

Motherhood Pte Ltd v Lau Elaine and others
[2013] SGHC 258

Case Number : Suit No 720 of 2012
Decision Date : 25 November 2013
Tribunal/Court : High Court
Coram : Chan Seng Onn J
Counsel Name(s) : Wun Rizwi & Ow Shi Jack (RHTLaw Taylor Wessing LLP) for the plaintiff; Thomas Sim Yuan Po & Lee Xian Cong (Engelin Teh Practice LLC) for the defendants.
Parties : Motherhood Pte Ltd — Lau Elaine and others

Tort – Passing off

Trade Marks and Trade Names – Well-known trade mark

25 November 2013

Chan Seng Onn J:

Introduction

1 This was an action by Motherhood Pte Ltd (“the Plaintiff”) against Lau Elaine, Lim Poh Heng and TNAP Services LLP (“the Defendants”) for passing off and under ss 55(2) and 55(3)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”). I reserved judgment after the trial and eventually dismissed the Plaintiff’s claim on 3 October 2013. As the Plaintiff has filed an appeal, I now give my full reasons.

The facts

2 Motherhood Magazine (“the Plaintiff’s Magazine”) is a monthly print periodical dealing with issues relating to pregnancy, motherhood, parenting and childcare (“parenting issues”). It has been published in Singapore since 1983 by Eastern Holdings Ltd and/or Eastern Publishing Pte Ltd (collectively, “Eastern”). Since the formation of the Plaintiff in 1999, the Plaintiff’s Magazine has been published by the Plaintiff and Eastern. The Plaintiff and Eastern also publish other periodicals associated with the Plaintiff’s Magazine on an annual basis under the names “Motherhood Baby Plus”, “Motherhood Guide to Childcare” and “Motherhood Healthy Pregnancy”. In addition, the Plaintiff and Eastern own and operate a website and a Facebook page relating to the Plaintiff’s Magazine. Finally, since 1988, the Plaintiff and Eastern have held an annual exhibition in Singapore under the “Motherhood” mark promoting goods and services relating to parenting issues. For ease of reference, I shall refer to the “Motherhood” and “Motherhood Magazine” marks collectively as “the Motherhood Marks”.

3 On 15 May 2012, by way of an assignment agreement, Eastern assigned all their rights, title and interest in the intellectual property of the business, including the Motherhood Marks, to the Plaintiff.

4 The 1st and 2nd Defendants are husband and wife. The 3rd Defendant is a limited liability partnership set up by them on 23 March 2009. From June 2009 to November 2011, the Defendants

published an online periodical relating to parenting issues ("the Defendants' Magazine"). The Defendants' Magazine was named "Today's Motherhood" ("the Disputed Mark") and was published on a website bearing the domain name of www.todaysmotherhood.com. It started out as a monthly publication but was changed to a bi-monthly publication from February 2010. The Defendants also created a Facebook page named "Today's Motherhood" on 17 June 2009.

5 In September 2011, the Defendants participated in a children enrichment and education fair called "Star Kidz 2011". They decided to print a one-off special commemorative print issue of their magazine ("the Special Print Issue") to be distributed during the fair. The Special Print Issue was a 32-page A5 booklet consisting of the most-read articles from the Defendants' Magazine. 5,000 copies were printed and distributed free of charge at the fair.

6 On 28 September 2011, the Plaintiff's solicitors wrote to the Defendants claiming that the Defendants' use of the Disputed Mark constituted an act of passing off. They demanded that the Defendants cease using any names that were confusingly similar to the Motherhood Marks. The Defendants' solicitors replied on 14 October 2011 strongly denying all allegations of passing off.

7 In January 2012, the Defendants undertook a rebranding exercise in which they changed the name of their magazine and Facebook page to "The New Age Parents". They also started the process of migrating their website to the new domain name of www.thenewageparents.com (a process that was completed in mid-March 2012). The Defendants' solicitors then wrote to the Plaintiff's solicitors on 20 February 2012 to inform the Plaintiff of the rebranding exercise. The letter made it clear that the rebranding exercise was without admission of liability to any of the Plaintiff's claims and without prejudice to the Defendants' right to resist the Plaintiff's claims at the appropriate forum.

8 However, the Plaintiff was not satisfied as back issues of the Defendants' Magazine with the cover page bearing the Disputed Mark remained available to the public on the Defendants' website. Despite the fact that those back issues were completely removed from the Defendants' website by July 2012, the Plaintiff commenced this suit against the Defendants on 29 August 2012.

9 I should add that although the Plaintiff's Magazine has been published since 1983, the Plaintiff only applied to register "MOTHERHOOD" as a series of three marks in the relevant class groups (including magazines and electronic publications) on 23 May 2012 ("the Registered Motherhood Marks"). The application was granted by the Intellectual Property Office of Singapore ("IPOS") on 4 July 2013 on the basis of acquired distinctiveness through use, with the registration being effective from 23 May 2012. Consequently, the Plaintiff did not claim for infringement of a registered trade mark under s 31 of the TMA.

Relief sought

10 The Plaintiff based its claim on the tort of passing off and ss 55(2) and 55(3)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("TMA"), which allow a proprietor of a "well known trade mark" to restrain by injunction the use of its trade mark if the requirements of those sections were satisfied. The Plaintiff sought the following relief:

- (a) an injunction to restrain the Defendants, whether by themselves, their officers, servants or agents, or licensees or any of them or otherwise howsoever, from passing off by using the Disputed Mark or any other name which is identical with or similar to the Motherhood Marks in the course of trade on periodicals, whether in print or any other kind of media, that cover parenting issues;

(b) an injunction to restrain the Defendants, whether by themselves, their officers, servants or agents, or licensees or any of them or otherwise howsoever, from using the Disputed Mark or any trade mark which, or an essential part of which, is identical with or similar to the Motherhood Marks in the course of trade, where such use is likely to cause confusion or is likely to damage the Plaintiff's interests;

(c) an inquiry as to the damages suffered by the Plaintiff or at its option an account of the profits made by the Defendants from all the acts of passing off and payment by the Defendants to the Plaintiff of all sums found due upon assessment of the damages or profits at the inquiry;

(d) an order for erasure, removal or obliteration upon oath of all printed or online matter, materials or articles in the possession, custody or control of the Defendants, the use of which would be a breach of either of the foregoing injunctions; and

(e) full discovery of all acts of passing off and trade mark infringement by the Defendants.

My decision

Passing off

11 In order to establish passing off, the Plaintiff had to establish the "classical trinity" of goodwill, misrepresentation and damage: *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [37]. Specifically, it had to prove that:

(a) it possessed goodwill in Singapore in its magazine business with which the Motherhood Marks were associated;

(b) the Defendants had committed a misrepresentation that misled or was likely to mislead a significant section of the relevant public that its goods were actually those of, or were related to or associated with, the Plaintiff; and

(c) the Defendants' misrepresentation had caused actual damage or was likely to cause damage to the Plaintiff's goodwill.

12 I will deal with each of these elements in turn.

Goodwill

13 I will only discuss this element briefly as the Defendants readily conceded that the Plaintiff possessed goodwill in its business with which the Motherhood Marks were associated. [\[note: 1\]](#)

14 Goodwill is defined as "the attractive force which brings in custom": *The Commissioners of Inland Revenue v Muller & Co.'s Margarine, Limited* [1901] AC 217 at 224. Where goodwill is said to consist in a descriptive mark, the plaintiff must establish that the descriptive mark "has become so well associated with his goods or services such that [it] does not merely convey to the purchasing public the *nature* of his good or services but that they *originated* from him" [emphasis in original]: Susanna H S Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) at para 35.033.

15 Clearly, the word "motherhood" is descriptive of the Plaintiff's goods and services, which consist of periodicals and exhibitions dealing with parenting issues. The question therefore was whether the

Motherhood Marks have become so well associated with the Plaintiff's goods and services that they serve to denote those goods and services as coming from the Plaintiff. In this regard, it was undisputed that the Motherhood Marks have been used in association with the Plaintiff's business for decades. As mentioned at [2] above, the Plaintiff's Magazine has been published in Singapore under the Motherhood Marks since 1983, and from 1988, annual exhibitions bearing the Motherhood Marks have been organised to promote goods and services relating to parenting issues. The Motherhood Marks have also been advertised on various media in Singapore in relation to the Plaintiff's Magazine and the annual exhibitions — for example, the Plaintiff tendered evidence that it had spent a total of at least US\$93,000 and S\$181,203 on such advertising in 2011. Finally, the Plaintiff relied on the fact that the Registrar of Trade Marks had granted registration of the Registered Motherhood Marks (see [9] above) on the basis of acquired distinctiveness through use.

16 Given these circumstances, I accepted that the goodwill element was satisfied.

Misrepresentation

17 The Plaintiff alleged that by using the Disputed Mark, the Defendants had made a misrepresentation that the Defendants' Magazine, webpage and Facebook page were those of the Plaintiff or were associated with or connected with the Plaintiff. In determining whether this misrepresentation was made out, two important issues arose for my decision: (a) whether the Motherhood Marks should receive a lesser degree of protection, and (b) whether the relevant segment of the public was likely to be confused by the Disputed Mark.

(1) Should the Motherhood Marks receive a lesser degree of protection?

18 It is well-established that a descriptive mark will generally receive a lesser degree of protection, such that small differences may be sufficient to enable a defendant to avoid liability: *The Singapore Professional Golfers' Association v Chen Eng Waye and others* [2013] 2 SLR 495 ("SPGA") at [55]. The Defendants argued that this general rule applied here. They cited five cases where the courts had refused to grant relief in passing off or trademark infringement claims where the plaintiff's mark consisted of or included a descriptive term:

(a) In *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd and another and another appeal* [2000] 2 SLR(R) 214, the Court of Appeal held that "SUPER COFFEEMIX" was sufficiently different from "INDOCAFE Coffeemix", when applied to instant coffee mixes.

(b) In *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd (trading as ONE.99 SHOP)* [2000] 1 SLR(R) 687 ("*Lifestyle 1.99*"), the Court of Appeal held that "Lifestyle 1.99" was not confusingly similar to "ONE.99 Shop", when applied to shops that sold goods at a fixed price of \$1.99.

(c) In *Doctor's Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE)* [2012] 3 SLR 193, the High Court held that there was no likelihood of confusion between "SUBWAY" and "Subway niche" when applied to shops that sold sandwiches.

(d) In *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690, the Court of Appeal held that "POLO" and "POLO PACIFIC" were not similar, nor were they likely to cause confusion, when applied to clothing, handbags and shoes.

(e) In *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] 2 SLR 459, the High Court held that "GLAMOUR" (when applied to a fashion magazine) and "HYSTERIC GLAMOUR" (when applied to fashion apparel and accessories) were visually and aurally dissimilar, and were

unlikely to cause confusion.

19 But the complication in this case was that the Defendants had accepted that the Plaintiff *did* possess goodwill in the goods and services associated with the Motherhood Marks, thereby implicitly conceding that the Motherhood Marks, although descriptive in nature, had acquired a secondary meaning and had come to be associated with the Plaintiff's goods and services. Thus, the issue before me was whether the Motherhood Marks should receive a lesser degree of protection *assuming* that they had acquired such a secondary meaning. In this regard, the Plaintiff argued strenuously that the Motherhood Marks were entitled to the full degree of protection. It cited the Court of Appeal's statement that it was "not a fixed rule of principle" that descriptive terms should receive a lesser degree of protection (*SPGA* at [55]). It also sought to distinguish the cases cited by the Defendants on the basis that none of them dealt with a descriptive mark that was either well known or had acquired a secondary meaning in Singapore.

20 I did not agree with the Plaintiff's argument. In my judgment, the Plaintiff was conflating two separate issues — first, whether the Motherhood Marks had become sufficiently distinctive to establish goodwill despite their descriptive nature; and second, whether the Motherhood Marks should receive a lesser degree of protection because of their descriptive nature. The mere fact that the Motherhood Marks had acquired a secondary meaning through prolonged use (in the sense that they had come to denote the goods and services of the Plaintiff to the exclusion of other traders) did not necessarily imply that they should receive the same level of protection as fancy or inherently distinctive marks. This is clear from the following passage in Professor Christopher Wadlow, *The Law of Passing-Off* (Sweet & Maxwell, 4th Ed, 2011) at para 8-064:

... Even if a claimant succeeds in proving that a *prima facie* descriptive term has acquired some degree of secondary meaning, he will find that the scope of protection for his mark is narrower than for a wholly arbitrary term. There is a rule of law that relatively minor differences will suffice to distinguish the defendant's goods or [business] when both use a mark which is descriptive of the goods or services they provide. This applies even though the defendant is using the closely similar term in a trade mark sense. "Office Cleaning Association" was sufficiently different to "Office Cleaning Services" even though it was the trading name of the defendant. The plaintiff was free to choose a name of higher inherent distinctiveness, and the penalty for his failing to do so was that a degree of confusion would be tolerated as the only alternative to giving him an unfair monopoly.

21 Likewise, in *SPGA*, the Court of Appeal explained that a mark's descriptive nature is relevant not just for determining whether the plaintiff has goodwill, but also in assessing whether two marks are confusingly similar for the purposes of establishing misrepresentation (at [36]):

It will be evident from the foregoing that in the tort of passing off concerning names, brands or marks, it will be essential for the claimant to establish that its goodwill is sufficiently associated with its name or brand such that its name or brand is distinctive, in that it denotes the goods and services of the claimant to the exclusion of those of other traders (*Lifestyle 1.99* ([29] *supra*) at [27]) (either inherently or because the name or brand in question has acquired a secondary meaning). *The separate but related question of whether the name or mark is fancy or descriptive will be relevant in assessing both distinctiveness (as to which, see [29] above) as well as the degree of protection the law will afford the claimant. This is reflected in the level of scrutiny that is applied by the court in assessing whether the defendant has misrepresented its goods or services as those of or associated with the claimant (as to which, see [34]–[35] above). [emphasis added]*

22 In *Lifestyle 1.99*, the plaintiff was the owner of a chain of retail shops that operated under the style "ONE.99 Shop", where all the goods in its outlets were sold at a fixed price of \$1.99. The defendant owned shops named "Lifestyle 1.99" that employed the same retail concept of selling goods at \$1.99. Despite finding that the plaintiff's shops were well known in Singapore such that the plaintiff had acquired goodwill in the business bearing the name "ONE.99" (at [23]–[24]), the Court of Appeal held that there was no misrepresentation because the plaintiff's mark was descriptive in nature, and the defendant had taken adequate measures to distinguish its mark from the plaintiff's mark (at [41]). The court concluded (at [48]):

In the result, we do not think that the respondents have shown that there has been any misrepresentation. We noted the evidence relating to the survey results show that there were members of the public who thought the two businesses were related. But in the nature of things some such misconception would be inevitable when you have two businesses adopting a similar descriptive term as a part of their names. Given a little time the public will be able to distinguish, now that the two businesses are operating side-by-side. Otherwise, it would amount to granting a monopoly to the person who happens to use that descriptive term first.

23 In my view, the reasoning in *Lifestyle 1.99* was applicable to the present case. There is a clear policy in the law of passing off against allowing traders to monopolise the use of ordinary descriptive terms for their business, and this policy remains even where a trader has used a descriptive term as part of its mark for a long time. Other traders should be allowed to use the same descriptive term as long as they have taken sufficient steps to distinguish their mark from that of the original user. Thus, although it was undisputed that the Plaintiff possessed goodwill with respect to the Motherhood Marks, I could still take into account the descriptive nature of the marks in determining the level of protection that they should be granted.

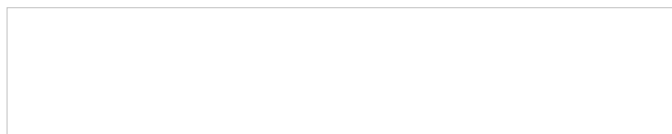
(2) Is the relevant public likely to be confused by the Disputed Mark?

24 In order for a misrepresentation to be actionable under the tort of passing off, it must give rise to actual confusion or a likelihood of confusion in the relevant segment of the public: *Amanresorts* at [77]. The relevant public consists of the actual or potential customers of the claimant who have goodwill towards the claimant's mark: *Amanresorts* at [73]–[75]. In assessing the likelihood of confusion, the following factors (among others) may be relevant: (a) the strength of the public's association with the claimant's sign; (b) the similarity of the claimant's and the defendant's respective signs; (c) the proximity of the parties' respective fields of business; (d) the characteristics of the market; and (e) the defendant's intention: *SPGA* at [54].

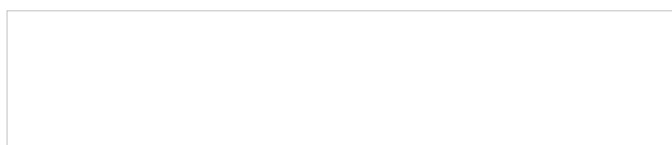
25 In the present case, no evidence was adduced by the Plaintiff to show that any of its actual or potential customers were *actually* confused by the Defendants' use of the Disputed Mark. Consequently, the Plaintiff's case rested on my assessment of whether the two marks were similar and whether the relevant segment of the public was likely to be confused between the two marks taking into account all the relevant circumstances.

26 First, I considered the similarity between the Motherhood Marks and the Disputed Mark. In terms of similarities, both marks included the word "motherhood" printed in small capital letters and a sans serif typeface. In terms of differences, the Motherhood Marks, when applied to the Plaintiff's Magazine, consisted of the word "motherhood" with the word "Magazine" scrawled in much smaller font of a different colour over the bottom half of the "ood" in "motherhood". In addition, the catchphrase "The No. 1 Choice for Mothers!" was printed in smaller font above the characters "mo". The Disputed Mark, on the other hand, consisted of the phrase "today'smotherhood" with "today's" printed in a different colour from "motherhood". In addition, the catchphrase "Parenting in a New Era"

was printed in smaller type below the “herhood” in “today’smotherhood”. Samples of the Plaintiff’s and the Defendants’ marks as shown on the cover page of their magazines are reproduced below (the exact colour of the fonts varied from issue to issue for both marks):



The Plaintiff’s mark



The Defendants’ mark

27 Overall, I was of the view that the two marks were sufficiently dissimilar both visually and aurally. Visually, the word “today’s” in the Disputed Mark was at least as prominent as the word “motherhood”. In contrast, the word “motherhood” dominated the title of the Plaintiff’s Magazine, with the word “Magazine” being relegated to an inconspicuous corner. The overall impression that a reader would get was that the title of the Plaintiff’s Magazine consisted of one word whereas the title of the Defendants’ Magazine consisted of two. Aurally, the beginnings of marks tend to receive more emphasis when pronounced (*London Lubricants (1920) Ltd’s Application* (1925) 42 RPC 264 at 279), and here the two marks begin with different words altogether.

28 As for conceptual similarity, the two marks were undoubtedly conceptually similar in that both invoked the concept of motherhood (the addition of the word “today’s” in the Disputed Mark did little to modify this central concept). But as I have stated earlier (at [23]), the Plaintiff is not entitled to a monopoly on the word “motherhood”, much less the general concept of motherhood.

29 Second, I considered the characteristics of the relevant public. In this case, the Plaintiff’s actual or potential customers would be parents, parents-to-be or other persons with childcare responsibilities who are interested in reading content and articles relating to parenting issues. They comprise individuals who are keen on learning about the best childcare techniques for their children and are not content to simply “wing it”, so to speak, when it comes to parenting. I was of the view that such customers would be more discerning and educated than the average person, and would not easily be confused by superficial similarities in the titles of two magazines. In my judgment, they fell squarely within the category of customers described by the court in *SPGA* as follows (at [52]):

... In our view, much turns on the nature of the product in question and the type of customer it tends to attract. If, in a given case, because of the peculiarities of the product or for any other reason, the relevant public were made up of “well-informed”, “particularly attentive” and cautious customers who would likely remember a high level of detail, slight differences between the claimant’s and the defendant’s respective signs may well be sufficient to avoid liability on the part of the defendant (*Bently & Sherman* ([16] *supra*) at p 763). ...

30 Third, I took into account the characteristics of the magazine market. The Defendants adduced evidence that it was common for magazines in Singapore dealing with similar topics to use the same descriptive word in their titles. For example:

- (a) in relation to the word "home", there were two Singapore magazines titled "Singapore Home Concepts" and "Singapore Home & Decor", both of which dealt with matters relating to interior design;
- (b) in relation to the word "health", there were two Singapore magazines titled "EzyHealth" and "Men's Health", both of which dealt with matters relating to health and well-being;
- (c) in relation to the word "baby", there were two Singapore magazines titled "LiveWell Baby" and "Mother & Baby", both of which dealt with parenting issues;
- (d) in relation to the word "parents", there were three Singapore magazines titled "Today's Parents", "Parents World" and "Young Parents", all of which dealt with parenting issues; and
- (e) in relation to the word "teen", there were two Singapore magazines titled "Teens" and "Teenage", both of which were aimed at teenage readers.

31 The Plaintiff argued that the presence of those magazines on the market was inconclusive, because there was no evidence as to why they were able to co-exist peacefully in the market. For example, any peaceful co-existence might be a result of a commercial decision by the owners in question; or it might be the case that no one possessed goodwill in the specific words "home", "health", "baby", "parents" and "teen" (as opposed to the word "motherhood"). In my view, the Plaintiff's argument missed the point. The point being made was that magazine consumers in Singapore are accustomed to seeing different magazines on the same topic using the same descriptive term in their titles, and would not be too quick to assume that such magazines must necessarily originate from the same publisher. This was relevant in assessing the likelihood that the relevant public would be confused by the Defendants' use of the word "motherhood" in their magazine title.

32 Fourth, turning to the Defendants' intention, I was not persuaded by the Plaintiff's submission that the Defendants possessed a fraudulent intent to ride on the Plaintiff's goodwill by using the Disputed Mark. The sum total of the Plaintiff's evidence for this accusation was that the 1st Defendant knew of the Motherhood Marks and had checked with IPOS on the registration status of the word "motherhood" before she decided to use the Disputed Mark for her magazine. But this did not prove that the 1st Defendant had included the word "motherhood" in the Disputed Mark *because* she wanted to ride on the Plaintiff's goodwill. The 1st Defendant's evidence at trial indicated that she chose the word for its intrinsic descriptive qualities:

A: Because I'm a mum, I'm a mother, so naturally when I want to produce---when I want to think of a name---and at that point in time my objective was actually, er, to have like a group of mummies online whereby we can really communicate. So naturally the word "motherhood", it---it makes sense for me to use, like Today's Motherhood, modern mothers, modern methods, that was my whole idea. And it is like---okay, maybe you can imagine like "Today's Motherhood", "Today's Mother", "Today's Mum", then if you think of all the combination, Today's Motherhood sounds good to like put forth because it describes the motherhood matters at heart for the mum. [\[note: 2\]](#)

She also explained her reasoning for checking with IPOS:

A: Hm. Okay. As I have spoken just now, I know that there is "Motherhood Magazine", I know that there's "Singapore Motherhood". So I just want to be sure that the name can be used. So actually after I checked with IPOS and I see that there is "Singapore Motherhood", so by adding a prefix in front and furthermore when I went to IPOS, right, the person told me that, er, "motherhood" is a generic term that cannot be trademarked. So I feel that it's actually quite safe to use. And since I add a prefix in front it's like "Today's Motherhood", so it's like clearly distinguished. Because "motherhood" is actually a term that is generic and it described the content in the magazine in the website. [\[note: 3\]](#)

Therefore, the evidence did not support the inference that the 1st Defendant had fraudulently intended to ride on the Plaintiff's goodwill. On the contrary, it appeared to me that the 1st Defendant had acted in good faith by using the word "motherhood" only after making sure that no one had registered that word as a trade mark, and by taking the precaution of adding the prefix "Today's" to distinguish the Disputed Mark from other marks that also use the word "motherhood".

33 Finally, I should also address three foreign decisions dealing with magazine titles that the Plaintiff cited in support of its case:

(a) In *Healthy Food Media Limited v Healthy Options Limited* [2005] NZHC 230 ("*Healthy Food Media*"), the plaintiff, who published a magazine titled "Healthy Food Guide" dealing with healthy food, sought an *ex parte* interim injunction to restrain the defendant from distributing a competing magazine titled "Health Food A Nutritional Guide". Asher J granted the injunction on the basis that the defendant had gone further than merely using the same descriptive words that were used by the plaintiff: the overall appearance of the defendant's magazine was very similar to the plaintiff's.

(b) In *Emap National Publications Limited v Security Publications Limited* [1997] FSR 891 ("*Emap*"), the plaintiff, who published a magazine for classic car enthusiasts titled "Practical Classics", sought an interim injunction to restrain the defendant from distributing a competing magazine on the same topic titled "Classics". Lloyd J granted the injunction on the basis that the plaintiff's and the defendant's magazine covers were strikingly similar.

(c) In *Morgan-Grampian Plc v Training Personnel Limited* [1992] FSR 267 ("*Morgan-Grampian*"), the plaintiff was the publisher of a series of magazines with titles commencing "What's New In ...", where the last word of the title described the area of interest covered by the particular magazine (such as "Design", "Farming" or "Computing"). The plaintiff sought an interim injunction to restrain the defendant from distributing a magazine aimed at training managers titled "What's New In Training". The defendant conceded that there was a serious question to be tried as to whether its actions constituted passing off, and focused its arguments on the balance of convenience and justice. Mummery J granted the injunction.

34 In my view, none of these cases assisted the Plaintiff. To begin with, all of them dealt with interlocutory injunctions where the plaintiffs only had to meet the low standard of establishing that there was a serious question to be tried with respect to the merits. Indeed, the defendant conceded this issue in *Morgan-Grampian* while *Healthy Food Media* concerned an *ex parte* application. Moreover, *Healthy Food Media* and *Emap* were decided on the basis of the close similarities in the design and layout of the plaintiff's and the defendant's magazine cover pages. In *Healthy Food Media*, Asher J made it clear that the plaintiff could not complain merely because the defendant had used the same descriptive terms in its magazine title (at [18]):

The title of the plaintiff's magazine "Healthy Food Guide" is a descriptive title using ordinary words

in common parlance. Indeed, the words exactly describe what the magazine sets out to do. It is clear that a party that chooses to use such words as a trade name must accept that it has no right to those words individually or in combination, and that competitors may use them also. ...

Likewise, in *Emap*, Lloyd J stated (at 892):

... The name of each magazine is generic or descriptive and no claim by either against the other publisher could be or is based on the name alone, or on confusion resulting from the similarity of the name.

Here, however, the Plaintiff did not raise any issue as to the overall design or layout of the Defendants' Magazine. The foundation of its entire case was that the Motherhood Marks and the Disputed Mark were substantially similar because both featured the word "motherhood". As the Defendants noted, this fell squarely within the category of claims that the courts in *Healthy Food Media* and *Emap* had rejected — claims premised on alleged confusion arising solely from the use of similar generic or descriptive magazine titles.

35 Having regard to the above factors, I found that the Defendants' use of the Disputed Mark was not likely to cause confusion to the relevant public, and the element of misrepresentation was not made out. I should note that in coming to this decision, I did not place much weight on the fact that the Defendants' Magazine was published online while the Plaintiff's Magazine was a print periodical. In this day and age, many print magazines also have an online presence, and magazine readers generally have access to both print and online content (though some might favour one medium over the other). Thus, where an online magazine bears a similar mark to a print magazine, consumers might be misled into thinking that the online magazine is an online edition of the print magazine.

Damage

36 Turning now to the element of damage, the Plaintiff argued that it was likely to suffer damage by both "blurring" and "tarnishment". These two concepts were explained by the court in *Amanresorts* as follows (at [97]–[98]):

97 There are two primary and very well-established means by which goodwill can be damaged, namely, by "blurring" and by "tarnishment". Blurring occurs when the plaintiff's get-up, instead of being indicative of only the plaintiff's goods, services or business, also becomes indicative of the defendant's goods, services or business. While customers may still be drawn by the attractive force of the plaintiff's get-up, they may be drawn to the business, goods or services of the defendant instead of those of the plaintiff. In other words, the goodwill attached to the plaintiff's business, goods or services becomes spread out over business, goods or services which are not the plaintiff's. This phenomenon occurs only when the business, goods or services of the plaintiff and those of the defendant are in competition with or are at least substitutes for each other. The damage manifests itself in sales being diverted from the plaintiff to the defendant.

98 Tarnishment occurs when the business, goods or services of the defendant are of a worse quality than those of the plaintiff or have some other undesirable characteristic. Customers think that the plaintiff is now the source of such poor quality or undesirable business, goods or services. The goodwill previously attached to the plaintiff's business, goods or services loses its attractive quality and may even become a liability, driving away custom rather than attracting it. Where it is alleged that goodwill has been damaged by tarnishment, there is no need for the plaintiff's business, goods or services and those of the defendant to be in competition with each other (*contra* the position where damage to goodwill by blurring is concerned). The plaintiff and

the defendant can be engaged in entirely different fields of business so long as it is shown that the poor quality or undesirability of the defendant's business, goods or services rebounds on the plaintiff.

37 Needless to say, the Plaintiff could only suffer such damage if the element of misrepresentation was made out; if there was no likelihood of confusion by the relevant public between the two marks, there could be no issue of sales or advertising being mistakenly diverted from the Plaintiff to the Defendants, nor could the Plaintiff's goodwill be tarnished by any deficiencies in the quality of the Defendants' Magazine. Since I had found that the Defendants did not commit any misrepresentation, it followed that the damage element was not established.

Claims under the TMA

38 The Plaintiff also claimed for an injunction under both s 55(2) and s 55(3)(a) of the TMA. The relevant sections state:

Protection of well known trade marks

55.—(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.

(2) 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 identical or similar goods or services, where the use is likely to cause confusion.

(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

...

39 A "well known trade mark" is defined in s 2(1) of the TMA as follows:

...

"well known trade mark" means —

(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;

...

Further, ss 2(7)–(9) provide guidance on how to determine whether a trade mark is well known in Singapore:

...

(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.

40 Consistent with their concession on the goodwill point (see [13] above), the Defendants accepted that the Motherhood Marks were well known trade marks in Singapore. [\[note: 41\]](#) I will therefore proceed to examine the other requirements of ss 55(2) and 55(3)(a) in turn.

Section 55(2)

41 In order to succeed under s 55(2), the Plaintiff had to show that the Disputed Mark (or an essential part thereof) was identical with or similar to the Motherhood Marks, and that the Defendants' use of the Disputed Mark in relation to similar or identical goods or services was likely to cause confusion.

42 It was not disputed that the Plaintiff's goods and services were similar to the Defendants' goods and services. [\[note: 51\]](#) The key issue was whether the Motherhood Marks and the Disputed Mark were similar and whether there was any likelihood of confusion. This was essentially the same issue that I have discussed above in relation to the misrepresentation element for passing off (at [17]–[35]), and for the reasons mentioned earlier, I found that s 55(2) was not satisfied.

Section 55(3)(a)

43 Unlike s 55(2), s 55(3)(a) does not expressly require proof of a likelihood of confusion; it simply requires that the defendant's use of a similar or identical mark in relation to *any* goods or services would "indicate a connection" between those goods or services and the plaintiff, and is likely to damage the plaintiff's interests. But the Court of Appeal has interpreted s 55(3)(a) to *also* require a likelihood of confusion to be shown before an injunction can be obtained thereunder: *Amanresorts* at [233]. As the court explained, the tests for the "connection" and "damage" requirements in s 55(3)(a) are largely the same as the tests for the misrepresentation and damage elements respectively in the tort of passing off, save that s 55(3)(a) concerns the plaintiff's *interests* whereas passing off concerns the plaintiff's *goodwill* ([at 234]):

In the instant case, we agree with the Judge's finding (at [74] of the Judgment) that ***the tests to be adopted for the purposes of the "connection" requirement and the "likely to damage the [plaintiff's] interests" requirement in s 55(3)(a) of the current TMA would yield the same results as those obtained from applying the corresponding tests vis-à-vis the Respondents' claim for passing off*** (which tests are, respectively, whether the Appellant has made a misrepresentation to the relevant sector of the public ... which causes that section of the public to mistakenly think that the Project has the same source as or is connected with the Respondents' resorts, and whether such misrepresentation has resulted in or is likely to result in damage to the goodwill attached to the "Aman" names). We thus uphold the Judge's decision that the claim under s 55(3)(a) of the current TMA has been made out. However, we pause to clarify that while the tests relating to misrepresentation and damage under the law of passing off are substantively the same as the tests relating to, respectively, the "connection" requirement and the "likely to damage the [plaintiff's] interests" requirement in s 55(3)(a) of the current TMA, the two sets of tests are not identical in one aspect. An important distinction is that the tests relating to misrepresentation and damage in passing off actions concern the plaintiff's goodwill (see [69] above), whereas the corresponding tests under s 55(3)(a) of the current TMA concern the *interests* of the plaintiff and *not* its goodwill (indeed, as the definition of "well known trade

mark” in s 2(1) of the current TMA makes clear, the plaintiff's trade mark may be a “well known trade mark” for the purposes of s 55(3)(a) even if the plaintiff has no goodwill in Singapore). [emphasis in original in italics; emphasis added in bold italics]

44 Since I had found that the Defendants’ use of the Disputed Mark was not likely to engender confusion, the Plaintiff’s claim under s 55(3)(a) was also dismissed.

Conclusion

45 For the foregoing reasons, I dismissed the Plaintiff’s claim and awarded costs to the Defendants to be taxed if not agreed.

46 I would add that although I decided this case on the basis of the facts as they stood before the Defendants changed the title of their magazine from “Today’s Motherhood” to “The New Age Parents”, this rebranding exercise was completed even *before* the Plaintiff filed this suit (see [8] above). There was also no reason to believe that the Defendants would revert to the original title if they were not restrained from doing so. Therefore, even if I had found that the Disputed Mark was similar to the Motherhood Marks and was likely to cause confusion, I would not have been minded to grant the injunctions sought by the Plaintiff, simply because the Defendants had already stopped using the Disputed Mark by the time this action was commenced.

[\[note: 1\]](#) Defendants’ Closing Submission dated 21 August 2013 at para 12.

[\[note: 2\]](#) NE 30 July 2013 at p 80.

[\[note: 3\]](#) NE 31 July 2013 at p 2.

[\[note: 4\]](#) Defendants’ Closing Submission dated 21 August 2013 at para 129.

[\[note: 5\]](#) *Ibid* at para 130.

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