

2,1976

IN THE JUDICIAL COMMITTEE  
OF THE PRIVY COUNCIL

NO. 11 OF 1974

O N A P P E A L  
FROM THE COURT OF APPEAL (CIVIL SIDE) OF SINGAPORE

B E T W E E N :

STAR INDUSTRIAL COMPANY LIMITED

Appellants  
(Plaintiffs)

- and -

YAP KWEE KOR trading as  
NEW STAR INDUSTRIAL COMPANY

Respondent  
(Defendant)

---

RECORD OF PROCEEDINGS

---

Simmons & Simmons,  
14 Dominion Street,  
London, EC2M 2RJ.

Solicitors for the Appellants

Collyer-Bristow & Co.,  
4 Bedford Row,  
London WC1R 4DF.

Solicitors for the Respondent

O N A P P E A L  
FROM THE COURT OF APPEAL (CIVIL SIDE) OF SINGAPORE

B E T W E E N:

STAR INDUSTRIAL COMPANY LIMITED

Appellants  
(Plaintiffs)

- and -

YAP KWEE KOR trading as  
NEW STAR INDUSTRIAL COMPANY

Respondent  
(Defendant)

RECORD OF PROCEEDINGS

INDEX OF REFERENCE

Part I

No.	Description of Document	Date	Page
<u>IN THE HIGH COURT OF SINGAPORE</u>			
1.	Notice of Originating Motion (No. 2 of 1971)	26th January 1971	1
2.	Affidavit of Michael Sim	26th January 1971	3
3.	Exhibit M.S.1 - Letter, Lim Seng Huat (Singapore) Private Limited to Registrar of Trade Marks	23rd September 1970	4
4.	Exhibit M.S.2 - Letter, Lim Teck Lee (Private) Limited to Registrar of Trade Marks	23rd September 1970	5
5.	Exhibit M.S.3 - Letter, Cheong Lee Yuen (Private) Limited to Registrar of Trade Marks	24th September 1970	6

No.	Description of Document	Date	Page
6.	Exhibit M.S.4 - Letter, Sim Yeow Seng (Private) Limited to Registrar of Trade Marks	23rd September 1970	8
7.	Exhibit M.S.5 - Letter, Tan Lee Seng (Private) Limited to Registrar of Trade Marks	23rd September 1970	9
8.	Affidavit (No. 1) of Clement Tan	16th February 1971	10
9.	Exhibit C.T.1 - Receipt of Mei Ling Store	2nd February 1971	11
10.	Exhibit C.T.4 - Statutory Declaration	3rd February 1971	12
11.	Affidavit (No.2) of Clement Tan	16th February 1971	13
12.	Exhibit C.T.3 - Statutory Declaration	11th February 1971	14
13.	Affidavit (No.3) of Clement Tan	16th February 1971	15
14.	Exhibit C.T.1 - Cash bill of Malabar Store	12th February 1971	16
15.	Affidavit (No.4) of Clement Tan	16th February 1971	17
16.	Exhibit C.T.1 - Receipt	Undated	18
17.	Affidavit (No.5) of Clement Tan	16th February 1971	19
18.	Affidavit of K.Y. Tongson	10th February 1971	20
19.	Exhibit KYT 2 - Warning Notice published in Straits Times together with samples of advertisements	23rd January 1971 and various other dates	26
20.	Exhibit KYT 3 - Application No.47884 for registration of trade mark	26th January 1971	31
21.	Exhibit KYT 4 - Application No.47885 for registration of trade mark	26th January 1971	32
22.	Exhibit KYT 5 - Certificate of registration of trade mark No.12197	23rd January 1971	33
23.	Exhibit KYT 6 - Certificate of registration of trade mark No.B39808	23rd January 1971	34
24.	Exhibit KYT 8 - Letter, Appellants' Solicitors to Respondent	15th January 1971	35

No.	Description of Document	Date	Page
25.	Writ of Summons	9th February 1971	37
26.	Statement of Claim	9th February 1971	38
27.	Defence	26th April 1971	42
28.	Reply	5th August 1971	45
29.	Order on Summons for Directions	10th January 1972	46
	<u>Plaintiff's Evidence</u>		
30.	Notes of Evidence (Judges Notes)	19th June 1972	47
31.	Kenneth Tongson	20th June 1972	48
32.	Tan Kim Seng	21st June 1972	58
33.	Sim Tow Khan	21st June 1972	61
34.	Tan Kay Moh	21st June 1972	63
35.	Chng Peng Soon	21st June 1972	67
36.	Yeow Yang Boon	21st June 1972	72
37.	Kenneth Tongson (Recalled)	21st June 1972	76
38.	Leung Jhi Hung	2nd October 1972	77
	<u>Defendant's Evidence</u>		
39.	Notes of Evidence (Judges Notes)	2nd October 1972	86
40.	Yap Kwee Kor	2nd and 4th October 1972	88
	<u>Closing Speeches</u>		
41.	Closing Speech of Counsel for Defendant (Judges Notes)	4th October 1972	99
42.	Speech of Counsel for Plaintiffs in Reply (Judges Notes)	4th October 1972	101
43.	List of exhibits tendered and admitted	2nd and 4th October 1972	102

No.	Description of Document	Date	Page
<u>Written Submissions</u>			
44.	On behalf of the Plaintiffs/Applicants	4th October 1972	103
45.	On behalf of Defendant	6th October 1972	116
46.	Further written submissions on behalf of Plaintiffs/Applicants	7th October 1972	128
47.	Judgment of Choor Singh J.	19th April 1973	132
48.	Formal Judgment	19th April 1973	143
<u>IN THE COURT OF APPEAL (CIVIL SIDE) OF SINGAPORE</u>			
49.	Notice of Appeal	15th May 1973	144
50.	Petition of Appeal	16th June 1973	144
51.	Order on Judgment	26th October 1973	147
52.	Order granting leave to appeal to the Judicial Committee of the Privy Council	28th January 1974	147
53.	Grounds of Judgment	25th March 1974	148

Part IIEXHIBITS

No.	Description of Document	Date	Page
P26	Newspaper cutting from Nanyang Siang Pau	18th March 1961	153
P3	Certificate of Registration	7th October 1961	155
AB2	Certificate No. M/46287 issued in the States of Malaya to Respondent under S.39 of the Trade Marks Ordinance in respect of nylon toothbrushes	6th August 1966	158

No.	Description of Document	Date	Page
AB3	Letter, Lin Seng Huat (Singapore) Limited to Plaintiffs	21st March 1968	159
AB4 <sup>5</sup>	Letter, Plaintiffs to Lin Teck Lee Company Limited and Lim Seng Huat (Singapore) Ltd.	22nd August 1968	160
AB6	Agreement (in Chinese) made between, Respondent and Singapore General Merchandise Joint Venture Pte. Ltd.	24th September 1968	164
AB7	Translation of AB6	24th September 1968	165
P11	Application for registration of registered user	9th December 1969	166
P14	Statutory Declaration	23rd December 1969	168
AB9	Letter, Plaintiffs' Solicitors to Defendant	2nd February 1971	170
AB11	Letter, Defendant's Solicitors to Plaintiffs' Solicitors	10th February 1971	172
AB12	Letter, Plaintiffs' Solicitors to Defendant's Solicitors	15th February 1971	173
P7	List of persons holding shares in Star Plastics Industrial Company (Pte.) Limited	31st January 1972	174
AB18	Letter, Plaintiffs' Solicitors to Defendant's Solicitors	25th May 1972	175
P28	Declaration of Woo Po Shing, Notary Public	19th July 1972	176
P9	Application for registration of trade mark	2nd October 1972	178
P9A	Letter from Registrar of Trade Marks	2nd October 1972	179
P9B	Application for registration of trade mark	2nd October 1972	181
AB1	Certificate No.39808 as to proprietorship of toothbrushes	Undated	182

Part IIIItems not transmitted

<u>Description of Documents Omitted</u>	<u>Date</u>
Exhibits C.T.2 and C.T.3 to Affidavit (No.1) of Clement Tan	16th February 1971
Exhibits C.T.1 and C.T.2 to Affidavit (No.2) of Clement Tan	16th February 1971
Exhibits C.T.2 and C.T.3 to Affidavit (No.3) of Clement Tan	16th February 1971
Exhibits C.T.2 and C.T.3 to Affidavit (No.4) of Clement Tan	16th February 1971
Exhibits C.T.1 and C.T.2 to Affidavit (No.5) of Clement Tan	16th February 1971
Exhibits K.Y.T.1 and K.Y.T.7 to Affidavit of K.Y.Tongson	10th February 1971

Documents transmitted to the  
Privy Council but not reproduced

All toothbrushes

P.29 Advertisement in Hong King paper	13th January 1953
P29A Translation of P.29	Undated
P27 Advertisement in Chinese paper	Undated
P4 ) P5 ) Advertisements P6 )	Undated
P2 Memorandum and Articles of Association of Plaintiff Company	Incorporated 25th May 1961
D3 Certificate of registration in Hong King	7th October 1961
P24 Inward Declaration	19th August 1963
P25 Invoice	20th February 1965
P23 Application for registration of registered user	9th December 1969
P12 Receipt No. 71784	15th December 1969

Exhibits	Description of documents omitted	Date
P15	Certificate of Incorporation of General Merchandise Joint Venture (Private) Limited	18th December 1969
P22	Statutory Declaration	23rd December 1969
P13	Letter from Registry of Trade Marks	21st January 1970
AB8	Warning notice published in Straits Times	23rd January 1971
AB16) AB17)	Letter T.S. Chong & Co. to Star Plastic Co. Ltd.	27th July 1971
P7	List of shareholders of Star Plastics	20th June 1972
P16) P17) P18)	List of directors	1971-72
AB20	Key to extracts of accounting records	Undated
AB21- AB 107	Extracts of accounting records relating to sales of Ace tooth-brushes to Singapore, showing quantity and value	1960 to 1969
D2	Application for registration	
AB2	Certificate No. 19/46287 issued in Malaya under Section 39 of the Trade Marks Ordinance	Undated
D7	Page 208 of Chinese telephone directory	Undated
P10	Catalogue	



IN THE PRIVY COUNCIL

No. 11 of 1974

ON APPEAL  
FROM THE COURT OF APPEAL (CIVIL SIDE) OF SINGAPORE

BETWEEN :

STAR INDUSTRIAL COMPANY LIMITED

Appellants  
(Plaintiffs)

- and -

YAP KWEE KOR trading as  
NEW STAR INDUSTRIAL COMPANY

Respondent  
(Defendant)

RECORD OF PROCEEDINGS

No. 1

In the High  
Court of  
Singapore

NOTICE OF ORIGINATING MOTION

No. 1

Notice of  
Originating  
Motion

26th January  
1971

TAKE NOTICE that this Honourable Court will be moved on Friday the 26th day of February, 1971 at 10.30 o'clock in the forenoon, or soon thereafter as Counsel can be heard, by Mr. Michael Sim of Counsel for the Applicants, Star Industrial Company Limited whose registered office is situate at 25, Tai Yau Street, San Po Kong, Kowloon, Hong Kong, persons aggrieved under the provisions of Section 39(1)(a) of the Trade Marks Ordinance by an entry made in the Register of Trade Marks without sufficient cause and wrongfully remaining on the Register of Trade Marks, for an order that the entry of the Trade Mark No. 39808 in Class 21 in Part B of the Register of Trade Marks kept under the Trade Marks Ordinance be expunged on the following grounds:-

10

20

1. That the use of the said Trade Mark is likely to deceive or cause confusion or otherwise and is contrary to Section 15 of the Trade Marks Ordinance by reason of the close similarity between the said Trade Mark and the Applicants' RED "A" ACE Trade Mark used by the Applicants on tooth brushes in Singapore since at least 1956, by reason of which the Applicants have become common law prior proprietors of the ACE Trade Mark.

In the High  
Court of  
Singapore

No. 1

Notice of  
Originating  
Motion

26th January  
1971

(continued)

2. That the said Mark was registered contrary to Section 10 of the Trade Marks Ordinance as the said Mark was not distinctive nor capable of distinguishing at the date of registration.

3. That the Respondents could not validly claim to be the proprietors of the said Mark at the date of registration and registration was therefore obtained contrary to Section 11 of the Trade Marks Ordinance.

4. That the use of the said Mark by reason of its confusing similarity to the Applicants' RED "A" ACE Trade Mark, is disentitled to protection in a Court of Justice, and would be contrary to law or morality and therefore offends Section 15 of the Trade Marks Ordinance.

10

And for such further order or orders consequent thereon as to this Honourable Court may seem fit and proper.

Dated the 26th day of January, 1971.

Sd. Drew & Napier

20

Solicitors for the Applicants.

Messrs. Drew & Napier of Nos. 30-35, Chartered Bank Chambers, Battery Road, Singapore, Solicitors for the abovenamed Applicants, whose address for service is Nos. 30-35, Chartered Bank Chambers, Battery Road, Singapore.

To

The abovenamed ~~Defendant~~ (Respondent) of No. ~~18 Hokien Street~~, 307-A, Block 1, Jalan Bukit Merah, Redhill, Flatted Factory, Singapore.

Amended as underlined in red ink this 17th day of February, 1971, pursuant to the Order of the Deputy Registrar dated the 12th day of February, 1971.

30

Sd. Drew & Napier

Solicitors for the Applicants.

No. 2

AFFIDAVIT OF MICHAEL SIMIn the High  
Court of  
Singapore

No. 2

Affidavit of  
Michael Sim26th January  
1971

I, Michael Sim of No.17, Carmen Terrace, Singapore do solemnly and sincerely make oath and say as follows:-

1. I am an assistant Solicitor in the employ of Messrs. Drew & Napier the Solicitors for the Applicant Company herein and I have conduct of this matter. The facts deposed to herein are from my own personal knowledge as Solicitor in charge.

10

2. On information received that the Applicants' tooth brushes under the ACE Trade Mark have been sold in Singapore through local trade representatives I arranged for Mr. Jhi Hung Leung, Chairman of the Board of Directors of Star Industrial Company Limited to approach each of the local trade representatives of Star Industrial Company Limited to write confirmation letters that they had been importing into Singapore ACE tooth brushes.

20

3. The names of these local trade representatives are as follows:-

(a) Lim Seng Huat (S) Pte. Ltd.,  
13 Circular Road,  
Singapore, 1.

(b) Lim Teck Lee (Pte.) Ltd.,  
2-5 Circular Road,  
Singapore, 1.

(c) Cheong Lee Yuen (Pte.) Ltd.,  
57 South Bridge Road,  
Singapore, 1.

30

(d) Sim Yeow Seng (Pte.) Ltd.,  
31 Circular Road,  
Singapore, 1.

(e) Tan Lee Seng (Pte.) Ltd.,  
29 South Bridge Road,  
Singapore, 1.

4. In response to Mr. Jhi's requests I have now received a reply from each of the local dealers and their replies are now attached hereto and marked "MS 1", "MS 2", "MS 3", "MS 4" and "MS 5" respectively.

40

In the High Court of Singapore

No. 2  
Affidavit of Michael Sim  
26th January 1971  
(continued)

5. I pray that the replies received from these local dealers may be taken into consideration by the Court in arriving at a decision.

Sworn at Singapore by the )  
abovenamed Michael Sim this ) Sd. Michael Sim  
26th day of January, 1971. )

Before me,  
Sd. Thomas Potts  
A Commissioner for Oaths.

No. 3  
Exhibit M.S.1  
23rd September 1970

No. 3  
EXHIBIT M.S.1

10

From: Lim Seng Huat (S)  
Pte. Ltd.,  
13, Circular Road,  
Singapore, 1.

23rd September, 1970

The Registrar of Trade Marks,  
SINGAPORE

Dear Sir,

Singapore Trade Mark Application No.  
S.47884 and No.47885 in Class 21 -  
ACE Label by Star Industrial Co. Ltd.

20

We have been requested by Messrs. Drew & Napier, the solicitors for Star Industrial Co.Ltd. to assist them in the registration of the above-mentioned trade mark application.

This letter will serve to confirm that we have been importing into Singapore from Star Industrial Co. Ltd. all kinds of brushes including toothbrushes under their ACE trade mark for over ten years.

30

We have always associated the ACE trade-mark with Star Industrial Co. Ltd. in connection with brushes and we know of no other manufacturer

or company who has used the ACE trade mark on brushes.

In the High Court of Singapore

Yours faithfully,

LIM SENG HUAT (S) PTE. LTD.

Sd. Lim Tow Yong

Director.

No. 3

Exhibit M.S.1  
23rd September 1970

(continued)

This is the exhibit marked "MS 1" referred to in the affidavit of Michael Sim sworn this 26th day of January, 1971.

10

Before me,

Sd. Thomas Potts

A Commissioner for Oaths.

No. 4

EXHIBIT M.S.2

No. 4

Exhibit M.S.2  
23rd September 1970

From: Lim Teck Lee (Pte.)Ltd.,  
2-5, Circular Road,  
Singapore 1.

23rd September, 1970.

20 The Registrar of Trade Marks,  
SINGAPORE

Dear Sir,

Singapore Trade Mark Application No.  
S.47884 and No.47885 in Class 21 -  
ACE Label by Star Industrial Co. Ltd.

We have been requested by Messrs. Drew & Napier, the solicitors for Star Industrial Co.Ltd. to assist them in the registration of the above-mentioned trade mark application.

In the High  
Court of  
Singapore

No. 4

Exhibit M.S.2

23rd September  
1970

(continued)

This letter will serve to confirm that we have been importing into Singapore from Star Industrial Co. Ltd. all kinds of brushes including toothbrushes under their ACE trade mark for over ten years.

We have always associated the ACE trademark with Star Industrial Co. Ltd. in connection with brushes and we know of no other manufacturer or company who has used the ACE trade mark on brushes.

Yours faithfully,

10

LIM TECK LEE (PTE.) LTD.

Sd. Roland Lim

Assistant Manager.

This is the exhibit marked "MS 2" referred to in the affidavit of Michael Sim sworn this 26th day of January, 1971.

Before me,

Sd. Thomas Potts

A Commissioner for Oaths.

20

No. 5

Exhibit M.S.3

24th September  
1970

No. 5

EXHIBIT M.S. 3

CHEONG LEE YUEN (PTE.) LTD.,  
57, South Bridge Road,  
Singapore, 1.

24th September, 1970.

The Registrar of Trade Marks,  
SINGAPORE

Dear Sir,

Re: Singapore Trade Mark Application No.  
S.47884 and No.47885 in Class 21 -  
ACE Label by Star Industrial Co. Ltd.

30

We have been requested by Messrs. Drew & Napier, the solicitors for Star Industrial Co. Ltd., Hongkong, to assist them in the registration of the above-mentioned trade mark application.

In the High Court of Singapore

No. 5

This letter will serve to confirm that we have knowledge that all kinds of brushes including tooth-brushes under the ACE trademark have been continuously imported into Singapore for over ten years, and are products of Star Industrial Co. Ltd., Hongkong.

Exhibit M.S.3  
24th September  
1970

(continued)

10

We have always associated the ACE trademark with Star Industrial Co. Ltd. in connection with brushes.

Yours faithfully,

CHEONG LEE YUEN (PTE.) LTD.  
SINGAPORE

Sd. Illegible

Director.

20

This is the exhibit marked "MS 3" referred to in the affidavit of Michael Sim sworn this 26th day of January, 1971.

Before me,

Sd. Thomas Potts

A. Commissioner for Oaths.

8.

In the High  
Court of  
Singapore

No. 6

Exhibit M.S.4

No. 6  
Exhibit M.S.4  
23rd September  
1970

From: Sim Yeo Seng (Pte.) Ltd.,  
31, Circular Road,  
Singapore, 1.

23rd September, 1970.

The Registrar of Trade Marks,  
SINGAPORE.

Dear Sir,

Singapore Trade Mark Application No. 10  
S.47884 and No.47885 in Class 21 -  
ACE Label by Star Industrial Co. Ltd.

We have been requested by Messrs. Drew & Napier, the solicitors for Star Industrial Co. Ltd. to assist them in the registration of the above-mentioned trade mark application.

This letter will serve to confirm that we have been importing into Singapore from Star Industrial Co. Ltd. all kinds of brushes including toothbrushes under their ACE trade mark for over 20  
ten years.

We have always associated the ACE trademark with Star Industrial Co. Ltd. in connection with brushes and we know of no other manufacturer or company who has used the ACE trade mark on brushes.

Yours faithfully,  
SIM YEOW SENG (PTE) LTD.

Sd. Illegible  
Director.

This is the exhibit marked "MS 4"  
referred to in the affidavit of  
Michael Sim sworn this 26th day of  
January, 1971. 30

Before me,  
Sd. Thomas Potts  
A Commissioner for Oaths.



9.

No. 7

Exhibit M.S. 5

From: Tan Lee Seng (Pte.) Ltd.,  
31, South Bridge Road,  
Singapore.

23rd September, 1970.

In the High  
Court of  
Singapore

No. 7

Exhibit M.S.5

23rd September  
1970

The Registrar of Trade Marks,  
SINGAPORE.

Dear Sir,

10

Singapore Trade Mark Application  
No.S.47884 and No.47885 in Class  
21 - ACE Label by Star Industrial  
Co. Ltd.

We have been requested by Messrs. Drew & Napier, the solicitors for Star Industrial Co. Ltd. to assist them in the registration of the above-mentioned trade mark application.

20

This letter will serve to confirm that we have been importing into Singapore from Star Industrial Co. Ltd. all kinds of brushes including tooth-brushes under their ACE trade mark for over ten years.

We have always associated the ACE trademark with Star Industrial Co. Ltd. in connection with brushes and we know of no other manufacturer or company who has used the ACE trade mark on brushes.

Yours faithfully,

Sd. Illegible

TAN LEE SENG (PTE. LTD.  
No.29, South Bridge Road,  
Singapore.

30

This is the exhibit marked "MS 5" referred to in the affidavit of Michael Sim sworn this 26th day of January, 1971.

Before me,

Sd. Thomas Potts

A Commissioner for Oaths.

In the High Court of Singapore

No. 8

AFFIDAVIT (No.1) OF CLEMENT TAN

No. 8  
Affidavit  
(No.1) of  
Clement Tan  
16th February  
1971

I, Clement Tan of 292, Telok Kurau Road, Singapore do make oath and say as follows:-

1. I am a clerk employed by Messrs. Drew & Napier of 30/35 Chartered Bank Chambers, Battery Road, Singapore.

2. At approximately 2.30 p.m. on Tuesday, the 2nd day of February, 1971 I was instructed to purchase one dozen "ACE" brand tooth brushes from Mei Ling Store at 16, Mei Ling Street, Block 152, Singapore, 3.

10

3. At approximately 3.30 p.m. on the same day I arrived at Mei Ling Store and saw several tooth brushes on display on the counter. I then produced the sample of the "ACE" toothbrush which I had brought with me and asked for a dozen of "ACE" brand tooth brushes from a lady shop assistant who in response to my order handed me a dozen of "AGE" brand tooth brushes for which I paid the sum of \$3.60 and obtained a receipt which is attached hereto and marked "C.T.1".

20

4. There is now produced and marked "C.T.2" the "ACE" brand tooth brush which I showed to the shop assistant when making my order for one dozen "ACE" tooth brushes.

5. There is now produced and shown to me and marked "C.T.3" the "AGE" brand tooth brushes I was given in response to my order for "ACE" tooth brushes.

6. Attached hereto and marked "C.T.4" is the Statutory Declaration I sworn soon after the trap purchase was made.

30

Sworn at Singapore by the )  
abovenamed Clement Tan this ) Sd. Clement Tan  
16th day of February, 1971.)

Before me,  
Sd. D.E.S. Chelliah  
A Commissioner for Oaths,  
Singapore.

11.

No.9

Exhibit C.T. 1

In the High  
Court of  
Singapore

星洲門牌第拾陸號  
(二五一號大馬路三號)  
店商玲美

MEI LING STORE

No. 16, Mei Ling Street. (Block 152)  
SINGAPORE. 3.

No. 9  
Exhibit C.T.1  
2nd February  
1971

現 2/2/71  
紅印牙粉 18 號 360  
—————  
18 號 360  
L

This is the exhibit marked "C.T.1"  
referred to in the affidavit of  
CLEMENT TAN sworn this 15th day of  
February, 1971.

Before me,

Sd. D. E. S. Chelliah

A Commissioner for Oaths.

No. 10  
Exhibit C.T.4

In the High  
Court of  
Singapore

STATUTORY DECLARATION

No.10

Exhibit C.T.4

3rd February  
1971

I, CLEMENT TAN of 292, Telok Kurau Road,  
Singapore 15, do solemnly and sincerely declare as  
follows:-

1. I am a clerk employed by Messrs. Drew & Napier  
of 30/35 Chartered Bank Chambers, Battery Road,  
Singapore.

10 2. At approximately 2.30 p.m. on Tuesday the 2nd  
day of February 1971 I was instructed to purchase  
one dozen "ACE" brand tooth brushes from Mei Ling  
Store at 16, Mei Ling Street, Block 152, Singapore 3.

20 3. At approximately 3.30 p.m. on the same day I  
arrived at Mei Ling Store and saw several tooth  
brushes on display on the counter. I then produced  
the sample of the "ACE" toothbrush which I had  
brought with me and asked for a dozen of "ACE" brand  
tooth brushes from a lady shop assistant who in  
response to my order handed me a dozen of "AGE"  
brand tooth brushes for which I paid the sum of  
\$3.60 and obtained a receipt which is attached  
hereto and marked "C.T.1".

4. There is now produced and marked "C.T.2" the  
"ACE" brand toothbrush which I showed to the shop  
assistant when making my order for one dozen "ACE"  
toothbrushes.

30 5. There is now produced and shown to me and  
marked "C.T.3" the "AGE" brand toothbrushes I was  
given in response to my order for "ACE" toothbrushes.

AND I MAKE this solemn declaration conscienti-  
ously believing the same to be true and by virtue of  
the provisions of the Statutory Declarations  
Ordinance.

DECLARED at Singapore this) Sd. Clement Tan  
3rd day of February, 1971.)

Before me,

Sd. Tan Seow Kiew

A Commissioner for Oaths,  
Singapore.

In the High Court of Singapore

No.11

AFFIDAVIT (No.2) OF CLEMENT TAN

No.11  
Affidavit  
(No.2) of  
Clement Tan  
16th February  
1971

I, Clement Tan of 292, Telok Kurau Road, Singapore do make oath and say as follows:-

1. I am a clerk employed by Messrs. Drew & Napier of 30/35 Chartered Bank Chambers, Battery Road, Singapore.

2. At approximately 10.20 a.m. on Thursday, the 11th day of February, 1971 I was instructed to purchase one dozen of "ACE" brand tooth brushes from Hoe Huat Hup Kee at 46, Mei Ling Street, Block 154, Singapore, 3.

10

3. At approximately 11.45 a.m. on the same day I arrived at Hoe Huat Hup Kee and saw several tooth brushes on display on the counter. I then produced the sample of the "ACE" tooth brush which I had brought with me and asked for a dozen of "ACE" brand tooth brush from a man shop assistant who in response to my order handed me "AGE" brand tooth brushes for which I paid the sum of \$3.20.

20

4. There is now produced and marked "C.T.1" the "ACE" brand tooth brush which I showed to the shop assistant when making my order for one dozen "ACE" tooth brushes.

5. There is now produced and shown to me and marked "C.T.2" the "AGE" brand tooth brushes I was given in response to my order for "ACE" tooth brush. No receipt was issued in respect of this purchase, although I asked for it.

6. Attached hereto and marked "C.T.3" is the Statutory Declaration I swore soon after the trap purchase was made.

30

Sworn at Singapore by the )  
abovenamed Clement Tan this ) Sd. Clement Tan  
16th day of February, 1971. )

Before me,

Sd. D.E.S. Chelliah

A Commissioner for Oaths,  
Singapore.

No. 12  
Exhibit C.T. 3

In the High  
Court of  
Singapore

STATUTORY DECLARATION

No.12

Exhibit C.T.3  
11th February  
1971

I, CLEMENT TAN of 292, Telok Kurau Road,  
Singapore 15, do solemnly and sincerely declare as  
follows:-

1. I am a clerk employed by Messrs. Drew & Napier  
of 30/35 Chartered Bank Chambers, Battery Road,  
Singapore.

10 2. At approximately 10.20 a.m. on Thursday the  
11th day of February 1971 I was instructed to  
purchase one dozen of "ACE" brand toothbrushes from  
Hoe Huat Hup Kee at 46, Mei Ling Street, Block 154,  
Singapore 3.

20 3. At approximately 11.45 a.m. on the same day I  
arrived at Hoe Huat Hup Kee and saw several tooth-  
brushes on display on the counter. I then produced  
the sample of the "ACE" toothbrush which I had  
brought with me and asked for a dozen of "ACE"  
brand toothbrush from a man shop assistant who in  
response to my order handed me "AGE" brand tooth-  
brushes for which I paid the sum of \$3.20.

4. There is now produced and marked "C.T.1" the  
"ACE" brand toothbrush which I showed to the shop  
assistant when making my order for one dozen "ACE"  
toothbrushes.

30 5. There is now produced and shown to me and  
marked "C.T.2" the "AGE" brand toothbrushes I was  
given in response to my order for "ACE" toothbrush.  
No receipt was issued in respect of this purchase,  
although I asked for it.

AND I MAKE this solemn declaration conscienti-  
ously believing the same to be true and by virtue of  
the provisions of the Statutory Declarations  
Ordinance.

DECLARED at Singapore this )  
11th day of February, 1971.) Sd. Clement Tan

Before me,

Sd. S.K. Tan

40 A Commissioner for Oaths,  
Singapore.

In the High Court of Singapore

No. 13

AFFIDAVIT (No.3) OF CLEMENT TAN

No.13  
Affidavit  
(No.3) of  
Clement Tan  
16th February  
1971

I, Clement Tan of 292, Telok Kurau Road, Singapore do make oath and say as follows:-

1. I am a clerk employed by Messrs. Drew & Napier of 30/35 Chartered Bank Chambers, Battery Road, Singapore.

2. At approximately 10.30 a.m. on Friday, the 12th day of February, 1971 I was instructed to purchase the dozen "ACE" brand tooth brushes from Malabar Store at 310, Tanjong Katong Road, Singapore 15. 10

3. At approximately 10.30 a.m. on Saturday, the 13th day of February, 1971 I arrived at Malabar Store and saw several tooth brushes on display on the counter. I then produced the sample of the "ACE" brand tooth brush which I had brought with me and asked for a dozen of "ACE" brand tooth brushes from a lady shop assistant who in response to my order handed me eight "AGE" brand tooth brushes for which I paid the sum of \$2.40 and obtained a receipt which is attached hereto and marked "C.T.1". 20

4. There is now produced and marked "C.T.2" an "ACE" brand tooth brush which I showed to the shop assistant when making my order for one dozen "ACE" tooth brushes.

5. There is now produced and shown to me and marked "C.T.3" the "AGE" brand tooth brushes I was given in response to my order for "ACE" tooth brushes. 30

Sworn at Singapore by the )  
abovenamed Clement Tan this ) Sd. Clement Tan  
16th day of February, 1971.)

Before me,

Sd. D.E.S. Chelliah

A Commissioner for Oaths,  
Singapore.

16.

No. 14  
Exhibit C.T. 1

In the High  
Court of  
Singapore

CASH BILL

No.15  
Exhibit C.T.1  
12th February  
1971

No. A 1398

Date: 13/

M A L A B A R     S T O R E

310 TANJONG KATONG ROAD     SINGAPORE-15.

Book Sellers, Stationers & Specialist in  
technical Equipments

Particulars	₹ cts.
8 Toothbrushes @ 30¢	2 40

10

Paid

E. & O.E.

Goods once sold cannot be taken back.  
Thank you. Call again.

This is the exhibit marked "C.T.1"  
referred to in the affidavit of  
CLEMENT TAN sworn this 16th day of  
February, 1971.

Before me,

20

Sd. D.E.S. Chelliah

A Commissioner for Oaths.



In the High Court of Singapore

No. 15

AFFIDAVIT (No.4) OF CLEMENT TAN

No.15  
Affidavit  
(No.4) of  
Clement Tan  
16th February  
1971

I, Clement Tan of 292, Telok Kurau Road, Singapore do make oath and say as follows:

1. I am a clerk employed by Messrs. Drew & Napier of 30/35 Chartered Bank Chambers, Battery Road, Singapore.

2. At approximately 10.30 a.m. on Friday, the 12th day of February, 1971 I was instructed to purchase one dozen of "ACE" brand tooth brushes from No.923A, Geyland Road, Singapore 14. 10

3. At approximately 11.30 a.m. on Saturday, the 13th day of February, 1971 I arrived at 923A, Geyland Road, and saw several tooth brushes on display on the counter. I then produced the sample of the "ACE" brand tooth brush which I had brought with me and asked for a dozen of "ACE" brand tooth brushes from a man in the shop who in response to my order handed me "AGE" brand tooth brushes for which I paid the sum of \$3.60 and obtained a receipt which is attached hereto and marked "C.T.1". 20

4. There is now produced and marked "C.T.2" an "ACE" brand tooth brush which I showed to the man when making my order for one dozen "ACE" tooth brushes.

5. There is now produced and shown to me and marked "C.T.3" the "AGE" brand tooth brushes I was given in response to my order for "ACE" tooth brushes. 30

Sworn at Singapore by the )  
abovenamed Clement Tan this ) Sd. Clement Tan  
16th day of February, 1971.)

Before me,

Sd. D.E.S.Chelliah

A Commissioner for Oaths.

Singapore.

18.

No. 16

Exhibit C.T. 1

In the High  
Court of  
Singapore

No.16

Exhibit C.T.1

A. Brush 1 Doz. 3.60

No.923A, Geyland Road,  
Singapore 14.

This is the exhibit marked "C.T.1"  
referred to in the affidavit of  
CLEMENT TAN sworn this 16th day of  
February, 1971.

10

Before me,

Sd. D.E.S. Chelliah

A Commissioner for Oaths

In the High  
Court of  
Singapore

No. 17

AFFIDAVIT (No.5) OF CLEMENT TAN

No.17  
Affidavit  
(No.5) of  
Clement Tan  
16th February  
1971

I, Clement Tan of 292, Telok Kurau Road,  
Singapore, do make oath and say as follows:-

1. I am a clerk employed by Messrs. Drew &  
Napier of 30/35 Chartered Bank Chambers, Battery  
Road, Singapore.

2. At approximately 10.30 a.m. on Friday, the  
12th day of February 1971 I was instructed to  
purchase one dozen "ACE" brand tooth brushes from  
Guan Moh Chan at 110 East Coast Road, Singapore.

10

3. At approximately 12.20 p.m. on Saturday, the  
13th day of February, 1971 I arrived at Guan Moh  
Chan and saw several tooth brushes on display on  
the counter. I then produced the sample of the  
"ACE" brand tooth brush which I had brought with  
me and asked for a dozen of "ACE" brand tooth  
brushes from a man shop assistant who in response  
to my order handed me  $\frac{1}{2}$  dozen of "AGE" brand tooth  
brushes for which I paid the sum of \$1.60. No  
receipt was issued in respect of this purchase.

20

4. There is now produced and marked "C.T.1" the  
"ACE" brand tooth brush which I showed to the shop  
assistant when making my order for one dozen "ACE"  
tooth brushes.

5. There is now produced and shown to me and  
marked "C.T.2" the "AGE" brand tooth brushes I was  
given in response to my order for "ACE" tooth  
brushes.

Sworn at Singapore by the )  
abovenamed Clement Tan this ) Sd. Clement Tan  
16th day of February, 1971.)

30

Before me,

Sd. D.E.S. Chelliah

A Commissioner for Oaths.

Singapore.

No. 18

AFFIDAVIT OF K. Y. TONGSONIn the High  
Court of  
Singapore

No.18

Affidavit of  
K.Y. Tongson  
10th February  
1971

I, K.Y. Tongson of 25, Tai Yau Street, San Po Kong, Kowloon, Hong Kong affirm and say as follows:

1. I am a Director and also the Development Manager of Star Industrial Company Limited, a Company incorporated in Hong Kong, being the manufacturer of the applicants' products.

10 2. The abovenamed Applicants have been manufacturing toothbrushes under the ACE Trade Mark since at least 1956 and have been exporting tooth brushes under the ACE trade mark to Singapore since that date up to 1968.

A sample of the Applicants' ACE tooth brush is attached hereto and marked "KYT 1".

3. The sales of tooth brushes bearing the ACE Trade Mark in Singapore are very substantial and given hereunder are details of sale of the said tooth brushes in Singapore.

20	<u>Year</u>	<u>Quantity Sold</u> (In Excess of:)	<u>Gross Value</u> (In Excess of:)
	1956 - 1959	58,000 dozens	\$150,000.00
	1960	28,188 dozens	\$ 51,366.53
	1961	50,480 dozens	\$ 86,445.54
	1962	47,436 dozens	\$ 86,527.43
	1963	45,360 dozens	\$ 82,550.88
	1964	41,940 dozens	\$ 76,953.98
	1965	30,820 dozens	\$ 56,321.14
	1966	11,340 dozens	\$ 20,899.62
30	1967	5,214 dozens	\$ 9,609.40
	1968	240 dozens	\$ 481.13
	1969	19,452 dozens	\$ 39,278.77
	1970	221,520 dozens	\$447,213.68

40 4. It will be noticed that between 1967 and 1968 the sales of my Company's ACE tooth brushes fell sharply and this is because of very severe tariff imposition by the Singapore Government which wiped out any possibility of selling RED A ACE tooth brushes which originate from Hong Kong which up to 1968 has been the base of manufacturing operations of my Company and the origin of the RED A ACE tooth brushes.

In the High  
Court of  
Singapore

No.18

Affidavit of  
K.Y. Tongson

10th February  
1971

(continued)

5. In 1969 my Company incorporated an associate Company in Singapore called Star Plastics Industrial Co. (Pte.) Ltd. and commenced manufacturing locally in Singapore tooth brushes and other plastic products for sale in Singapore as well as to markets overseas and, as a result, sales of my Company's ACE tooth brushes in Singapore were revived.

6. My Company has also spent a considerable amount of money in promoting this Trade Mark and attached hereto and marked "KYT 2" are samples of advertisements which were inserted by my Company in several local newspapers. 10

7. Given hereunder are details of advertising expenditure incurred by my Company in promoting the ACE Trade Mark.

<u>Year</u>	<u>Advertising Costs</u> (In Excess of:)
1960	\$10,000/-
1961	\$10,000/-
1962	\$10,000/-
1963	\$10,000/-
1964	\$ 4,000/-
1965	\$ 4,000/-
1966	\$ 8,000/-
1967	\$ 4,000/-
1968	\$ 4,000/-
1969	\$ 4,000/-
1970	\$ 4,000/-

8. By virtue of such use by my Company of the ACE Trade Mark on tooth brushes my Company has now acquired what is known as common law proprietorship in the Trade Mark. 30

9. My Company did not make any attempt to register the ACE Trade Mark in Singapore until late 1969 when two applications were filed in Singapore through Messrs. Drew & Napier under Applications Nos. 47884 and 47885.

Certified copies of the Applications Nos. 47884 and 47885 are now attached and marked "KYT 3" and "KYT 4" respectively. 40

10. Soon after these applications were filed the Registrar of Trade Marks objected to these

applications on the grounds of possible conflict with Trade Marks Nos. 12197 and 39808.

Certified extracts of the cited conflicting Registrations Nos. 12197 and 39808 are now attached and marked "KYT 5" and "KYT 6" respectively.

In the High  
Court of  
Singapore

—  
No.18

Affidavit of  
K.Y. Tongson

10th February  
1971

(continued)

10 11. The citation of Trade Mark No. 12197 is in so far as the Applicant Company is concerned is not serious as it is in respect of wire brushes only and can be overcome upon the Applicant Company excluding wire brushes from the goods intended to be covered by Applications Nos. 47884 and 47885.

20 12. The citation of Trade Mark No. 39808 is however more serious and forms a complete bar to the registration of the Applicant Company's ACE Trade Mark since the word "AGE" and "ACE" are considered too close and confusingly similar. Besides, Trade Mark No. 39808 has been registered in respect of tooth brushes which are the goods of interest to the Applicant Company and on which the ACE Trade Mark has been used by the Applicants.

13. The Applicant Company are therefore aggrieved persons within the meaning of Section 39(1)(a) of the Trade Marks Ordinance.

14. The Applicant Company has made investigations of the use of the AGE Trade Mark No. 39808 by the Respondents and attached hereto and marked "KYT 7" is a sample of the Respondents' AGE tooth brush.

30 15. The Applicant Company has been using the ACE Trade Mark as per exhibit "KYT 1" of this Affidavit since 1956 in Singapore whereas the date of registration of Application No. 39808 is 3rd August 1966 and in the premises the Applicant Company has prior rights in the ACE Trade Mark.

16. It will be noted from a comparison of the Applicant Company's ACE Trade Mark and the Respondents' AGE Trade Mark that there is a close similarity not only between the two Trade Marks

In the High  
Court of  
Singapore

—  
No.18

Affidavit of  
K.Y. Tongson

10th February  
1971

(continued)

but also in the get-up and design of the two types of tooth brushes and confusion and deception is bound to arise to the trade and public. The use of the Respondents' Trade Mark would therefore offend against Section 15 of the Trade Marks Ordinance.

17. The Applicant Company through its Solicitors Messrs. Drew & Napier have written to the Respondents requesting them to cancel their registration voluntarily and to cease the use of the particular get-up and design of the Applicants' tooth brushes but the Respondents have failed to comply with the Applicant Company's demands.

10

Attached hereto and marked "KYT 8" is a copy of the letter sent by Messrs. Drew & Napier to the Respondents.

18. The use by the Respondent Company of the Trade Mark AGE in a get-up and design which is confusingly similar to the Applicant Company's ACE tooth brushes is designed to pass-off the Respondents' goods as and for the Applicant Company's goods and therefore the use of the Respondent Company's Trade Mark is deceptive and contravenes Section 15 of the Trade Marks Ordinance.

20

19. By reason of the prior use of the ACE Trade Mark by the Applicant Company and its particular get-up and design the Respondents are not entitled to claim to be the proprietors of the AGE Trade Mark and therefore their registration was obtained contrary to Section 11 of the Trade Marks Ordinance.

30

20. By virtue of the Applicant Company's prior use of the ACE Trade Mark on tooth brushes the Trade Mark AGE is not distinctive for the purposes of registration under Section 10 of the Trade Marks Ordinance and that therefore the Respondents' registration has been obtained under false representations to the Registrar of Trade Marks and therefore ought to be expunged.

40

In the High  
Court of  
Singapore

—  
No.18

Affidavit of  
K.Y. Tongson

10th February  
1971

(continued)

10 21. If at the time of application of Trade Mark No.39808, the Registrar had been made aware of the Applicants' prior use of the AGE Trade Mark the Registrar of Trade Marks would have refused registration of the Respondents' Trade Mark No.39808 under Section 10 and 11 of the Trade Marks Ordinance. If the Registrar was made aware that the respondents' use of the AGE Trade Mark was designed to pass-off the Respondents' tooth brushes as and for the Applicant Company's Trade Mark he would have refused registration of the Respondents' Trade Mark No.39808 under Section 15 of the Trade Marks Ordinance.

20 22. The Applicant Company was not aware of the Respondents' registration No. 39808 until the Registrar cited this mark against the Applicant Company's Applications Nos.47884 and 47885 whereupon the Applicant Company then made investigations and discovered the wrongful use of the AGE Trade Mark by the Respondents in a get-up and design confusingly similar to the Applicant Company's design and get-up of their AGE Trade Mark which has been used by the Applicant Company since 1956.

23. The Respondents' Registration No.39808 was therefore obtained wrongfully when:-

- 30 (1) The Respondents declared in their Form of Application that they were the proprietors of the AGE Trade Mark when in fact they were not the reason being the Applicant Company's prior use of the AGE Trade Mark.
- (2) The Respondents represented to the Registrar of Trade Marks that their AGE Trade Mark was adopted to distinguish when in fact it was not and could not be capable of distinguishing their goods having regard to the Applicant Company's prior use of the AGE Trade Mark with its particular get-up and design.

40 24. Furthermore the Respondents' Registration No. 39808 now remains wrongfully on the Register by



In the High  
Court of  
Singapore

—  
No.18

Affidavit of  
K.Y. Tongson  
10th February  
1971

(continued)

reason of its confusing similarity with the Applicant Company's ACE Trade Mark which has been used by the Applicant Company since 1956 and as such Registration No.39808 offends Section 15 of the Trade Marks Ordinance.

25. By reason of the aforesaid premises the Respondents' Registration No.39808 is an entry wrongfully remaining on the Register and should be expunged.

AFFIRMED at Hong Kong by the )  
abovenamed K.Y. Tongson this )  
Tenth day of February, 1971. )

10

Before me,

Sd. Woo Po Thing

A Notary Public,  
Hong Kong.

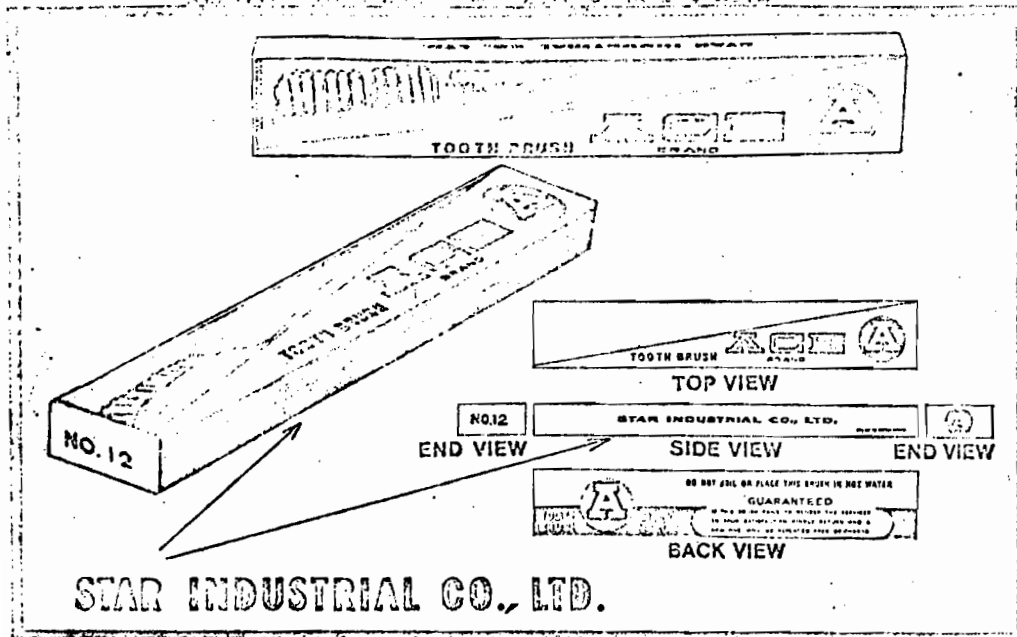
Stamp of Hongkong

₤3.00

# WARNING NOTICE

**RED A ACE Trade Mark  
IMITATORS BEWARE!**

*Straits Times dated the 23rd January, 1971*



**STAR INDUSTRIAL CO., LTD.**

Star Industrial Co. Ltd.  
Hong Kong.

In the High  
Court of  
Singapore

No. 19

Warning notice  
and samples of  
advertisements

The trade and public are advised that Star Industrial Co. Ltd., are the exclusive proprietors of the RED A ACE trade mark used on tooth brushes representations of which appear above.

Star Industrial Co. Ltd., are the first user and manufacturer of the RED A ACE brand plastic-handled tooth brushes.

As a result of its great popularity the RED A ACE trade mark has been widely copied and imitated by unscrupulous manufacturers and traders all over South East Asia.

Star Industrial Co. Ltd., have commenced the first of a series of legal proceedings against such imitation of their tooth brushes in Indonesia and this action, heard by the Indonesian Country Court on the 17th day of November, 1970 has resulted in a verdict wholly in favour of Star Industrial Co. Ltd., under Judgment No. 376/1970G. This Judgment firmly establishes that Star Industrial Co. Ltd., are the exclusive proprietors of the RED A ACE trade mark for tooth brushes. A claim for loss and damages against the Indonesian imitators is now in process. Similar actions are being contemplated against manufacturers and traders in Singapore and Malaysia who are imitating the RED A ACE brand on tooth brushes and other RED A brand plastic products.

Members of the trade are advised to avoid imitating the RED A ACE trade mark for tooth brushes as well as other plastic products for which Star Industrial Co. Ltd., have established a reputation under the RED A trade mark as by doing so they will get themselves unnecessarily involved in Court proceedings.

Proceedings against imitators will be commenced without hesitation so as to protect the well-known RED A ACE trade mark and to uphold the good reputation which this trade mark enjoys with consumers.

MESSRS. DREW & NAPIER,  
30, 35, Chartered Bank Chambers,  
Battery Road,  
Singapore.

Solicitors for Star Industrial Co. Ltd.

Exhibit K.Y.T. 2

In the High Court of Singapore

No. 19

Warning Notice and samples of advertisements (continued)

Newspaper: Singapore (星洲日報)  
Insertion Date: 24th September, 1961;  
12th October, 1961.

The advertisement is for Lawson's toothbrushes. It features a central illustration of a family (a man, a woman, and two children) smiling. Below the illustration, several toothbrushes are displayed diagonally. The text is in Chinese characters, including 'LAWSON'S' and '星洲日報'. A circular seal is visible in the bottom right corner of the ad area.

Exhibit K.Y.T. 2

Newspaper: Singapore ( )  
Insertion Date: 16th, 20th, 24th, 28th August, 1962.

In the High  
Court of  
Singapore

No. 19

Warning Notice  
and samples of  
advertisements  
(continued)

兒童、少年、成人  
 備有各款、等價  
 料原色最  
 造製工精  
 年半耐用

品元 廠牌 總經 理  
 坡坡二四五坊安南街廣興隆  
 二九四四四 二八二〇七

Exhibit K.Y.T. 2

In the High  
Court of  
Singapore

No. 19

Warning Notice  
and samples of  
advertisements  
(continued)

Newspaper: Singapore (星洲報)  
Insertion Date: 15th, 20th, 24th, 29th August, 1962.  
3rd September, 1962.

星洲報

老少咸宜  
款式新穎

長位佳潔  
潔齒五線  
保潔耐用

海獅牌

星洲報廣告部

Exhibit K.Y.T. 2

Newspaper: Singapore ( )

Insertion Date: 4th, 11th, 12th, 18th, 25th September, 196

In the High  
Court of  
Singapore

No. 19

Warning Notice  
and samples of  
advertisements  
(continued)

南洋  
 總代理  
 新加坡  
 海山街  
 電話  
 號碼

Exhibit K.Y.T. 3

In the High Court of Singapore

No. 20

Exhibit K.Y.T. 3

26th January 1971

This is the exhibit marked "KYT 3" referred to in the affidavit of K.Y. Tongson sworn this 10th day of February, 1971.

THE TRADE MARKS ORDINANCE (CHAPTER 165)

Before me,  
Sd. Illegible

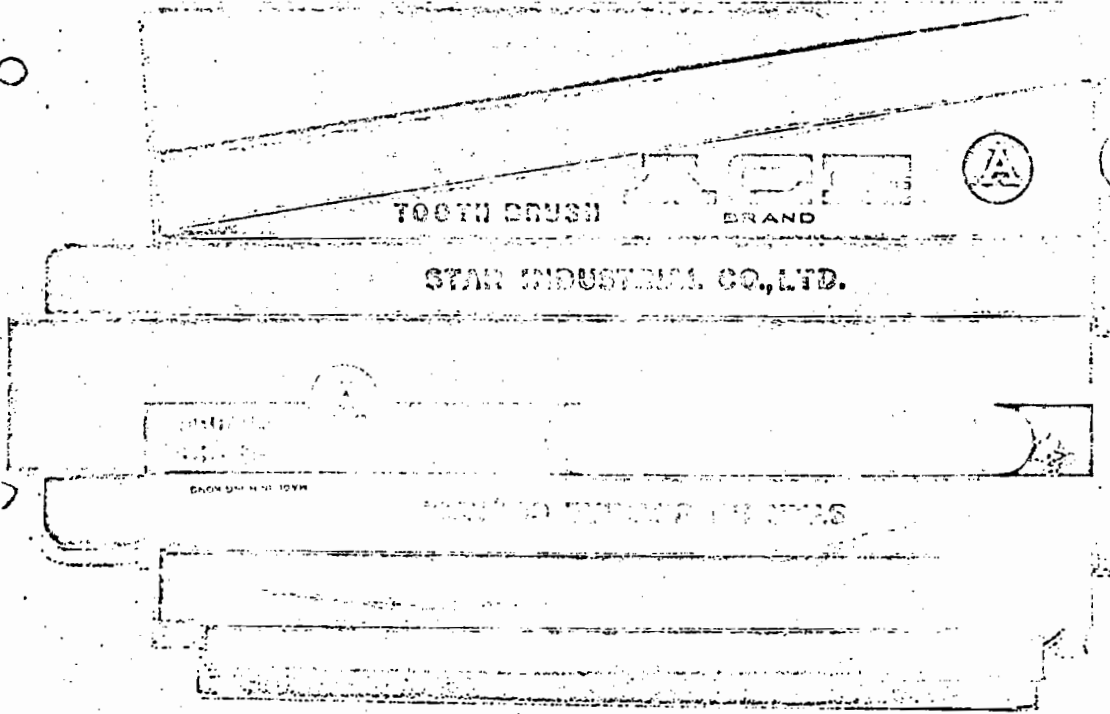
In the Matter of an Application for the Registration of a Trade Mark of Star Industrial Company Limited.

NOTARY PUBLIC

I, the undersigned, being the Deputy Registrar and an Officer duly authorized under Section 3(4) of the Trade Marks Ordinance, (Chapter 165), hereby CERTIFY that under date the 3rd December, 1969, an application was made by STAR INDUSTRIAL COMPANY LIMITED, a Company incorporated in Hong Kong, of 25, Tai Yau Street, San Po Kong, Kowloon, Hong Kong, Manufacturers and Merchants, for the registration of a Trade Mark in Class 21, under No. 47884 in respect of Brushes, and that such application is still pending.

The Trade Mark is limited to the colours as shown in the representation on the form of application.

A copy of the said Trade Mark appears below.



Witness my hand this 26th day of January, 1971.

(Katherine Lam Sui Hong)  
By Registrar of Trade Marks  
Singapore

THE TRADE MARKS REGISTRY,  
SINGAPORE

*No. 21*  
Exhibit K.Y.T. 4

*In the High Court  
of Singapore*  
*No. 21*  
*Exhibit K.Y.T. 4*

This is the exhibit marked "KYT 4" referred to in the affidavit of K.Y. Tongson sworn this 10th day of February, 1971.

Before me,  
Sd. Illegible  
NOTARY PUBLIC

In the Matter of an Application for the Registration of a Trade Mark of Star Industrial Company Limited.

In the High Court of Singapore

No. 21

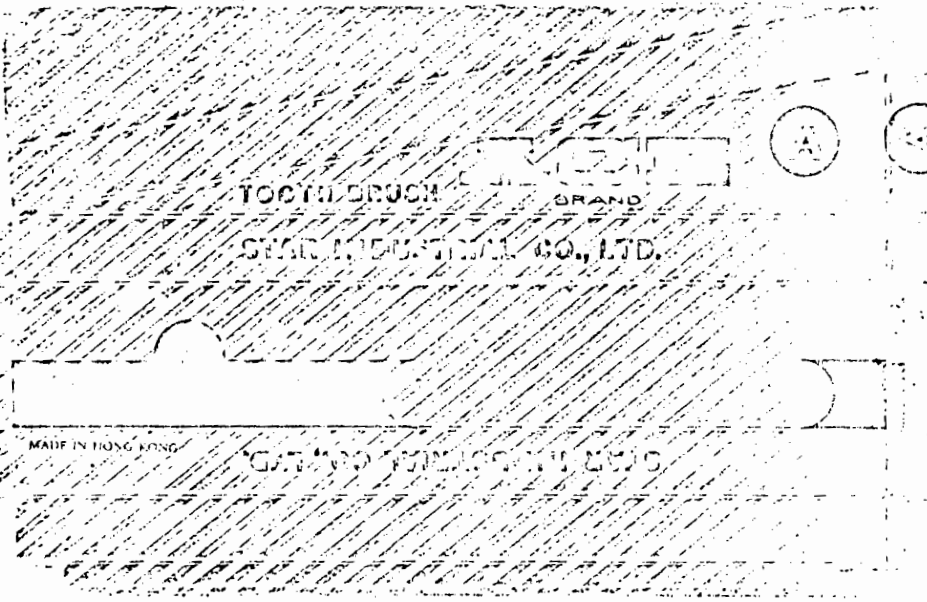
Exhibit K.Y.T. 4  
26th January 1971

*26th January, 1971*

I, the undersigned, being the Deputy Registrar and an Officer duly authorized under Section 3(4) of the Trade Marks Ordinance, (Chapter 165), hereby CERTIFY that under date the 3rd December, 1969, an application was made by STAR INDUSTRIAL COMPANY LIMITED, a Company incorporated in Hong Kong, of No. 25, Tai Yai Street, San Po Kong, Kowloon, Hong Kong, Manufacturers and Merchants, for the registration of a Trade Mark in Class 21, under No. 47885 in respect of brushes, and that such application is still pending.

The Trade Mark is limited to the colours as shown in the representation on the form of application.

A copy of the said Trade Mark appears below.



Witness my hand this 26th day  
of January, 1971.

*(Katherine Lim Sai Hong)*  
By, Registrar of Trade Marks,  
Singapore.

THE TRADE MARKS REGISTRY,  
SINGAPORE.



No. 22

In the High Court of Singapore

Exhibit KYT 5

No.22

Exhibit KYT 5

23rd January 1971

This is the exhibit marked "KYT 5" referred to in the affidavit of K.Y.Tongson sworn this 10th day of February, 1971

THE TRADE MARKS ORDINANCE  
(CHAPTER 185)

This Certificate is issued for use in Legal Proceedings

Before me,

Sd. Illegible

NOTARY PUBLIC

10

No.12197

IN THE MATTER OF THE REGISTERED  
TRADE MARK NO.12197

I, the undersigned, being the Deputy Registrar and an Officer duly authorised under Section 3(4) of the Trade Marks Ordinance, (Chapter 185), hereby CERTIFY that as from the 28th day of February, 1950, the Trade Mark, a copy of which is affixed hereto, is registered in the name of LIM KENG SENG (British Subject) trading as TAI CHEONG & CO., of No.135, Beach Street, Penang, Federation of Malaya, Merchant, in Class 21, in respect of "Wire brushes".

20

The Registration has been renewed for a period of fourteen years from the 28th day of February, 1957, and may be renewed at the expiration of that period and on the expiration of each succeeding period of fourteen years.

DOUBLE ACE



WITNESS my hand this 23rd day of January, 1971

Sd. Illegible

(Katherine Lim Sui Hong)

Dy. Registrar of Trade Marks,  
Singapore

THE TRADE MARKS REGISTRY,  
SINGAPORE.

TYT/-

30

In the High  
Court of  
Singapore

No. 23

Exhibit KYT 6

No.23  
Exhibit KYT 6  
23rd January  
1971

This is the exhibit  
marked "KYT 6" referred  
to in the affidavit of  
K.Y.Tongson sworn this  
10th day of February,  
1971.

THE TRADE MARKS  
ORDINANCE (CHAPTER 185)

This Certificate is  
issued for use in  
Legal Proceedings

Before me,

Sd. Illegible  
NOTARY PUBLIC

10

IN THE MATTER OF THE REGISTERED  
TRADE MARK NO.B39808

I, the undersigned, being the Deputy Registrar  
and an Officer duly authorised under Section 3(4)  
of the Trade Marks Ordinance, (Chapter 185), hereby  
CERTIFY that as from the 3rd day of August, 1966,  
the Trade Mark, a representation of which appears  
below, is registered in the name of YAP KWEE KOR  
(Malaysian Citizen) trading as YAP TRADING CO.,  
of 18 Hokien Street, Singapore 1; Manufacturers  
and Merchants, in Class 21, in respect of "Tooth  
brushes".

20

In pursuance of an application received on  
the 11th May, 1970, Name and address of Proprietor  
altered to:- New Star Industrial Company; of  
307-A Jalan Bukit Merah, Block 1, Redhill Flatted  
Factory, Singapore 3.

The Trade Mark is registered for a period of  
seven years from the above date and may be renewed  
at the expiration of that period and on the  
expiration of each succeeding period of fourteen  
years.

30

A G E

WITNESS my hand this 23rd day  
of January, 1971.

THE TRADE MARKS  
REGISTRY,  
SINGAPORE.  
KLSH/LFP.

Sd. Illegible  
(Katherine Lim Sui Hong)  
Dy. Registrar of Trade Marks,  
Singapore.

No. 24

Exhibit KYT 8

This is the exhibit marked "KYT 8" referred to in the affidavit of K.Y. Tongson sworn this 10th day of February, 1971.

Before me,

Sd. Illegible

NOTARY PUBLIC

In the High  
Court of  
Singapore

No.24

Exhibit KYT 8

15th January  
1971

10 Our Ref: MS/AF/TM 773-70

15th January, 1971.

A.R. REGISTERED

Yap Kwee Kor t/a Yap Trading Co.,  
18, Hokien Street,  
Singapore, 1.

Dear Sirs,

Re: Proposed Rectification Proceedings  
against your Registration No.39808  
in Class 21

- 20 1. We act for Star Industrial Co. L+d., who are the common law proprietors of the Trade Mark ACE which has been used by them on tooth brushes in Singapore since 1956.
2. Our clients have applied for registration of their ACE Trade Mark in Class 21 in Singapore under Nos. S/47884 and S/47885 but these applications have been objected to by the Registrar of Trade Marks on the grounds of conflict with your Registration No.39808 also covering tooth brushes.
- 30 3. The Registrar has held the view that the Trade Marks ACE and AGE are confusingly similar and therefore cannot be registered side by side.
4. Our clients have made investigations on your use of the Trade Mark AGE and we find that your tooth brushes under the AGE Trade Mark have been

In the High  
Court of  
Singapore

No.24  
Exhibit KYT 8  
15th January  
1971  
(continued)

packed with a get-up and design which is confusingly similar to our clients' ACE Trade Mark.

5. Our clients and ourselves hold the view that the particular get-up of your AGE tooth brushes is bound to lead to confusion and deception arising to the trade and public having regard to our clients' prior use of the get-up and packing of their ACE tooth brushes.

6. Our clients have been using the particular get-up and design of their ACE tooth brushes since 1956 and therefore have acquired prior common law rights to the Trade Mark and get-up of their tooth brushes. 10

7. The purpose of this letter is to enquire whether:-

(a) You would be prepared to cancel your Registration No.39808 voluntarily.

(b) Cease the further manufacture of AGE tooth brushes. 20

(c) Cease the use of the particular get-up and design adopted by our clients for their ACE tooth brushes.

8. We have instructions from our clients to commence separately against you the following proceedings:-

(a) Rectification of the Register of your Trade Mark No.39808.

(b) Passing-off proceedings against you at common law for the unlawful use and adoption of a get-up and design of our clients' ACE tooth brushes. 30

9. Unless you are prepared to comply with our demands herein within seven days of the date of this letter we regret proceedings will be initiated for the cancellation of your Registration as well as for an Injunction to restrain you from passing-off your tooth brushes as and for the tooth brushes of our clients.

Yours faithfully,  
Sd. Drew & Napier

c.c. The Registrar of Trade Marks,  
Singapore.  
c.c. Clients. 40

No. 25

WRIT OF SUMMONSIn the High  
Court of  
SingaporeNo.25Writ of  
Summons9th February  
1971

The Plaintiffs' claim is for:-

1. An Injunction to restrain the Defendant whether by himself, his servants or agents or any of them or otherwise howsoever from passing-off or attempting to pass-off or causing enabling or assisting others to pass-off tooth brushes not the manufacture of the Plaintiffs as and for the tooth brushes of the Plaintiffs by the use or in connection therewith in the course of trade of a get-up similar to that of the Plaintiffs' ACE marked tooth brushes or any colourable imitation thereof, without clearly distinguishing such use from the goods of the Plaintiffs or by any other means.

2. An Injunction to restrain passing-off or attempting to pass-off the business of the Defendant as manufacturers of tooth brushes as and for the business of the Plaintiffs by the use in connection therewith of the trading name New Star Industrial Co., or by any other means.

3. An inquiry as to damages or at the Plaintiffs' option an account of profits and payment of all sums found due upon taking inquiry of such account.

4. Delivery up or destruction upon oath of all AGE marked tooth brushes in the possession, custody or control of the Defendant.

5. Costs.

6. Further or other relief.

Sd. Drew &amp; Napier

Solicitors for the Plaintiffs

In the High  
Court of  
Singapore

No. 26

STATEMENT OF CLAIM

No.26  
Statement  
of Claim  
9th February  
1971

1. The Plaintiffs are a Company incorporated in Hong Kong having their registered office at 25, Tai Yau Street, San Po Kong, Kowloon, Hong Kong and carry on business there as manufacturers and traders in inter-alia tooth brushes and other plastic goods.

2. The Plaintiffs have an associated Company in Singapore known as Star Plastics Industrial Co. (Pte.) Ltd., at Lot 7 Section 4, Lorong Tukang Tiga, Jurong Industrial Estate, Singapore, 22. 10

3. The said business has been carried on by the Plaintiffs and their predecessors for upwards of twenty years.

4. For upwards of fourteen years the Plaintiffs have manufactured and sold in Singapore tooth brushes packed in hard paper with a silvery background and with the word "ACE" and the alphabet "A" within a red circle clearly embossed on the packet. 20

Particulars of the Plaintiffs' tooth brushes

The front panel of the Plaintiffs' tooth brush packet is divided diagonally into two parts, the top part consisting of white transparent cellophane paper and the bottom half of plain hard paper with a silver background with the words ACE BRAND TOOTH BRUSH together with the symbol of the letter "A" enclosed within a red circle embossed thereon. 30

The prominent feature of the front face consists of the words ACE BRAND together with the letter "A" enclosed within a red circle.

The back face of the Plaintiffs' tooth brush consists as a distinctive portion thereof the alphabet "A" within a red circle.

On the right face of the back face the following words appear:-

"DO NOT BOIL OR PLACE THIS BRUSH IN HOT WATER

GUARANTEED

IF THIS BRUSH FAILS TO RENDER THE SERVICES TO  
YOUR SATISFACTION, KINDLY RETURN AND A NEW  
ONE WILL BE REPLACED FREE OF CHARGE "

On the left hand side of the back face the words TOOTH BRUSH BEST NYLON appear on a black panel.

In the High  
Court of  
Singapore

No.26

Statement  
of Claim

9th February  
1971

(continued)

10 5. The Plaintiffs and their predecessors have sold in Singapore since 1956 very large quantities of tooth brushes packed in the manner aforesaid bearing the said label and get-up and by reason of the said use of the said packet and the get-up has become very wellknown and has for the last fourteen years been distinctive of the tooth brushes of the Plaintiffs and no others.

20 6. The Plaintiffs have been trading under their trading name Star Industrial Company Limited for upwards of fourteen years and their associates in Singapore are also known as Star Plastics Industrial Co. (Pte.) Ltd.

7. The Defendant is the sole proprietor of the firm known as New Star Industrial Co., carrying on business as tooth brush manufacturers at 307-A, Block 1, Jalan Bukit Merah, Redhill Flatted Factory, Singapore, 3.

30 8. The Plaintiffs have recently ascertained as is the fact that the Defendant has put upon the market and sold tooth brushes not of the Plaintiffs' manufacture or merchandise in a packing and get-up which is a colourable and deceptive imitation of the wellknown packet and get-up of the Plaintiffs' tooth brushes.

Particulars of Defendant's tooth brush

40 The front face of the Defendant's tooth brush packet is divided diagonally into two parts, the top part consisting of white transparent cellophane paper and the bottom half of plain hard paper with a silver background with the symbol of the letter "A" enclosed within a red circle embossed thereon.

In the High  
Court of  
Singapore

No.26

Statement  
of Claim

9th February  
1971

(continued)

The prominent feature of the front face of the Defendant's tooth brush packet consists of the words AGE BRAND together with the letter "A" enclosed within a red circle.

The back face of the Defendant's tooth brush consists as a distinctive portion thereof the alphabet "A" within a red circle.

On the right of the back face the following words appear:-

"DO NOT BOIL OR PLACE THIS BRUSH IN HOT WATER

10

GUARANTEED

IF THIS BRUSH FAILS TO RENDER THE SERVICES TO  
YOUR SATISFACTION, KINDLY RETURN AND A NEW  
ONE WILL BE REPLACED FREE OF CHARGE "

On the left hand side of the back face of the packet the words TOOTH BRUSH BEST NYLON appear on a black panel.

Except for the substitution of the word AGE for ACE the Defendant has adopted every detail of the design and get-up of the Plaintiffs' tooth brush packet, including the shape of the tooth brush.

20

10. The use by the Defendant of the said get-up for his tooth brushes not of the Plaintiffs' manufacture or merchandise is calculated to lead to the belief that the Defendant's tooth brushes are the tooth brushes of the Plaintiffs and must have caused tooth brushes not of the Plaintiffs' manufacture and merchandise to be passed-off as and for the tooth brushes of the Plaintiffs and the Plaintiffs have thereby suffered and will suffer damage.

30

11. The use by the Defendant of his trading name "New Star Industrial Co." is calculated to lead to the belief that the Defendant's business is connected with the business of the Plaintiffs and is further calculated to cause and must have caused the Defendant's business to be associated with the Plaintiffs' business as tooth brush manufacturers and the Plaintiffs have thereby suffered and will suffer damage.

40



12. The Plaintiffs will contend in the absence of any satisfactory explanation as to how the Defendant came to adopt his trading name and the design and get-up of the Defendant's tooth brushes that the trading name of the Defendant and design and get-up of the Defendant's tooth brushes was adopted with the object of enabling the Defendant's business to be passed-off as and for the Plaintiffs' business and to pass-off the Defendant's tooth brushes as and for the tooth brushes of the Plaintiffs.

In the High  
Court of  
Singapore

—  
No.26

Statement  
of Claim

9th February  
1971

(continued)

13. The Plaintiffs have ascertained as a fact that tooth brushes under the AGE Trade Mark are being sold in Singapore as and for ACE Tooth brushes and will rely in particular on the following trap order:-

- (a) The sale of one dozen AGE tooth brushes by Mei Ling Store of No.16, Mei Ling Street, Block 152, Singapore on the 2nd day of February, 1971 to one Tan Kim Seng in response of our order for one dozen ACE tooth brushes.

14. The Plaintiffs are unable until after discovery to give particulars of all the acts of passing-off engaged in by retailers of the Defendant's tooth brushes but will seek to recover in respect of each of the same.

And the Plaintiffs claim:-

(a) An Injunction to restrain the Defendant whether by himself, his servants or agents or any of them or otherwise howsoever from passing-off or attempting to pass-off or causing enabling or assisting others to pass-off tooth brushes not the manufacture of the Plaintiffs as and for the tooth brushes of the Plaintiffs by the use or in connection therewith in the course of trade of a get-up similar to that of the Plaintiffs' ACE marked tooth brushes or any colourable imitation thereof, without clearly distinguishing such use from the goods of the Plaintiffs or by any other means.

(b) An Injunction to restrain passing-off or attempting to pass-off the business of the Defendant as manufacturers of tooth brushes as and for the business of the Plaintiffs by the use in connection therewith of the trading name New Star Industrial Co., or by any other means.

In the High Court of Singapore

No.26  
Statement of Claim  
9th February 1971  
(continued)

(c) An inquiry as to damages or at the Plaintiffs' option and account of profits and payment of all sums found due upon taking inquiry of such account.

(d) Delivery up or destruction upon oath of all AGE marked tooth brushes in the possession, custody or control of the Defendant.

(e) Costs.

(f) Further or other relief.

Delivered this 9th day of February, 1971.

Sd. Drew & Napier

10

Solicitors for the Plaintiffs.

No.27  
Defence  
26th April 1971

No. 27

DEFENCE

1. The Defendant denies paragraphs 1, 2, 3, 4, 5 and 6 of the Statement of Claim and in answer thereto will say that the Plaintiffs manufactured in Hong Kong and sold to Singapore tooth-brushes in the manner described in paragraph 4 of the Statement of Claim up to the year 1965 when the Plaintiffs ceased the manufacture and sale thereof and abandoned the trade and business in Singapore therein.

20

2. In the year 1967, the Defendant commenced to manufacture and sell tooth-brushes got up in the manner complained of under the Trade Mark "AGE" which said Trade Mark was registered in Singapore under No.39808 in the year 1966.

3. The Defendants will contend that although the get up was not dissimilar yet the goods were distinguishable from the goods previously sold by the Plaintiffs and that the Defendant did not pass off as and for the Plaintiffs' goods, goods not of the Plaintiffs' manufacture but sold the said goods as and for their own goods and the said get up and Trade Mark "AGE" became known to the trade and public as the trade mark of the Defendant firm.

30

4. The goods of the Defendant were manufactured and sold under the trading style "New Star Industrial Company" through inter alia the following parties:-

(i) Lim Teck Lee (Pte.) Ltd.,  
2-5 Circular Road,  
Singapore.

(ii) Falcon Enterprise (Pte.) Ltd.,  
32-B South Bridge Road,  
Singapore.

In the High  
Court of  
Singapore

No.27

Defence

26th April  
1971

(continued)

10

who actively promoted the sales of the said goods.

5. The following persons are shareholders and directors of Lim Teck Lee (Pte.) Ltd. - Lim Kee Hock, Lim Kee Chin, Lim Kee Ming and Lim Kee Siang, and Chng Peng Soon of 40 Tiverton Lane, Singapore, is an employee of Lim Teck Lee (Pte.) Ltd.

6. Falcon Enterprise (Pte.) Ltd. is a subsidiary of Lim Seng Huat (Singapore) Private Ltd.

7. In the year 1969 the following parties:-

(i) Jap I Soe of 11 Happy Avenue West,  
Singapore

(ii) Lim Kee Hock of 32 Orange Grove  
Road, Singapore

(iii) Lim Kee Chin of 32 Orange Grove  
Road, Singapore

(iv) Lim Kee Ming of 2-5 Circular Road,  
Singapore

(v) Leung Jhi Hung of 138 Waterloo  
Road, 1st floor, Kowloon, Hong  
Kong

(vi) Kenneth Yuhung Tongson of C2  
Dragon View 39 Macdonnell Road,  
Hong Kong

(vii) Sen Ho Yin of 5 May Wan Road,  
Flat c, 16th floor, Waterloo  
Road Hill, Hong Kong

(viii) Cho Man Chi of 121 Java Road,  
10th floor, Flat 1126, North  
Point, Hong Kong

20

30

In the High  
Court of  
Singapore

No.27

Defence

26th April  
1971

(continued)

(ix) Madam Huai Chu Liang of Kam Fai  
Mansion, 5th floor, "B" Block 68A,  
Macdonnell Road, Hong Kong

(x) Lim Kee Siang of 2-5 Circular Road,  
Singapore,

formed a Limited Company known as "Star Plastics  
Industrial Private Limited" and commenced the  
manufacture of tooth-brushes in Singapore under  
a trade mark in a manner identical to that  
previously used by Star Industrial Company Ltd.,  
the Plaintiffs, and which was at that time a  
colourable imitation of the trade mark and get up  
by which the Defendant's goods had become well-  
known to the trade and public in Singapore and  
the said fact is known to the Plaintiffs who are  
minority shareholders in Star Plastics  
Industrial Private Limited.

10

8. In the premises, the Plaintiffs are not the  
proprietors of the trade mark sued upon or have  
they any special rights in the get up nor have  
the Defendant passed off as and for the Plaintiffs  
goods not of the Plaintiffs' manufacture.

20

9. Further, by virtue of the fact that the  
Plaintiffs in conjunction with certain other  
parties have formed in Singapore "Star Plastics  
Industrial Private Limited" which said other  
parties have known of the use by the Defendant of  
the Trade Mark "AGE" and the get up complained of  
since the end of the year 1967 have acquiesced in  
the use by the said Defendant of the aforesaid  
Trade Mark and get up and have been guilty of  
laches in connection therewith.

30

Dated and delivered this 26th day of April,  
1971.

Sd. L.A.J. Smith

Solicitors for the Defendant.

No. 28

REPLYIn the High  
Court of  
Singapore

No.28

Reply

5th August  
1971

1. The Plaintiffs deny that at any time they ceased the manufacture and sale of toothbrushes as alleged in paragraph 1 of the Defence or that at any time they abandoned their trade and business therein in Singapore. Save that it is admitted that the Plaintiffs' trade in toothbrushes was curtailed as a result of government restrictions by way of a tariff imposed in 1965, the Plaintiffs will assert that they have preserved their reputation and goodwill in the manufacture and sale of toothbrushes got up in their distinctive manner, and that the Defendant fraudulently sought to exploit the Plaintiffs' goodwill at a time when importation of the genuine articles made by the Plaintiffs was impeded for reasons wholly beyond the control of the Plaintiffs.

2. The Plaintiffs make no admission with respect to paragraph 2 of the Defence.

3. The Plaintiffs deny every allegation contained in paragraph 3 of the Defence, which paragraph is inconsistent with the allegations contained in paragraph 7 of the Defence. In paragraph 7 of the Defence it is admitted by the Defendant that the trade mark and get up previously used by the Plaintiffs, and the trade mark and get up at present in use by the Defendant, bear such resemblance the one to the other, that one is a colourable imitation of the other. The Plaintiffs confirm the truth of the said averment, and being the originators of the trade mark and get up in question which they had used on a very substantial scale before its first use by the Defendant in or after 1967, they are on the Defendant's own admission entitled to the relief sought.

4. Paragraph 8 of the Defence is denied.

5. Save that it is admitted that persons who acted as distributors of the Defendant's goods are now associated with the Plaintiffs' associated company, the Plaintiffs deny that the facts alleged in paragraphs 4, 5 and 9 have any relevance to the Plaintiffs' cause of action, and the Plaintiffs specifically deny that they have been

In the High Court of Singapore

No.28

Reply

5th August 1971

(continued)

No.29

Order on Summons for Directions

10th January 1972

guilty of laches as alleged or at all.

Delivered this 5th day of August, 1971.

Sd. Drew & Napier

Solicitors for the Plaintiffs.

No. 29

ORDER ON SUMMONS FOR DIRECTIONS

BEFORE THE HONOURABLE THE CHIEF JUSTICE

IN CHAMBERS

Upon the application of the Plaintiffs by Summons No.2816 of 1971 and upon hearing the Solicitors for the Plaintiffs and for the Defendant and by consent IT IS ORDERED that

10

1. Originating Motion No.2 of 1971 be consolidated with this action namely Suit No.102 of 1971.

2. The Defendant within fourteen days of this Order serve on the Plaintiffs a list of documents and file an affidavit verifying such list.

3. There be inspection of documents within fourteen days of the service of the list.

4. The action be set down within thirty days of this Order, the estimated length of trial being 4 days and the number of witnesses six, and that early dates for the hearing be fixed by the Registrar after setting down.

20

5. That the parties shall be at liberty to file affidavits of evidence to be led in chief at the trial subject to a right to cross-examination.

Dated this 10th day of January, 1972.

Sd. Michael Khoo Kah Lip

DEPUTY REGISTRAR.

30

No. 30

NOTES OF EVIDENCE (JUDGES NOTES)

Coram: Choor Singh J.

In the High Court of Singapore

No.30

NOTES OF EVIDENCE

Plaintiffs' Evidence

(Judges Notes)

Monday, 19th June 1972

19th June 1972

Fergusson for the pltfs.

L.A.J. Smith for the defd.

Agreed bundle of documents read, admitted and marked A.B.

10

Fergusson opens.

Reads pleadings.

Actin for passing off goods and not for infringement of trade mark as trade mark is not registered in S'pore.

Motion for rectification of register.

Both ordered to be heard together.

Cites Kerley on Trade Marks, Cap.15, para.2.

Parker-Knoll Ltd. v. Knoll International Ltd. (1962) Patent Cases, 261.

20

Norman Kark v. Odhams Press Ltd. (1962) Patent Cases, 163.

Tuesday, 20th June 1972

Hearing resumed.

As before.

Fergusson:

Spalding v. Gamage, (1914) 2 Ch., Clerk & Lindsell on Torts, para.2231  
We are entitled to sue for passing off. Actin for infringement and action for passing off are entirely different actions. See (1971) 2 All E.R. 300.

30

Intld. C.S.

In the High  
Court of  
Singapore

No. 31

Evidence of Kenneth Tongson

Plaintiffs'  
Evidence

No.31

Kenneth  
Tongson

Examination

20th June  
1972

P.W.1 Kenneth Tongson, s/s.

I live at 39 MacDonald Road, Hongkong.

I am a director of the pltf. company and its  
development manager.

My Co. is successor in business of the Star Brush  
Manufacturing Co. Hong Kong which first adopted  
the Ace Mark in 1955 or 1956.

The get up of the packing was as in this packet  
(P.1). These toothbrushes were first exported to  
S'pore, by the Star Brush Manufacturing Co. in  
1956.

10

Pltf. Co. was incorporated in H.K. in May 1961.

I produce its Memorandum & Articles of Association  
(P.2).

The Star Brush Manufacturing Co. registered the  
Ace trade mark in H.K. in 1963.

I produce certified copy of the registration (P.3).

This mark was assigned to the pltfs. who were  
registered as proprietors on 5.11.68, as shown by  
the endorsement on Ex. P.3.

20

Pltf. Co. shipped goods to S'pore, bearing the  
Ace get up in 1961.

When pltf. Co. was incorporated in Hongkong in  
May 1961 it took over all the business of the  
Star Brush Manufacturing Co. which then ceased  
to carry on business.

Our sales to S'pore were as follows:-

1962	-	47,436 dozens	-	£86,445.54
1963				
1964				
1965		30,820 "	-	£56,321.14



Smith says he accepts these figures but he will not accept any figures for the years 1961 to 1968 and the pltfs. must prove their sales in S'pore. for those years.

In the High  
Court of  
Singapore

—  
Plaintiffs'  
Evidence

No.31

Kenneth  
Tongson  
Examination

20th June  
1972

(continued)

As a result of the imposition of a tariff in S'pore. sales slumped in 1966.

We continued to manufacture and sell to other countries around the world as well as in H.K.

10 Ace A trade mark has been advertised in this part of the world.

It has been advertised in newspapers circulating in S'pore.

It was advertised in 1966, 1967 and 1968.

I produce copies of advertisements appearing in S'pore. papers (P.4, P.5 and P.6).

In 1968 my company entered into negotiations with people in S'pore. to start a joint venture.

20 On 22.8.68 we wrote A.B.4 to Lim Teck Lee Co. Ltd. and Lim Seng Huat (Singapore) Ltd. of Singapore.

Pursuant to the terms of that letter a company called "Star Plastics Industrial Co. (Pte.) Ltd. was formed in S'pore.

I am a director of this Co. which has an issued capital of \$1,200,000.

Pltfs. hold 168,000 shares of \$1 each in this Co.

I produce a list of the shareholders of this Co. (P.7). Pltfs. supplied moulds to the S'pore Co.

30 We sent technicians and a production manager to supervise the production of toothbrushes and plastic wares.

Orders for materials are specified by our Co. from Hong Kong.

The S'pore. Co. has entered into a formal agreement with the pltfs. for the use of the Ace A trade mark.

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.31

Kenneth  
Tongson  
Examination

20th June  
1972

(continued)

The letter A.B.4 is the formal agreement.

As far as we are concerned that is sufficient.

I see A.B.3.

This is the toothbrush which was sent with that letter (P.8).

I did the translation appearing at the foot of the letter.

I first saw the letter on 26.3.68.

As a result of that letter I wrote to our S'pore. Co. asking them to make an application for the registration of our trade mark. My object was to protect our interests because a similar mark was being used by someone else in S'pore.

10

In other words to bring an action for infringement we had to be registered.

Applications for registration of our Ace get up and trade mark were filed on 3.12.69.

The delay was due to the time required for retrieving old records to support our application for registration.

20

This is a certified copy of our application (P.9).

Our trade mark has not yet been registered.

I caused a warning notice to be published in the S.T. on the 23.1.71. It is A.B.8.

Our company publishes in H.K. a catalogue showing our various products. I produce a copy (P.10).

This catalogue comes to S'pore.

P.58 shows the Ace toothbrush.

Catalogue first published in 1964.

An application for permitted use was filed on 15.12.69 by the attorney for the pltfs. and the Star Plastics Industrial Co. (Pte.) Ltd. I produce a copy of the application (P.11).

30

I produce receipt for the fee paid (P.12).

I produce copy of letter from Registry of Trade Marks (P.13).

A declaration in support of this application was filed by Mr. Leung. I produce a copy of it (P.14).

In the year 1969 Star Plastics Industrial Co. (Pte.) Ltd. manufactured and sold Red Ace toothbrushes in S'pore. 19,452 dozens. All these toothbrushes were sold in S'pore.

10 To the best of my knowledge about .5 per cent of their sales were consumed in S'pore. and the rest exported.

In the year 1970 the sales were 221,520 dozens and out of this .5 per cent were for local consumption and the rest were exported.

From March 1968 until the issue of the writ in Feb. 1971 the pl'tfs. had no intention of giving up the red A Ace trade mark and get up.

20 In the market place consumers ask for "Red A" toothbrushes. They ask for it in Chinese.

The tariff was imposed in S'pore. in Oct. 1965 and that caused our sales to drop dramatically.

The purpose of the joint venture was to derive benefit from our Red A Ace trade mark and get up in S'pore.

Apart from the arrangements existing between the pl'tfs. and the joint venture company, no other company in S'pore. is authorised to use our Red A Ace get up.

30 I have visited S'pore. from the year 1965 onwards in connection with our business.

Pl'tf. company's Red A toothbrushes were sold in S'pore. by a number of firms.

Lim Teck Lee (Pte.) Ltd. was one of them.

Lim Seng Huat (Pte.) Ltd. was another.

I have seen in S'pore. for sale the Red A toothbrushes of the pl'tfs. in 1966, 1968 and 1969.

In the High Court of Singapore

Plaintiffs' Evidence

No.31

Kenneth Tongson

Examination

20th June 1972

(continued)

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No. 31

Kenneth  
Tongson

Examination  
20th June  
1972

(continued)

There were toothbrushes of the pltfs. imported from Hongkong.

The pltfs. have not given any authority to Lim Teck Lee, Lim Seng Huat or any other of the S'pore. outlets to use or to authorise others to use the Red A Ace trade mark.

I have heard of the S'pore. General Merchandise Joint Venture Pte. Ltd.

First heard of it about two weeks ago when I was in S'pore. 10

I became aware of A.B.6 about 2 weeks ago.

A.B.6 is dated 24.9.68.

I was informed that it was a joint venture between certain merchants in S'pore.

I produce a certified copy of the certificate of incorporation (P.15).

My Co. - the pltfs. - has nothing to do with it. I have now ascertained that certain shareholders of the Star Plastics Industrial Co. (Pte.) Ltd. are connected with the S'pore. General Merchandise Joint Venture (Pte.) Ltd. 20

I produce a list of its directors as at 17. 2.71 (P.16) and as at April 1971 (P.17) and as at April 1972 (P.18).

The Registrar has objected to the registration of our Red A Ace trade mark because of the prior registration of the defd.'s trade mark "Age". It is shown at A.B.1.

Cross-  
Examination

Cross-Examination

Xxd. by Smith 30

Q. From 1956 to 1961 the mark as used by you in S'pore. was like the one shown in Ex.P.3?

A. Yes.

Q. And it is correct to say that after 1961 to 1967 or 1968 you continued to use the mark in P.3 with "Star Brush Manufacturing Co. on the mark and after the assignment it was "Star Industrial Co. Ltd."?

- A. I cannot recall the year in which we changed from Star Brush to Star Industrial Co. Ltd.
- Q. After the formation of Star Industrial Co. Ltd. you did continue to use the mark "Star Brush Manufacturing Co."?
- A. Yes.
- Q. Who is the sole proprietor of Star Brush Manufacturing Co.?
- A. J.H. Leung.
- 10 Q. He became a shareholder in Star Industrial Co. Ltd.?
- A. Yes.
- Q. Do you have a copy of the agreement between J.H. Leung and the pltf. for the sale of the business?
- A. No.
- Q. Possibly a letter of intent setting out terms?
- A. No. Nothing.
- 20 Q. I put it to you Mr. Leung who is the managing director retained personal ownership of this mark until the assignment?
- A. Yes.
- Q. I suggest that until the assignment, it was used to denote the goods of Mr. Leung and not of the pltf. Co.?
- A. I don't follow it.
- Q. The pltf. Co. expanded the business of Mr. Leung?
- A. Yes.
- 30 Q. And Mr. Leung was the owner of the mark until the assignment?
- A. Yes.
- Q. The registration is limited on the certificate?
- A. Yes.
- Q. You have no rights in the letter A as a trade mark?
- A. Yes.
- Q. And anybody could also use the letter A?
- A. Yes.

In the High Court of Singapore

Plaintiffs' Evidence

No. 31

Kenneth Tongson

Cross-Examination

20th June 1972

(continued)

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No. 31

Kenneth  
Tongson

Cross-  
Examination

20th June  
1972

(continued)

Q. This trade mark is restricted to use on goods made in H.K.?

A. Yes.

Q. It would appear that goods made in S'pore. are not entitled to enjoy the goodwill of this H.K. registered mark?

A. Yes.

Q. Let us turn to 1965 with the imposition of tariff in S'pore. the tariff was 15 cents per toothbrush?

A. Yes.

10

Q. At the selling price of 30 cents, you could not sell with profit after paying the tariff?

A. Yes.

Q. That would be same for a retailer?

A. Yes.

Q. I understand that there are figures in the year 1966. Were those sales to a H.K. party for export to S'pore?

A. Yes.

20

Q. Apart from the figures you have obtained that way, you have no evidence of sales to the public in 1965?

A. Yes.

Q. Or for that matter for any of the previous years?

A. Yes.

Q. All the figures are of sales in Hongkong?

A. Yes.

Q. In 1969 you say the sales for local consumption were .5 per cent of the figure?

A. Yes.

30

Q. Exports were mainly to Indonesia?

A. Yes. Also to Malaysia, Australia.

Q. In 1956 S'pore. was a free port?

A. Yes.

Q. Most probably such of it was for outside S'pore.?

A. Yes.

- |    |   |                                |
|----|---|--------------------------------|
|    | Q. From 1956 to 1960 you have no evidence of actual sales in S'pore.?   | In the High Court of Singapore |
|    | A. Yes.   |                                |
|    | Q. Similar consideration apply to all the figures in your affidavit?  | Plaintiffs' Evidence           |
|    | A. Yes.   | No.31                          |
|    | Q. You have applied for registration in S'pore. of sale of toothbrushes in packages bearing stripes as in this package (D.1)?   | Kenneth Tongson                |
| 10 | A. Yes.   | Cross-Examination              |
|    | Q. This is a copy of your application (D.2)?  | 20th June 1972                 |
|    | A. Yes.   | (continued)                    |
|    | Q. And this is a certificate of registration in HongKong (D.3)?   |                                |
|    | A. Yes.   |                                |
|    | Q. Mr. Leung owned a mark. Pltf. Co. developed it. That is agreed. In fact all toothbrushes sold by you in H.K. for export to S'pore. up to the year 1967 - just before the assignment - bore the mark "Star Brush Manufacturing Co." which was the sole proprietorship of Mr. Leung? |                                |
| 20 | A. Correct.   |                                |
|    | Q. It would appear Mr. Leung was prepared to sell his mark in 1968?   |                                |
|    | A. No. It was assigned but not sold.  |                                |
|    | Q. Mr. Leung is managing director and major shareholder of the pltf. Co.?   |                                |
|    | A. Yes.   |                                |
|    | Q. Have you heard of this Swan brand of H.K.(D.4)?  |                                |
| 30 | A. Yes.   |                                |
|    | Q. There are many companies in H.K. using similar type of boxes?  |                                |
|    | A. Yes.   |                                |
|    | Q. There are boxes other than yours silver coloured?  |                                |
|    | A. I can't say.   |                                |
|    | Q. Without the word "A and Ace" you would not take any action?  |                                |
|    | A. In HongKong I would.   |                                |

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No. 31

Kenneth  
Tongson

Cross-  
Examination

20th June  
1972

(continued)

- Q. Look at this Sun S (D.5)?  
A. Yes.
- Q. You would not sue?  
A. I would in H.K.
- Q. Sun S has been on the market in S'pore.  
since 1965?  
A. I don't know.
- Q. You have not seen it?  
A. I saw it in 1969.
- Q. You have not applied to strike it off the  
register? 10  
A. Yes.
- Q. Your case depends on confusion. Now, if you  
have two boxes in your hand, Sun S is clearly  
distinguishable from Ace A?  
A. Yes.
- Q. Ex. D.1 "Unica" clearly distinguishes from  
the goods of the pltf. Co.?  
A. Yes.
- Q. Star Plastics Industrial Sdn.Bhd. is a  
separate Co.? 20  
A. Yes.
- Q. The S'pore Co. owns no shares in the  
Malaysian Co.?  
A. I am not sure.
- Q. My clients have registered Ace A and Age A  
in Malaysia and you have not taken any steps  
to rectify the register?  
A. We will take steps.
- Q. Look at A.B.2. Since 1966 no one has taken  
any steps to rectify the register nor taken  
any legal proceedings? 30  
A. Yes.
- Q. When did you start manufacturing in Malaysia?  
A. Some time in the middle of 1971.
- Q. Has the Malaysian Co. any agreement with the  
pltf.s.?  
A. No.



- Q. Or with the S'pore Co.?  
A. I don't know.
- Q. Did you check the Registry to see if it was open for you to use?  
A. No.
- Q. But your solicitors checked and found our mark registered in Malaysia and yet you proceeded to use the mark?  
A. Yes.
- 10 Q. Your invoices of sales in H.K. for export to S'pore. do not show sales for West Malaysia and East Malaysia?  
A. Yes.
- Q. The use of the words Age A may be mistaken for Ace A - that is what this action is about?  
A. Yes. Correct.
- Q. As far as S'pore. is concerned, you are not knowledgable of actual sales in S'pore.?  
A. I know the mark has a reputation in S'pore.
- 20 Q. Your original affidavit and your pleadings state that the S'pore. Co. was a subsidiary of the pltfs.?  
A. It is an associate.
- Q. Look at A.B.8.?  
A. Yes.
- Q. You did not explain to the Indonesian judiciary the origin of the mark?  
A. We forwarded the H.K. Certificate to Indonesia.
- 30 Q. It was a case of who used first the Ace A?  
A. Yes.
- Q. And that is the case here now? Who used first, Ace A, the plyfs. or the defd.?  
A. Yes.
- Q. When the tariff came in, the pltfs. were no longer going to manufacture in H.K. and sell in S'pore.?  
A. Yes. We were going to do it through a S'pore. Co.

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.31

Kenneth  
Tongson

Cross-  
Examination

20th June  
1972

(continued)

In the High  
Court of  
Singapore

No.31

Kenneth  
Tongson

Re-  
examination  
20th June  
1972

Re-examination

I became aware of D.1 this morning in this court.

I have seen both pl'tfs.' brushes and the Star  
Brush Co.'s brushes for sale in S'pore.

There were many shops selling these toothbrushes.

We wanted to take action in S'pore first and then  
in Malaysia.

By me

Sgd. CHOOR SINGH

Adj'd. to 21.6.72 at 10.30 a.m.

10

No.32

Tan Kim Seng  
Examination

21st June  
1972

No. 32

Evidence of Tan Kim Seng

Wednesday, 21st June 1972

Hearing resumed. Parties and counsel as  
before.

Fergusson applies to add the Star Brush  
Manufacturing Co. as a pl'tf. under Order 15.

Smith opposes application.

I disallow application.

P.W.2 Tan Kim Seng s/s.

20

I live at 292 Telok Kurau Rd., S'pore.

I am a clerk employed by Drew & Napier.

On 2.2.71 I received instructions from Mr. Michael  
Sim to make some trap purchases.

I was asked to purchase the Age toothbrush.

I was handed a genuine Ace Toothbrush - similar  
to this one (Ex.P.1).

I went to Mei Lin St. There I went to a provision  
shop called Mei Lin Store.

I showed to the assistant in the shop the Ace toothbrush and requested to be supplied one of the same make. My conversation was in Chinese.

I asked for one toothbrush. I was supplied with one brush.

It was an Age toothbrush.

I may have bought 12 brushes. This was last year.

I think they were Age toothbrushes.

I see this packet of 12 brushes.

10 The goods I bought looked like this packet of 12 (marked P.19).

I went to four other shops and showed them the Ace toothbrush and requested them to supply me a similar brush and in each case I received an Age toothbrush.

On 25.5.72 I went to a shop in East Coast Rd. It is called Guan Moh Chan. I had an Ace toothbrush with me.

This is the brush I took with me (P.20).

20 I showed P.20 to the shop assistant and asked to be supplied with a similar toothbrush. I was supplied with an Age toothbrush. This is it (P.21). I paid 30 cents for it.

Cross-examination

Xcd. by Smith

Q. You spoke in Chinese?

A. Yes. In Hokkien.

Q. You had no knowledge if Hokkien was his language?

30 A. Yes. Most shop-keepers speak Hokkien.

Q. You may have been understood to mean that you wanted "one like this"?

A. Yes. I said that.

Q. He gave you what you wanted?

A. Yes.

In the High Court of Singapore

Plaintiffs' Evidence

No.32

Tan Kim Seng

Examination

21st June

1972

(continued)

Cross-examination

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.32

Tan Kim Seng

Cross-  
examination

21st June  
1972

(continued)

Q. You are the clerk in charge of this matter in Drew & Napier?

A. Yes.

Q. Neither you nor any solicitor wrote to the various stores informing them of what had taken place?

A. Yes.

Q. It is obviously impossible now for us to ask those people if they remember you?

A. Yes. 10

Q. Is the "Ace" in Hokkien substantially different from "Age"?

A. It depends how it is spoken.

Q. You did not use the word "Ace" at all?

A. Yes.

Q. You could pronounce "Ace" in such a manner as to be understood to mean "Age"?

A. Yes.

Q. I suggest the shops you went to are merely interested in selling the goods and not any particular brand? 20

A. Yes.

Q. Were there any toothbrushes on display?

A. I did not check.

Q. You cannot say whether they had "Ace" toothbrushes?

A. Yes.

Q. When you showed them your sample you were quite certain you were going to get an "Age" toothbrush? 30

A. Yes. I was quite certain.

Re-examination

Re-examination

I said in Hokkien "I want one toothbrush". Then I asked for the price. He said, "30 cents" and I paid 30 cents.

On Saturday 17th June I went to the Registry of Deeds and made copies of the St. Declaration of Mr. J.H. Leung and the application of the Star Industrial Co. Ltd. which I now produce. (P.22 and P.23 respectively). 40

By me  
Sgd. CHOOH SINGH.

No. 33

Evidence of Sim Tow KhanIn the High  
Court of  
SingaporePlaintiffs'  
Evidence

No.33

Sim Tow Khan

Examination

21st June  
1972

P.W.3 Sim Tow Khan, affd. in Teochew.

I live at 287D Commonwealth Crescent, S'pore.  
Block 110.I am sales manager with Sim Yeow Seng (Pte.) Ltd.  
of 31 Circular Road, S'pore.

I have been with them for about 15 years.

Sim Yeow Seng sells toothbrushes.

10 They sold toothbrushes like this one before (P.1).

We do not sell it now.

We do not sell toothbrushes at present.

We first sold toothbrushes like P.1 before the  
increase of taxes.

The brushes which we sold had a red A and number 12.

I did not notice the name of the manufacturer.

I did not pay attention to that.

We got the Red A brushes from Hongkong.

20 Before the imposition of the tariff we sold Red A  
toothbrushes for about ten years.We sold both for local consumption and export  
abroad.Each year we sold 200 to 300 gross worth six to  
seven thousand dollars.

Can't say how much of it was for local consumption.

When customers order them, they mentioned Red A  
No.12 toothbrush.

I see Ex. P.21. This is a Red A toothbrush.

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence  
No.33

Sim Tow Khan

Cross-  
examination

21st June  
1972

(continued)

Cross-examination

Xxd.

Q. Do you speak English?

A. No.

Q. Do you read English?

A. No.

Q. Your Co. is a member of Singapore General  
Merchandise Joint Venture (Pte.) Ltd.?

A. I do not know about that.

Q. Your business is mainly wholesale?

A. Yes.

10

Q. And export at that?

A. Yes.

Q. And your main market is Indonesia?

A. That is correct.

Q. Your idea of ordering these toothbrushes  
from H.K. was for export to Indonesia?

A. Both for Singapore and for Indonesia.

Q. You export to the Karimon islands?

A. Yes.

20

Q. Later your firm bought and sold "Age"  
toothbrushes?

A. No. Never.

Q. So you only sold "Ace" toothbrushes?

A. Yes.

Q. You can tell the difference between an Ace  
and Age?

A. They look alike.

Q. But you can tell the difference?

A. Yes. The middle letter is different.

30

Q. Looking at both side by side you know Age is  
not Ace?

A. Yes.

Q. The Red A is common on both?

A. Yes.

Re-examination

We sold to 20 to 30 shops in S'pore. the Red A toothbrushes from HongKong.

When the tariff came in we dropped the toothbrush business altogether. Our H.K. branch bought from the manufacturers in H.K. the manufacturers' were "Starlight".

By me

Sgd. CHOOR SINGH.

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.33

Sim Tow Khan

Re-  
examination

21st June  
1972

(continued)

10

No. 34

Evidence of Tan Kay Moh

P.W.4 Tan Kay Moh, affd. in Teochew.

I live at 31 Novena Terrace, S'pore.

Managing Director of Tan Lee Seng (Pte.) Ltd. of 21 South Bridge Road. Have been with this Co. for 20 years.

We purchased and sold toothbrushes.

We imported them from H.K.

They were similar to Ex. P.1.

20

We imported them for about 8 years until 1964.

After that we stopped importing them because of the tariff.

The tariff was imposed in 1965.

We do not purchase toothbrushes similar to this one (P.20) manufactured in S'pore.

We now sell toothbrushes similar to P.21.

I do not know the address of the manufacturers.

I purchase them from Chop Hong Hwa of Nankin St.

30

Prior to the tariff, our sales of toothbrushes were in the region of \$5,000 per year.

No.34

Tan Kay Moh  
Examination

21st June  
1972

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No. 34

Tan Kay Moh

Examination

21st June

1972

(continued)

Cross-  
examination

They were all for local consumption.

We supplied to about 20 retail shops.

Our customers ordered by mentioning Red A toothbrushes.

Before the imposition of the tariff we imported from H.K. through another shop in H.K.

Cross-examination

Xcd. by Smith

Q. Your firm is a wholesaler?

A. Yes. 10

Q. You export to Indonesia and other places?

A. Yes.

Q. Bulk of your sales are to Indonesia?

A. Yes.

Q. You sell to other merchants in S'pore. who also export to Indonesia?

A. No. The retailers sell in S'pore.

Q. Any figures of sales to retailers before 1965?

A. No.

Q. Your reference to Chop Hong Hwa is to the same shop in Hokkien St.? 20

A. Yes. You are right.

Q. You are not selling Ace toothbrushes now?

A. Yes.

Q. You are selling "Age" which you purchase from Chop Hong Hwa of Hokkien St.?

A. Yes.

Q. Are you aware that Star Plastics is manufacturing Red A Ace toothbrushes in S'pore.?

A. Yes. I am aware of that. 30

Q. That started last year?

A. Two or three years ago.

Q. All your retailers know the difference between "Ace" and "Age" toothbrushes both of which have a red A?

A. I think they do not know the difference because both look alike.



- |    |   |                                |
|----|---|--------------------------------|
|    | Q. You know the difference. You picked out "Age"?                                 | In the High Court of Singapore |
|    | A. Yes.   | —                              |
|    | Q. You were shown "Ace" manufactured in S'pore. and you said you did not sell it? | Plaintiffs' Evidence           |
|    | A. Yes.   | No. 34                         |
|    | Q. Therefore you know the difference?   | Tan Kay Moh                    |
|    | A. Yes.   | Cross-examination              |
| 10 | Q. Similarly the retailers would know the difference?                             | 21st June 1972                 |
|    | A. That I can't say.  | (continued)                    |
|    | Q. Before the tariff, Red A came from H.K.?                                       |                                |
|    | A. Yes.   |                                |
|    | Q. After the tariff Red A was made in S'pore. by different people?                |                                |
|    | A. Yes.   |                                |
|    | Q. Because the H.K. people had given up and were out of the market?               |                                |
|    | A. I do not know about that.  |                                |
| 20 | Q. Look at Sun S (D.5)?   |                                |
|    | A. Yes.   |                                |
|    | Q. You sell Sun S?  |                                |
|    | A. No.  |                                |
|    | Q. Do you know S'pore. General Merchandise Joint Venture (Pte.) Ltd.?             |                                |
|    | A. Yes.   |                                |
|    | Q. Your Co. is a shareholder of that Co.?   |                                |
|    | A. Yes.   |                                |
|    | Q. That Co. entered into agreement with the defd.?                                |                                |
|    | A. That I don't know.   |                                |
| 30 | Q. That Co. is a group of wholesalers?  |                                |
|    | A. Yes.   |                                |
|    | Q. The agreement was designed to sell "Age" toothbrushes?                         |                                |
|    | A. Yes.   |                                |
|    | Q. You are promoting the sale of Age red A toothbrushes even today?               |                                |
|    | A. Yes.   |                                |

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No. 34

Tan Kay Moh

Cross-  
examination

21st June  
1972

(continued)

Q. None of you would do that if you thought it was wrong?

A. Yes.

Q. You did it because the Red A Ace was no longer coming from H.K.?

A. Yes.

Q. And Red A Age was not Red A Ace?

A. Yes.

Q. And Age was sufficiently distinguished from the other?

A. Yes.

10

Q. In promoting your sales you refer to your retailers "Red A Age"?

A. We merely say Red A.

Q. Now, in S'pore., Red A means the goods of the defd.?

A. Star Plastics is also using Red A.

Q. That is a new Co.?

A. Yes.

Q. This new Co. is pushing its goods as if they were the defd.'s?

A. Yes.

20

Q. So this new Co. should stop using Red A?

A. Both are using Red A.

Q. There is a distinction between the two - one is Age and the other Ace?

A. Yes.

Q. You personally know the difference?

A. Yes.

Q. The goods you want are "Age" from the defd.?

A. Yes.

30

Q. When you order the goods you want Age Red A?

A. I order "Red A".

Q. You are happy as long as you get "Red A"?

A. Yes.

Q. It does not matter to you whether they are Age or Ace?

A. Yes.

Q. Both are equally popular?  
A. That is correct.

In the High Court of Singapore

Re-examination

Plaintiffs' Evidence

No.34

Star Plastics in S'pore. was established by the original manufacturers in H.K. of Red A.

Tan Kay Moh Cross-examination

Before the tariff there were no other Red A toothbrushes other than those from H.K. They were manufactured by "Starlight". Mr. Sheng was their sales manager.

21st June 1972

10 Don't know name of his "Boss".

(continued)

Our customers order goods by mentioning "Red A" toothbrushes.

Re-examination

Per curiam:

Q. Do you read English? By me  
A. No.

CHOOH SINGH

No. 35

No.35

Evidence of Chng Peng Soon

Cheng Peng Soon

P.W.5 Chng Peng Soon, affd. in Teochew.

Examination

I live at 60 Tiverton Lane, S.9.

21st June 1972

20 Sundry Dept. Manager of Lim Teck Lee of 2-5 Circular Rd. S'pore. Have been with them for 38 years.

I have sold Red A toothbrushes.

I first sold this Red A (Ex.P.3). It has "Red A" on it.

I have picked out P.3 because it has Red A.

They all have Red A on them and so I simply picked up P.3.

Have sold Red A for about ten years.

30 Our Co. first imported them in the 1950s.

In the High Court of Singapore

Plaintiffs' Evidence

No.35

Chng Peng Soon

Examination

21st June 1972

(continued)

They were made in H.K. by "Starlight" whose proprietor was Leung Chee Hong.

Our annual sales were \$3,000 to \$5,000 a year - about 200 gross toothbrushes a year.

We sold for local consumption to the retailers.

A tariff was imposed in 1965 or 1966. That stopped us from importing from H.K.

At present we sell this type (P.20) of toothbrushes which are made in S'pore. by "Starlight" in which we have shares.

10

I see Ex. P.20. It is made by "Star Plastics Industrial Co. (Pte.) Ltd. We have been selling it from 1970.

I see Ex. P.21. We have sold this type before.

Comparing P.20 and P.21, the only difference is the middle letter in Ace.

We sold P.21 in 1968. We stopped selling P.21 ever since Star Plastics started making Red A.

When we sold P.21 I did not know if it had any connection with the HongKong Co.

20

Our customers ask for Red A.

When they ask for Red A we supply Red toothbrushes.

Before the tariff we supplied toothbrushes received from H.K.

After the tariff we supplied toothbrushes made in S'pore. by the New Star Co.

(Identifies P.21 as produce of New Star).

Now if someone asks for Red Star I supply the toothbrushes made by Star Plastics Co.

We did not inform H.K. that we were selling Red A Age toothbrushes.

30

Cross-examinationXxd. by Smith

Q. Have a look at A.B.6?

A. Yes.

Q. Your firm is one of the shareholders of that Co.

A. Yes.

Q. You are a director of this Co. - Singapore General Merchandise Joint Venture (Pte.) Ltd.?

10 A. I am manager.

Q. That Agreement - A.B.6 - bears your signature?

A. Yes.

Q. This Co. agreed to buy No.12 Red A Age toothbrush?

A. Yes.

Q. Which was on the market at that time in a small way?

A. Yes.

Q. And sold in this pack (P.21)?

20 A. Yes.

Q. Would you say that that pack is different from P.20?

A. I recognise only the Red A.

Q. You knew defd. was selling Red A Age?

A. Yes.

Q. That was defd.'s mark and you considered it all right?

A. We expressed no opinion and no objection.

Q. Are you in business to deceive innocent purchasers as to the origin of the toothbrush?

30 A. No.

Q. You knew very well that defd. had no connection with H.K.?

A. I did not know.

Q. Your Co. is a shareholder of Star Plastics Industrial Co. (Pte.) Ltd.?

A. Yes.

In the High Court of Singapore

Plaintiffs' Evidence

No.35

Chng Peng Sock

Cross-examination

21st June 1972

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.35

Chng Peng  
Soon

Cross-  
examination

21st June  
1972

(continued)

Q. And your Co. has entered into an agreement with Star Industrial of H.K. to manufacture Red A Ace toothbrush previously manufactured by Star Industrial Co. of H.K.?

A. No.

Q. Now, look at A.B.4?

A. Yes.

Q. That is a letter to your Co.?

A. I do not know about this letter. It did not come to me. I am only an employee.

10

Q. You negotiated A.B.6?

A. No. I signed it.

Q. All your directors knew about this agreement?

A. Yes. Other directors of General Merchandise Joint Venture (Pte.) Ltd. knew about it.

Q. And also the shareholders?

A. Some of them did.

Q. Your Co. is still selling Red A Age?

A. No. We are now selling the product of Star Plastics.

20

Q. You stopped buying a year ago?

A. Long ago.

Q. The reason is that you wanted to promote Red A Ace?

A. We recognise Red A only and we sell Red A.

Q. Red S Sun has nothing to do with H.K.?

A. I do not know.

Q. If you had the slightest suspicion that there was anything wrong with Red A Age or Red S Sun, you would not have done business in them? You would not have signed A.B.6?

30

A. I do not know whether it was right or wrong.

Q. You saw Red A Age and Red S Sun before you signed A.B.6?

A. Yes.

Q. The H.K. Co. had been out of business for 4 years?

A. I do not know.

Q. During 1965, 1966, 1967 and 1968 you did not import Red A Ace from H.K.?

A. That is correct.

Q. And you knew when you signed A.B.6 that Red A Age and Red S Sun came from the defd.?

A. Yes.

In the High Court of Singapore

Plaintiffs' Evidence

No.35

Chng Peng Soon

Cross-examination

21st June 1972

(continued)

Re-examination

Re-examination

I do not read English.

10 I signed A.B.6 on 24.9.68. But our Co. - General Merchandise Joint Venture (Pte.) Ltd. was incorporated in Dec. 1969.

In Sept. 1968 I signed on behalf of "S'pore. Miscellaneous Goods Joint Centre Group" which was in Dec. 1968 incorporated as "General Merchandise Joint Venture Co. (Pte.) Ltd."

When I signed in Sept. 1968 on A.B.6 I had nothing to do with the H.K. Co. or Mr. Leung.

20 Defd. manufactured the two kinds of toothbrushes mentioned in A.B.6 and he asked us to help him sell his goods.

We ceased sales of his goods at the beginning of 1969.

The agreement was good for only a few months - from Sept. 1968 to beginning of 1969.

Since the imposition of the tariff we have not sold any toothbrushes from H.K.

By me

Sgd. CHOOR SINGH.

In the High  
Court of  
Singapore

No. 36

Evidence of Yeow Yang Boon

No. 36  
Yeow Yang Boon  
Examination  
21st June  
1972

P.W.6 Yeow Yang Boon, affd. in Teochew.

I live at 322-F, Block 109, Toa Payoh, S'pore.12.

Assistant Manager of Lim Seng Huat (Pte.) Ltd. of  
12/13 Circular Road, S'pore.

Have been with them for about 25 years.

I have sold toothbrushes. (Picks out P.20).

I sold such toothbrushes more than ten years ago.

We bought them from H.K. from "Starlight" which  
was owned by Leung Jhi Hung. 10

We imported about \$10,000 worth of toothbrushes  
annually.

That would be about 5,000 dozen. Most of them  
were sold in S'pore. A small portion were  
exported elsewhere.

We supplied about 40 to 50 retailers in S'pore.

Tariff was imposed on toothbrushes in S'pore.

As a result we stopped importing from H.K.

I produce a Customs declaration form together  
with a bill from our branch in H.K. showing  
importation of toothbrushes together with some  
other goods. 20

The bill mentions "A12" toothbrushes.

It refers to Ex. P.20.

The quantity mentioned is one hundred gross  
(Ex.P.24).

I also produce Invoice of 20.2.65 covering a wide  
range of goods. It includes "A.12" toothbrushes.  
The quantity is 80 gross. 30

The Custom declaration has been mislaid and cannot  
be found (marked Ex.P.25).



My customers ask for Red A toothbrushes.

After the tariff was imposed we did not import from H.K.

We sold locally made Red A toothbrushes.

We bought them from General Merchandise (Pte.) Ltd.

They were similar to P.20 (Red A Ace).

I see Ex. P.21.

I do not remember definitely whether we sold any similar to P.21.

10

(Witness asked to compare P.20 and P.21)

They are both the same. They bear the Red A symbol.

We started selling S'pore. made Red A Ace toothbrushes about 3 years ago. We sold several thousand dozens each year.

They were sold for the retail market.

We have 40 to 50 retailers.

Cross-examination

Xxd. by Smith

20

Q. Have a look at the defd.?

A. Yes.

Q. You know him personally?

A. Yes.

Q. You placed orders with him for his Red A Age?

A. Yes. A little quantity at the beginning.

Q. And more later?

A. No. Not much.

Q. Red A Age has nothing to do with Red A Ace?

A. I do not know about that.

30

Q. Your Co. is one of the shareholders of a local Co. manufacturing Red A Ace?

A. Yes.

In the High  
Court of  
Singapore

No.36

Yow Yang Boon

Examination

21st June  
1972

(continued)

Cross-  
examination

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.36

Yeow Yang Boon

Examination

21st June  
1972

(continued)

- Q. Your Co. wrote to P.W.1 and told him that there was in S'pore. a Red A Age?  
A. I don't know. May be one of the directors did.
- Q. You have been sent here as a substitute for the directors?  
A. Yes.
- Q. Look at A.B.3? Read it?  
A. Yes.
- Q. You produced the toothbrush to the directors of your Co.? 10  
A. I did not say anything.
- Q. Did you produce the packet to your director?  
A. No.
- Q. After that letter your Co. sold my client goods as genuine?  
A. Our customers like to buy Red A. We had had these Red A and so we sold them.
- Q. Your customers thought they were getting the H.K. Red A? 20  
A. Yes.
- Q. You were a party to the passing off?  
A. No answer.
- Q. When you sold the Age mark your customers knew they were getting a different toothbrush?  
A. No. They did not know the difference at the beginning.
- Q. Did they know later?  
A. They only read the name of the manufacturers and know it was made in Singapore. 30
- Q. And they knew it was a different toothbrush from the H.K. one?  
A. Yes.
- Q. And they did not care about the Age A, the Ace A or the Red A?  
A. Yes.
- Q. They looked at the name of the manufacturer?  
A. Yes.

Q. The Pltfs. have not asked any of your whole-  
salers to stop selling "Age" toothbrushes  
before the manufacture of the Red A Ace in  
S'pore.?

A. I do not know.

Q. If he had you would have stopped selling "Age"?

A. That is so.

Q. Your Co. is a shareholder or General Merchan-  
dise Joint Venture (Pte.) Ltd.?

10 A. Yes.

Q. Your Co. is also a shareholder of Star Plastics  
Industrial Co. (Pte.) Ltd.?

A. Yes.

Q. Can you remember if the old Red A Ace had the  
name of the Co. on the side of the box?

A. I do not remember.

Q. Could it be Star Brush Manufacturing Co.?

A. I do not remember.

Re-examination

20 Our Co. did sell Red A Age toothbrushes some time  
in 1968 but for a very short period. A very small  
quantity was sold. We stopped because of the  
product of the Star Plastics Industrial Co. (Pte.)  
Ltd. came on the market.

Prior to the tariff the Red A Ace was manufactured  
by Leung Jhi Hung. I associated them with Leung.

Now they are manufactured by the new Co. In S'pore.-  
Star Plastics Industrial Co. (Pte.) Ltd.

By me

30

Sgd. CHOR SINGH

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.36

Yeow Yang Soon

Cross-  
examination

21st June  
1972

(continued)

Re-  
examination

In the High  
Court of  
Singapore

No. 37

Evidence of Kenneth Tongson

Plaintiffs'  
Evidence

P.W.1 Kenneth Tongson, on former oath, recalled  
by Fergusson.

No.37

Kenneth  
Tongson  
(Recalled)

In para. 7 of my affidavit I gave particulars of  
expenditure on advertising by my Co. and its  
predecessors.

Examination

These figures are exclusively for S'pore. They  
were prepared by my accountant.

21st June  
1972

These figures are exclusively for toothbrush  
advertisements. 10

I produce a cutting from the Nanyang Siang Pau of  
18.3.61 - (P.26).

Cross-  
examination

Cross-examination

Xxd. by Smith

Q. In support of the figures given in your  
affidavit you have produced to your solicitors  
a great number of advertisements and invoices  
relating to the "A" mark. They do not relate  
to toothbrushes. 20

A. I can't produce now.

Q. Look at this advert (P.27). Is this the way  
your brush was got up in 1957?

A. Yes.

Q. This one is in 1960 (P.28)?

A. Yes.

Q. The re-designed pack came into existence when?

A. We had both at the same time.

Q. In 1957 you were selling the other pack?

A. Possible.

Q. You do have in 1960 on your pack "Star Brush  
Manufacturing Co."?

A. Yes.

By me

Sgd. CHOOR SINGH

- Adj. to a date to be fixed by the Registrar -

No. 38

Evidence of Leung Jhi HungMonday 2nd October 1972

Hearing resumed.

As before.

P.W.7 Leung Jhi Hung, s/s in Cantonese.

I live at 130-A Waterloo Rd., Kowloon, H.K.

I am Chairman, managing director and manager of the pltf. Co.

10 I am also a director of Star Plastics Industrial (Pte.) Ltd.

In early 1948 I took up residence in H.K. from China.

In 1949 I started brush making in H.K. I formed the Star Brush Manufacturing Co. I manufactured toothbrushes and household brushes. My business was registered in H.K. in 1952. This is certified copy of my business registration particulars. (Ex.P.28).

20 Up till 1952 we were manufacturing:

1. Star Brand tooth-brush
2. Flying Horse brand tooth-brush.

In 1952 I formed the intention to introduce a new tooth-brush in the market - a better class tooth-brush.

30 After prolonged discussion I decided to use "ACE" as a trade mark - A in a ring with red background. A was selected because it is the first alphabet and Ace stood for first class quality. A always represents the best quality. Ace is the highest card of all in playing cards.

I see Ex. P.3. It was similar to Ex. P.1 except that the name on it was "The Star Brush Manufacturing Co."

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.38

Leung Jhi  
Hung

Examination

2nd October  
1972

In the High  
Court of  
Singapore  
—  
Plaintiffs'  
Evidence

No.38

Leung Jhi  
Hung

Examination

2nd October  
1972

(continued)

I sold tooth-brushes in packages similar to Ex.P.1.

When I designed this package, I collected tooth-brush packages available and the one I designed was entirely different from all of them.

I started making sales of this tooth-brush to Singapore in Jan. 1952 or 1953. My sales records for 1952 and 1953 are not available now. My sales of this tooth-brush in Singapore in 1953 was 1,500 gross according to my recollection. This amount was all for retail sale in Singapore and not for re-export. In 1954 the sales were between 1,500 and 2,000 gross.

10

In 1953 there was an article published in a Chinese newspaper in H.K. about the sale of my tooth-brush. I produce a certified copy and its translation.

(Admitted as Smith does not object and marked P.29 and translation P.29A.)

My customers ordered my tooth-brushes by calling them "Red A No.12" or "Red A No.3".

20

My Singapore distributors referred to them as "Red A" tooth-brushes or "A Mark" tooth-brushes. Some called them "No.12A" tooth-brushes.

In 1957 I decided to diversify and expand into other lines - household plastic ware. I selected the "Red A" trade mark. I did this business under the name of Star Industrial Co. and I continued making tooth-brushes under the name of Star Tooth Brush Manufacturing Co.

In 1961 I incorporated the Star Industrial Company Ltd. - the pltf. Co. I am the principal shareholder in the pltf. Co. It was my intention that the pltf. Co. should take over the Star Industrial Co. and the Star Brush Manufacturing Co. from 1.1.62. The take over was consummated at a later date - on 15th March 1962. I ceased to trade as the Star Brush Manufacturing Co. on 31.3.62. And from that time the business of "Red A" tooth-brushes was carried on by the pltf. Co. I did not make any formal assignment of the goodwill in the business of Red A Ace tooth-brushes. I had applied for trade mark registration in my

30

40

own name in 1961. Ultimately I assigned the trade mark to the pltf. Co. in 1968. I received no consideration. I assigned it gratis because I was the major shareholder of the pltf. Co. which is a family concern. My wife and sister are shareholders.

Since Jan. 1964 the Red A tooth-brush has carried the name of the pltf. Co.

10 Between Jan. 1962 and Jan. 1964 the tooth-brush carried the name of the Star Tooth Brush Manufacturing Co. because we used the old packages belonging to the Star Tooth Brush Manufacturing Co. of which we had a large stock.

Between 1962 and 1964 the sale price of these tooth brushes was received by the pltf. Co. which paid the workers.

From 1962 onwards the pltf. Co. sold in Singapore 250 gross per month. These were for retail sales in Singapore.

20 In 1965 a tariff was imposed in Singapore. Our sales went down. A small quantity was still exported to Singapore. There were reduced sales in 1966 and 1967.

Because of the tariff I formed a joint venture in Singapore called Star Plastics Industrial Co. (Pte.) Ltd.

I sent A.B. 4 to Messrs. Lim Teck Lee Co. Ltd. of Singapore.

30 Members of my family and I hold 50 per cent of the shares of this new Co.

The pltf. Co. supplied moulds for the manufacture of tooth brushes. The pltf. Co. supplied technical assistance.

We sent many technicians and a factory manager to Singapore.

The H.K. Co. had the right to control the quality of the manufacture. The raw materials were sent from H.K.

In the High Court of Singapore

Plaintiffs' Evidence

No. 38

Leung Jhi Hung

Examination

2nd October 1972

(continued)

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.38

Leung Jhi  
Hung

Examination

2nd October  
1972

(continued)

The packages were sent from H.K. at the beginning but later they were manufactured in Singapore using the H.K. design.

From 1965 to 1968 our world wide sale of H.K. tooth-brushes was about 30,000 gross.

The Singapore Co. - Star Plastics Industrial Co. (Pte.) Ltd. started sales of tooth-brushes in Sept.1969 - Red A tooth-brushes.

I see A.B.3. I received it. At once I instructed my solicitors to take legal proceedings. Proceedings were commenced in 1971. The pltfs. applied for registration of our trade mark in Singapore and Malaysia. There was some delay in the registration. It was when our trade mark was registered that we commenced proceedings. In the course of the prosecution of the registration of our trade mark, I learnt that the defd. was the proprietor of the trade mark "AGE" in Class 21 in respect of tooth brushes. In O.S. 2/71 I applied for rectification of the Register as a person aggrieved by that registration. 10 20

From 1965 onwards so far as the pltf. Co. is concerned I had no intention to abandon the trade mark Red A ACE tooth-brushes in Singapore.

In the Chinese language, the pltf. Co. is referred to in H.K. as "Seng Kong Sat Yip" (Star Light Realty or Star Light Industrial).

In Chinese we never use a single word, therefore Star Light.

Cross-  
examination

Cross-examination

Q. Starlight Plastics is a well-known Australian firm? 30

A. I don't know.

Q. That Australian company sells goods in H.K.?

A. I don't know.

Q. "A" is a quality mark?

A. Yes.

Q. In your H.K. registration you disclaimed the exclusive use of the letter "A"?

A. Yes.



- |    |   |                                |
|----|---|--------------------------------|
|    | Q. Have a look at your Singapore application - (P.9)?   | In the High Court of Singapore |
|    | A. Yes.   |                                |
|    | Q. You will see that the name of the Co. in the mark is "Star Brush Manufacturing Co." and the application is by the pltf. Co.?                                       | Plaintiffs' Evidence           |
|    | A. Yes.   | No.38                          |
|    | Q. Can you explain that ?   | Leung Jhi Hung                 |
|    | A. It is a mistake.   | Cross-examination              |
| 10 | Q. You were aware of my client's use of their mark - AGE - in 1968 and in fact the only action taken by you was to file an application for registration in Dec. 1969? | 2nd October 1972               |
|    | A. Yes .  | (continued)                    |
|    | Q. Not one letter was written to my clients for 21 months although Lim Seng Huat is in Singapore?   |                                |
|    | A. We took the precaution to apply for registration.  |                                |
| 20 | Q. But for 21 months you allowed my clients to sell goods under their trade mark?   |                                |
|    | A. Yes.   |                                |
|    | Q. It was not until 2.2.71 that you wrote a letter through Drew & Napier objecting to my clients using this trade mark?   |                                |
|    | A. Yes.   |                                |
|    | Q. And then only because the Registrar took the view that the registered mark "AGE" was likely to be infringed by your trade mark?                                    |                                |
|    | A. Yes.   |                                |
| 30 | Q. You were then fully aware of my client's trademark?  |                                |
|    | A. Yes.   |                                |
|    | Q. The whole tenor of A.B.9 deals with the marks "ACE" and "AGE"?   |                                |
|    | A. Yes.   |                                |
|    | Q. At A.B.11 you have my answer?  |                                |
|    | A. Yes.   |                                |
|    | Q. My clients had no objection to your "ACE" mark?  |                                |
|    | A. Yes.   |                                |
|    | Q. You could have instituted legal proceedings as far back as 1968 if there was any real confusion?   |                                |

In the High.  
Court of  
Singapore

Plaintiffs'  
Evidence

No.38

Leung Jhi  
Hung

Cross-  
examination

2nd October  
1972

(continued)

- A. We could not institute legal proceedings before registering our trade mark.
- Q. You did not check the register in 1968?
- A. Yes. We did.
- Q. And you found our mark was registered?
- A. Yes.
- Q. You found you had no chance of stopping its use?
- A. We must first apply for registration.
- Q. You could not stop its use by legal process? 10
- A. Why not?
- Q. It was being used in the manner you are complaining of today?
- A. Yes.
- Q. Like this (Ex. P.21)?
- A. Yes.
- Q. The point is in March 1968 there was a tariff barrier since the end of 1965?
- A. Yes.
- Q. Which made the export of tooth-brushes from H.K. to Singapore impracticable? 20
- A. Not entirely impracticable.
- Q. It was of no commercial interest to import tooth-brushes from H.K. for sale in Singapore?
- A. Yes.
- Q. In 1969 you were interested in this mark because of a new Singapore company which was likely to emerge?
- A. In my mark?
- Q. Your mark? 30
- A. I have always been interested in my mark for the last 20 years.
- Q. When was your Co. formed in Singapore?
- A. 1969.
- Q. That was when your mark became of interest and you applied for registration?
- A. Yes.

Q. This type of packing has been used by people before you? In Shanghai?

A. No. It had a straight window.

Q. Was it silver or gold?

A. It had several colours.

Q. Did it have a red circle?

A. No.

Q. I put it to you, that this type of packing was started by China products?

A. They had a straight line.

Q. You have no particular property in a diagonal line?

A. They all go together. The whole design must be looked at.

Q. Now look at Ex. D.1?

A. Yes. We discussed it a few months ago.

Q. And you have done nothing about it?

A. We will take action.

Q. Why?

A. It looks so similar.

Q. Look at Ex. D.3?

A. Yes. We will take action.

Q. It has been on the market before the AGE mark and you have not written a single letter?

A. I did not know about it.

Q. What confusion would there be between Sun and your mark?

A. It might be confused - the colour and design of the package was quite easily confused.

Q. Since you started these proceedings you have made further enquiries?

A. Yes.

Q. And found that my clients have registered ACE in Malaysia and also "A"?

A. Yes.

Q. And that registration took place in 1965?

A. Yes.

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.38

Leung Jhi  
Hung

Cross-  
examination

2nd October  
1972

(continued)

10

20

30

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No. 38

Leung Jhi  
Hung

Cross-  
examination

2nd October  
1972

(continued)

- Q. And my clients have been using these marks in Malaysia?  
A. Yes.
- Q. What action have you taken?  
A. We have written letters.
- Q. When?  
A. At same time as in Singapore.
- Q. My clients have received no letters re. this Malaysian registration?  
A. Yes. 10
- Q. In fact by A.B.71 they accuse you of infringing their mark?  
A. Yes.
- Q. And you did not reply?  
A. Yes.
- Q. Look at this pack (Ex.D.6)?  
A. Yes.
- Q. This pack has been on sale in West Malaysia?  
A. Yes.
- Q. That pack has been on sale for many years?  
A. Yes. Three years. 20
- Q. Apart from Drew & Napier's clerk, you have no evidence of confusion at all?  
A. That is so.
- Q. You have heard of this "General Merchandise Joint Venture Co."?  
A. Yes.
- Q. It is a company of large wholesalers?  
A. Yes.
- Q. The Star Plastics Industrial Co. (Pte.) Ltd. will be doing business with them or through them?  
A. We have trading connections. 30
- Q. That Co. was selling in Singapore AGE tooth-brushes?  
A. I do not know.
- Q. Look at A.B.7.  
A. Yes.

Q. You have seen this Agreement before?

A. No.

Q. It is dated 24.9.68?

A. Yes.

Q. But see A.B.3? On 25.3.68 Lim Seng Huat wrote to you?

A. Yes.

Q. You never answered that?

A. Yes.

10 Q. You were no longer interested in manufacturing in H.K. and exporting to Singapore?

A. I don't agree.

Q. You have no idea at all what was sold in Singapore - your figures?

A. I know

Q. Actual re-sale figures in Singapore? There is no evidence of actual sales in Singapore? Sales to the Singapore public?

A. We do not know that.

20 Q. You are asking the court to infer from the figures you have given?

A. (No answer).

Re-examination

The Swan pack when it first came out was in silver.

We wrote to them objecting to their colour. They then changed the colour to gold.

I first heard of the joint venture company in the beginning of 1968 when I came to Singapore. I did not give them licence or permission to use Red A AGE mark.

30

I came to know that they were selling defds.' AGE tooth-brush soon after the Star Plastics Co. was formed in 1969.

Sales in Singapore averaged 250 gross per month. I got this figure from several wholesalers. We enjoy 10 to 11 per cent of the market. Our sales manager paid regular visits to Singapore. He has paid three visits to Singapore during that period.

In the High  
Court of  
Singapore

Plaintiffs'  
Evidence

No.38

Leung Jhi  
Hung

Cross-  
examination

2nd October  
1972

(continued)

Re-  
examination

In the High  
Court of  
Singapore

Star Plastics Industrial Co. (Pte.) Ltd.  
has sales of about 250 gross tooth-brushes in  
Singapore. They are also sold in Singapore.

Plaintiffs'  
Evidence

For export we supply wooden casing and deliver to  
the lighter.

No.38

Re-examination of P.W.7 by Fergusson

Leung Jhi  
Hung

From enquiries I have caused to be made, there  
are about 200 shops in Singapore selling our  
tooth-brushes.

Re-  
examination

2nd October  
1972

By me

10

(continued)

Sgd. CHOOR SINGH

Fergusson tenders Certificate from Registrar  
together with a letter.

Smith has no objection.

marked P.9A and P.9B

- Case for the pltfs. -

Defendants'  
Evidence

Defendant's Evidence

No.39

No.39

Judges  
Notes

Notes of Evidence (Judges Notes)

2nd October  
1972

Smith:

20

Sen Sen Co. v. Britten (1899) 1 Ch.692.  
You can't sue unless you have registered it.  
Action for passing off but in substance it  
is action for using trade mark. See  
section 49. They rely on sec. 53. The two  
are separate.

Halsbury's Statutes of England, vol.19,  
1st edn. para.45, 860.

Passing off is general get up of the goods.  
On the evidence so far produced and on the  
pleadings this is an action by a H.K. Co.  
They manufactured right up to 1968. Pltf.  
Co. did not manufacture the tooth-brush  
before 1968. Up to 1968 the goodwill vested  
in the sole proprietor who retained it.

30

Smith:

What was exported to Singapore was the Star Brush Manufacturing Co.'s goods. Not manufactured by the pltfs. at all.

Para.4 of S/Claim is not correct.

From 1965 to all intents and purposes the exports ceased. No evidence at all of any sales in Singapore.

Para.5 of S/Claim has not been proved.

10 Copying the mark is not necessarily passing off. They went out of business in 1965 because of the tariff business.

This is the cheap tooth-brush trade. Generally speaking there are so many of them looking alike in the market.

20 No evidence of passing off except Drew & Napier clerk whose evidence is worth nothing. He got what he asked for. They have not proved anything. Their operations were suspended. They knew of our operations. They did nothing.

They applied for registration of ACE. Only then did they think of passing off.

See their reply. How did they preserve their reputation and goodwill? There is no evidence at all.

Para.1 of Reply is complete nonsense. Not a shred of evidence.

30 They talk of fraud - not a shred of evidence of that.

No one stopped H.K. tooth-brushes coming into Singapore.

Tariffs don't impede. There was no embargo. Our trade mark registered in 1966.

They have specific knowledge of our mark in 1968 and they did nothing.

In the High Court of Singapore

Defendant's Evidence

No.39

Judges Notes

2nd October 1972

(continued)

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.39

Judges  
Notes

2nd October  
1972

(continued)

No.40

Yap Kwee Kor

Examination

2nd October  
1972

Smith:

The H.K. Co. has started a company of their own now in Singapore and they want to use the trade mark "ACE".

They allowed a Singapore Co. to manufacture and sell in Singapore.

See A.B.4. But formal agreement not produced. There is no formal agreement.

No. 40

Evidence of Yap Kwee Kor

10

D.W.1 Yap Kwee Kor, affd. in Hokkien.

I live at 68-F 4, Jalan Indra Putra, J.B.

Proprietor of a factory.

I have been manufacturing tooth-brushes since 1966.

First tooth-brush was "Red Sun" brand. Second one was Red A "AGE". First one is Ex. D.5. Second one is Ex. P.21.

This is the one the pltfs. complain about. This was the idea of Lim Teck Lee and Chong Peng Soon. Lim Seng Huat also suggested it. They suggested it in 1966 but I could not manufacture it until 1967.

20

I see this Chinese Telephone Directory for the year 1969.

On page 208 there is an advertisement for Red A AGE and Red S SUN (Ex. D.7) by my Co.

I sold these tooth-brushes in Singapore in 1967, 1968, 1969 right up to date. I am still selling them. I sold them to Lim Teck Lee, Lim Seng Huat and all other substantial wholesalers in Singapore. They sell them in Singapore.

30

My RED and AGE tooth-brush is known in Singapore as "RED A AGE". I am familiar with Star Plastics Industrial Co. (Pte.) Ltd. Came to know it in 1970.



Their mark is known as "A. C. E."

I registered the "AGE" trade mark in 1968.

I have sold it quite openly.

In 1968 I was selling through Lim Seng Huat. I supplied him AGE toothbrushes.

I have my books showing sales of "AGE" tooth-brushes in Singapore. I can produce them tomorrow.

-Adjd to 4th Oct. 1972 at 10.30 a.m. -

Wednesday, 4th October 1972

In the High Court of Singapore

Defendant's Evidence

No.40

Yap Kwee Kor Examination

2nd October 1972

(continued)

10 Hearing resumed.

As before.

D.W.1 Yap Kwee Kor, ohfa.

I produce my books of a/cs. relating to sales in Singapore. (Ex.D.8).

Cross-examination

Cross-examination

Xxd. by Fergusson

Q. You started tooth-brush business in 1966?  
A. Yes.

20 Q. In Singapore or Malaysia?  
A. In both places.

Q. In Malaysia you trade under "Sin Fatt Trading Co."?  
A. Yes.

Q. In Singapore in 1966 you also traded under "Sin Fatt"?  
A. No. Since 1967 I traded under "New Star".

Q. In 1966?  
A. "Yap Co.".

30 Q. You registered New Star Industrial Co. on 2.6.67 with effect from 2.6.67?  
A. Yes.

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

- Q. In 1966 when you traded as Yap Co. did you produce "Red S SUN"?
- A. Yes.
- Q. And did you put your label "Yap Co."?
- A. No.
- Q. What name did you put on?
- A. New Star.
- Q. But you were trading as "Yap Co."? Why put "New Star"?
- A. I put "New Star Industrial Co." on Red SUN tooth-brushes in 1966. 10
- Q. From what date did you start selling Red SUN?
- A. On 13.12.66.
- Q. From the time you put them on sale you stamped on them "New Star Industrial Co."?
- A. I do not quite remember.
- Q. What did the invoices state?
- A. They were in the name of Yap Co.
- Q. In Malaysia, they were labelled Sin Fatt?
- A. Yes. 20
- Q. You were in charge of Sin Fatt, Yap Co. and later New Star Industrial Co.?
- A. Yes.
- Q. You arranged the printing of the labels?
- A. Yes.
- Q. Can you recall any period before 1.6.67 when tooth-brushes made by you in Singapore were labelled other than "New Star Industrial Co."?
- A. No.
- Q. Before 1.6.67 tooth-brushes made by you were marked New Star Industrial Co.?
- A. Yes. 30
- Q. You also sold prior to 1967 and indeed from Dec.1965 tooth-brushes marked "New Star Industrial Co."?
- A. No. In 1965 I did not manufacture tooth-brushes.
- Q. From Dec.1966, had you used "New Star Industrial Co." on your tooth-brushes?
- A. Yes.

- |    |   |              |
|----|---|--------------|
|    | Q. Although you were trading as Yap Co.           | In the High  |
|    | A. Yes.   | Court of     |
|    |   | Singapore    |
|    | Q. Can you tell us why you selected "New Star     | Defendant's  |
|    | Industrial Co."?                                  | Evidence     |
|    | A. It is easier to call the trading mark "New     | No.40        |
|    | Star" than "Yap Co.".                             | Yap Kwee Kor |
|    | Q. What was wrong with "Sin Fatt"? You used that  | Cross-       |
|    | in Johore?  | examination  |
|    | A. That was up to me.                             | 4th October  |
| 10 | Q. You could have used same name in both          | 1972         |
|    | territories?                                      | (continued)  |
|    | A. I decided to use that name.                    |              |
|    | Q. Where did you get the name from? Why not       |              |
|    | "Star Industrial Co."?                            |              |
|    | A. I learnt it from the newspaper. It is often    |              |
|    | advertised in the newspaper "New Star".           |              |
|    | Other companies were using the name "New          |              |
|    | Star". Besides it goes quite well with the        |              |
| 20 | Chinese words for it "Sin Seng" when used         |              |
|    | with Singapore.                                   |              |
|    | Q. When did you first start tooth-brush business? |              |
|    | A. In 1966.                                       |              |
|    | Q. "RED S SUN" was your very first venture?       |              |
|    | A. Yes.   |              |
|    | Q. Did you look at the market to see what other   |              |
|    | tooth-brushes were available?                     |              |
|    | A. Yes.   |              |
|    | Q. And did you find amongst others this one?      |              |
|    | (P.7) (Red ACE)                                   |              |
| 30 | A. No. I did not see it in Singapore in 1966.     |              |
|    | Q. Had you seen it prior to 1966?                 |              |
|    | A. No.  |              |
|    | Q. Look at Ex. D.5?                               |              |
|    | A. Yes.   |              |
|    | Q. It is your tooth-brush?                        |              |
|    | A. Yes.   |              |
|    | Q. You heard Leung's evidence?                    |              |
|    | A. Yes.   |              |

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

- Q. He told the court how he designed P.1?  
A. Yes.
- Q. Now compare P.1 and D.5?  
A. Yes.
- Q. First, boxes are of same size?  
A. Yes.
- Q. Secondly, background colour of both is silver?  
A. Yes.
- Q. Both have a circle in red at right hand edge on which a letter is printed? 10  
A. Yes.
- Q. That letter is picked out or outlined in black?  
A. Yes.
- Q. Both have a three letter word in block letters in red?  
A. Yes.
- Q. These letters are also outlined in block?  
A. Yes.
- Q. Both packs are diagonally divided, the left upper part is transparent through which the tooth-brush may be seen? 20  
A. Yes.
- Q. The marking appearing on the back of P.1 and D.5 is as follows: "Do not boil or place this tooth-brush in hot water"?  
A. Yes.
- Q. That is printed in black?  
A. Yes.
- Q. Below that printed in red is "Guaranteed"? 30  
A. Yes.
- Q. Next, beneath that on the silver background enclosed by black parenthesis, on both appear the following:  
"If this brush fails to render the services to your satisfaction, kindly return and a new one will be replaced free of charge."  
A. Yes.

- Q. On the back of D.5 in the same position as on the back of P.1 there appears a red circle with a capital letter of the alphabet?  
 A. Yes.
- Q. Also there appear the words "Tooth-brush - best nylon"? written on each side of the red circle?  
 A. Yes.
- 10 Q. Look at the end label - right hand edge - there is a letter "A" on P.1 and letter "S" on D.5?  
 A. Yes.
- Q. Look at the left hand edge, does it say "No.12"?  
 A. Yes.
- Q. Can you please tell the court how you came to design the Red S label?  
 A. I had seen other brands of tooth-brushes also packed in similar manner as my Sun tooth-brush.
- 20 Q. Do you agree, that apart from the use of the word Sun and the letter S on D.5 in place of the word ACE and the letter "A" on P.1, every single feature which appears on P.1 is duplicated on D.5?  
 A. I agree.
- Q. You told us that you had not seen P.1 in Singapore in 1966 or before that?  
 A. Yes.
- 30 Q. You also told us that you had seen other tooth-brushes similar to P.1?  
 A. Yes, the Swan brand and the Red Eagle brand.
- Q. You had never seen the Red A ACE and therefore you copied Swan and the Red Eagle?  
 A. Yes. With some slight alteration.
- Q. Why did you call your tooth-brush No.12 when it was the first one you produced?  
 A. It was a convenient number.
- 40 Q. I put it to you that the Red S Sun label was prepared by you in deliberate imitation of the Red A ACE label of the pltfs.?  
 A. No. That is not true.

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

- Q. When you did that you were aware of the Red A ACE label of Star Industrial Co. Ltd. - the pltfs. - of H.K.?
- A. No. I did not know.
- Q. I put it to you that you selected the name "New Star Industrial Co." so as to trade on the already established reputation of the Star Industrial Co. Ltd. of H.K.?
- A. No.
- Q. When did you first become aware of Star Industrial Co. Ltd. of H.K.?
- A. At the time I received the summons. 10
- Q. You had a letter before the Writ?
- A. No.
- Q. Letter dated 2.2.71?
- A. I did not.
- Q. Look at A.B.9 and 10?
- A. I did not receive this letter.
- Q. In A.B.11 your counsel wrote a reply to Drew & Napier?
- A. I don't quite remember. 20
- Q. Now look at P.21 and P.1?
- A. Yes.
- Q. P.21 was your second tooth-brush?
- A. Yes.
- Q. When did you bring it out?
- A. I do not quite remember.
- Q. In your evidence in chief you stated that you started producing it in 1967?
- A. No. In 1968. 30
- Q. The idea of producing Red A AGE was suggested by somebody else?
- A. Yes. And they gave me a sample.
- Q. Who?
- A. Lim Teck Lee - Chong Peng Soon of Lim Teck Lee.
- Q. Was the sample provided to you in the form of Ex. P.1.?
- A. Yes.

Q. When was that provided to you?  
A. End of 1967.

Q. With what instructions?  
A. To manufacture "AGE" tooth-brushes.

Q. But the label produced to you was of Red A ACE?  
A. Yes.

Q. And you copied the Red A ACE label?  
A. No. AGE was first registered in 1966.

10 Q. Apart from using "AGE" you copied the pltfs.'  
label ACE?  
A. No. I copied my Sun brand label.

Q. If you look at the long side of P.1 you see  
the name "Star Industrial Co. Ltd."?  
A. Yes.

Q. At the very least you were well aware of the  
pltf. Co. when Chong Peng Soon showed you the  
pltfs.' label?  
A. I do not know the names in English.

20 Q. Did you know in 1967 of a company in H.K.  
called Seng Kong?  
A. Yes. I heard about it.

Q. When did you first hear about Seng Kong of H.K.?  
A. At the time when Chong Peng Soon showed me  
that sample.

Q. Did you hear Chong Peng Soon give evidence in  
this court?  
A. Yes.

Q. That was the same man?  
A. Yes.

Q. It was never put to him that he suggested to  
you the production of "AGE" tooth-brushes?  
A. I don't know.

Q. You had sold AGE to Lim Teck Lee and Lim Seng  
Huat?  
A. Yes.

Q. Do you continue to do so?  
A. No.

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

- Q. They ceased purchasing your AGE at the beginning of 1969?  
A. That is correct.
- Q. When Chong produced that label to you, whose label did you take it to be?  
A. He said that since 1966 this ACE brand tooth-brush had ceased being sold in the market and he suggested that I produce "AGE" tooth-brushes.
- Q. So that at that time you knew that ACE had been selling in Singapore prior to 1966? 10  
A. I did not know. That is what Chong told me. I knew H.K. tooth-brushes had stopped coming into S'pore. because of the tariff.
- Q. Did you not consider it proper to enquire whether the H.K. owners had abandoned their trade mark?  
A. No. I did not make enquiries. In fact since 1966 there was no such tooth-brush on sale in Singapore.
- Q. But prior to 1966 there was? 20  
A. I had not seen it.
- Q. Supposing the Singapore tariff had caused the sale of Dr. West tooth-brush to cease, would it be right for you to produce Dr. West tooth-brush?  
A. I would register the trade mark and then produce it.
- Q. If you could have registered it, you would have considered it quite all right to produce it? 30  
A. Yes.
- Q. You registered AGE in 1966?  
A. Yes.
- Q. What caused you to select the word "AGE"?  
A. I thought of it myself.
- Q. I suggest to you that you selected it because it could conveniently be mistaken for "ACE"?  
A. No.
- Q. Do you agree that there is to the eye very little difference between "ACE" and "AGE"? 40  
A. At that time I had not seen ACE. But now I agree that they appear quite similar.



- |    |  |                                |
|----|--|--------------------------------|
|    | Q. The registration of your "AGE" is in ordinary block letters?  | In the High Court of Singapore |
|    | A. Yes.  |                                |
|    | Q. Why did you select a form of print which is in all respects the same as ACE?                            | Defendant's Evidence           |
|    | A. I copied "AGE" from "SUN".  | No.40                          |
|    | Q. You say that the pltfs. have unduly delayed in bringing this action?                                    | Yap Kwee Kor                   |
|    | A. Yes.  | Cross-examination              |
| 10 | Q. What would you have done if the pltfs. had written to you in June or July 1968 objecting to your "AGE"? | 4th October 1972               |
|    | A. I would have ignored it because I had already registered my trade mark.                                 | (continued)                    |
|    | Q. You are using more than your registered trade mark?   |                                |
|    | A. No. I copied AGE from SUN.  |                                |
|    | Q. You copied from the label Chong showed you?   |                                |
|    | A. No. I only changed "SUN" to "AGE".  |                                |
| 20 | Q. But Chong showed you the ACE label?   |                                |
|    | A. Yes.  |                                |
|    | Q. Did you not notice that it looked similar to your Sun?  |                                |
|    | A. Yes. The wording was different.   |                                |
|    | Q. Apart from the word "SUN", there was no other difference?   |                                |
|    | A. Yes.  |                                |
|    | Q. It did not occur to you that someone was copying your SUN?  |                                |
| 30 | A. Yes. It did occur to me but I saw that the label was imported from H.K.                                 |                                |
|    | Q. Ex. P.20 - is now being sold in Singapore?  |                                |
|    | A. Yes.  |                                |
|    | Q. Lim Teck Lee and Lim Seng Huat are selling P.20 now?  |                                |
|    | A. That I don't know.  |                                |
|    | Q. They stopped buying your AGE in 1969?   |                                |
|    | A. That is correct.  |                                |

In the High  
Court of  
Singapore

Defendant's  
Evidence

No.40

Yap Kwee Kor

Cross-  
examination

4th October  
1972

(continued)

Q. You have not taken action to sue Star Plastics Industrial Co.(Pte.) Ltd.?

A. I was about to do so when I received a summons from them.

Q. Do you in fact consider the Star Plastics Industrial Co. (Pte.) Ltd. and the pltfs. one and same organisation?

A. Their name is the same.

Q. I put it to you that you designed the Red A AGE mark in full knowledge of the rights of the pltf. in their Red A ACE?

A. I did not know but at that time there were no such tooth-brush on sale in Singapore. 10

Q. I further put it to you that you manufactured and packed your Red A AGE you knew they were bound to be purchased as Red A ACE of H.K.?

A. I did not know that.

Q. You selected "New Star Industrial Co." with the deliberate intention of trading on the reputation of the pltfs.

A. No. 20

Q. I further put it to you, that you selected and registered the trade mark AGE so that it could be used to be confused with the mark ACE of the pltfs.?

A. No.

No re-examination.

By me

Sgd. CHOOR SINGH

- Case for the defd. -

No. 41

Closing Speech of Counsel for  
the Defendant (Judges Notes)In the High  
Court of  
Singapore

No.41

Closing  
speech of  
Counsel for  
Defendant(Judges  
Notes)

Smith:

Action substantially on an unregistered trade mark.

Must be decided on S'pore. law.

Intention of the legislature.

Kerley's Law, 9th edn. p.308, para.593.

10 We have two separate sections. Sections 49 and 53 of our Act.

No injunction in respect of an unregistered trade mark. Never.

We invite the ct. to make this dictum clear in S'pore.

Each case on its own merits.

Vol.44 (1927) R.P.C.361 at 363 & 364.

Once you are registered you have a proper and statutory right.

20 See 71 (1954) R.P.C. 23.

As long as you have a st. right you can bring your action even after 20 years. When there is an action for passing off, there is the question of acquiescence.

Kerley, pg.391, para.746

Pltf. must prove:

30 they have a trade or business in S'pore. in the goods in action when they commenced the action. They ceased to have that in 1965 or 1966. It is a new Co. which intends to do business in S'pore. They must show that they have a trade or business in S'pore. which is going to be injured by the defds.

In the High  
Court of  
Singapore

          
No.41

Closing  
speech of  
Counsel for  
Defendant

(continued)

Smith:

Any trade case must depend on the facts in  
S'pore.

Is their delay explained?

No one has suggested that "AGE" is not well  
known. They admit we are well known

We do not have to prove our reputation.

Not a shred of evidence that pltf. has a  
reputation.

Did you have any reputation at all when you  
commenced these proceedings?

10

No reputation left at all after 1956.

Kerley, p.325, para.631.

para.633. Delay in a passing off action.

Pltfs. showed no interest although they knew  
very well of what was happening.

Kerley, para.756.

This action is not brought by the H.K. Co. on  
the facts.

In 1968 when the mark was assigned, there was  
no goodwill in S'pore.

20

Co. doing business in S'pore. is Star Plastics.

It is not before the ct.

Any Co. which is not doing business cannot  
bring an action to seek relief of the ct.

If anybody is doing business it is the Star  
Plastics Co.

Agreement between parties of unregistered  
mark.

Pltfs. cannot succeed without the S'pore.Co.  
which is actually doing business.

30

para.755, para.2.

Speech of Counsel for Plaintiffs in ReplyIn the High  
Court of  
Singapore

No.42

Speech of  
Counsel for  
Plaintiffs  
in Reply

Fergusson:

(1960) R.P.C.16  
 (1961) R.P.C.116  
 (1899) 1 Ch. 692  
 (1967) M.L.J.129  
 (1887) 36 Ch., 1. Lever v. Goodwin  
 (1971) 2 All E.R., 300.

10 Pltfs. and their predecessors have used ACE  
 in S'pore. until 1965.

Goodwill enjoyed up to the tariff, continued  
 and lapsed over for the benefit of the pltfs.

Goodwill was established in S'pore. by Star  
 Brush Manufacturing Co.

That business carried on until 1962 when the  
 pltfs. acquired from Leung the sole propri-  
 etorship of Star Brush certain of the assets  
 of the Star Brush.

20 Although no formal assignment of goodwill was  
 made, nevertheless in fact Mr. Leung ceased  
 to carry on business as Star Brush from  
 31.3.62 and that from that time onward the  
 Red A ACE labels were used by and for the  
 benefit of the pltfs. They made the goods,  
 they sold the goods. They got the proceeds  
 of the sale and they derived the full  
 commercial advantage from the label. And they  
 did it without facing any competition from  
 30 Leung. The conduct of the pltfs. and of Leung  
 is quite sufficient to support a de facto if  
 not a de jure assignment of goodwill from  
 Mr. Leung to the Pltfs.

It is suggested that the goodwill was  
 abandoned in 1965. But see 26 Ch.398 -  
Mousson v. Boehm.

There must be evidence of distinct intention  
 to abandon.

Our case is different from Thorneloe v. Hill  
 (1894) 1 Ch.

In the High  
Court of  
Singapore

No.42

Speech of  
Counsel for  
Plaintiffs  
in Reply

(continued)

See Bostitch case, (1963) R.P.C. 183

Laches - delay - acquiescence

But see Mousson's case.

Limitation Act - Action in tort.

Period of limitation is 6 years.

Equitable relief - defds.' lands are not  
equitably clear.

Such delay as has taken place is not such  
as to found a defence of laches.

- C. A. V. -

10

Certified true copy.  
Sgd. Koh Bee Kiat  
Private Secretary to Judge  
Court No.6  
Supreme Court, Singapore.

No.43

List of  
exhibits  
tendered and  
admitted  
2nd & 4th  
October 1972

No. 43

Exhibits tendered and admitted at the  
resumed hearing on 2nd & 4th October 1972

- |       |   |    |
|-------|---|----|
| P.28  | Declaration of Woo Po Shing, Notary Public<br>dd.19.7.72  | 20 |
| P.29  | Photostat of an advert (in Chinese) in a<br>H.K. paper    |    |
| P.29A | Translation of P.29                                       |    |
| P.9A  | Letter dd. 2.10.72 from Registrar of<br>Trade Marks       |    |
| P.9B  | Application for registration of trade mark<br>dd. 2.10.72 |    |
| D.6   | "ACE" tooth-brushes (one doz.)                            |    |
| D.7   | Page 208 of Chinese telephone directory                   |    |
| D.8   | Bundle of account books (in Chinese)                      | 30 |

No. 44

Written Submissions on behalf of the  
Plaintiffs/Applicants

In the High  
Court of  
Singapore

No.44

Written  
submissions  
on behalf of  
Plaintiffs

10 Suit No.102 of 1971 is an action for passing off by the Plaintiffs against the defendants trading as New Star Industrial Co. based on the manufacture and sale by the defendant of plastic toothbrushes packed in boxes the getup of which is described at paragraph 8 of the plaintiffs' Statement of Claim which the plaintiffs alleged is confusingly similar to tooth brushes sold by the plaintiffs and their predecessors in business the getup of the plaintiff's tooth brushes being described at paragraph 4 of the Statement of Claim. In these submissions the plaintiff's tooth brushes will be referred to as RED A ACE and the defendant's tooth brushes as RED A AGE.

2. The defendant apparently challenged the plaintiff's right to sue on the following grounds:

20 (a) that the plaintiffs are seeking to enforce rights in a trade mark which is not registered and section 49 of the Trade Marks Act Cap. 206 of Singapore provide as follows:

"49. No person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade mark".

30 (b) that the plaintiffs are not the "proprietors" of the goodwill of the getup of RED A ACE label at the date the action commenced (9th February 1971).

As to contention (a) above, section 53 of the Trade Marks Act Cap.206 reads:

"53. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof".

40 The plaintiffs' action is an action for passing off and does not rest upon the necessity for the plaintiffs' mark badge or getup to be registered. The defendants cited in support of their contention the case of Sen Sen Company v. Britten 1899 Chancery Division Vol. 1 page 692 at pages 694 and 695.

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs  
(continued)

The defendants have also referred to Halsbury's Laws Vol.19 page 860 (it is believed defendants' solicitors referred to the first or second edition of Halsbury's Laws). It is submitted that the case of Sen Sen Company v. Britten is not authority for the proposition that a trader must sue for infringement where a trade mark is involved and unless that trade mark is registered he is barred from taking action. The head note of the Sen Sen Company v. Britten case reads as follows:

10

" The use by a trader on his goods of the words "trade mark" in connection with a particular mark which he has used as a trade mark, but for which he has not obtained registration, does not necessarily imply that the trade mark is registered so as to constitute an offence under s.105 of the Patents, Designs and Trade Marks Act 1883 and apart from s.105 is not itself such a misrepresentation as to disentitle him to relief in an action to restrain the imitation of the getup of his goods".

20

In the Sen Sen case the plaintiffs had marked their product with the words "Sen Sen - Trade Mark". It was alleged that Sen Sen Company were not entitled to relief on the basis that the manner in which the mark was used implied that it was a registered trade mark and that it in fact was not so registered and therefore was disentitled to relief in equity. In the Sen Sen Company case the Court granted relief.

30

It has long been held that proceedings for both an infringement of trade mark based on a registered mark and for passing off can be sustained. It is a common defence to an action for infringement of trade mark that the mark sued upon is invalid or does not protect in respect of the actions of the defendant. It is not uncommon for an action for infringement of trade mark to fail but the action for passing off on the same facts to succeed. A recent example may be found in the Privy Council decision in Lee Kar Choo v. Lee Lian Choon 1967 1 MLJ page 129. In the action the Courts found that there was no infringement of a registered trade mark but that there was passing off on which point the plaintiff succeeded. The judgment of Sir Garfield Berwick at page 133 reads:

40



"There is no necessary inconsistency between a finding of no infringement and a finding of passing off, these findings are not so easy to reconcile where as here the court of first instance has placed its finding as to passing off on the central circumstance that the respondent has used an essential feature of the appellant's mark. It may be that if such decisions as Saville Perfumery Ltd. v. June Perfect Ltd. and Cordova & Ors. v. Vick Chemical Co. had been before him the learned trial judge might well have found infringement. However, as there was no cross appeal, their Lordships prefer not to enter upon the question whether or not the trial judge's finding of no infringement is supportable. The claim to an injunction to restrain the passing off is sufficient for the appellant's purposes and, little, if any, practical consequence could flow from the reversal of the finding of no infringement".

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs

(continued)

(b) as to the contention that the plaintiffs have no goodwill and are not entitled to sue either (i) because the reputation in the mark existed in Mr. Leung Jhi Hung trading as Star Brush Manufacturing Co. of Hong Kong or (ii) because the RED A ACE label was at the date of commencement of proceedings being used by Star Plastics Industrial Co. Pte. Ltd. a Singapore company. The plaintiffs rely on the following:

(I) Bollinger J. and Others v. Costa Brava Wine Coy. Ltd. 1960 RPC page 16 and 1961 RPC 116 as authority for the proposition that where more than one person is entitled to the reputation or "goodwill" in any label or trade name then any of the persons so entitled may sue in passing off to protect their rights. Further the evidence of Mr. Leung was that although no formal assignment of goodwill from himself to the plaintiff company was effected nevertheless he regarded that company as being his successor, the assignment of trade marks in Hong Kong when eventually it did take place (1968) was made gratis and that he Mr. Leung ceased to carry on business as Star Brush Manufacturing Company with effect from the 31st March 1962. It is clear that by ceasing to carry on his business the plaintiff company were ipso facto his successors in business. They applied the RED A ACE label to tooth brushes of their manufacture and they enjoyed all the advantages and benefits of the trade. The

In the High  
Court of  
Singapore

No.44

Written  
submissions  
on behalf of  
Plaintiffs  
(continued)

fact (as was admitted in evidence by Mr. Leung) that the name of Star Industrial Co. Ltd. do not appear on the RED A ACE label in place of Star Brush Manufacturing Co. until 1964 (as according to the evidence given by Mr. Leung old stocks of labels were being used up) does not detract from the acquisition by the plaintiff company of the goodwill formerly enjoyed by Mr. Leung trading as Star Brush Manufacturing Co. in the RED A ACE label in respect of tooth brushes.

10

II. The case of "Bostitch" Trade Mark 1963 RPC page 183 is authority for the proposition that use of the RED A ACE trade mark by Star Plastics Industrial Co. Pte. Ltd. would not be deceptive to the public and in the plaintiff's submission such use would be for the benefit of and use of the goodwill of the plaintiff company.

Evidence has been adduced to show:

(AA) that the promoters of Star Plastic Industrial Co. (Private) Limited anticipated the plaintiffs giving them the right to use the RED A ACE trade mark (and other trade marks of the plaintiffs). See the letter at pages 4 and 5 of the Agreed Bundle from the plaintiffs under the hand of Mr. Leung to Lim Teck Lee & Co. Ltd. and Lim Seng Huat & Co. (Singapore) Pte. Ltd. of Singapore. No formal agreement has been entered into between the plaintiffs and Star Plastics Industrial Co. Pte. Ltd. save that Star Plastics Industrial Private Limited have applied to be registered as permitted users of the RED A ACE trade marks applied for in Singapore by the plaintiff company as appears in plaintiffs' Exhibit P.23. The plaintiffs control the quality and methods of manufacture by the said Star Plastics Industrial Co. Pte. Ltd. and the manner in which the marks of the plaintiffs are used by the said Star Plastics Industrial Pte. Ltd. (see the evidence of Mr. Kenneth Tongson PW 1 at page 4 of the Notes of Evidence paragraph (b), and also the evidence of Mr. Leung. It is submitted that because of the control exercised by the plaintiffs over the manufacture of RED A ACE tooth brushes by Star Plastics Industrial that no deception or confusion would be caused to the public by reason of the plaintiffs permitting the use of their RED A ACE labelling by the said Star Plastics Industrial Co. Pte. Ltd. It is also submitted that by reason of the plaintiffs' control of the

20

30

40

50

method of manufacture etc. by Star Plastics Industrial Co. Pte. Ltd. and by reason of the arrangement existing between the plaintiffs and the said Star Plastic Industrial as set forth in the letter in the Agreed Bundle A.B.4 and 5 that any goodwill ensures for the benefit of the plaintiffs and not for Star Plastics Industrial Co. Pte. Ltd. independently.

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs  
(continued)

10 3. The action for passing off lies where a trader so conducts his business as to lead to the belief that his goods or business are goods or business of another. See Clark & Lindsell on Torts 13th Edition paragraphs 2227 and also see Johnston and Orr-Ewing (1882) 7 Ap. cases 219 and Spalding v. Gamages 1915 84 L.J. Chancery 449 and 32 RPC 273 and the Times Law Reports page 328. See also Lee Kar Choo v. Lee Lian Choon Supra and Kerley on Trade Marks 9th Edition Chapter 17 and particularly paragraphs 777 at pages 415 and 416.

20 In this instance as will be seen from the Exhibits of the plaintiffs' tooth brushes RED A ACE label and from the defendant's tooth brushes RED A AGE label the defendant has taken every feature of the plaintiffs' getup (and the getup of its predecessors in business) save that the letter 'C' in the word ACE has been modified to the letter 'G' although the style of printing remains the same.

30 The plaintiffs submit that they have discharged the burden of proof upon them to establish their reputation in their getup. The plaintiffs have advertised their RED A ACE tooth brushes (and also RED A household wares) as appears in Exhibits P4, P5, P6 and P26 and by the circulation of a catalogue Exhibit P10 and by reason of the sales made by the plaintiffs to merchants in Singapore and further sales made within Singapore either by the Plaintiffs their predecessors in business Mr. Leung trading as Star Brush Manufacturing Co. or Star Plastic Industrial Co. Pte. Ltd. Evidence of sales and reputation of the plaintiffs in the RED A ACE label is contained in the evidence of Sim Tow Kiang PW 3  
40 the sales manager for Sim Yeow Seng Pte. Ltd. of 31 Circular Road, Singapore who stated that the company had sold RED A brushes from Hong Kong prior to the imposition of a tariff for about ten years and sales in the region of 200 to 300 gross each year for both local consumption and export. Sim Tow Kiang also deposed that prior to the tariff his company sold

In the High  
Court of  
Singapore

No.44

Written  
submissions  
on behalf of  
Plaintiffs  
(continued)

to 20 to 30 shps in Singapore. He further stated that the Hong Kong manufacturers were "Starlight".

The evidence of Tan Kay Moh PW 4 was that tooth brushes similar to Exhibit P1 were imported by his company Tan Lee Seng Pte. Ltd. for about eight years until 1964 and that prior to the tariff which was imposed in 1965 sales of tooth brushes were in the region of \$5,000 per year (all for local Singapore consumption) and that his company supplied about 20 retail shops. This witness also deposed that the customers ordered by mentioning RED A tooth brushes. This witness also stated that Star Plastics in Singapore was established by the original manufacturers in Hong Kong of RED A ACE, that before the tariff there were no other RED A ACE tooth brushes other than those from Hong Kong which were manufactured by Starlight. He also deposed that his customers ordered by mentioning RED A tooth brushes. 10

The evidence of Chng Peng Soon PW 5 Sundry Department Manager of Lim Teck Lee also deposes to the use made by the plaintiffs of the RED A ACE label in Singapore referring to annual sales of \$3,000 to \$5,000 a year about 200 gross tooth brushes a year which was sold for local consumption to retailers and that his company had imported RED A tooth brushes from the 1950's. This witness also deposed that customers asked for RED A and are supplied with RED A tooth brushes from Hong Kong and after the imposition of the tariff they would be supplied with RED A tooth brushes made in Singapore either by New Star Co. or, after the establishment of Star Plastic Industrial Co. Pte. Ltd. made by that company. 20 30

Evidence of PW 6 Yeow Yang Boon Assistant Manager of Lim Seng Huat was to the effect that tooth brushes similar to the plaintiffs' tooth brushes have been sold by them for more than ten years and that they were purchased from Hong Kong from "Starlight" which was owned by Mr. Leung. This witness stated that annual imports were to the value of \$10,000 worth that is approximately 5,000 dozen most of which were sold in Singapore. The witness also stated "we supplied about 40 to 50 retailers in Singapore". This witness also produced documentary evidence P24 and P25 relating to the import to Singapore of A 12 tooth brushes referred to RED A ACE tooth brushes. The witness also deposed that his customers asked for RED A 40

tooth brushes. This witness also stated on being shown Exhibits P20 (RED A ACE, P21 RED A AGE) that both were the same. The witness further stated that RED A ACE tooth brushes made in Singapore had been sold by his company from some three years ago and several thousand dozen each year were sold for the retail market. There is also the evidence of Mr. Leung the official notes of which are not yet available but which was to the effect that sales of the plaintiffs and its predecessors in business tooth brushes in Singapore prior to the imposition of the tariff for the period 1953 and 1954 were approximately 1,500 gross per year for sale in Singapore and from about 1957 onwards until the imposition of the tariff in late 1965 sales in Singapore were in the region of 250 gross per month. This witness also deposed that customers asked for the tooth brushes in the Chinese language by the words RED A or on occasions "A Brand". The witness also deposed that in Chinese his company was known as Starlight Industrial Limited Co. (Seng Kwong Sat Yip Yau Han Kongs). It is submitted that on the basis of this evidence the plaintiffs have adequately shown the connection between the goods referred to by the witnesses PW 3, PW 4 and PW 5 and PW 6 and themselves. They have also adequately shown that their tooth brushes were known as RED A and enjoy substantial sales in Singapore in the domestic market. They have also shown that prior to the introduction of the Defendant's RED A AGE they were the only company producing RED A AGE tooth brushes (see evidence of PW 4).

It is submitted that even if members of the general public do not know the origin of RED ACE tooth brushes they would necessarily wish to obtain the tooth brushes of the plaintiffs. See Yorkshire Relish Case, Powell v. Birmingham Vinegar Brewery Company page 54 and see Sykes v. Sykes English Reports 107 page 834 (copy of report attached).

4. As to evidence of confusion it is submitted that the Court is entitled to assume the probability of confusion by a mere comparison of the two labels but even if the Court is not prepared to do this there is evidence of PW 2 Tan Kim Seng of Trap purchase made where in response to an order made when exhibiting one of plaintiffs' tooth brushes, goods of the defendants RED A AGE were supplied. Whether or not notice of such conduct by retailers was given to the defendants is so far as confusion

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs  
(continued)

In the High  
Court of  
Singapore

No.44

Written  
submissions  
on behalf of  
Plaintiffs

(continued)

is concerned irrelevant. There is also the evidence of PW 3 Sim Tow Kiang who on being shown Exhibit P21 (RED A AGE) stated "this is a RED A tooth brush".

The evidence of PW 4 Tan Kay Moh in cross examination who stated (page 31 paragraph (c)). "A. Our customers like to buy Red A. We had had these Red A and so we sold them.

Q. Your customers thought they were getting the H.K. Red A?

A. Yes."

10

As to comparison between the RED A ACE label and the RED A AGE of the defendants it is submitted that the Court must look at the labels as a whole and it is a matter of law whether or not knowing the plaintiffs' getup but without the plaintiffs' label being present, on seeing the defendants' getup, a member of the public would be deceived into the belief that the defendants' goods were the goods of the plaintiffs.

20

See Lever & Goodwin 36 Chancery Division page 1 and particularly the judgments of Cotton L.J. at pages 5 and 6 and the judgment of Lindley L.J. at pages 7 and 8. See also Reddaway v. Banham 1896 Ap. cases page 199 (the Camel Hair Belting case) and particularly the judgment of Lord Halsbury at page 204 "for myself, I believe the principle of law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else".

30

"How far the use of particular words, signs, or pictures does or does not come up to the proposition which I have enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact the legal consequence appears to follow" and also the judgment of Lord Herschell at pages 209 and 210 commencing at paragraph appearing at page 209.

40

5. Another defence the defendants have alleged is that the plaintiffs have abandoned their trade mark and their business in the RED A ACE tooth brushes in Singapore. The plaintiffs rely on Mouson & Co. v. Boehm 26 Chancery Division page 398

as authority for the proposition that mere non user by the plaintiffs of their trade mark though coupled with non registration does not amount to an abandonment by the plaintiffs of their getup and their business in RED A ACE tooth brushes in Singapore and further discontinuance of user (which in any event was denied by the plaintiffs see the evidence of Mr. Leung) is not evidence of abandonment. The plaintiffs submit that there is no evidence of any kind to support that they have abandoned their RED A ACE trade mark. The plaintiffs also rely on the decision on Ad-Lib Club Ltd. v. Granville 1971 2 ALL ER 300 and also Berkeley Hotel Company Limited v. Berkeley International (Mayfair) Limited and Another 1972 RPC page 237 (the judgment of Pennycuik V.C. page 241 onwards) (Copy of report attached). See also Norman Kark Publications v. Odhams Press Limited 1962 RPC page 163.

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs

(continued)

6. The Defendants rely upon laches in paragraph 9 of the defence in that from March 1968 until the commencement of proceedings in February 1971 the Plaintiffs failed to take action to restrain the defendants from selling RED A ACE tooth brushes. The plaintiffs submit that laches is an equitable relief and it is a long established maxim of the doctrine of equity that "he who comes to equity must come with clean hands". Having regard to the conduct of the defendant in adopting every salient feature of the plaintiffs' getup and RED A ACE trade mark it is submitted that the defendant cannot rely on equitable relief so as to deprive the plaintiffs of their remedy. Further the action for passing off is an action in tort and it is provided by section 6 of the Limitation Act Cap.10 that actions are required to be brought within six years from the date on which the cause of action accrued. The plaintiffs are therefore within the statutory limit for commencing proceedings as, their cause of action accrued either when the defendants first began using the RED A AGE label and getup of which the plaintiffs complain (which on the defendant's evidence appears to be in 1967) or from the time that the defendant's conduct came to the attention of the plaintiffs which on the evidence dates from the receipt by the plaintiffs of the letter from Lim Seng Huat & Co. (Singapore) Pte.Ltd. appearing at page 3 of the Agreed Bundle that is on or about the 25th March 1968. It is submitted that this is not a case for reducing the statutory period of limitation on the basis of the equitable doctrine of laches so as to deprive the plaintiffs of their legal remedies.

In the High  
Court of  
Singapore

No.44

Written  
submissions  
on behalf of  
Plaintiffs

(continued)

It is also submitted that in any event such delay as did exist is not sufficient to allow the defendant to succeed on this defence (see *Electrolux v. Electrix Ltd.* 1954 71 RPC 23 at page 34 (the judgment of Sir Raymond Evershed, M.R.) at line 11 where a delay of five or six years is described as "not very great". See also Evershed's, M.R. judgment from page 32 to page 35.

Cases where inordinate delay has founded the defence of laches include *Vine Products v. McKenzie & Co.* 1969 RPC 1 and *Cluett Peabody v. McIntyre Hogg Marsh Ltd.* 1958 RPC 335 but in the *Vine Products* case the delay was about 100 years and in the *Cluett Peabody* case (*Arrow Shirt*) a favourable reckoning of the delay was 29 years and probably extended to 42 years. It is submitted that the delay in this case between March 1968 and the commencement of proceedings is not inordinate delay and does not entitle the defendants to succeed in their contention at paragraph 9 of the Defence that the plaintiffs have been guilty of laches and that the plaintiffs have acquiesced in the use by the Defendants of the trade mark AGE and the getup complained of. The plaintiffs submit that notwithstanding the claim raised by the defendant of acquiescence and laches nevertheless they are entitled to succeed. 10 20

7. The plaintiffs admit that the defendant is the proprietor of the trade mark AGE registered in block letters in Singapore under No.39808 but the plaintiffs submit that the use which the defendant has made of his trade mark is not fair and reasonable use of his trade mark and the use made is such that may be restrained. See *Johnson v. Orr-Ewing* and also *Lee Kar Choo v. Lee Lian Choon* both cited above. 30

8. The defendant claims that he was requested to produce RED A AGE tooth brushes by one of his customers Lim Teck Lee (presumably represented by Chng Peng Soon). In his evidence the defendant also suggested that Lim Seng Huat & Co. (Singapore) Pte. Ltd. also suggested he produce RED A AGE tooth brushes. The defendant appears to argue that by reason of Lim Teck Lee & Co. Ltd. and certain shareholders of that company and Lim Seng Huat & Co. (Singapore) Pte. Ltd. and certain shareholders of that company being associated with General Merchandise Joint Venture Private Limited with 40



whom the defendant had an agreement (see Agreed Bundle pages 6 and 7) that because those same persons or persons connected with them are also shareholders in Star Plastics Industrial Pte. Ltd. therefore the conduct of Lim Teck Lee and Lim Seng Huat and General Merchandise Joint Venture Pte. Ltd. may be imputed to Star Plastics Industrial Co. Pte. Ltd. and to the plaintiffs. The plaintiffs submit that such a proposition has no foundation in law and is contrary to the doctrine of the separate legal personality of incorporated bodies as set out in Salomon v. Saloman & Co. Ltd. 1897 Appeal Cases page 22 and particularly the judgment of Lord Halsbury at page 30 line 32 to the end of the page "but short of such proof it seems to me impossible to dispute that once the company is legally incorporated it must be treated like anyother independent person with its rights and liabilities appropriate to itself, and that the motives of those who take part in the promotion of the company are absolutely irrelevant in discussing what those rights and liabilities are". The Companies Act cap. 185 of Singapore provides at section 16 subsection (v) that on and from the date of incorporation ... the company shall be a body corporate ... exercising all the functions of an incorporated company etc.

It is further submitted that the actions of various traders in procuring the defendant to produce RED A AGE tooth brushes does not affect the plaintiffs' legal rights or rights in equity. Further the allegation made by the defendant that he was requested to produce RED A AGE by Chng Peng Soon was not specifically put to Chng Peng Soon PW 5 when he gave evidence and, the tenor of the cross examination of Chng Peng Soon as appears from the Notes of Evidence was that RED A AGE tooth brushes were on the market in a small way prior to Singapore General Merchandise Joint Venture entering into the agreement with the defendant in the form appearing at page 6 of the Agreed Bundle.

9. With regard to the defendant's trade mark registered in Singapore No.39808, the plaintiffs are applicants in Originating Motion No.2 of 1971 consolidated with Suit 102 of 1971 for the rectification of the Register by striking out the said trade mark. The applicants are persons aggrieved by reason of their application in Singapore for the registration of their trade mark RED A ACE label under No.47884 being objected to by the Registrar of Trade Marks on the basis of the defendant's

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs

(continued)

In the High  
Court of  
Singapore

—  
No.44

Written  
submissions  
on behalf of  
Plaintiffs

(continued)

prior registration on the grounds of the alleged similarity between the words ACE and AGE. Unless this objection can be overcome the Plaintiffs/Applicants will not be able to obtain registration of their trade mark. A comparison of the marks AGE and ACE both by ear and (particularly) by eye shows that deception and confusion would be (and has in fact been) the result of the use of the words AGE and ACE in a competing trade.

It is also submitted that at the time of the application by the defendant for his trade mark AGE by reason of the use then being made by the Plaintiff of their mark ACE, it would have been disentitled to protection in a Court of justice and accordingly registration offended against section 15 of the Trade Marks Act Cap.206. The plaintiffs submit that the decision of the House of Lords in "BALI" trade mark 1969 RPC 472 is authority for rectification of the Register of Trade Marks by expunging the defendant's registration No. 39808.

GENERAL:

1. It is well established that whether or not a mark or 'get-up' so nearly resembles a 'registered mark' (and it is submitted also a mark or get-up which is unregistered but enjoys a reputation) as to be likely to deceive or cause confusion, is a matter for the Courts and not for individual witnesses. See the dissenting judgment of Lord Denning in Parker Knoll Limited v Knoll International Limited 1962 R.P.C. 265 at page 274 lines 11 to 21 and the cases cited. See also the same judgment for a statement on the law relating to passing-off at pages 275 line 43 to page 276 line 22.

2. The judgment of Lord Morris of Borth-y-Gest: in Parker Knoll Limited v Knoll International Limited (supra) sets out a useful set of propositions in deciding the competing rights of traders.

"In solving the problems which have arisen there has been no need to resort to any abstruse principles but rather I think to the straight forward principle that trading must not only be honest but must not even unintentionally be unfair" (page 278 lines 21 to 24)".

10

20

30

40

The propositions set forth by the noble and learned Lord then appear at pages 278 line 34 to 279 line 36.

In the High  
Court of  
Singapore

No.44

Written  
submissions  
on behalf of  
Plaintiffs  
(continued)

10 It should be noted that the Sixth proposition at page 279 line 26 - 36 states quite clearly that once it is proved that the plaintiffs name or mark has acquired "such a secondar meaning", then it is a question for the Court whether a defendant, .... is so describing his goods that there is a likelihood that a substantial section of the purchasing public will be misled into believing that his goods are the goods of the plaintiffs.

0 Reference is also made to the judgment of Lord Hodson at page 284 line 48 to the end of the page rejecting the argument that honest user of a defendants own name put a special burden on the plaintiff to discharge the burden of proof in a passing off action. By analogy to the present case, use by the defendant of the AGE trade mark would put no special burden on the Plaintiffs to discharge the burden of proof upon them.

20

See also the same judgment at page 285 line 1 to 12 as to the presence of honesty or the presence of fraud.

See also the judgment of Lord Devlin at pages 291 line 47 to page 292 line 2 and particularly:

"The court must in the end trust to its own perception into the mind of the reasonable man".

30 For further discussion on the law relating to the action for Passing Off see the judgments of the English Court of Appeal in F. Hoffmann La Roche & Company A.G. and Another v D D S A Pharmaceuticals Limited 1972 R.P.C. 1 at pages 16 to 25 and to the discussion on the authorities therein cited.

#### CONCLUSION:

40 Having regard to the evidence given both oral and in the form of exhibits and having regard to the conduct of the Defendant which, on the Defendants own pleadings substantially admits to taking the RED A ACE label of the Plaintiffs without any authority or permission (other than a wholly misconceived personal view that the Plaintiffs had

In the High Court of Singapore

No.44

Written submissions on behalf of Plaintiffs (continued)

abandoned their market in Singapore for RED A ACE toothbrushes). The Plaintiffs are entitled to the relief sought, namely an injunction in the terms of claims (a) (b) (c) and (d) of the Statement of Claim.

And further that the Court should order rectification of the Register of Trade Marks Singapore by deleting the trade mark of the Defendants/Respondent AGE No.39808 under the provisions of Section 39(1)(a) of the Trade Marks Act Cap. 206 on the grounds set forth by the Plaintiffs/Applicants in Originating Motion No.2 of 1971 which is consolidated with Suit No. 102 of 1971.

10

4th October 1972

Sd. Drew & Napier

No.45

Written submissions on behalf of Defendants

No. 45

Written Submission on behalf of Defendant

DEFENDANT'S SUBMISSIONS OF LAW AND FACTS

20

Passing-off - infringement of Trade Mark

A trade mark as such since the coming into force of the Trade Marks Ordinance in 1938 now known as The Trade Marks Act, Chapter 206, can be and is the subject of a statutory right so that any person using the trade mark or a colourable imitation of it can be restrained by an injunction and is liable under the Statute to damages for his use per se irrespective of damage to business or goodwill.

30

In our submission, this is a totally new right unknown to the law prior to the passing of the Trade Marks Ordinance now Trade Marks Act in Singapore.

By the provisions of Section 49 unless the mark is registered, no action can be maintained to prevent or recover damages for the use by another person of the mark or a colourable imitation thereof.

Section 53 deals with passing off.

40

In our submission this is an action dealing with damage to a currently operating business or one which would be operated or could be operated but for extraneous factors beyond the control of the owner of the business, not for a non-existent business. See R.J. Reuter Co. Ltd. v. Mulhens.

In the High  
Court of  
Singapore

No.45

Written  
submissions  
on behalf of  
Defendant

(continued)

The position is set out in Burberrys vs. Cording which is referred to in Kerly on Trade Marks, 9th Edition, page 391 at paragraph 746.

10 Particular reference is made to the following:

"on the one hand apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name".

This passage refers essentially to registered trade marks in which statutory rights are given in the registered words or names per se. If it refers to unregistered marks and an action for passing off, then it means the origin of goods being dealt in in such a manner that protection must be accorded to the trade in which the mark is used by the Plaintiffs.

20

The next sentence reads:

"On the other hand, no one is entitled by the use of any word or name or indeed in any other way to represent his goods as being the goods of another to that other's injury".

Further on this passage is clarified

"but the property to protect ..... is not property in the word or name but property in the trade or goodwill which will be injured by its use".

30

In our submission, at the time of the Writ in an action for passing off, it must be shown that there is a trade or goodwill by the Plaintiff in the article in question currently in existence to be protected.

I would refer to the following words:-

"It is also important for the same business to consider history, the nature of its use by the person who seeks the injunction and

In the High  
Court of  
Singapore

No.45

Written  
submissions  
on behalf of  
Defendant

(continued)

the extent to which it is or has been used  
by others."

Assuming the facts in this case to be that  
ACE and a "A" in a red circle was used in Singapore  
by Star Brush Manufacturing Co. originally.

These goods were manufactured by Star  
Industrial Co. Ltd. from 1962 to 1965 for sale in  
Singapore.

In Hong Kong, Star Brush Manufacturing Co.  
registered a label which contained restrictions  
and was only for goods made in Hong Kong and the  
exclusive right to the letter "A" was disclaimed.

10

This registered mark was with the permission  
of Star Brush Manufacturing Co. used by Star  
Industrial Co. Ltd. on goods made in Hong Kong and  
sent to Singapore.

I would refer to pages 7 and 8 of the Notes  
of Evidence.

"Q. After the formation of Star Industrial Co.  
Ltd. you did continue to use the mark "Star  
Brush Manufacturing Co.?"

20

A. Yes.

Q. Who is the sole proprietor of Star Brush  
Manufacturing Co.?

A. J.H. Leung.

Q. He became a shareholder in Star Industrial  
Co. Ltd.?

A. Yes.

Q. Do you have a copy of the agreement between  
J.H. Leung and the plaintiffs for the sale  
of the business?

30

A. No.

Q. Possibly a letter of intent setting out terms?

A. No. Nothing.

Q. I put it to you Mr. Leung who is the managing  
director retained personal ownership of this  
mark until the assignment?

A. Yes.

Q. I suggest that until the assignment, it was used to denote the goods of Mr. Leung and not of the Plaintiff Co.?

A. I don't follow it.

Q. The Plaintiff Co. expanded the business of Mr. Leung?

A. Yes.

Q. And Mr. Leung was the owner of the mark until the assignment?

A. Yes.

Q. The registration is limited on the certificate?

A. Yes.

Q. You have no rights in the letter A as a trade mark?

A. Yes.

Q. And anybody could also use the letter A?

A. Yes.

Q. This trade mark is restricted to use on goods made in H.K.?

A. Yes.

Q. It would appear that goods made in S'pore. are not entitled to enjoy the goodwill of this H.K. registered mark?

A. Yes."

The whole of this passage is important but in particular these questions and these answers:-

"Q. I put it to you Mr. Leung who is the managing director retained personal ownership of this mark until the assignment?

A. Yes.

Q. This trade mark is restricted to use on goods made in H.K.?

A. Yes.

Q. It would appear that goods made in Singapore are not entitled to enjoy the goodwill of this H.K. registered mark?

A. Yes."

The agreement between Mr. Leung (if any) - there appears to be none - and the Plaintiff Co.

In the High Court of Singapore

No.45

Written submissions on behalf of Defendant

(continued)

10

20

30

In the High Court of Singapore

No.45

Written submissions on behalf of Defendant (continued)

was that the Plaintiff Co. expanded the business but Mr. Leung kept the trade mark. The trade mark denotes the origin. The trade mark was therefore to denote Star Brush Manufacturing Co. was not manufacturing these tooth-brushes. This arrangement destroyed Mr. Leung's goodwill. See Lacteosote Ltd. v. Alburman 1927 2 Chancery 117. This case is referred to R.J. Reuter Co. Ltd. v. Ferd Mulhens 1953 2 A.E.R. page 1160 at page 1175 line H. seq. and Leather Cloth Co. v. American Leather Cloth Co. 1865 11 H.L. Cas. 523 referred to in the abovementioned case as "authority for the proposition that a purchaser of a mark becomes owner of it only if he becomes at the same time purchaser of the manufactory or the business concerned in the goods to which the mark has been affixed."

10

The passage subsequently quoted at page 1176 is similar to what happened in this case.

The Plaintiffs apparently produced the goods but Mr. Leung kept the mark. The mark therefore was incapable of being distinctive of Mr. Leung's goods "if the identity of the business is destroyed, the mark is destroyed with it."

20

I would refer to Kerly paragraph 488 page 248 and in the passage attributed to Lord Macnagthen:-

"for goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business and the goodwill perishes with it though elements remain which may perhaps be gathered up and be revived again."

30

In the further passage attributed to Lord Lindley:-

"Goodwill regarded as property has no meaning except in connection with some business, trade or calling ..... In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on ..... or in several and if in several, there may be several businesses each having a goodwill of its own."

40



The Plaintiffs rely on an assignment from Mr. Leung of a registered mark in 1968 in Hong Kong. At that time, Mr. Leung had no goodwill in Singapore in connection with the mark registered in Hong Kong to assign to Star Industrial Co. Ltd.

In the High Court of Singapore

—  
No.45

1890 7 R.P.C. paragraphs 594 to 598

Written submissions on behalf of Defendant

(continued)

10

Although these cases deal with infringement registration as a fundamental necessity requires a statement that the mark is used by the proprietor or intended to be used by the proprietor.

In this case it means the Applicant.

1968 - In our submission, if there was any trade or goodwill up to 1965, such a mark if distinctive belongs to Star Brush Manufacturing Co.

In 1968 when the mark was assigned it could only be assigned in respect of the goods made in Hong Kong and sold in Singapore by Leung.

20

At that time there was no business in Singapore by Star Brush Manufacturing Co. and as far as Singapore is concerned, the assignment was an assignment of nothing. This is a similar position now.

Neither the Plaintiffs nor the party for whom they claimed to be entitled has any business in Singapore and as a passing off action deals with misrepresentations injuring another party's business, the Plaintiffs' business is nil.

Evidence of business and goodwill

30

Page 3 of the Notes of Evidence - "As a result of the imposition of a tariff in Singapore, sales slumped in 1966. We continued to manufacture and sell to other countries around the world as well as in H.K."

Page 5 of the Notes of Evidence - "In the year 1969 Star Plastics Industrial Co. (Pte.) Ltd. manufactured and sold Red Ace tooth-brushes in Singapore."

The figures given are either .5% or 5%.

In our submission, the Plaintiffs have failed to prove or establish or given evidence sufficient

In the High  
Court of  
Singapore

—  
No.45

Written  
submissions  
on behalf of  
Defendant

(continued)

for the Plaintiffs to claim that prior to 1965 they had sold in Singapore sufficient tooth-brushes under their mark to establish any reputation in it at all. They have called no retailers and their trap orders on the usual basis are meaningless. The figures given are meaningless and the Plaintiffs' main witness admits that if they came to Singapore it was for redistribution in other countries.

See page 9 of the Notes of Evidence:-

10

"Q. In 1969 you say the sales for local consumption were .5 per cent of the figure?

A. Yes.

Q. Exports were mainly to Indonesia?

A. Yes. Also to Malaysia, Australia.

Q. In 1956 Singapore was a free port?

A. Yes.

Q. Most probably much of it was for outside Singapore?

A. Yes.

20

Q. From 1956 to 1960 you have no evidence of actual sales in Singapore?

A. Yes.

Q. Similar consideration apply to all the figures in your affidavit?

A. Yes."

There is a clear cut admission in this evidence that there are no figures of actual sales in Singapore at all.

Get up of Packs

See pages 10, 11 and 12 of the Notes of Evidence.

Page 10

Q. There are many companies in Hong Kong using similar type of boxes.

A. Yes.

Page 11

- Q. Your case depends on confusion. Now, if you have two boxes in your hand, Sun S is clearly distinguishable from Ace A?
- A. Yes.

Page 12

- Q. The use of the words Age A may be mistaken for Ace A - that is what this action is about?
- A. Yes. Correct.

10

In our submission on the evidence, the pack in silver of its type is common to the trade in Singapore.

Application for rectification

The clear cut admission of Kenneth Tongson means that application must fail. Figures have been given which it is now known as totally incorrect as to sales in Singapore.

Witness to prove reputation

20

Witness P.W.3 - Each year we sold 200 to 300 gross worth six to seven thousand dollars. Can't say how much of it was for local consumption.

P.W.3 witness admits is wholesale and export and the main market is Indonesia.

In re-examination the witness admits that when the tariff came in, they dropped the tooth-brush business altogether.

30

Witness P.W.4 - This witness in cross-examination admits he is a wholesaler mainly concerned with export in Indonesia. He could produce no figures of sales to retailers in Singapore before 1965. He also admits he is promoting the sale of the Defendant's tooth-brushes. See page 22 of the Notes of Evidence when he admits the two packs are distinct and he admits that the Singapore Co. i.e. the new Company is pushing its goods as if they were the Defendant's, and he maintains that they are distinguishable.

40

His evidence on reputation, etc. is in our submission not supporting the Plaintiffs' case.

In the High  
Court of  
Singapore

—  
No.45

Written  
submissions  
on behalf of  
Defendant

(continued)

In the High  
Court of  
Singapore

No.45

Written  
submissions  
on behalf of  
Defendant

(continued)

Witness P.W.5 - This witness admits they sell the Singapore Co.'s tooth-brushes and that the Hong Kong Co. stopped in 1965. He also admits no imports from Hong Kong in 1965, 1966, 1967 and 1968.

Witness P.W.6 - "Customers in Singapore clearly know the difference between the Hong Kong tooth-brush and the Singapore tooth-brush."

This evidence called by the Plaintiff clearly establishes that the Defendant Co.'s tooth-brush is known in Singapore and is made by different people.

10

The following passage is referred to:-

"A. They only read the name of the manufacturers and know it was made in Singapore.

Q. And they knew it was a different tooth-brush from the H.K. one?

A. Yes.

Q. And they did not care about the Age A, the Ace A or the Red A?

A. Yes."

20

This witness establishes that the only business in Singapore other than the Defendant's is the Singapore Co. not the Hong Kong Co.

Summary of position re business in Singapore

We would refer to R.J. Reuter Co. Ltd. v. Mulhens 1953 R.P.C. Vol. 70 page 235.

The particular passages to which reference is called are page 251 commencing from line 20 to the bottom of the page.

30

From this we wish to call particular reference to lines 40, 41 in which it is said that a trade mark is "distinctive of the origin of goods."

Also at page 253 lines 15, 16, 17 in particular "And plainly, if the Defendant be unable to prove the requisite association of the marks with his business, any passing-off action on his part must fail."

Applying to these goods the Plaintiffs have to show that at the date of the Writ or the date of the trial the mark Ace A means in Singapore goods made in Hong Kong and exported to Singapore.

In the High Court of Singapore

No.45

Written submissions on behalf of Defendant (continued)

There has been no such business since 1965.

The Plaintiffs do not intend either at the date of the Writ or today to make tooth-brushes in Hong Kong and send to Singapore.

Particular reference from line 19 to line 53.

10 In this connection we would stress that there were witnesses and the Judge accepted that German made 4711 could be confused with English made 4711 but says as follows:-

20 "Still I do not think the Defendant is entitled to succeed in his claim for passing off. He is conducting in England no business selling here no goods. As it seems to me, he has not in this country any proprietary right which he is entitled to protect. Proof of the facts, as I have assumed them, does not create or give him such a right."

At line 36 the right is discussed.

30 The Hong Kong Co. would have to show they have the sole or single use and continues at line 44 "Nevertheless, I cannot think that, at any rate in the absence of some very special circumstances, a person who is not trading in this country and has in this country no proprietary interest in a name or mark can be said to have the exclusive right ....."

Further, "The question, and the only question, with which we are concerned is whether the Defendant in this country has any such proprietary interest, under common law or otherwise, in the mark or badge or in the business of making and selling Eau de Cologne as will support a claim on his part for passing-off against the Plaintiff Co. or any other person."

40 Applying this latter sentence to this case and substituting for "Eau de Cologne" "tooth-brushes made in Hong Kong by Star Industrial Co. Ltd." at the present time, can it be said that in Ace A the

In the High  
Court of  
Singapore

—  
No.45

Written  
submissions  
on behalf of  
Defendant  
(continued)

Plaintiffs who applied it to such tooth-brushes has today any proprietary right to stop Star Plastics Industrial Private Ltd., a Singapore Co., who are making these tooth-brushes or my client?

I am enclosing with this submission a photocopy of this case for easy reference.

Reference is also made to A.G. Spalding & Bros. v. A.W. Gamage Ltd. 1915 R.P.C. Vol 32 page 273 at page 283 - 285 marked for convenience reference with lines which stresses that the essence of a passing off action is that damages may probably ensue.

10

It is impossible in this case knowing that Ace A assuming it acquired a reputation to hold that damages will ensue to the Hong Kong Co. in the sense that the Defendant's tooth-brushes can do any damage to the sale of tooth-brushes made in Hong Kong and sent to Singapore as there have been no sales since 1965 at all and there won't be any.

Also on goodwill being linked with a de facto business, we would refer to Pinto v. Badman 1891 R.P.C. Vol. 8 page 181 with particular reference to pages 194 and 195.

20

Delay, acquiescence, laches

These require consideration only if one assumes that the Plaintiffs have established a proprietary right.

The Plaintiffs were informed that this mark was used by my client in 1968 (early). No interest was shown.

30

Interest was shown when a shareholder of the Hong Kong Co. was interested in becoming a shareholder with Singapore interest of a Singapore Co., not to sell tooth-brushes made in Hong Kong but to manufacture in Singapore tooth-brushes and use as a trade mark denoting Singapore origin the mark Ace A. At that time the pack was common to the trade in Singapore.

These acts in my submission show that Mr. Leung and the Hong Kong Co. had no intention of using Ace A to denote goods of the origin of the Hong Kong Co. and have in fact abandoned the mark in

40

the sense that it is no longer to be used to denote Hong Kong origin.

In the High  
Court of  
Singapore

—  
No.45

Written  
submissions  
on behalf of  
Defendant

(continued)

The only part who could be a Plaintiff is Star Plastics Industrial Private Ltd. a Singapore Co. as they are the people doing business in the Ace A mark and denoting this separate independent Singapore Co. They are not before the Court and if there was any goodwill or proprietary rights, they have been passed over to the Singapore Co.

10 I would refer to page 13 of the Notes of Evidence -

Q. When the tariff came in, the plaintiffs were no longer going to manufacture in H.K. and sell in Singapore?

A. Yes. We were going to do it through a Singapore Co.

The facts about the Singapore Co. are now known.

Evidence of repute

20 In my submission the Plaintiffs apart from the questions above dealt with have totally failed to prove that either in 1965 or the date of the issue of the Writ repute in Singapore sufficient to sustain the action. There is in fact no evidence of sales in Singapore sufficient to bring an action. Shipments to Singapore if any were mainly for Indonesia. But in fact the evidence is of sales in Hong Kong.

Dated this 6th day of October, 1972.

30

Sd. L.A.J. SMITH

In the High  
Court of  
Singapore

No.46

Further  
written  
submissions  
on behalf of  
Plaintiffs/  
Applicants

No. 46

Further written submissions on  
behalf of the Plaintiffs/Applicants

(A) As to the plaintiffs' right to sue:

1. It has been argued on behalf of the defendant that at the date the Writ in Suit No. 102 of 1971 was issued the plaintiffs no longer had any business in Singapore and they had nothing to protect having abandoned the Singapore mark. It is further argued that no legal assignment of the RED A ACE trade mark in Hong Kong was effected by Star Brush Manufacturing Co. of which Mr. Leung Jhi Hung was the sole proprietor until after the defendant had commenced to manufacture and sell in Singapore RED A AGE tooth brushes. 10

2. It is submitted that from 31st March 1962 when Mr. Leung Jhi Hung ceased to carry on business as Star Brush Manufacturing Co. (at the latest) and probably on and from the 15th March 1962 when the plaintiffs acquired from Mr. Leung Jhi Hung certain of the assets of Mr. Leung formerly used by him in connection with the business of Star Brush Manufacturing Co., the goodwill in the business of RED A ACE tooth brushes passed to the plaintiffs who perhaps from the date of the assignment of the manufacturing equipment and certainly from the date that Mr. Leung Jhi Hung ceased to carry on business as Star Brush Manufacturing Co. enjoyed all the rights, advantages and benefits of the trade in RED A ACE tooth brushes in Hong Kong and Singapore and elsewhere. The fact that no legal assignment of the goodwill in the business formerly carried on by Mr. Leung Jhi Hung in the name of Star Brush Manufacturing Co. was then entered into does not detract from the effective transfer of goodwill when Star Industrial Co. Ltd. began manufacturing and selling for their own benefit and enjoyment RED A ACE tooth brushes. 20 30

With further reference to the transfer or assignment of goodwill from Mr. Leung Jhi Hung to the plaintiffs reference is made to the Third Edition of Halsbury's Laws of England Volume 4 pages 492 and 493 paragraph 1018 and particularly at the top of page 493 "an agreement amounting to an equitable assignment may be expressed and 40



written or may even be made out from a course of dealing between the parties".

In the High  
Court of  
Singapore

—  
No.46

Further  
written  
submissions  
on behalf of  
Plaintiffs/  
Applicants  
(continued)

10 Paragraphs 483 and 483(a) at page 245 of the  
9th Edition of Kerley on Trade Marks deal with  
"Assignment and transmission of common law trade  
mark", and "Transfer by implication with goodwill".  
It is submitted that where reputation has been  
proved in a particular label or getup so that the  
same has become distinctive of the goods of one  
trader and no other (as in the case with RED A ACE  
prior to the defendant's conduct) then substanti-  
ally such distinctive label stands in no different  
position from a trade mark and if the proprietor  
of such label in fact (whether with or without  
legal documentation) transfers his business and  
his labels to another trader and permits that other  
to carry on the business and does not himself  
compete therewith and himself ceases business it  
necessarily follows that a transfer of goodwill  
takes place.

20 At common law a trade mark could not be assigned  
except with the goodwill of the business in the  
goods in connection with which it was used. "It  
was held that the sale and transfer of the goodwill  
of a business assigned the trade marks used in the  
business to the purchaser and transferee by  
implication and without any express grant being  
needed". (See para 483(a) and the authorities  
there cited). It is submitted that the plaintiffs  
30 are the successors in title to Mr. Leung Jhi Hung  
trading as Star Brush Manufacturing Co. of Hong  
Kong and accordingly at the date of the imposition  
of tariff on tooth brushes in October 1965 were the  
proprietors of the goodwill and reputation of the  
RED A ACE labels in Singapore.

40 3. The imposition of the tariff commercially  
prevented the plaintiffs from continuing to sell  
RED A ACE tooth brushes manufactured in Hong Kong  
in Singapore (although the plaintiffs maintain some  
small sales did continue). The case of Ad-Lib Club  
v. Granville 1972 2 ALL ER page 300 is authority  
for the proposition that a trader who ceases to  
carry on business may nonetheless retain for a  
period of time the goodwill of that business. See  
also The Berkeley Hotel Co. Ltd. v. Berkeley  
International (Mayfair) Ltd. 1972 RPC page 237.  
It is submitted that at the date the defendant  
commenced to manufacture and sell in Singapore

In the High  
Court of  
Singapore

No.46

Further  
written  
submissions  
on behalf of  
Plaintiffs/  
Applicants

(continued)

RED A AGE tooth brushes the plaintiffs continued to enjoy the reputation held by them in their RED A ACE tooth brushes prior to the imposition of the tariff. The imposition of the tariff was a circumstance of the trade beyond the control of the plaintiffs (see Aktiebolaget Manus v. R.J. Fullwood & Bland Limited 1949 Chancery Division 208) and the plaintiffs have not by reason of the imposition of the tariff abandoned their goodwill trade and business in Singapore. (See also Mouson v. Boehm 26 Chancery Division 398).

10

4. The plaintiffs having still maintained their reputation at the date the defendant commenced sales of RED A AGE tooth brushes the plaintiffs, at the very worst are one of the persons entitled to sue and where more than one party is entitled to sue action may be brought by any of them (See Bollinger v. Spanish Wine Importers 1960 RPC 16 and 1961 RPC 116 referred to in the previous submission).

20

5. In any event the business in RED A ACE tooth brushes in Singapore which are now being sold by Star Plastics Industrial Co. Pte. Ltd. is exploiting the goodwill and reputation of the plaintiffs. It is this goodwill of the plaintiffs which the actions of the defendant damage. There is no deception to the public as a result of Star Plastics Industrial Co. Pte. Ltd. using the RED A ACE label of the plaintiffs as the plaintiffs maintain (as is the evidence) full control over the products to which the RED A ACE labels are applied and the manner in which those labels are applied. Further the Singapore factory enjoys a licence from the plaintiffs. This licence is informal at the present being embodied in the letter appearing at pages 4 and 5 of the Agreed Bundle.

30

6. The present case is clearly distinguishable from that of Thorneloe v. Hill 11 RPC 61 in which case the plaintiff was an assignee of what purported to be goodwill in a trade name without any assignment of the business therewith and which trade name had not been used by the assignor or for a period of time by the assignors' predecessors in title who had granted to third parties substantially prior to the purported assignment a licence to use the same mark for a limited period of time without reserving any control over the manner in which the same was used. In any event the trade name in that case (Thorneloe v. Hill) was not being properly applied by the plaintiff or his predecessors in title and was leading to deception.

40

50

7. Reference is also made to the 9th Edition of Kerley on Trade Marks pages 385 and 386 paragraph 742 on "Assignment and devolution of trade name etc." and particularly to the notes on Imperial Tobacco Company of India v. Bonnan (1924) 41 RPC 441. It is submitted that that case when coupled with the decision of the "Bostitch" case 1963 RPC 183 is ample authority for the proposition that sales by Star Plastics Industrial Co. Pte. Ltd., in view of the control exercised by the plaintiffs over their methods of manufacture and use of the RED A ACE labels result in the reputation in the RED A ACE mark (that is the goodwill vested therein) remaining with the plaintiffs.

In the High  
Court of  
Singapore

—  
No.46

Further  
written  
submissions  
on behalf of  
Plaintiffs/  
Applicants

(continued)

8. The case of R.J. Reuter Coy. Ltd. v. Mulhens (1953) 70 RPC 102 is also relevant both on the question of assignment of goodwill and also for the observations contained in section 2 of the Trade Marks Act 1938. In the judgment of Danckwerts J. at page 121, first, at lines 4 to 8 sums up the relevance of the English Trade Marks Act 1938 section 2 (which is in the same terms as the Trade Marks Act Cap. 206 section 53). The learned judge there stated:

" I think that the only relevance of this section for the purposes of this action is that it prevents the Plaintiffs relying upon their registered trade marks so far as getup of the goods, as distinguished from the trade marks is concerned, and makes the Trade Marks Act irrelevant as regards the claim of passing-off so far as it is based on getup or appearance of the articles sold".

The foregoing is clearly additional authority for a Plaintiff being entitled to seek relief for passing off where his trade mark or getup is not registered.

From line 9 on the same page the question of goodwill is discussed. In that case it will be noted that goodwill was assigned to Reuter by the Custodian of Enemy Property so that Mulhens in his counterclaim for passing off had no goodwill or reputation upon which to sue. The discussion on goodwill is not authority for the proposition that by reason of the imposition of the tariff in Singapore the plaintiffs were kept out of the market and thus forfeited their goodwill. It is

In the High  
Court of  
Singapore

—  
No.46

Further  
written  
submissions  
on behalf of  
Plaintiffs/  
Applicants  
(continued)

further submitted that this part of the judgment of Danckwerts J. supports the plaintiffs' contention that they have acquired the goodwill formerly owned by Mr. Leung Jhi Hung trading as Star Brush Manufacturing Co.

There has been no assignment or transfer of goodwill from the plaintiffs to Star Plastics Industrial Co. Pte. Ltd., Singapore, as the licence given to the latter company to use the labels and marks of the plaintiffs is restricted and is in fact subject to control by the plaintiffs.

10

Dated this 7th day of October, 1972.

Sd. Drew & Napier.

No.47

Judgment of  
Choor Singh J.

19th April  
1973

No. 47

JUDGMENT OF CHOOR SINGH, J.

This action is brought to restrain the defendants from passing-off tooth-brushes not of the manufacture of the plaintiffs as and for the tooth-brushes of the plaintiffs.

20

The circumstances giving rise to the action are these. In the year 1953 one J.H. Leung residing in HongKong and trading there under the name of "Star Brush Manufacturing Co." started manufacturing in HongKong tooth-brushes which were packed in packets which were divided diagonally into two parts, the top part consisting of white transparent cellophane paper and the bottom half of plain hard paper with a silver background with the words "ACE BRAND TOOTH BRUSH" together with the symbol of the letter "A" enclosed with a red circle embossed thereon. These tooth-brushes were first imported in Singapore in 1953 and they were mostly for re-export to Indonesia and the other surrounding territories although there were some local sales as well. The "Ace" trade mark was not registered in Singapore and has never been registered here.

30

In 1961 Leung's tooth-brush business was taken over by a new company which was incorporated and registered under the HongKong Companies Act under the name of "Star Industrial Co. Ltd." Leung became a major shareholder of this Company

40

and its managing director. This Company took over the manufacture of the "ACE" brand tooth-brushes which they exported to Singapore and Leung's Star Brush Manufacturing ceased manufacturing such tooth-brushes.

In the High  
Court of  
Singapore

—  
No.47

Judgment of  
Choor Singh J.

19th April  
1973

(continued)

10

It is here relevant to note two significant facts that occurred at this time. First, although Leung was the managing director and the major shareholder of the Star Industrial Co. Ltd. which now manufactured and exported the "ACE Brand" tooth-brushes, Leung retained personal ownership of the "ACE Brand" mark. Secondly, although the "ACE Brand" tooth-brushes were now manufactured and exported by the Star Industrial Co. Ltd. these tooth-brushes continued to be packed and exported in packets labelled "Star Brush Manufacturing Co."

20

In 1963 the "ACE Brand" was registered as a trademark in HongKong not by the plaintiff Company which was then using this mark on tooth-brushes manufactured by it, but by the Star Brush Manufacturing Co. of which Leung was still the sole proprietor and which no longer manufactured any tooth-brushes.

30

In October 1965 the Singapore Government imposed a tariff of 15 cents per tooth-brush on all tooth-brushes imported into Singapore and the plaintiff thereafter stopped exporting their tooth-brushes to Singapore as they could not be sold with profit.

40

In 1968 the plaintiff Company entered into negotiations with some merchants in Singapore with a view of starting a joint venture in Singapore for manufacturing the "ACE Brand" tooth-brushes. These negotiations resulted in the incorporation in Singapore of the Star Plastics Industrial Co. (Pte.) Ltd. with a capital of \$1,200,000 of which \$168,000 was subscribed by the plaintiff Company. The plaintiff Company supplied the "know-how" and sent from HongKong moulds for the production of tooth-brushes and they also sent technicians and a production manager to supervise the manufacture of tooth-brushes and plastic wares. The plaintiff Company also persuaded Leung in 1968 to assign to the plaintiff Company the "ACE Brand" trade mark registered in HongKong which he did grain.(sic)

In 1969 the Star Plastics Industrial Co. (Pte.) Ltd. started manufacturing in Singapore the "ACE

In the High  
Court of  
Singapore

—  
No.47

Judgment of  
Choor Singh J.

19th April  
1973

(continued)

Brand" tooth-brushes and on the 3rd December 1969 they applied to the Registrar of Trade Marks in Singapore for the registration of the "ACE Brand" trade mark. The Registrar objected to the registration of the "ACE Brand" trade mark because of the prior registration of the "AGE" trade mark by the defendant Company.

What had happened was that after the imposition of tariffs upon the import of tooth-brushes into Singapore, all Singapore dealers had stopped importing "ACE Brand tooth-brushes from HongKong. In 1968 the defendant who was originally trading as Yap Trading Co. changed the name of his business to that of "New Star Industrial Co." and started manufacturing tooth-brushes which he sold under the brand name of "AGE" which he registered as a trade mark with the Registry of Trade Marks in Singapore. So, when the Star Plastics Industrial Co. (Pte.) Ltd. applied in December 1969 to register the "ACE" trade mark, the Registrar took the view that the registered mark "AGE" was likely to be infringed by the "ACE" trade mark and he refused its registration. Nothing happened for about a year and then in 1971 the plaintiff Company commenced this action claiming that the defendant was passing-off his tooth-brushes as the tooth-brushes of the plaintiff Company. They also commenced Originating Summons No.2 of 1971 wherein they claimed rectification of the Register of Trade Marks and the removal of the defendant's trade mark from the Register. Both these proceedings have been consolidated and the rectification of the Register will depend on the result of this action.

10

20

30

All the wholesalers called by the plaintiffs to give evidence on their behalf admitted that upon the imposition by the Singapore Government in October 1965 of tariffs on the import of tooth-brushes, they stopped importing ACE tooth-brushes from HongKong. Leung claimed that a small quantity was exported to Singapore in 1966 and 1967. There is no independent evidence to support this claim and I am therefore unable to accept it. On the evidence before me I hold that after 1965, the "ACE Brand" tooth-brushes were not imported into Singapore.

40

It is also clear from the evidence that all "ACE Brand" tooth-brushes imported into Singapore prior to the imposition of the tariffs had the label "Star Brush Manufacturing Co." on their

10 packets. However, Leung claimed that from January 1964 the "ACE Brand" tooth-brushes imported into Singapore had on their packets the name of the plaintiff Company i.e. Star Industrial Co. Ltd. There is again no independent evidence to support this assertion. No one in Singapore was called to support this claim by Leung. If what Leung stated was true then the wholesalers who imported tooth-brushes in 1964 and the retailers who sold them to the public in Singapore could have testified to the truth of Leung's contention. There is no such evidence before the court. In my opinion Leung was not speaking the truth and I therefore reject his contention, I find it as a fact that all "ACE Brand" tooth-brushes sold in Singapore prior to the imposition of the tariffs carried the label "Star Brush Manufacturing Co." on their packets.

In the High Court of Singapore

—  
No.47

Judgment of Choor Singh J.

19th April 1973

(continued)

20 These are the facts upon which I will now proceed to determine this case. A large number of authorities were cited by both counsel, but in my opinion this dispute is easily resolved if one comprehends clearly the true basis of a passing-off action.

30 In so far as imitation of get-up is concerned, the gist of the action for passing-off is this. The plaintiff by using and making known a particular get-up in relation to his goods, and thus causing it to be associated exclusively with his goods, acquires a quasi-proprietary right to the exclusive use of the get-up in relation to goods of that kind. And this right is invaded by any person who, by using some deceptively similar get-up in relation to other goods of that kind but not of the plaintiff's manufacture, induces customers to buy from him such other goods as goods of the plaintiff's manufacture, thereby diverting to himself orders intended for and rightfully belonging to the plaintiffs. That is the view expressed by Jenkins L.J. in Qertli A.G. v. Bowman (London) Ltd. (1957) R.P.C. 388 at page 397.

40 The basis of the proceedings in a passing-off action is the protection of rights of property affecting the plaintiff's trade for there is no right of action where there is no interference with the plaintiff's trade. The view that the law intervenes to protect rights of property is clearly supported by the observations of Lord Parker in Spalding & Bros. v. A.W. Gamage Ltd. (1915) 32 R.P.C. at page 284.

In the High  
Court of  
Singapore

No.47

Judgment of  
Choor Singh J.

19th April  
1973

(continued)

" There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing-off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question - property in what? Some authorities say, property in the mark, name or get up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in Reddaway v. Banham, (1896) A.C. 199 expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think, strong reasons for preferring the latter view."

10

The same view is supported by the statements of Romer, L.J., in Samuelson v. Producers' Distributing Co. Ltd., (1931) All E.R.74 at page 81 and of Goddard, L.J. in Draper v. Trist, (1939) 3 All E.R. 513 at page 526, where he says:-

20

" In passing-off cases, however, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business."

In Burberrys v. Gording, (1900) 26 R.P.C. 693, Parker, J. summarised the principles of law applicable, in the following passage, at page 701:

30

" The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade mark, on one can claim monopoly rights in the use of a word or name. On the other hand, on one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or goodwill which will be injured by its use .....

40



In Commissioners of Inland Revenue v. Muller & Co.'s Margarine Ltd., (1901) A.C. 217 in discussing goodwill, Lord Macnaghten said, at page 223:-

" Goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business and the goodwill perishes with it though elements remain which may perhaps be gathered up and be revived again."

In the High Court of Singapore

No.47

Judgment of Choor Singh J.

19th April 1973

(continued)

10 And Lord Lindley added:-

"Goodwill regarded as property has no meaning except in connection with some business, trade or calling ..... In this wide sense goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country ..... or in several and if in several, there may be several businesses each having a goodwill of its own."

20

It follows from all these authorities that a passing-off action is an action dealing with damage to a currently operating business or one which would be operated or could be operated but for extraneous factors beyond the control of the owner of the business. See R.J. Reuter Co. Ltd. v. Mulhens, 1953 R.P.C. vol 70 page 235. In a passing-off action it must be shown that at the time of the Writ there is a trade or goodwill by the plaintiff in the article in question currently in existence to be protected.

30

Although the plaintiffs claim that this is a passing-off action, their claim is in substance based on an unregistered trade mark and their real complaint is that the defendants have infringed their unregistered trade mark. The "ACE" mark is not registered in Singapore under the Trade Marks Act (Cap. 206). It is therefore necessary to ascertain what are the rights, if any, of an unregistered trade mark. A trade mark as such, since the coming into force of the Trade Marks Ordinance in 1938, now known as the Trade Marks Act (Cap.206, hereinafter referred to as the Act) can be the subject of a statutory right so that any person using the trade mark or a colourable imitation of it can be restrained by an injunction and is liable

40

In the High  
Court of  
Singapore

No.47

Judgment of  
Choor Singh J.

19th April  
1973

(continued)

under the Act to damages for his use per se irrespective of damage to business or goodwill. This is a totally new right unknown to the law prior to the passing of the Act. Section 49 of the Act provides that unless the mark is registered, no action can be maintained to prevent or recover damages for the use by another of the mark or a colourable imitation thereof.

And unregistered trade mark cannot be validly assigned unless the whole of the goodwill in the business in which the mark is used is assigned at the same time. See Sinclair's case, (1932) 49 R.P.C. 123. See also Leather Cloth Co. Ltd. v. American Leather Cloth Co. Ltd. (1865) 11 H.L.C. 524 which is referred to in R.J. Reuter Co. Ltd. v. Mulhens (supra), as "authority for the proposition that a purchaser of a mark becomes owner of it only if he becomes at the same time purchaser of the manufactory or the business concerned in the goods to which the mark has been affixed."

10

20

It is true that under section 42 of the Act it is now possible to effectually assign a mark not together with the whole business of origin of the mark but this competency is confined to registered trade marks. Unregistered trade marks can be so assigned only if "at the time of the assignment of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the registered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned." See section 42(3) of the Act.

30

Furthermore "even in the case of what are sometimes referred to as common law trade marks, the property, if any, of the so-called owner is in its nature transitory, and only exists so long as the mark is distinctive of his own goods in the eyes of the public" per Lord Parker in Spalding and Brothers v A.W. Gamage, Limited, (1915) 32 R.P.C. 273, at page 284.

40

When these principles of Law are applied to the facts of this case, it will be seen that the plaintiffs' claim fails on a number of grounds.

10 First, the evidence, in my opinion, is inadequate to establish any goodwill or property of the plaintiffs in Singapore in respect of the "ACE Brand" tooth-brush. To establish a reputation in it they must prove that a sufficiently large quantity was sold in Singapore. The figures given are of exports from HongKong to Singapore and the plaintiffs concede that these tooth-brushes were mainly for re-export to Indonesia, Malaysia and Australia. They have made a clear-cut admission that they have no figures of actual sales in Singapore. They have called no retailers. The figures given are meaningless because the plaintiffs' main witness admits that the tooth-brushes came to Singapore for redistribution to other countries. In my judgment the plaintiffs have failed to prove that prior to 1965 they had sold in Singapore sufficient tooth-brushes under the "ACE Brand" mark to establish a reputation in it and their claim therefore fails.

20 It is apparent that rights in respect of un-registered trade marks arise in consequence of facts. One of the facts is the reaction of ordinary members of the public when they see a trade mark on goods. The reputation of the "ACE Brand" mark was associated in the public mind with the Star Brush Manufacturing Co. because all such tooth-brushes imported into Singapore from HongKong prior to the imposition of the tariff were sold in packets labelled "Star Brush Manufacturing Co." If there was any property or goodwill in Singapore up to 1965 in respect of the "ACE Brand" tooth-brushes, it was distinctive of and belonged to the Star Brush Manufacturing Co. It follows therefore that the plaintiff Company never had any property or goodwill in Singapore in respect of the "ACE Brand" tooth-brushes and their claim therefore fails.

40 The use of the "ACE Brand" mark on the plaintiff Company's tooth-brushes imported into Singapore was clearly deceptive. This unregistered mark was being used not in connection with the goods of Leung, the proprietor of this mark, but on goods of someone else. By selling their "ACE Brand" tooth-brushes in Singapore in packets labelled "Star Brush Manufacturing Co." the plaintiffs were making a false representation that their tooth-brushes were the tooth-brushes of the Star Brush Manufacturing Co. which they were not.

In the High Court of Singapore

No.47

Judgment of Choor Singh J.

19th April 1973

(continued)

In the High  
Court of  
Singapore

—  
No.47

Judgment of  
Choor Singh J.

19th April  
1973

(continued)

The plaintiff Company by using the "ACE Brand" on their tooth-brushes in the manner in which they did, were passing-off their tooth-brushes as those of the Star Brush Manufacturing Co. This deceptive action which was quite clearly contrary to public policy gave them no rights of property or goodwill in respect of the "ACE Brand" mark in Singapore. See Lacteosote, Ltd. v. Alberman, (1927) 2 Ch. 117 at page 131, where Clauson, J. observed:

" ..... It would seem to be reasonable and it is, in my judgment, the law that a mark ceases to be a good mark if, owing to the action of the registered owner, it becomes deceptive: see In re Hotpoint Electric Heating Co. (1921) 38 R.P.C. 63.

I do not see why a mark should not cease to be a good mark if it is assigned in such a way as to enable the transferee to use it, so as to re-present something other than that which the mark represented in the hands of the transferor; see Pinto v. Badman, (8) R.P.C. 181."

By allowing the plaintiff Company to use his "ACE Brand" mark on tooth-brushes not manufactured by him or by his Star Brush Manufacturing Co. Leung destroyed any goodwill or property that he may have had in Singapore in respect of the said mark. See Lacteosote, Ltd. v. Alberman, (supra).

The purported assignment of the "ACE Brand" mark by Leung to the plaintiff Company in 1968 was invalid because he did not assign at the same time the whole of the goodwill in the manufactory or business concerned in the goods to which the mark had been fixed". In 1968 Leung had no manufactory or business in "ACE Brand" tooth-brushes which he could assign. His Star Brush Manufacturing Co. had stopped manufacturing tooth-brushes as far back as 1961 and as already stated any goodwill or property rights that he had in Singapore in respect of the "ACE Brand" tooth-brushes had been destroyed when he allowed the plaintiff Company to use this mark on their tooth-brushes. The mark being un-registered, its purported assignment under the circumstances in which it took place, was of no legal effect and gave the plaintiff Company no rights whatsoever in Singapore.

10

20

30

40

10 The plaintiffs rely on the purported assign-  
 ment to them by Leung in 1968 of the "ACE Brand"  
 mark registered in HongKong. Leung's Star Brush  
 Manufacturing Co. had been using this mark on  
 tooth-brushes manufactured in HongKong. The  
 essential function of a trade mark is that it  
 indicates the origin of the goods. The Star Brush  
 Manufacturing Co. has never manufactured tooth-  
 brushes in Singapore. In 1968 when the mark was  
 assigned to the plaintiffs it could only be  
 assigned for use on tooth-brushes manufactured in  
 HongKong. Therefore the assignment, even if it  
 was a valid one, it did not give the plaintiffs a  
 right to use the "ACE Brand" mark on tooth-brushes  
 to be manufactured in Singapore. It did not give  
 them any proprietary rights in Singapore. The  
 "ACE Brand" mark means or indicates in Singapore  
 a tooth-brush manufactured in HongKong. The  
 Plaintiffs have not claimed that they intend to  
 20 resume the manufacture in HongKong of "ACE Brand"  
 tooth-brushes for export to Singapore. There has  
 been no such business since 1965 and there is no  
 evidence that it is going to be resumed.

30 The court exercises its jurisdiction for the  
 protection of goodwill of a trader and it does not  
 interfere to protect a non trader such as the  
 plaintiff Company which has no trade or business  
 in Singapore since 1965. The doctrine of passing-  
 off has no application except as between rival  
 traders. That is clear from the judgment of  
 Evershed, M.R. in Reuter Co. Ltd. v. Mulhens,  
 (supra) at page 253:-

40 " Still I do not think that the defendant  
 is entitled to succeed in his claim for  
 passing-off. He is conducting in England no  
 business, selling there no goods. As it seems  
 to me, he has not in this country any propri-  
 etary right which he is entitled to protect.  
 Proof of the facts, as I have assumed them,  
 does not create or give him such a right.

In the case of a trade mark, whether  
 registered or unregistered, the proprietary  
 right is no doubt sufficient to support an  
 action to exclude. Nevertheless, I cannot  
 think that, at any rate in the absence of  
 some very special circumstances, a person who  
 is not trading in this country and has in this  
 country no proprietary interest in a name or

In the High  
 Court of  
 Singapore

—  
 No.47

Judgment of  
 Choor Singh J.

19th April  
 1973

(continued)

In the High  
Court of  
Singapore

No.47

Judgment of  
Choor Singh J.

19th April  
1973

(continued)

mark can be said to have "the exclusive right" contemplated by section 22(4) because of the goodwill he possesses in another country."

The plaintiff Company, not having evinced any intention of manufacturing "ACE Brand" tooth-brushes in HongKong for export to Singapore and not having, at present, any trade in such tooth-brushes in Singapore, cannot, under the circumstances, succeed in a claim for passing-off against the defendant or any other person because they have no trade which is being injured or going to be injured by the conduct of the defendant. The fact that the plaintiff Company has no trade in tooth-brushes in Singapore is absolutely fatal for its success in this action. As already stated, the basis of the proceedings in a passing-off action is the protection of rights of property affecting the plaintiffs trade. There is no right of action where, as in this case, there is no interference with the plaintiff's trade. 10

Counsel for the plaintiffs submitted that the plaintiffs were entitled to the relief which they are seeking because they are closely associated with the Star Plastics Industrial Co. (Pte.) Ltd. of Singapore; that the plaintiffs have granted an informal licence to this Singapore Company to use the "ACE Brand" on tooth-brushes manufactured by it for sale in Singapore and that the plaintiff Company maintains full control over the products to which the "ACE Brand" labels are applied. However, he conceded that there has been no assignment or transfer of goodwill from the plaintiff Company to the Star Plastics Industrial Co. (Pte.) Ltd. In my opinion, this submission is entirely without merit. Such a proposition has no foundation in law and is contrary to the doctrine of separate legal personality of incorporated bodies. No matter how closely the plaintiff Company is associated with the Star Plastics Industrial Co. (Pte.) Ltd., the fact remains that the plaintiff Company is not, in the eyes of the law, carrying on any trade in tooth-brushes in Singapore. 30

In the final analysis, the evidence, the surrounding circumstances and also the submissions of counsel for the plaintiffs, indicate quite clearly that the real grievance of the plaintiffs 40

is that the defendant is infringing the "ACE Brand" trade mark of which they claim to be the proprietors by virtue of its assignment to them by Leung, its registered owner. This action is therefore, in substance, an action to restrain the infringement of a trade mark and not a passing-off action as claimed by the plaintiffs. As the trade mark in question is unregistered in Singapore, the action fails under section 49 of the Act.

In the High Court of Singapore

No.47

Judgment of Choor Singh J.

19th April 1973

(continued)

10

For the above reasons, the claim of the plaintiffs fails and is dismissed with costs. The defendant is entitled to remain on the Register as proprietor of the "AGE" trade mark. The motion by the plaintiffs in Originating Motion No.2 of 1971 for an order that the defendant's trade mark be expunged from the Register is dismissed with costs.

Dated this 19th day of April, 1973.

Sd. Choor Singh

J U D G E

20

Certified true copy.  
Sd. Koh Bee Kiat  
Private Secretary to Judge  
Court No. 6  
Supreme Court, Singapore.

No. 48

FORMAL JUDGMENT

The 19th day of April, 1973

No.48

Formal Judgment

19th April 1973

30

This action having been tried before the Honourable Mr. Justice Choor Singh on the 19th, 20th and 21st days of June 1972 and on 2nd and 4th days of October, 1972.

IT IS ADJUDGED that this action be dismissed with costs.

Entered this 3rd day of May, 1973, in Volume CXXI Page 314 at 10.10 a.m.

Sd. R.E. Martin

ASST. REGISTRAR

144.

In the Court  
of Appeal of  
Singapore

No. 49

NOTICE OF APPEAL

No.49  
Notice of  
Appeal  
15th May 1973

TAKE NOTICE that the Appellants being dissatisfied with the decision of the Honourable Mr. Justice Choor Singh given on the 19th day of April, 1973, appeal to the Court of Appeal against the whole of the said decision.

Dated the 15th day of May, 1973.

Sd. Drew & Napier

Solicitors for the Appellants.

10

To:

The Registrar, Supreme Court

The Respondent, and to his Solicitors,  
L.A.J. Smith, Esquire.

The address for service of the Appellants is the office of Messrs. Drew & Napier of Nos.30-35, Chartered Bank Chambers, Battery Road, Singapore.

No.50

No. 50

Petition of  
Appeal

PETITION OF APPEAL

16th June  
1973

To:

The Honourable the Judges of the Court of  
Appeal.

20

The Petition of the above-named Appellants.

Showeth as follows:

1. The appeal arises from a claim by the Appellants, inter alia, for an injunction to restrain

(a) the Respondent whether by himself, his servants or agents or any of them or otherwise howsoever from passing-off or attempting to pass-off or causing enabling or assisting others to pas-off tooth brushes not the



manufacture of the Appellants as and for the tooth brushes of the Appellants by the use or in connection therewith in the course of trade of a get-up similar to that of the Appellants' ACE marked tooth brushes or any colourable imitation thereof, without clearly distinguishing such use from the goods of the Appellants or by any other means:

In the Court  
of Appeal of  
Singapore

—  
No.50

Petition of  
Appeal

16th June  
1973

(continued)

- 10 (b) passing-off or attempting to pass-off the business of the Respondent as manufacturers of tooth brushes as and for the business of the Appellants by the use in connection therewith of the trading name New Star Industrial Co., or by any other means.

2. By judgment dated the 19th day of April, 1973, the action was dismissed with costs.

3. Your Petitioners are dissatisfied with the said Judgment on the following grounds:

- 20 (1) That the learned Judge was wrong when he found that Leung Jhi Hung retained ownership of the 'ACE' brand mark and the Star Brush Manufacturing Company whereas in fact all the assets of the Star Brush Manufacturing Company including the goodwill in the said mark and the trading style Star Brush Manufacturing Company were validly assigned by Leung Jhi Hung to the Appellants herein in 1961.
- 30 (2) That the learned Judge was wrong when he held that a passing off action is an action dealing only with damage to a currently operating business or one which would be operated or could be operated but for extraneous circumstances beyond the control of the owner of the business.
- 40 (3) That the learned Judge was wrong when he held that this action is in substance an action to restrain infringement of an unregistered trade mark. This action has been brought for the protection of the Appellants' reputation in the whole get up of the 'ACE' brand toothbrush.
- (4) That the learned Judge's finding that the Appellants had failed to prove that prior to 1965 they had sold in Singapore sufficient

In the Court  
of Appeal of  
Singapore

—  
No. 50

Petition of  
Appeal

16th June  
1973

(continued)

toothbrushes under the 'ACE' brand mark to establish a reputation was contrary to the weight of the evidence.

- (5) That when considering the question of whether the Appellants had any goodwill or property in Singapore in respect of the 'ACE' brand toothbrush, the learned Judge was wrong to ignore the Appellants' toothbrushes which were re-exported from Singapore to other markets and to ignore the Appellants' reputation in such other markets. 10
- (6) That the learned Judge was wrong when he found that such goodwill as existed in respect of the 'ACE' brand toothbrushes in Singapore was not the property of the Appellants.
- (7) That the learned Judge was wrong when he found to be false the Appellants' representation that their goods were those of the Star Brush Manufacturing Company. The said representation was true since the name 'Star Brush Manufacturing Company' had been since 1961 a trading style of the Appellants. 20
- (8) That the learned Judge was wrong when he found that the 'ACE' brand mark means or indicates in Singapore a toothbrush manufactured in Hong Kong and could not be used by the Appellants on toothbrushes made in Singapore without causing confusion. 30
- (9) That the learned Judge's decision that for success in a passing off action the Appellants must be personally trading in Singapore was wrong, and that the learned Judge wrongly failed to take into consideration the business conducted by Star Plastics Industrial Company (Private) Limited in Singapore in 'ACE' brand toothbrushes and the degree of control exercised by the Appellants over the said business. 40

4. Your Petitioners pray that such Judgment may be reversed.

Dated the 16th day of June, 1973.

Sd. Drew & Napier  
Solicitors for the Appellants.

147.

No. 51

ORDER ON JUDGMENT

CORAM: THE HONOURABLE MR. JUSTICE WEE CHONG JIN,  
CHIEF JUSTICE OF SINGAPORE;  
THE HONOURABLE MR. JUSTICE F.A. CHUA and  
THE HONOURABLE MR. JUSTICE KULASEKARAM.

In the Court  
of Appeal of  
Singapore

No.51

Order on  
Judgment

26th October  
1973

THE 26TH DAY OF OCTOBER, 1973

IN OPEN COURT

O R D E R

10

THIS APPEAL coming on for hearing on the 22nd,  
23rd, 24th and 26th days of October, 1973 in the  
presence of Mr. A.C. Fergusson of Counsel for the  
Appellants and Mr. L.A.J. Smith of Counsel for the  
Respondent AND UPON READING the Record of Appeal  
AND UPON HEARING Counsel for the Appellants and for  
the Respondent IT IS ADJUDGED that this Appeal be  
and is hereby dismissed AND IT IS ORDERED that the  
costs of this Appeal be paid by the Appellants to  
the Respondent AND IT IS FURTHER ORDERED that the  
sum of \$500.00 (Dollars Five hundred) paid into  
Court by the Appellants as security for costs of  
this Appeal be paid out to the Respondent or his  
Solicitor, Mr. L.A.J. Smith.

20

GIVEN under my hand and the seal of the Court  
this 1st day of November, 1973.

Sd. R.E. Martin  
ASST. REGISTRAR.

No. 52

No.52

Order granting leave to appeal to the  
Judicial Committee of the Privy Council

30

Coram: THE HONOURABLE THE CHIEF JUSTICE  
THE HONOURABLE MR. JUSTICE CHUA  
THE HONOURABLE MR. JUSTICE TAN AH TAH

Order  
granting  
leave to  
appeal to  
the Judicial  
Committee of  
the Privy  
Council

O R D E R

Upon Motion made unto the Court this day by  
Counsel for the Appellants and upon reading the  
affidavit of Alec Crowther Fergusson filed on the  
16th day of January, 1974, and upon hearing Counsel

28th January  
1974

In the Court  
of Appeal of  
Singapore

No.52

Order  
granting  
leave to  
appeal to  
the Judicial  
Committee of  
the Privy  
Council

28th January  
1974

(continued)

No.53

Grounds of  
Judgment

25th March  
1974

for the Appellants and for the Respondents IT IS ORDERED that the Appellants be at liberty to appeal to the Judicial Committee from the whole of the Judgment of the Court of Appeal dated the 26th day of October, 1973 AND IT IS ORDERED that the security to be given by the Appellants under Order 58, rule 4, of the Rules of the Supreme Court shall be in the sum of \$15,000.00.

Dated the 28th day of January, 1974.

Sd. R.E. Martin

10

ASSISTANT REGISTRAR.

No. 53

GROUND OF JUDGMENT

Coram: WEE CHONG JIN, C.J.  
CHUA, J.  
KULASEKARAM, J.

This appeal arises from an action in which a Hong Kong Company named Star Industrial Company Ltd. (the appellants in this appeal) were plaintiffs and a Singapore merchant trading as New Star Industrial Co. (the respondent in this appeal) was defendant. The appellants brought an action to restrain the respondent from passing-off toothbrushes not of the manufacture of the appellants as and for the toothbrushes of the appellants by the use of a get up similar to that of the appellants "ACE" brand toothbrushes.

20

At the conclusion of the hearing we dismissed the appeal indicating that we would give our reasons at a later date. We now proceed to do so.

30

The facts are shortly these. In 1953 one J.H. Leung residing in HongKong and trading there under the name of "Star Brush Manufacturing Co." started manufacturing in Hongkong toothbrushes which were packed in packets which were divided diagonally into two parts, the top part consisting of white transparent cellophane paper and the bottom half of plain hard paper with a silver background with the words "ACE BRAND TOOTH BRUSH"

together with the symbol of the letter "A" enclosed within a red circle embossed thereon (hereinafter referred as "ACE brand toothbrushes"). These toothbrushes were first imported into Singapore in 1953 and they were mostly for re-export to Indonesia and the other surrounding territories and there were some local sales as well.

In the Court  
of Appeal of  
Singapore

—  
No.53

Grounds of  
Judgment

25th March  
1974

(continued)

10 In May, 1961, the appellant company was incorporated in Hongkong and having their registered office there. Leung was the major shareholder of the appellant company and the managing director. In 1961 the appellant company took over the manufacture of the ACE brand toothbrushes which they exported to Singapore and Leung's Star Brush Manufacturing Co. ceased manufacturing such toothbrushes. Leung, however, did not assign to the appellant company the goodwill of his business or his goodwill in ACE brand toothbrushes and the  
20 toothbrushes manufactured by the appellant company continued to be packed and exported in packets labelled "Star Brush Manufacturing Co."

In 1963 the "ACE" brand mark was registered as a trade-mark in Hongkong, not by the appellant company which was then using this mark on toothbrushes manufactured by them, but by the Star Brush Manufacturing Co. of which Leung was still the sole proprietor and which no longer manufactured any toothbrushes.

30 In October, 1965, the Singapore Government imposed a tariff of 15 cents per toothbrush on all toothbrushes imported into Singapore with the result that the Singapore dealers stopped importing ACE brand toothbrushes from Hongkong as they could not be sold with profit and the appellant company stopped exporting their toothbrushes to Singapore.

40 In 1968 the appellant company entered into negotiations with some merchants in Singapore with the view of starting a joint venture in Singapore for manufacturing the ACE brand toothbrushes. As a result the Star Plastics Industrial Co. (Pte.) Ltd. was incorporated in Singapore.

The appellant company persuaded Leung to assign to them the "ACE" brand trademark registered in Hongkong which Leung did in 1968 gratis.

In the Court  
of Appeal of  
Singapore

—  
No. 53

Grounds of  
Judgment

25th March  
1974

(continued)

In 1968 the respondent, who was originally trading as Yap Trading Co., changed the name of his business to that of "New Star Industrial Co." and started manufacturing toothbrushes in a packing and get-up which is strikingly similar to the packing and get-up of the ACE brand toothbrushes which he sold under the brand name of "AGE" which he registered as a trademark with the Registry of Trade Marks in Singapore.

In 1969 the Star Plastics Industrial Co. (Pte.) Ltd. started manufacturing in Singapore the ACE brand toothbrushes and on the 3rd December, 1969, they applied to the Registrar of Trade Marks in Singapore for the registration of the "ACE" brand mark. The Registrar objected to the registration of the "ACE" brand mark because of the prior registration of the "AGE" trade mark by the respondent. The Registrar took the view that the registered mark "AGE" was likely to be infringed by the "ACE" brand mark and he refused its registration.

10

20

Nothing happened for about a year and then in 1971 the appellants commenced this action claiming that the respondent was passing-off his toothbrushes as the toothbrushes of the appellants. They also commenced Originating Motion No. 2 of 1971 wherein they claimed rectification of the Register of Trade Marks and the removal of the respondent's trademark from the Register. Both these proceedings were consolidated.

30

The High Court dismissed the appellants' claim with costs. The appellants' Motion for an order that the respondent's trademark be expunged from the Register was also dismissed with costs.

The appellants' appeal is only against the judgment of the Court dismissing the action.

From this brief outline of the facts which were never in dispute it is clear that from 1961 Star Brush Manufacturing Co., of which Leung then was and continued to remain the sole proprietor, ceased manufacturing and ceased exporting to Singapore ACE brand toothbrushes. It is also clear that any goodwill or proprietary right in Singapore that Leung, as such sole proprietor, had in toothbrushes bearing the ACE brand mark and

40

get-up, was never assigned by Leung to the appellants. It follows, in our view, that when the appellants from 1961 started manufacturing and exporting to Singapore until 1965 toothbrushes bearing the ACE brand mark and get-up in packets labelled "Star Brush Manufacturing Co." and not labelled under their own name, albeit presumably with Leung's implied permission, the appellants could not, on any view, have acquired a right of property in Singapore by 1965 in respect of the toothbrushes they exported from Hongkong on which to found an action for passing-off against someone who subsequently manufactures and sells in Singapore toothbrushes packed in a get-up deceptively similar thereto.

10

20

30

Furthermore, we are of the view, where on the undisputed facts the appellants had ceased exporting to Singapore their ACE brand toothbrushes from 1965 right up to the time of the Writ in this action, that the appellants' claim fails in limine. The nature of the right which the law protects in a passing-off action is a right of property in the goodwill or business likely to be injured by the alleged misrepresentation (see Lord Parker in Spalding Bros. v. A.W. Gamage Ltd. (1915) 32 R.P.C. at page 284.) On the undisputed facts, the appellants at the time of the Writ were conducting in Singapore no business and selling no toothbrushes bearing the ACE brand mark and get-up and in our opinion they have not proved that they have in Singapore any proprietary right which they are entitled to protect.

For these reasons we were of the opinion that the trial judge was right in dismissing the appellants' claim and accordingly we dismissed the appeal.

Sd. Wee Chong Jin  
 .....  
 WEE CHONG JIN, C.J.

Sd. F. A. Chua  
 .....  
 CHUA, J.

40

In the Court  
of Appeal of  
Singapore

—  
 No.53

Grounds of  
Judgment

25th March  
1974

(continued)

In the Court  
of Appeal of  
Singapore

Sd. T. Kulasekaram  
.....  
KULASEKARAM, J.

No.53

Grounds of  
Judgment

25th March  
1974

(continued)

Dated this 25th day of March, 1974.

Certified true copy.  
Sd. Kwek Chip Leng  
Private Secretary to Judge  
Court No.2  
Supreme Court, Singapore.



# 南洋商報 愛齒牙刷 A

年半月保 造製工精 料原佳最  
1961.3.6.

**№8**  
刷牙年少

用適歲四至歲一十

**№16**  
刷牙童兒

用適歲六至歲三

**№10**  
刷牙童中

用適歲十至歲七

有到  
售處

# 南洋商報 愛齒牙刷 A

年半月保 造製工精 料原佳最  
1961.3.11.  
1961.2.11.  
1961.2.18.

**№8**  
刷牙年少

用適歲四至歲一十

**№16**  
刷牙童兒

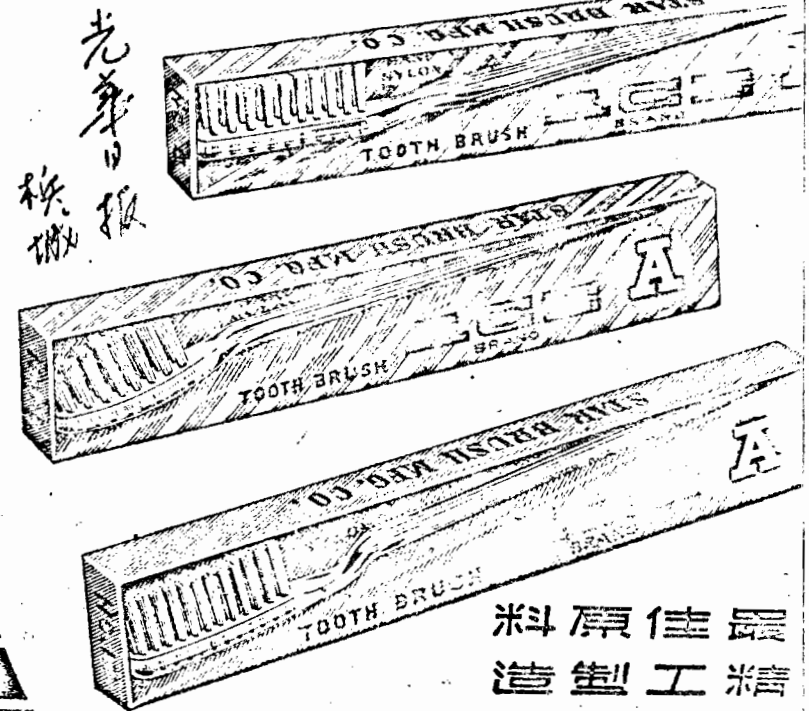
用適歲六至歲三

**№10**  
刷牙童中

用適歲十至歲七

有到  
售處

# 紅 A 牌 愛齒牙刷



光華日報  
秋報

料原佳最  
造製工精  
年半月保  
售有到

Exhibits

P 26

Newspaper cutting from Nanyang Siang Pau

18th March 1961

1.26  
102-71  
1-6-71

P26 Newspaper cutting from  
Nunyang Siang Pau

P 26

Exhibits

P 26

Newspaper  
cutting from  
Nunyang Siang  
Pau

18th March  
1961  
(continued)

11.7.60 1961 熱耐 碎不

# 盆面膠塑

佳最質品

齊最碼尺

N9750  
11吋口徑



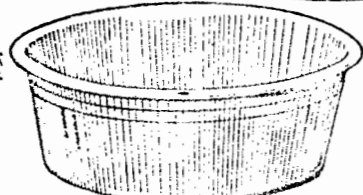
N9752  
12吋口徑



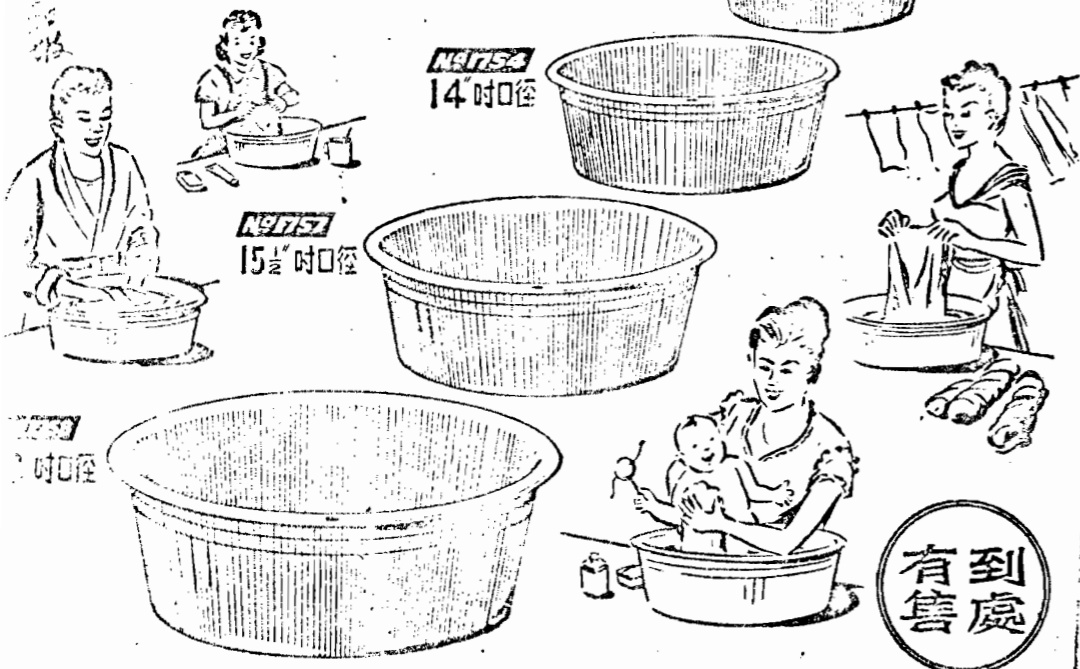
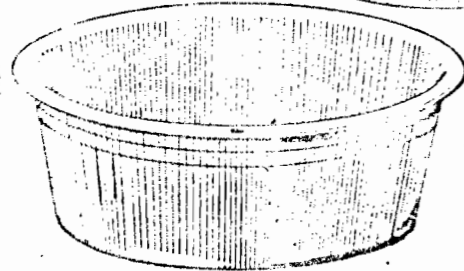
N9754  
14吋口徑



N9757  
15吋口徑



N9759  
18吋口徑



有到  
售處

品云 司公業實光星

17.3.65  
1961.3.15

熱耐 碎不

# 盆面膠塑

佳最質品

齊最碼尺

N9750  
11吋口徑



N9752  
12吋口徑



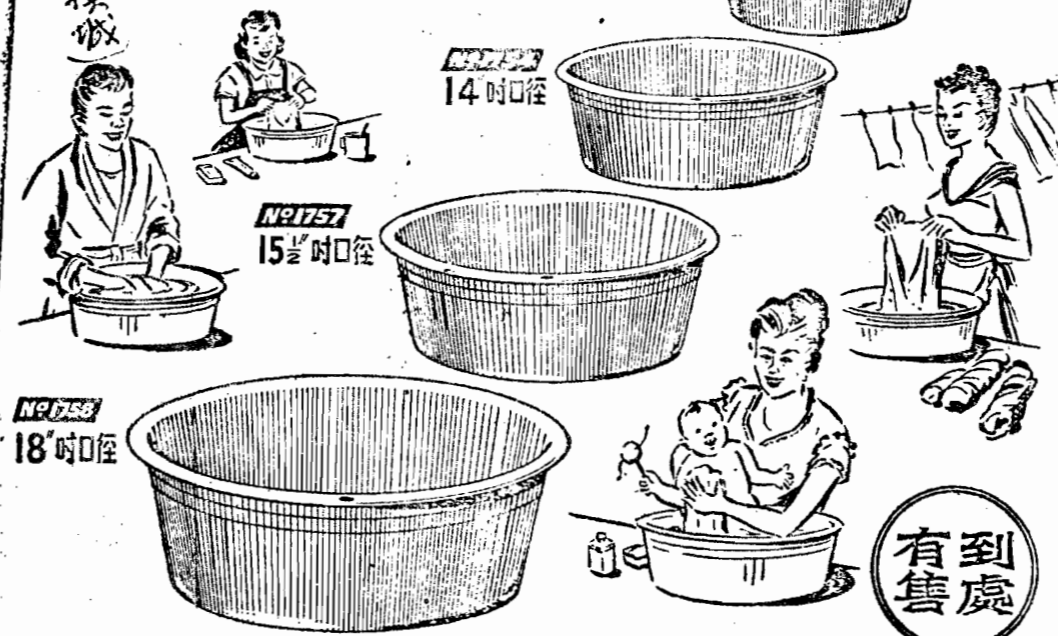
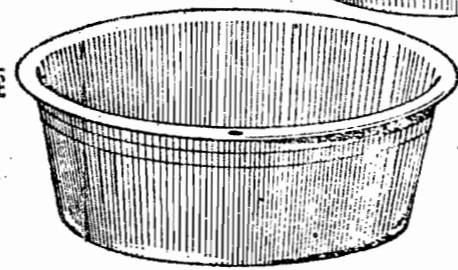
N9754  
14吋口徑



N9757  
15吋口徑



N9759  
18吋口徑



有到  
售處

品云 司公業實光星

P3 Certificate of Registration

018 600011  
444-000-0000

SUPREME COURT.  
SINGAPORE.  
EXHIBIT P. 3  
in S. 102-71  
Date 20.6.72 Registrar.

Page No. 220

Class 21

File No. 892 of 1961

Exhibits

P3

Certificate of Registration

7th October 1961

REGISTER OF TRADE MARKS.  
HONG KONG

Trade Mark No. 707 of 1963 registered in Class 21  
on the 7th day of October, 1961.

I hereby certify that this is a true copy of the registration entry in the Register.



Goods covered by registration } all kinds of brushes including tooth brushes.

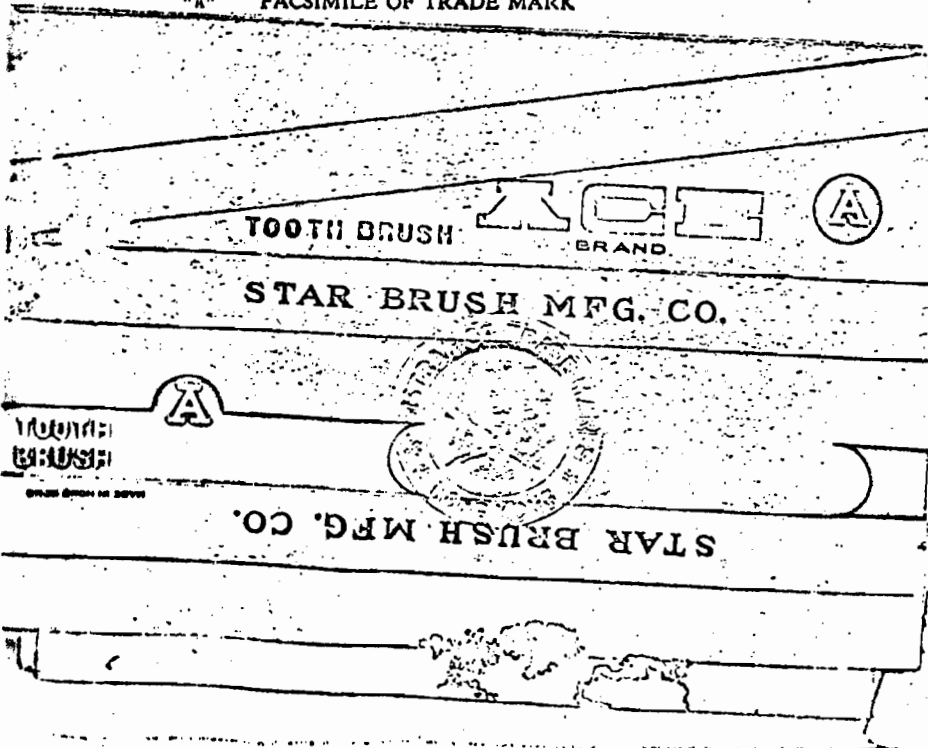
*E. R. Maycock*  
E. R. MAYCOCK  
p. Registrar General  
(Registrar of Trade Marks)  
8.4.70.

Name and Address of Proprietor } STAR BRUSH MANUFACTURING COMPANY, of Shaukiwan Inland Lot No. 542, Nam On Street, Victoria in the Colony of Hong Kong.

This certified copy is issued for use other than in legal proceedings or in obtaining registration abroad.

*E. R. Maycock*  
E. R. MAYCOCK  
Assistant Registrar  
p. Registrar General  
(Registrar of Trade Marks)  
15. 7. 63.

"A" FACSIMILE OF TRADE MARK



P 3

Notifications of Assignment and transmission, disclaimers, conditions, limitations, renewals, associated trade marks and such other matters relating to such trade mark are to be entered below:—

Exhibits

P3

Certificate of Registration

7th October 1961

This Trade Mark is associated with Trade Marks Nos. 401 of 1953, B306 of 1961 and 708 of 1963.

Registration of this Trade Mark shall give no right to the exclusive use of the letter "A".

This Trade Mark is limited to the colours red, silver and black as shown on the specimen mark affixed hereto.

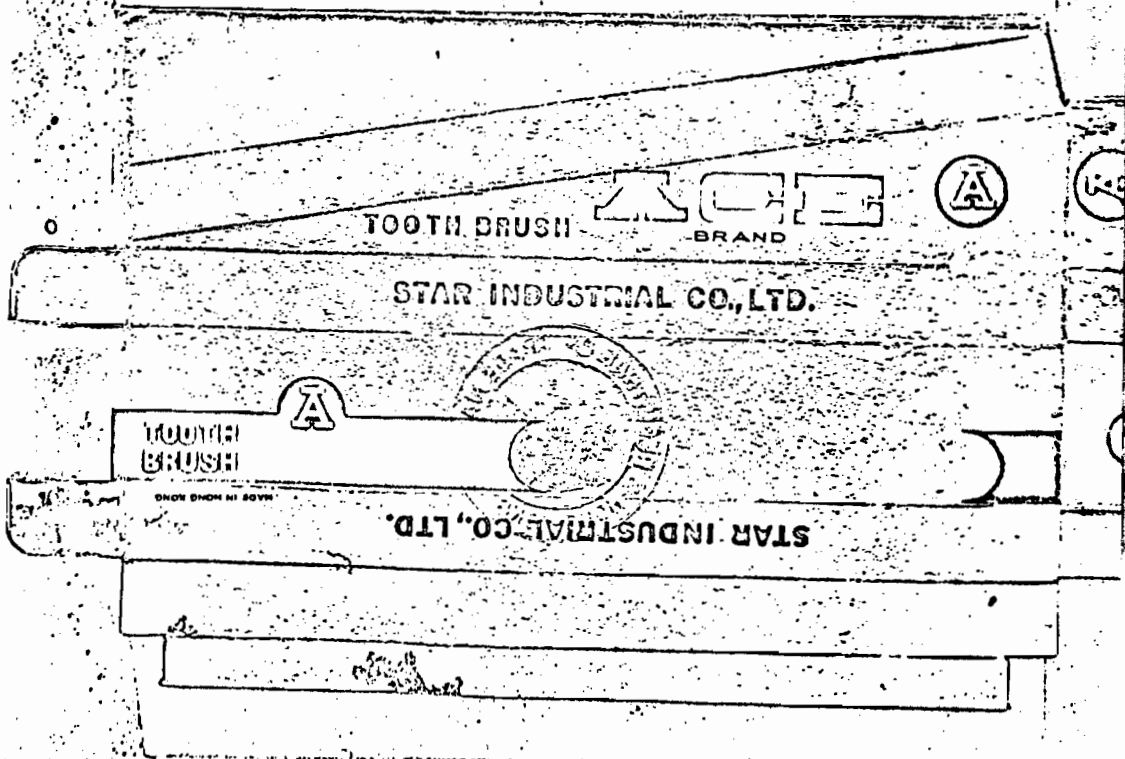
It is a condition of registration that this Trade Mark shall be used only on goods made in Hong Kong.

STAR INDUSTRIAL COMPANY LIMITED whose registered office is situate at No.25, Tai Yau Street, San Po Kong, Kowloon, Hong Kong, registered as subsequent proprietors on 5th November, 1968 by virtue of a Deed of Assignment dated 14th October, 1968. (File No.892/61).

*B.C. Wong*  
(Miss) B.C. WONG  
p. Registrar of Trade Marks.  
5. 11. 68.

Renewed for 14 years  
from 7.11.68

*[Signature]*  
22 NOV 1968



Page No.  
Class 21  
File No.  
892 of 1961

Exhibits  
—  
P 3  
Certificate  
of  
Registration  
7th October  
1961  
(continued)

REGISTER OF TRADE MARKS  
HONG KONG

Trade Mark No. 707 of 1963 registered in Class 21  
on the 7th day of October, 1961.

---

10

Goods covered ) all kinds of brushes including  
by registration) tooth brushes.

---

FACSIMILE OF TRADE MARK

Mark "B" substituted for Mark "A" under the  
provisions of Section 51 of the Trade Marks  
Ordinance. (File 892 of 1961)

This Trade Mark is associated with Trade Marks  
Nos. B306 of 1961 and 708 of 1963.

Registration of this Trade Mark shall give  
no right to the exclusive use of the letter "A".

20

This Trade Mark is limited to the colours  
red, silver and black as shown on the specimen  
mark affixed hereto.

It is a condition of registration that this  
Trade Mark shall be used only on goods made in  
Hong Kong.

Sgd. E. R. Maycock

E.R. MAYCOCK  
p. Registrar General  
(Registrar of Trade Marks)  
14.3.69

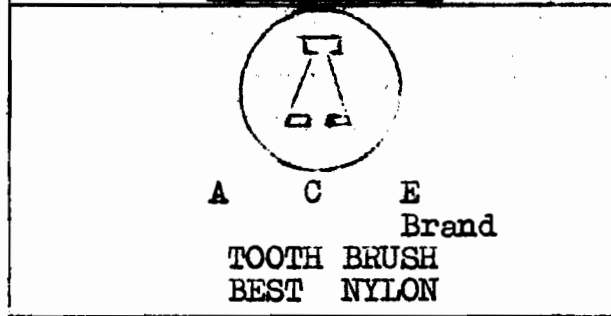
Exhibits

AB 2

Certificate  
of  
Registration

AB 2  
Certificate No. M.46287 issued to Defendant under  
Section 39 of Trade Marks Ordinance, 1950  
(Official Issue)

S T A T E S O F M A L A Y A  
CERTIFICATE ISSUED UNDER SECTION 39 AND RULE  
58 OF THE TRADE MARKS ORDINANCE, 1960



No. M/46287

10

To: Yap Kwee Kor trading as Sin Fatt Trading Co.

I HEREBY CERTIFY that under the provisions of the Trade Marks Ordinance, 1950, your name has been entered in Part A of the Register as proprietor of the above numbered Trade Mark as from the 6th August, 1966, in Class 21 in respect of the following goods, Nylon tooth brush.

A representation of the Mark is affixed hereto.

STAMP  
of  
States  
of  
Malaya  
TRADE MARKS REGISTRY  
STATES OF MALAYA,  
KUALA LUMPUR.

20

Sd: Illegible  
.....  
Registrar

Registration is for a period of 7 years and may be renewed at the expiration of this period and upon the expiration of each succeeding period of 14 years.

Lim Seng Huat (Singapore) Limited  
to Plaintiffs

林信發(新加坡)有限公司  
LIM SENG HUAT (SINGAPORE) LIMITED

INCORPORATED IN MALAYA LIMITED  
NO. 22, CROSS STREET, SINGAPORE  
MALAYSIA  
NO. 2, G. CHUAN STREET, PENANG,  
MALAYSIA  
HONG-KONG OFFICE  
NO. 21, BURNING STREET, EAST, HONGKONG.

INCORPORATED IN SINGAPORE  
IMPORTERS & EXPORTERS  
MANUFACTURERS' REPRESENTATIVES

CABLE ADDRESS: "LEADING" SINGAPORE.  
TELEPHONE NOS. 24925, 24926, 24927.  
P. O. BOX NO. 1131  
Nos. 12 & 13, Circular Road,  
SINGAPORE. 1.

Exhibits

AB3

Lim Seng Huat  
(Singapore)  
Limited to  
Plaintiffs  
21st March  
1968

我公司最近獲悉我地某商號以“紅A”之商標出產牙刷，從這商標看來顯係影射貴公司所出產之紅A牙刷，未知貴公司所經營之紅A牙刷在我地及馬來西亞各地方有商標註冊否？茲隨函奉送我地所出產之紅A牌牙刷實樣壹支供貴公司研究參考；希查收，專此奉達 請洽照為荷。//

此致

星光實業有限公司

*left in exhibit behind my seat.*  
*25/3/68*

林信發(新加坡)有限公司  
LIM SENG HUAT (S) LTD.

*[Signature]*  
Director.

一九六八年三月廿一日

*25/3/1968*

*[Signature]*  
*25/3/68*

TRANSLATION OF THE ABOVE

To: Star Industrial Co., Ltd.

My company has recently learned that a certain trading firm here is producing tooth-brush under the trade mark of Red A. Looking at this trade mark, it is evident that it is a passing-off of the Red A tooth-brush produced by your company. It is not known whether or not the Red A tooth-brush produced and marketed by your company has had a trade mark registration in Singapore and various parts of Malaysia. Enclosed herewith we are forwarding to you an actual sample of the locally produced Red A brand tooth-brush for your study and reference.

LIM SENG HUAT (S) LTD.

Exhibit AB 4/5

Letter, Plaintiffs to Lim Teck Lee  
Company Limited and Lim Seng Huat  
(Singapore) Limited

Exhibits  
AB4/5

Letter,  
Plaintiffs to  
Lim Teck Lee  
Company  
Limited and  
Lim Seng Huat  
(Singapore)  
Limited

PRIVATE AND CONFIDENTIAL

22nd August, 1968

22nd August  
1968

M/s. Lim Teck Lee Co. Ltd. of  
Singapore & Lim Seng Huat (Singapore) Ltd.,  
2-5 Circular Road,  
SINGAPORE.

10

For the Attention of: Messrs. Richard Lim  
Kee Ming & Lim Tow Yong

Dear Sirs,

Further to our letter of 13th June, 1968 and  
the subsequent long-distance telephonic conversa-  
tion between Messrs. Richard Lim Kee Ming and  
J.H. Leung on 19th August, 1968 amendments to  
point No. 4 have duly been made as requested. The  
following are therefore the terms and conditions  
for the joint venture between you and the Star  
Industrial Co. Ltd. of Hong Kong in their final  
form and are to supersede those contained in our  
letter of 13th June, 1968:-

20

1. Name of the new company to be incorpor-  
ated in Singapore - Star Plastics  
Industrial Co. (Private) Limited.
2. Main object of new company - operation  
of factories in Jurong and Singapore for  
the manufacturing and sales of plastic  
products.

30



Exhibits

AB 4/5

Letter,  
Plaintiffs to  
Lim Teck Lee  
Company  
Limited and  
Lim Seng Huat  
(Singapore)  
Limited

22nd August  
1968

(continued)

3. Capital:

- (a) Star Industrial Co. Ltd. of Hong Kong or its nominees (to be referred to as the Hong Kong Group) shall hold 50% of the shares of the new company.
- (b) Lim Teck Lee Co. Ltd. of Singapore and Lim Seng Huat (Singapore) Ltd. or their respective nominees (to be referred to as the Singapore Group) shall together hold 50% of the shares of the new company.
- (c) Capital exceeding paid-up capital to be covered by credits extended by material suppliers and banking facilities.

10

4. The Hong Kong Group and Singapore Group will jointly be responsible for the management and operation of the new company.

5. The decision to promote business or to set up a manufacturing plant into the district of Malaysia will be at the discretion of the new company.

20

6. Engagement of all staff will be made according to qualifications with regards to requirements.

Exhibits

AB4/5

Letter,  
Plaintiffs to  
Lim Teck Lee  
Company  
Limited and  
Lim Seng Huat  
(Singapore)  
Limited

22nd August  
1968

(continued)

7. The new company will maintain a minimum of 20 sets of moulds to be purchased from the Star Industrial Co. Ltd. of Hong Kong for production of popular items.
8. The transfer or sale of shares of the new company to a third party and the decision to take in new share-holders by means of increase of the capital of the new company shall be subject to the mutual consent of the Hong Kong Group and Singapore Group.
9. Upon the incorporation of the new company, the new company shall enter into a formal agreement with the Star Industrial Co. Ltd. of Hong Kong in which the following terms and conditions will be incorporated:-
- (a) The new company will be allowed to use the Red "A" trade mark in Singapore and other markets free of rent or royalties for the period of 10 years with priority for renewal but permission to use other registered brand names either belonging to Star Industrial Co. Ltd. of Hong Kong or to be created by the new company will be subject to future decision.
- (b) Star Industrial Company Limited of Hong Kong will render full technical assistance

10

20

Exhibits

AB 4/5

and support to the new company including providing moulds required for production on loan basis.

Letter,  
Plaintiffs to  
Lim Teck Lee  
Company  
Limited and  
Lim Seng Huat  
(Singapore)  
Limited

(c) At the request and costs of the new company, Star Industrial Company Limited of Hong Kong will have new moulds made for the new company according to instructions and specifications given by the new company.

22nd August  
1968

(d) The new company shall pay the Star Industrial Company Limited of Hong Kong as remuneration for the use of the said moulds and for all technical assistance as aforesaid at the following rates:-

10

(continued)

(i) 3% on the total monthly sales of the new company.

Should you find the above terms agreeable to you kindly confirm your consent by signing and returning a copy of this letter as a preliminary agreement for proceeding with the said joint venture.

20

Yours faithfully,  
STAR INDUSTRIAL CO. LTD.,

Sd. J. H. Leung,

Chairman of the Board,  
& General Manager.

We confirm the above

Sd. Illegible  
.....

Lim Teck Lee Co. Ltd. of S'pore.  
& Lim Seng Huat (Singapore) Ltd.

30

c.c. Mr. Tan Choon Chye, Singapore.  
M/s. Woo & Kwan Solicitors,  
Hong Kong.

Agreement between Respondent and  
Singapore General Merchandise Joint  
Venture Pte. Ltd.

Exhibits  
AB 6  
Agreement

# NEW STAR INDUSTRIAL CO.

新星工业公司

TOOTHBRUSH MANUFACTURER

牙刷製造商

BRANDS: "FOUR STAR" "AGU" "SUN" "SELAMAT PAU"

8, JALAN KESEMBI,  
OFF 11-1 M.S. WOODLANDS ROAD,  
SINGAPORE, 23.  
TELEPHONE: 692403

Your Ref:

Our Ref:

Date: 24-9-1968

### 訂合約試銷牙刷三個月辦法如下

1. NO. 12 A AGE 牙刷 24 萬枝 NO. 13 SUN 牙刷 24 萬枝
2. 以上之款式之牙刷 訂明之月銷額最低 240 萬
3. 訂明之月銷額在 240 萬之內者 折扣及個數
4. 月銷額超過 240 萬者 即以此之數額 加 2% 已作為
5. 將大獎金。
6. 廠方保證在借在試銷期內 不得散售 經發現者 亦
7. 神信損失予試銷者。
8. 試銷期為三個月 由 1968 年 10 月 1 日 起 雙方如再
9. 續約 應先在三個月內通知 多件者再洽議。
10. NO. 12 A AGE 牙刷 NO. 13 SUN 牙刷 裝裝各合一 共 60 打 裝一 下 昂
11. 此即是若 5 力 此 不 補。

廠方代表簽

NEW STAR INDUSTRIAL CO.  
SINGAPORE

新星工业公司  
總經理 王通德 簽

General Time Provision

A 5000... of the High Court

AB 7 - Translation of AB 6

Exhibits

AB7Translation  
of AB6

Agreement to sell toothbrush on three-month probation on the following conditions:-

1. No.12 Red A AGE toothbrush at \$28/- per gross. No.12 Red S Sun toothbrush at \$26/- per gross, each brush to be packed in silver paper case.
2. The minimum amount of sales of the above two types of toothbrush shall be 240 gross per month.
- 10 3. It is agreed that (the purchase) shall be in cash. No discount or commission shall be given if the sales fall below the amount of 240 gross per month.
4. 2% on the amount exceeding 240 gross monthly shall be given as reward.
5. The Factory guarantee that during the probation period no retail (of the toothbrush) shall be dealt by the Factory, compensation of damages shall be awarded to the person put on probation if in breach of contract.
- 20 6. The probation period shall be three months commencing from 1st October 1968 to 31st December 1968. The parties if desirous of continuing the agreement shall give one month's notice to the other upon terms to be agreed.
7. Each packet of the No.12 Red A Age and No.12 Red S Sun shall contain 12 (toothbrushes), 60 dozen in one big case - 5 gross. There shall be no wooden boxes.

Sd. by the Factory Representative: Yap Kwi Koh

30 Sd. by the representative of the Singapore  
General Merchandise Joint Venture Pte. Ltd.  
Chng Peng Soon.

Made this 24th day of September, 1968.

Certified True Translation

Sd. Illegible

A Sworn Interpreter of the High Court,  
Singapore.

Exhibits

P.11P 11

Application  
for registra-  
tion of  
registered  
user

9th December  
1969

THE TRADE MARKS ORDINANCEAPPLICATION FOR REGISTRATION OF  
REGISTERED USER

APPLICATION is hereby made by STAR INDUSTRIAL COMPANY LIMITED, a Company incorporated in Hong Kong, of No. 25 Tai Yau Street, San Po Kong, Kowloon Hong Kong, Manufacturers and Merchants, who are the Applicants for registration of the following trade marks:-

- (a) Red "A" Brand filed in class 21 in respect of Combs, soap boxes, coat hangers, cups, bowls, saucers, powder containers, butter containers, bottles, basins, fruit trays and chopsticks (all pastic) and all kinds of brushes including tooth brushes.
- (b) Red "A" Brand filed in Class 11 in respect of Lamp Shades, chandeliers, light fittings.
- (c) Ace Brand Label filed in class 21 in respect of Brushes of all kinds.
- (d) Ace Brand Label (striped) filed in class 21 in respect of Brushes of all kinds.

that STAR PLASTICS INDUSTRIAL COMPANY (PTE.) LIMITED, a Company incorporated in the Republic of Singapore of Lot 7, Section 4, Lorong Tukang Tiga, Jurong Industrial Estate, Jurong, Singapore 22, Manufacturers and Merchants who hereby joint in the application may be registered as Registered Users of the said trade mark in respect of the goods covered by the registrations subject to the following conditions or restrictions:-

- (1) The Users shall manufacture the said products in strict accordance with the standards of quality specifications, directions and information prescribed given or approved from time to time in writing by or on behalf of the Proprietors and not to use the said trade marks except in relation to the said products so manufactured.

10

20

30

40

(2) The Users shall permit the Proprietors or its authorised representative at all reasonable times to enter the premises of the Users for the purpose of inspecting the said products to which the said trade marks are applied or intended to be applied and the method of manufacturing same and the Users will from time to time at the request of the Proprietors submit samples of the said product and/or the materials for manufacturing packing and labelling the same for the inspection and approval of the Proprietors or such persons or companies as the Proprietors may appoint for such purpose.

Exhibits

P 11

Application for registration of registered user

9th December 1969

(continued)

(3) The Users shall use the trade marks in such manner as to avoid confusion among or deception to the public with regard to the origin of the goods concerned and the Users undertake not to jeopardize the rights in the said trade marks by improper use of the said trade marks or by non-use of the said trade marks.

(4) The User shall not be the sole Users of the said trade marks in respect of the said goods.

(5) The proposed permitted use is to be for a period of ten years from the date of the issuance of Registration Certificate.

Dated this 9th day of December, 1969.

STAR INDUSTRIAL COMPANY LIMITED,  
By their Attorneys,

To, Sgd. Drew & Napier  
The Registrar of Trade  
Marks, STAR PLASTICS INDUSTRIAL COMPANY  
Singapore. (PTE) LIMITED,

Sgd. Drew & Napier

SUPREME COURT  
SINGAPORE.

EXHIBIT P 11

in S. 102-71 Sd. Illegible

Date 20.6.72 Registrar.

10

20

30

Exhibits

P 14 - Statutory Declaration

P 14

THE TRADE MARKS ORDINANCEStatutory  
Declaration23rd December  
1969IN THE MATTER of trade marks  
Red "A" and Ace Brand Labels  
in the Republic of Singapore  
of M/s. STAR INDUSTRIAL  
COMPANY LIMITED.STATUTORY DECLARATION AND STATEMENT OF CASE

I, J.H. LEUNG residing at No.138 Waterloo Road, Kowloon, Hong Kong do hereby solemnly and sincerely declare as follows:- 10

1. I am the Managing Director of STAR INDUSTRIAL COMPANY LIMITED, a Company incorporated in Hong Kong, of No.25, Tai Yau Street, San Po Kong, Kowloon, Hongkong, Manufacturers and Merchants (hereinafter called "the Proprietors") and I am duly authorised to make this declaration on behalf of the Proprietors.

2. The Proprietors propose that STAR PLASTICS INDUSTRIAL COMPANY (PTE) LIMITED, a Company incorporated in the Republic of Singapore, of Lot 7, Section 4, Lorong Tukang Tiga, Jurong Industrial Estate, Jurong, Singapore, Manufacturers and Merchants, (hereinafter called "the Users") may be registered as a Registered User of the trade marks as shown below:- 20

- (a) Red "A" Brand filed in Class 21 in respect of Combs, soap boxes, coat hangers, cups, bowls, saucers, powder containers, butter containers, bottles, basins, fruit trays and chopsticks (all plastic) and all kinds of brushes including brushes. 30
- (b) Red "A" Brand filed in Class 11 in respect of Lamp Shades, chandeliers, light fittings.
- (c) Ace Brand Label filed in Class 21 in respect of Brushes of all kinds.
- (d) Ace Brand Label (striped) filed in Class 21 in respect of Brushes of all kinds.

3. The Users shall manufacture the said products in strict accordance with the standards of quality specifications, directions, and information 40



prescribed given or approved from time to time in writing by or on behalf of the Proprietors and not to use the said trade mark except in relation to the said product so manufactured.

Exhibits

P 14

Statutory Declaration

23rd December 1969

(continued)

10

4. The Users shall permit the Proprietors or its authorised representative at all reasonable times to enter the premises of the Users for the purpose of inspecting the said products to which the said trade marks are applied or intended to be applied and the method of manufacturing same and the Users will from time to time at the request of the Proprietors submit samples of the said product and/or materials for manufacturing packing and labelling the same for the inspection and approval of the Proprietors or such persons or companies as the Proprietors may appoint for such purpose.

20

5. The Users shall use the trade mark in such manner as to avoid confusion among or deception to the public with regard to the origin of the goods concerned and the Users undertake not to jeopardize the rights in the said trade mark by improper use of the said trade mark or by non-use of the said trade mark.

6. The Users shall not be the sole Users of the said trade marks in respect of the said goods.

7. The proposed permitted use is to be for a period of ten years from date of issuance of Registration Certificate.

30

AND I MAKE this solemn declaration conscientiously believing the same to be true and by virtue of the Statutory Declaration Ordinance.

DECLARED at Rm.1724 Prince's Building, Victoria, HongKong this 23rd day of December,1969.) ) STAR INDUSTRIAL COMPANY, LIMITED Sd. J.H. Leung Managing Director.

Before me, Sd. Woo Po Shing NOTARY PUBLIC Hong Kong.

SUPREME COURT SINGAPORE EXHIBIT P 14 in S.102-71 Sd.Illegible Date 20/6/72 Registrar

40

Total: Five Declarations Each for each territory, namely, Singapore, Malaya, Sabah, Sarawak and Brunei.

Exhibits

AB 9/10

Letter,  
Plaintiffs'  
Solicitors to  
Defendant

2nd February  
1971

AB 9 - Letter, Plaintiffs'  
Solicitors to Defendant

DREW & NAPIER

2nd February, 1971

Our Ref: MS/AF/TM 773-70

Yap Kwee Kor t/a New Star  
Industrial Co.,  
307-A, Block 1, Jalan  
Bukit Merah,  
Redhill Flatted Factory,  
Singapore 3.

10

Dear Sirs,

Re: Proposed Rectification  
Proceedings against your  
Registration No. 39808 in Class 21

1. We act for Star Industrial Co. Ltd., who are the common law proprietors of the Trade Mark ACE which has been used by them on tooth brushes in Singapore since 1956.

2. Our clients have applied for registration of their ACE Trade Mark in Class 21 in Singapore under Nos. S/47884 and S/47885 but these applications have been objected to by the Registrar of Trade Marks on the grounds of conflict with your Registration No. 39808 also covering tooth brushes.

20

3. The Registrar has held the view that the Trade Marks ACE and AGE are confusingly similar and therefore cannot be registered side by side.

4. Our clients have made investigations on your use of the Trade Mark AGE and we find that your tooth brushes under the AGE Trade Mark have been packed with a get-up and design which is confusingly similar to our clients' ACE Trade Mark.

30

5. Our clients and ourselves hold the view that the particular get-up of your AGE tooth brushes is bound to lead to confusion and deception arising to the trade and public having regard to our clients' prior use of the get-up and packing

of their ACE tooth brushes.

6. Our clients have been using the particular get-up and design of their ACE tooth brushes since 1956 and therefore have acquired prior common law rights to the Trade Mark and get-up of their tooth brushes.

7. The purpose of this letter is to enquire whether:-

- 10
- (a) You would be prepared to cancel your Registration No. 39808 voluntarily.
  - (b) Cease the further manufacture of AGE tooth brushes.
  - (c) Cease the use of the particular get-up and design adopted by our clients for their ACE tooth brushes.

8. We have instructions from our clients to commence separately against you the following proceedings:-

- 20
- (a) Rectification of the Register of your Trade Mark No. 39808.
  - (b) Passing-off proceedings against you at common law for the unlawful use and adoption of a get-up and design of our clients' ACE tooth brushes.

30

9. Unless you are prepared to comply with our demands herein within seven days of the date of this letter we regret proceedings will be initiated for the cancellation of your Registration as well as for an Injunction to restrain you from passing-off your tooth brushes as and for the tooth brushes of our clients.

Yours faithfully,

Sd. Drew & Napier

c.c. The Registrar of Trade Marks,  
Singapore.

c.c. Clients

Exhibits

AB 9/10

Letter,  
Plaintiffs'  
Solicitors to  
Defendant

2nd February  
1971

(continued)

Exhibits

AB 11 - Letter, Defendants' Solicitors  
to Plaintiffs' Solicitors

AB 11

Letter,  
Defendants  
Solicitors to  
Plaintiffs'  
Solicitors  
10th February  
1971

L.A.J. SMITH  
YOUR REF: MS/AF/TM773-70  
OUR REF: LAJS/BL/313/71

February 10, 1971.

Messrs. Drew & Napier,  
Singapore.

Dear Sirs,

re: Proposed Rectification Proceedings 10  
against Yap Kwee Kor t/a New Star  
Industrial Co.'s Registration  
No. 39808 in Class 21

Your letter of the 2nd February, 1971,  
addressed to Yap Kwee Kor t/a New Star Industrial  
Co. has been handed to us with instructions to  
reply thereto.

There appears to be no real possibility of 20  
confusion in the two Trade Marks "Ace" and "Age" in  
spite of the Registrar's views. The Registrar's  
refusal of your clients' "Ace" Trade Mark could  
perhaps be got over by our clients consenting to  
your clients' application.

Our clients have no objection to your clients'  
use of the "Ace" mark.

Get-Up - There appears to be no confusion as a 30  
result of the get up but as your clients have only  
recently commenced production in Singapore, they  
might consider that their interests are best served  
by modifying their get up to be distinguishable  
from my clients' get up which has now been on the  
market for some five years. There apparently has  
been no instance of confusion.

My clients are prepared to modify their get-  
up and perhaps our clients could make some mutual  
arrangements.

Our client has suggested that the two letters  
"A" of his pack could be altered to "AGE".

Perhaps you will be good enough to let us 40  
hear from you.

Yours faithfully,  
Sd. L.A.J. SMITH

c.c. Clients

AB 12 - Letter, Plaintiffs' Solicitors  
to Defendant's Solicitors

Exhibits

AB 12

DREW & NAPIER

Our Ref: MS/AF/TM 773-70

Your Ref: LAJS/BL/313/71

15th February, 1971

Letter,  
Plaintiffs'  
Solicitors to  
Defendant's  
Solicitors

15th February  
1971

Mr. L.A.J. Smith,  
18-H, Battery Road,  
Singapore 1.

10 Dear Sir,

Re: Proposed Rectification Proceedings  
against Yap Kwee Kor t/a New Star  
Industrial Co.  
Registration No. 39808 in Class 21

1. We thank you for your letter of the 10th  
February, 1971.

20 2. We do not agree with your observation that  
there is no likelihood of confusion between ACE and  
AGE and we are doubtful if the Registrar would be  
prepared to proceed with our clients' application  
on consent.

3. You will bear in mind that the public interest  
is of paramount importance and we hold the view  
that the sale of ACE and AGE side by side is not  
conducive to the public interest having regard to  
the close similarity between the get-up of the two  
products.

30 4. We have obtained evidence of five instances of  
confusion when in response to an order for ACE  
tooth brushes AGE tooth brushes were supplied.

5. We have already commenced rectification  
proceedings in the High Court and enquire if you  
have instructions to accept service of proceedings.

Yours faithfully,

Sd. Drew & Napier

c.c. Clients.

## Exhibits

P 7 - List of Shareholders

P 7  
List of  
Shareholders

List of persons holding shares in STAR PLASTICS INDUSTRIAL COMPANY (PTE.) LIMITED on the 31st day of January 1972 (being the date of the return or other authorised date) and an account of the shares so held.

Folio in Register Ledger Containing Particulars	Names	Addresses	Number of shares held by existing members	
6	STAR INDUSTRIAL CO. LTD.	25, Tai Yau Street, Sam Po Kong, Kowloon, Hongkong.	168,000	
6	LEUNG JHI HUNG	138, Waterloo Rd. Kowloon, Hongkong	216,000	
7	KUO HSIEN LEUNG (MRS.)	138, Waterloo Rd., Kowloon, Hongkong.	72,000	
7	HUAI CHU LIANG (MDM.)	Kam Fai Mansion, Blk. B., 5th Fl., 684, Macdonnell Road, Hongkong.	72,000	20
8	LILIA TONGSON (MRS.)	Dragon View, Flat C2, 39-41, Macdonnell Road, Hongkong.	48,000	
8	KENNETH TUHUNG TONGSON	Dragon View, Flat C2, 39-41 Macdonnell Road, Hong Kong	24,000	
9	LIM KEE MING	2-5 Circular Rd. S'pore, 1.	10,000	30
9	LIM KEE CHIN	- do -	10,000	
10	LIM KEE HOCK	- do -	10,000	
10	LIM KEE SIANG	- do -	10,000	
11	CHING PENG SOON	40, Tiverton Lane, S'pore.	10,000	
11	FOONG WENG CHEONG	3, Hale Street, Ipoh	60,000	
12	LIM TECK LEE & CO. LTD.	2-5 Circular Rd. S'pore. 1.	250,000	

Folio in Register Ledger Containing Particulars	Names	Addresses	Number of shares held by existing members	Exhibits P 7 List of Shareholders (continued)
12	JAP I SOE	11, Happy Avenue, S'pore. 13.	120,000	
13	FALCON ENTERPRISES (PTE.) LTD.	32-B, South Bridge Road, S'pore. 1.	120,000	
			1,200,000	

Signature: Sd. Illegible  
.....

SUPREME COURT  
SINGAPORE.

EXHIBIT P 7  
in S.102-71 Sd. Illegible  
Date 20/6/72 Registrar.

AB 18

Letter, Plaintiffs' Solicitors to  
Defendant's Solicitors

DREW & NAPIER

ACF/CYT/TM 773A-70  
Your Ref: LAJS/EAM/313/71

25th May 1972

Mr. L.A.J. Smith,  
SINGAPORE.

Dear Sir,

Suit No. 102 of 1971.  
Originating Motion No.2 of 1972  
Star Industrial Co. Ltd. v.  
Yap Kwee Kor t/a New Star  
Industrial Co.

We have to give you notice that at approxi-  
mately 3 p.m. on Thursday 25th May our clerk  
Mr. Clement Tan purchased from Messrs. Guan Moh Chan

AB 18

Letter,  
Plaintiffs'  
Solicitors  
to  
Defendant's  
Solicitors  
25th May  
1972

Exhibits  
—  
AB 18  
Letter,  
Plaintiffs'  
Solicitors to  
Defendant's  
Solicitors  
25th May  
1972  
(continued)

of 110 East Coast Road, Singapore, a toothbrush by exhibiting to the assistant in the shop a male Chinese, one genuine ACE Red A toothbrush in its packet and requested to be supplied with one toothbrush of the same make. In response to this request the said shop assistant supplied one AGE toothbrush of the manufacture or merchandise of your clients New Star Industrial Co. for which our Clerk paid the sum of thirty cents.

Yours faithfully, 10

Sd. Drew & Napier

c.c. clients.

P 28  
Declaration  
of Woo Po  
Shing  
Notary Public  
19th July  
1972

P 28 - Declaration of Woo Po Shing  
Notary Public

TO ALL TO WHOM THESE PRESENTS SHALL COME:

I, WOO PO SHING  
NOTARY PUBLIC

duly admitted, authorised and sworn, practising at Victoria in the Colony of Hong Kong DO HEREBY CERTIFY that I have this day examined the Paper Writing hereto annexed and FURTHER CERTIFY that the same is a true photostat copy of the Business Registration Certificate No. 015889 of the Star Brush Mfg. Co. alias "Star Industrial Co." of the Colony of Hong Kong extracted from the record of the Business Registration Office of Hong Kong.

20

IN TESTIMONY whereof I have hereunto subscribed my name and affixed my Seal of Office this 19th day of July One thousand nine hundred and seventy two.

30

Sd. Woo Po Shing  
Notary Public  
Hong Kong.

SUPREME COURT  
SINGAPORE.  
EXHIBIT P 28  
in Suit 102-71  
Date 2/10/72

Stamp of Hong Kong

₹3.00

40

Sd. Illegible  
Registrar.



THE BUSINESS REGULATION RULES, 1952.  
THE BUSINESS REGULATION RULES, 1952. (Rule 2).

015829

FORM (a).

Application by an individual for registration of business(es) carried on by him in the Colony.

Exhibits

P 28

SECTION A

20 JUN 1972

Official Stamp  
Commissioner of Inland Revenue  
(NG/Kui-Keung)

Pursuant to the provisions of the Business Regulation Ordinance, I certify that the particulars set out below are true and contain a complete record of all businesses carried on by me in the Colony and that I have no partners in any of the said businesses.

- (a) Name and all aliases.....Mr. Leung Jhi Eun. or J. M. Leung.....
- (b) Identity Card Serial Number.....503666.....
- (c) Residential address.....57 Kwai Lun Street, 1st floor, Kowloon.....
- (d) Business carried on.....

- (1) (a) Name in which carried on.....~~Star Brush Mfg. Co.~~ *Star Industrial Co*
- (b) Address.....~~514 No. 542, Nam On St., Shekwan, HK.~~
- (c) Description and nature of business.....Manufacturers of Brushes, General Importers & Exporters & Wholesalers
- (d) Date commenced.....March 16, 1959

- (2) (a) Name in which carried on.....~~Office of STAR BRUSH MANUFACTURING COMPANY~~
- (b) Address.....123 Queens Road C., 1st floor, Hongkong.....
- (c) Description and nature of business.....Manufacturers of Brushes, General Importers & Exporters & Wholesalers
- (d) Date commenced.....March 26, 1959

- (3) (a) Name in which carried on.....~~(also named) Kwangli Traders~~
- (b) Address.....123 Queens Road C., 1st floor, Hongkong.....
- (c) Description and nature of business.....~~Importers & Exporters & Wholesalers~~
- (d) Date commenced.....June 1, 1952.....

- (4) (a) Name in which carried on.....~~Star Brush Mfg. Company~~
- (b) Address.....~~43, Nam On Street, Shekwan, HK.~~
- (c) Description and nature of business.....~~As above~~
- (d) Date commenced.....~~1.3.60~~

- (5) (a) Name in which carried on.....~~As above~~
- (b) Address.....~~9-11, Seoi San Ho St., Shekwan, HK.~~
- (c) Description and nature of business.....~~As above~~
- (d) Date commenced.....~~As above~~

- (6) (a) Name in which carried on.....~~As above~~
- (b) Address.....~~9-11, Seoi San Ho St., Shekwan, HK.~~
- (c) Description and nature of business.....~~As above~~
- (d) Date commenced.....~~As above~~

CANCELLED 17 MAR 1960 Date.....July 31, 1952  
 Audited and sealed on 5/3/60  
 per (L) dt. 25-2-60 Signed J. H. Leung

Application for registration of trade mark

Exhibits

P 9

Application for registration of trade mark  
2nd October 1972

THE TRADE MARKS ACT  
(CHAPTER 206)

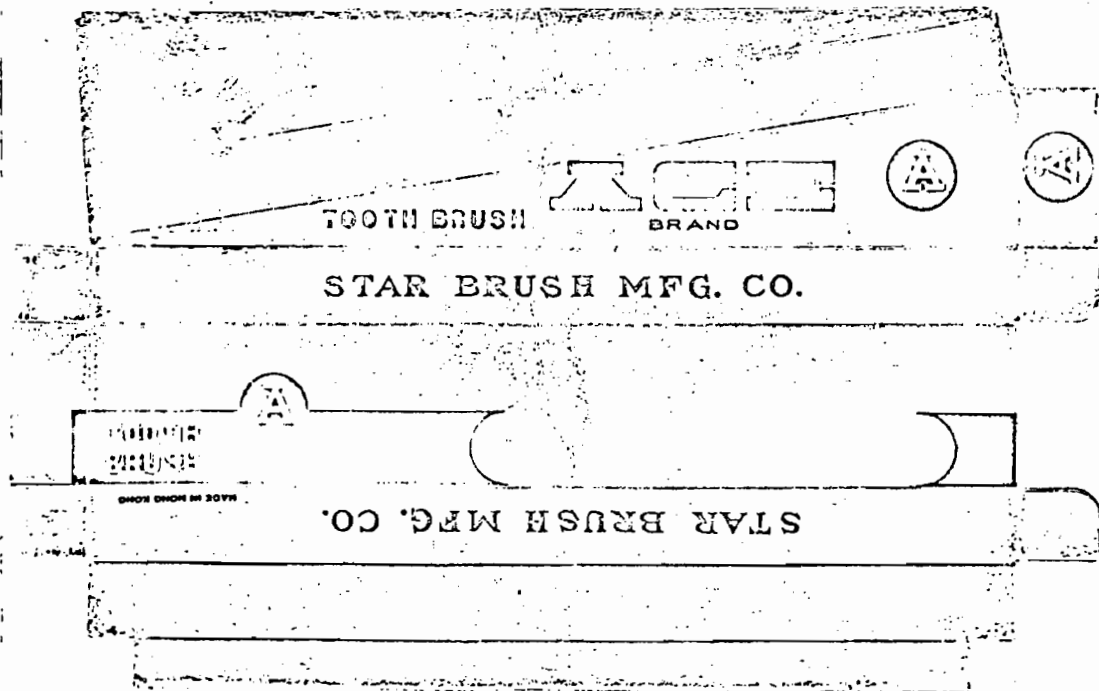
SUPREME COURT.	
SINGAPORE.	
EXHIBIT	P 9
in	S. 102-71 9
Date	20-6-72, Registrar.

In the Matter of an Application for the Registration of a Trade Mark of Star Industrial Company Limited.

I, the undersigned, being the duly appointed Registrar of Trade Marks under Section 3(1) of the Trade Marks Act, (Chapter 206), hereby CERTIFY that under date the 3rd day of December, 1969, an application was made by STAR INDUSTRIAL COMPANY LIMITED, a Company incorporated in Hong Kong, of 25, Tai Yau Street, San Po Kong, Kowloon, Hong Kong, Manufacturers and Merchants, for the registration of a Trade Mark in Class 21, under No. 47884 in respect of Brushes, and that such application is still pending.

The Trade Mark is limited to the colours as shown in the representation on the form of application.

A copy of the said Trade Mark appears below.



WITNESS my hand this 16th day  
of June, 1972

*N. A. D'ROZARIO*  
(N. A. D'ROZARIO)  
Registrar of Trade Marks  
Singapore

THE TRADE MARKS REGISTRY,

QKK:HW

179.

P 9A

Letter from Registrar of Trade Marks

THE GOVERNMENT OF SINGAPORE

Tel. 32294

In reply please quote:

No. TM 47884

REGISTRY OF TRADE  
MARKS & PATENTS,

11 Fort Canning Road,

Singapore 6

Republic of Singapore.

Date 2 October 72.

Messrs. Drew & Napier  
Chartered Bank Chambers  
Singapore 1.

Your Ref: MS/HS/S.47884/T.

Gentlemen

TRADE MARK APPLICATION NO. 47884  
STAR INDUSTRIAL COMPANY LIMITED

10

1. With reference to your application on Form TM 48 dated 2nd October 1972, I enclose herewith a General Certificate of the above trade mark application for legal proceedings.

2. This certificate replaces the one issued by me on the 16th June 1972 as I have been informed that through a clerical error a wrong label bearing the words Star Brush Mfg. Co. was affixed to it now exhibited before the Court as Exhibit P9.

Exhibits

P 9A

Letter from  
Registrar of  
Trade Marks

2nd October  
1972

Exhibits

—  
P 9A

Letter from  
Registrar of  
Trade Marks  
2nd October  
1972

(continued)

3. I confirm that Trade Mark Application No. 47884 is in the name of Star Industrial Company Limited, (which name appears in the label in the form of application), a Company incorporated in Hong Kong of No.25, Tai Yau Street, San Po Kong, Kow Loon, Hong Kong in respect of a Mark which is now attached to my General Certificate for legal proceedings dated 2nd October, 1972.

I am, Gentlemen  
Your obedient servant

Sd. N.A. D'ROZARIO  
REGISTRAR OF TRADE MARKS  
SINGAPORE.

ENC 1

/EC

SUPREME COURT  
SINGAPORE

EXHIBIT P 9A

in S. 102-71 Sd. Illegible

Date 2/10/72 Registrar.

10

20

Application for registration of trade  
mark

Exhibits

P 9B

Application  
for registration  
of trade mark

2nd October  
1972

COURT,  
SINGAPORE.  
No. P.9B  
in S.107-71  
Date 2/X/72  
Registrar.

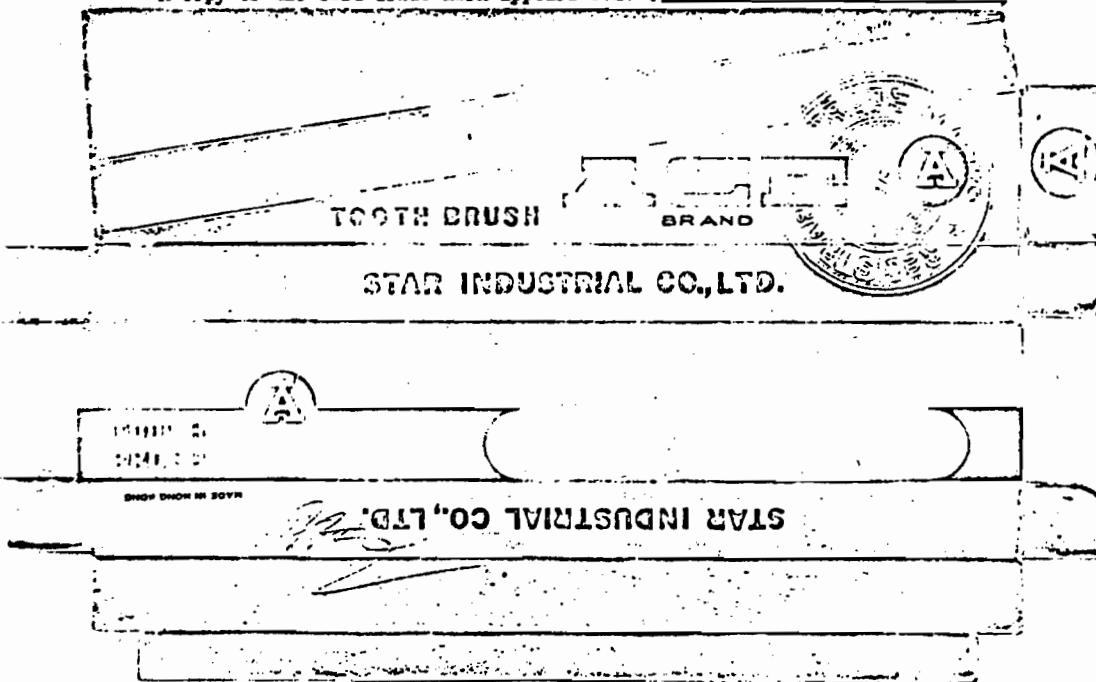
THE TRADE MARKS ACT  
(CHAPTER 206)

In the Matter of an Application  
for the Registration of a Trade  
Mark of Star Industrial Company  
Limited

I, the undersigned, being the duly appointed Registrar of Trade Marks under Section 3(1) of the Trade Marks Act, (Chapter 206), hereby CERTIFY that under date the 3rd day of December, 1969, an application was made by STAR INDUSTRIAL COMPANY LIMITED, a Company incorporated in Hong Kong, of 25 Tai Yau Street, San Po Kong, Kowloon, Hong Kong, Manufacturers and Merchants, for the registration of a Trade Mark in Class 21, under No.47884 in respect of Brushes, and that such application is still pending.

The Trade Mark is limited to the colours as shown in the representation on the form of application.

A copy of the said Trade Mark appears below.



WITNESS my hand this 2nd day  
of October 1972

*N A D'ROZARIO*  
N A D'ROZARIO  
REGISTRAR OF TRADE MARKS  
SINGAPORE

THE TRADE MARKS REGISTRY  
SINGAPORE

/LFP

9

AB 1  
 Certificate No. 39808 as to propriet-  
 orship of toothbrushes

---

REPUBLIC OF SINGAPORE  
 CERTIFICATE ISSUED UNDER SECTION 31 OF  
 THE TRADE MARKS ORDINANCE, (CHAPTER 185)

---

Exhibits

—  
AB 1

Certificate  
 No. 39808  
 as to  
 proprietorship  
 of  
 toothbrushes

A G E

No. 39808

TO

MR. YAP KWEE KOR trading as YAP TRADING CO.

10

I HEREBY CERTIFY that under the provisions of the Trade Marks Ordinance, your name has been entered in Part B of the Register as proprietor of the above numbered Trade Mark as from the 3rd day of August, 1966, in Class 21 in respect of the following goods:- Toothbrushes.

A representation of the Trade Mark is affixed hereto.

Sd. (Illegible)  
 .....  
 Registrar

20

TRADE MARKS REGISTRY,  
 SINGAPORE.

20

Registration is for a period of 7 years and may be renewed at the expiration of this period and upon the expiration of each succeeding period of 14 years.

IN THE JUDICIAL COMMITTEE  
OF THE PRIVY COUNCIL

NO. 11 OF 1974

ON APPEAL  
FROM THE COURT OF APPEAL (CIVIL SIDE) OF SINGAPORE

B E T W E E N :

STAR INDUSTRIAL COMPANY LIMITED

Appellants  
(Plaintiffs)

- and -

YAP KWEE KOR trading as  
NEW STAR INDUSTRIAL COMPANY

Respondent  
(Defendant)

---

RECORD OF PROCEEDINGS

---

Simmons & Simmons,  
14 Dominion Street,  
London, EC2M 2RJ.

Solicitors for the Appellants

Collyer-Bristow & Co.,  
4 Bedford Row,  
London WC1R 4DF.

Solicitors for the Respondent

IN THE JUDICIAL COMMITTEE  
OF THE PRIVY COUNCIL

No. 11 OF 1974

O N A P P E A L

FROM THE COURT OF APPEAL (CIVIL SIDE) OF SINGAPORE

B E T W E E N

STAR INDUSTRIAL COMPANY LIMITED

Appellants  
(Plaintiffs)

- and -

YAP KWEE KOR trading as  
NEW STAR INDUSTRIAL COMPANY

Respondent  
(Defendant)

---

CASE FOR THE APPELLANTS  
CASE FOR THE RESPONDENT  
RECORD OF PROCEEDINGS

---

Simmons & Simmons  
14 Dominion Street  
London EC2M 2RJ

Collyer-Bristow & Co.  
4 Bedford Row  
London WC1R 4DF

Solicitors for the Appellants

Solicitors for the Respondent