong Siew Hong ( Infinitus Law Corp ) for the defendants

**Parties** : Fragrance Foodstuff Pte Ltd — Bee Cheng Hiang Hup Chong Foodstuff Pte Ltd

*Copyright – Infringement – Defence of fair dealing in the public interest – Whether public interest element exists – Whether defence applicable in respect of artistic works – Whether incidents of confusion can be considered current events – s 37 Copyright Act (Cap 63, 1999 Ed)*

*Copyright – Infringement – Defendants reproducing plaintiffs' logo in advertisements without consent – Whether infringement established – ss 7(1)(a), 31(1), 26(1)(b)(i), 27(1), 27 (4) & 37 Copyright Act (Cap 63, 1999 Ed)*

*Trade Marks and Trade Names – Infringement – Defence of use of trade mark for purpose of identifying goods or services as those of proprietor or licensee – Whether defence established – s 27(6) Trade Marks Act (Cap 332, 1999 Ed)*

*Trade Marks and Trade Names – Infringement – Use of trade mark – Whether usage of trade mark must be in accordance with class of registration – Whether requirements of s 27 of Trade Marks Act (Cap 332, 1999 Ed) satisfied – s 27 Trade Marks Act (Cap 332, 1999 Ed)*

judgment by the plaintiffs to restrain the defendants from infringing their copyright and trademark in a logo (the Work) which they had commissioned. It was not in dispute that the defendants had reproduced the plaintiffs' Work in certain advertisements and notices without the plaintiffs' consent. The plaintiffs had earlier registered the Work as a class 30 trademark for biscuits, cakes, pastry and confectionery. The defendants raised a preliminary issue that s 27 of the Trade Marks Act (Cap 332) was not satisfied because there was no "use" of the trademark since the defendants' advertisements did not refer to any goods within class 30. Two of the defences raised were that (a) Copyright Act (Cap 63) should not be used as a mechanism to suppress information which the public has a right as well as an interest to know; (b) the defendants had used the Work for the purpose of identifying goods or services as those of the proprietor or licensee in accordance with s 27(6) of the Trade Marks Act.

**Held**

:

(1) The preliminary argument was rejected. There was no requirement or limitation that usage must be in accordance with the trademark's registration under class 30 thereof (see 17)

(2) All the ingredients to found liability on the part of the defendants for copyright infringement had been satisfied (see 26 to 32).

(3) The defence of fair dealing was not established. The matter was only of interest to the plaintiffs and the defendants, not the general public. Further, it would be straining the language of s 37(a) of the Copyright Act to say that the incidents of confusion alleged by the defendants could qualify as current events. As the Work is not a literary but an artistic work, the defence of fair dealing was not available to the defendants (see 34 to 36).

(4) Having considered the conduct of the defendants, the court held that they had not established the second defence either (see 37).

(5) As no defence or any triable issue was raised against the plaintiff's claim, the court granted the application to restrain the defendants from repeating the mischief committed by their advertisements/notices (see 38).

#### Cases referred to

*Anacon Corporation Limited v Environmental Research Technology Limited*

[1994] FLR 659 (refd)

*Beloff v Pressdram Ltd* [1973] 1 All ER 241 (refd)

*Hubbard & anor v Vosper & anor* [1972] 2 QB 84 (refd)

*Lion Laboratories Ltd v Evans & ors* [1985] 1 QB 526 (refd)

#### Legislation referred to

Copyright Act (Cap 63), ss 7, 26, 31 & 37

Trade Marks Act (Cap 332), s 27

[Editorial note: The defendants' appeal in CA 43 of 2002 is pending]

### Judgment

#### **GROUND OF DECISION**

##### *The facts*

1. Fragrance Foodstuffs Pte Ltd (the plaintiffs) were incorporated on 12 April 1990 Singapore and since that date have been (and even prior thereto under its predecessors in title) in the business of manufacturing and selling food items such as titbits, fried cuttlefish, mooncakes and, barbecued pork/meat more commonly known by its Hokkien description "bakwa".

2. Bee Cheng Hiang Hup Chong Foodstuff Pte Ltd (the defendants) are in a similar business of manufacturing and selling barbecued meats as well as related products such as pork floss and fish floss. However, they/their predecessors have been in the business considerably longer than the defendants, namely from about the 1930s and, unlike the plaintiffs, the defendants do not sell crocodile "bakwa". The defendants have more outlets (about 22) than the plaintiffs (16-17) and target a slightly different market from the latter. According to the plaintiffs, the defendants have a more upmarket customer base, as their outlets are located in shopping centres whereas the plaintiffs' outlets are situated in public housing (HDB) estates.

3. Sometime in October 1994, the plaintiffs commissioned (and paid) a Singapore citizen and designer, one Chionh Cher Tin (Chionh) to create a logo for their business, on the understanding that the copyright for the same would belong to the plaintiffs. Chionh created a logo (the Work) which comprised of the English word "Fragrance" with its Mandarin equivalent " " (pronounced "Xiang") and a stylised representation of the tongue coming out of the mouth and licking lips, as reproduced below:

According to the plaintiffs, the tongue licking the lips was meant to emphasise the quality and tastiness of the plaintiffs' products. The Work was first published in Singapore in or about January 1995. The plaintiffs gradually used the Work on all their products, signage, packing, advertisements and other promotional materials. In July 1995, they applied to and did register, a mark comprising the

Work in class 30 for biscuits, cakes, pastry and confectionery under T95/06325E which registration is still valid and subsisting. At the same time they also applied to register the Work as a mark in class 29 (for dried minced pork, pork floss, chicken floss, snack foods, preserved, jellies, dried and cooked fruits and vegetables).

4. The plaintiffs' application under class 29 is still pending due to the defendants' opposition on the ground inter alia, that the Work is identical to or nearly resembles the defendants' logo which (since 1985) is a single calligraphic Mandarin character "Xiang" meaning 'fragrant'; the parties are waiting for a hearing date for the opposition proceedings.

5. Ten (10) days before this year's Lunar New Year festival, namely on 2 and 3 February 2002, the defendants caused to be published in the local English and Chinese newspapers the following half-page advertisement:

At the same time, the defendants also distributed to the public pamphlets/notices similar to their advertisements; these were handed out at the defendants' outlets, to passers-by near the plaintiffs' outlets and were even placed under the windshield wipers of parked vehicles.

6. Apparently, the defendants were prompted to place the advertisements as a result of two incidents (according to their affidavits). The first occurred in 1988 when Bloomdale (S) Pte Ltd, a gift/hamper company, in its Lunar New Year catalogue, mistakenly advertised as part of its hamper offerings, pork/fish floss of the plaintiffs as the defendants' products. The company was required by the defendants to tender in a press advertisement an apology for its unfortunate error and to correct its catalogue.

7. The second incident of mistaken identity between the parties occurred in the February 2002 issue of the monthly periodical **Singapore Women's Weekly** where (at p 43) headed WATCH there appeared the following comments against a picture of packaged products:

#### **FRAGRANCE YOU'LL LOVE**

Think bak kwa and pork floss, and Fragrance Foodstuff comes to mind. Its bak kwa stays fresh for two weeks without refrigeration, and there's a whole range of floss, lup cheong and even crocodile bak kwa that promises to be a tasty snack. Get your fill of sweet meats this festive season at one of their 16 outlets. For inquiries, call 2984020.

There was no confusion in the advertisement itself but, the telephone number stated was the defendants', not the plaintiffs'. This advertisement prompted the defendants' solicitors to write to the magazine's publishers who apologised for their mistake; the publishers claimed it resulted from the fact that the magazine had sent an 'intern' to the press conference organised by the plaintiffs, who subsequently did the above write-up. The publishers explained that after the press conference, the intern had checked the telephone number of the plaintiffs using the Chinese character "Xiang", not realising that the defendants used the same logo. The intern assumed (wrongly) that the defendants' telephone number was that of the plaintiffs.

8. It did not help matters that on 3 February 2002, a report in the Chinese daily Lianhe Zaobao quoted the defendants' general manager Daniel Wong (Wong) as saying that the defendants may continue to publish notices similar to that set out in para 5 above, in order to dispel the public's confusion that the plaintiffs and the defendants are one and the same company/management.

9. By an agreement dated 5 February 2002, Chionh formally assigned to the plaintiffs all his rights and interest in the Work, including the right to commence action for any infringement of the

copyright in the Work. On the following day, the plaintiffs' solicitors wrote to the defendants pointing out that the newspaper notices using the Work had been placed without the plaintiffs' consent and hence constituted an infringement of the plaintiffs' copyright in the Work. The solicitors demanded: (i) a written undertaking from the defendants that they would not reproduce the Work or deal with it in any form or manner, (ii) costs and (iii) compliance with certain other conditions, by 1pm of 7 February 2002.

10. The defendants' solicitors replied to the above demands on 7 February requesting more time (until 8 February 2002) in which to render a substantive response. However, this was past the plaintiffs' solicitors' deadline. Consequently, the plaintiffs issued this writ on 8 February 2002, alleging that the defendants had infringed their copyright in the Work as well as, the trademark.

### *The applications*

11. At the same time that they commenced this action, the plaintiffs applied by way of summons in chambers no. 417 of 2002 for an ex-parte injunction (the injunction application) to inter alia, restrain the defendants (whether acting by their directors, officers, servants or agents or any of them) until after the trial or until further order, from infringing the plaintiffs' copyright in the Work and the trademark. Hearing of the injunction application on 8 February 2002 was postponed to be dealt with inter-partes at a later date, on the defendants' voluntary undertaking not to further infringe the copyright in the Work.

12. Shortly after the defendants' solicitors had filed a memorandum of appearance and the plaintiffs had filed their statement of claim, the plaintiffs applied by way of summons in chambers no. 626 of 2002 (the O 14 application) for summary judgment on the following prayers:-

(i) the defendants, whether acting by their directors, officers, servants or agents or any of them or otherwise howsoever, be restrained and an injunction be hereby granted restraining them from infringing the plaintiffs' copyright in the Work,

in particular from reproducing the Work (or any substantial part thereof) by way of trade, exhibiting and issuing to the public copies of the Work and authorising the reproduction, exhibition or issuing to the public copies of the Work without the licence of the plaintiffs;

(ii) there be an inquiry as to damages or at the plaintiffs' option, an account of profits for infringing the plaintiffs' copyright in the Work and an order for the payment of all sums found due and owing upon taking such inquiry or account together with interest thereon at such rate as the court deems just;

(iii) costs.

13. Both applications eventually came up for hearing before me on 10 April 2002. I granted the plaintiffs an order in terms of prayer 1 of the O 14 application for infringing copyright in the Work (but not for the trademark) and awarded costs (agreed between the parties) of \$10,000. Prayer 1 was subject to the condition that until trial or further order, the plaintiffs would not take any further steps or execution proceedings. However, on the injunction application, I made no orders on condition the defendants undertook not to repeat their advertisements in any shape or form using the plaintiffs' trademark, until trial or further order. I further gave leave to the defendants to file their defence by certain deadlines with liberty to the plaintiffs to file their Reply and Defence to the defendants' Counterclaim (if there be one). Finally, I ordered early trial dates. The defendants have now appealed (in Civil Appeal No. 43 of 2002) against the orders I made in the O 14 application.

### *Preliminary issues*

14. Before I refer to the affidavits filed by the parties to support their respective stands, I need to first address a preliminary issue which was raised by counsel for the defendants.

15. Counsel pointed out that the two (2) applications were inconsistent, the plaintiffs must elect which one they wished to proceed with. The O 14 application required the plaintiffs to affirm on affidavit that the defendants have no defence to their claim. At the same time the plaintiffs were applying to court for an injunction which was premised on there being a serious issue to be tried. Counsel for the plaintiffs countered that he was not approbating or reprobating. He submitted on the O 14 application that the defendants had no defence on the issue of copyright infringement. On the other hand, the injunction application related to infringement of trademarks and copyright. Questioned by the court, counsel confirmed that the plaintiffs elected to proceed with the injunction application for trademark infringement only, while the O 14 application would be for copyright infringement.

16. Counsel for the defendants attempted (as a second preliminary argument) to persuade the court that the requirements under s 27 of the Trade Marks Act Cap 332 had not been satisfied by the plaintiffs. Consequently, there was no infringement by the defendants. Section 27 reads as follows:

(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.

(3) A person infringes a registered trade mark which is well known in Singapore if —

(a) without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with or similar to the trade mark, in relation to goods or services which are not similar to those for which the trade mark is registered;

(b) the use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor;

(c) there exists a likelihood of confusion on the part of the public because of such use; and

(d) the interests of the proprietor are likely to be damaged by such use.

(4) For the purposes of this section, sections 28 and 29, a person uses a sign if, in particular, he —

(a) applies it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;

(c) imports or exports goods under the sign;

(d) uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or

(e) uses the sign in advertising.

(5) Notwithstanding subsection (4), a person who —

(a) applies a sign to any material used or intended to be used for labelling or packaging goods; or

(b) uses it on any document described in subsection (4)(d) or in advertising,

is deemed not to use the sign if, at the time of such application or use, he does not know nor has reason to believe that the proprietor or a licensee of the registered trade mark did not consent to such application or use of the sign.

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

17. The defendants' argument was that there had been no 'use' of the trademark as such (under classification 30) since, the defendants' advertisement did not refer to any goods let alone cakes, biscuits, pastry or confectionery. I did not accept this argument. It seems to me that the defendants' advertisement and pamphlets clearly made use of the Work within the ambit of s 27(4)(e) of the Trade Marks Act; there was no requirement or limitation, that usage must be in accordance with the trademark's registration under class 30 thereof.

*The affidavits*

18. I shall now touch on the affidavits filed by the parties. As the affidavits were filed for both applications, I shall only refer to those portions which are relevant to the O 14 application. The plaintiffs' managing-director (since April 1990) Tan Tiong Hwa (Tan) who is also a shareholder, was the deponent for the plaintiffs' affidavits whilst Wong filed affidavits on the defendants' behalf.

19. The contents of Tan's first affidavit have more or less been set out in the above narrative. Tan explained the reasons for prayer 1 of the O 14 application. Quite apart from the issue of copyright infringement (which was clearly in favour of the plaintiffs as they had not consented to the defendants' use of the Work), he deposed that damages would be an inadequate remedy as, the purpose of the defendants' advertisement was not only to promote their products but to do so by making unfair use of the Work — the defendants were extolling the qualities of their products by suggesting that the defendants' goods have been confused with those of the plaintiffs. This was supported by the defendants'/Wong's self-serving comments to Lianhe Zaobao citing instances of confusion. The effect was that the public would think that the plaintiffs were responsible for the confusion and, that the plaintiffs' products were either inferior to the defendants' or not on par. Such perception was highly damaging to the plaintiffs and the harm done was not compensatable in monetary terms.

20. Tan added that the defendants' notice/advertisement was designed to achieve the maximum impact and inflict the maximum damage on the plaintiffs coming as it did, just ten (10) days before the Chinese New Year on 12 February 2002; during the period, the demand for "bakwa" and other seasonal products was very high. Hence, the defendants' advertisement (with the hidden agenda set out above) was not only aimed at luring away the plaintiffs' customers but was used by the defendants as an opportunity to sully the plaintiffs' goodwill and reputation.

21. In response, Wong's first affidavit (filed on 22 February 2002) sought to justify the defendants' advertisements and usage of the Work by referring to the two incidents set out in paras 6 and 7 above. To reinforce his allegation of confusion on the part of the public (over the use of the Chinese character "Xiang" by the plaintiffs since the introduction of the Work as their brand in 1995), Wong exhibited (in **DW-5**) statutory declarations which the defendants filed in the opposition proceedings to the plaintiffs' registration of the Work as a mark under class 29. All sixteen (16) statutory declarations were sworn by supervisors or other employees of the defendants' outlets; they alleged that customers had come to their outlets stating they thought the plaintiffs' and the defendants' brands were under the same company or management. There had even been instances where customers produced the plaintiffs' discount card thinking it could be used at the defendants' outlets. I should add that in the statement he gave to the press on 3 February 2002, Wong had also cited two (2) other instances of confusion -- customers brought the plaintiffs' products to the defendants' outlets for exchange and, customers also made inquiries of crocodile barbecued meat at the defendants' outlets.

22. Tan refuted Wong's allegation of confusion over the parties' respective marks. He too exhibited (to his second affidavit filed 1 March 2002) statutory declarations (10) sworn by proprietors of shops (not the plaintiffs' outlets) selling barbecued meats, which the plaintiffs had filed in the opposition proceedings. The deponents swore there had been no confusion over the parties' marks on the part of their customers. On the contrary Tan stated, the only confusion that arose related to the defendants' name. He pointed out that in the market, there is more than one company with the defendants' name. Besides the defendants, Tan was aware of four (4) other companies bearing the defendants' name, all in the business of manufacturing/selling "bakwa". He named them (supported by searches from the Registry of Companies and other documents) as follows:

(a) a sole proprietorship called Bee Chun Heng;

- (b) a partnership called Bee Chun Heng
- (c) Bee Chun Heng Keng Kee;
- (d) Bee Chung Heng Lau Po.

Tan deposed that the above firms are all offshoots from the same family which started the original business in the 1930s. He added that the three (3) rival factions continue to deal in the same business and compete with one another strenuously.

23. Tan (in his second affidavit) also questioned the veracity of the explanation given by the publishers of **Singapore Women's Weekly**, for printing the defendants' telephone number instead of the plaintiffs' in their article. He recalled that the plaintiffs had invited the magazine to a press conference (on 15 November 2001) in conjunction with the opening of their new outlet at Bugis Junction. Attendees were given a press kit comprising inter alia, of materials (which clearly showed the plaintiffs' addresses and telephone numbers) as well as samples of the plaintiffs' products, again with the plaintiffs' addresses/telephone contacts on most of the packaging. Miss Beverly Gomez (presumably the 'intern' referred to) attended on the magazine's behalf. If indeed she had wanted to check the plaintiffs' telephone numbers, she need only have contacted the plaintiffs at the number(s) stated on their products/materials; why did she have to use the Chinese character "Xiang" as a guide? I note from Tan's exhibit **TTH-22** that the plaintiffs had faxed their invitation to the magazine on their letterhead which contained their fax as well as telephone numbers and, the invitation also stated the telephone and hand-phone numbers of one Joanne Ho, should the magazine wish to contact the plaintiffs. One would have thought that if indeed Beverly Gomez (or anyone else) needed to verify the plaintiffs' contact numbers, she would logically have called either Joanne Ho or the plaintiffs, not look at the "Xiang" logo (if indeed it was published) in the telephone directory.

24. I should add that Tan also cast doubts on the veracity of Wong's claim that the plaintiffs' customers attempted to exchange products at the defendants' outlets or asked to purchase barbecued crocodile meat. I share Tan's scepticism on the former instance of confusion as Wong did not elaborate on the kind of products sought to be exchanged by 'confused' customers; I cannot imagine how customers of perishable products like barbecued pork would be allowed to exchange what they had purchased unless the packaging contained expiry dates and their purchases had indeed expired at the time they bought the same.

#### *The decision*

25. As there is only one appeal by the defendants against my decision in granting the O 14 application, I shall confine my grounds to that application, bearing in mind that:

- (i) I had declined to grant the injunction application;
- (ii) the opposition proceedings relating to the plaintiffs' application to register the trademark in class 29 is still pending and I should not prejudge the issue.

26. It was not disputed by the defendants (according to Wong's affidavits and their counsel's submissions) that they did not have the plaintiffs' consent to reproduce the Work or the plaintiffs' trademark T95/06325E (the trademark) in the defendants' advertisement and other notices. Consequently, there was infringement within s 31(1) of the Copyright Act Cap 63 (the Copyright Act); the section states:



Subject to the provisions of this Act, the copyright in a literary, dramatic, musical or artistic work is infringed by a person who, not being the owner of the copyright, and without the licence of the owner of the copyright, does in Singapore, or authorises the doing in Singapore of, any act comprised in the copyright.

27. I shall now refer to some other provisions of the Copyright Act, which had led me to conclude there was infringement by the defendants of the Work.

28. I start with s 7 which states:

(1) "Artistic work" means —

(a) a painting, sculpture, drawing, engraving or photograph, whether the work is of artistic quality or not;

(b) a building or model of a building, whether the building or model is of artistic quality or not; or

(c) a work of artistic craftsmanship to which neither paragraph (a) nor (b) applies;

but does not include a layout-design or an integrated circuit within the meaning of section 2 of the Layout-Design of Integrated Circuits Act 1999 (Act 3 of 1999).

29. Other provisions of the Copyright Act which are relevant for our purpose are the following:-

26 — (1) For the purposes of this Act, unless the contrary intention appears, copyright, in relation to a work, is the exclusive right —

(a) .....

(i) to reproduce the work in a material form;

(ii) to publish the work if the work is unpublished ;

(b) in the case of an artistic work, to do all or any of the following acts:

(i) to reproduce the work in a material form;

(ii) to publish the work in Singapore or any country in relation to which this Act applies, if the work is unpublished;

27. — (1) Subject to the provisions of this Act, copyright shall subsist in an original literary, dramatic, musical or artistic work that is unpublished and of which the author —

(a) was a qualified person at the time when the work was made;

or

(b) if the making of the work extended over a period — was a qualified person for a substantial part of that period.

(4) In this section, "qualified person" means a citizen of Singapore or a person resident in Singapore.

30. There is no question that the Work created by Chionh comes within the definition of "*artistic work*" under s 7(a) of the Copyright Act. Equally, it cannot be disputed that Chionh comes within the definition of "*qualified person*" under s 27(1)(a) and (4) of the same Act as, he holds a Singapore identity card. If he is not a citizen, then he must be at least a permanent resident. In any case, the assertion by Tan (in his first affidavit) that Chionh is a Singapore citizen was not challenged by the defendants. Further, the assignment agreement in exhibit **TTH2** of Tan's first affidavit indicated that Chionh resides in Singapore. As the defendants have not made any issue of the assignment agreement, I assumed that the same was/is both valid and subsisting.

31. The defendants also did not dispute that the Work has indeed been published by the plaintiffs. Over the years since the Work was created in 1994, the plaintiffs have used the same extensively on their products. The defendants did not have the plaintiffs' permission to reproduce the Work in a material form under s 26(b)(i) when they advertised the same on 2 and 3 February 2002.

32. Based on the sections of the Copyright Act set out above, it appeared to me that all the ingredients to found liability on the part of the defendants for copyright infringement had been satisfied.

33. On their part, although they did not deny infringement, the defendants raised a number of defences, some of which were so completely unmeritorious (implied licence, s 74 of the Copyright Act) that I shall not refer to them. I shall only refer to two (2) of the defences which warranted consideration.

34. The first defence raised was the question of fair dealing, under s 37 of the Copyright Act; that section states:-

A fair dealing with a literary, dramatic, musical or artistic work, or with an adaptation of a literary, dramatic or musical work, shall not constitute an infringement of the copyright in the work if it is for the purpose of, or is associated with, the reporting of current events —

(a) in a newspaper, magazine or similar periodical and a sufficient acknowledgement of the work is made or

(b) by means of broadcasting, or a cable programme service or in a cinematograph film.

Counsel for the defendants had argued that the Copyright Act provides for certain common law defences, one of which was fair dealing in the public interest. Citing *Hubbard & Anor v Vosper & Anor* [1972] 2 QB 84, *Beloff v Pressdram Ltd* [1973] 1 All ER 241 and *Lion Laboratories Ltd v Evans & Others* [1985] 1 QB 526, counsel submitted that the Copyright Act should not be used as a mechanism to suppress information which the public has a right as well as an interest, to know. I was not persuaded by this argument. Firstly, the matter was only of interest to the plaintiffs and the defendants, not to the general public. Further, it seemed to me to be straining the language of s

37(a) of the Copyright Act to say that the incidents of confusion alleged by the defendants could qualify as *current events* when, the first instance of confusion (on the part of Bloomdale) took place in 1988 while the press conference (out of which confusion on the part of the **Singapore Women's Weekly** arose) took place on 15 November 2001. These events can hardly qualify as *current*.

35. Counsel's reliance on the three (3) authorities was misconceived. To elaborate, in *Hubbard v Vosper*, the English Court of Appeal (per Denning MR) spoke of "fair dealing" under s 6(2) of the Copyright Act 1956 (which wording is similar to s 37 of our Act) in the following terms (pp 94-95):

It is impossible to define what is "fair dealing". It must be a question of degree. You must consider first the number and extent of the quotations and extracts. Are they altogether too many and too long to be fair? Then you must consider the use made of them. If they are used as a basis for comment, criticism or review, that may be fair dealing. If they are used to convey the same information as the author, for a rival purpose, that may be unfair.....

.....

Although a literary work may not be published to the world at large, it may, however, be circulated to such a wide circle that it is "fair dealing" to criticise it publicly in a newspaper, or elsewhere. This happens sometimes when a company sends a circular to the whole body of shareholders. It may be of such general interest that it is quite legitimate for a newspaper to make quotations from it and to criticise them – or review them – without thereby being guilty of infringing copyright.

As the Work is not a literary but an artistic, work, I did not think the defence of fair dealing was available to the defendants. In this regard, I disagreed with the submission of counsel for the plaintiffs, who relied on *Anacon Corporation Limited v Environmental Research Technology Limited* [1994] FLR 659 for his proposition that the Work was a literary work. Applying Jacob J's conditions for a literary work (holding no. 5) in that case, whilst I agree Chionh's logo was written down, I cannot say it contained information which could be read by someone, as opposed to being appreciated simply with the eye, unlike circuit diagrams (which was the subject matter of infringement in that case).

36. I turn now to the other two (2) cases cited by the defendants. The court (Ungoed-Thomas J) in *Beloff v Pressdram Ltd* relied on the definition of "fair dealing" in *Hubbard v Vosper* when it dismissed the plaintiff's claim for copyright infringement of a memorandum dated 17 February 1971 which she had written to the editor of The Observer newspaper, while employed as its correspondent. *Lion Laboratories Ltd v Evans* was an action for infringement of copyright, by manufacturers of an electronic computerised instrument known as the Lion Intoximeter 3000, which was used to test the breath of motorists suspected of driving after consuming alcohol beyond the statutorily prescribed limit. The plaintiffs sought an injunction and damages for breach of confidence and copyright against their former employees/technicians, who had taken away (without authority) the company's confidential internal memoranda, which cast doubt on the accuracy of the functioning of the instrument. The appellate court held that there was a conflict between two public interests namely, the plaintiffs' right to protect their internal, confidential information and their copyright in them and, the public's entitlement to information which raised serious doubts about the reliability of an

instrument which was providing the sole evidence on which members of the public had been or were being prosecuted. The court went on to hold that the information contained in the documents was so important to the public as to outweigh the plaintiffs' interests and accordingly, the court would (overruling the decision below) permit publication of specified documents. These two (2) cases are far removed from the facts of our case.

37. I had briefly addressed (para 16 *supra*) the preliminary issue raised by counsel for the defendants, that the requirements of s 27 of the Trademarks Act had not been satisfied. Counsel relied on s 27(6) for his submission that his clients' use of the Work was *for the purpose of identifying goods or services as those of the proprietor or licensee*. This submission did not find favour with me either. I accepted the plaintiffs'/Tan's interpretation of the advertisement/notices as containing a subtle suggestion that the defendants' goods had been confused with those of the plaintiffs' which were inferior to the defendants', that the plaintiffs were responsible for such confusion and, that the plaintiffs copied the defendants' logo. The situation was aggravated by Wong's subsequent press statement. The parties had exhibited in their clients' respective affidavits, their own translations of that press statement. I have considered both translations and there is little difference between the two (2). In essence, both versions said that Wong had stated that both companies used the Chinese character "Xiang" in their logos. What was objectionable about the defendants' advertisement and Wong's press statement was, that the defendants did not disclose (nor in their submissions) that the Chinese character "Xiang" had been expressly disclaimed by the defendants; the certificate for their mark No. T91/10763J registered under class 29 (exhibit **TTH-4** in Tan's first affidavit filed 8 February 2002) stated:

Registration of this mark shall give no right to the exclusive use of the Chinese character(s) of which the hanyu pinyin is "Xiang" except in the form as represented.

Their mark was protected only in respect of the form in which the character was represented. Yet, knowing that and, that the registration of the plaintiffs' mark under class 29 was still pending due to their opposition (alleging similarity and confusion with the defendants' mark), the defendants placed the advertisement in the manner they did and Wong spoke to the press, giving the impression that the defendants had first use of the Chinese character "Xiang" and the plaintiffs were a 'newcomer'. Why else would the press report that the following question was asked of Wong?

Will the 'Fragrance' brand/logo affect the revenue/turnover of [the defendants]?

### *Conclusion*

38. The defendants had admitted infringing the copyright in the Work while the plaintiffs had fulfilled all the requirements under the Copyright Act for their claim. As no defence or any triable issue was raised against the plaintiffs' claim, I granted an order in terms of prayer 1 of the O 14 application, so as to restrain the defendants from repeating the mischief committed by their advertisement/notices.

Sgd:

LAI SIU CHIU

JUDGE

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