

Amanresorts Limited and Another v Novelty Pte Ltd
[2007] SGHC 201

Case Number : Suit 276/2006
Decision Date : 27 November 2007
Tribunal/Court : High Court
Coram : Tay Yong Kwang J
Counsel Name(s) : Alban Kang, Koh Chia Ling and Ang Kai Hsiang (Alban Tay Mahtani & De Silva) for the plaintiffs; Tan Tee Jim SC, Christopher de Souza and Lim Ke Xiu (Lee & Lee) for the defendant

Parties : Amanresorts Limited; Amanresorts International Pte Ltd — Novelty Pte Ltd

Tort – Misrepresentation – Fraud and deceit – Whether there was misrepresentation amounting to fraud – Whether making reference to similarly-named resort amounting to fraud – Whether plagiarising superlatives describing trade mark proprietor's resort amounting to fraud

Tort – Passing off – Damage – Damage required – Requirement for probability of damage to goodwill in respect of trade or business – Whether there was requisite damage – Whether loss in form of loss of uniqueness and exclusivity, branding fees and prejudice to future real estate development plans amounting to requisite damage

Tort – Passing off – Goodwill – Whether there was goodwill

Tort – Passing off – Misrepresentation – Misrepresentation required – Requirement of real risk that alleged infringer's representation would deceive substantial number of persons of relevant section of public – Requirement of consequence of misrepresentation being that relevant section of public would believe that goods or services of alleged infringer were those of trade mark proprietor – Requirement of consequence of misrepresentation being that relevant section of public would believe that there was business connection between trade mark proprietor and alleged infringer in relation to goods or services provided by them – Whether there was requisite misrepresentation

Tort – Passing off – Test for tort of passing off to be established – Requirement of goodwill – Requirement of misrepresentation – Requirement of damage – Whether tort of passing off established

Trade Marks and Trade Names – Goodwill – Whether there was goodwill

Words and Phrases – "Connection" – "Likely to damage the interests of the proprietor" – Sections 55, 55(3)(a) Trade Marks Act (Cap 332, 2005 Rev Ed)

Words and Phrases – "Relevant sector of the public in Singapore" – Section 2(8) Trade Marks Act (Cap 332, 2005 Rev Ed)

27 November 2007

Judgment reserved.

Tay Yong Kwang J

Synopsis of the case

1 The plaintiffs are the proprietors of various trademarks worldwide consisting of the word "Aman" or the prefix "Aman", including Amanusa, which is, however, not a Singapore trademark at the material time. Amanusa is the name of one of the plaintiffs' exclusive resorts in Bali, Indonesia.

2 The defendant is a developer of real estate in Singapore. Sometime in early 2006, it began marketing for sale a residential project undergoing construction at Yio Chu Kang Drive in the north-central part of Singapore. The project was also called Amanusa.

3 The plaintiffs alleged passing-off and a fraudulent intention to deceive on the part of the defendant. They also claimed, in the alternative, that Amanusa and/or Aman were well-known trademarks which were entitled to protection pursuant to s 55 of the Trade Marks Act (Cap 332, 2005 revised edition).

4 At the conclusion of the trial, I held that there was passing-off but I was not satisfied that there was a fraudulent intention to deceive. I also held that the plaintiffs' trademarks were well known trademarks and that the plaintiffs were entitled to an injunction (with consequential directions) to restrain the defendant from using them, in particular, Amanusa, in relation to any form of accommodation. The injunction was confined to the plaintiffs' trademarks and did not extend, as pleaded by the plaintiffs, to all words which included the prefix "Aman". I did not order an inquiry as to damages or an account of profits as there was no immediate damage suffered by the plaintiffs as a result of the use of the name Amanusa. The plaintiffs were awarded 90% of the costs of the action, the deduction being in respect of the issues on which they failed. No certificate for costs for more than two solicitors was ordered under O 59 r 19 of the Rules of Court (Cap 322, R 5)

The plaintiffs' case

5 The plaintiffs' evidence was adduced principally through their director, Gregory Sirois. The 1st plaintiff is a company incorporated in Hong Kong, which is a party to the Paris Convention and is a member of the World Trade Organisation. It is represented in Singapore by the 2nd plaintiff, a company incorporated here. The plaintiffs' International Corporate Office and International Reservations Office are located in Singapore. Both plaintiffs are wholly-owned subsidiaries of Silverlink Holdings Limited, a British Virgin Islands company, and operate under the umbrella of the Amanresorts group consisting of more than 80 companies. The Amanresorts group was founded in the mid-1980s by Adrian Zecha, a Javanese-born Dutch national and businessman. The plaintiffs operate many exclusive, ultra-luxurious boutique resorts situated at beautiful locations around the world, catering to the upper end of the tourist market by emphasizing privacy and impeccable service. They are the proprietors worldwide of trademarks consisting of the word "Aman" and/or containing the prefix "Aman", such as Aman, Amanresorts, Amandari, Amanpuri and Amanyara, for a wide range of goods and services, including the provision of resorts and accommodation. In respect of Amanusa mark, the plaintiffs own the trademark in Brunei, Hong Kong, Indonesia, Malaysia, Myanmar and the Philippines. There used to be a Singapore Amanusa trademark between 1998 and 2001 but that was not renewed following a shift in the plaintiffs' commercial strategy at that time. The plaintiffs also claimed to be the owners of the reputation and goodwill in the said trademarks, particularly Amanusa, both in Singapore and worldwide,.

6 The defendant is a Singapore company incorporated in May 2005. It is part of the Novelty group of companies, a family-owned business involved in the development and sale of residential properties and in the hotel and resort business.

7 The plaintiffs' first resort was the Amanpuri, which opened in 1988 in Phuket, Thailand. The second resort was the Amandari in Bali, Indonesia. In 1990, the plaintiffs built their first real estate development of 31 villa homes at the Amanpuri in Phuket. These homes provided long-term accommodation. While the resort hotel business was central to their business, the plaintiffs also considered the development of such long-term accommodation as a significant part of their core

business. In addition, the plaintiffs also offer high-value experiences for their guests, such as Aman Cruises, Aman Weddings and Amanusa Golf Experience.

8 In 1992, the Amankila and the Amanusa opened in Bali. These were the second and the third of the plaintiffs' resorts on that island. The architects who designed the resort won an award in 1993 for its design. From 1988 to 2006, 16 Aman-prefixed resorts sprung up all over the globe but with most in Asia. The plaintiffs also acquired two resorts which operated under their trade name and house mark "Amanresorts". These were the Hotel Bora Bora, French Polynesia, in 1989 and the Amanresorts Le Melezin, Courchevel, France, in 1992.

9 The plaintiffs have also, with various partners, developed and marketed long-term residential accommodation at some of their resorts, which gradually became known as Aman Villas. The development of such branded real estate projects was part of a worldwide trend whereby luxury hotel groups would develop and manage branded long-term residential projects. Conversely, developers of houses and condominiums have also started building hotels and resorts. There was therefore an ongoing convergence of the two erstwhile separate industries. In Singapore, for example, the Shangri-La Hotels and Resorts manage the Shangri-La Residences, a branded residential condominium development, and the Shangri-La Apartments, a project involving branded serviced apartments. Similarly, Starwood Hotels & Resorts Worldwide would be managing the six-star St Regis Hotel together with the St Regis Residences.

10 The plaintiffs have received many requests from developers to use the Aman brand name for their projects in return for a branding fee. Such an arrangement would increase the prestige and price of the projects. The plaintiffs would typically charge a branding fee of 10% of the price of the units in the projects and would be responsible for the design of the projects and, for another fee, their management upon completion of construction. The plaintiffs are currently developing residential projects bearing the Aman brand in various parts of the world, for instance, USA, Bahamas, Greece and India. Their joint-venture partner has also acquired land for developing Amanusa villas adjacent to the Amanusa resort. Such branded developments were not necessarily confined to villas in remote areas. The plaintiffs have signed agreements for high-rise developments in Tokyo and New York.

11 Worldwide sales for the plaintiffs' goods and services ranged from about USD39m in 1995 to around USD86m in 2006. The annual promotional and marketing expenditure incurred by the plaintiffs worldwide ranged from USD1.9m in 1995 to about USD3m in 2006. The plaintiffs have a website at www.amanresorts.com registered in December 1996 which, for the past several years, has attracted millions of "hits". The plaintiffs also own the domain name, www.amanusa.com and many other domain names bearing the names of the various resorts. Since 1994, they have been distributing newsletters on the Aman resorts and their related activities in Singapore and elsewhere, with subscribers worldwide numbering about 100,000 and those in Singapore numbering more than 2,000. Brochures for all the Aman resorts are available at their International Corporate Office and International Reservations Office here.

12 The plaintiffs' resorts have received numerous awards and accolades in the travel and hospitality industries in each year of operation. They have also been featured in international and regional magazines and newspapers both in Singapore and elsewhere in the world. In one such journal, the name Aman was described as one that "inspires hushed awe". Celebrities such as Elizabeth Taylor and Mick Jagger were reportedly frequent visitors of the resorts, described variously as "super-exclusive, superb-luxury hotels", "usually the preserve of a very wealthy few", "the cocoon of luxury" and "aimed at a more discerning class of traveller (never a 'tourist') who are cash-rich, style-conscious". It has even been written that "a new international cult of Aman junkies has arisen" (referring to people who have visited at least one Aman resort or those who stay at Aman hotels

around the world, travelling to a new one every time it opens) and that their numbers exceed 130,000. The emphasis is on quality, not quantity. The plaintiffs' 18 resorts worldwide have only 626 rooms to offer.

13 The plaintiffs also produced statistics to show that a large number of Singaporeans visit Bali every year, with more than 35,000 annually for the years 2003 to 2005. More than 300,000 have gone to Bali between 1995 and 2005. Some 1382 Singaporeans visited the Amanusa resort in Bali between 1995 and 2005.

14 By virtue of all the above, the plaintiffs claim to have substantial reputation and goodwill in Singapore and worldwide in the names Aman, Amanusa and/or any words with the prefix "Aman" when used in relation to resorts and accommodation such that they have common law rights to the exclusive use of the same as indicators of the source and/or quality of the goods and services offered by them.

15 According to Tevy Eliazaar, the 1st plaintiff's Area Financial Controller, an Indonesian by race and nationality and someone who is fully conversant in Bahasa Indonesia, the word Aman meant "peace" or "peaceful" and the word "Nusa" meant "island" or "isle". The phrase "Aman Nusa" was not a common one in Bahasa Indonesia as it was grammatically incorrect. In that language, the adjective ought to follow the noun and the correct rendition of the phrase should have been "Nusa Aman". The word Amanusa was an invented word. There is no other place in Bali known as Aman Nusa or Amanusa other than the Amanusa resort in Nusa Dua, Bali.

16 Sometime in February 2006, the plaintiffs realised that the defendant was advertising and offering for sale a residential project undergoing construction called the Amanusa located at Yio Chu Kang Drive, Singapore ("the Yio Chu Kang project"). The Yio Chu Kang project comprises 36 freehold three-storey terrace houses in a cluster with common amenities such as cascading pools. On 14 February 2006, the 1st plaintiff issued a letter of demand to the defendant asking it to change the name of the Yio Chu Kang project. As the defendant refused to do so, this action was commenced on 3 May 2006.

17 The plaintiffs claimed that as a result of their extensive use of the Aman and Amanusa names, many developers were trying to ride on these names in order to give their projects an air of exclusivity since the said names were associated with high-end, top quality, exclusive resorts. The defendant was not the only developer seeking to ride on the Amanusa name. In March 2006, a residential project in Indonesia was named Amanusa Regency. Following an exchange of correspondence between the plaintiffs' solicitors and the developer of the Indonesian project, the name was changed to Anugraha Regency.

18 The defendant's Yio Chu Kang project's name was identical to the plaintiffs' trademark, Amanusa (not registered in Singapore). It also bore the prefix Aman and was therefore identical with or otherwise similar to the plaintiffs' various Aman trademarks in essential aspects. The plaintiffs have also been involved in the business of promoting and selling real estate in association with their Aman resorts. Both the plaintiffs and the defendant were therefore providers of identical or similar services (in real estate and accommodation).

19 Three of the plaintiffs' luxury resorts are in Bali. In addition, the plaintiffs' Amanwana resort is located on Moyo Island which is near to and accessed through Bali. The defendant's sales brochure and newspaper advertisements in February 2006 described the Yio Chu Kang project as having a Balinese-inspired retreat that included a water-themed backdrop. The advertisements also described the said project as "exclusive", a "private hideaway" with luxury fittings. This was similar to the way

the plaintiffs' Aman real estate and resorts were described. Further, the name Amanusa had no natural connection with the defendant but was strongly associated with the plaintiffs since 1992. The adoption of that invented word would give the impression that the Yio Chu Kang project was connected to the plaintiffs. The confusion caused would be a continuing one as the units in the said project could be sold by the present buyers to others, including foreigners (subject to approval from the authorities). In 2006, foreigners formed about 23% of buyers of private properties in Singapore. Many of the plaintiffs' customers or potential customers were foreigners and there was a strong likelihood that they would be confused into believing that the Yio Chu Kang project was connected to the plaintiffs.

20 The use of the name Amanusa by the defendant would lead to the gradual whittling away and eventual erosion of the uniqueness and exclusivity associated with the plaintiffs' Aman trademarks and lessen their capacity to identify and distinguish the plaintiffs' goods and services from others. Other third parties could also decide to do the same, thereby causing further whittling away and erosion. Members of the public in Singapore would no longer associate the Aman brand with a standard equivalent to other prestigious developments here, such as the Four Seasons Park and the St Regis Residences. There would also be loss of branding fees as other developers would see no need to pay for the exclusive use of the Aman brand for their projects. The plaintiffs would suffer further damage in not being able to use the name Amanusa or other Aman-prefixed name for their own real estate developments in Singapore or elsewhere due to possible customer confusion, given the globalised nature of the plaintiffs' real estate market.

21 Two private investigation agencies were employed by the plaintiffs to conduct investigations in relation to the Yio Chu Kang project. On 26 March 2007, Leong Chee Wing ("Leong"), general manager of Pan Intel Investigation & Consultants, visited the defendant's sales office cum show flat in the vicinity of Balestier Road. There he met Jerry Koh ("Jerry") of Huttons Residential Pte Ltd ("Huttons"), the marketing agents for the Yio Chu Kang project. Jerry explained to him the details of the project and handed him a hard-cover sales brochure. Leong asked Jerry about the name Amanusa and was told that it was an Indian name, "it is like a resort, there is a resort called Amanusa. It is a very famous resort". Jerry explained further that a search on the Internet would show the Indonesian resort. Jerry's colleague added that the name meant "quiet, safe, native".

22 Kelley Teo ("Kelley"), a private investigator employed by Commercial Investigations LLP, visited the sales office for the Yio Chu Kang project on 30 March 2007. She spoke to Jason Cai ("Jason") of Huttons and was given a hard-cover sales brochure. When she mentioned that the development looked "kind of like exclusive", Jason said that was because it was named after a very well-known holiday resort and that the concept of the Yio Chu Kang project was resort living. Jason was unable to say where that famous resort was located.

23 The pleaded particulars of the defendant's alleged fraudulent intention to deceive were:

- (a) the defendant and/or its representatives and agent involved in the development of the Yio Chu Kang project knew of the Aman group of resorts and its other Aman properties;
- (b) the defendant deliberately chose the word Amanusa for the name of its condominium development, a name identical to the plaintiffs' Amanusa resort in Bali;
- (c) the defendant intended to use the Amanusa name to market the Yio Chu Kang project as one with an exclusive and luxurious Balinese resort-style concept; and
- (d) the use of the name Amanusa was intended to show a connection between the plaintiffs'

Amanusa resort and the Yio Chu Kang project.

24 The plaintiffs claimed a declaration that their Amanusa trademark and/or their Aman trademarks were well known trademarks in Singapore and, pursuant to s 55(3)(a) of the Trade Marks Act, an injunction to restrain the defendant from using a trade name, trademark or business identifier including the prefix or word Aman in relation to any form of accommodation. The plaintiffs also sought an injunction to restrain the defendant from passing off any form of accommodation as that of the plaintiffs by the use of the trademark Amanusa or any word with the prefix Aman or otherwise. They sought an order for delivery up and destruction, at the defendant's expense, of all goods and documents, the use of which by the defendant in the course of trade would be a breach of the said injunctions and an order for the removal of the name Amanusa or any word with the prefix Aman from any infringing goods which could not be delivered up. The plaintiffs also asked for an inquiry as to damages or an account of profits for the unauthorised use of Amanusa and/or passing off the Aman trademarks, interest and costs.

The defendant's case

25 The defendant averred that the Yio Chu Kang project was targeted at homeowners in Singapore, unlike the plaintiffs' resorts and accommodation which focused on visitors, tourists and corporate convention participants. It claimed that there was no likelihood of, or no, confusion or deception and no likelihood of, or no, damage to the plaintiffs' interests.

26 Manoj Dharmadas Kalwani ("Manoj"), a director of the defendant, testified that besides the Yio Chu Kang project, the defendant and its sister companies had developed many other residential projects in Singapore, such as The Tai Pan, Tai Pan Jade, Tai Pan Regency, Bluwaters, Platinum Edge, Iridium and Vanadium. These projects were successful because of reasonable pricing, convenient locations and, in particular, quality finishes and furnishings for which the defendant was well known. The purchasers of the units were mostly Singaporeans wishing to own a home or to upgrade.

27 In July 2005, the defendant bought the 56,355 sq ft site on which the Yio Chu Kang project now stands. It was then a vacant plot of land with lush greenery and thick foliage all round, nestled in a quiet residential neighbourhood and near a nature reserve. The defendant discussed with its architects on how to capitalise on the site to ensure a successful residential project. It was decided that the Yio Chu Kang project would comprise a cluster of 36 three-storey terrace houses with basement car park and roof garden. The project would also harmonize with its surroundings and provide a peaceful and soothing place of abode for its occupants. There would also be high-quality fixtures and equipment in the units. Because of the vision to provide an oasis or a sanctuary, the architects suggested the name Amanusa which meant "peaceful island" in Malay. The defendant agreed, without then knowing about the Amanusa resort in Bali or other Aman resorts and hotels.

28 On 1 September 2005, the architects applied to the Street and Building Names Board to name the Yio Chu Kang project as Amanusa. Approval was given within a week. This reinforced the defendant's view that the name was appropriate for the project. This was because the said board rejected an application in December 2004 in respect of another project (at Jalan Loyang Besar) which the defendant had proposed to name "Paradise Waters" on the ground that it could create the wrong impression that the development was located next to the sea. At that time, the defendant was still ignorant about the plaintiffs' resorts.

29 The defendant then engaged Debenham Tie Leung (SEA) Pte Ltd ("DTZ") to market the Yio Chu Kang project. Manoj spoke to some of the visitors at the show flat and learnt that most of them were Singaporean families wishing to own landed property or to upgrade from their current homes, mainly

public housing. They did not give him the impression that they were there because they thought the Yio Chu Kang project was related to the plaintiffs' resorts. He paid attention to all this because the defendant had received the plaintiffs' letter of demand dated 14 February 2006 alleging passing-off.

30 The defendant's solicitors responded to the said letter of demand. The defendant denied that the 1st plaintiff had extensive reputation or goodwill in Singapore in respect of Aman or Amanusa. The defendant stated that the Street and Building Names Board would not have approved the name for the Yio Chu Kang project if it was distinctive and associated in Singapore with only the 1st plaintiff. The defendant also did not believe that many Singaporeans had heard or were aware of Aman or Amanusa. Any such knowledge, it argued, would be confined to a very small and select group of Singaporeans. It also argued that Aman was a common and descriptive Malay word meaning "peace" and that Nusa meant "motherland" and that "peaceful motherland" was an appropriate name for the project with its serene environment. The defendant denied any likelihood of confusion between the Yio Chu Kang project and the plaintiffs' resorts. Further, the developer was clearly stated in the sales brochures as the Novelty Group. The residential housing project was also clearly different from the "temporary holiday accommodation" provided by the 1st plaintiff overseas. The actual and potential customers were different. The defendant's customers would only purchase a unit after lengthy and careful consideration and evaluation and would not be confused.

31 In another letter (dated 6 March 2006), the defendant's solicitors reiterated that the "composite word" Amanusa meant "peaceful motherland" and that the component words were common descriptive ones which the courts were loathe to allow anyone to monopolise.

32 As a result of the plaintiffs' letter of demand, the defendant started issuing questionnaires to potential purchasers of the Yio Chu Kang project from July 2006. Some of the questions asked were, "What were your reasons/factors for choosing the Amanusa development?", "Would you have chosen the Amanusa development if it were called by some other name? (Please state reason(s) for your "yes" or "no" or any other answer)" and "Does the name/word "Amanusa" mean anything to you? If so, please indicate its meaning to you". There were 51 responses and these did not bear out the plaintiffs' allegations of confusion. As at 5 March 2007 (more than a year after marketing began), only 11 of the 36 units in the Yio Chu Kang project were sold, unlike some of the defendant's other projects which sold out within 6 to 8 months of their launch. (At the time of the trial, only one unit remained unsold.) The defendant submitted that the name Amanusa therefore did not help in driving the sales.

33 From the plaintiffs' sales brochures and other promotional materials and their trademark certificates (relating to their Aman-prefixed marks), it was clear that the plaintiffs were not in the business of building residential and commercial properties for sale or lease to homeowners. The plaintiffs were in the business of providing leisure, retreat, recreational, spa and other such services within the luxurious and expensive resorts and hotels owned or operated by them. The accommodation provided by them was short-term stay in the resorts and hotels.

34 The plaintiffs' business catered to very well-to-do and high net worth individuals. The room rates for Amanusa in Bali were between USD700 and USD 1,500 per night, not including 10% service charge and 11% government tax. The range of room rates for the plaintiffs' other resorts in Bali was similar to Amanusa's. Out of the 1,382 guests from Singapore between 1995 and 2005, many were probably repeat guests (the so-called "Aman junkies"). The plaintiffs' villas and homes were adjacent to and were part of the relevant resorts, enjoying the same amenities such as tennis courts and fitness centres. They were owned by others but managed by the plaintiffs and catered to a different category of guests from those in the resorts, such as those with large families or those who want

their privacy. The rates for the villas were similarly very high. It was thus evident that the plaintiffs and the defendants catered to different market segments and different clientele.

35 Purchasers of real estate in Singapore would generally be discerning and cautious, considering other factors such as price, location, amenities and the reputation of the developer before making a commitment. Ordinary Singaporeans wishing to travel overseas for holiday were highly unlikely to find themselves in the Yio Chu Kang project thinking that they were in the midst of the plaintiff's luxurious Amanusa resort. The plaintiffs' fear of confusion or deception was unfounded or imaginary. This was borne out by three of the defendant's purchasers who testified at the trial that when they bought their respective units in April 2006 and in April 2007, they had not heard of the plaintiffs' resorts and did not decide to buy because of the name Amanusa. One of them was an Indonesian businessman who travelled frequently between Jakarta and Singapore. Another, a Singaporean lady, testified that her husband did some research on the Internet about the Yio Chu Kang project before buying a unit and chanced upon the plaintiffs' website, www.amanresorts.com, and the Amanusa resort. However, the sales agent marketing the Yio Chu Kang project merely said that he had heard of a resort somewhere having the same name and did not claim any connection between the Yio Chu Kang project and the Amanusa resort.

36 Chan Sze Chin ("Chan") of JGP Architecture (S) Pte Ltd, the architects for the Yio Chu Kang project, explained how the name Amanusa was eventually chosen for the said project. His colleagues and the defendant's other consultants met for brainstorming sessions for a suitable name for the project, keeping Chan informed of the progress as he was its concept architect. They were all aware of the guidelines set out by the Street and Building Names Board that the choice of name should reflect and reinforce the Singaporean character of the locality of the site. They considered "Cascading Waters" and "Tropical Waters" but decided that these were too mundane and lacked appeal. From experience, they knew that using a non-English name, such as "Les Jardins de Hollande", could help to drive sales. However, as the project had a tropical theme, French names were inappropriate. They then turned to the dominant languages in south-east Asia, namely, Bahasa Indonesia and Malay.

37 They decided to leverage on the tranquillity of the project's surroundings and "peaceful" came to mind. Two possible equivalent words in the said dominant languages for "peaceful" were "aman" and "sentosa". The latter was rejected as it would be associated with our southern island bearing that name. Having decided on Aman, they considered words that could capture the setting as well. They came upon the term "nusantara" meaning "archipelago". However, the word was too long and it was decided that it would be shortened to "Nusa" meaning "island", which would convey the impression of an oasis and sanctuary, the very ambience they were seeking to create.

38 After deciding on the two components, they had to decide on the order of the two words in a way that could be easily pronounced and remembered. Amanusa was preferred over Nusa Aman as the former "rolled off the tongue more easily". One of the "n"s was dropped because the double "n" would cause the reader to pause before pronouncing the word as it would be very difficult to pronounce. Since it was a name, it would be easier to have one word instead of two. For instance, in one project, the two Malay words "tanah" and "merah" were compressed into "tanamera". It was felt that the name would adequately capture the design concept for the Yio Chu Kang project. The brainstorming team members were not aware of the plaintiffs' Amanusa resort then although Chan had heard of Amanpuri in Phuket, Thailand. However, he foresaw no difficulty as that resort was completely different in many aspects from the Yio Chu Kang project and it never crossed his mind that any sensible person would object to the use of the name Amanusa on the ground of confusion with Amanpuri. The choice of name was therefore not influenced in any way by the plaintiffs' Aman resorts and hotels.

39 On 8 September 2005, the Street and Building Names Board approved the name Amanusa unconditionally and stated that no request for a change of name would be entertained. Chan and his team were aware that the said board would not approve a proposed name if it was identical with or substantially similar to the name of an existing development here or elsewhere such that there was a likelihood of confusion. For instance, the defendant had originally wanted to name its Bluwaters residential development as Twin Waters but that name was rejected as there was a resort known as Twin Waters in Australia, something Chan and his team were not aware of. That earlier unsuccessful application showed that the said board did checks with names of developments and resorts in other countries.

40 When Chan was asked by the court whether the team checked the coined word Amanusa on the Internet, he replied that it did not because it knew that the proposed name would have to be approved by the Street and Building Names Board and there would therefore be some form of checking already. The team thought the name sounded nice and was quite comfortable with it.

41 Huttons took over the marketing of the Yio Chu Kang project from March 2007. Jerry (see [21] above) testified that he and the other sales agents of Huttons were briefed by their project director on the Yio Chu Kang project. They were told specifically that the said project was not related to or associated with the Amanusa in Bali in any way. They were also instructed not to link the project to the Bali resort. In addition, all purchasers of units in the said project would have to sign a declaration form acknowledging and agreeing that their request for an option to purchase and their subsequent exercise of the same "do not confer upon me/us any right or interest in respect of the name "Amanusa" and that the name does not and will not constitute a consideration influencing my/our decision to exercise the option to purchase". Jerry understood this to mean that the purchasers would be informed thereby that the Yio Chu Kang project was not related to the Amanusa resort in Bali. Jerry did not know the reason behind the "unprecedented step" although he had heard rumours there was a legal dispute regarding the project's name. It did not matter to him as he knew from experience that Singaporeans did not usually care about the name of housing developments unless it sounded inauspicious.

42 Jerry complied with the above instructions in all his dealings with prospective purchasers. On 26 March 2007, when the private investigator, Leong (see [21] above), and his companion visited the sales office, Jerry did not volunteer any information about the name Amanusa. His only reference to "resort living" was when he wanted to illustrate his point that having a home in the Yio Chu Kang project would resemble resort living. It was only when Leong talked about the name of the project that Jerry replied that he was aware of a resort of that name. However, Jerry did not suggest any linkage between the project and the Amanusa resort. No other prospective purchaser showed any interest in the name of the project.

43 Another of Huttons' sales agents, Jason (see [22] above, whose actual name is Sua Ting Kuang), confirmed the instructions spelt out by Jerry above. When he met Kelley and her companion at the sales office on 30 March 2007, towards the end of his sales pitch, the private investigators commented that the Yio Chu Kang project looked exclusive. Eager to make small talk, Jason replied that "it was because the project was named after the resort". As prospective purchasers were generally not interested in the name of a project, he had not bothered to do any research about the resort "other than what [he] had heard from [his] colleagues". When pressed further about the resort, he therefore hazarded a guess that it must be an expensive resort in some western country. At no time did he say that the project was linked to the Amanusa resort, which he had not heard of then. Like Jerry, Jason was also of the view that prospective purchasers of property in Singapore were not interested in a project's name unless it happened to sound inauspicious. He believed it to be highly unlikely that anyone would confuse the Yio Chu Kang project with the Amanusa in Bali.

44 By 30 March 2007, the defendant had modified its hardcover sales brochure. For instance, on the outer cover, a thatched roof at the top right corner and a water spout featuring a mythical creature were erased in the later version. In the write-up inside, the word "Balinese" was omitted from the sentence "Borrowing from a hybrid of modern and tropical architectural style, Amanusa, which translates to "peaceful isle", sets the scene for a true Balinese experience".

45 Bharat Dharmadas Kalwani ("Bharat"), brother of Manoj (see [26] above), a director of the defendant and the group president and chief executive officer of the Novelty Group, affirmed an affidavit of evidence-in-chief which was admitted in evidence without the deponent being called as there was no challenge to his evidence. His evidence addressed the statement by the plaintiffs' Gregory Sirois that the defendant had links with the hotel and resort business because of Bharat's involvement with a company called Royal Woods Resort Pte Ltd ("Royal Woods") whose business activities were listed as "country and golf clubs" and "real estate activities on a fee or contract basis".

46 Bharat stated that there were only three companies within the Novelty Group which were involved in the hotel or resort business. One of these (Royal Woods Resort Pte Ltd) bought land in Australia in 1995 for the purpose of building a residential development. However, before it could build, the property market there suffered a downturn. It then decided to build and market the development as a time-share resort. Shortly thereafter, such resorts received bad publicity in the media and so, around the year 2000, the company started leasing the units on short-term tenancies as vacation accommodation. The time-share memberships that were already issued continued alongside the said tenancies.

47 Bharat was not involved in the daily operations of that company although he was one of its directors as he had many other companies to take care of. The control and management of that company and the resort were entirely in the hands of his sister.

The decision of the court

48 In *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 ("the *Millenia* case"), our Court of Appeal said (at [86]):

In conclusion, it would be helpful to remind ourselves of the essential elements of the tort of passing off. Lord Oliver in *Reckitt & Colman Products Ltd v Borden Inc* (supra) gave the following summary at p 406:

The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely upon a

particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

These pronouncements were made with reference to the business of sale of goods in that case but they are equally applicable to the business of provision of services, such as in the instant case. The respondents had successfully showed that the three elements of passing off were present: goodwill, misrepresentation and probability of damage. ...

49 The plaintiffs' brand name Amanusa is distinctive because it is a portmanteau word invented through the clever use of intentional syntax error coupled with syncopation by dropping one "n". Incidentally, the *Millenia* case also concerned a dispute over a word (Millennia) which had one of its "n"s omitted (to become Millenia), like the word Amanusa here. There is no such word as Amanusa in the Indonesian language. This was not in dispute. The brand name Aman, although a descriptive word (meaning "peace" or "peaceful") standing by itself, is also a fancy mark when used in relation to hotels and resorts as it is not merely describing the plaintiffs' goods and services. Aman hotel and Aman resort can be and are as distinctive as the Hotel de la Paix ("paix" being the French word for "peace") and the Peace Hotel in Shanghai, China.

50 The plaintiffs' brand names Aman and Amanusa did have goodwill in Singapore (before 2006), as evidenced by their nearly two decades of history, their huge sales revenue worldwide (more than 35% of which is attributable to its Singapore office) and their substantial promotional and marketing expenditure. The fact that there is no Aman resort in Singapore is immaterial (see *Sheraton Corp of America v Sheraton Motels Ltd* [1964] RPC 202). Although the plaintiffs did not advertise through the traditional media of newspapers and television, they have asserted their presence through other means, such as their promotional materials to travel agents, collaboration with airlines and credit card companies in targeting high net worth individuals, their newsletters to customers in Singapore and elsewhere and their more than 20 domain names over the Internet (all of which are hosted here).

51 In luxury markets such as this, an article in a periodical about the Aman resorts may build their reputation more effectively than paid advertisements in the usual media. As the trial judge in the *Millenia* case, Chao Hick Tin J (as he then was), said (see [1997] 3 SLR 726 at [50]):

Advertising in the press and other media is of course an obvious means and perhaps the most expeditious means. But if there are reports in the media extolling the virtues or excellence of a service I fail to understand why that should be disregarded. I would have thought the important thing is what is the message that is being conveyed, not whether the owners pay for the media's space or time. It is the message that counts. If the press or a periodical should do a write-up on RCMS arguably, in terms of goodwill, that could even be better than a paid advertisement. The publication of brochures and material could also generate goodwill. The launch of the Ritz-Carlton, Millenia Singapore on 17 October 1994 could just as much help to establish goodwill, at least among those invited guests, who were people from the industry or people who had an interest in the project or were influential.

The plaintiffs have adduced in evidence many independent publications, foreign and local, describing the Aman resorts and the Amanusa with superlatives. These were not confined to specialist travel magazines or publications targeted at well-to-do readers. They included periodicals of general interest and mass appeal such as *Female*, *Time* and *Her World*.

52 In the *Millenia* case, a hotel which was in the process of construction succeeded in its claim that it had goodwill in its name. In the instant case, the first Aman resort has been in operation since 1988, the Amanusa has been in existence since 1992 and the plaintiffs' International Reservations Office has been operating here since 2001. The plaintiffs did allow their Amanusa trademark registration in Singapore in respect of international classes 3, 16, 25 and 42 to lapse for economic reasons but clearly, there was never any intention to stop usage of the Aman and Amanusa brand names here.

53 Some 1382 Singaporeans visited the Amanusa resort in Bali between 1995 and 2005. This resort is just one out of three Aman resorts on that island. The number of visitors to the Amanusa may not be astronomical (especially if, as the defendant suggested, a number of these are repeat visitors) but that is largely due to the fact that Aman resorts are not numbers-oriented. For example, the Amanusa has only 35 villas and the Aman resorts worldwide have only 626 rooms. In the same way that ultra-luxury cars are not produced nor purchased in large numbers, the statistics merely reinforced the exclusivity and uniqueness of the resorts. I am of the view therefore that the plaintiffs did have goodwill and reputation here in its Aman resorts in 2006, when the Yio Chu Kang project was marketed to the public, and even earlier. The Aman and Amanusa names were and are wholly distinctive of the plaintiffs.

54 Where misrepresentation is concerned, *The Law of Passing-Off* by Christopher Wadlow, 2004 Ed, has this to say (at paragraphs 1-9, 5-5 and 5-8):

The misrepresentation in passing-off is almost always conveyed by the defendant adopting for his own goods or business some material such as a name, mark, get-up or other sign which is deceptively similar to material distinctive of the claimant. The misrepresentation is deemed to be made as soon as such goods are released into circulation, even if the immediate recipients are traders who are not themselves deceived.

...

The misrepresentation need not relate to goods, but may be to the effect that the businesses of the claimant and the defendant are the same, or have merged, or that one is a branch, agency, subsidiary of the other; or, more generally, that the defendant has any connection with the claimant that is likely to cause damage ...

...

Most importantly, the misrepresentation in passing-off need not be made fraudulently or with any intention to deceive: "calculated" in Lord Diplock's speech in *Advocaat* means *likely* rather than *intended*. The only continuing importance of fraud is for its evidential value.

55 Our Court of Appeal in the *Millenia* case said (at [72]) that in an action where one party is seeking to prevent an apprehended misrepresentation by another, the test is whether there is a real risk that the defendant's representation would deceive a substantial number of persons of the relevant section of the public into believing either that the goods or services of the defendant are those of the plaintiff or that there is a business connection between the plaintiff and the defendant in relation to the goods or services provided by them. The Court of Appeal went on to state (at [73]):

Whether there is a 'substantial number of persons among the relevant section of the public' depends on the particular circumstances of each case. A 'substantial number' does not necessarily mean a large proportion of the public. In *Neutrogena Corp v Golden Ltd*

[1996] RPC 473, the successful plaintiffs did not have a huge percentage of the market. Its product, namely, shampoo, only had 0.25% of the market, but it was held that a substantial number of members of the public would be misled into thinking that the defendants' products were those of the plaintiffs.

56 The *Millenia* case was concerned about the similarity between the words 'Millenia' and 'Millennium', each of which appeared with some other words to identify a particular hotel. In the present case, we are dealing with two developments bearing exactly the same name – nothing more, nothing less than Amanusa. It matters not that different fonts or colours are used by the parties in setting out the name. Amanusa, in whatever font or hue, will still be pronounced the same way and any name search on the Internet will present both the Bali resort and the Yio Chu Kang project in the results. The plaintiffs' burden is therefore lightened to the extent that they do not have to demonstrate the visual or aural similarities between their name and that used by the defendant.

57 The relevant section of the public in the present case would encompass Singapore citizens or residents who have visited the Aman resorts once or more times or are prospective visitors to the resorts, foreign individuals and corporations here intending to visit the resorts or seeking to invest in high-end properties (and there is a substantial number of foreign entities here) and developers and hoteliers interested in becoming licensees of the Aman brand names. Conceivably, there would also be a portion of the more than 300,000 Singapore visitors to Bali since 1995 who have read about or heard of the three Aman resorts there. As stated earlier, when dealing with luxury goods and services catering to those who think nothing of spending USD700 or more per night, it should not be surprising that the number of people patronising Aman resorts or who are familiar with their goods and services is a relatively small one. That does not detract from the reality that those goods and services are well known to those for whom they are designed.

58 Although the risk of confusion will increase if the parties are in mutual competition, it is settled law that they need not be in common fields of enterprise (see The *Millenia* case at [63]). It must be borne in mind that today's businesses tend not only to expand geographically, there is also a perceptible trend that brand names do not confine themselves to the original products or services which made them famous, even though such products or services may remain their core competence, but may diversify into other areas, whether related or not. For instance, Dunhill has long ceased to be only a famous brand of tobacco. The parameters of different industries are also being constantly redrawn by convergence and re-definition. Convergence of erstwhile disparate areas in electronics is already an established fact.

59 Similarly, the dividing line between purely residential developments and luxury hotel/resort developments is no longer pronounced. The law should recognise such changing business practices and conditions. Here, the defendant's Yio Chu Kang project bears the same coined name as the plaintiffs' Bali resort. That nexus in itself is bad enough. Further, the Yio Chu Kang project is also being billed as having the atmosphere of a Bali resort and has features of Balinese architectural style. There is a significant body of persons in Singapore who have heard of the Aman resorts, particularly Amanusa in this case. The use of an identical name for the Yio Chu Kang project would give them the impression that it is somehow related or connected to the plaintiffs, perhaps by way of licence to use the name or that the development has the plaintiffs' endorsement and will in future be managed by them. It may even convey the wrong impression that the plaintiffs are involved as developers. The precise nature of such relationship or connection is not material and the degree of connection would depend on the particular facts of each case. The husband of one of the defendant's witnesses (a purchaser of a unit in the Yio Chu Kang project) certainly drew such a connection when he asked the marketing agent whether the Yio Chu Kang project had anything to do with the Amanusa resort in Bali. Another of the defendant's purchasers acknowledged that, if he had heard about the Aman

resorts, he would have to check whether the Yio Chu Kang project was related to them.

60 It is no answer to an allegation of misrepresentation in such a case to say that one could easily check the facts with the defendant or its agents or through its sales brochures (which would indicate the name of the developers for the project) or otherwise check with the plaintiffs or other independent sources. The defendant should also not be allowed to say that the relevant section of the public in this case would tend to be more intelligent and would verify matters which they are not certain about. The fact that such checking or verification is required is itself evidence of confusion. Even if the defendant were to publish a disclaimer of any connection to the Aman resorts, that would not help dispel future confusion because the Amanusa name will remain in documents relating to addresses and will, in all probability, be displayed at the main gate of the Yio Chu Kang project. On this point, it should also be noted that it is not necessary to show any confusion occasioned by the misrepresentation although confusion is of great evidential value in determining whether or not there has been misrepresentation (see *The Millenia* case at [71]).

61 I therefore accepted that there was misrepresentation in the circumstances. What I did not accept was the allegation that such misrepresentation was fraudulent on the part of the defendant in that it had a "fraudulent intent to deceive" (see the pleadings set out at [23] above). There is no monopoly in a particular country's style of architecture or theme (for instance, Balinese style or Japanese Garden). The defendant or its agents did not deliberately and deceptively portray the Yio Chu Kang project as being connected to the Amanusa resort. There may have been passing remarks that there is a resort by that name in Bali or elsewhere but that is still far from fraudulently claiming or implying a connection between the two. There may also have been some plagiarism in that some nice-sounding, laudatory phrases used in literature to describe the Amanusa resort were used in the defendant's sales brochure to describe the Yio Chu Kang project but, again, that falls short of fraud.

62 However, I did not accept the defendant's evidence as to how the Yio Chu Kang project's name was given birth to by the creative invention of inversion of two words. It would be much too coincidental that the defendant chanced on the same two foreign words and decided to fuse them in exactly the same way as the plaintiffs did some 15 years earlier in respect of a resort which also had a Balinese theme. This is reinforced by the defendant's initial claims in the correspondence that the name meant "peaceful motherland" when its actual meaning was already in the sales brochure. In this Internet age, it is also hard to believe that no search whatsoever was made to see if the invented word actually existed in some language and, if so, whether it could possibly mean something quite unintended or even untoward. This is especially so when the defendant acknowledged that it was aware that the Street and Building Names Board would not permit a name to be used if it was similar to a development here or elsewhere. The members of the brainstorming team would surely want to do some research so that their proposed name would not be rejected outright on this ground, thereby causing a delay in the launch of the Yio Chu Kang project for want of a name. The reluctance to acknowledge that a search was conducted on the Internet was most definitely because any such search would have shown the name was that of the plaintiffs' resort in Bali. I believe that the defendant's architect was inspired by the Amanusa resort which he must have read about or seen pictures of in the course of his work or research and that he tried to replicate the ambience of a Balinese resort and, at the same time, pay the sincerest form of compliment by copying the famous name.

63 The plaintiffs do not have to prove actual damage to succeed in this action. A probability of damage suffices but the actual or probable damage must be to their goodwill in respect of their trade or business (*Nation Fittings (M) Sdn Bhd v Oystertec Plc and anor* [2006] 1 SLR 712). The plaintiffs claimed the following heads of damage:

- (a) loss of licensing opportunity or income (see *Lego System Aktieselskab v Lego M Lemelstrich* [1983] FSR 155);
- (b) inferiority of the defendant's goods and services (see *Rolls-Royce Motors Ltd v Zanelli* [1979] RPC 148);
- (c) likelihood of damage should the defendant get into financial, legal or other trouble (see *British Legion v British Legion Club (Street) Ltd* (1931) 48 RPC 555);
- (d) misappropriation of the plaintiffs' goodwill and reputation (see *Lloyd's v Lloyd's (Southampton) Ltd* (1912) 29 RPC 433);
- (e) restriction on the plaintiffs' natural expansion into residential real estate (see *Eastman Photographic Materials Co Ltd v Griffiths (John) Cycle Corp Ltd* (1898) 15 RPC 105);
- (f) loss of exclusivity and erosion of distinctiveness (see *Taylor Bros v Taylor Group* [1988] 2 NZLR 1);
- (g) dilution of the brand name (see the *Millenia* case).

64 The evidence shows that none of the purchasers of units in the Yio Chu Kang project did so on the misunderstanding that it was related to the Aman group or to Amanusa resort. Actual damage was therefore not shown. It is also unlikely that future purchasers (by sub-sale or re-sale) would buy on the basis of such misunderstanding. This is because purchasing real estate is not quite the same as buying a shirt or a handbag. The former would invariably involve some preliminary work or research and further discussions or even viewing before a deal is finalised. Any misunderstanding would be dispelled by such activities (although, as stated at [60] above, this is no answer to an allegation of misrepresentation).

65 For a case like the present, the most potent form of likely damage is the intangible loss that may be occasioned by the insidious process of dilution such that the famous name loses its uniqueness or, worse, such that the name which inspired hushed awe could in future evoke suppressed laughter because of the association with projects that do not quite exude the same luxury and class or quality of upkeep, especially when residential projects have begun to show their age. As experience shows, this is particularly true for developments which contain shared common property. I find the following comments of our Court of Appeal in the *Millenia* case (at [84]) to be highly appropriate for this case, bearing in mind of course that the parties in that case were both in the hotel industry:

The concern here is the public's perception that RCMS, Millenia Tower and Millenia Walk are associated with or related to the Millennium hotels of the appellants and such association would be likely to result in a dilution of the respondents' goodwill in their business. The respondents have acquired goodwill in their business at the Millenia complex which is inextricably associated with the use of the name 'Millenia'. In so far as the hotel industry is concerned, RCMS symbolises world class quality and prestige with top-of-the-range services and amenities. The appellants' hotels in Singapore are of a lower class and quality and are more economically priced. Hotel guests pay a premium to stay at RCMS. It would be commercially damaging for a business of a super deluxe 'five-star' hotel, as RCMS is, to be associated with that of a 'four-star' hotel, which the appellants' hotels admittedly are.

Visitors to Aman resorts, like the guests at RCMS (The Ritz-Carlton, Millenia Singapore), pay a

premium to stay at the resorts. On the other hand, as emphasized by the defendant and its counsel, the Yio Chu Kang project's target buyers were people looking for reasonably-priced landed property (the listed prices for most of the units ranged from \$1.3m to \$1.45m, with the most expensive unit priced at \$1.8m). Although the defendant did assert that its projects were well known for their high quality finishes and imported fixtures, I doubt the Yio Chu Kang project would be capable of replicating the ambience and spaciousness of the plaintiffs' resorts. I quote the words of one of the visitors to the defendant's sales office, who responded to the defendant's questionnaire asking whether the word Amanusa meant anything to him by answering, "means spa; alone; serene – but the development is totally opposite to its meaning. Very crowded" (emphasis in original)(see page 302 of Manoj's affidavit of evidence-in-chief).

66 I also accepted that the plaintiffs would be deprived of licensing revenue if developers were permitted to appropriate the Aman names for their residential projects. As shown in evidence, the defendant has named its other projects using names with a common theme, for example, the Taipan series and the "metal" series. The plaintiffs were rightfully wary that the defendant, if not stopped in its tracks now, would start an Aman series, using the names of its various resorts. The plaintiffs would also be prejudiced in any future commercial plans to expand into residential developments here, whether alone or in partnership with others, if they did not seek to protect their Aman names now.

67 The second aspect of the plaintiffs' claim is that their trade marks are well known marks within the meaning of s 55 of the Trade Marks Act, the relevant portions of which provide:

- (1) A well known trade mark shall be entitled to protection under this section –
 - (a) whether or not the trade mark has been registered in Singapore, or an application for the registration of the trade mark has been made to the Registrar; and
 - (b) whether or not the proprietor of the trade mark carries on business, or has any goodwill, in Singapore.
- ...
- (3) Subject to subsections (6) and (7), the proprietor of a well known trade mark shall be entitled to restrain by injunction the use in Singapore, in the course of trade and without the proprietor's consent, of any trade mark which, or an essential part of which, is identical with or similar to the proprietor's trade mark, in relation to any goods or services, where the use of the trade mark –
 - (a) would indicate a connection between those goods or services and the proprietor, and is likely to damage the interests of the proprietor; or
 - (b) if the proprietor's trade mark is well known to the public at large in Singapore –
 - (i) would cause dilution in an unfair manner of the distinctive character of the proprietor's trade mark; or
 - (ii) would take unfair advantage of the distinctive character of the proprietor's trade mark.
- ...

(11) For the purposes of this section and sections 55A, 56, 57 and 59, "use", in relation to a trade mark, means use within the meaning of section 27(4).

The plaintiffs are relying on only s 55(3)(a) for their case.

68 Section 2(1) of the Trade Marks Act defines "well known trade mark" as:

- (a) any registered trade mark that is well known in Singapore; or
- (b) any unregistered trade mark that is well known in Singapore and that belongs to a person who –
 - (i) is a national of a Convention country; or
 - (ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore.

69 Section 2(7), (8) and (9), which are also concerned with well known trade marks, provide:

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;
- (b) the duration, extent and geographical area of –
 - (i) any use of the trade mark; or
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;
- (e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

(9) In subsections (7) and (8), "relevant sector of the public in Singapore" includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.

The factors set out in s 2(7) are guidelines and not pre-conditions for determining whether a mark in question is a well known trade mark. They do not preclude the consideration of other matters not listed therein which may be found to be relevant in a particular case, whether by themselves or in combination with the listed factors.

70 The defendant submitted that the “relevant sector of the public in Singapore” must refer to the actual and/or potential consumers of the defendant’s goods and not the plaintiffs’. If it were otherwise, it argued, it would be very easy for a mark to be well known because it would obviously be recognised by those who use, distribute or deal with those goods. Alternatively, the defendant contended that the relevant sector ought to be the “buying public who are actual and potential consumers of hotel and resort services, not the plaintiffs’ actual and potential customers”. However, a careful reading shows that “*the* trade mark” in s 2(7), (8) and (9) all relate to *a* trade mark which is alleged to be well known and that the goods or services in s 2(9)(a) to (c) are all qualified by “to which *the* trade mark is applied”. The phrase must therefore refer to the plaintiffs’ goods or services, since the trade mark in question would be the plaintiffs’ and would be applied to the plaintiffs’ goods or services and not those of the defendant. The categories in s 2(9) are also not exhaustive as seen in the use of the word “includes”. Section 2(7)(a) requires the *degree* of recognition by the said relevant sector to be considered as well.

71 As indicated earlier, the Aman brand name in respect of high-end hotel and resort services was well known in Singapore to its actual and potential customers as well as the people in the travel and leisure industry before 2006, when the defendant started marketing the Yio Chu Kang project. The plaintiffs have used the name Aman and its trade marks containing the prefix Aman for their resorts and services. They have also used such names at promotional events, for donations to charitable functions and on brochures. The Aman resorts have a wide geographical reach. They are spread over 12 countries, including South-East Asian ones like Indonesia, Thailand and the Philippines. Further, the plaintiffs are involved in new accommodation in many countries. Their resorts have been lauded as the best resort chain by periodicals here and elsewhere.

72 The plaintiffs also have trade mark registration for their names in various classes of the International Classification of Goods and Services and, until a few years ago, were proprietors of the Amanusa trade mark in Singapore. Administrative panels of the World Intellectual Property Organization, in 2 decisions pertaining to domain name disputes, have acknowledged that the plaintiffs were well known as Amanresorts and that the Aman group was well known in the premium end of the hotel and resort market. All relevant factors point to the fact that the Aman names are well known in Singapore. The relevant sector of the public here would clearly have a high degree of recognition of the exclusive Aman names too and, by virtue of s 2(8) of the Trade Marks Act, they are deemed to be well known in Singapore.

73 In s 2(1) of the Trade Marks Act, “trade mark” means any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the

course of trade by a person from goods or services so dealt with or provided by any other person and "sign" includes any word, name or brand. Names of buildings may be registered as trade marks under class 6 ("buildings of metal") and class 19 ("buildings, not of metal") of the International Classification of Goods and Services. The defendant has "used" the sign Amanusa within the meaning of s 27(4) by applying it to its "goods" (the Yio Chu Kang project) and offering the development for sale under that name. There is also no dispute that the defendant has "used" Amanusa in advertising (in the media, in its sales brochure and in directional signs to its sales office). Such use was in the course of trade (i.e. for commercial purposes) and without the plaintiffs' consent.

74 In my view, the tests to be adopted for "connection" and "is likely to damage the interests of the proprietor" in s 55(3)(a) of the Trade Marks Act are no different from those enunciated in case law on passing-off. I have already indicated my findings in respect of the "connection" (see [59] and [60] above) and the likely damage to the plaintiffs' interests (see [63] to [66] above). They are equally applicable to the claim under s 55(3)(a). In *The TRIPS Agreement: Drafting History and Analysis* by Daniel Gervais, 2nd Ed (2003)(at paragraph 2.171), it is said that the test "likely to damage" (in s 55(3)(a)) should be given a liberal interpretation since a simple likelihood of damage suffices and that such likelihood should be established objectively and supported by evidence. In the *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization, published in 2000, the Notes on Article 4 (which is about Conflicting Marks) state:

4.2 *Paragraph (1)(b)* is applicable irrespective of the nature of the goods and/or services to which the conflicting mark applies. ...

4.3 *Item (i)*. Under this item, a connection between a well-known mark and a third party's goods or services may be indicated, for example, if the impression is created that the owner of the well-known mark is involved in the production of those goods, or the offering of those services, or that such production or offering was licensed or sponsored by him. The interests of the owner of the well-known mark could be damaged if the goods and/or services with which the connection is established have a down-market image, thereby reflecting negatively on the goodwill of the well-known mark.

The said paragraph (1)(b) and item (i) refer to a rough equivalent of our s 55(3)(a) containing the phrase, "and would be likely to damage his interests". I believe the findings discussed earlier are consonant with the approach advocated in respect of s 55(3)(a) in these quotations.

75 In the light of all the above, I held that the plaintiffs succeeded in their claims in passing-off (but not in respect of their allegation as to fraudulent misrepresentation) and under s 55(3)(a) of the Trade Marks Act. I granted a declaration that the plaintiffs' trade marks are well known trade marks in Singapore and granted an injunction to restrain the defendant and anyone acting on its behalf from using the plaintiffs' trade marks, in particular, Amanusa, in relation to any form of accommodation. The injunction is confined to the plaintiffs' trade marks and does not extend, as claimed by the plaintiffs, to all words which include the prefix Aman because each case should be dealt with on its facts. The defendant highlighted in the course of trial that a condominium called Amaninda already exists here without protest from the plaintiffs.

76 I also ordered the defendant to stop distributing any material which describes the Yio Chu Kang project as Amanusa. However, I did not think it was necessary to order the delivery-up of such material for destruction unlike the case of counterfeit goods which should never have come into existence in the first place. The offending act was in using the name and once that has stopped, the

likelihood of damage ceases.

77 There was no immediate damage suffered by the plaintiffs. The damage is only prospective and that likelihood should no longer exist with the orders that I have made. There was therefore no need to order an inquiry as to damages or an account of profits.

78 The defendant was further ordered to apply to the Street and Building Names Board for a change of name for the Yio Chu Kang project and to inform the said board about my orders within 4 weeks from the date of pronouncement. Although the board had indicated in its letter to the defendant that no change of name would be entertained (after approval was given for the name of the project), that could not mean that the board will not give regard to an order of court. Similarly, approval by the board of any building name could not by itself confer immunity against infringement of intellectual property.

79 As the plaintiffs succeeded on most counts, I thought it appropriate to order the defendant to pay 90% of the costs of this action, the 10% deduction being in respect of the issues on which the plaintiffs failed (particularly the fraudulent misrepresentation). In the course of arguments on costs, I declined to order a certificate for two counsel pursuant to O 59 r 19 of the Rules of Court, the amendments made to that rule with effect from 1 January 2007 apparently having slipped everyone's mind then. I have since clarified with the parties by way of correspondence that my decision was that I would not order a certificate for *more than* two counsel for the plaintiffs.

Copyright © Government of Singapore.