

Richemont International SA v Da Vinci Collections Pte Ltd
[2006] SGHC 150

Case Number : Suit 800/2005, SUM 374/2006
Decision Date : 22 August 2006
Tribunal/Court : High Court
Coram : Andrew Ang J
Counsel Name(s) : Dedar Singh Gill, Penny Leng Li Yuen and Paul Teo (Drew & Napier LLC) for the plaintiff; Tan Tee Jim SC and Lam Chung Nian (Lee & Lee) for the defendant
Parties : Richemont International SA — Da Vinci Collections Pte Ltd

Trade Marks and Trade Names – Infringement – Plaintiff seeking injunction restraining use of word mark on ground such use infringing plaintiff's registered mark – Defendant denying such infringement and counterclaiming for order revoking registration and/or declaring registration invalid due to non-use, lack of distinctiveness and bad faith in registration – Whether use of registered mark by plaintiff in stylised form amounting to use of registered mark under s 22 Trade Marks Act – Sections 22(1), 22(2), 27(1) Trade Marks Act (Cap 332, 2005 Rev Ed)

22 August 2006

Andrew Ang J:

1 This was an application for summary judgment in Suit No 800 of 2005 wherein the plaintiff sought, *inter alia*, an injunction to restrain the defendant from infringing the plaintiff's Singapore registered trade mark "DA VINCI" ("the Registered Mark") in class 14 in respect of "watches and watch straps".

2 As deposed to in the first affidavit of Marc Frisanco (filed on 1 January 2006 on behalf of the plaintiff), the plaintiff is part of the Richemont Group which owns many well-known brands in the luxury watch and accessories industry, including Cartier, Baume & Mercier, Piaget and Jaeger-LeCoultre. In the year 2000, the Richemont Group acquired the International Watch Company ("IWC") which was established in Switzerland in 1868. Pursuant to the acquisition and restructuring, all the trade marks of IWC and the goodwill in the business under the marks were transferred to the plaintiff. In particular, the Registered Mark, which since 1 August 1989 had been registered in the name of IWC, was transferred to the plaintiff. The latter was registered as the subsequent proprietor with effect from 1 April 2002.

3 The plaintiff alleged in the action that the defendant infringed the Registered Mark in three ways, *viz*:

- (a) by the use of a word mark "Da Vinci";
- (b) by the use of a device mark "Da Vinci"; and
- (c) by the use of a composite word and device mark.

However, for the purpose of the application for summary judgment before me, the plaintiff confined itself only to the defendant's alleged infringement by the use of the word mark in breach of s 27(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") which provides:

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to

goods or services which are identical with those for which it is registered.

4 The plaintiff's contention was that the defendant was using a word mark ("Da Vinci") identical to the Registered Mark on goods which were identical to those for which the Registered Mark was registered.

5 By its amended defence and counterclaim, the defendant denied infringement and counterclaimed for an order for revocation and/or declaration of invalidity of the registration on the grounds, *inter alia*, that:

(a) within the period of five years following the date of completion of registration of the Registered Mark (*ie*, five years from 1 August 1989), the registered proprietor did not put the mark to genuine use in the course of trade in Singapore in relation to watches or watch straps for which it was registered and there was no proper reason for the non-use;

(b) the use of the Registered Mark in the course of trade in Singapore in relation to watches or watch straps for which it is registered had been suspended for an uninterrupted period of five years and there was no proper reason for the non-use;

(c) the Registered Mark was and had at all material times been used by the plaintiff to designate a particular line or family of the plaintiff's watches and/or to distinguish it from its other lines or families of watches; in particular, the Registered Mark was and had at all material times not been used in the course of trade by the plaintiff as an indicator of origin or to distinguish the plaintiff's watches or watch straps from others;

(d) the plaintiff's application to register the mark had been made in bad faith as the mark was intended to be used, and had at all material times been used, by the plaintiff for the purposes or in the manner described above and not as an indicator of origin or to distinguish the plaintiff's watches or watch straps from others in the course of trade.

6 A fifth ground in the amended defence and counterclaim was that the Registered Mark was devoid of any distinctive character but this was not covered in the written submissions tendered by the defence counsel. It should also be noted that the counterclaim seeking revocation and/or a declaration of invalidity of the registration of the plaintiff's mark raised the same points as were covered in the defence.

7 A disposal of the plaintiff's application requires the court's determination whether there is an issue or question in dispute which ought to be tried or there ought, for some other reason, to be a trial of the plaintiff's claim or part thereof (O 14 r 3 of the Rules of Court (Cap 322, R 5, 2006 Rev Ed)). This calls for an examination of the issues raised by the defendant.

Issues

Whether the defendant infringed the Registered Mark by using an identical sign

8 Leaving aside for the moment the question whether the registration of the Registered Mark may be revoked or declared invalid, there is no doubt that the defendant used a sign in the form of the words "Da Vinci" in respect of watches and watch straps and that the sign is identical to the Registered Mark.

9 Although in para 18 of the defendant's written submissions it was argued that whether a sign

was identical to a registered mark depended on the perception of the average consumer thus giving rise to a question of fact, that appeared to have been raised with reference to the defendant's device. Certainly such a contention with reference to the defendant's use of the words "Da Vinci" would have been quite untenable.

Whether the plaintiff put the Registered Mark to genuine use during the relevant five-year period

10 Section 22(1)(a) of the Act provides that the registration of a trade mark may be revoked if:

... within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by the proprietor or within his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use[.]

11 In the present case, the relevant period of five years commenced from 1 August 1989, the date of registration of the Registered Mark. It is for the plaintiff to show what use has been made of the Registered Mark (see s 105 of the Act). The defendant submitted that a trade mark had to be used in the form in which it was registered on pain of revocation otherwise. This was a paraphrase, not altogether accurate, of s 22(2) read with s 22(1) of the Act. Section 22(2) reads as follows:

For the purposes of subsection (1), use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered ...

The basis upon which the defendant sought to argue that the plaintiff's use of the Registered Mark was not in the form in which it was registered was that it was always used in conjunction with the trade mark "IWC". (By this the defendant meant that the "IWC" mark always appears on the face of the plaintiff's watches whereas the Registered Mark appears on the back.) This contention is surprising considering that it is well established in trade mark law that a product may carry more than one trade mark. I shall return to this shortly.

12 Even more curious is the fact that the defendant cited in support of its contention *Nation Fittings (M) Sdn Bhd v Oystertec Plc* [2006] 1 SLR 712 (the "Oystertec case") at [116]–[125]. In that case the court was considering a situation where the registered mark (TM 114) had been subsumed within other elements to such an extent that it could not be considered to have been used within the meaning of s 22(1) of the Act. In particular, TM 114 (which was a plain mark) appeared as part of the letter "o" in "Conex". It also formed the frame within which the "Conex" brand was advertised in various forms in words. In those circumstances, the learned judge Andrew Phang Boon Leong J (as he then was) found that the presence of the other elements altered the distinctive character of TM 114, it being his view that in the use to which TM 114 had been put the focus was not really on the registered mark but on the "Conex" brand.

13 The *Oystertec* case clearly does not support the defendant's contention. In the case before me, the Registered Mark was not in any way subsumed within or intertwined with other elements but stood separate and distinct from the "IWC" mark. The defendant's contention was based on a misinterpretation of s 22(2). Inferentially, that subsection disqualifies for the purposes of s 22(1) any use of a trade mark "in a form differing in elements" which "alter the distinctive character of the mark in the form in which it was registered". It has no application where the trade mark is used in the very form in which it was registered. (Lest I be misunderstood, I hasten to add that, as we shall see later, given that the Registered Mark was registered in block capitals, any use of it in any other form of

lettering would also constitute use of the Registered Mark: see *In the Matter of Morny Ltd's Trade Marks* (1951) 68 RPC 131 ("*Morny*") a decision of the Court of Appeal in England.)

14 I now return to the question whether the Registered Mark could be said to have been put to genuine use where it appeared on the back of the watch while another trade mark "IWC" appeared on the face of the same watch. As earlier stated, it 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.

15 The case of *Safari Trade Mark* [2002] RPC 23 is instructive. That case concerned an application for revocation for non-use of the registered trade mark "Safari" on the basis, *inter alia*, that the mark "Safari" was being used as a description of the goods and not as a trade mark. The applicant argued that there was no "trade mark use" of the word "Safari" for two reasons: (a) the goods in question were identified primarily by the marks "Land Rover" and "Discovery"; and (b) the word "Safari" was descriptive of the goods in respect of which the mark was used. The Registrar hearing the matter held as follows at [21] and [22]:

Mr Blum submitted that the use shown by Rover Group Limited was not, in any event, used as a trade mark. As I understood it, this criticism took two forms. Firstly, that use of SAFARI was not used as a trade mark because the goods in question were primarily identified by the marks "Land Rover" and "Discovery". *There is no rule that a secondary or even third level product identifier cannot be a trade mark.* On the contrary, it is easy to think of examples, such as Ford Escort **XRSi** and Ford Sierra **Cosworth** where the third level identifier is plainly a trade mark. Each case therefore turns on its own facts.

The second leg of Mr Blum's submissions is that the word SAFARI is descriptive of the goods in respect of which the mark was used: that the use of SAFARI was analogous to signs such as "five door" or "V8". It is not obvious to me what characteristic of the goods is described by the word "safari". It is true that the promotion of the mark SAFARI by Rover Group Limited plays upon a safari "theme". The vehicle in question is said to come with a protection bar, running boards and a ladder, all of which may suggest that the vehicle is suitable for use on a safari. However, the vehicle also comes with metallic paint, five spoke sports alloy wheels, and a CD player. The registered proprietor's evidence suggests that Rover Group Limited used the mark SAFARI in a fanciful way in relation to a vehicle which whilst undoubted having off-road capabilities was, in reality, promoted as an up-market form of transport for the U.K. rather than as a specially adapted vehicle for use on "safari" in Africa or other distant places.

[emphasis added in italics]

16 The plaintiff also relied on the cases of *Levi Strauss & Co v Shah* [1985] RPC 371 ("*Levi Strauss*") and *George Weston Foods Ltd v Manildra Flour Mills Pty Ltd* (1999) 47 IPR 145 ("*George Weston*"). In *Levi Strauss*, the plaintiff (Levi Strauss) had obtained a registration covering five plain-coloured labels (including white) "sewn into the left hand seam of the rear pocket of a pair of jeans". The word "Levi's" was also a registered trade mark of the plaintiff and was invariably added to the tabs. The defendants sold jeans with white tabs sewn into the pockets, bearing the word KING. The plaintiff alleged infringement of its registration for the coloured labels and the defendant counterclaimed for revocation on the ground of non-use. The High Court held that the defendant had infringed the plaintiff's registration and dismissed the counterclaim, holding (at 378) that the plaintiff had used "plain-coloured tabs from start to finish, albeit in connection with the word LEVI'S".

17 The *Levi Strauss* case was followed in *George Weston*, where the hearing officer held that the use of a registered trade mark with other trade marks constituted “use” and prevented the mark from being revoked on the ground of non-use. In that case, the registered mark in question was a “kangaroo device”, which was always used in combination with other trade marks. It was held that the fact that the registered mark was always used in combination with other trade marks did not detract from the fact that it had been used and should therefore not be revoked.

18 As was deposed to by the plaintiff’s representative, Marc Frisanco, in his second affidavit, there are many secondary trade marks registered in Singapore for watches, including “Oyster” (in conjunction with the house mark “Rolex”), “Royal Oak” (in conjunction with the house mark “Audemars Piguet”), “Constellation” (in conjunction with the house mark “Omega”) and “Calatrava” (in conjunction with the house mark “Patek Philippe”). The defendant’s contention denying protection for the secondary mark would lead to the conclusion that competitors in the watch industry would be free to appropriate and use any of these secondary marks with impunity. Clearly that cannot be.

19 Another question that arose was whether, given that the Registered Mark comprised the words “DA VINCI” in block capitals, the plaintiff’s use of the “DA VINCI” mark in cursive form constituted “use” of the Registered Mark for purposes of s 22 of the Act.

20 In response, the plaintiff firstly pointed out that it had indeed used the Registered Mark in block capitals on some models of the plaintiff’s watches. The Registered Mark had also been used in plain typeface on advertisements and catalogues. In regard to this latter manner of use, Lord Walker of Gestingthorpe held in *Bud and Budweiser Budbräu Trade Marks* [2003] RPC 25 (“the *Budweiser* case”) at [38]:

[I]n the case of goods, the primary use of a trade mark (reflected in Art.5.3(a) of the First Council Directive 89/104 and in s.10(4)(a) of the Act, although only for the purposes of that section) is to put the trade mark on the goods, or on their packaging. *But a trade mark can also be used “in relation to” the goods for which it is registered in other ways, for instance in advertising, either at or away from the point of sale.* [emphasis added]

More importantly, the plaintiff contended that it was clear from authorities that the use of the words “Da Vinci” in cursive form constituted use of the Registered Mark, the registration of a word mark in block capital conferring protection in a very wide range of typefaces. This is summarised in *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 14th Ed, 2005) at para 2-036 as follows:

Consider a word-only registration. The graphical representation is the word in capitals in plain type. Such a registration covers the word in a very wide range of typefaces. The variation in presentation is permissible because the distinctive character of the mark resides in the word itself and that does not change.

This statement is founded upon good authority.

21 In the English Court of Appeal case of *Morny* ([13] *supra*), it was held that use of the mark “Morny” (which had been registered as “MORNY” in plain block capitals) in various stylised forms amounted to use of the registered mark. Evershed MR stated at 145:

The question is: Was or is the use of the word “Morny”, in the form or manner which I have attempted to describe, user of the mark “Morny” as registered, consisting, as I have stated, of the five letters “M-o-r-n-y” in capital letters?

It seems to me that, if a name is registered, you may either register it under Para. (a) of Sec. 9 (1) (that is to say, in a particular representation) or not. And, if it is not registered as a particular representation of the name, then the inference, I should have thought, must be that it was not intended to confine it to the form in which it was registered, but that the thing that was intended was use of that particular name in any way representing it.

Similarly, Jenkins LJ observed at 149–150:

The mark in question is “Morny” in block capitals and I should have thought, as my Lord has in effect said, that it must really be obvious that the registration of a word in block capitals must cover use of that word in any clearly legible form of lettering and not be confined to its representation in block capitals. Otherwise the registration of a mark consisting of a name in block capitals would give virtually no protection at all, for anyone could use the same word in some other form of type or lettering in imitation handwriting or some other form of that kind; and it would obviously be impossible for anyone seeking to register a particular word, such as “Morny”, to cover in his application or applications every conceivable form of lettering in which it might be represented.

22 In *Express Newspapers Ltd v Star Newspaper Co* [1984] IPD 7090 (UK Reg), referred to at p 377 of *Shanahan’s Australian Law of Trade Marks and Passing Off* (Lawbook Co, 3rd Ed, 2003), the hearing officer adopted the principles set out in *Morny*.

23 On the facts, however, the case was distinguished from those in *Morny*. In the case in suit, the title “The Star” had been registered in Gallic script with a device between the two words showing a man in a star but, as used, the words were in italic script and without the device. The hearing officer explained:

[I]f registration of a name or word or other mark takes a particular form, then it is to be inferred that it is intended to confine the mark and its use to that form. If not registered in a particular form, then a mark may be safeguarded by use in some different form, provided that its name or other significance comes shining through. This leaves unresolved the question: “what constitutes a particular form?” In a certain sense, every mark registered may be said to have a particular form, that is the form in which it is registered. But what it seems to me that the Master of the Rolls was saying [in *Morny*] was that “particular form” means “out of the ordinary”. Thus, “MORNY” in plain block capitals is not a registration in an out of the ordinary form and may be used as a trade mark with various embellishments provided “MORNY” remains discernible as the essential feature.

24 In the present case, the mark “DA VINCI” was registered in plain block capitals. This is not an “out of the ordinary” form and may therefore be used in a stylised form provided the words “Da Vinci” remain distinctly the essential feature which was clearly the case here.

25 The defendant countered the plaintiff’s submission by citing two cases. The first was *Elle Trade Marks* [1997] FSR 529. In that case, the appellant was the proprietor of two identical trade marks which were registered for various toiletries. The marks consisted of the word “elle” in lower case letters in the middle of a circle with a cross off the circle bottom right (the scientific symbol for the female gender) and there was a disclaimer of any right to the exclusive use of the word “elle”. The respondent applied for the revocation of the marks for non-use under s 46 of the UK Trade Marks Act 1994 (c 26) (the equivalent of s 22 of our Act). The appellant contended that its use of the word “elle” alone and in upper case letters did not alter the distinctive character of the mark in the form in which it was registered and therefore constituted “use” within s 46(2) of the UK Act.

26 Lloyd J held that the word “elle” alone and without the device and in upper case letters altered the distinctive character of the mark in a significant and substantial way. At 533 he observed:

It seems to me that the device is at least as much what makes the mark distinctive as the word.

I cannot see how this case is of assistance to the defendant. Unlike in the case before me, the registered mark in *Elle Trade Marks* was not a plain word mark.

27 The second case cited by the defendant in this connection was the *Budweiser* case ([20] *supra*), a decision of the English Court of Appeal. This was the hearing of two appeals from the decision of the High Court, Chancery Division, on appeals from the decisions of the Registrar of Trade Marks. We are concerned more with the first appeal.

28 In the first appeal, the registered proprietor appealed against the judge’s decision to revoke on the ground of five years’ non-use of its registered trade mark comprising the words BUDWEISER BUDBRÄU in stylised script. The registered proprietor accepted that it had not made use of the words “Budweiser Budbräu” in the form as registered but had made use of them in block capitals as a circular surround to a device consisting of a castle and shield and also as part of a frieze comprising the words “Budweiser-Budweiser-Budvar-Budweiser-Budbräu-Bud-” the frieze surrounding invoices for Budweiser beer. It claimed that such use was use of the mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered” as required in s 46(2) of the UK Trade Marks Act 1994. The registrar upheld the registered proprietor’s contention. On appeal, the High Court reversed this decision holding that the registrar had applied the wrong test by asking what the average consumer’s reaction to the mark was and by seeking to ascertain what the central message of the mark was. He then proceeded to substitute his own finding that the registered proprietor’s use fell outside s 46(2).

29 On the further appeal of the registered proprietor, the Court of Appeal held that the registrar’s test was not wrong although the grounds of decision might have been better expressed. Accordingly, in the absence of an error of principle, it was not open to the judge to consider afresh whether or not the use fell within s 46(2). Although, as Lord Walker stated, the decision of the registrar was surprising and if it were up to him he would himself have arrived at the opposite conclusion, nevertheless in the absence of an error of principle, the decision of the registrar had to stand.

30 The defendant’s reliance on this case was, obviously, not on the outcome of the Court of Appeal’s decision but on the reasoning (in particular Lord Walker’s). The defendant’s counsel cited Lord Walker’s statement in [37] of his Lordship’s judgment that “[t]he distinction between plain words and stylised words is legally significant”. This, however, should be read in context. At [48], his Lordship also observed as follows:

The hearing officer concluded that the distinctive character of the BUDWEISER BUDBRÄU mark resided in those two words (*just as if the mark were a plain words mark*) and that:

“The different fonts and the underlining do not detract from or add anything to, the central message.”

[emphasis added]

31 The addition of the observation “just as if the mark were a plain words mark” is highly significant as it supports the plaintiff’s case and is consistent with *Morny* ([13] *supra*). (The

observation was unlikely to be that of the hearing officer (registrar) as the relevant paragraphs of his decision quoted in the report did not include the comment.)

32 Besides, Lord Walker's statement that "[t]he distinction between plain words and stylised words is legally significant" can be explained: Where, as registered, the words constituting a mark are in stylised script, as in the *Budweiser* case, their use in block capitals would likely fall outside the use in s 46(2) of the UK Trade Marks Act 1994. In contrast, as we have seen, the registration of the word mark in plain capitals covers use of the word in any other form of lettering: see *Morny*.

33 In further support of its contention that the plaintiff had not put the Registered Mark to genuine use, the defendant averred that the Registered Mark had at all times been used by the plaintiff to designate a particular line or family of the plaintiff's watches and/or to distinguish it from its other lines or families of watches and not as an indicator of origin or to distinguish the plaintiff's watches or watch straps from those of other undertakings. This was connected to the defendant's contention that the Registered Mark was devoid of any distinctive character. Distinctiveness of character requires that the mark must act as an indicator of origin.

34 Section 7(1)(b) of the Act prohibits the registration of any trade mark which is devoid of any distinctive character and s 23(1) read with s 23(2) provides that the registration of any such trade mark may be declared invalid unless it has, after registration, acquired a distinctive character in relation to the goods or services for which it is registered.

35 In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 306, Jacob J held:

What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any distinctive *inherently* character. [emphasis in original]

In the present context, "Da Vinci" is clearly a meaningless or inappropriate word when used in relation to watches and watch straps; it is clearly distinctive in relation to the goods in question and, as deposed to in Marc Frisanco's first affidavit, has been successfully registered in many other countries around the world including the UK, Australia, New Zealand, Hong Kong and the United States of America. It is curious that the defendant should have alleged that the plaintiff's mark was devoid of distinctiveness when, as pointed out in Marc Frisanco's first affidavit, the defendant has itself applied for and obtained registration of several "Da Vinci" marks. (To be fair, though, I should add that usually the distinctiveness of the mark cannot be assessed in a vacuum but in the context of the trade of the goods or services in question.)

36 The Registered Mark cannot be said to be descriptive of the goods in question in the sense that it merely serves, in trade, to designate the kind, quality, quantity, intended purpose, value or other characteristics of the goods (see s 7(1)(c) of the Act). In contrast, "Doublemint" has been held to consist of terms which may be used in trade to designate the characteristics of chewing gum: *OHIM v Wm Wrigley Jr Company (Doublemint)* [2004] RPC 18. Likewise, as suggested in *Safari Trade Mark* ([15] *supra*), "five door" or "V8" would not qualify for registration as trade marks in relation to motor vehicles.

37 The defendant's contention is not truly that the Registered Mark is descriptive of certain

characteristics of the goods. Rather, it is that the Registered Mark is used by the plaintiff to designate a particular line or family of the plaintiff's watch and/or to distinguish it from the plaintiff's other lines or families of watches.

38 It is clear that a mark or sign that is merely descriptive of certain characteristics of goods or services is denied protection because it is in the public interest that they be freely used by all: *OHIM v Wm Wrigley Jr Company (Doublemint)*.

39 The same objection cannot apply to a mark merely because that mark serves to differentiate one line or family of the plaintiff's watches from another. This point was touched upon in the *Safari Trade Mark* case ([15] *supra*) at [22] and [23] as follows:

The second leg of Mr Blum's submissions is that the word SAFARI is descriptive of the goods in respect of which the mark was used: that the use of SAFARI was analogous to signs such as "five door" or "V8". It is not obvious to me what characteristic of the goods is described by the word "safari". It is true that the promotion of the mark SAFARI by Rover Group Limited plays upon a safari "theme". The vehicle in question is said to come with a protection bar, running boards and a ladder, all of which may suggest that the vehicle is suitable for use on a safari. However, the vehicle also comes with metallic paint, five spoke sports alloy wheels, and a CD player. The registered proprietor's evidence suggests that Rover Group Limited used the mark SAFARI in a fanciful way in relation to a vehicle which whilst undoubtedly having off-road capabilities was, in reality, promoted as an up-market form of transport for the U.K. rather than as a specially adapted vehicle for use on "safari" in Africa or other distant places.

Mr Blum referred me to a promotional brochure for the Land Rover Discovery Safari exhibited as FB 3 to [Monsieur] Bouet's first declaration. Mr Blum pointed out that the second page of the brochure listed the three models available under the same SAFARI (Safari Tdi, Safari Tdi Automatic, Safari V8i Automatic) under the heading of "Description". However, *it appears to me that the brochure is, as one would expect, providing descriptions of the various models available for sale. It is in this sense that the word SAFARI is used as a description. I do not think that brochure supports the applicant's contention that the word SAFARI was used as a description of a characteristic of the goods in the way that "V8" and "five door" plainly are.* I have therefore reached the conclusion that the use shown of the trade mark by Rover Group Limited (with the registered proprietor's consent) is use as a trade mark in relation to a motor land vehicle.

[emphasis added]

As may be seen from the above, the fact that "Safari" served as a description of the vehicle model was unobjectionable as distinct from a mark that merely described a characteristic of the goods.

40 Whilst, undisputably, the Registered Mark has the effect of differentiating the "Da Vinci" line of the plaintiff's watches from the plaintiff's other lines, that does not detract from the fact that the Registered Mark also serves to distinguish the plaintiff's watches in the "Da Vinci" line from those of its competitors, in other words, as an indicator of origin.

41 Finally, we come to the extent or frequency of use. More than sufficient evidence of genuine use during the five years commencing 1 August 1989 ("the relevant period") was shown in exhibits referred to in the first affidavit of Marc Frisanco. They included advertisements in *The Straits Times*, *The Peak* magazine, *Singapore Tatler*, the *Silver Kris* magazine and *Prestige Singapore* magazine. Also exhibited were some sales invoices during the relevant period showing sales of "Da Vinci" watches. The use of the Registered Mark may also be seen in the plaintiff's catalogues which, according to the

evidence of Marc Frisanco, were sent to watch retailers in Singapore for distribution to customers, mailed directly to customers and distributed at events held in Singapore.

Bad faith

42 In view of the above evidence of genuine use and on the view I have taken that the Registered Mark was used as an indicator of origin, it cannot be said that the plaintiff's application to register the trade mark was made in bad faith. I do not think anything further needs to be added.

43 In the result, I found that the defendant had not satisfied me, with respect to the plaintiff's claim of infringement of the Registered Mark in relation to the defendant's watches, that there was any issue or question in dispute which ought to be tried. Neither did the defendant satisfy me that there ought for some other reason to be a trial of that claim. That, however, was not for want of trying.

44 Indeed, the defendant quoted from the following passage in the *Singapore Civil Procedure 2003* (Sweet & Maxwell Asia, 2003) at para 14/4/10, p 155:

Moreover, where the defendant sets up a *bona fide* counterclaim arising out of the same subject-matter of the action, and connected with the grounds of defence, the order should not be for judgment on the claim subject to a stay of execution pending the trial of the counterclaim, but should be for unconditional leave to defend, even if the defendant admits the whole or part of the claim (*Morgan & Son Ltd. v. S. Martin Johnson & Co.* [1949] 1 K.B. 107, CA (whole claim admitted)).

Further down that same page it is stated:

On the other hand, the mere fact that the defendant has a counterclaim does not necessarily entitle him to leave to defend (*Anglo-Italian Bank v. Wells & Davies* (1978) 38 L.T.197 ... Where therefore there is clearly no defence to the plaintiff's claim, so that the plaintiff should not be put to the trouble and expense of proving it, but the defendant sets up a *plausible counterclaim* for an amount not less than the plaintiff's claim, the order should not be for leave to defend but should be for judgment for the plaintiff on the claim with costs, with a stay of execution until the trial of the counterclaim or pending further order (*Sheppards & Co. v. Wilkinson & Jarvis* (1889) 6 T.L.R. 13, CA (England) followed in *Invar Realty Pte. Ltd. v. Kenzo Tange Urtec Inc. & Anor* [1990] S.L.R. 791 ... An order of stay of execution in such a situation is at the discretion of the court (*Hua Khian Ceramics Tiles Supplies Pte. Ltd. v. Torie Construction Pte. Ltd.* [1992] 1 S.L.R. 884). ...

...

The degree of connection between the claim and counterclaim, the strength of the counterclaim and the ability of the plaintiff to satisfy any judgment on the counterclaim are some of the considerations which the court may take account of in the exercise of its discretion whether or not to order a stay.

...

Although, as with a claim, the court cannot under O.14 try a counterclaim (*per* Lord Esher M.R. in *Sheppards & Co. v. Wilkinson & Jarvis*, above) yet if the counterclaim is frivolous or untenable, it will be disregarded (*Anglo-Italian Bank v. Wells & Davis* (1878) 38 L.T. 197).

[emphasis added]

45 From the above, it was clear to me that there was no room to order a stay let alone to grant unconditional leave to defend. The counterclaim was for all practical purposes identical to the defence. Given my determination that the defence raised no triable issue in respect of the plaintiff's claim against the defendant for infringement of the Registered Mark in relation to the defendant's watches, the counterclaim, if it were for me to decide, would have to fail (save with respect to watch straps as to which it appeared there was no evidence of genuine use during the relevant period).

46 I therefore granted an injunction in terms applied for but only with respect to the use by the defendant, its officers, servants, agents or howsoever of the word mark "DA VINCI" in relation to watches.

47 I also ordered as follows:

- (a) that there be an inquiry as to damages or, at the option of the plaintiff, an account of profits;
- (b) that the defendant deliver up to the plaintiff all infringing goods, namely, the watches sold by the defendant under the "DA VINCI" trade mark;
- (c) that the inquiry as to damages or account of profits be reserved to the Registrar;
- (d) that the plaintiff's prayer for payment of interest on sums found due as damages or profits be likewise left to the Registrar; and
- (e) that costs to the plaintiff be taxed unless agreed.

48 Although I initially allowed a stay of execution pending appeal, upon further argument I lifted the stay of the injunction partially so that the defendant, its officers, servants and agents were restrained from advertising its watches using the word mark "DA VINCI" in breach of s 27(1) of the Act.

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