

The Chinese Calligraphy Society of Singapore v Khoo Seng Kong
[2008] SGHC 121

Case Number : Suit 481/2006
Decision Date : 30 July 2008
Tribunal/Court : High Court
Coram : Tay Yong Kwang J
Counsel Name(s) : Tan Tee Jim SC, Christopher De Souza, Lim Ke Xiu (Lee & Lee) for plaintiff; Chan Chun Hwee Allan (C H Chan & Company) for the defendant
Parties : The Chinese Calligraphy Society of Singapore — Khoo Seng Kong
Tort – Passing off

30 July 2008

Tay Yong Kwang J:

The plaintiff's case

1 The plaintiff is a society registered under the Societies Act on 19 December 1968. Its objectives include the promotion and advancement of Chinese calligraphy and the maintenance and improvement of the said art form in Singapore. The plaintiff has organised and conducted numerous activities here and abroad to further its objectives. These include exhibitions, competitions, classes and publication of magazines.

2 In 1993, the National Arts Council ("NAC") agreed to lease the building located at 48 Waterloo Street to the plaintiff under the NAC's Arts Housing Scheme. Sometime about January 1994, the plaintiff adopted the name Singapore Calligraphy Centre (and its rendition in the Chinese language, "Xin Jia Po Shu Fa Zhong Xin") ("the names in issue") for the said building. It used the grants from the NAC and public donations to restore and reconstruct the building and, on 1 September 1995, it moved into the building. The Singapore Calligraphy Centre ("the Centre") was declared open by the Minister for Home Affairs, Mr Wong Kan Seng, on 27 May 1996.

3 Many of the activities at the Centre were publicised in the Chinese and the English language media, both locally and internationally. Many government officials have also visited the Centre. Classes in calligraphy were also held in the building. By reason of all these and as the plaintiff has been using the names in issue since September 1995, it claims to have built up a valuable reputation or goodwill in the said names. The names in issue, the plaintiff avers, have become associated with the plaintiff and/or its activities.

4 The defendant is a sole proprietorship registered on 21 April 2005. Its place of business is at 323A, New Bridge Road. The defendant's business name is identical to the name used for the plaintiff's building and its activities. The defendant's activities are stated to be "calligraphy promotion" and "exhibition organisers". The defendant used to be a member of the plaintiff and must therefore have been aware of the plaintiff when he registered his business in April 2005.

5 In this action, the plaintiff claims that the defendant passed off, attempted to pass off and/or enabled or caused others to pass off his business and its activities as the plaintiff's or as associated with or connected to the plaintiff and/or its services and activities. The defendant paid no heed to the plaintiff's solicitors' letter of 22 June 2006 asking him to cease and desist from his passing off

activities. Accordingly, the plaintiff claims an injunction to restrain the defendant and his agents from passing off, attempting to pass off, causing, enabling, assisting and/or authorising others to pass off his firm as the plaintiff, or his goods, services or activities as the plaintiff's or as associated with or connected thereto. The plaintiff also seeks a mandatory injunction to compel the defendant and his agents to take all necessary steps to immediately terminate the registration of the sole proprietorship known as "Singapore Calligraphy Centre" or to change it to another name which is not identical with or confusingly similar to the names in issue. It also wants the defendant to deliver up all printed or written matter, the use of which would be a breach of either of the two injunctions sought. The plaintiff further seeks an assessment of damages or an account of profits.

6 Sometime around March 2006, one of the plaintiff's members, also a teacher at the Centre, informed its current president, Tan Siah Kwee, that the Chinese version of the names in issue had been used in conjunction with the names of other calligraphy organisations in Singapore, including the defendant's, as part of a posting on an internet calligraphy forum at www.sfzk.net. To aggravate matters, the Chinese name was placed second on the list of names of such organisations. The order in which the names of organisations appear is determined by etiquette in the calligraphy community. If no explanatory note is given next to the list, it would be implied that the names were ranked in order of importance. Such a placing therefore implied that the Centre and, accordingly, the plaintiff, were inferior to the preceding organisation. The funding of the plaintiff, which is partly from public donations, would be affected if the public were misled into donating to the defendant's business entity instead. Further, enrolment fees for the calligraphy classes would be lost if students of the art form signed up with the wrong entity. The plaintiff also has no control over the activities of the defendant's business. The Centre's reputation could suffer if some adverse publicity should affect the defendant's business because members of the public would think that the defendant's business is connected to the Centre in some way.

The defendant's case

7 In his Defence, the defendant acknowledges that he used to be actively involved in the operations of the plaintiff. He was a member of the plaintiff since its inception in 1968 until around 1988 when he left the society after some disagreement with Tan Siah Kwee (who testified at the trial for the plaintiff). The defendant disputes the averment that the public in Singapore would associate the names in issue with the plaintiff whose registered name is "The Chinese Calligraphy Society of Singapore". Further, the defendant's name, "Singapore Calligraphy Centre", is said to be totally different from the name displayed on the exterior of the plaintiff's building at 48 Waterloo Street, namely, "Singapore Calligraphy Centre (1995)". The defendant disputes that the plaintiff could rely on the name or external signage on a building which is leased and not owned to claim ownership of and goodwill in that name. He further avers that the plaintiff's use of the names in issue for the said building was "tainted with illegality" as it did not apply to the Street and Building Names Board for approval to use the names. In any event, such approval would not have been given by the Board because of the use of the word "Singapore" in the names.

8 The defendant denies having done any act calculated to deceive or which is likely to deceive members of the public by naming his business in the way he has done. He claims to be a master calligrapher who has his own style of writing and has no intention of being associated with the plaintiff.

9 He submitted more than one name to the then Registry of Companies and Businesses when he was registering his business and the names in issue were duly approved. The name in issue was, however, his first choice. After receipt of the plaintiff's solicitors' letter to cease and desist the use of the names in issue, the defendant decided not to commence business pending resolution of this

dispute. The plaintiff's president also registered a company in Singapore known as "Singapore Calligraphy Centre (1995)" on 15 May 2006. That, he claims, shows that the said president did not think it was confusing for a company to bear a name similar to the names in issue.

10 The defendant denies that the plaintiff is entitled to claim any loss or damage as it is a non-profit organization and both parties are actively promoting the same art form.

The decision of the court

11 To succeed in the tort of passing off, the plaintiff has to establish 3 elements. They are goodwill or reputation, misrepresentation (whether intentional or not) by the defendant leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff and damage or the likelihood thereof (*Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 at 499; *Super Coffeemix Manufacturing Ltd v Unico Trading Pte Ltd* [2000] 3 SLR 145).

12 It is possible for one to acquire goodwill and reputation in a name used for a building where one's business is carried out, for instance, a hotel. So in *The Clock Ltd v The Clock House Hotel* (1936) 53 RPC 269, the operators of a hotel which had become well known as "The Clock" or "The Clock House" were able to stop others from using that name or similar names (such as "Hotel Clock House") for their hotel several miles down the road.

13 Similarly, in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 2 SLR 550 ("*CDL Hotels International Ltd v Pontiac Marina Pte Ltd*"), the proprietors of a massive building complex named the "Millenia" and a super-deluxe five-star hotel known as the Ritz-Carlton, Millenia Singapore were successful in their action for passing off and obtained orders to restrain another hotel chain from operating any hotel in Singapore under the name "Millennium" or other similar names. The Court of Appeal, in affirming the decision of Chao Hick Tin J (as he then was), held (at [63]) that the parties in a passing off action need not be in mutual competition but may be engaged in different fields of business activities. In response to the argument that the word "Millenia" only designated the location of the hotel, the court said (at [68]):

Even if "Millenia" is a geographical locator (which we have held it not to be), we think it is distinctive of the respondents' complex. There are many cases which have held that geographical names are distinctive ...

The Court of Appeal also referred to case law which decided that the relevant date at which the reputation of the party claiming passing off should be considered was the date on which the conduct complained of commenced (see [34] to [37]).

14 In the present case, the plaintiff has been using the names in issue since 1995. The conduct complained of took place on 21 April 2005, when the defendant registered his business name. By that date, the evidence adduced showed that the Singapore Calligraphy Centre had already been identified in the local media as the "first home" of the plaintiff. There were also numerous news reports which associated the Centre with the plaintiff. Even the defendant's witness conceded under cross-examination that the Centre and the plaintiff were connected in that the Centre was where the plaintiff carried out its activities.

15 In the same way as goodwill attaches to the brand names of goods or services even if the purchasing public does not know of the manufacturer or supplier by name, it is sufficient in law that the public knows the names in issue here even if it does not know or readily recall the entity which

runs the Centre known by the said names. It is therefore immaterial that the plaintiff's registered address was not the same as that of the Centre until recently.

16 The Centre's many activities, including exhibitions, seminars and calligraphy demonstrations, over the decade in question (1995 to 2005) were widely publicised locally as well as abroad. Past and present Presidents of our country, government Ministers and high-ranking officials were guests of honour or participants at various events held at the Centre over the years. The names in issue were approved by the NAC. The plaintiff is also known in local calligraphy circles as the provider of high quality classes in the art form. From an initial 8 classes at the inception of the Centre, demand has necessitated some 50 classes to be held now. Advertisements for these classes invariably referred to the location of teaching as the Singapore Calligraphy Centre.

17 Clearly, therefore, the plaintiff has acquired goodwill in the names in issue. It matters not that the said names could also be said to be descriptive of the type of activities held at the Centre. Descriptive names can also become distinctive ones. It depends on the facts of each case. Similarly, even if the use of the word "Singapore" is said to be merely a geographical locator, in this case, the country where the calligraphy centre is, the names in issue can nevertheless be distinctive of the plaintiff's building and activities such that goodwill attaches to them (see the Court of Appeal's holding in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* quoted at [13] above). The addition of the founding year of the Centre to its name plate or in some documents does not detract from the distinctiveness of the names in issue as it would be clear to anyone in the context here that "(1995)" merely denotes the year of commencement of business or of opening of the Centre. Whether the building in question is owned or leased by the plaintiff can also have no bearing on the determination of the issue of goodwill here. Even if the plaintiff decides to re-locate the Centre sometime in the future, it will still have goodwill in the names in issue and will be able to use them for the new premises to the exclusion of other persons such as the defendant.

18 On the issue of misrepresentation, the Court of Appeal in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* ([13] *supra* said at [71]:

It is not necessary that there should be any confusion occasioned by the misrepresentation, although confusion is of great evidential value in determining whether or not there has been any misrepresentation. If the names of two entities are confusingly similar, there is a great likelihood that the public will be misled into thinking that they or their businesses are connected with each other.

19 In the present case, the defendant has chosen a name for his business which is identical to that used by the plaintiff for the Centre. The registered activities of his business are essentially the same as those of the plaintiff's. Anyone (other than a person with intimate knowledge about the plaintiff's and/or the defendant's activities and business) who knows about the Centre and sees the signage of the defendant's business premises or the business name used in some document would assume that the two are related in some way, thinking perhaps that the defendant's business is a small branch or office of the Centre in Chinatown. There was also evidence of confusion in that a congratulatory message in the name of the defendant's business posted on the calligraphy website mentioned earlier was thought by a member of the plaintiff to have emanated from the plaintiff. Further, it is immaterial that one entity is a society while the other is a business entity. A social club could be viewed as connected in some way with a charitable organisation (see the case of *British Legion v British Legion Club (Street) Ltd* (1931) 48 RPC 555).

20 Misrepresentation can be intentional and fraudulent or not at all (see [11] above). Having been a member of the plaintiff for about two decades, there could be no doubt that the defendant was

aware that the plaintiff had been using the names in issue for about ten years before his application to register his business. The added fact that he parted with the plaintiff in less than amicable circumstances immediately raises doubt about the defendant's good faith in using the same name. It is no defence to plead that the use of the business name was approved by the business regulatory authority as that authority would not necessarily be apprised of the existence of the Centre or its relationship to the defendant. However, even if the defendant had no intention to cause confusion or to associate his business in any way with the plaintiff or the Centre, he can still be held liable if the use of the names in issue is likely to cause confusion (see *Jumbo Seafood Pte Ltd & Anor v Hong Kong Jumbo Seafood Restaurant Pte Ltd* [1998] 1 SLR 860).

21 Tan Siah Kwee's subsequent registration of a company known as the Singapore Calligraphy Centre (1995) on 15 May 2006 was, as stated clearly by him in his testimony, nothing more than a "preventive measure" taken on behalf of the plaintiff to pre-empt copycats of the defendant who might decide to register a company using the names in issue. In any event, the defendant's protest to the business regulatory authority about this registration showed that his assertions in court about absence of confusion were completely lacking in candour. Several months after the said registration of the company, the defendant wrote to the said authority to protest that the name of the company would inevitably cause confusion to the public and affect the operations of his business. Despite this, the defendant could continue to assert in court that no confusion would be caused as between the Centre and his business, bearing in mind that the Centre also has a name plate on its walls bearing the name in issue together with the year of commencement of operation.

22 On the issue of damage or the likelihood thereof, the plaintiff submits that it has pecuniary and other interests to protect. Its funding comes from government grants as well as donations from private organisations and members of the public. The plaintiff uses the names in issue in its fund raising efforts. If donations and enrolment fees for classes were diverted to the defendant as a result of the confusion caused by the defendant's use of the names in issue, the plaintiff and its Centre would suffer damage in loss of income. I agree with the plaintiff. The plaintiff also has no control whatsoever over the activities of the defendant where calligraphy activities are concerned. Further, should anything adverse happen to the defendant's business, it would be likely to have repercussions for the plaintiff's reputation. The defendant asked, why would members of the public want to make a donation to a business? The answer is simply that they would not but could be misled into thinking that the defendant's business is in fact the plaintiff, ie a non-profit organisation of calligraphers deserving of financial support.

23 The final issue concerns the submission by the defendant that the plaintiff's use of the names in issue for the building at 48 Waterloo Street contravened s 52(2)(b) of the Property Tax Act (Cap 254, 2005 Rev Ed) in that the plaintiff had not obtained the Street and Building Names Board's approval for its use. Accordingly, the defendant argues, the use of the names in issue was illegal.

24 In the explanatory notes on the application form for such approval, it is stated that the names of institutions (including educational institutions, clubs and places of worship) and/or businesses are not within the purview of the Street and Building Names Board. The Board, despite having been informed by the defendant of the plaintiff's use of the names in issue, was of the opinion that the plaintiff's name (ie the society) and the names in issue were organisation names and were outside its purview. No prosecution of the plaintiff on this score has occurred. In any event, any alleged illegality must relate to the elements of the tort of passing off before it can succeed as a defence and, in this case, it does not. It is not the case where the names in issue are themselves illegal and therefore could never be used lawfully so as to acquire goodwill in them.

25 In the circumstances, the plaintiff succeeds in its claim in passing off. I therefore granted the

relief sought and ordered that compliance with the injunctions be effected within one month from the date of order. At the request of the plaintiff, an assessment of damages was ordered instead of an account of profits. I also ordered the defendant to pay the plaintiff the costs incurred in this action.

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