

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2020] SGHC 77

Tribunal Appeal No 22 of 2019

Between

(1) Harvard Club of Singapore

... Appellant

And

(1) President and Fellows of
Harvard College

... Respondent

JUDGMENT

[Trade Marks and Trade Names] — [Passing off]

[Trade Marks and Trade Names] — [Ownership]

[Trade Marks and Trade Names] — [Grounds for refusal of registration]

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Harvard Club of Singapore
v
President and Fellows of Harvard College

[2020] SGHC 77

High Court — Tribunal Appeal No 22 of 2019
Chan Seng Onn J
14 February 2020

20 April 2020

Judgment reserved.

Chan Seng Onn J:

Introduction

1 More than four centuries ago, William Shakespeare famously wrote:¹

What's in a name? That which we call a rose
By any other name would smell as sweet;

As this case shows, the answer is quite a lot, especially for one as well-known as Harvard.

2 The present appeal arises from the decision of the learned Principal Assistant Registrar (“the PAR”) in *Harvard Club of Singapore v President and Fellows of Harvard College* [2019] SGIPOS 14 (“the GD”) where the PAR

¹ Romeo and Juliet, Act II, Scene II.

dismissed the appellant's opposition to the respondent's application to register two trade marks as tabulated below:

S/N	Trade marks	Registration no.	ICGS class and specification
1	HARVARD CLUB OF SINGAPORE	40201402804X	Class 41: Club Services [education or entertainment]
2	HARVARD UNIVERSITY CLUB OF SINGAPORE	40201402805W	Class 41: Club Services [education or entertainment]

3 For ease of reference, I will refer to the subject of trade mark application Nos. 40201402804X and 40201402805W as the first and second Application Mark respectively (collectively, “the Application Marks”).

4 After hearing both parties and considering their written submissions, I dismiss the appeal and allow both trade mark applications to proceed to registration. These are the reasons for my decision.

Facts

5 I begin with a summary of the basic facts, which are largely taken from the GD. More detailed discussion of the facts will be set out below where relevant.

The Parties

6 The appellant, Harvard Club of Singapore, has served the Harvard alumni in Singapore for close to 50 years. It was registered as a society on 26

May 1969² and up until 2015, it was recognised as the *only* official Harvard alumni club in Singapore with all the attendant benefits that followed. As the first Application Mark takes the same name as the appellant, I will refer to the appellant as “the Club” to avoid any confusion.

7 The respondent, President and Fellows of Harvard College (“the University”), is the body corporate which constitutes Harvard University.³ As one of the top ranking universities in the world, the strength of the “HARVARD” brand is such that Harvard University needs little introduction. Each academic year, students from more than 125 countries enrol in its courses, including more than a hundred students from Singapore.⁴

8 The international appeal of Harvard University is not restricted to its academic prowess. Indeed, as the PAR aptly puts it (GD at [3]):

Part of Harvard University’s attraction lies in the fact that some of the best and brightest pass through its halls. Graduates enjoy access to alumni networks through, among other things, various Harvard Clubs. Indeed, with very limited exceptions, only Harvard graduates may be a member of a Harvard Club. There are over 195 Harvard Clubs located throughout the world. They are supported by the Harvard Alumni Association, or “HAA”, an office within the University.

² Irene Lee Siew Mun’s 1st Statutory Declaration (“SD”) (Lee’s 1st SD) at para 6.

³ Enrique Calixto’s 2nd SD (“Calixto’s 2nd SD”) at para 6.

⁴ GD at [2].

9 The Harvard Alumni Association (“HAA”) provides support and resources to official Harvard alumni clubs (“Harvard Clubs”) around the world. In particular, it operates two key websites:

(a) The Harvard Alumni website (<http://alumni.harvard.edu/haa/clubs-signs>) which contains, *inter alia*, the HAA Club Requirements. These state that Harvard Clubs are required to satisfy certain fundamental criteria known as HAA Club Standards in order to retain their official affiliation with the University. For example, Harvard Clubs must submit a President’s Annual Report and an Officer Listing annually in order to “be in compliance with the HAA and to receive HAA services” such as website hosting, a post.harvard.edu club email forwarding address and invitations to the HAA’s annual Alumni Leadership Conference.

(i) The HAA Club Standards are also found in the current HAA Club Officer Handbook⁵ (“the Handbook”) which is intended to provide guidelines and resource information for starting a Harvard Club. There is evidence that such handbooks have been given to fledging Harvard Clubs as far back as 1969 (see [67] below).⁶

(b) The Officers’ Lounge website (<http://officerslounge.clubs.harvard.edu>) which contains the fundamental operating guidelines under which the HAA expects

⁵ Philip Lovejoy’s (“Lovejoy”) SD at Annex 17 pp 746 – 747.

⁶ Lovejoy’s SD at Annex 10 p 196.

Harvard Clubs to function (“the Guidelines”).⁷ Among other things, the Guidelines explicitly state that:

- A. The *University grants Harvard Clubs permission to use the "Harvard Club" name*. Harvard Clubs need to comply with policies set forth in ... the Harvard Trademark Program's website at <http://www.trademark.harvard.edu/> ...
 - ...
 - C. Harvard Club Presidents shall not serve more than three consecutive years. ...
 - ...
 - F. Non-compliance with HAA and University policies and standards may result in the *Club's loss of the right to use the 'Harvard' name*.
 - G. The HAA shall be notified promptly of any changes in the Club officers and directors ...
- [emphasis added]

10 The relationship between the Club and the University dates back to the first days of the Club’s founding in 1969. However, this came to an end on 29 May 2015, when the Executive Director of the HAA, Mr Philip Lovejoy, officially terminated the relationship between the Club and the University and revoked its status as an official Harvard Club. The official termination letter states that:⁸

The University is also *withdrawing its consent* for the Club to use the names "Harvard" and "Harvard Club", the "VERITAS" shields, and all other University names and logos. This means that you must immediately stop any Club use of Harvard names and logos, and that any registration you have made of any Harvard name or logo for any such purpose must be cancelled immediately.

⁷ Lovejoy’s SD at Annex 8 p 191.

⁸ Lovejoy’s SD at Annex 12, p 387.

... the University reserves the right to recognize and appoint another club as the official Harvard alumni club in Singapore.

[emphasis added]

A brief background to the dispute

11 The official termination letter dated 29 May 2015 was the culmination of a year-long dispute that took place during Dr Lee Siew Mun Irene’s (“Dr Lee”) tenure as president of the Club. A detailed account of the facts pertaining to the dispute can be found at [6] – [9] of the GD.

12 For present purposes, it suffices to say that the dispute began in April 2014 when the HAA started to take steps to secure a change of leadership in the Club. Dr Lee resisted the HAA’s attempts and stood again for presidency in the Club’s November 2014 elections. She subsequently won a second term.

13 In the midst of the dispute, the University took steps to consolidate its position and applied to register the Application Marks on 24 December 2014.⁹ The Club mounted two opposition actions (later consolidated into one)¹⁰ in respect of the Application Marks and relied upon the following grounds under the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”) at the hearing before the PAR:

Ground of Opposition	Application Marks
TMA s 8(7)(a): Passing off	HARVARD CLUB OF SINGAPORE
	HARVARD UNIVERSITY CLUB OF SINGAPORE

⁹ Respondent’s Submissions at para 16.

¹⁰ GD at [11].

Ground of Opposition	Application Marks
TMA s 7(6): Bad faith	HARVARD CLUB OF SINGAPORE
	HARVARD UNIVERSITY CLUB OF SINGAPORE
TMA s 7(5) read with s 4(3)(c) of the Societies Act (“Societies Act”) (Cap 311, 2014 Rev Ed): Use prohibited in Singapore by written law or rule of law	HARVARD CLUB OF SINGAPORE

14 The University subsequently sought to register the name “HARVARD UNIVERSITY CLUB OF SINGAPORE” with the Registry of Societies¹¹ but was refused registration on the basis that the new society’s name was too similar to the existing registration of the Club. A group of the University’s alumni, with the full authorisation of the HAA, proceeded to register the Singapore branch of the new official Harvard Club under the name “HARVARD UNIVERSITY ASSOCIATION OF ALUMNI IN SINGAPORE” on 7 December 2015. I will refer to the new club as “HUAAS”.

The decision of the PAR

15 In his GD, the PAR dealt with a larger list of issues (both procedural and substantive) than is relevant for the purposes of this judgment. I will thus summarise his decisions only on the relevant grounds, namely the substantive grounds of opposition laid out at [13] above.

¹¹ Lovejoy’s SD at para 57 and Annex 22.

The PAR’s findings in relation to s 8(7)(a) of the TMA

16 The PAR dismissed the opposition under s 8(7)(a) of the TMA as he found that the goodwill generated by the Club in connection with its use of the Application Marks belongs to the University by virtue of an implied licence. In this regard, the Club was a “mere licensee” of the University, thereby allowing it to use the University’s trade marks including, *inter alia*, “HARVARD” and “HARVARD CLUB” (GD at [79] - [80]).

17 The PAR reasoned that the default position in law is that ownership of the goodwill remains with the University unless there was an agreement otherwise (GD at [83]). As there was no agreement for the goodwill to accrue to the Club, the Club did not enjoy the goodwill connected with the Application Marks. The first element of the tort of passing off was not made out and he thus rejected the Club’s opposition under s 8(7)(a) of the TMA (GD at [88] – [89]).

18 While the PAR’s remarks in relation to the tort of passing off were primarily addressed at “HARVARD CLUB OF SINGAPORE”, they should be read as pertaining also to “HARVARD UNIVERSITY CLUB OF SINGAPORE”, by virtue of the similarity in the names.

The PAR’s findings in relation to bad faith under s 7(6) of the TMA

19 The PAR rejected all the following three lines of argument that the Club raised as evidence of the University’s bad faith in registering the Application Marks under s 7(6) of the TMA: (1) that the Application Marks were filed by the HAA in the University’s name but without the University’s authority; (2) that there was dishonest, improper or some form of unacceptable conduct falling

within the scope of bad faith; and (3) that the Applicant had filed for two trade marks at the same time without a *bona fide* intention to use them.

20 After reviewing the evidence, the PAR rejected the first argument “without any hesitation whatsoever” as there was no evidence of this (GD at [96]).

21 Given his earlier finding that the University owns the goodwill attached to the Application Marks, the PAR decided that the Club’s rights to use the name “HARVARD CLUB OF SINGAPORE” were contingent on the University’s continued recognition of affiliation. The University has the right to file for the Application Marks, and it could exercise this at any time, including prior to the termination letter (GD at [98]).

22 The third argument was rejected on the basis that trade marks and society names are different. Even though the University would not be able to register both names as societies in the Registry of Societies, this does not mean that the University does not intend to use the Application Marks. Further, there is no rule to say that a registered trade mark proprietor must use its marks immediately (GD at [100]).

The PAR’s findings in relation to s 7(5) of the TMA read with s 4(3)(c) of the Societies Act

23 This ground pertained solely to the first Application Mark, “HARVARD CLUB OF SINGAPORE”. The PAR rejected it on the basis that the Club’s case could not fulfil the two constituent elements under s 7(5) of the TMA.

24 Section 7(5) of the TMA reads:

Absolute grounds for refusal of registration

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

25 The PAR opined that the word “use” under s 7(5) of the TMA must be targeted at the “actual use” of a trade mark and would not cover the mere registration of a society under the Societies Act. Further, the discretion of the Registrar of Societies under s 4(3)(c) of the Societies Act to refuse to register a specified society does not amount to a prohibition under “written law or rule of law” prohibiting the use of a name or mark in Singapore under s 7(5) of the TMA.

26 The Club’s opposition thus failed on all grounds before the PAR.

Issues – Grounds of Opposition

27 The broad issues before me are whether the PAR erred in dismissing the Club’s opposition based on passing off under s 8(7)(a) of the TMA, bad faith under s 7(6) of the TMA, and use prohibited in Singapore by written law or rule of law under s 7(5) of the TMA read with s 4(3)(c) of the Societies Act (see [13] above).

28 Within these broad issues, various sub-issues arise for consideration. Given the nature of the claims and the variety of issues canvassed before me, I will deal with each ground of opposition in a discrete section in this judgment, beginning first with the tort of passing off.

***Preliminary point: the nature of an appeal to the High Court from
the Trade Mark tribunal***

29 It is important to state at the outset that the applicable standard of review is that of a *de novo* hearing (*Monster Energy Company v Glamco Co, Ltd* [2018] SGHC 238 at [44] (“*Monster Energy*”). Order 87 r 4(2) of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) provides that an appeal from the Trade Mark Registry “shall be by way of rehearing and the evidence used on appeal shall be the same as that used before the Registrar and, except with the leave of the Court, no further evidence shall be given.” This was interpreted by the Singapore Court of Appeal (“CA”) in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 at [15] to mean that the appellate court is to hear the matter afresh with “no threshold requirement of general application that ‘a material error of fact or law’ ... be shown before appellate intervention is warranted in such appeals.”

30 Be that as it may, I am not precluded from adopting the PAR’s findings of fact and analyses where they accord with my own views (*Monster Energy* at [44]).

Issue 1: Passing off

The law on passing off

31 Section 8(7)(a) of the TMA is a relative ground for the refusal of registration and states as follows:

Relative grounds for refusal of registration

8.—(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;

32 To succeed under this ground of opposition, the Club must be able to establish the three classical elements of passing off (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) at [27] – [28]), namely:

- (a) goodwill;
- (b) misrepresentation; and
- (c) damage.

33 The burden of proof lies upon the Club which must adduce sufficient evidence to establish, at the very least, a *prima facie* case of passing off (*Monster Energy* ([29] *supra*) at [91]).

34 As the Club’s case in respect of passing off raises interesting questions of law in relation to implied licences and the ownership of goodwill, a large part of my analysis will be devoted to elucidating the nature and principles of goodwill.

Goodwill

35 The tort of passing off is aimed at protecting the goodwill between a trader and his customers and is not directly concerned with protecting a specific mark, logo or get-up of a business (*The Singapore Professional Golfers’ Association v Chen Eng Waye and others* [2013] 2 SLR 495 at [21] (“*SPGA*”). The clearest and most oft-cited definition of goodwill is found in *The*

Commissioners of Inland Revenue v Muller & Co's Margarine, Limited [1901]

AC 217 at 223–224:

... [Goodwill] 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 which 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 a power of attraction sufficient to bring customers home to the source from which it emanates.

36 Two essential features of goodwill can be distilled from the above paragraph as the CA in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 observed at [39]:

... First, it is the association of a good, service or business on which the plaintiff's mark, name, labelling, *etc* (referred to generically as the plaintiff's 'get-up') has been applied with a particular source. Second, this association is an 'attractive force which brings in custom' ...

37 The protection that the tort of passing off confers can extend to the goodwill that non-commercial organisations such as charities, non-profit golfing associations and indeed, even the Club may have. As the CA in *SPGA* explained at [23], this arises because:

... Such associations typically benefit from and indeed depend upon 'voluntary membership, subscriptions, donations or support' (*The Law of Passing-Off* at para 3-022). Such support reflects the magnetic force of the particular association in question, and this constitutes goodwill which can be damaged by a misrepresentation that amounts to passing off ...

38 Before me, the following points were undisputed (mirroring the points of agreement in [48] of the GD):

- (a) The University owns approximately 750 registered trade marks containing the words “HARVARD” and “HARVARD CLUB” worldwide including in Singapore.¹² In Singapore, the University has registered, *inter alia*, “HARVARD”, the VERITAS shield and “HARVARD UNIVERSITY PRESS”. I will refer to the University’s marks (whether registered in Singapore or overseas) as “Harvard Marks”. The goodwill generated in connection with the Club’s use of the Singapore registered marks belongs to the University.¹³
- (b) The relevant segment of the public would primarily be composed of actual and potential Harvard alumni.¹⁴
- (c) The Club’s activities and services have generated goodwill.¹⁵

¹² Lovejoy’s SD at para 29, see in particular p 451.

¹³ Lovejoy’s SD at para 29; Club’s Submissions at paras 19.3, 34 and 35.

¹⁴ Club’s Submissions at para 17.1(a);

¹⁵ Club’s Submissions at para 19; University’s Submissions at para 47.

39 The Club argues that it is the owner of the abovementioned goodwill on the basis that:

(a) The goodwill connected to the Harvard Marks and the Application Marks are separate and distinct. The names “HARVARD CLUB OF SINGAPORE” and “HARVARD UNIVERSITY CLUB OF SINGAPORE” are indivisible.¹⁶ The Club “is claiming goodwill only over the full descriptive term ‘HARVARD CLUB OF SINGAPORE’, and not the term ‘HARVARD’ without more”.¹⁷

(b) While the University is a well-known organisation that owns the Harvard Marks, this does not mean that it is the exclusive owner of all goodwill generated in connection with all use of the many variations of trade marks incorporating the Harvard Marks (citing *Harrods Limited v Harrodian School Limited* [1996] EWCA Civ 1315 (“*Harrods*”)).¹⁸

(c) The Application Marks are descriptive in nature and the goodwill generated by the Club’s use of the mark “HARVARD CLUB OF SINGAPORE” accrues to the Club by virtue of its registration with the Registry of Societies in 1969 and was “subsequently earned through many years of activities and events organised for the benefit of Harvard [a]lumni in Singapore”.¹⁹

¹⁶ Hearing recording on 14 Feb 2020 at 11:30.

¹⁷ Club’s Submissions at para 19.4.

¹⁸ Club’s Submissions at 19.6.

¹⁹ Club’s Submissions at 19.7(b).

40 The cornerstone of the Club’s submissions is that it is a separate entity that exists and operates independently from the University and the HAA.²⁰

41 In response, the University argues that it owns the goodwill generated through the use of the Application Marks on two alternative grounds:

(a) First, by virtue of an implied licence.

(i) An implied licensor-licensee relationship exists between the University and the Club because the University exerted a degree of control and/or supervision over the Club’s operations and use of the Application Marks.²¹

(ii) It is trite law that in the absence of any agreement to the contrary, the default position is that the licensor is the owner of the goodwill.²² No such agreement exists.²³

(b) Second, on account of the fact that the relevant public associates or identifies the services and activities of the Club with the University. The University also draws an analogy between franchisor-franchisee and distributor-manufacturer relationships and the present case.²⁴

²⁰ Club’s Submissions at para 19.1.

²¹ University’s Submissions at paras 33 – 42.

²² University’s Submissions at paras 46 - 47.

²³ GD at [54].

²⁴ University’s Submissions at paras 49 - 66.

(1) The importance of precision in the goodwill analysis

42 Before turning to my decision on goodwill, I find it apposite to emphasise the importance of precision in the language used as part of the goodwill analysis.

43 It bears firm repeating that “[t]he goodwill relevant in a passing off action is not in the mark, logo or get-up. It is the goodwill between a trader and his customers which is protected by this tort” (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [45]). In other words, the relevant goodwill is the attractive force that draws the relevant public to the business of the Club as an alumni club *ie*, the services provided and activities organised by the Club for the actual and potential alumni of the University. Any references to goodwill should be construed in this light.

44 Per the CA in *SPGA* at [27], the Application Marks are relevant to the tort of passing off because:

The goodwill that subsists in relation to an organisation’s business is commonly associated with its name, or its sign or other badge of identity because this becomes a proxy for the organisation, and the name or badge in question serves to distinguish the products or services of that organisation from those of another.

45 In their submissions on goodwill, parties have used terms like “goodwill in the Harvard Marks”²⁵ and “goodwill in the name ‘HARVARD CLUB OF SINGAPORE’”.²⁶ This gives the impression that they are concerned not specifically with the goodwill in the Club’s business as a whole but with

²⁵ University’s Submissions at paras 33 and 46.

²⁶ Club’s Submissions at paras 19, 19.2 and 19.4.

whether the Club had acquired goodwill in the names “HARVARD CLUB OF SINGAPORE” and “HARVARD UNIVERSITY CLUB OF SINGAPORE”.

46 The use of such terms as part of the goodwill ownership analysis runs dangerously close to importing the concept of distinctiveness back into the goodwill inquiry. This is because distinctiveness, as part of the misrepresentation inquiry, specifically looks at whether the relevant public associates the mark, get-up or any other claimed badge of origin (eg, the Club’s name “HARVARD CLUB OF SINGAPORE”) with the goodwill (see *Singsung* ([32] *supra*) at [39] citing *SPGA* ([35] *supra*) at [20]).

47 This should be avoided as it is contrary to the express guidance of the CA that the distinctiveness inquiry should be dealt with solely at the misrepresentation stage (see *Singsung* ([32] *supra*) at [38] – [39] and *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 (“*AMC*”) at [82] - [83]).

48 Bearing this caution in mind, I now consider the issue of goodwill.

(2) My decision on goodwill

49 In a large majority of cases, it is unnecessary to undertake a separate inquiry on goodwill ownership once goodwill has been found to exist on the facts. This is because the entity whose business as a whole generates the goodwill will often be the undisputed owner. The question of ownership arises when there are rival claims to goodwill, for example as between a licensor and a licensee or a manufacturer and its distributor (see Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) (“*Ng-Loy Wee Loon*”) at paras 17.6.1 to 17.6.3).

50 In the present case, parties are in agreement that the Club’s activities and services have generated goodwill. The dispute centres around who owns it.

51 I agree with the University that the Club has no goodwill with which to sustain an opposition based on the tort of passing off. In arriving at my decision, I am aided by the PAR’s meticulous and detailed analysis of the facts.

52 Taking each of the University’s arguments in turn, my reasons will be structured as follows:

- (a) First, whether an implied licence exists on the facts of this case.
- (b) Second, whether the presence of an implied licence *ipso facto* means that the ownership of the goodwill vests in the licensor.
- (c) Third, who owns the relevant goodwill on the facts?

(A) WHETHER AN IMPLIED LICENCE EXISTS AS BETWEEN THE CLUB AND THE UNIVERSITY

53 I agree with the PAR that the Club and the University were in a trade mark licensor-licensee relationship in relation to the Harvard Marks including “HARVARD” and “HARVARD CLUB”.

54 Unlike most other commercial arrangements, the present case is unique in that there was no formal signed trade mark licence agreement.²⁷ The University thus resorted to the implied licence argument.

²⁷ GD at [54].

55 By way of background, a trade mark licence is often said to be the grant of permission by the proprietor for the use of the trade mark by a third party. It is often, but not necessarily, in the form of an agreement that is subject to the laws of contract. In other words, it is the licence that prevents the third party (*ie*, the licensee) from infringing on the trade mark or being liable in passing off while the contract (if any) spells out how parties are to carry out the agreement (see Neil J Wilkof & Daniel Burkitt, *Trade Mark Licensing* (Sweet & Maxwell, 2nd Ed, 2005) (“*Wilkof & Burkitt*”) at paras 1-10 and 10-02).

56 An implied licence is an unwritten licence often thought to arise from the conduct and actions of parties (*Wilkof & Burkitt* at para 11-02). In the UK, implied licences have been found to exist even in cases of unregistered marks (see *eg*, *Harrods Ltd v Harrods (Buenos Aires) Ltd* [1999] F.S.R 187).

57 It is important to note that strictly speaking, an unregistered trade mark is not in itself a species of property. What is licensed is the right to use the mark in a manner which the tort of passing off would otherwise prevent (Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (5th Ed) (“*Wadlow*”) at para 7-93).

58 Some of the University’s Harvard Marks *eg*, “HARVARD”, were only registered in Singapore starting from 1991, more than 20 years after the Club’s registration as a society in 1969.²⁸ Further, not all of the various types of Harvard Marks that the University owns, have been registered in Singapore. For example, the mark “HARVARD CLUB” is registered in Europe (European

²⁸ Lovejoy’s SD at Annex 15, p 564.

Trade Mark Registration No. 007049661) but not in Singapore.²⁹ However, I agree with the PAR and adopt his view that the late registration or non-registration of the various Harvard Marks in Singapore (GD at [81]):

... does not undermine [any] finding of a licensor-licensee relationship in any way, because the term trade mark license is wide enough to encompass common law rights as well. As such, when I use terms such as “trade mark license” or “licensor-licensee relationship”, what I really mean is that in addition to any license relating to registered rights, the terms of the license also cover any use by the [Club] of [the Harvard Marks] in any manner that would otherwise amount to passing off.

59 In *Weir Warman Ltd v Research & Development Pty Ltd* [2007] SGHC 59 (“*Weir Warman*”), V K Rajah JA reviewed the authorities and concluded that “a trade mark licence arrangement between the plaintiff and the defendant may only be established if the *plaintiff exerts some manner or form of control or supervision over the defendant’s goods. ...*” [emphasis mine] (at [68]). He added that in applying this test, it is necessary to have regard to the objective conduct of the parties (at [67]).

60 For completeness, I have also had regard to the contrary view in Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 3rd Ed, 2014) at para 10.059 (“*Tan Tee Jim*”), that the above remarks by V K Rajah JA were actually made in the context of the Trade Marks Ordinance 1938 (Ordinance 38 of 1938) (derived from the Trade Marks Act 1938 (c 22) UK) and are now outdated. That said, I am bound by two recent CA judgments that expressly cite the above test in the context of the TMA (see *Kickapoo (Malaysia) Sdn Bhd and another v The Monarch Beverage Co (Europe) Ltd*

²⁹ University’s Submissions before the PAR dated 17 June 2019 at para 26.

[2010] 1 SLR 1212 at [41] and *Valentino Globe BV v Pacific Rim Industries Inc* [2010] SGCA 14 (“*Valentino*”) at [45]).

(I) *THE UNIVERSITY’S CONTROL AND SUPERVISION OF THE CLUB*

61 Turning to the facts of this case, I adopt the PAR’s finding that the University exerted control and supervision over the Club for four reasons.

62 First, the founders of the Club intended for the Club to operate under the auspices of the University and the Associated Harvard Alumni (HAA’s predecessor).³⁰ In early 1969, a group of approximately 30 Harvard alumni in Singapore took steps to form the Club.³¹

(a) On 20 February 1969, the group’s acting secretary, Mr Michael Wilsey, wrote to the Associated Harvard Alumni informing it of the group’s intention to form the Club and asking it for:³²

... guidance as to how [the group] might conduct [its] affairs and gain recognition from the Alumni Association. Information on the procedures and activities of other clubs could be most helpful.

³⁰ Lovejoy’s SD at para 8.

³¹ Lovejoy’s SD at Annex 10.

³² Lovejoy’s SD at Annex 10 p 194.

(b) No reply was received and Mr Wilsey wrote again a month later on 3 April 1969. The letter stated that:³³

... [the group's] needs for direction from [the Alumni Association] are even more urgent. We would be most appreciative of some word from you as to *what steps we must take to be recogni[s]ed as a Harvard Club.*

[emphasis added]

63 A reply from the Associated Harvard Alumni was only sent on 29 May 1969, by which time the Club's founders had already registered the Club as a society. During the hearing, the Club's counsel leveraged on this point to bolster his argument that the Club's existence is separate and independent from the University.³⁴

64 In my view, this fact does not go very far to assist the Club's case. A quick perusal of Mr Wilsey's letters makes three things apparent about the Club's founders:

- (a) They were willing and eager to abide by the University's conditions in return for recognition as a Harvard Club.
- (b) They "regarded the University as the fount of authority for their fledging club" (GD at [79(b)]).
- (c) They only went ahead with the registration after repeated attempts to gain recognition from the University.

³³ Lovejoy's SD at Annex 10 p 195.

³⁴ Hearing recording on 14 February 2020 at 11:15 – 11.19 am.

To me, this is apodictic evidence that the Club was *inviting* the University to control *and* supervise it.

65 At best, the facts show that the Club did not have a licence at its inception but that does not preclude it from having obtained one later on. The logical corollary to this is that the Club might have been making *unauthorised use* of the Harvard name and thus infringing on the University's rights in respect of it prior to receiving the reply from the Associated Harvard Alumni dated 29 May 1969.

66 Second, focusing on the time period prior to Dr Lee's presidency, it is clear that the Club was aware of the basic conditions it had to fulfil in order to maintain its affiliation with the University and complied with them.

67 Upon receiving news of the Club's founding in 1969, the Associated Harvard Alumni sent the Club a sample Constitution, a 1969 version of the Handbook and a sample annual report.³⁵ While the 1969 Handbook is not available to me, the 2017 edition makes it compulsory for Harvard Clubs to submit President's Annual Reports and Officer Listings.³⁶ The Club was aware of these requirements and did in fact abide by them (at least some of the time) from 1969 till Dr Lee's presidency.

(a) On 25 March 1971, the Club wrote to update the Associated Harvard Alumni on the list of officers in the Club.³⁷

³⁵ Lovejoy's SD at Annex 10 p 198.

³⁶ Lovejoy's SD at Annex 17 p 747.

³⁷ Lovejoy's SD at Annex 10 p 198.

(b) In 1973, the University sent Mr Isadore Paisner to check on the progress and management of various clubs in the “Far East” region including the Club. Mr Paisner reported that the leadership of the clubs “is uniformly good” and that they hold frequent club meetings. He also said that “[t]he Singapore Club also appears to have good material waiting to take over”. It is quite unlikely that Mr Paisner would praise the Club if it had been wilfully flouting the University’s rules and policies.³⁸

(c) On 9 January 1975, the Club’s president informed the University that the Club had received and perused the 1975 Handbook.³⁹

(d) The Club submitted President’s Annual Reports for eight years leading up to 2011.⁴⁰

(e) On 25 July 2011, approximately five months prior to Dr Lee’s presidency, the University conducted a survey aimed at gathering information on the operations of various Harvard Clubs. Amongst other things, the survey was designed to test their presidents’ understanding of HAA guidelines and procedures. As astutely observed by the PAR, the Club stated correctly that the presidential term limit is three years when such information is not found in the Club’s constitution and bylaws but is present in the Guidelines and Handbook.⁴¹ This betrays at least some knowledge of the above materials on the Club’s part.

³⁸ Lovejoy’s SD at Annex 10 pp 202 - 205.

³⁹ Lovejoy’s SD at Annex 10, p 207.

⁴⁰ Lovejoy’s SD at para 20, Adrian Foo’s SD at para 6.

⁴¹ Dr Lee’s SD 1, Exhibit ILSM -1.

68 In light of the evidence above, I am satisfied that from the time of the Club's founding up till Dr Lee's presidency, the University was able to exert a degree of control *and* supervision over the Club's activities. This was done by ensuring that the Club received updated copies of the Handbook, sending down university officials such as Mr Paisner to check on the Club's management, and mandating that the Club provide Officer Lists and President's Annual Reports.

69 Third, during the first three years of Dr Lee's presidency from 2011 to 2014, the Club continued to seek the University's guidance in relation to Club affairs and was at least, fully aware of the conditions imposed by the University on all Harvard Clubs.

70 On 17 November 2011, a mere two days after Dr Lee was elected as president, she wrote to the HAA introducing herself and asking for guidance in relation to her presidency and the Club's direction. She also sought support from the University to be involved in its events. Her email reads:⁴²

... We had our AGM on 15.11.11 and I've succeeded Nina as the new President of the Harvard Club of Singapore. What is the official protocol to effect this change with the HAA and locally? Do I need to send out an announcement to the HCS members / alumni? Who can I turn to for guidance in order to solve problems with membership, communication/website, governance etc.?

It will be interesting to try and organi[s]e the live webstreaming of this Saturday's Harvard Yale football game – can you please send the login credentials if convenient? ...

⁴² Lovejoy's SD, Annex 11, p 224.

71 Contrary to Dr Lee’s assertions that the Club always operated independently from the University,⁴³ the above extract shows that it was important to her that she was *officially recognised* as president not just by members of the Club but also by the HAA.

72 In a bid to bolster the Club’s case, Dr Lee claimed that she only found out about the existence of the Handbook and the Guidelines in April 2014, more than two years into her presidency.⁴⁴ This is important because the Handbook contains fundamental conditions that a Harvard Club must comply with to retain its affiliation with the University and the Guidelines explicitly state that “[t]he University grants Harvard Clubs permission to use the ‘Harvard Club’ name”. Her assertions are unsubstantiated and wholly unbelievable for the following reasons:

(a) Email correspondence between Dr Lee and the HAA on 13 to 14 December 2011⁴⁵ show that Dr Lee was personally involved in setting up the Club’s official website (www.harvardclub.sg). For example, she contacted graphic designers, reserved the domain name and sought permission from HAA to create links in the said website to HAA’s websites. It is evident from the correspondence that Dr Lee is a proactive president who takes her role seriously. This being the case, it is highly improbable that she would simply list links to external webpages on the Club’s official website without at least checking the contents therein.

⁴³ Dr Lee’s SD at paras 8 - 11.

⁴⁴ Dr Lee’s SD at para 11.

⁴⁵ Lovejoy’s SD at Annex 11 pp 235 – 237.

(b) Dr Lee accessed HAA’s websites in order to create links therein to the Club’s official website.

(c) Dr Lee admitted that she has been a regular attendee of Harvard alumni leadership conferences and club leaders meetings where she familiarised herself with the HAA’s activities.⁴⁶ Topics such as “leadership best practices” and “transitioning leadership” were specifically addressed at several of those meetings.⁴⁷ It is unlikely that Dr Lee would have taken the time and effort to attend such conferences overseas without at least reviewing key (and easily accessible) HAA leadership documents like the Guidelines and Handbook.

(d) Dr Lee also took pains to inform HAA representatives about the agenda of the Club’s Executive Committee meetings.⁴⁸

(e) Finally, email correspondence from 11 April 2012 to 8 May 2012 show that Dr Lee would inform the HAA when she wanted to make changes to the Club’s Executive Committee and even sought advice for her problems with the existing members.⁴⁹ Much like the three year term limit for presidents (see [67(e)] above), her actions are in line with the Guidelines (see [9(b)] above) which are not found in the Club’s Constitution and by-laws.

⁴⁶ Dr Lee’s 1st SD at para 3.

⁴⁷ Lovejoy’s SD at para 44 and Annex 11 pp 246 and 275.

⁴⁸ Lovejoy’s SD at Annex 11 pp 258 – 259, 290.

⁴⁹ Lovejoy’s SD at Annex 11 pp 331 – 335.

73 Accordingly, I reject Dr Lee’s unsubstantiated claim of ignorance. I find that she was fully aware of the minimum conditions the Club needed to fulfil to remain a Harvard Club and complied with at least some of them during her presidency.

74 Finally, I agree with the PAR that while the Club may not have described its relationship with the University as a licensor-licensee relationship, “the parties certainly conducted their affairs as such.”⁵⁰

75 In return for the Club’s compliance with the terms of affiliation in the Guidelines and the Handbook, the University (through the HAA) provided continual support and guidance. As the PAR succinctly puts it at [73] of his GD:

Peppered across the documentary exhibits annexed to Lovejoy’s SD was evidence (e.g. relating to technical support, lists of alumni in Singapore and other contact information) that the Applicant had actively supported the Harvard Club of Singapore. ... if the HAA had not provided the Opponent with personal information of Harvard alumni in Singapore, the Opponent would not have been able to effectively perform its role as the official recognised alumni association.

76 Mr Lovejoy also makes clear that if any entity uses the name “HARVARD CLUB OF [location]” without being officially affiliated to the University, the University would have taken action immediately because its alumni would immediately associate the entity with an official Harvard Club. No such action has ever been taken against the Club because it was an official Harvard Club up till the termination of the relationship on 29 May 2015. I have reviewed the names of the various Harvard Clubs and I note that all Harvard Clubs in the Asia-Pacific and South Asia region (apart from the new official

⁵⁰ GD at [79].

club in Singapore) adhere to the standard nomenclature of “HARVARD CLUB OF [location]”.⁵¹ In fact, given that nearly all Harvard Clubs worldwide are named as such, I see no reason to disbelieve Mr Lovejoy.⁵²

77 On top of that, the Club also conducted itself in a manner that suggests it implicitly acknowledged its status as a trade mark licensee. The clearest example of this occurred when a Harvard alumnus, Mr Oscar Tan, created a Facebook group and LinkedIn page that made use of some of the Harvard Marks without being authorised by the University (for detailed facts see [69] – [72] of the GD). For present purposes, it suffices for me to say that when the Club realised that an interloper was attracting members away from it, its response was to swiftly call upon the University to enforce its rights in the Harvard Marks against Oscar Tan and not to enforce any trade mark rights on its own behalf.⁵³

78 I thus conclude that the University exercised a sufficient degree of control *and* supervision over the Club’s affairs such that the Club had an implied licence to use the Harvard Marks. This implied licence arose when the Associated Harvard Alumni wrote to the Club’s founders to acknowledge the Club’s existence on 29 May 1969. It lasted up till the termination of their relationship on 29 May 2015.

79 Although *Weir Warman* ([59] *supra*) involved a commercial dispute, the test stated therein remains applicable to the present facts. This is because, in formulating the said test, V K Rajah JA expressly cited and approved the US

⁵¹ Lovejoy’s SD at Annex 7, p 178 – 180.

⁵² Lovejoy’s SD at para 10 and Annex 7.

⁵³ Lovejoy’s SD at Annex 11, pp 243 – 244.

case of *Villanova University v Villanova Alumni Educational Foundation, Inc* 123 F Supp 2d 293 (E.D. PA. 2000) (“*Villanova*”), a case involving similar facts. There, a group of alumni sought Villanova University’s permission to use its trade mark to form a club that conducted fundraising activities in support of the university’s sports programs. The alumni group was given verbal permission to do so by the president of the university in 1972. This was followed by a formal affiliation agreement only much later in 1992 and finally a revised agreement in 1995. The court however found, based on the objective conduct of the parties, that the university exercised a sufficient degree of control over the club’s operations such that an implied licence existed between 1972 and 1992, which encompassed the club’s use of the university’s trade mark. This was because the club generally followed the guidelines imposed on it by the university. The university would also take steps to update the guidelines and enforce them (albeit with a gentle hand) in the event of violations. The court also found that the 1992 and 1995 affiliation agreements made express the previously implied licence agreement between the parties.

80 An implied licence between the University and the Club can therefore arise out of the objective conduct of the parties for the use of the Harvard Marks even where the parties had not entered into a written and signed licence agreement.

(II) *IF SO, WHAT KIND OF IMPLIED LICENCE IS THIS?*

81 The above paragraphs make it clear that the implied licence was in relation to the use of the Harvard Marks including “HARVARD” and “HARVARD CLUB”. This was by virtue of the Club’s old status as a Harvard Club.

82 Moreover, this licence is a limited and exclusive one.

83 It is limited in that the licence only covered the sphere of activities and operations of a Harvard Club. It is conceivable that an authorised distributor of the University could set up shop in Singapore to sell authentic “HARVARD” sports jerseys.

84 It is exclusive as the Club appears to have been the only entity in Singapore authorised to use the Harvard Marks (in particular “HARVARD CLUB”) as a Harvard Club. It acted as if this licence was to the exclusion of all others, including the University itself (see s 43(1) of the TMA). I say so for two reasons.

85 First, both parties agree that the Club was the first and only Harvard Club in Singapore for close to 50 years. While there are now two new societies on the Registry of Societies that incorporate Harvard Marks into their names (Harvard Business School Club of Singapore and HUAAS), the earlier one was only registered on 28 January 2015. While the Club’s implied licence was only revoked on 29 May 2015 (see above at [78]), the relevant date for the purposes of assessing a claim of passing off is the date on which the complained of conduct of the University commences (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [34]). In the present case, the complained of conduct would have commenced, at the latest, when the University sought to register the Application Marks on 24 December 2014. The Club was thus the sole entity authorised to use the University’s Harvard Marks in Singapore during the relevant period.

86 Second, as mentioned above, the Club took swift action to call upon the University to enforce its trade mark rights the moment it felt that its position as the sole Harvard alumni organisation in Singapore was threatened by Mr Oscar Tan in late 2011. Emails from a HAA director, Mr Peter Weldon, show that University sided with the Club and offered solutions to safeguard the Club's position. This is notwithstanding the fact that Mr Oscar Tan is also a Harvard alumnus.⁵⁴ The conduct of the parties is thus consistent with that of an exclusive licensor-licensee relationship.

(B) WHETHER THE EXISTENCE OF AN IMPLIED LICENCE *IPSO FACTO* MEANS THAT THE LICENSOR OWNS THE GOODWILL

87 I now turn to the follow up question of whether the existence of an implied exclusive licence *ipso facto* means that the licensor owns all the relevant goodwill.

88 As mentioned above at [17], the PAR answered this question in the affirmative at [83] of the GD:

The law on ownership of goodwill in licensor-licensee situations *appears to be well settled*. In the absence of some sort of agreement to the contrary, the *default position is that the licensor or franchisor is the owner of the goodwill*.

[emphasis mine]

89 In support of this proposition, the PAR cited two paragraphs from *Wadlow* which deal with ownership of goodwill in the context of licences and franchises (GD at [83]). I reproduce the former passage as it is more relevant to the present licensing fact scenario:

⁵⁴ Lovejoy SD at Annex 11, p 245

[3-150] If the commercial purpose of an agreement is to license the use of a distinctive name or mark in respect of which the licensor has (or is agreed to have) goodwill, to a licensee with no such goodwill, and in circumstances where the licensee's use would otherwise be actionable as passing-off, then in the *absence of agreement to the contrary or other supervening factors*, the goodwill in the business so carried on by the licensee under the licensed name or mark will accrue to the licensor rather than the licensee. The licence may be express or implied...

[emphasis added]

90 The cited paragraph alludes to the fact-based nature of the ownership inquiry as it includes a consideration of “other supervening factors” alongside the agreement or contract. In my view, in a case where there is no express contract or agreement as to the ownership of the goodwill, it is especially important that one does not end the enquiry by employing a “default position” analysis. Rather, one must have regard to the full factual matrix of a case to determine ownership in an implied licence situation.

91 In this regard, I agree with Lai Siu Chiu J in *QB Net Co Ltd v Earnson Management (S) Pte Ltd and others* [2007] 1 SLR(R) 1 (“*QB Net*”) at [35] that “it would be unwise to rigidly adhere to the general rule that a licensee does not acquire goodwill in respect of the licensor’s business. Instead, regard must be had to the evidence adduced by the parties on the facts.”

92 In *QB Net*, Lai J observed in *obiter* that goodwill could be jointly owned by the foreign licensor and domestic licensee even though there were two licence agreements between them which gave the licensee the right to operate 10-minute hair cut salons under the trade names “QB House” and “QB Shell” and to adopt the QB house system, get up and house marks. Her Honour found that the licensee had contributed significantly to publicity efforts in

Singapore and substantially modified the licensor's instructions manuals to make them suitable for use here.

93 Having reviewed the facts of this case, I have no difficulty in concluding that ownership of the goodwill resides in the University for two reasons.

94 First, the success and continued operation of the Club would not be possible without the help and support of the University. This is because many of the services and activities provided by the Club depend on the University. These manifested in the following ways:

(a) The provision of lists of alumni along with their contract details to the Club to enable it to recruit new members.⁵⁵

(b) The provision of technical support such as website hosting, links on HAA websites and post.harvard.edu club email forwarding addresses (see above at [9(a)]).

(c) The provision of opportunities for Club leaders to learn how to manage the Club and its affairs at leadership conferences.

(d) The provision of direct advice and guidance as to the running of the Club when Dr Lee faced difficulties in this regard.⁵⁶

(e) There is also evidence that the University facilitated the success of key events in the Club's social calendar like the Harvard Club of Singapore Annual Dinner 2012 through providing a gift for the Guest-

⁵⁵ Lovejoy's SD at Annex 11, pp 198, 298 and 367.

⁵⁶ Lovejoy's SD at Annex 11, pp 225, 229, 231, 238 – 239.

of-Honour, memorabilia for guests in the form of 150 Harvard 375th anniversary pins, administrative assistance and publicity on HAA's websites.

(f) Further, without the cooperation of the University, the Club would not be able to host distinguished university officials like Professor Steve Kelman⁵⁷ or solicit donations on behalf of the University.⁵⁸

(g) Importantly, the University (through the Associated Harvard Alumni) helped to ensure the survival of the Club in 1971. At that time, there was only a single officer in the Club, Mr Joseph Zuber, who became uncontactable. The Associated Harvard Alumni thus reached out to one Mr Edward Moriarty to ask him to become the Club's alumnus contact and even offered a list of 16 other alumni in Singapore (*ie*, the relevant public) to help him.⁵⁹

95 Second, the events post-termination do show that the attractive force in the activities and functions of the Club is actually rooted in its connection to the University. Dr Lee gave evidence that Harvard alumni who had recently arrived in Singapore would express interest in the Club but then changed their mind immediately upon realising that the Club is no longer affiliated with the University. To add insult to injury, a current faculty member of the University

⁵⁷ Lovejoy's SD at Annex 11, pp 324, 304 and 295

⁵⁸ University's Submissions at para 55.

⁵⁹ Lovejoy's SD at Annex 10, p 198.

originally arranged to meet with Dr Lee only to abruptly cancel the meeting after realising that the Club is no longer a Harvard Club.⁶⁰

96 With the foregoing facts in mind, I have no difficulty in concluding that the goodwill generated by the Club’s services and activities belongs to the University.

97 For completeness, I will deal briefly with the Club’s remaining argument listed at [39(b)] of this judgment.

98 The Club argues that while the University is well-known, this does not give it the right to lay claim to “every variant that incorporates [its] name”.⁶¹ In support of this, it cites the English case of *Harrods* ([39(b)] *supra*). There, the famed department store, Harrods of Knightsbridge, failed in its action of passing off against a private school called “The Harrodian School” as the business with which Harrods was associated with did not include schools. I agree with the PAR (GD at [85]) that *Harrods* can be distinguished on the facts as it involved two parties in wholly disparate fields of commercial activities whereas the present case involves a school and its alumni club. The fields of activity are both rooted in education and deal with the same select group of individuals. The University is thus entitled to claim the Application Marks.

99 To conclude this section on goodwill, I reject the Club’s arguments and find that the relevant goodwill belongs solely to the University. In the words of the CA in *SPGA* ([35] *supra*) at [20], the Club has failed to establish that it has

⁶⁰ Dr Lee’s SD 1 at para 20.

⁶¹ Club’s Submission at para 19.6.

an interest that the law of passing off will protect. I thus reject the first ground of opposition under s 8(7)(a) of the TMA.

(3) Misrepresentation

100 Strictly speaking, there is no need for me to deal with the elements of misrepresentation and damage. However, as parts of the parties’ cases are built on the use of the Harvard marks and the Application Marks, I will touch briefly on the distinctiveness of the Application Marks as part of misrepresentation.

101 The test of distinctiveness is best understood as a threshold inquiry in the context of determining whether the University, in attempting to register the Application Marks and presumably using it in the future, has committed an actionable misrepresentation. Simply put, if the Application Marks (and more particularly “HARVARD CLUB OF SINGAPORE”) are not distinctive of the Club’s services and activities, the mere fact that the University wishes to use very name of the Club (or something very similar) will not amount to a misrepresentation (*Singsung* ([32] *supra*) at [38]). In other words, the question is whether the goodwill of the Club is sufficiently associated with the Application Marks, the registration of which is being challenged by the Club (*AMC* ([47] *supra*) at [87]).

102 In my view, even on the assumption that the relevant goodwill belongs to the Club, the Club will still fail to prove an actionable misrepresentation as it cannot fulfil the threshold test of distinctiveness. For the avoidance of doubt, my comments here pertain also to “HARVARD UNIVERSITY CLUB OF SINGAPORE” even though the Club does not use it as its name. This is by virtue of the close similarity of the Application Marks (see [18] above).

103 First, the goodwill generated by the Club is associated with the word “HARVARD” rather than the names of the Application Marks. The word “HARVARD” in the Application Marks is evocative of the University and designates it as its trade source and origin. This is the result of the University’s substantial investment in advertising, promoting and protecting the Harvard Marks in Singapore and around the world.⁶²

104 While the Club does not explicitly address the test of distinctiveness in its submissions on misrepresentation⁶³, some of the points it raises in respect of goodwill are nevertheless, relevant responses to the above point.

(a) For one, the Club argues that the Application Marks are merely descriptive and cites *SPGA* ([35] *supra*) for the proposition that descriptive names like “The Singapore Professional Golfers’ Association” are capable of acquiring a secondary meaning in the form of a distinctive reputation by virtue of its long use.⁶⁴ I agree with the PAR that while every single term in “The Singapore Professional Golfers’ Association” is essentially descriptive, the same cannot be said for the Application Marks which include the distinctive word “HARVARD”. The analogy is thus misconceived.

(b) In addition, the Club submits that it is possible to draw a distinction between “HARVARD” and the Application Marks. In other words, the individual words in Application Marks must be taken as a

⁶² Lovejoy’s SD at paras 30 – 32.

⁶³ Club’s Submissions at paras 20 – 26.

⁶⁴ Club’s Submissions at para 19.3.

whole – “HARVARD CLUB OF SINGAPORE” and “HARVARD UNIVERSITY CLUB OF SINGAPORE” – and not broken into its constituent elements. The obvious flaw in this argument is that it is impossible to read the Application Marks without immediately focusing on the word “HARVARD”, the only distinctive element in the Application Marks. Without it, “CLUB OF SINGAPORE” and “UNIVERSITY CLUB OF SINGAPORE” would mean nothing to actual and potential Harvard alumni. It would be unable to attract new members and may also lose existing members.

105 Second, the overwhelming majority of Harvard Clubs worldwide are named “HARVARD CLUB OF [location]”. This is a clear suggestion that there is at least *some* nexus between any entity named “HARVARD CLUB OF [location]” and the University. As a matter of common sense, I am inclined to accept Mr Lovejoy’s assertion that the naming convention:⁶⁵

... immediately indicates to [the] University’s over 300,000 alumni that the club is associated with [the] University, and [alumni] expect that such clubs are officially recognised by the university, meet certain standards and provide certain services to alumni

106 This would indicate that any variant of “HARVARD CLUB OF [location]” would be distinctive of the University and its Harvard Clubs as a whole rather than any particular Club, unless some supervening reasons are shown. This is absent on the facts.

⁶⁵ Lovejoy’s SD at para 11.

107 Interestingly, the Club appears to concede the above point because it submits that it “owns the goodwill in the name HARVARD CLUB OF SINGAPORE [sic] insofar as the *relevant section of the Harvard Alumni in Singapore recognise [the Club] to be affiliated to or connected with [the University]*” [emphasis added].⁶⁶ Given that the licence arrangement between the Club and the University terminated on 29 May 2015, I agree with the PAR that it may well be open for the University to pursue an action in passing off against the Club for continued use of the Harvard Marks as part of the Club’s name.⁶⁷

108 For the reasons stated above, I conclude that that the Application Marks are *not* distinctive of the Club but of the University and its Harvard Clubs as a whole. Even assuming that the Club could prove ownership of the relevant goodwill, its opposition on the ground of passing off still fails as the University’s registration and subsequent use of the Application Marks would not amount to an actionable misrepresentation.

Issue 2: Bad faith

109 Section 7(6) of the TMA reads as follows:

Absolute grounds for refusal of registration

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

⁶⁶ Club’s Submissions at para 34.2.

⁶⁷ GD at [89].

110 The leading decision of the CA in *Valentino* ([60] *supra*) sets out the relevant principles of bad faith:

(a) Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark (*Valentino* at [28] citing *Weir Warman* ([59] *supra*) at [48]).

(b) The presence of bad faith is determined by a combined test which contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary people adopting proper standards would think). Bad faith as a concept is context-dependent and hinges upon the specific factual matrix of each case (*Valentino* at [29] referring to *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [105]).

(c) An allegation of bad faith is a serious one and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference (*Valentino* at [30] ([60] *supra*)).

(i) There is, however, no absolute prohibition against drawing inferences per the learned author in *Ng-Loy Wee Loon* at para 21.4.1 who noted that in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina Lotus*”) at [115], the Singapore High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.

(d) The legal burden of proof needed to substantiate an action for opposition lies throughout on the party opposing the trade mark application (*Valentino* at [21] referring to *Wing Joo Loong* at [33]). It is only after a *prima facie* case of bad faith is made out by the opposing party that the burden of disproving any element of bad faith shifts to the party applying to register the trade mark (*Valentino* at [36]).

(e) The relevant date for determining whether there is bad faith is the time of filing the application for registration. Matters occurring after the date of the application may also assist in determining the applicant's state of mind at the time of the application for registration (*Festina Lotus* at [100]).

111 The Club advances three lines of argument in support of its opposition on the ground of bad faith, I will deal with each in turn.

Argument 1: Lack of authority

112 The Club's first argument is that the registration applications filed by the University were filed by the "HAA, likely without the authority of the [University], but nonetheless utilising the name of the [University]".⁶⁸ In particular, it takes aim at Mr Lovejoy and states that his statutory declaration should be struck out as he has no authority to submit any evidence on behalf of the University.⁶⁹

113 I find this argument to be wholly without merit, for a number of reasons:

⁶⁸ Club's Submissions at para 43.1(a).

⁶⁹ Club's submissions at paras 12 and 42.2(b)(iv).

(a) Mr Lovejoy’s authority to give evidence in relation to the University and the HAA clearly stems from his position as Executive Director of the HAA.⁷⁰

(b) Even if there is any doubt about this, it would have been adequately addressed by Mr Enrique Calixto’s first statutory declaration which unequivocally confirms that both he and Mr Lovejoy have the authority to provide evidence on behalf of the University by virtue of their office.⁷¹ As further proof of this, Mr Calixto tendered a notarised Secretary’s Certificate signed by *the University’s Secretary*. This certifies that:⁷²

(i) Mr Calixto is a duly appointed and acting officer of the University who holds the office of Executive Director of the Harvard Trade Mark Program (*ie*, the department in charge of protecting and managing the University’s trade marks).

(ii) Mr Calixto has the authority to sign or delegate to other Harvard employees the authority to sign all documents related to trade marks owned by the University.

(c) There is documentary evidence to prove that the University was clearly aware of the various events surrounding the registration of the Application Marks. I list two examples of this.

⁷⁰ Lovejoy’s SD at para 1.

⁷¹ Calixto’s 2nd SD at para 10.

⁷² Calixto’s 2nd SD 1 at Annex 1, p 9.

(i) The Club's termination letter was sent with the knowledge and support of key office holders in the University, including the Vice Provost for International Affairs and the President of the HAA.⁷³

(ii) The HAA wrote a letter to the Registry of Societies to support and authorise the registration of a new Harvard Club. This letter was signed by Ms Jennifer C. Flynn who is the HAA's Director of Clubs, Shared Interest Groups and International Affairs.⁷⁴

114 In light of the evidence that key office holders in the University (and not just the HAA) were involved in the events leading to the registration of the Application Marks, I find it wholly improbable that the applications were filed without the authority of the University.

Argument 2: Improper, dishonest or unacceptable conduct

115 The Club's second argument is four-fold:⁷⁵

(a) First, the University repeatedly interfered with the activities of the Club (*eg*, by asking Dr Lee to step down from her role as president and threatening to terminate the Club's status as a Harvard Club).

⁷³ Lovejoy's SD at Annex 12, p 387,

⁷⁴ Lovejoy's SD at Annex 22, p 856.

⁷⁵ Club's Submissions at paras 43.2 – 43.4.

(b) Second, the University did not enter into negotiations with the Club in good faith as it filed the two trade mark applications while negotiations were ongoing, six months before the termination letter.

(c) Third, the University sought to usurp the Club’s role as an alumni club in Singapore.

(d) Fourth, the University deliberately chose Application Marks that are identical or very similar to the Club’s name.

116 I agree with the PAR’s decision to reject these arguments. The University is the sole owner of the goodwill generated by the Club in connection with the use of the Application Marks and is thus entitled to file for their registration at any point. The PAR rightly observed that the Club is a mere licensee who did not pay any licence fees to use the Harvard Marks. The permission granted to it was “contingent on the [University’s] continued recognition of affiliation and thus revocable by the University at any point” (GD at [98]). On the facts, the Club was clearly in breach of the University and HAA’s policies (*eg*, by failing to adhere to the 3-year presidential term limit) and the University was more than justified in terminating the affiliation.

117 I also add that while the two Application Marks are identical and similar (respectively) to the Club’s name, this does not *ipso facto* mean that there is bad faith because one must still have regard to the factual circumstances of the case. As the learned author in *Tan Tee Jim* states at para 7.170:

Bad faith does not invariably arise if all that is present is knowledge of a rival’s use of an identical or similar mark for identical or similar goods or services. *The applicant may well honestly believe that he has a superior right to registration and/or use of mark.*

[emphasis added]

Furthermore, per V K Rajah JA in *Weir Warman* ([59] *supra*) at [49]:

It appears to me to be an incontrovertible proposition that if a registrant of a trade mark has proprietorship of that trade mark, or at the very least, the *right to register* that trade mark, then such registration of the trade mark should fall well within the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the particular trade.

[emphasis in original]

118 The University is the registered owner of the Harvard Marks both in Singapore and around the world. All the goodwill generated by the Club in connection with the use of the Application Marks resides in the University. I thus find that its behaviour in registering the Application Marks (even though negotiations were ongoing) falls well within the standards of acceptable commercial behaviour.

Argument 3: No intention to use

119 The Club’s final argument is that the University filed for two, almost identical marks within class 41 for club services with no intention to use them. This is because it would not be possible for the University to register both Application Marks as societies – the Registrar of Societies would block this under s 4(3)(c) of the Societies Act as the names would be too similar.

120 As the PAR correctly pointed out, there is a difference between a trade mark and a society name. A registered society may be registered in one name and yet use different marks to denote its services. Furthermore, a registered trade mark proprietor does not have to put its marks into use immediately. Under s 22(1)(a) of the TMA, a registered mark only becomes liable to be revoked on the basis of non-use for five years after the completion of registration.

121 The University also makes it clear that it fully intends to use those marks. It previously attempted to register a society under the name “HARVARD UNIVERSITY CLUB OF SINGAPORE” and even provided an official authorisation letter to the Registry of Societies.⁷⁶ Furthermore, the vast majority of Harvard Clubs follow the standard naming convention of “HARVARD CLUB OF [location]” – this indicates that if the Club did not exist, the University would likely make use of its standard naming convention when naming its new Harvard Club to be formed in Singapore.

122 I thus reject the Club’s third argument on bad faith.

123 To conclude this section, I find that the Club has failed to discharge its burden to show even a *prima facie* case of bad faith. Accordingly, I reject the second ground of opposition under s 7(6) TMA.

Issue 3: Use prohibited by law

124 I turn now to the Club’s final ground of opposition. In relation only to the first Application Mark *ie*, “HARVARD CLUB OF SINGAPORE”, the Club submits that its use is prohibited in Singapore by any written law or rule of law under s 7(5) of the TMA. I have already reproduced s 7(5) of the TMA at [24] above.

125 The Club relies upon s 4(3)(c) of the Societies Act as the “written law or rule of law” prohibiting the use of “HARVARD CLUB OF SINGAPORE”:

Registration of specified societies and refusal to register

⁷⁶ Lovejoy’s SD at para 57 and Annex 22, p 856.

4.—(3) The Registrar may refuse to register a specified society if —

....

(c) it appears to him that the name under which the specified society is to be registered —

(i) is likely to mislead members of the public as to the true character or purpose of the specified society or so nearly resembles the name of some other society as is likely to deceive the members of the public or members of either society;

(ii) is identical to that of any other existing society; or

...

126 For convenience, I adopt the PAR’s terminology in calling s 4(3)(c)(i) the “Deceptive Resemblance” ground and s 4(3)(c)(ii) the “Identical Name” ground.

127 The Club’s argument is structured as follows:⁷⁷

(a) The Registrar of Societies has a discretion to refuse to register a society if its name falls into the Deceptive Resemblance or Identical Name grounds.

(b) The Registrar of Societies has already refused the University’s application to register a society on the basis that its name “HARVARD UNIVERSITY CLUB OF SINGAPORE” was caught by the Deceptive Resemblance ground.

⁷⁷ Club’s Submissions at paras 37, 38.2 – 38.6

(c) Assuming that the University remains true to its word and indeed takes steps to use the name “HARVARD CLUB OF SINGAPORE”, the University would likely use one of the Application Marks as the name of a new Harvard Club.

(d) If the attempt is indeed made, the Registrar would refuse to register the new society on the basis of the Identical Name ground because the Club is already registered under the same name and is a separate legal entity.

(e) The Registrar’s decision would amount to a prohibition against the use of “HARVARD CLUB OF SINGAPORE” under “any written law or rule of law” within s 7(5) of the TMA such that the registration of the same name as a trade mark must be refused.

128 As this appears to be the first case that directly addresses the interplay between s 4(3) of the Societies Act and s 7(5) of the TMA and one of the rare local cases dealing with s 7(5) of the TMA, it is necessary for me to have regard to first principles in analysing the Club’s argument. In my view, the Club’s argument is wrong in principle and must be rejected.

129 Dealing first with the requirement of prohibition according to “written law or rule of law”, I agree with the PAR that s 7(5) of the TMA is not meant to cover the present situation. I say this for a few reasons.

(a) Despite the lack of judicial authority, the meaning of the term “written law” is clear; it refers to an express prohibition in statute. Per *Ng-Loy Wee Loon* at para 21.5.3:

... The real targets of s 7(5) are trade marks the use of which is prohibited by, for example, other legislation such as the Singapore Tourism Board Act (on the use of the Merlion symbol) and the Geneva Conventions Act (on the use of the symbol associated with the Red Cross).

A similar view was also taken in *Tan Tee Jim* at para 7.148. Plainly, the decision of the Registrar of Societies to disallow registration cannot count as a “written law”. To read it otherwise would mean that a mere registered society name has the same status as *eg*, the Merlion symbol, which is expressly protected against misuse on pain of criminal sanction under s 24 of the Singapore Tourism Board Act (Cap 305B, 1997 Rev Ed). This clearly cannot be the position at law.

(b) Unfortunately, the same clarity does not exist in respect of the expression “rule of law” (see *Tan Tee Jim* at para 7.148) which appears to be wider in scope than “written law”. Nonetheless, it is clear to me that s 7(5) of the TMA was not meant to be read with s 4(3)(c) of the Societies Act. The wording of ss 4(3)(c)(i) and 4(3)(c)(ii) of the Act makes it clear that Parliament intended for the Registrar’s power to be discretionary. This is because s 4(3) of the Act uses the word “may” while the preceding subsections ss 4(1) and 4(2) of the Act employ the mandatory word “shall”. This means that it is within the Registrar’s statute-given powers to register a society even if it falls afoul of the Deceptive Resemblance or Identical Name grounds. A discretion, which by its very definition, may or may not be exercised, cannot fall within the definition of “rule of law”.

130 Even taking the Club’s argument at its highest and assuming that the Registrar’s discretion to refuse registration amounts to prohibition by “rule of

law”, I agree with the PAR that the Club cannot succeed under s 7(5) of the TMA because the word “use” relates to “actual use” in the trade mark sense and does not cover the mere registration of a society for the following reasons:

(a) Sections 4(3)(c)(i) and 4(3)(c)(ii) of the Societies Act do not provide the Registrar of Societies with authority over the use of any trade mark but merely a limited authority over the registration of society names. The Registrar cannot grant or prohibit the use of trade marks even if it is identical to the name of a registered society.

(b) The “actual use” approach is in line with *Scotch Whisky Association v Isetan Mitsukoshi* [2019] SGHC 200 (“*Scotch Whisky Association*”), the latest local pronouncement on s 7(5) of the TMA. There, the “written law or rule of law” refers to ss 3(2)(a), 3(2)(b) and 3(2)(d) of the Geographical Indications Act (Cap 117B, 1999 Rev Ed) (“GIA”). In order for s 7(5) of the TMA to come into play, there had to be “use of a geographical indication” under the abovementioned sections of the GIA. The court thus had to decide what “use” in the context of GIA meant. It held that the “plain and ordinary meaning of the word ‘use’” should be employed and not the wider forms of “use” such as “indirect commercial use” and “evocation”. While the High Court’s decision appears to be primarily concerned with the word “use” as found in the abovementioned sections of the GIA (as opposed to “use” under s 7(5) of the TMA), I agree with the PAR’s observation that the relevant provisions of the GIA all deal with instances of actual use. The dicta in *Scotch Whisky Association* in relation to “use” can thus be extended by analogy to the present case.

131 For completeness, I add one further observation as to why the Club's opposition on this ground must fail.

132 It would be against public policy to permit a registration in the Register of Societies to block a trade mark application in the trade marks register. The Societies Act and the TMA govern distinct regimes that deal with wholly disparate subject matters. The latter governs the trade mark regime in Singapore while the former

... plays a gate-keeping role in ensuring that groups which may be used for unlawful purposes or pose a threat to public order, welfare or good order in Singapore, or which will be contrary to our national interests are not allowed to establish themselves in Singapore.

*(Singapore Parliamentary Debates, Official Report (19 May 2005)
vol 77 Associate Professor Ho Peng Kee, Senior Minister of State
for Home Affairs)*

133 The logical corollary to allowing the opposition based on the Club's argument is that trade mark rights (which count as legal property) can effectively be subordinated to the registration of a society name which does not create legal rights. This would have far reaching practical consequences. For one, a trade mark owner might be precluded from using its own Singapore registered trade mark if an entity manages to register a society under an identical or similar name. This is plainly unjust.

134 Such a result would also be at odds with practical realities because the Registrar of Trade Marks does not conduct prior mark searches on the societies register before registering a trade mark. The same can be said about the Registrar of Societies; under s 4 of the Societies Act, the Registrar does not have to consider the laws and principles of trade marks when registering a society (or

when refusing to do so). Thus, it would be against public policy to allow an opposition under s 7(5) of the TMA on the basis of the Identical Name ground.

135 To conclude, I find that the Club cannot rely on s 7(5) of the TMA read with s 4(3)(c) of the Societies Act to mount an opposition against the application of the first Application Mark, “HARVARD CLUB OF SINGAPORE”. The last ground of opposition is accordingly rejected.

Conclusion

136 For the reasons set out above, I find that none of the grounds of opposition are made out. I dismiss the appeal and affirm the PAR’s decision to allow the registration of the Application Marks.

137 I will hear parties on costs if not agreed.

Chan Seng Onn
Judge

Wun Rizwi (RHTLaw Asia LLP) for the appellant;
Chew Lixian Ashley (Ella Cheong LLC) for the respondent.
