

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF  
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T1406879J  
Hearing Date: 15 March 2017  
Further Submissions: 13 April 2017

**IN THE MATTER OF A TRADE MARK APPLICATION BY  
ORCO INTERNATIONAL (S) PTE LTD**

**AND**

**OPPOSITION THERETO BY  
LOUIS DREYFUS COMMODITIES MEA TRADING DMCC**

Hearing Officer: Ong Sheng Li, Gabriel  
Assistant Registrar of Trade Marks

Representation: Mr Dominic Tan (Joyce A. Tan & Partners LLC) for the  
Opponent, Louis Dreyfus Commodities MEA Trading DMCC

(Orco International (S) Pte Ltd filed its pleadings and evidence, but did not appear at the hearing.<sup>1</sup>)

**GROUND OF DECISION**

**Introduction**

1 It is a truism that the outcome of most trade mark disputes turns on the evidence. This is especially so where one party seeks to establish that his trade mark is well known in Singapore, or where he alleges that another's trade mark was applied for in bad faith. Unless borne out by the evidence, claims such as these will fail at the very outset. The present action is no exception.

**Background**

2 On 5 May 2014, Orco International (S) Pte Ltd (the "Applicant") applied to register the following trade mark (Application No. T1406879J) in Class 30 for "Rice" (the "Application Mark"):

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<sup>1</sup> Where one party has filed its pleadings and evidence, but does not file Form HC1 (Notice of Attendance at Hearing) prior to the hearing, the Registrar has the discretion to, and will typically, proceed with the hearing in that party's absence (see [20] – [22] below).




The form of the application contains the following Mark Clause: “*The French words “La Fleur De” appearing in the mark mean “The Flower Of”.*”<sup>2</sup>

3 On 5 January 2015, this opposition was commenced by Louis Dreyfus Commodities MEA Trading DMCC (the “Opponent”). The Opponent is part of the Louis Dreyfus Group, a large, well-established, global conglomerate which deals with many commodities, including rice.

4 In its Notice of Opposition, the Opponent claimed that it had conceptualised and made extensive use of: (a) the word mark “PADDY LEAF” (including use in a specifically chosen



font, as follows: “**PADDY LEAF**”); and (b) the device “”. The thrust of the Opponent’s case was that the Applicant had simply taken the device and the words “PADDY LEAF” in the specific font, added the words “LA FLEUR DE PADDY” below (which in its view was so small as to be practically insignificant) and applied to register the whole as a composite mark. The pleaded grounds of opposition were Sections 8(1), 8(2)(b), 8(4), 8(7)(a) and 7(6) of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.) (“TMA”).

5 On 4 March 2015, the Applicant filed its Counter Statement. The Applicant was unrepresented at that point of time. The Counter Statement was not drafted in legal language, but its import was clear. The Applicant did not deny that there was similarity between the marks. The reason? According to Mr David Duclos, who signed off as Managing Director of the Applicant on the Counter Statement, “*The similarity in the logo is no coincidence*” because this was a brand “*created by Orco in the 90’s*”, and which the Opponent had “*deliberately used without permission*”.<sup>3</sup>

## Evidence filed

### *Opponent’s evidence*

6 Mr Franck Soutoul gave evidence for the Opponent by way of statutory declaration (“SD”). Mr Soutoul’s first SD dated 7 March 2016 (“FS SD-1”) was filed on 7 March 2016.

7 Mr Soutoul identified himself as an authorised agent of the Opponent. He furnished evidence relating to the background and trade of the Louis Dreyfus Group, and provided

<sup>2</sup> Thus, the words “LA FLEUR DE PADDY” in the Application Mark could be translated as “the flower of the paddy” or alternatively, “the paddy flower”.

<sup>3</sup> Counter Statement at unnumbered paragraph 3.

documents which ostensibly showed the use of PADDY LEAF in relation to rice shipments dating as far back as 2007.<sup>4</sup> Mr Soutoul also produced copies of signed statements by “*various members of the rice trade, confirming the extensive and continuous use*” of PADDY LEAF by the Opponent or one of its related companies in relation to rice.<sup>5</sup>

8 The Opponent also took exception to the Applicant’s conduct in the proceedings. Mr Soutoul described the Applicant’s conduct as “*disruptive*”, exhibiting “*blatant disrespect*”, and being “*consistent with the actions of a party who has acted in bad faith to disrupt the business of the Opponent*”.<sup>6</sup> A number of other allegations were made, and I will come to them in the context of the issue of bad faith, one of the pleaded grounds of opposition (Section 7(6) TMA).

#### *Applicant’s evidence*

9 Mr Johan David Berman gave evidence for the Applicant by way of SD. On 7 July 2016, sometime before Mr Berman’s SD was due, the Registrar received notice that Rajah & Tann Singapore LLP (“R&T”) had been entered as agent on record for the Applicant. Prior to this, the Applicant had been unrepresented in the proceedings. Mr Berman’s SD dated 28 July 2016 (“JB SD”) was filed on 28 July 2016 through R&T.

10 Mr Berman identified himself as a Director of the Applicant, a position which he had held since 2016. This was *after* the commencement of this opposition on 5 January 2015. However, nothing turns on it because the Applicant was relying not so much on Mr Berman’s personal knowledge of events, but rather the documents he had access to by virtue of his position. I address the Applicant’s documentary evidence in detail at [36] to [39] below. The main thrust of the evidence was that the Applicant had used “*the “Paddy Leaf la Fleur de Paddy” trademark*” in relation to shipments of rice, “*before the dates the opponent is allegedly said to have used this brand*”.<sup>7</sup>

#### *Opponent’s evidence in reply*

11 Mr Soutoul and Mr Bernard Frachon gave evidence in reply for the Opponent, each by way of SD. The Opponent’s SDs in reply were filed on 19 October 2016.

12 Mr Frachon’s SD dated 10 March 2016 (“BF SD”) presented a different version of the facts from Mr Berman’s statutory declaration. Mr Bernard Frachon introduced himself as a “*Partner of the company ORCO for a period of 10 years from 1990 to 2000*”.<sup>8</sup> During that time, he claimed to be “*responsible for the management, operations and business for West Africa*”.<sup>9</sup> I touch on Mr Frachon’s evidence further at [42] below. In brief, his evidence was that he was in a position to know whether the Applicant had used the Application Mark (or any other mark similar thereto), and to his knowledge, the Applicant did not use the mark as claimed.

13 Mr Soutoul’s second SD dated 14 October 2016 (“FS SD-2”) contained “*observations*” in the nature of submissions rather than evidence. His main arguments were that the Applicant

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<sup>4</sup> FS SD-1 at Exhibit D

<sup>5</sup> FS SD-1 at Exhibit E

<sup>6</sup> FS SD-1 at [14] – [15]

<sup>7</sup> JB SD at [2] – [5]

<sup>8</sup> BF SD at [2]

<sup>9</sup> *Ibid*

had “*failed to submit any evidence of use of the [Application Mark] as it is sought to be registered*”,<sup>10</sup> and that he had “*strong doubts as to the veracity and authenticity of the documents submitted by the Applicant*”.<sup>11</sup> By and large his points were repeated in the Opponent’s written submissions and this SD adds little, if anything, to the matter.

### **Pre-hearing review**

14 As per the usual procedure, a pre-hearing review took place after the close of evidence. It was held on 16 November 2016.

15 During the pre-hearing review, Mr William Teo, who introduced himself as a director of the Applicant, informed the Registrar that R&T had discharged themselves and were no longer acting for the Applicant in the opposition. From that point on, the Applicant was once again unrepresented in the proceedings.

16 Mr Teo also indicated that the Applicant wanted to file further evidence. I drew his attention to HMD Practice Circular No. 1/2011, and directions were given for the Applicant to inform the Registrar in writing if it wanted to take further steps in this regard. As it turned out, the Applicant never followed up on its stated intention to file further evidence.

17 Mr Christopher Cheong from Joyce A. Tan & Partners, agent for the Opponent, attended the pre-hearing review. He indicated that the Opponent would be proceeding on all pleaded grounds, including all sub-limbs of the “well known” trade mark ground of opposition (Section 8(4) TMA), namely, Section 8(4)(a) read with: Section 8(4)(b)(i); Section 8(4)(b)(ii)(A); and Section 8(4)(b)(ii)(B) TMA.

18 After the pre-hearing review, the Opponent wrote in to confirm that it would not be applying for cross-examination. The Opponent also requested for an oral hearing, which was later fixed for 15 March 2017. It duly filed its written submissions more than a month prior to the hearing, as per the usual timelines.

19 All attempts to engage the Applicant in correspondence after the pre-hearing review were unsuccessful, and the Applicant did not take any further step in the proceedings. This also meant that it did not file written submissions.

### **Procedure where one party does not file Form HC1**

20 Any party who intends to appear at the hearing is required to file Form HC1 (Notice of Attendance at Hearing). If a party does not do so, it may be treated as “*not desiring to be heard*”, and the Registrar “*may proceed with the hearing in the absence of that party*”. Alternatively, the Registrar may, “*without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit*”. (See Rule 37(3) and 37(4) of the Trade Marks Rules (Cap. 332, R1) (“TMR”).)

21 In this case, Form HC1 was filed by the Opponent, but not the Applicant. HMD Practice Circular No. 4/2015 dated 30 June 2015, as amended on 22 July 2016 (“Practice Circular 4/2015”) provides guidance on this specific situation. The relevant part reads as follows:

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<sup>10</sup> FS SD-2 at [5]

<sup>11</sup> FS SD-2 at [6.3]

*“Where Form HC 1 is filed by only one party, the Registrar will, under ordinary circumstances, proceed with the hearing in the absence of the party who did not file Form HC1”.<sup>12</sup>*

22 I saw no reason to depart from the guidance set out in Practice Circular 4/2015. Ultimately, the Opponent bore the burden of proving its case under Sections 8(1), 8(2)(b), 8(4), 8(7)(a) and 7(6) TMA. The fact that the Applicant did not tender written submissions or file Form HC1 did not have the effect of shifting this burden. Moreover, the Applicant had filed a Counter Statement and evidence in support of the application. In any event, the Opponent did not object to having the hearing proceed in the Applicant’s absence.

### **The hearing**

23 Mr Dominic Tan from Joyce A. Tan & Partners appeared for, and made oral submissions on behalf of, the Opponent.

24 In the course of his arguments, Mr Tan informed me that the Opponent was no longer pursuing the “well known to the public at large” grounds of opposition (that is: Section 8(4)(b)(ii)(A) and Section 8(4)(b)(ii)(B) TMA). This was the first time that the Opponent had notified the Registrar of its intentions in this regard.

25 After hearing submissions, I gave leave for the Opponent to address me further on certain issues. The Opponent furnished these further submissions by way of letter on 13 April 2017.

## **MAIN DECISION**

### **Relevant date**

26 The relevant date in these proceedings is 5 May 2014, the date on which the Application Mark was applied for.

### **Sections 8(1), 8(2)(b) and 8(4)(b)(i) TMA**

27 Since the Opponent abandoned the “well known to the public at large” grounds of opposition, the remaining grounds of opposition are: Sections 8(1), 8(2)(b), 8(4)(b)(i), 8(7)(a) and 7(6) TMA. For reasons that will become clear very shortly, it is convenient to deal with the first three grounds together.

### **Earlier trade mark**

28 A central common feature of the grounds of opposition in Sections 8(1), 8(2)(b) and 8(4)(b)(i) TMA is that they concern conflict with an “earlier trade mark”. The underlined portions below are illustrative.

“**8.** – (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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<sup>12</sup> Practice Circular 4/2015 at p 6

(a) -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

...

(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark”


(emphasis added)

29 In many trade mark disputes, the “earlier trade mark” relied upon is one that has been registered. Not so in this case. The Opponent did not seek to rely on any earlier registrations. Instead, its case in relation to these 3 grounds was premised on the basis that it had the following earlier (albeit unregistered) trade marks:

(a) First, the word mark “PADDY LEAF”, used since 2007.

(b) Second, the words “PADDY LEAF” in a specific font: “**PADDY LEAF**”, used since February 2008.



(c) Third, the device: “”, which I will refer to as “Three Stalks Device”, also used since February 2008.

(d) Fourth, the above marks used in combination.

(Collectively, the “PADDY LEAF Marks”.)

30 Specifically, it was the Opponent’s case that each of these PADDY LEAF Marks satisfied the definition of an “earlier trade mark” in Section 2(1) TMA, because they were each well known trade marks:

“2. – (1) “earlier trade mark” means –

...

(b) a trade mark which, at the date of application for registration of the trade mark in question [here: the Application Mark]... was a well known trade mark...”

(emphasis added)

31 As to what constitutes a “well known trade mark”, the relevant part of Section 2(1) TMA states:

““well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

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

(emphasis added)

Thus, the fact that the PADDY LEAF Marks were unregistered does not mean that they cannot be well known in Singapore.

32 To summarise: in order to qualify as “earlier trade marks”, the Opponent needed to show that the PADDY LEAF Marks were its well known trade marks in Singapore as at the relevant date (i.e. 5 May 2014). If so, reliance could be placed on them as “earlier trade marks” in order to oppose the registration of the Application Mark. (See *Formula One Licensing BV v Idea Marketing SA* [2015] 5 SLR 1349 (“*Formula One (HC)*”) at [17].<sup>13</sup>)

33 The converse is also true: If the Opponent cannot establish that any of the PADDY LEAF Marks were its well known trade marks as at the relevant date, it would have no “earlier trade marks” to speak of, and the opposition under Sections 8(1), 8(2)(b) and 8(4)(b)(i) TMA would fail at the very threshold.

Was there prior use of the Application Mark (or a similar mark) in Singapore by the Applicant?

34 At this juncture, I pause to address a separate but related issue: can the PADDY LEAF Marks really be said to be “earlier trade marks” if the Applicant had first use of the Application Mark (or a similar mark thereto) in Singapore, in relation to rice?

35 This issue arose because the Applicant claimed to have evidence that it had used “*Paddy Leaf La Fleur de Paddy*” in relation to rice *as far back as 1998*, which was prior to the Opponent’s first claimed use of the word mark “PADDY LEAF” *in 2007*. If true, logically, this would appear to negatively impact on the Opponent’s claim that the PADDY LEAF Marks were “earlier trade marks”.

*Mr Johan Berman’s evidence*

36 According to the Applicant’s Mr Berman, the documents he furnished proved the use of “*Paddy Leaf La Fleur de Paddy*” on the goods.<sup>14</sup> There was only one exhibit to his SD: Exhibit

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<sup>13</sup> Upheld on appeal by the Court of Appeal with no written grounds of decision issued.

<sup>14</sup> JB SD at [4]

A. It contained the following: (a) a copy of a Letter of Confirmation from Gemadept Corporation (a Vietnamese company) dated 12 April 2015; and (b) copies of bills of lading.

(A) Gemadept Corporation's Letter of Confirmation

37 The Letter of Confirmation was engrossed on Gemadept Corporation's letterhead, and was addressed: "*To: Whom it may be concerned*". The first paragraph read as follows:

*"We, Gemadept Corporation, as the ship's agent hereby confirm Messrs Orco International (S) Pte Ltd was the buyer/charte- [this part is cut off, but presumably meant to state "charterer"] "VIETNAMESE WHITE RICE" cargoes shipped on board the vessels below at Hochiminh City port with shipment details as follow- [this part is cut off]..."*

38 Set out beneath those words was a table containing details of shipments, including the name of the shipper, consignee, vessel name, cargo weight, cargo "*bag marking*", and port of discharge. There also appeared to have been other columns in the table, but these were not shown in full in the copy (which was, unfortunately, poorly made). The author of the letter was one "*Do Loc, General Manager*". The letter was signed and stamped "*GEMADEPT CORPORATION AGENCY DEPARTMENT*".

39 It is not necessary for me to go through each shipment detailed in the table. I need only make the following general observations.

- (a) The Applicant is not listed as the shipper of the goods. Instead, the shippers were traders known by names such as "*IMEX CUU LONG*", "*SONG HAU IMPORT-EXPORT*", and "*CANTHO FOOD COMPANY*", to give some examples.
- (b) The cargo was described as "*(IN BOLD GREEN COLOUR) PICTURE OF A PADDY LEAF*" and "*IN BOLD GREEN COLOUR (PICTURE OF A PADDY LEAF IN TOP LEFT)*".
- (c) The weight of the cargo was in the thousands of metric tonnes.
- (d) The table listed a total of 21 shipments in all.
- (e) The ports of discharge were located in Indonesia and Africa. Out of the 21 shipments, 4 of them were to Indonesia (Pahang and Surabaya), whereas the others were to unnamed ports in Africa (including ports in West Africa).

(B) The Bills of Lading

40 Annexed to Gemadept Corporation's Letter of Confirmation were 21 copies of bills of lading. The bills of lading corresponded to – and were evidence of – the 21 shipments tabulated in the Letter of Confirmation.

41 I have outlined the main points concerning these 21 shipments above. I make the following further observations after having perused the copies of the bills of lading.

- (a) I could not find any reference to the Applicant in the bills of lading.



- (b) The cargo in each case was Vietnamese long grain white rice.
- (c) Although the markings were described as “(IN BOLD GREEN COLOUR) PICTURE OF A PADDY LEAF” and “IN BOLD GREEN COLOUR (PICTURE OF A PADDY LEAF IN TOP LEFT)”, it is unclear what these markings were.
  - i. More likely than not, they had some sort of trade mark significance (i.e. indicated trade origin). A mere generic illustration would not likely have been placed on the top left of the packaging, in bold green colour. The fact that they were referenced in bills of lading also supports the view that they were used as trade marks. The “PICTURE OF A PADDY LEAF” may or may not have been the Three Stalks Device, but there is no way of telling from the evidence.
  - ii. It is curious that the words “PICTURE OF A PADDY LEAF” were used in the bills of lading. The Opponent itself had argued that “PADDY LEAF” was a fanciful and invented term.<sup>15</sup> Given the circumstances, it is possible that the words “PADDY LEAF” appeared on the packaging, but there was no evidence of this.
- (d) The shipments all took place in 1998. Specifically, the bills of lading bore the following dates: 8 April 1998, 5 May 1998, 28 October 1998, 17 November 1998, 18 November 1998, and 30 November 1998. (In some cases, there was more than one shipment dated the same day.)

*Mr Bernard Frachon’s SD in reply*

42 As mentioned at [11] – [12] above, Mr Frachon gave evidence in reply on behalf of the Opponent. The gist of his SD was that the Applicant did not use the Application Mark (or any other similar mark). He further asserted that had any such mark been used by the Applicant during his time at ORCO (i.e. from 1990 to 2000), it would have come to his attention since it would have fallen “*within the purview of [his] responsibilities as Partner of ORCO*”.<sup>16</sup>

*Evaluation*

43 There are numerous gaps in the evidence. Nevertheless, I must proceed based on what I have before me.

44 I begin with Mr Frachon’s evidence.

- (a) Unfortunately, Mr Frachon did not specify exactly what he meant by being “*a Partner of ORCO*”. Did he mean ORCO as in the Applicant, a parent company of

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<sup>15</sup> Specifically, that “PADDY LEAF” was “*certainly not a usual way of describing rice*”, given that “*the leaf of the paddy plant is typically discarded in the rice harvesting process and therefore not commonly associated in the minds of the public with rice sold for consumption, which is in fact the seed or grain of the paddy plant*”. The Opponent also argued that “*the word “paddy” has also, through customary usage, come to refer specifically to the flooded fields in which the paddy plant is grown (i.e. paddy fields), rather than to rice itself*”: see Notice of Opposition at [2.1], incorporated into FS SD-1 at [7]

<sup>16</sup> BF SD at [6.2]

the Applicant, or some other company related to the Applicant? During the hearing, Mr Tan acknowledged that the point was unclear.

- (b) In my view, the fact that Mr Frachon used the term “Applicant” as shorthand for Orco International (S) Pte Ltd in one paragraph, and referenced “ORCO” in the next paragraph suggested that he drew a distinction between the two. (Otherwise, he would have said that he was a Partner of the Applicant instead of “*Partner of ORCO*”.) Although the Applicant’s evidence was silent on the point, it appears from Mr Frachon’s evidence that the Applicant was related to some other entity or group (outside of Singapore) that traded under the name “ORCO”.
- (c) I see no reason to doubt Mr Frachon’s evidence that he was a partner of the unidentified ORCO from 1990 to 2000. However, it is unclear whether this necessarily put him in a position to comment on whether or not the Application Mark (or a similar mark thereto) had been used by the Applicant. After all, he did not claim to be an officer or employee of the Applicant.
- (d) It is sometimes said that it is difficult to prove a negative. So too, here. All things considered, Mr Frachon’s evidence did not preclude the possibility that the Application Mark (or a similar mark thereto) was used without his knowledge, in relation to rice.

45 I now turn to the documents in Mr Berman’s SD. Admittedly, they give rise to more questions than answers. But, for present purposes, it is sufficient that I make the following findings. (I will return to these documents later in the context of the ground of opposition under Section 7(6) TMA (i.e. that the Application Mark was applied for in bad faith.)

- (a) First, there was no evidence that the Applicant (or any other party) used the Application Mark (or any similar mark thereto) *in Singapore* prior to the relevant date.
- (b) Second, although the bills of lading show that as far back as 1998, markings described as “(IN BOLD GREEN COLOUR) PICTURE OF A PADDY LEAF” and “(IN BOLD GREEN COLOUR (PICTURE OF A PADDY LEAF IN TOP LEFT))” were used in relation to rice, as far as I can tell, any such use took place *outside of Singapore*. The rice was never imported into Singapore, and none of the parties named in the bills of lading were Singapore businesses or individuals.
- (c) Third, since the Applicant (and ORCO) was not named in any of the bills of lading, the only link between the bills of lading and the Applicant was Gemadept Corporation’s statement in the Letter of Confirmation that the Applicant was the buyer or charterer of the rice in question.

46 In light of the above, it is unnecessary for me to make findings as to the veracity or accuracy of Gemadept’s statement that the Applicant was the buyer or charterer of the rice in question. Nevertheless, even if I were to take the statement at face value, it does not carry the matter much further. There was no evidence as to what the “*PICTURE OF A PADDY LEAF*” referred to. Additionally, since the Applicant was absent during the hearing I did not have the benefit of hearing submissions as to whether the buying/chartering of rice by the Applicant bearing a “*PICTURE OF A PADDY LEAF*” necessarily amounted to trade mark use of it by

the Applicant. All things considered, I am unable to draw any meaningful relevant conclusions from the evidence as to the Applicant’s trading activities in 1998.

47 To conclude, the documents furnished by Mr Berman did not undermine the Opponent’s claim that the PADDY LEAF Marks were its earlier trade marks *in Singapore*. The very most that could be said is that as far back as 1998, *someone* was using a “*PICTURE OF A PADDY LEAF*” in relation to rice – albeit outside of Singapore. But the evidence did not establish use of the Application Mark (or any similar mark thereto) by the Applicant in Singapore, prior to the relevant date.

Was there prior use of PADDY LEAF in Singapore by an unrelated third party?

48 During the hearing, I posed the following question to Mr Tan: even if there was no prior use of the Application Mark (or a similar mark thereto) in Singapore by the Applicant, what if the evidence showed that an unrelated *third party* had used PADDY LEAF (or a similar mark thereto) in relation to rice? Would that adversely impact on the Opponent’s claim that the PADDY LEAF Marks were its “earlier trade marks”?

49 In the Opponent’s further submissions tendered by way of letter on 13 April 2017, it argued that even if a third party had used a “*PICTURE OF A PADDY LEAF*” in relation to rice, that did not amount to evidence that a trade mark similar to the PADDY LEAF Marks was used in 1998.<sup>17</sup> Having evaluated the evidence carefully, I agree insofar as the position in Singapore is concerned. The “*PICTURE OF A PADDY LEAF*” may possibly have been a representation of the Three Stalks Device (see [41(c)(i)] above). And, the words PADDY LEAF may possibly have appeared on the bags of rice shipped by Gemadep Corporation in 1998 (see [41(c)(ii)] above). But I cannot make findings based on mere speculation. More importantly, any such use of the “*PICTURE OF A PADDY LEAF*” was outside of Singapore.

50 For completeness, I should mention that the Opponent also argued that *even if* a third party had used PADDY LEAF (or a similar mark thereto) in relation to rice in Singapore, such use should not be taken into account.<sup>18</sup> The Opponent gave two reasons.

- (a) First, the definition of an “earlier trade mark” under Section 2(1) TMA does not include an “*additional requirement to establish that the well-known trade mark is the earliest such trade mark used in Singapore, or that no other party has used a similar trade mark at an earlier date*”.<sup>19</sup>

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<sup>17</sup> Opponent’s further submissions at [4.1] to [4.2]

<sup>18</sup> For the avoidance of doubt, this is distinct from the question of whether an opponent may rely on third party trade marks in an opposition under Section 8(2) TMA. The answer is “yes”: See *Application for Amendment of Notice of Opposition by MHCS and Objection Thereto by J.-E. Borie SA* [2013] SGIPOS 4 (“*Borie*”) at [3] to [23]. Subsequently, in *Converse Inc. v Southern Rubber Works Sdn Bhd* [2015] SGIPOS 11 (“*Converse*”), the learned IP Adjudicator held that *Borie* case stood for the wider principle that under Section 13(2) TMA, “*any person*” may give notice of an opposition and as such, there was no requirement that an opponent must be the proprietor of the earlier marks relied on. Further, there was also no requirement that an opponent must show that it has sufficient interest in the proceedings (see *Converse* at [14] – [20]).

<sup>19</sup> Opponent’s further submissions at [5.4.2]

- (b) Second, Section 8(2)(b) TMA is a relative ground of position that “*addresses the position of the parties vis-à-vis one another, and no other person, so that the consideration of any third party use of a similar mark is irrelevant*”.<sup>20</sup>

51 The above submissions were based on first principles and without reference to case law. Although I do not have to decide the point, I must say that I found them to be attractive in principle. However, in practice, it would seem that if some other trader had prior use of a trade mark that is identical (or similar to) the “earlier trade mark” which an opponent is relying upon, it would be more difficult, from an evidential standpoint, for such an opponent to succeed in showing that the mark relied upon was his well known trade mark.

52 I now move to examine whether the Opponent has shown that the PADDY LEAF Marks were its well known trade marks as at the relevant date, such that it may rely upon them as its “earlier trade marks”.

Were any of the PADDY LEAF Marks well known trade marks?

53 Sections 2(7) to 2(9) TMA are the starting point in the assessment of whether a trade mark is “well known in Singapore”. They provide:

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

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

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

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

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;

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<sup>20</sup> Opponent’s further submissions at [5.5.1]. By logical extension, that argument would extend to Section 8(4) as well.

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

54 In *Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR(R) 216 (“*Amanresorts*”), the Court of Appeal held (at [137] and [139] – [140]) that the factors in Section 2(7) TMA were not exhaustive. A court (or tribunal) is ordinarily free to disregard any or all of the factors as the case requires – except for Section 2(7)(a) TMA – and to take additional factors into consideration.

55 Indeed, Section 2(7)(a) has been described as “*arguably the most crucial factor when determining whether a trade mark is well known in Singapore*”. This is because of the deeming provision in Section 2(8) TMA which provides that once a trade mark has been found to be well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore. (*Amanresorts* at [139].)

56 Although nothing in this case turns on it, I should briefly mention the Court of Appeal’s decision in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] SGCA 30 (“*Caesarstone*”).<sup>21</sup> In *Caesarstone*, the Court of Appeal referred to its earlier observation in *Amanresorts* at [229] which read “*Finally, it will be recalled that it is not too difficult for a trade mark to be regarded as “well known in Singapore”*” and stated as follows:

“102 We do not think that this comment in *Amanresorts* was made to lay down a general principle. In this regard, we agree with the Respondent’s submission that the context of this comment was the desire to clarify that, in order for a mark to be well known in Singapore, the relevant sector to which a mark must be shown to be well known can be *any* relevant sector of the Singaporean public, and this sector need not be large in size. Beyond this, it should not be read as suggesting (more generally) that the threshold for a trade mark to be regarded as well known in Singapore is a low one.”

57 Returning to the present case, the Opponent did not identify the relevant sector of the public for the purposes of establishing its claim that the PADDY LEAF Marks were well known in Singapore.<sup>22</sup> Nevertheless, since the Opponent has claimed that it has used the PADDY LEAF Marks in relation to rice, it must logically follow that the relevant sectors of the public would be: (a) consumers of rice in Singapore and (b) rice traders in Singapore. I examine each in turn.

#### *Consumers of rice in Singapore*

58 Rice is a staple food in Singapore. Common experience would inform that households in Singapore purchase, cook and consume rice regularly.

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<sup>21</sup> The decision was handed down by the Court of Appeal on 26 April 2017, after the Opponent tendered its further submissions. However, on this point, the Court of Appeal essentially took the same position as Wei J who decided *Caesarstone* at the High Court (see [2016] SGHC 45). Wei J’s decision in *Caesarstone* (HC) was cited by the Principal Assistant Registrar in *Abercrombie & Fitch Europe SAGL v MMC International Services Pte Ltd* [2016] SGIPOS 6 (which was in Tab 1 of the Opponent’s Bundle of Authorities).

<sup>22</sup> What it *did* do, however, was to identify the relevant public for the assessment of likelihood of confusion as: “*the members of the rice trade and consumers in Singapore*”: see Opponent’s Written Submissions at [4.4.2]

59 Hypothetically speaking, one way of showing that rice sold under a certain trade mark was well known to consumers in Singapore would be, as a proxy, to adduce evidence of sales and advertising under the mark. One could also show how rice was distributed through various channels e.g. supermarkets/grocery stores, online sales (e-commerce), and the like. There was no such evidence in the present case. In fact, none of the documents show, or even suggest, that rice bearing any of the PADDY LEAF Marks was ever advertised or sold to end consumers in Singapore.

60 But of course, this does not dispose of the matter. The Opponent could show that the PADDY LEAF Marks were known to or recognised by the rice consuming public in other ways.

61 The Opponent's evidence constituted the following: print-outs from the Louis Dreyfus Group's website concerning its global rice trading business;<sup>23</sup> an interim financial report of the Louis Dreyfus Group for the year 2015;<sup>24</sup> and printouts from the internet describing the Louis Dreyfus Group as "*the world's largest rice trader*"<sup>25</sup>. The Opponent also claimed that the Louis Dreyfus Group was "*thrust into the wider public consciousness in Singapore when it made headlines in 2011 for a proposed collaboration with Singapore-based agri-business giant Olam International Limited*".<sup>26</sup>

62 I have no difficulty accepting that the Louis Dreyfus Group was a world leader in the rice trade; that it dealt in paddy, brown and milled rice; and that it had a presence globally as well as in Singapore.<sup>27</sup> It is also clear from the evidence that the Louis Dreyfus Group had been described as "*the world's largest rice and cotton trader*".<sup>28</sup>

63 However, as mentioned (at [59]) above, there was no evidence that rice bearing the PADDY LEAF Marks were ever advertised or sold to consumers in Singapore. (On the other hand, there was evidence that the Louis Dreyfus Group was – at least in Africa – working towards selling rice under trade marks such as "Allsome Rice".<sup>29</sup>) It is worth noting that in *Caesarstone* the opponent's sales figures for Singapore ranged from as high as S\$3,390,094 (in 2002) to the hundreds of thousands (in 2006 and 2007).<sup>30</sup> While the Court of Appeal was prepared to accept that those figures did go towards showing that the opponent's mark was at least *known* in Singapore, the evidence as a whole was nevertheless insufficient to show that the mark was *well known* in Singapore. Contrast those figures with the present case where there were no sales figures at all (and more importantly no evidence of sales at all) for Singapore under any of the PADDY LEAF Marks.

64 It is also fair to say that the proposed collaboration (or discussions concerning a possible merger) with Olam would likely have increased public awareness in Singapore of the Louis Dreyfus Group. But it does not follow that the public would be aware of the PADDY LEAF Marks as a result, and there is no evidence to suggest as much. Moreover, there is no evidence

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<sup>23</sup> FS SD-1 at Exhibit A

<sup>24</sup> FS SD-1 at Exhibit B

<sup>25</sup> FS SD-1 at Exhibit C

<sup>26</sup> Opponent's Written Submissions at 1.1.4 and Notice of Opposition at [1]

<sup>27</sup> FS SD-1 at Exhibit A, pp 7, 17, 19, 20, 74 and 76

<sup>28</sup> FS SD-1 at Exhibit A, pp 78, 79, 85

<sup>29</sup> FS SD-1 at Exhibit A, p 82

<sup>30</sup> *Caesarstone* at [104]

that the contemplated collaboration or merger ever took place – if it did, surely the Opponent would have adduced evidence in this regard.

65 After examining the evidence carefully, I find that none of the PADDY LEAF Marks were well known to consumers of rice in Singapore.

*Rice traders in Singapore*

66 Next, I consider whether the PADDY LEAF Marks were well known to the rice trading sector in Singapore. Since rice is not typically grown in Singapore, the focus of the assessment is on businesses which buy/sell or import/export rice.

67 As touched on briefly at [7] above, the Opponent had copies of bills of lading and invoices evidencing the use of the PADDY LEAF word mark in relation to rice shipments dating as far back as 2007 and 2008, and up to as recently as 2013. It also tendered copies of signed statements by “*various members of the rice trade, confirming the extensive and continuous use*” of PADDY LEAF by the Opponent in relation to rice. These were exhibited to FS SD-1 at Exhibits D and E respectively.

68 However, a closer look at these documents reveals the following.

- (a) First, and most importantly, none of the rice traders that the Opponent (or any of its related companies) had dealt with were in Singapore. The traders were foreign businesses in Thailand (*viz.* Capital Cereals Co. Ltd., Asia Golden Rice Co., Ltd., and Industry Ummuoychai Co., Ltd.) and India (*viz.* Amira Pure Foods Private Limited, S.S. Industries, and Sri Lalitha Enterprises Industries (P) Ltd.).
- (b) Second, on the evidence, none of the rice under the PADDY LEAF mark was ever imported into Singapore. The bills of lading and invoices indicate that the rice marked PADDY LEAF was of Thai or Indian origin. It was loaded onto ships from ports in Thailand<sup>31</sup> and India.<sup>32</sup> The destination? Various ports in Africa. This fact was also corroborated by signed statements from rice traders in Thailand<sup>33</sup> and India,<sup>34</sup> each attesting to the fact that they had sold rice – bound for the African market – to a company related to the Opponent. PADDY LEAF rice did not move through Singapore’s port at all.
- (c) Third, although the word mark PADDY LEAF was used in relation to rice, it is impossible to tell whether the words appeared in the specific font as claimed by the Opponent. Moreover, there is nothing to suggest that the bags of rice bore the Three Stalks Device claimed by the Opponent as its well known trade mark. (Interestingly enough, there are references to PADDY LEAF YELLOW although it is unclear what this refers to, and in any event nothing turns on it.)
- (d) Fourth, some of the documents show that the “buyer” of the rice marked PADDY LEAF / PADDY LEAF YELLOW was a Singapore corporate entity: Louis Dreyfus Commodities Asia Pte. Ltd. But, these documents related to trading

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<sup>31</sup> FS SD-1 at Exhibit D, pp 88, 89, 90, 91, 92, 99, 100, 101, 102, 104, 105, 106, and 107

<sup>32</sup> FS SD-1 at Exhibit D, pp 93, 94, 95, 96, 97, 98, and 103

<sup>33</sup> FS SD-1 at Exhibit D, pp 109, 110, and 111

<sup>34</sup> FS SD-1 at Exhibit D, pp 112, 113 and 114

activities *outside of Singapore*: see sub-paragraphs (a) and (b) above. There was no evidence that any of the claimed PADDY LEAF Marks were ever used in the course of trade in Singapore (whether by any of the companies in the Louis Dreyfus Group or otherwise). I fail to see how the purchase of rice (by Louis Dreyfus Commodities Asia Pte. Ltd.) originating from *Thailand* and *India* marked PADDY LEAF bound for the *African market* equated to use of the PADDY LEAF Marks in a manner that made them the Opponent's well known trade marks *in Singapore*. At the very most, this could be said to be internal use within the Louis Dreyfus Group. It fell far short of showing that any of the PADDY LEAF Marks were well known to the trade *in Singapore*.

- (e) Fifth, the only other (albeit remote) connection to Singapore that I could find was that the bills of lading/invoices make reference to letters of credit (or L/Cs) issued by financial entities such as “*Fortis Bank S.A/N.V., Singapore, Singapore*”,<sup>35</sup> “*CALYON SINGAPORE SG*”,<sup>36</sup> and “*United Overseas Bank Limited Singapore, SG*”.<sup>37</sup> However, for obvious reasons, the provision of credit facilities from Singapore is irrelevant to the question of whether PADDY LEAF Marks were well known to those in the rice trade in Singapore.

69 When the documents are considered in totality, the following picture emerges: While the Opponent (or its related companies in the Louis Dreyfus Group) may have used PADDY LEAF as far back as 2007 and 2008, such use was strictly in relation to goods located outside of Singapore, and in connection with traders located outside of Singapore. The evidence falls far short of showing that any of the PADDY LEAF Marks were known to or recognised by the rice trading sector *in Singapore*.

#### *Conclusion on the well known trade marks issue*

70 For the reasons above, I find that the Opponent has failed to establish that any of the PADDY LEAF Marks were well known to any relevant sector of the public in Singapore.

#### Section 8(1) TMA

71 Section 8(1) TMA provides that:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.”

(emphasis added)

72 I have found at [70] above that the Opponent has failed to establish that any of the PADDY LEAF Marks were well known to any relevant sector of the public in Singapore. As such, the Opponent does not have any “earlier trade mark” to rely on for the purposes of Section 8(1) TMA. The opposition under this section therefore fails.

#### *Identity of marks?*

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<sup>35</sup> FS SD-1 at Exhibit D, pp 93 and 94

<sup>36</sup> FS SD-1 at Exhibit D, p 101

<sup>37</sup> FS SD-1 at Exhibit D, p 104



73 My findings above make it unnecessary for me to deal with the issue of whether the competing trade marks were identical.

74 Nevertheless, I should briefly touch on an exchange that took place during the hearing concerning the words “LA FLEUR DE PADDY” (which are part of the Application Mark but are not in any of the PADDY LEAF Marks). Mr Tan’s argument was that “LA FLEUR DE PADDY” was visually small and insignificant. To this, I observed that it appeared from the case law – for instance, in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382 (“*City Chain*”) – that the word “identical” in the section was to be interpreted strictly, and that this suggested that slight differences may be sufficient to give rise to a finding that the competing marks are not identical.

75 It is well established in local case law that the policy rationale for this “strict interpretation” is that the protection accorded under the so-called double identity provision cannot be extended beyond the situations for which it was envisaged so as to cross into the realm of another statutory provision (e.g. likelihood of confusion under Section 8(2)(b) or Section 27(2)(b)). Such a strict approach is taken under Section 27(1) TMA (and by extension Section 8(1) TMA) because “*once a case is shown to fall within that provision, protection ipso facto follows, irrespective of whether there is proof of likelihood of confusion on the part of the public*” (*City Chain* at [39]).

76 Although the Opponent was given an opportunity to make further submissions on this issue, it elected not to pursue the point further. Had it been necessary for me to decide the issue, I would have found that the requirement of identity of marks was not satisfied. The words “LA FLEUR DE PADDY” may appear small in comparison with “PADDY LEAF” but I cannot simply disregard them altogether.

#### *Identity of goods?*

77 For completeness, I note that there is no dispute that the goods (here: rice) are identical. However, since the comparison is made against the goods for which the “*earlier trade mark is protected*” and I have found that there is no earlier trade mark that the Opponent can rely on for the purposes of Section 8(1), the issue does not arise and I do not need to decide the point.<sup>38</sup>

#### Section 8(2)(b) TMA

78 Section 8(2)(b) TMA provides that:

“(2) A trade mark shall not be registered if because —

(a) -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.”

(emphasis added)

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<sup>38</sup> Moreover, the Applicant was, for the most part, unrepresented by counsel and its representatives did not attend the hearing. Hence, I am reluctant to express any views on this point.

79 I have found at [70] above that the Opponent has failed to establish that any of the PADDY LEAF Marks were well known to any relevant sector of the public in Singapore. As such, the Opponent does not have any “earlier trade mark” to rely on for the purposes of Section 8(2)(b) TMA. The opposition under this section therefore fails.

80 In light of my findings above, the issue of whether the Application Mark is similar to any of the PADDY LEAF Marks does not arise, and I make no findings in this regard. It is also unnecessary for me to deal with the likelihood of confusion issue.<sup>39</sup>

### *Observations*

81 It is interesting that the Opponent sought to rely on Section 8(2)(b) TMA in this opposition. Cases of this sort, where the “earlier trade marks” relied upon under Section 8(2)(b) TMA are alleged to be unregistered “well known trade marks” are relatively uncommon.

82 In recent years, the above approach was attempted in two cases: *Alphasonics (Ultrasonic Cleaning Systems) Ltd. v Alphasonics (Pte) Ltd* [2013] SGIPOS 6 (“*Alphasonics*”); and *Formula One Licensing BV v Idea Marketing SA* [2015] SGIPOS 7.<sup>40</sup> In the latter case, an appeal to the High Court was unsuccessful (see *Formula One (HC)*), and the High Court’s decision was in turn upheld by the Court of Appeal with no written grounds of decision issued. Although each case must necessarily turn on its own facts, it should not escape notice that in both these cases the opponents were unsuccessful.

83 The observations of the learned Principal Assistant Registrar in *Alphasonics* (at [42]) are particularly incisive, and worth repeating. He considered that:

*“...it is probable that such cases are rare because most marks which can be said to be well known in Singapore would, in practice, be registered in Singapore for a party’s goods of interest. If a party has indeed expended large amounts of time, effort or money to develop and promote their mark, it is unlikely that they will be deterred by the low marginal cost to register this mark in Singapore at least in relation to the goods or services of primary interest to them.”*

I respectfully agree. Of course, this does not mean that the absence of a registration is fatal to a claim that a mark is well known. But, as in this present case, it calls for a careful scrutiny of the evidence to ensure that the allegation that the mark is well known is properly founded.

### Section 8(4)(b)(i) TMA

84 Section 8(4)(b)(i) TMA provides that:

“(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

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<sup>39</sup> My comment at footnote 38 above applies here as well.

<sup>40</sup> To be read with *Formula One Licensing BV v Idea Marketing SA* [2013] SGIPOS 8

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark”

(emphasis added)

85 I have found at [70] above that the Opponent has failed to establish that any of the PADDY LEAF Marks were well known to any relevant sector of the public in Singapore. As such, the Opponent did not have any “earlier trade mark” to rely on for the purposes of Section 8(4)(b)(i) TMA. The opposition under this section therefore fails as well.

86 In light of my findings above, the issue of whether the whole or an essential part of the Application Mark is identical with or similar to any of the PADDY LEAF Marks does not arise, and I make no findings in this regard. Similarly with the other elements of the provision.<sup>41</sup>

### **Section 8(7)(a) TMA**

87 Section 8(7)(a) TMA provides that a trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented “*by any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*”.

88 In *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618, the High Court held that this section essentially requires that the opponent establish a *prima facie* case of passing off. Why *prima facie*? Because the court (or tribunal, in this case) “*is inevitably hampered by the lack of a full trial and detailed facts and evidence...*” and yet must decide whether a passing off claim would succeed should one be brought (at [164]).

### The law

89 It is trite law that there are three elements in the tort of passing off: goodwill, misrepresentation, and damage. (*Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 at [130]; *The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] 3 SLR 517 at [80].)

90 In *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”) the Court of Appeal restated the law (at [32] – [41]) concerning each of these elements. The court also took the opportunity to clarify certain aspects of the law which, in its view, suffered “*from a lack of precision*” (see [36]). A summary of the key points (some of them paraphrased) drawn from *Singsung* is set out below.

#### (a) Goodwill:

- i. Goodwill is “*the legal property that the law of passing off protects*”. It is an “*amorphous idea that does not sit well with strict definitions*”, but is essentially a term to describe “*the state of the trader’s relationship with his customers*”. Some other formulations include: “*benefit and advantage of the*

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<sup>41</sup> My comment at footnote 38 above applies here as well.

*good name, reputation, and connection of a business*”, and more famously, *“the attractive force which brings in custom”*. (Singsung at [32].)

- ii. It is also useful to appreciate what goodwill – for the purposes of the tort of passing off – is not. Because passing off *“protects a trader’s relationship with his customers”*, goodwill is ultimately concerned with the *“business as a whole”*, and not in its *“constituent elements, such as the mark, logo or get-up”* used by the business. Put another way, the goodwill relevant to passing off is not *“in the mark, logo or get-up”* per se. (Singsung at [33] – [34].)
- iii. Goodwill *“does not exist on its own, but attaches to a business in the jurisdiction, and is manifested in the custom that the business enjoys”*. (Singsung at [34].)
- iv. How is goodwill proved? It may be proved *“by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear”*. (Singsung at [34].)

(b) Distinctiveness generally:

- i. Previously, the courts have taken one of two broad approaches when analysing distinctiveness. On occasion, it *“has been considered as part of the analysis of goodwill”*. At other times, it is analysed *“in the context of misrepresentation”*. (Singsung at [36].)
- ii. In most cases, whether one takes one approach or the other, the outcome is inconsequential. This is because the elements of the tort are connected and interdependent. (Singsung at [37].)
- iii. But, *“as a matter both of principle and conceptual clarity, the issue of whether a mark or get-up is distinctive of the plaintiff’s products or services”* is *“a question that is best dealt with in the context of the inquiry as to whether the defendant had made a misrepresentation”*. (Singsung at [37].)

(c) Distinctiveness as a threshold issue (Singsung at [38]):

- i. The *“issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether the defendant has committed an actionable misrepresentation”*.
- ii. If *“a mark or get-up is not distinctive of the plaintiff’s products or services”*, the *“mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant’s products or services are the plaintiff’s or are economically linked to the plaintiff”*.
- iii. If *“it is found that the mark or get-up is distinctive of the plaintiff, then the next question is whether the use of similar indicia by the defendant amounts to a misrepresentation”*.

(d) Misrepresentation:

- i. The misrepresentation inquiry “typically begins with a consideration of how the defendant is said to be doing this”. In general, it entails “the use of some element that serves as a badge or identifier marking the goods or services in question as emanating from the claimant”. It will then be “necessary to consider whether that element does serve as a badge or identifier, or, in the parlance of the action, whether it is ‘distinctive’ of the claimant’s goods and services, and whether the claimant’s goodwill (established under the first stage of the inquiry) is in fact associated with that element”. Next, it falls to be considered, among other things, “whether there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant’s goods or services are, or emanate from a source that is linked to, the claimant’s”. (*Singsung* at [39] citing *The Singapore Professional Golfers’ Association v Chen Eng Waye* [2013] 2 SLR 495 at [20])
- ii. Ultimately, whether misrepresentation has occurred “is a question to be determined by the court in the light of the surrounding circumstances”. In order to be actionable, the misrepresentation “must give rise to confusion or the likelihood thereof. Whether this is so is a question to be determined by the court/tribunal in the light of the surrounding circumstances. This is not to be determined on a visual side-by-side comparison. Rather, it is to be assessed from the perspective of a notional customer with imperfect recollection”. (*Singsung* at [40].)

- (e) Damage: The claimant need not show actual damage as long as a real tangible risk of substantial damage is present. This could occur by way of blurring or tarnishment. (*Singsung* at [41].) (I would add that it could also arise from diversion of sales, particularly where parties are in direct competition, as in the case of *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [118].)

91 I now turn to apply the law to the facts.

### Goodwill

92 First, goodwill.

93 At this stage, I only need concern myself with the question of whether the Opponent enjoys goodwill in its business as a whole, and not specifically in its constituent elements: *Singsung* at [34]. Here, I do not examine the question of whether the indicia relied on is distinctive of the Opponent because that is a threshold issue under the second element, misrepresentation: *Singsung* at [37] – [38].

94 The Opponent’s group – the Louis Dreyfus Group – has a business presence in Singapore. Specifically, Louis Dreyfus Commodities B.V. wholly owns a number of companies in

Singapore, including Louis Dreyfus Commodities Asia Pte. Ltd.<sup>42</sup> This subsidiary – Louis Dreyfus Commodities Asia Pte. Ltd – was engaged in business activities: see [68(d)] above.

95 In the circumstances, I find that the element of goodwill has been made out.

### Misrepresentation

96 Next, misrepresentation.

97 The essence of the Opponent’s case on this element is that the Application Mark and the PADDY LEAF Marks are “*practically identical, so that it is difficult to see how the average consumer would not be confused*”.<sup>43</sup>

98 But, even if the competing marks are similar, that does not dispose of the issue. The Court of Appeal’s words in *Singsung* (at [38]) bear repeating:

“...Simply put, if a mark or get-up is not distinctive of the plaintiff’s products or services, the mere fact that the defendant has used something similar or even identical in marketing and selling its products or services would not amount to a misrepresentation that the defendant’s products or services are the plaintiff’s or are economically linked to the plaintiff...”

The question then, is this: were any of the PADDY LEAF Marks distinctive of the Opponent’s rice in Singapore?

### *Distinctiveness*

99 Distinctiveness in the context of passing off – and misrepresentation specifically – is inextricably tied to use. If a mark has never been used by a trader, it cannot be said to be distinctive of a trader. A trader may conduct business in Singapore and thus enjoy goodwill. But unless there is a link, or association, between that goodwill and the mark relied upon (which can only arise if the mark is distinctive of the trader’s goods or services) there cannot be any misrepresentation to speak of.

100 Above,<sup>44</sup> I have found that: (a) there was no evidence that rice bearing any of the PADDY LEAF Marks was ever imported into Singapore, let alone advertised or sold to end consumers in Singapore; and (b) the rice traders that the Opponent (or its related companies) had purchased PADDY LEAF rice from were foreign businesses located either in Thailand or India, and the rice was shipped to various ports in Africa. In effect therefore, none of the PADDY LEAF Marks had been used *in Singapore* in relation to rice. These findings had led me to the conclusion that none of the PADDY LEAF Marks were known to or recognised by any relevant sector of the public in Singapore.

101 These findings also lead me to the conclusion that the PADDY LEAF Marks were *not* distinctive of the Opponent’s rice in Singapore. In any event the Opponent’s goodwill in Singapore was not associated with the PADDY LEAF Marks. Accordingly, there cannot be any misrepresentation even if the competing marks are similar (a point I do not need to decide).

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<sup>42</sup> FS SD-1 at Exhibit A, p 74.

<sup>43</sup> Opponent’s Written Submissions at [5.3.2]

<sup>44</sup> See [59] and [68]

102 In conclusion, the element of misrepresentation has not been made out, and the opposition under Section 8(7)(a) fails.

### Damage

103 I have found that there was no misrepresentation. Thus, it follows that there is no damage, or likelihood thereof, to the Opponent's goodwill.

### **Section 7(6) TMA**

104 The final remaining ground of opposition is Section 7(6) TMA, which provides that a trade mark "*shall not be registered if or to the extent that the application is made in bad faith*".

### The law

105 The leading case on this provision is the Court of Appeal's decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 ("*Valentino*"). A summary of the applicable principles was set out by the learned Principal Assistant Registrar in *Appitude Pte Ltd v MGG Software Pte Ltd* [2016] SGIPOS 15 at [116], which I reproduce below:

- (a) Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve 'no breach of any duty, obligation, prohibition or requirement that is legally binding' upon the registrant of the trade mark' (see *Valentino* at [28]).
- (b) The test contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Thus, "bad faith" as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case (see *Valentino* at [29]).
- (c) Once a *prima facie* case of bad faith is made out by the Opponent, the burden of disproving any element of bad faith on the part of the Applicant would arise (see *Valentino* at [36]).
- (d) An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference (see *Valentino* at [30]). However, as observed in Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 at [21.4.1], footnote 109, this does not mean that there is an absolute prohibition against drawing inferences. In support of this observation, Professor Ng-Loy cited the decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.
- (e) Once bad faith is established, the application for registration of a mark must be refused even though the mark would not cause any confusion (*Valentino* at [20]).

106 The relevant time for determining whether there was bad faith is the time of filing the application for registration. (See *Leonid Kovalkov v Tan Siew Keng Angeline* [2016] SGIPOS 10 at [29], wherein the learned IP Adjudicator cited *Kerly's Law of Trade Marks and Trade Names* (15<sup>th</sup> Ed) (Sweet & Maxwell, 2011) at [8-263], which referred in turn to the decision of the European Court of Justice in *Chocoladefabriken Lindt & Sprungli AG v Franx Hauswirth GmbH* (C-529/07) for this proposition.)

107 I should also mention a passage in *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR 1073 at [42], which the Opponent helpfully drew my attention to. There, VK Rajah JA (as he then was) cited with approval *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 14<sup>th</sup> Ed, 2005) at p 237, where the following 3 illustrations of “*hijacking a mark or spoiling a competitor's plans that suggest bad faith*” were set out:-

- “(1) The applicant has no *bona fide* intention to use the trade mark at all, but wishes to prevent a competitor from using the, or a similar, mark;
- (2) The applicant has no present or fixed intention to use the mark, but wishes to stockpile the mark for use at some indeterminate time in the future; and
- (3) The applicant becomes aware that someone else plans to use the mark, and files a pre-emptive application with a view to selling it.”

#### Opponent's submissions

108 The Opponent's case on bad faith was that the circumstances were “*more than sufficient to justify a finding of bad faith*” and advanced arguments along two lines.<sup>45</sup>

#### *The Direct Copying Argument*

109 The Opponent's first argument<sup>46</sup> goes like this: Being in the same rice trade, the Applicant would have been aware of the Opponent's use of the PADDY LEAF Marks in relation to rice. According to the Opponent, the constituent elements of the Application Mark were a “*direct and obvious*” copy of one or more of the PADDY LEAF Marks (save for the “*perfunctory addition of the tiny words*” – “LA FLEUR DE PADDY”), and this was “*calculated to take advantage of and ride on the worldwide fame of the PADDY LEAF Marks*” and to “*associate [the Applicant's] rice products with those of the world's largest rice trader*”. In this connection, the Opponent repeated its submission that the Applicant had failed to show evidence of use of the Application Mark as sought to be registered or at all. It also stressed that the veracity and authenticity of the documents tendered by the Applicant were in doubt.

110 In my judgment, the Opponent's evidence did not meet the required threshold. None of the documents suggested actual dishonesty or dealings which would be considered as commercially unacceptable by reasonable and experienced persons in the trade. Neither did the Opponent apply to cross-examine Mr Berman. The argument was, in reality, premised on inference based on alleged similarity (or identity) of marks.

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<sup>45</sup> Opponent's Written Submissions at [6.2.1]

<sup>46</sup> Opponent's Written Submissions at [6.2.2]



111 I have found above that none of the PADDY LEAF Marks were used *in Singapore* prior to the relevant date; that the PADDY LEAF Marks were not known to or recognised by any relevant sector of the public in Singapore; and that the PADDY LEAF Marks were not distinctive of the Opponent in Singapore. To add to the complexity of the situation, it appears that as far back as 1998, at least one trader (unrelated to either party) had used bags marked with a “*PICTURE OF A PADDY LEAF*” in relation to rice, outside of Singapore. In these circumstances, it is difficult to see how the Opponent’s claim that the Applicant had acted in bad faith could be sustained.

### *The Disruptive Conduct Argument*

112 The Opponent also urged me to bear in mind the Applicant’s conduct throughout the opposition, which (according to the Opponent) showed “*blatant disrespect for the integrity of these proceedings*”; was “*consistent with the actions of a party which has acted in bad faith to disrupt the Opponent’s business*”; and was “*a concerted attempt to disrupt the business and activities of the Opponent*”.<sup>47</sup> Specifically, the Applicant was alleged to have had:

- “(i) contravened the Trade Marks Rules by not serving a copy of the Counter Statement on the Opponent within the prescribed deadline, despite being directed by the Registrar to do so on the day it filed the Counter-Statement;
- (ii) only served such copy of the Counter-Statement on the Opponent a full 7 days after being directed to do so by the Registrar, and 6 days after the said prescribed deadline;
- (iii) misled the Opponent by indicating its wish to submit the opposition to mediation in its Notification to Registrar form dated 11 June 2015, only to subsequently reveal that it in fact did not wish to submit the opposition to meditation –
  - (a) verbally to the Registrar, as stated in the Registrar’s letter dated 31 July 2015 (copied to the Opponent);
  - (b) after the Opponent had in good faith completed and signed the Agreement and Request for WIPO Mediation;
- (iii) repeatedly communicated with the Registrar without the knowledge of the Opponent, including on 2 March 2015, 11 March 2015, 24 March 2015, 25 March 2015, 11 June 2015, 16 July 2015 and 31 July 2015, as detailed in the Registrar’s letter dated 4 August 2015 (copied to the Opponent).”

113 With respect, this argument was misguided. The crux of the issue was whether the Application Mark was made (i.e. applied for) in bad faith. This had to be assessed at the time of the application, not by reference to the Applicant’s conduct after the commencement of opposition proceedings. While the Applicant’s conduct may have fallen far below expectations, such conduct was, strictly speaking, irrelevant to the opposition under Section 7(6) TMA (although it may be relevant to the issue of costs).

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<sup>47</sup> Opponent’s Written Submissions at [6.2.3]

## **Conclusion**

114 Having considered all the pleadings, evidence and submissions before me, I find that the opposition fails on all grounds. I will hear parties on costs.

Date of Issue: 13 July 2017