

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)

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CASE FOR THE RESPONDENT

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London W.C.1.



without clearly distinguishing such use from the goods of the Appellants or by any other means.

(ii) 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.

p.134  
1.46 to  
p. 135  
1.17

3. On appeal to the Court of Appeal of Singapore the Appellants did not appeal or dispute that part of the judgment of Choor Singh J. whereby he found that the Appellants had not used the trading name "Star Industrial Co. Ltd." in Singapore in respect of the manufacture and sale of their tooth-brushes and dismissed the Appellants' claim to restrain the Respondent from using the trading name "New Star Industrial Co."

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4. The question for decision is whether the Appellants can restrain the Respondent from manufacturing and trading in tooth-brushes in Singapore under or by reference to the trade mark "AGE" got up in packages similar to the sample packet which forms Exhibit P.21 herein (hereinafter referred to as the "AGE Brand" tooth-brush.)

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Appendix

5. The issue in this appeal is whether the Appellants had in 1968 (when the Respondent first sold the "AGE Brand" tooth-brush in Singapore) and continued to have until at least the 9th

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February 1971 (the date of the Writ herein) any goodwill or proprietary rights in Singapore in respect of tooth-brushes packaged in packets 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 (hereinafter referred to as the "ACE Brand" tooth-brush). A sample packet of the "ACE Brand" tooth-brush forms Exhibit P.3 herein. Put another way, in Singapore, did the Appellants have a goodwill or reputation in the "ACE Brand" tooth-brush such that the offer for sale, sale and supply of the Respondent's "AGE Brand" tooth-brush in 1968 and at all times until at least the 9th February 1971 was calculated or likely to deceive a substantial number of people into believing the such tooth-brushes were the Appellants' brushes or were brushes connected with the Appellants.

Appendix

6. The material facts which it is believed are not in dispute and most of which the Court of Appeal of Singapore stated were never in dispute, are as follows:

- (i) From 1953 to 1961 one Jhi Hung Leung trading from Hong Kong under the style "Star Brush Manufacturing Company" manufactured and sold "ACE Brand" tooth-brushes

p.132 1.21  
to p.133  
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p.148 1.31  
to p.149  
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in Hong Kong for export to Singapore.

Most of such tooth-brushes were for re-export from Singapore to Indonesia and surrounding territories although there were some local sales as well. The evidence does not establish how many of such tooth-brushes were sold in Singapore.

p.132  
1.39 to  
p.133 1.2  
p.149 1.8  
to 13

(ii) In May 1961 the Appellant company was incorporated in Hong Kong and registered under the Hong Kong Companies Act and J. H. Leung became a major shareholder and its managing director. The Appellants took over the manufacture of the "ACE Brand" tooth-brushes in Hong Kong. 10

p.78 1.30  
to 41  
p.133 1.7  
to 12  
p.149 1.14  
to 18

(iii) J. H. Leung's business "Star Brush Manufacturing Co." ceased manufacturing and selling "ACE Brand" tooth-brushes at or about the end of March 1962. J. H. Leung did not assign to the Appellants the goodwill of his business or his goodwill in "ACE Brand" tooth-brushes 20

p.134 1.12  
to 16  
p.134 1.46  
to p.135  
1.17  
p.149 1.12  
to 21

(iv) In or about 1961 or early 1962 the Appellants commenced selling "ACE Brand" tooth-brushes in Hong Kong for export to Singapore which continued to be packaged in packets labelled "Star Brush Manufacturing Co.". The evidence does not establish how many of such tooth-brushes were sold in Singapore.

p.133 1.17  
to 23  
p.149 1.22  
to 28

(v) In 1963 the "ACE" brand mark was registered as a trade mark in Hong Kong by the Star Brush Manufacturing Company of which J. H. Leung was still the sole proprietor. 30

- (vi) In October 1965 the Singapore Government imposed a tariff of 15 cents per tooth-brush on all tooth-brushes imported into Singapore and the Appellants stopped selling "ACE Brand" tooth-brushes for export to Singapore. p.133 1.24 to 30 p.134 1.8 to 11 p.134 1.34 to 45 p.149 1.29 to 36
- (vii) On the 3rd August 1966 the Respondent trading as "Yap Trading Company" registered the trade mark "AGE" in respect to tooth-brushes in Singapore. p.34 p.134 1.12 to 18
- 10 (viii) In about 1968 the Respondent changed the name of his business to "New Star Industrial Company" and started manufacturing and selling "AGE Brand" tooth-brushes in Singapore. p.134 1.12 to 15 p.150 1.1 to 9
- (ix) At some time subsequent to the 22nd August, 1968 the Appellants and Lim Teck Lee Company Limited and Lim Seng Huat (Singapore) Limited formed a joint venture company in Singapore called Star Plastics Industrial Company (Private) Limited, the main object of which was the operation of factories in Jurong and Singapore for the manufacture and sale of plastic products. The Appellants supplied such company with know-how and moulds for the production of tooth-brushes and sent technicians and a production manager to supervise the manufacture of tooth-brushes. p.133 1.31 to 43 p.149 1.37 to 42 p.160 to 163
- 20
- (x) In 1968 J. H. Leung assigned to the Appellants the "ACE Brand" trade mark registered in Hong Kong. p.133 1.43 to 46 p.149 1.43 to 45
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p.80 1.6 (xi) Since about September 1969 Star Plastics  
to 8  
p.133 1.47 Industrial Co. (Private) Limited have  
to p.134 1.1 manufactured "ACE Brand" tooth-brushes in  
p.150 1.10 Singapore for sale to Indonesia, Malaysia and  
to 12 Australia. A small percentage (0.5 per  
p.54 1.30 cent in 1969) of such "ACE Brand" tooth-brushes  
to 39 have been sold in Singapore.

p.139 1.1 7. In his judgment Choor Singh J. held that the  
to 20 evidence was inadequate to establish any goodwill or  
property of the Appellants in Singapore in respect 10  
of the "ACE Brand" tooth-brush. In particular he held  
that the Appellants 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.

p.134 In so doing Choor Singh J. rejected the  
1.35-45 evidence of J. H. Leung that a small quantity of  
"ACE Brand" tooth-brushes was exported from Hong Hong  
to Singapore in 1966 and 1967 - a finding that was  
accepted by the Appellants on appeal to the Court 20

p.142 1.22 of Appeal of Singapore - and he held that since  
to 44 1965 the Appellants have not sold or carried on any  
p.141 trade in "ACE Brand" tooth-brushes in Singapore and  
1.18-23 there was no evidence that they intended to do so  
in the future.

p.151 8. The Court of Appeal of Singapore (Wee Chong Jin  
1.16 C. J. Chua and Kulasekaram J. J.) held that as (on the  
to 32 undisputed facts) the Appellants had ceased exporting  
to Singapore their "ACE Brand" tooth-bruses from 1965  
right up to the time of the Writ in the action, their 30  
claim failed in limine.

M.R. accurately stated the law as follows:

"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 here no goods. As it seems to me, he has not in this Country any proprietary right which he is entitled to protect".

10 A passage cited by Choor Singh J. in his judgment in this case. p.141 1.30  
to p.142  
1.4

10. Choor Singh J. and the Court of Appeal of Singapore held that any goodwill or proprietary right in Singapore that may have been vested in J. H. Leung, as sole proprietor of Star Brush Manufacturing Co., in "ACE Brand" tooth-brushes was never assigned to the Appellants. p.133  
1.6-12  
p.140 1.29  
to p.141  
1.23  
p.150 1.42  
to p.151  
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20 Such a finding is supported by the evidence and in any event even if it were not so (which is denied) it would not effect the findings and conclusions of Choor Singh J. and the Court of Appeal of Singapore set out in paragraphs 7 and 8 above.

11. Further both Choor Singh J. and the Court of Appeal of Singapore held that as all the "ACE Brand" tooth-brushes which were manufactureed by the Appellants in Hong Kong and imported into Singapore bore the label "Star Brush Manufacturing Co". on their packets the Appellants could not rely upon such user as p.134 1.46  
to p.135  
1.17  
p.139 1.21  
to p.140  
1.28  
p.151 1.2  
to 15

30 Singh J. stated that by selling their "ACE Brand" tooth-brushes in Singapore in packets labelled "Star Brush Manufacturing Co." the Appellants were p.139 1.39  
to p.140  
to 1.28



falsely representing that their tooth-brushes were the tooth-brushes of the Star Brush Manufacturing Co. Citing an observation of Clauson J. in Lacteosote v. Alberman that a mark should cease to be a mark "if it is assigned in such a way as to enable the transferee to use it, as to represent something other than that which the mark represented in the hands of the transferor", Choor Singh J. held that the deceptive action of the Appellants was contrary to public policy and gave the Appellants no right of property or goodwill in respect of the "ACE Brand" mark in Singapore.

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12. On the 28th January 1974 the Court of Appeal of Singapore made an order granting leave to appeal to the Judicial Committee of the Privy Council.

13. The Respondent submits that this appeal should be dismissed with costs for the following amongst other

#### REASONS

1. BECAUSE as the Courts below have rightly held, the Appellants have not established that in 1968 or at anytime thereafter they had any goodwill or property in Singapore in respect of the "ACE Brand" tooth-brush.

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2. BECAUSE the learned trial judge found as a fact that the Appellants have not sold any "ACE Brand" tooth-brushes in Singapore since 1965 and that there was no evidence that they intended to do so in the future .

3. BECAUSE the judgments of both the learned trial judge and of the Court of Appeal were right.

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