

Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another
[2012] SGHC 104

Case Number : Suit No 669 of 2010
Decision Date : 11 May 2012
Tribunal/Court : High Court
Coram : Chan Seng Onn J
Counsel Name(s) : Gill Dedar Singh, Tang Li Ling Yvonne and Chiang Hui Shan Michelle (Drew & Napier LLC) for the plaintiff; Wong Siew Hong and Ong Zhenhui Wayne (Eldan Law LLP) for the defendants
Parties : Hai Tong Co (Pte) Ltd — Ventree Singapore Pte Ltd and another

Trade marks and trade names – infringement – passing off

11 May 2012

Chan Seng Onn J:

Introduction

1 The plaintiff, Hai Tong Co Pte Ltd (“the Plaintiff”), is a company incorporated in Singapore. It carries on the business of importing, exporting, distributing and selling cosmetics, sundries and beauty accessories, including a range of cosmetic products under the brand “*Lady Rose*”. The first defendant, Ventree Singapore Pte Ltd (“the 1st Defendant”), is a company incorporated in Singapore. The 1st Defendant is in the business of importing, exporting and distributing cosmetic products, and is the distributor of “Rose Lady” cosmetic products pursuant to a Sole Agent Agreement with the manufacturer of these products, VOV Cosmetics Co Ltd (“VOV Cosmetics”). VOV Cosmetics is a company incorporated in South Korea and is not a party to the present proceedings. VOV Cosmetics is the registered proprietor of the “VOV” trade mark in Singapore, which was registered in 2004 under Trade Mark Number T0406108D. The second defendant, SKY (“the 2nd Defendant”), is a partnership incorporated in Singapore. It operates a retail department store at People’s Park Complex selling, *inter alia*, cosmetics and perfumes, including cosmetic products from the “Rose Lady” brand. It previously sold products from the Plaintiff’s “*Lady Rose*” brand, but has not sold the Plaintiff’s products since around 2005.

Factual Background

2 With regard to the “*Lady Rose*” brand, the Plaintiff is the registered proprietor of the following mark (“the “*Lady Rose*” mark”):

Trade Mark No	Trade mark	Specifications

T7048436B		Perfumery, essential oils, hair lotions, hair creams and cosmetics.
-----------	--	---

3 The “*Lady Rose*” mark was registered by the Plaintiff’s predecessor (Hai Tong Company) in 1970, and has been in use by the Plaintiff and/or its predecessors since 1960. The Plaintiff distributes its “*Lady Rose*” products to various retailers across Singapore, including department stores such as Robinsons and retail cosmetics shops. The Plaintiff also sells these products to walk-in customers at its shop in Sago Lane. In particular, the Plaintiff sells two cosmetic products under the “*Lady Rose*” mark, viz a two way cake and a foundation with sunscreen.

4 On 15 July 2009, the 1st Defendant entered into a Sole Agent Agreement with VOV Cosmetics which allowed the former to import and distribute VOV Cosmetics’ products, including a range of VOV Cosmetics’ products bearing the words “Rose Lady”. These products contained *rosa canina*, essence of dog rose, as an ingredient. The product packaging was peach and featured sketches of five-petalled flowers. The 1st Defendant imported three “Rose Lady” products into Singapore: “VOV” Rose Lady Cover Foundation, “VOV” Rose Lady Skin Cover, and “VOV” Rose Lady Two Way Cake (“the Infringing Products”). VOV Cosmetics’ products were sold at various retailers across Singapore, including department stores such as John Little and retail cosmetics shops. The 2nd Defendant sold “VOV” Rose Lady Skin Cover since January 2010, but did not sell the other two Infringing Products.

5 In or around July 2010, the Plaintiff received a number of complaints from its customers regarding the quality of certain “*Lady Rose*” cosmetic products packaged in a peach coloured case. As the Plaintiff uses blue packaging for the “*Lady Rose*” cosmetic products, it became concerned about the possibility of counterfeit “*Lady Rose*” products on the market and proceeded to conduct investigations into the matter. As a result of its investigations, the Plaintiff became aware that the 1st Defendant was importing VOV’s “Rose Lady” cosmetic products into Singapore. The Plaintiff also discovered that these “Rose Lady” cosmetic products were being sold at a number of other retail outlets in Singapore, including but not limited to the 2nd Defendant’s retail store.

6 On or about 21 July 2010, the Plaintiff through its solicitors issued a Letter of Demand to the 1st Defendant claiming, *inter alia*, that the 1st Defendant had infringed the Plaintiff’s “*Lady Rose*” mark. On 23 July 2010, the 1st Defendant replied through its solicitors denying all allegations of trade mark infringement. The Plaintiff through its solicitors also sent a cease-and-desist letter to the 2nd Defendant. On 1 August 2010, the Plaintiff filed this action against the 1st and 2nd Defendants (the “Defendants”), claiming that they had infringed the Plaintiff’s “*Lady Rose*” mark by importing and

offering for sale the Infringing Products, and also alleging that the Defendants had acted together to pass off the Infringing Products as the Plaintiff's goods. The 1st Defendant has since ceased importing the Infringing Products.

The Plaintiff's claims

7 In the Plaintiff's Statement of Claim, the Plaintiff alleged that the Defendants had done the following:

(a) Infringed the registered trade mark of the Plaintiff by the use in the course of trade of a sign where, because the sign was similar to the registered trade mark and was used in relation to goods similar or identical to those for which the registered trade mark was registered, there existed a likelihood of confusion; and

(b) Passed off and/or attempted to pass off and/or enabled, assisted, caused or procured others to pass off, the cosmetic products marketed under and by reference to the mark "Rose Lady", not being goods of the Plaintiff, as and for the same.

8 I turn first to consider the trade mark infringement claim.

Trade Mark Infringement

9 Section 27(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("TMA") provides thus:

(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* —

...

(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.

[emphasis added]

10 Section 2(1) of the TMA defines the term "sign" thus:

any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof.

11 Here, the Plaintiff first had to establish that the "Rose Lady" sign was used in the course of trade by the Defendants. If this threshold issue was resolved in favour of the Plaintiff, the Plaintiff then had to show the following three elements in order to establish an infringement under s 27(2)(b) of the TMA (applying *The Polo/Lauren Co, LP v Shop-In Department Store Pte Ltd* [2006] 2 SLR(R) 690 ("Polo") at [8]):

(a) The "Rose Lady" sign used by the Defendants was similar to the Plaintiff's "Lady Rose" trade mark;

(b) The "Rose Lady" sign was used in relation to goods or services identical or similar to those

for which the Plaintiff's "Lady Rose" trade mark was registered; and

(c) On account of (a) and (b) above, there was a likelihood of confusion on the part of the public.

Whether the "Rose Lady" sign was used by the Defendants in the course of trade

12 The Defendants submitted before me that the words "Rose Lady" were descriptive of cosmetic products made with essence of the *rosa canina* plant that were intended for ladies' use. They further argued that the words were commonly used in the cosmetics industry, and merely descriptive of common features of cosmetic products. However, I did not accept these arguments. I found that the combination of the two words "Rose" and "Lady" was distinctive rather than descriptive. In *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co)* [2003] 4 SLR(R) 92, the court held at [40]:

While the words "BLUE" and "STAR" are common words individually and each was used in marks belonging to others, it was the combination of these two words which, in my view, gave the RTM its distinctive character.. The combination of two common words can be distinctive like "Burger King".

13 Here, the Defendants used "Rose Lady" as a brand name for a line of cosmetics under which they marketed a range of products. I found that although "Rose" and "Lady" were common words individually, when used together in this manner they had a distinctive character which enabled the sign to function as a trade mark and identify a line of products. Under cross-examination, the Defendants' witness Mr Goh Soo Ching, a partner of the 2nd Defendant, admitted that "Rose Lady" was being used as the name of a particular range of products, rather than to describe any of the ingredients in the products:

Ct: You used a name to identify a range?

A: Okay, if for example for this, maybe they will – they will call this the Rose Lady range.

Ct: Oh I see.

A: The range of it... for this brand.

Ct: Basically it's a name, it's not as if to describe it –

A: Correct.

Ct: - but it's a name ...

...

Ct: So that ["Rose Lady"] is used as a name.

A: Yes, right.

Ct: Not so much as to describe what is in the ingredient of the product.

A: Yes.

14 The Defendants also argued that "Rose Lady" was not being used as a trade mark, as the Infringing Products were actually being marketed under the "VOV" trade mark. The Defendants submitted that the Infringing Products were made by VOV Cosmetics, and sold together with other "VOV" products. They further submitted that the dominant mark on the packaging of the Infringing Products was the "VOV" mark, and that the photographs of the Infringing Products revealed that they were marketed as "VOV Rose Lady" products rather than "Rose Lady" products *per se*. The Defendants further argued that "Rose Lady" was not being used as a secondary mark to identify a range of products in the "VOV" line. They highlighted that "Rose Lady" was not a registered trade mark in Singapore, in contrast to VOV Cosmetics' registered trade marks "JADILLA J" and "CASTLEDEW", which were used on certain ranges of VOV Cosmetics' products.

15 However, I did not accept the Defendants' arguments. I found that "Rose Lady" was a secondary product identifier that was being used as a secondary mark. In *Richemont International SA v Da Vinci Collections Pte Ltd* [2006] 4 SLR(R) 369, the court stated at [14] that:

... [I]t is well established in trade mark law that a product may have more than one trade mark. Thus, secondary or even third-level product identifiers can function as trade marks if they indicate to the consumer that the product originates from a particular undertaking.

16 In *British Sugar PLC v James Robertson & Sons Ltd* (1996) RPC 281, the court observed at 299 that:

It is of course the case that you can have two trade marks used together ("Ford Prefect"), but whether the secondary word is used as a trade mark is a question of fact. If it is a fancy word, then obviously it is a trade mark because it could not be taken as anything else.

As such, although the Infringing Products also had the "VOV" trade mark on the packaging, that did not in and of itself preclude the possibility that "Rose Lady" was also being used as a secondary trade mark on the Infringing Products. Additionally, as discussed above at [12] – [13], "Rose Lady" was not a descriptive phrase but instead a fancy mark.

17 In *Neutrogena Corporation v Golden Ltd (t/a Garnier)* [1996] RPC 473, the marks being compared were "NEUTRALIA", used on a narrow product range of a shampoo, facial wash, shower gel, bath foam, moisturisers and liquid soaps, and "NEUTROGENA", used on a wider range of soaps, shampoos and other skin and hair care products. The "NEUTRALIA" products were sold in clear transparent bottles (the liquid inside also being clear), with the name "LABORATORIES GARNIER" on the front bottom right of the bottle. In relation to the visibility of the name "LABORATORIES GARNIER", the court said at 481:

Owing to the clarity of the bottle and contents however, these words do not stand out. I find as a fact that many consumers simply do not notice them, particularly (but by no means only) in shopping conditions.

18 Here, I found that "Rose Lady" was being used as a secondary mark on the Defendants' products: the words "Rose Lady Skin Cover" and "Rose Lady Two Way Cake" were prominently displayed in the middle of the front covers of the packaging, whereas the words "Rose Lady Cover Foundation" were prominently displayed in the middle of the back cover of the packaging and the words "Rose Lady Cover Foundation" on the product itself could be seen through the transparent front cover of the packaging, thus indicating to the consumer that the three products originated from the "Rose Lady" line. In contrast, the "VOV" mark was not prominently displayed. The "VOV" mark appeared in a much smaller font at the bottom corner of the front cover and on two sides of the

packaging for the "Rose Lady Skin Cover" and "Rose Lady Two Way Cake" products. For the "Rose Lady Cover Foundation", the "VOV" mark appeared in a much smaller font at the bottom of the back cover and on three sides of the packaging, and was partly shielded from view on the transparent front cover of the packaging. The "VOV" trade mark did not even appear on both the "Rose Lady Skin Cover" and the "Rose Lady Two Way Cake" products themselves. Instead, the words "Rose Lady Skin Cover" and "Rose Lady Two Way Cake" appeared prominently on the front covers of the two products. As such, I found that "Rose Lady" was a secondary product identifier that was being used as a secondary mark. Clearly, the "Rose Lady" sign was used by the Defendants in the course of trade.

Whether the "Rose Lady" sign used by the Defendants was similar to the Plaintiff's "Lady Rose" trade mark

19 The Plaintiff had to prove that there was similarity between the allegedly infringing sign "Rose Lady" and the Plaintiff's registered trade mark "Lady Rose". I found that they were similar. They shared strong visual, aural and conceptual similarities. In any case, the law does not require all three similarities to be made out before the finding that the allegedly infringing sign is similar to the registered trade mark can be made: *MediaCorp News Pte Ltd v Astro All Asia Networks plc* [2009] 4 SLR(R) 496 at [32] ("*MediaCorp*").

Visual similarity

20 In *Ozone Community v Advance Magazine Publishers Inc* [2010] 2 SLR 459 at [49], the court cited the following observation from Bently & Sherman, *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) at 865 ("*Bently & Sherman*"):

in the case of word marks, a determination of visual similarity typically involves looking at the (a) length of the marks; (b) structure of the marks (*ie*, whether there are the same number of words); and (c) whether the same letters are used in the marks.

21 The court in *Hedgefund Intelligence Ltd v OHIM* (2009) Cast T-67/08 ("*Hedgefund Intelligence*") held that marks that consisted of inverted words (in that case, "HEDGE INVEST" and "InvestHedge") could be visually similar:

The mere inversion of the elements of a mark cannot allow the conclusion to be drawn that there is no visual similarity

...

... [E]ven though the elements 'hedge' and 'invest' appear, in the mark applied for, in inverted order and written in slightly different characters, the signs do present visual similarities.

In *Macquarie Bank Limited v Great Southern Loan (SP) Pty Ltd* [2007] 73 IPR 573, the court held that the marks "FORWARD THINKING" and "THINKING FORWARD" were visually similar. In *R&C Products Pte Ltd v Hunters Products Pte Ltd* [1998] ATPR 40-839, the appellant, in using the name "Fresh & Blue" on its product, was found to have engaged in misleading or deceptive conduct *vis-à-vis* the respondent which sold a product called "blue & fresh". Similarly, in *Automobile Club De L'ouest v Gardiakos* [2006] 66 IPR 191, the marks "Adelaide Le Mans" and "Le Mans Adelaide" were held to be deceptively similar. It is evident from the case law that marks having identical words in an inverted sequence can be visually similar.

22 Here, the Defendants' sign consisted of the same two words present in the Plaintiff's mark. Both were also identical in length and had the same number of words. The main difference was the sequence in which the words were placed, but as held in the cases above, marks with identical words in an inverted sequence could be deceptively similar.

23 Additionally, when comparing two marks visually, "what is relevant is the 'imperfect recollection' of the consumer" (*Nautical Concept Pte Ltd v Jeffrey Mark Richard* [2007] 1 SLR(R) 1071 at [30]). The average consumer would often not have the opportunity to make a side-by-side comparison of the marks. As the court in *Caterpillar Inc v Ong Eng Peng* [2006] 2 SLR(R) 669 held at [55], "the person who is confused often makes comparison from memory removed in time and space from the marks." Accordingly, even where two marks may appear to be dissimilar, when the possibility of imperfect recollection is taken into account, the two marks may in fact be similar: *Bently & Sherman* at 865. Here, the Defendants tried to argue that the two marks were visually dissimilar as the "Lady Rose" mark included a drawing of a rose and was in a cursive font, whereas the "Rose Lady" mark did not include the drawing of a rose and was in a plain letter font. However, the words "Lady Rose" do stand out prominently in the Plaintiff's mark. With imperfect recollection, a consumer who had seen the Plaintiff's "Lady Rose" mark on a product previously, and now with the Defendants' product bearing the "Rose Lady" mark before her, might imagine the "Rose Lady" mark to be similar to her vague recollection of the "Lady Rose" mark in her mind. As such, I found that the two marks were visually similar.

Aural similarity

24 The court in *Future Enterprises Pte Ltd v McDonald's Corp* [2006] 4 SLR(R) 629 ("*Future Enterprises (HC)*") at [12] held that in assessing aural similarity, allowance must be made for "imperfect recollection" and "careless pronunciation and speech". In *Hedgefund Intelligence*, the court held at [39] that "the fact that the syllables are pronounced in an inverted order cannot prevent the signs from being similar overall. Consequently, there is a certain phonetic similarity between them." Here, the marks shared very strong aural similarity, especially with imperfect recollection on the part of consumers being taken into account. When spoken carelessly or quickly, the marks would sound highly similar. Indeed, the phonetic similarity was actually evidenced in the course of the trial, where parties sometimes said "Rose Lady" when they actually intended to refer to the "Lady Rose" mark, and *vice versa*. To a person who was not paying close attention to the inversion of the two words, he or she could easily be confused and use "Rose Lady" and "Lady Rose" interchangeably. Under cross-examination, the Defendants' witness Mr Goh Soo Ching conceded that the two marks were similar:

Q: Would you accept –

A: Mhm.

Q: - that the two names, as you call them, "Lady Rose" and "Rose Lady" are similar?

A: Mm, I – I can accept.

Q: You accept.

A: Yes.

Conceptual similarity

25 When assessing the question of conceptual similarity, it is necessary to consider the “ideas that lie behind or inform the earlier mark” (*Bently & Sherman* at 866). Here, there was very strong conceptual similarity between the two marks: the composite words of both marks were identical, and both marks evoked the idea of something floral and feminine. The word “Rose” in “Rose Lady” also described the flower which formed a part of the Plaintiff’s mark.

26 As such, I found that the two marks were similar as they shared strong visual, aural and conceptual similarities.

Whether the “Rose Lady” sign was used in relation to goods or services identical or similar to those for which the Plaintiff’s “Lady Rose” trade mark was registered

27 In determining whether the goods are identical, the court will look at the specification of goods for which the registered trade mark is registered and the primary purpose(s) for which they are or are to be used, and compare that with the goods on which the offending mark is applied. Here, the Plaintiff had to show that the “Rose Lady” mark was being used in relation to goods identical or similar to “perfumery, essential oils, hair lotions, hair creams and cosmetics.” As the “Rose Lady” mark was being used on similar cosmetic products, *viz* ladies’ skin cover and foundation products, this element was clearly satisfied.

Whether there was a likelihood of confusion on the part of the public

28 The third element that the Plaintiff had to show was a likelihood of confusion on the part of the public arising from the fact that the “Rose Lady” sign was similar to Plaintiff’s trade mark “Lady Rose” and the Defendants had used the “Rose Lady” sign in relation to similar goods for which the Plaintiff’s trade mark was registered. In *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd* [2011] SGHC 176 (“*Ferrero*”), the court held at [92]:

The issue of likelihood of confusion is to be determined as at the time when the alleged infringing use of the sign commenced (*City Chain* at [51]), the test being whether a substantial portion of the relevant public will be confused.

29 The question of likelihood of confusion is to be considered holistically. In *Polo*, the Court of Appeal held thus at [28]:

The question of likelihood of confusion has to be looked at globally taking into account all the circumstance including the closeness of the goods, the impression given by the marks, the possibility of imperfect recollection and the risk that the public might believe that the goods come from the same source or economically-linked sources.

30 Here, I found that there was a likelihood of confusion on the part of the public. First, as discussed above, there was a high degree of similarity in the marks, and the goods were identical. As the court in *Ferrero* held at [98], “accordingly, it stands to reason that where there is *greater similarity* in the marks and the goods, it would be easier to find a likelihood of confusion.”

31 Second, the goods were also being marketed in similar retail locations such as departmental stores and cosmetics shops, and targeted the same group of customers, females who used cosmetics. It thus followed that there was a risk that the public might believe that the “Rose Lady” goods came from the same source as the “Lady Rose” goods, or from economically-linked sources. Additionally, Mr Park In Pil, director of the 1st Defendant, had conceded under cross-examination that it was possible that consumers could be confused by the similarity of the two marks:

Q: Right, right, so that is actually my example, the mother just says to the daughter, "Please buy a Lady Rose foundation for me." The daughter goes to the shop, she sees "Rose Lady". He's already accepted that "Lady Rose," "Rose Lady" are similar. So it must follow that the daughter can come into the shop and be led to believe that they are the same product. You agree, right?"

Interpreter: He agrees about the point.

32 As such, I found there was likelihood that a substantial portion of the relevant public, viz consumers of cosmetic products, would be confused.

Conclusion on trade mark infringement

33 I thus found that the Plaintiff had made out all the elements under s 27(2)(b) of the TMA, and succeeded in establishing trade mark infringement.

Passing Off

34 The Plaintiff must establish the following elements to succeed in an action for passing off. In *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*"), the court held at [36], [37] and [69]:

(a) First, that the plaintiff has goodwill attached to the goods which he supplies in the mind of the purchasing public by association with the identifying "get-up" (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods.

(b) Second, that the defendant has made a misrepresentation to the public (whether intentional or otherwise) leading or likely to lead the public to believe that goods offered by the defendant are those of the plaintiff; and

(c) Third, that the plaintiff suffers or, in a quia timet action, is likely to suffer, damage to the plaintiff's goodwill by reason of the erroneous belief engendered by the defendant's misrepresentation.

35 The court in *Ferrero* held at [197]:

In determining whether goodwill exists in a name, *exposure* of the name is the relevant criterion (*Amanresorts* at [53]). Proving goodwill or distinctiveness is a question of fact (*City Chain* at [62]). Possible indicia of goodwill include volume of sales, trading, advertisements and promotion expenditure (*ibid*; *Caterpillar* at [64]). However, mere sales figures without more are not necessarily coincident with goodwill (*Nation Fittings* at [158]).

36 Here, the Plaintiff had not conducted any market surveys which indicated the market share of its products in the cosmetics industry. Although the Plaintiff provided its annual sales turnover for "Lady Rose" products from 2003 to June 2010, these were "mere sales figures without more" – the Plaintiff did not proceed to elaborate on the significance of these figures or how they related to volume of sales of its cosmetic products. The annual sales figures, which represented sales of both cosmetics and non-cosmetic products, were not particularly impressive as can be seen in the table

below:

Plaintiff's Sales Figures

Year	A n n u a l Sales (SGD)
2003	223,243.00
2004	209,830.00
2005	270,444.00
2006	288,758.00
2007	265,613.00
2008	253,272.00
2009	235,150.00
2010	171,664.02
June 2011	59,582.00

As the above were combined sales figures, it was not clear what the sales figures were specifically for the Plaintiff's cosmetic products. Additionally, the fact that the Plaintiff had not advertised its products since 1979 suggested that there had been negligible exposure of the "*Lady Rose*" name in the media: this was not a case where the Plaintiff had been actively promoting brand consciousness or awareness through advertising, thereby actively cultivating goodwill in the name. Although the Plaintiff claimed that it had an ongoing incentive promotion programme of providing free goods to retailers, no evidence was adduced of actual advertising and promotion to the public by the Plaintiff. The Plaintiff was also unable to show evidence that the benefits of the alleged incentive promotion were extended by the retailers to the public when cross-examined during the course of the trial. As such, apart from the fact that the Plaintiff and/or its predecessors had traded under the "*Lady Rose*" mark for more than 40 years, it failed to adduce any further evidence of goodwill before this court. The Plaintiff's case appeared to be based largely on the bare assertion that it necessarily had goodwill because it had been trading under this mark for some 40 years.

37 It was stated in Morcom, Roughton and Malynicz, *The Modern Law of Trade Marks*, (LexisNexis, 3rd Ed, 2008) at paragraph 14.19 that:

At some point a reputation may be respected by such a small group of people that it will not support a passing off action. As Laddie J said in *Sutherland v V2 Music Ltd* [2002] EWHC 14 (Ch):

"The law of passing off protects a small business as much as the large, but it will not interfere to protect the goodwill which any reasonable person would consider trivial."

In *Hart v Relentless Records Ltd* [2003] FSR 36 Jacob J (as he then was) said the court is looking for more than minimal reputation. A goodwill of trivial extent will not be protected. In that case Mr Justice Jacob described the claimant as "unmemorable minnow". Another consequence of minimal goodwill in that case was that there was no damage.

38 For proof of damage or a likelihood of damage, the Plaintiff simply asserted that likelihood of

damage to its ability to exploit the goodwill itself could be readily inferred from the fact that the Infringing Products were in direct competition with the Plaintiff's "*Lady Rose*" products. The Plaintiff failed to adduce any evidence before me that there was damage or a likelihood of damage. Instead, in its closing submissions, it simply invited the court to infer a likelihood of damage based on the fact that the Plaintiff and Defendants were in a common field of activity. On balance, I was not able to infer that there was a real likelihood of damage to the Plaintiff's meagre goodwill owing to the Defendants' alleged misrepresentation.

39 A plaintiff might have used a mark or brand name on its goods for a substantial number of years. But without adequate and sustained promotion and advertisement, especially in the crowded and competitive cosmetics market place in Singapore, it could well have remained largely unknown to the relevant sector of the public and would thus have hardly any reputation and goodwill to speak about. On the facts of this case, even if there was any goodwill in "*Lady Rose*", in my view it would only be trivial. Under these circumstances, the Plaintiff would have a much more difficult evidential task to establish actual damage or a real likelihood of damage to its goodwill on a balance of probabilities.

40 More often than not, it would have been a defendant, who was relatively unknown in the market place and having inferior goods or products, who would try to represent its goods in such a way as to pass them off as goods of a far more established, well known and superior brand. It would be indeed rare for a defendant with an established, well known and superior brand to pass off its goods as that of a largely unknown and inferior brand of a plaintiff. Quite apart from having no good commercial reason for doing so, the defendant would also run the risk of ruining the goodwill in its own reputable brand.

41 I was more inclined to believe that "*VOV*", with its far wider range of cosmetic products, was a better known brand than "*Lady Rose*". With hardly any evidence of damage to the Plaintiff's goodwill placed before me, I was not prepared on the facts of this case to find or infer, on a balance of probabilities, that there was damage or a real likelihood of damage to the very limited goodwill of the Plaintiff.

42 It would be pertinent to note what the Court of Appeal in *Amanresorts* held at [94]:

The tort of passing off protects the plaintiff against damage caused to the goodwill attached to its business, goods or services by the defendant's misrepresentation. Thus, even if the defendant's misrepresentation is shown to have caused or to be likely to cause confusion between the plaintiff's business, goods or services and those of the defendant, such misrepresentation is not in itself actionable under the law of passing off unless it has caused (or is likely to cause) damage to the plaintiff's goodwill.

43 As the Plaintiff failed to discharge its burden of proving that there was damage or a likelihood of damage to its goodwill, I found that the passing off claim had not been made out and dismissed it accordingly.

Conclusion

44 Having found that the Defendants had infringed the Plaintiff's "*Lady Rose*" word mark under s 27(2)(b) of the TMA, I accordingly granted the Plaintiff the following injunctions to restrain the Defendants from infringing the Plaintiff's "*Lady Rose*" mark:

- (a) An injunction to restrain the 1st Defendant, whether acting by its directors, officers,

employees, agents or any of them or otherwise howsoever, from infringing Trade Mark Registration No T7048436B; and

(b) An injunction to restrain the 2nd Defendant and each of its partners, whether acting by himself, his employees or agents or any of them or otherwise howsoever, from infringing Trade Mark Registration No T7048436B.

45 I also made the following ancillary orders:

(a) An order for delivery-up and/or destruction upon oath of all products, printed or written matter, packaging and all other articles in the power, possession, custody and/or control of the Defendants and each of them, the use of which would be in breach of the foregoing injunction(s);

(b) An inquiry as to damages suffered by the Plaintiff, or at the Plaintiff's option, an account of profits; and

(c) An order for payment to the Plaintiff of all sums found due upon taking such inquiry or account, together with interest thereon pursuant to Section 12 of the Civil Law Act, at such rate and for such period as the Court thinks fit.

46 With regard to costs, I ordered that the Plaintiff was to have 90% of its costs paid by the Defendants. Although the Plaintiff did not succeed in its claim for passing off, I found that on the whole it had succeeded in its case and obtained the desired remedies.

Copyright © Government of Singapore.