

Court of Appeal decision on well known trade marks



By Ankur Gupta

In the wake of the Singapore Court of Appeal (SCOA) decision in *Mobil Petroleum Company Inc v Hyundai Mobis* [2008], the law concerning well known trade marks has yet again come into the limelight with the SCOA's judgment in *Novelty Pte Ltd v Amanresorts Ltd* [2009], in which the court affirmed the decision of Singapore's High Court to uphold a claim of passing off made by Amanresorts Ltd (Amanresorts) against Novelty Pte Ltd (Novelty).

The dispute between parties arose in 2006 when Amanresorts became wary of a housing project (the project) undertaken by Novelty which had been christened 'Amanusa'. Amanresorts objected to Novelty's use of this name as one of its existing resorts in Bali was named 'Amanusa'. The word 'Amanusa' was not a registered trademark in Singapore. Amanresorts based its challenge on the following two grounds:

Passing off

Amanresorts contended that in using the name "Amanusa" for the project, Novelty had passed off the accommodation as being Amanresorts' accommodation, although there was in fact no nexus with Amanresorts. The SCOA agreed that Amanresorts had made out its claim of passing off: goodwill was found to exist in the 'Aman' names in Singapore vis-à-vis high income individuals, who formed Amanresorts' core clientele, and the court held that Amanresorts had succeeded in demonstrating likelihood of damage.

Damage, the court opined, could be incurred firstly by virtue of "tarnishment of the goodwill attached to 'Aman' names due to the difference in quality between Aman resorts and the Project" and secondly, "by restrictions on [future] expansion plans [of Amanresorts] into the residential accommodation business in Singapore".

Infringement of a Well Known Mark

Amanresorts also claimed the 'Aman' names were "well known trade marks" within the meaning of Section 2(1) of the *Singapore*

Trade Marks Act (the Act), and were thus entitled to protection set out in Section 55 of the Act. Section 55(3) states that:

"the proprietor of a well known trade mark is entitled to restrain the use of any trade mark in Singapore which, in the course of trade and without the proprietor's consent, 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".

The specific allegation made by Amanresorts was that Novelty's use of 'Amanusa' would indicate a connection between the project and Amanresorts. Upholding the High Court's findings, the SCOA held that the requirements of "connection" and likelihood of damaging the Plaintiff's interest under Section 55(3)(a) would yield the same outcome as corresponding tests adopted when determining claims for passing off.

However, the court highlighted a critical difference between the tests relating to misrepresentation and damage under the law concerning passing off, and the requirements of "connection" and likelihood of damaging the Plaintiff's interests under Section 55(3)(a): the tests in passing off actions concerned the Plaintiff's goodwill, whereas the corresponding tests under Section 55 concerned the interest of the Plaintiff, and not its goodwill.

The case clarifies the position in Singapore regarding the protection of well known trade marks, drawing distinctions between marks that are merely well known in Singapore and those well known to the public at large, and between the tests relating to misrepresentation and damage in a passing-off action and the corresponding tests under s 55(3)(a) of the Act.

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