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

**[2022] SGIPOS 10**

Trade Mark Nos. 40201811254U, 40201814979U and 40201814978P

**IN THE MATTER OF TRADE MARK APPLICATIONS BY**

**ENG'S CHAR SIEW WANTAN MEE PTE. LTD.**

… *Applicant*

**AND OPPOSITION THERETO BY**

**PAULINE NEW PING PING**

… *Opponent*

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# GROUNDS OF DECISION

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# Pauline New Ping Ping
# v
# Eng's Char Siew Wantan Mee Pte. Ltd.

**[2022] SGIPOS 10**

Trade Mark Nos. 40201811254U, 40201814979U and 40201814978P
IP Adjudicator Andy Leck
4 April 2022

27 June 2022

**IP Adjudicator Andy Leck :**

## Introduction

1 This matter is one in a long line of disputes surrounding the successful *wanton mee*[1] hawker stall known as "Eng's".

2 This is a consolidated opposition to the following trade mark applications:

| **Trade Mark No.** | **Mark** | **Class** | **Specification** |
|---|---|---|---|
| 40201811254U | 榮 ENG'S 高 | 43 | Take away food services; Serving food and drinks; Providing food and drink; Providing of food and drink; Provision of food and drink; |

[1] Wanton mee consists of egg noodles and wanton dumplings, usually garnished with leafy vegetables. Wanton dumplings usually contain prawn or pork. Wanton mee is one of the common hawker offerings among Singapore street food. "Wanton" is also sometimes spelt as "wantan".

| | | | |
|---|---|---|---|
| | | | Preparation of food and drink; Restaurants; Restaurant services; Restaurant reservation services. |
| 40201814979U | 榮高 | 43 | Take away food services; Serving food and drinks; Providing food and drink; Providing of food and drink; Provision of food and drink; Preparation of food and drink; Restaurants; Restaurant services; Restaurant reservation services. |
| 40201814978P | ENG'S | 43 | Take away food services; Serving food and drinks; Providing food and drink; Providing of food and drink; Provision of food and drink; Preparation of food and drink; Restaurants; Restaurant services; Restaurant reservation services. |

(collectively referred to as "**the Application Marks**").

## Background facts

3 The "Eng's" wantan mee business is famous for its award-winning noodles, handmade wantan dumplings and spicy hot chilli sauce.

***The Eng's hawker business***

4 The Ng family's wantan mee business started in the 1950s as a pushcart in the East Coast area operated by Mr Ng Kit. His son, Mr Ng Ba Eng ("Mr Ng"), frequently helped out at and eventually took over the business in or around 1962, with a permanent space at Duku Road.[2]

5 Sometime in the 1980s, Mr Ng operated the business from a hawker stall on the second floor of Dunman Food Centre (the "Eng's Hawker Business"), bearing the signboard "ENG'S CHAR SIEW[3] WANTAN MEE".[4] It is not disputed that the name "Eng's" was derived from Mr Ng's name, Ng Ba Eng.

6 In Mandarin, the business was known as "**榮高叉烧云吞面**" which is transliterated as "Rong Gao Cha Shao Yun Tun Mian". The Chinese characters have the following meanings:

| | |
|---|---|
| **榮** | glory |
| **高** | high |
| **叉烧** | "char siew", see footnote 3 |
| **云吞面** | "wanton mee", see footnote 1 |

Mr Ng's nickname was "high nose" because of his high nose-bridge. It is the Applicant's evidence that taken as a whole, the sign "**榮** ENG'S **高**" was intended to signify the wantan mee business being the pride and glory of the Ng family.[5] "**榮高**" also appears in Trade Mark Nos. 40201811254U and 40201814979U at [2] above.

[2] Desmond's SD at [6] – [7].

[3] "Char siew" is a Cantonese style of barbecued pork.

[4] Desmond's SD at [8].

[5] Desmond's SD at [8].

7 The Eng's Hawker Business subsequently moved from the second floor to a stall in the basement of the Dunman Food Centre. The stall bore a white signboard with the English words "Eng's Char Siew Wan Ton Mee" in blue and the Chinese characters "**榮高叉燒雲吞麵**" in red:


*Figure 1: The signboard at the Dunman Food Centre basement stall*

8 In 2009, Mr Ng's son Desmond Ng Weng San ("Desmond") joined him in operating the Eng's Hawker Business at Dunman Food Centre.

***The joint venture***

9 Around 2012, Mr Ng and Desmond were approached by a businessman customer, one Jason Sim ("Jason"), who proposed a collaboration with the Eng's Hawker Business. Jason is the Opponent's husband. Following successful negotiations, Eng's Noodle House Pte Ltd ("ENHPL") was incorporated on 27 February 2012 with Desmond and the Opponent as shareholders and directors.

10 Mr Ng and Desmond commenced business operations from ENHPL's new premises at 287 Tanjong Katong Road ("287 TKR Premises"). ENHPL

operated the wantan mee business from the 287 TKR Premises for 6 years, from around 27 February 2012 to 28 February 2018.

11 The 287 TKR Premises displayed 2 signboards facing the main road:


*Figure 2: The top 298 TKR Premises signboard*


*Figure 3: The bottom 298 TKR Premises signboard*

12 The top signboard at the 287 TKR Premises prominently displayed the words "[t]he only original from Dunman Food Centre".[6]

13 Jason loaned $150,000 progressively to ENHPL, which ENHPL applied towards renovations and necessary installations at the 287 TKR Premises. The loan was recorded in ENHPL's accounts as an amount owed to Jason. The loan was fully repaid to Jason within a year of ENHPL commencing operations.[7]

14 Mr Ng passed away on 17 June 2013. Following the issuance of additional shares on 12 August 2015, the Opponent and Desmond each had their shareholding reduced to 47.5%; and one Teng Cheng Hai (or "Bill"), an

[6] Desmond's SD at [14].

[7] TCH's SD at [11].

employee at one of Jason's companies, was employed to assist and manage ENHPL's finances and given 5% of the shareholding.

15 It is not disputed that ENHPL enjoyed considerable success during its operations at the 287 TKR Premises. For example, in 2017, ENHPL attracted more than SGD 1.6 million in revenue.[8]

***Breakdown of the joint venture ENHPL and incorporation of the Applicant***

16 In or around 2017, the relationship between Jason and Desmond started to sour.

17 On 8 February 2017, Ng Mui Hong ("NMH"), a sister of Desmond, being aware of the deteriorating relationship between Jason and Desmond, registered a sole proprietorship as "Eng's Char Siew". It is the Applicant's evidence that this was done in anticipation of having an avenue to carry on the family business.[9]

18 The lease for the 287 TKR Premises was due to expire on 15 March 2018. The Opponent, who was supposed to sign the new lease in ENHPL's name, did not follow up to ensure that a new lease was obtained for continuation of ENHPL's business at the 287 TKR Premises.[10]

19 It is not disputed that ENHPL ceased business operations on 28 February 2018 and is currently dormant, with no business whatsoever.[11] The Opponent and Desmond resigned as directors of ENHPL on 8 June 2018 and 9 July 2018

[8] Pauline's 1st SD at [25].

[9] Desmond's SD at [23]; NMH's SD at [15].

[10] *Eng's* HC(A) Decision at [12] – [13] (Desmond's SD at p. 115 –116).

[11] Pauline's 1st SD at [22]; Desmond's SD at [23].

respectively, leaving Bill the only director of ENHPL (having assumed directorship only on 8 June 2018).

20 The 287 TKR Premises was eventually rented by Eng's Wantan Noodle Pte Ltd, a company incorporated on 28 February 2018.[12]

21 The sole proprietorship (Eng's Char Siew) was replaced by the Applicant, Eng's Char Siew Wantan Mee Pte Ltd, which was incorporated in Singapore on 5 March 2018. The current shareholders of the Applicant are NMH and Ng Mei Ling ("NML"). Both NMH and NML are Desmond's sisters.

22 In or around May 2018, the Applicant began operating its wantan mee business at 248/250 Tanjong Katong Road.[13] It is presently still operating there.

23 The effect of the above is that there are now two main competing businesses in Singapore selling wantan mee under the "Eng's" name. The first, Eng's Char Siew Wantan Mee Pte Ltd, is operated by the Applicant (and the Ng family). The second, Eng's Wantan Noodle Pte Ltd, is operated by Jason, his wife the Opponent and their business associates. Both businesses (and/or their associates in each camp) have filed a series of claims, counterclaims and registry disputes in a tussle over the late Mr Ng's legacy.

**Procedural history**

24 The Applicant applied to register i) Trade Mark No. 40201811254U (the "Eng's and Chinese Characters Mark" on 8 June 2018, ii) Trade Mark No. 40201814979U on 31 July 2018 (the "Chinese Characters Mark") and iii) Trade

[12] Desmond's SD at [23].

[13] NMH's SD at [17].

Mark No. 40201814978P (the "Eng's Mark") on 31 July 2018, all in Class 43[14]. I shall refer to 8 June 2018 and 31 July 2018 collectively as the "Relevant Dates".

25 The application for the Eng's and Chinese Characters Mark was accepted and published on 19 October 2018 for opposition purposes. The Opponent filed its Notice of Opposition to oppose this application on 19 February 2019. The Applicant filed its Counter-Statement on 28 May 2019.

26 The application for the Chinese Characters Mark was accepted and published on 30 November 2018 for opposition purposes. The Opponent filed its Notice of Opposition to oppose this application on 28 March 2019. The Applicant filed its Counter-Statement on 12 June 2019.

27 The application for the Eng's Mark was accepted and published on 14 December 2018 for opposition purposes. The Opponent filed its Notice of Opposition to oppose this application on 11 April 2019. The Applicant filed its Counter-Statement on 12 June 2019.

28 The oppositions to the applications were consolidated from the close of pleadings. As such, each party filed a single set of evidence in respect of the consolidated oppositions to the applications.

29 The Opponent filed its re-executed evidence in support of the opposition on 14 February 2020. The Applicant filed its evidence in support of the applications on 4 October 2021. The Opponent filed its evidence in reply on 6 December 2021. Following the close of evidence, a Pre-Hearing Review was held 5 January 2022. The matter was set down for a full hearing on 4 April 2022.

[14] See [2] above.

30 Parties elected to only file written submissions without appearing at the hearing to make oral submissions. Both parties filed their written submissions on 4 March 2022.

**Grounds of opposition**

31 The Opponent relies on Section 7(6) and Section 8(7)(a) of the Trade Marks Act 1998 (the "Act") in this opposition.

**Opponent's evidence**

32 The Opponent's evidence comprises the following:

(a) a Statutory Declaration made by Pauline New Ping Ping, purportedly acting in a representative capacity of ENHPL, on 10 February 2020 in Singapore ("Pauline's 1st SD"); and

(b) three Statutory Declarations in Reply made by the same Pauline New Ping Ping on 6 December 2021 in Singapore.

**Applicant's evidence**

33 The Applicant's evidence comprises the following:

(a) a Statutory Declaration made by NMH, a shareholder / director of the Applicant, on 1 October 2021 in Singapore ("NMH's SD");

(b) a Statutory Declaration made by Bill, a freelance bookkeeper for the Applicant, on 1 October 2021 in Singapore ("TCH's SD"); and

(c) a Statutory Declaration made by Desmond, an employee of the Applicant, on 1 October 2021 in Singapore ("Desmond's SD").

## Applicable law and burden of proof

34 There is no overall onus on the Applicant before the Registrar during examination or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

## Preliminary issue – whether the Opponent is entitled to bring the Opposition

35 It is not disputed that the Opponent has brought this opposition purportedly for and on behalf of ENHPL.[15]

36 The Applicant submits that the Registrar ought to have the inherent discretionary power to dismiss this opposition on this basis.[16]

37 Section 13(2) of the Act allows "[a]ny person" to give notice to the Registrar of that person's opposition to a trade mark registration. This does not limit the persons who can file opposition proceedings to the parties who have suffered loss or damage, nor to parties who have an interest in the ownership of the trade marks in question. In *J.-.E Borie SA v MHCS* [2013] SGIPOS 4, it was held at [23] that:

> (a) a plain reading of Section 13(2) states that "any person" may give a notice of opposition;
>
> (b) an examination of the Act shows that the issue of the requisite standing of a person to bring various types of proceedings is spelt out in the relevant provisions (for instance, "any person" may give notice of

[15] Applicant's Written Submissions ("AWS") at [9]; Opponent's Written Submissions ("OWS") at [2]; Pauline's 1st SD at [3].

[16] AWS at [10].

an opposition, whereas only a "person having a sufficient interest" may apply for the rectification of an error or omission in the Register);

(c) such an interpretation is also consistent with the approach taken by other common law jurisdictions in relation to the corresponding provisions in their respective legislations which adopt similar language to Section 13(2) of the Act; and

(d) a person can in any event rely on third party marks in support of an opposition brought under other sections in the Act.

38 This is different from a scenario where:

(a) a person seeks to bring a common law derivative action on behalf of a company, in which case it is settled that leave is not required to commence such action but required to continue pursuance of the same; or

(b) a person seeks to commence a statutory derivative action under Section 216A of the Companies Act 1967 on behalf of a company, where statute requires the obtaining of leave prior to the commencement of any suit.

39 For completeness, I note that the issue of whether leave was required for the Opponent's continuance of a common law derivative action (and if so, whether an action should be dismissed for lack of leave at trial) was canvassed in detail in related proceedings before the High Court and the Appellate Division of the High Court in *New Ping Ping Pauline v Eng's Noodles House Pte Ltd and others* [2020] SGHC 271 ("*Eng's* HC Decision") and *New Ping Ping Pauline v Eng's Noodles House Pte Ltd and others* [2021] SGHC(A) 4

("*Eng's* HC(A) Decision") respectively. In the *Eng's* HC(A) Decision, the Appellate Division of the High Court found that the Opponent's common law derivative action failed as it was not filed in good faith in the interest of ENHPL (at [8] and [23]).

40 That said, the principles governing standing to bring opposition proceedings under the Act differ from standing to bring a common law derivative action or its statutory counterpart under the Companies Act 1967. Given the discussion above regarding the meaning of "any person" under Section 13(2) of the Act, I am of the view that the Opponent is entitled to bring this opposition even if she does not have any mandate to do so on behalf of ENHPL.

41 I therefore find that the Registrar has no power to dismiss an opposition solely on the basis that the Opponent is not a director of ENHPL nor received any mandate from ENHPL to initiate this opposition.

42 I now turn to consider the two grounds of opposition relied on by the Opponent.

**Ground of opposition under Section 8(7)(a) – Use of the Application Marks in Singapore is liable to be prevented by the laws of passing off**

43 The first ground of opposition that the Opponent relies on is Section 8(7)(a) of the Act, namely that the Application Marks should not be registered as use of such marks in Singapore is liable to be prevented by the laws of passing off.

44 Section 8(7)(a) of the Act reads:

> (7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

> (a) by virtue of 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…

45 To succeed on this ground of opposition, the Opponent must be able to establish the three classical elements of passing off (*Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 at [27] – [28]):

(a) goodwill, namely that ENHPL has goodwill attached to the goods / services it supplies in the mind of the purchasing public by association with the identifying "get-up" (including brand names) under which its particular goods / services are offered to the public, such that the get-up is recognised by the public as distinctive of ENHPL's goods and no others. Further:

(i) the relevant date for establishing goodwill is at the date where the acts complained of were carried out (*Mopi Pte Ltd v Central Mercantle Corp (S) Ltd* [2001] SGHC 328 ("*Mopi*") at [113]); and

(ii) goodwill must attach to a business (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 ("*CDL Hotels*") at [46]);

(b) misrepresentation, namely that the Applicant has made a misrepresentation to the public (whether intentional or otherwise) leading (or likely to lead) the public to believe that goods / services offered by the Applicant are those of ENHPL's; and

(c) damage, namely that ENHPL suffers (or is likely to suffer) damage by reason of the erroneous belief engendered by the Applicant's misrepresentation.

46 The Applicant's case is that:[17]

(a) the Opponent has the burden of proving that ENHPL owned the necessary goodwill and that goodwill is being damaged;

(b) goodwill in the business never accrued to ENHPL as the marks used in ENHPL's wantan mee business were at all material times licensed to ENHPL by Mr Ng and/or the Ng family;

(c) as ENHPL never exclusively owned any goodwill, and has totally ceased business operations, no damage can be suffered by it.

47 The Opponent's case is that:

(a) in relation to the goodwill element:

(i) the Singapore public recognises what the Opponent terms the "ENHPL Marks"[18] to be ENHPL's business indicia, as

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[17] AWS at [15].

[18] OWS at [25]. The Opponent refers to the following as the "ENHPL Marks": the "ENG'S" mark (word mark in green); the "榮高" mark (Chinese characters in red) which is transliterated at "Rong Gao"; the "ENG'S CHAR SIEW WANTAN MEE 叉燒雲吞麵" mark, the Chinese characters of which are transliterated as "Cha Shao Yun Tun Mian"; the "ENG'S NOODLE HOUSE CHAR SIEW WANTAN MEE 叉燒雲吞" mark, the Chinese characters of which are transliterated as "Cha Shao Yun Tun Mian"; and the 2 signboards used at the 287 TKR Premises, namely the " 

" mark; and the " 

" mark.

these marks were continuously and exclusively used in ENHPL's restaurant business from 2012 to 2018;[19]

(ii) ENHPL's continued use and promotion of the ENHPL Marks has rendered these trade names and marks synonymous with the food quality and taste of the wantan mee served by ENHPL with its signature hot spicy chilli sauce;

(iii) ENHPL's growing annual sales revenue from 2012 to 2017 is testament to the growing goodwill and brand loyalty acquired by ENHPL;

(iv) the Applicant's use of the key elements of the ENHPL Marks, even after ENHPL ceased operations, has inadvertently continued to perpetuate ENHPL's goodwill in these trade names and marks;

(b) in relation to the misrepresentation element:

(i) the Applicant's choice of an identical trade name and use of the Application Marks are likely to cause the relevant sector of the public to associate the Applicant's restaurant services and goods with ENHPL;[20]

(ii) the Applicant has misrepresented to the Singapore public that the Applicant and ENHPL are of the same trade source and/or trade origin, or that there is a nexus between the two businesses, and/or that it is somehow related, connected or

[19] OWS at [170].

[20] OWS at [186].

associated with ENHPL when no such relations, connection or association exists, by:[21]

(A) operating an identical specialty wantan mee restaurant in the same locality as the 287 TKR Premises;

(B) choosing an identical trade name, "ENG'S CHAR SIEW WANTAN MEE";

(C) using ENHPL's other indicia (such as the "ENG'S", "荣高" word marks and chilli logo) in the Applicant's restaurant and publicity materials; and

(D) adopting an almost identical "get up" in its restaurant"; and

(c) in relation to the damage element:[22]

(i) the Opponent only needs to show a real tangible risk of substantial damage to ENHPL to satisfy this element, which may be displaced by proof that ENHPL did not suffer any damage as a matter of fact (*Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR 216 ("*Novelty*") at [63] and [105]);[23]

(ii) there is a real risk of tangible damage to ENHPL's business and goodwill, including through:[24]

(A) blurring (where ENHPL's get-up has become indicative of the Applicant's goods, services and

[21] OWS at [193].

[22] OWS at [232] – [235].

[23] OWS at [232] – [233].

[24] OWS at [234].

business, thereby causing sales to be diverted from ENHPL to the Applicant);

(B) dilution of goodwill;

(C) loss of revenue from licensing and co-branding opportunities;

(D) tarnishment of the Applicant's business, goods or services; and

(E) diversion of trade; and

(iii) ENHPL's dormant status does not displace the fact that there is a real tangible risk that ENHPL's goodwill in its business and marks has suffered damage.[25]

**Application of Section 8(7)(a) to the facts**

***Whether ENHPL has goodwill in the Application Marks***

48 Goodwill is a reflection of the public state of mind on the one hand, and legal property on the other (see Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 5th Ed, 2016) ("*Wadlow*") at para 3-138).

49 The essential features of goodwill are (see *Novelty* at [39]):

> … First, it is the association of a good, service or business on which the plaintiff's mark, name, labelling, etc (referred to generically as the plaintiff's "get-up") has been applied with a particular source. Second, this association is an "attractive force which brings in custom…

[25] OWS at [235].

50 At this juncture, it would be appropriate for me to briefly summarise the counterclaim brought by NMH, NML and the Applicant ("Counterclaimants") against the Opponent in the *Eng's* HC Decision. In that case, the Counterclaimants alleged that the Opponent had committed the tort of passing off through her various alleged acts of collusion with Eng's Wantan Noodle Pte Ltd.[26] This counterclaim ultimately failed as the Counterclaimants failed to establish that: (a) they owned the goodwill in the Eng's wantan mee business;[27] and (b) misrepresentation by the Opponent, since the entity responsible for any claimed misuse would have been Eng's Wantan Noodle Pte Ltd (and not the Opponent).[28]

51 While not directly relevant to this ground of opposition in the present proceedings (namely, that use of the Application Marks by the Applicant would be liable to be prevented by the law of passing off), it is important to bear in mind certain findings of the High Court in the *Eng's* HC Decision in relation to the goodwill in the Eng's wantan mee business. These were not disturbed on appeal in the *Eng's* HC(A) Decision.

52 In the *Eng's* HC Decision, Valerie Thean J found (at [24]) that:

> In the present case, the good being sold was wanton mee. It is associated with a particular source, namely the business using the late Mr Ng's recipe and method of preparation. In particular, the wanton mee is known for its "springy noodles" and accompanied by a "gunpowder" chilli paste. It is this association that formed the attractive force that brought in custom.

53 Thean J also found, in relation to the ownership and attachment of the goodwill in the Eng's wantan mee business, that:

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[26] *Eng's* HC Decision at [44].

[27] *Eng's* HC Decision at [143].

[28] *Eng's* HC Decision at [144].

(a) during the years at Dunman Food Centre, the goodwill was owned by Mr Ng and attached to the Eng's Hawker Business;[29] and

(b) during the period of ENHPL's operation of the wantan mee business at the 287 TKR Premises while Mr Ng was alive, i.e. from 27 February 2018 until 17 June 2013, there was a licensing arrangement, (although not labelled as such by the parties) of the goodwill and various Eng's marks (which would include the Application Marks) from Mr Ng as licensor to ENHPL as licensee. The consideration for this licence was reflected in the sum of Mr Ng's salary.[30] Without such consent from Mr Ng, use by ENHPL of the signboards at the 287 TKR Premises (featuring, among others, the Application Marks) would have amounted to passing off.[31] In other words, during this period, the goodwill in the Eng's wantan mee business continued to be owned by Mr Ng, and attached to ENHPL.[32]

54 It is after Mr Ng's passing on 17 June 2013 that ownership of the goodwill in the Eng's wantan mee business become unclear. In the *Eng's* HC Decision, Thean J rejected the arguments put forth by NMH, NML and the Applicant that that the licensing arrangement continued despite Mr Ng's passing on 17 June 2013, in particular, that:[33]

(a) it was the "family intention" for Mr Ng to assign goodwill in the Eng's wantan mee business to the Ng family after his passing, and that

[29] *Eng's* HC Decision at [126].

[30] *Eng's* HC Decision at [133].

[31] *Eng's* HC Decision at [134].

[32] *Eng's* HC Decision at [134].

[33] *Eng's* HC Decision at [138].

he had done so such that the Ng family had come to own such goodwill after his passing; and

(b) further and/or alternatively, the Ng family had made substantive and critical contributions to ENHPL's operations, which entitled them to ownership of the goodwill.[34]

55 Pertinently, the dismissal of the counterclaim, which was not appealed, was based on the following:

(a) there was no evidence that the public attributed the goodwill to other members of the Ng family, aside from the late Mr Ng or Desmond; and

(b) even if the news coverage evidence put forth was taken as reliable evidence of who the public attributed goodwill to, those persons would have been the late Mr Ng and at most, Desmond.[35] However, Desmond was not a plaintiff in the Counterclaim nor was there an assertion in the Counterclaim that he was the owner of goodwill. Accordingly, the Counterclaimants were unable to prove ownership of goodwill.[36]

56 I accept that during ENHPL's operation of its wantan mee business at the 287 TKR Premises from 2012 to 2018, when ENHPL was still carrying on business, goodwill in the Eng's wantan mee business (and the Application

[34] *Eng's* HC Decision at [139].

[35] *Eng's* HC Decision at [143].

[36] *Eng's* HC Decision at [143].

Marks) attached to ENHPL. This was the case even after Mr Ng's passing on 17 June 2013.

57 The Opponent has adduced evidence to this effect. For example, there is evidence that ENHPL used the ENG'S mark and/or the 榮高 mark in its operations at the 287 TKR Premises from 2012 to 2018.[37] There is also evidence of the significant publicity and reputation enjoyed by ENHPL during the operation of its business around 2012 to 2018.[38] These include a newspaper article on "The Straits Times – The School Pocket Money Fund" dated 5 May 2012 showcasing the use of, among others, the Application Marks in 2012, reviews from popular food websites (like Makansutra, MissTamChiak, ieat.ishoot.ipost) and even International social media platforms such as Trip Advisor, Yelp & Facebook, attesting to the growing popularity of ENHPL amongst the Singapore public.

58 As to who owned the goodwill in the Eng's wantan mee business after Mr Ng's passing, I note that the High Court had left open the possibility that Desmond was also a concurrent owner of such goodwill (see [55(b)] above). There is evidence that many customers visited ENHPL seeking Desmond out and associated the Eng's wantan mee business with Mr Ng and Desmond.[39] There is also evidence that Desmond remained instrumental in the Applicant's operations to bring in custom.[40] I also note that the Applicant has sought to "regularise matters" by having the Ng family (including Desmond) execute a Deed of Assignment between Mr Ng's wife, Desmond, NMH, NML and one

[37] Pauline's 1st SD at [20] – [32].

[38] Pauline's 1st SD at exhibit "PN-5" at p. 188 – 223.

[39] Desmond's SD at [35].

[40] *Eng's* HC Decision at [143].

Lim Ah Keat (i.e. Desmond's wife), assigning any goodwill they own in relation to the sale of "Ng Ba Eng's wantan noodles under the Eng's trade marks" and certain trade marks (including the Application Marks) to the Applicant.[41] Nonetheless, it is not necessary for the purposes of these opposition proceedings to make any finding regarding the ownership of such goodwill after Mr Ng's passing and I make no findings in relation to the same.

59 Notwithstanding the above, it must be emphasised that one of the essential characteristics of goodwill is its inseparable connection to a business. Per a local leading text on Intellectual Property, Ng-Loy Wee Loon, S.C., *Law of Intellectual Property of Singapore* (Sweet & Maxwell Asia, 3rd Rev Ed, 2021) ("*Ng-Loy*") at para 17.1.4:

> The second essential characteristic of goodwill is its inseparable connection to a *business*: goodwill can only exist attached to a business. This has important implications. In particular, if a plaintiff has no business in Singapore, it means that there is no substratum here to which goodwill can attach and hence the plaintiff cannot be said to have any goodwill in Singapore – even if he can show that his goods or services enjoy a reputation amongst the public in Singapore. This is the so-called 'hard-line' approach in passing off. In contrast, some countries like Australia and Canada adopt the 'soft-line' approach where proof of reputation within jurisdiction alone is sufficient to satisfy the first element of passing off.
>
> [emphasis in original]

60 In other words, goodwill cannot exist independently and must attach to a business (*CDL Hotels* at [46]). If an entity is not carrying on business in Singapore, it means there is no substratum here to which goodwill can attach. If a business is abandoned in one country in which it has acquired a goodwill, the goodwill in that country perishes with it (*Star Industrial Co Ltd v Yap Kwee Kor*

[41] Desmond's SD at exhibit "DN-13" at p. 289 – 295

*(trading as New Star Industrial Co)* [1974 – 1976] SLR(R) 581 ("*Star Industrial*") at [8]).

61 In *Star Industrial*, the plaintiff was a Hong Kong company which had a substantial business presence in Singapore between 1953 and 1965, selling its "ACE BRAND" toothbrushes imported from Hong Kong. By 1965, the "ACE BRAND" mark had become associated in the mind of the public exclusively with the plaintiff's toothbrushes. In 1965, the plaintiff decided to withdraw from the Singapore market when a new import duty imposed by the Singapore Government no longer made its importation of toothbrushes for sale profitable in Singapore. About 3 years later in 1968, the defendant adopted the "ACE BRAND" mark for its toothbrushes because there was still some residual reputation of this brand amongst the Singapore public.

62 Despite this residual reputation, the Privy Council found no passing off, with Lord Diplock (who delivered the judgment) stating at [8] that:

> Goodwill, as the subject of proprietary rights, is incapable of subsisting by itself. It has no independent existence apart from the business to which it is attached. It is local in character and divisible; if the business is carried on in several countries a separate goodwill attaches to it in each. So when the business is abandoned in one country in which it has acquired a goodwill the goodwill in that country perishes with it although the business may continue to be carried on in other countries … Once the Hong Kong company had abandoned that part of its former business that consisted in manufacturing toothbrushes for export to and sale in Singapore it ceased to have any proprietary right in Singapore which was entitled to protection in any action for passing off brought in the courts of that country.

63 Further, the relevant date for establishing goodwill is the date that the acts complained of were carried out (*Mopi* at [113]).

64 In this case, the acts complained of are the Applicant's applications to register the Application Marks on the Relevant Dates, namely on 8 June 2018 (for the Eng's and Chinese Characters Mark) and 31 June 2018 (for the Chinese Characters Mark and Eng's Mark).

65 Since it is not disputed that ENHPL ceased operations on 28 February 2018 and from that point onwards remained dormant with no business whatsoever, it follows that no goodwill attached to ENHPL as at the Relevant Dates since there was no business carried on by ENHPL to speak of.

66 Accordingly, I find that the Opponent has failed to make out the element of goodwill.

***Whether the Applicant has misrepresented to the public that the services offered by the Applicant are those of ENHPL's***

67 Turning to the second element of passing off, the Opponent must show that the Applicant's use of the Application Marks would amount to a misrepresentation that caused (or is likely to cause) confusion among the relevant public that the services offered by the Applicant are those of ENHPL's (*Singsung* at [70]). The relevant segment of the public are the actual or potential customers of ENHPL.

68 The Opponent argues that the Applicant's actions at [47(b)(ii)] above constitute misrepresentation, and that such misrepresentation is likely to cause and exacerbate confusion among the relevant section of the public, into thinking that the Applicant is somehow economically related, connected or associated with ENHPL when it is not.[42]

[42] OWS at [204].

69 Pertinently, whether the identifiers in question are distinctive of ENHPL and/or its goods is a crucial facet of the inquiry as to whether misrepresentation or deception in fact occurred. As long as what is copied is not distinctive of the claimant or its goods, the defendant should not be prohibited from copying these features since no misrepresentation or deception as to origin would result (see *Singsung* at [55]).

70 According to the Court of Appeal in *Singsung* at [38], the issue of distinctiveness is best understood as a threshold inquiry in the context of determining whether a defendant has committed an actionable misrepresentation. In other words, proof that the Application Marks have become distinctive of ENHPL's goods is a condition precedent to the misrepresentation element in a passing off action. Similarly, where the alleged representation consists of the use of a get-up, the claimant is required to show that the get-up in question has become so distinctive that the relevant segment of the public recognises goods / services with that get-up as originating from the claimant.

71 I accept the Applicant's evidence that the Opponent has failed to establish that the Application Marks are associated exclusively with ENHPL and no other. The Application Marks were used by Mr Ng and the Ng family for decades in relation to the Eng's wantan mee business, prior to ENHPL's incorporation and/or operations. I refer to, for example, the signboard at the Dunman Food Centre basement stall (see [7] above), which featured the "ENG'S" word mark (i.e. the Eng's Mark), the Chinese characters "榮 高" (i.e. the Chinese Characters Mark, albeit separated on either side of the signboard), and which together form the "榮 ENG'S 高" mark (i.e. the Eng's and Chinese Characters Mark).

72 ENHPL only used such marks for 6 years from 2012 to 2018, a fraction of the length of Mr Ng's prior use of such marks. Both this and the continued physical presence of Mr Ng and Desmond previously at ENHPL, and Desmond currently at the Applicant, would more likely result in the public continuing to associate such marks with the Ng family, instead of ENHPL.

73 Accordingly, I do not find that there is any misrepresentation by the Applicant.

***Whether ENHPL suffers (or is likely to suffer) damage by reason of the misrepresentation***

74 Even if the Opponent succeeds in making out the 2 elements of goodwill and misrepresentation, I find that the Opponent has not adduced sufficient evidence to show there is a "real tangible risk" of substantial damage to ENHPL (*Novelty* at [63]).

75 Despite arguing that as a result of the Applicant's misrepresentations, there is a real tangible risk of damage to ENHPL's business and goodwill with reference to the factors in *Novelty* (see [47(c)(ii)] above),[43] the Opponent has not adduced any evidence to justify or make out such factors.

76 In any event, as the Opponent itself submits, this "real tangible risk" can be displaced by proof that ENHPL did not suffer damage as a matter of fact (*Novelty* at [105]). Given that it is not disputed that ENHPL is a dormant business with no business operations to speak of,[44] even if there was a real

[43] OWS at [234].

[44] Pauline's 1st SD at [36]; Desmond's SD at [23].

tangible risk of substantial damage to ENHPL, this presumption is displaced in the present case.

77 I therefore find that the Opponent has failed to make out the third element of this ground of opposition.

***Opponent's submissions regarding the "own name" defence***

78 Finally, I also note that the Opponent has pre-emptively sought to argue that the Applicant cannot avail itself of the "own name" defence, namely that the Applicant is entitled to carry on its business in its own name as long as it does not do anything more than cause confusion with the business of another, provided it does so honestly. The Opponent argues that the Applicant is not entitled to do so as the Applicant's conduct falls short of this "honest practices" proviso.[45]

79 In its written submissions, the Applicant has not sought to rely on this defence to the Opponent's allegations of passing off. It is therefore not necessary to deal with this issue.

80 For completeness, while defendants in past cases have attempted to rely on the "own name" defence in response to a claim for passing off (*The Audience Motivation Co Asia Pte Ltd v AMC Live Group China Pte Ltd* [2016] 3 SLR 517) ("*AMC*"), the observation by *Ng-Loy* is that in reality, there should be no defence to passing off (at para 16.2.4). The Court of Appeal noted in *obiter* in *AMC* at [104] that if a plaintiff succeeds in proving the "classical trinity" of passing off, his right to protect his goodwill should prevail over the defendant's right to use his own name (at [104]).

[45] OWS at [207] – [231].

**Conclusion on opposition under Section 8(7)(a)**

81 The ground of opposition under Section 8(7)(a) therefore fails.

**Ground of opposition under Section 7(6) – Application Marks should not be registered as the applications were made in bad faith**

82 I now turn to the second ground of opposition under Section 7(6) of the Act, namely that the Application Marks should not be registered as the applications were made in bad faith.

83 Section 7(6) of the Act reads:

> (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

84 The Court of Appeal in *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 ("*Wing Joo Loong*") held at [106] that the test for bad faith involves:

> (a) an objective element (i.e., that the conduct of the Applicant fell short of the appropriate standard, namely acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined); and
>
> (b) a subjective element (i.e., that the Applicant knew of facts which, to an ordinary honest person, would have made the latter realise that what the Applicant was doing would be regarded as breaching those standards).

85 Bad faith is to be determined as at the date of the application(s) in question, although matters that occurred after the date of application(s) may assist in determining an applicant's state of mind as at the date of the application

can be taken into consideration: see *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 ("*Festina Lotus*") at [100].

86 An allegation of bad faith is a serious claim to make and must be sufficiently supported by evidence (*Ng-Loy* at para 21.4.1):

> An allegation of bad faith is a serious one, and it must be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.

87 In other words, while there is no absolute prohibition against drawing inferences, this will only be done in exceptional cases (*Ng-Loy* at para 21.4.1, citing *Festina Lotus* at [115]).

88 Further, it is accepted that the threshold for an allegation of bad faith is a high one and so the party alleging bad faith bears a heavy burden of proof (*Ng-Loy* at para 21.4.1).

89 The bad faith inquiry is a fact-sensitive one, and requires a holistic assessment of all relevant facts. I summarise some relevant factors to bear in mind when making this assessment (*Ng-Loy* at paras 21.4.5 to 21.4.15):

(a) resemblance between the parties' marks is not an essential ingredient in the bad faith doctrine, but a very relevant and even important factor in the bad faith inquiry. This is because resemblance between the marks goes towards establishing the link or nexus between the parties in dispute, which in turn provides the context for the investigation of the bad faith allegation.

(b) the breach by an applicant of a legal duty to do, or refrain from doing, an act is not an essential ingredient in the bad faith doctrine. Bad

faith in Section 7(6) captures conduct that falls short of the *moral* standards observed by the reasonable and honest man.

(c) a classic case of bad faith is where the applicant seeks to misappropriate a mark that rightfully belongs to a third party. This often manifests in the following scenario: the third party is the rightful proprietor of the trade mark in question (or a similar mark), and the applicant's attempt to register what he knows is not his amounts to "hijacking" of another's trade mark. To make out bad faith in such cases, it is not sufficient to show that the applicant knew of the existence of the trade mark and that the application mark had been used and/or been registered by a third party. The broader question is whether, in light of all the circumstances of the case, an ordinary honest person possessing this knowledge would have considered it appropriate to seek registration of the trade mark.

90 The Applicant's case is that:

(a) it does not constitute bad faith for a company to apply to register a trade mark just because it knows that third parties are using the same mark in relation to identical and/or similar goods and/or services;[46]

(b) all goodwill generated by the signboard marks, namely the various marks found at [7] and [11] above, and their components, resides in the Applicant. The Ng Family had never assigned its trade marks to ENHPL, nor did ENHPL file any trade mark applications during the time it was operating. Thus, the Applicant's applications to register the

[46] AWS at [72].

Application Marks fall within the standards of acceptable commercial behaviour;[47]

(c) the Opponent's case is premised on:

(i) the Opponent's belief that the Applicant has no right to register the Application Marks; and

(ii) unsubstantiated allegations upon which a finding of bad faith should be made by inference; and

(d) the Opponent has not met the high threshold required to establish bad faith.[48]

91 The Opponent's case is that the following shows the Applicant's bad faith in applying to register the Application Marks:[49]

(a) the past contractual relations between NMH, NML and ENHPL;

(b) the Applicant's failure to check the *bona fide* interests of ENHPL, before applying to register the Application Marks; and

(c) the Applicant's intention to prevent the Opponent and her associates from using the Application Marks.

[47] AWS at [74].

[48] AWS at [79]

[49] OWS at [101].

**Application of Section 7(6) to the facts**

92 The Court in *Festina Lotus* held (at [100]) that bad faith is to be determined as at the date of the application(s) in question. In the present case, this would be the Relevant Dates, namely (see [24] above):

(a) 8 June 2018 for the Eng's and Chinese Characters Mark;

(b) 31 July 2018 for the Chinese Characters Mark; and

(c) 31 July 2018 for the Eng's Mark.

***Past contractual relations between NMH, NML and ENHPL***

93 The Opponent argues that the past contractual relations with ENHPL evince the Applicant's bad faith, specifically:

(a) the Applicant is a separate legal entity incorporated by NMH and NML as joint owners and shareholders;

(b) the Applicant, NMH and NML are unrelated third parties with no stake or ownership in ENHPL;[50]

(c) the Applicant is a direct competitor to ENHPL and a third party to the existing contractual relationships between the owners of ENHPL (namely, the Opponent, Desmond and Bill);

(d) NMH is the co-owner and shareholder of Colorcode Print Pte Ltd, a former service provider engaged by ENHPL to carry out printing of collaterals / publicity materials over 6 years, and a third party to the existing contractual relations between the owners of ENHPL; and

[50] OWS at [106].

(e) NML was employed by ENHPL for around 6 years and is also a third party to the existing contractual relations between the owners of ENHPL.[51]

94 It appears that the Opponent is seeking to establish bad faith through inference – which while there is no prohibition against, is rarely possible (see [87] above).

95 Given the high threshold for establishing bad faith, and having regard to the fact that bad faith by inference is only possible in rare cases, I am of the view that the Opponent has not adduced sufficient evidence to infer that the Applicant had acted in bad faith based on the past contractual relations between NMH, NML and ENHPL.

***Failure to check ENHPL's interests before applying to register the Application Marks***

96 The Opponent also argues that the Applicant's bad faith is evinced by its awareness that ENHPL had "some sort of claim to the goodwill" in the Application Marks;[52] and that the Applicant had wilfully turned a blind eye and chose not to make the necessary enquiries prior to filing the applications for the Application Marks. The Opponent argues that this "deliberate avoidance" to make the necessary enquiries can only be explained by the fact that the Applicant knew that it lacked the legal rights to file the Application Marks, thereby establishing a finding of bad faith.[53]

[51] OWS at [105].

[52] OWS at [108].

[53] OWS at [129].

97 Again, it appears that the Opponent is asking for a finding of bad faith through inference, which is rarely possible.

98 Pertinently, in the recent Singapore High Court case of *Digi International Inc v Teraoka Seiko Co, Ltd* [2021] SGHC 165 ("*Digi International*"), it was held that it does not constitute bad faith for a party to apply to register a mark merely because he knows third parties are using the same mark in relation to identical goods or services, let alone where third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe he has a superior right to registration and use of the mark. Even if the applicant does not believe he has a superior right to registration and use of the mark, he may still believe he is entitled to registration (at [238], citing *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Ltd and others* [2008] EWHC 3032 (Ch) at [189]).

99 The Opponent argues that the Applicant knew (or must have known) that it did not possess any rights to the Application Marks as they are almost identical to the business indicia used and/or purportedly owned by ENHPL.[54]

100 The Opponent says that such knowledge is shown through the fact that NMH and NML were each a former employee of ENHPL who respectively handled and possessed ENHPL's branding collaterals, and handled ENHPL's daily operations.[55]

101 I do not find the Opponent's reliance on these facts persuasive in light of the principles in *Digi International* at [98] above. Knowledge that a third party is using an identical and/or similar mark in relation to identical and/or

[54] OWS at [114].

[55] OWS at [111] and [112].

similar goods or services does not *ipso facto* constitute bad faith. As noted in *Digi International*, an applicant might believe that he has a superior right to registration and/or use of the mark, or that he is entitled to registration nonetheless. Accordingly, the Applicant's knowledge of ENHPL's usage of marks identical and/or similar to the Application Marks when applying to register the same is, by itself, not tantamount to bad faith.

102 The Opponent also argues that a trade mark applicant should bear a positive duty to investigate into the *bona fides* of a mark before seeking registration.[56] In support of this principle, the Opponent cites the Singapore High Court case of *Rothmans of Pall Mall v Maycolson International Pte Ltd* [2006] 2 SLR(R) 551 ("*Rothmans*"), where the Honourable Justice Lai Siu Chiu (as she then was) stated that "[a] trade mark applicant should bear a positive duty to investigate into the *bona fides* of a mark before seeking registration" (at [19]).

103 The holding in *Rothmans* must be read in context. At [27] of the judgment, the Honourable Justice Lai Siu Chiu (as she then was) stated that a duty should be imposed on an applicant to make further inquiries if the circumstances would lead a reasonable person to harbour suspicions as to the propriety of the proposed mark. This gives colour to the statement imposing a positive duty to investigate into the bona fides of a mark before seeking registration (at [19] of *Rothmans*).

104 The sum effect of the above is that the Opponent must produce cogent evidence that the Applicant knew that it did not have the right to register the Application Marks and/or that the circumstances would lead a reasonable

[56] OWS at [149] – [152].

person to harbour suspicions as to the propriety of the proposed mark; yet the Applicant proceeded to file the applications anyway.

105 I am of the view that the Opponent has failed to do so. The Opponent has not produced any direct evidence regarding this point.

106 If anything, I am satisfied on the evidence that as of each of the Relevant Dates, the Applicant truly believed that it had a right to register the Application Marks. This is based on the following.

107 First, the Relevant Dates in this case are 8 June 2018 and 31 July 2018 (see [24] above). As of these dates, I accept the Applicant's evidence that the relevant members of the Ng family genuinely believed that they (and accordingly the Applicant) owned the intellectual property in the Application Marks and were entitled to register the same.

108 Following the breakdown of the relationship between the Ng family on the one hand and the Opponent and Jason on the other, NMH registered a sole proprietorship on 8 February 2017 which the Applicant says was in anticipation of having an avenue to carry on the family business and the legacy of Desmond's, NMH's and NML's parents. The Applicant was then incorporated on 5 March 2018 to replace the sole proprietorship.[57] The Applicant then applied to register the Application Marks on the Relevant Dates to safeguard these marks.[58]

109 The Applicant has also put forth evidence that as far as the Ng family were concerned, the Applicant had every right and entitlement to apply to

[57] Desmond's SD at [23].

[58] Desmond's SD at [24].

register the Application Marks that had been used by the Ng family business for decades, and that the Ng family (and accordingly the Applicant) were of the view that it was critical to do so to protect themselves against third parties who would otherwise ensure that they were prevented from carrying on the Eng's wantan noodle business.[59]

110 To this point, in the proceedings before the High Court (as reported in the *Eng's* HC Decision and the *Eng's* HC(A) Decision), the Counterclaimants argued that there was a licensing arrangement between Mr Ng as licensor and ENHPL as licensee (when Mr Ng was alive) and subsequently between members of the Ng Family and ENHPL (after Mr Ng's death), in respect of Mr Ng's goodwill in the Eng's wantan mee business and the following marks:[60]

(a) "Eng's Noodle House Char Siew Wantan Mee";

(b) "Eng's Char Siew Wantan Mee"; and

(c) "榮高雲吞麵".

111 Although Thean J rejected the argument by NMH, NML and the Applicant (i.e. the Counterclaimants) in the *Eng's* HC Decision that they had come to own goodwill in the Eng's wantan mee business based on heritage ownership or the contribution approach (see *Eng's* HC Decision at [138] – [143]), this does not preclude a finding that as of the Relevant Dates, the Applicant genuinely believed that it was entitled to register the Application Marks in its name.

[59] Desmond's SD at [25].

[60] *Eng's* HC Decision at [129].

112 This is also consistent with Thean J's findings in the *Eng's* HC Decision (which were not disturbed in the *Eng's* HC(A) Decision) at [87] that:

> The evidence of Desmond, [NMH, NML] and Mdm Loh show, rather, that the Ng family regarded the "Eng's" name as family property. They regarded it as something to be protected from unauthorised use, especially by [the Opponent], Jason and any of their associates.

113 Having regard to these circumstances as at the respective Relevant Dates, I therefore do not think that the Applicant knew of facts that to an ordinary honest person would have made the Applicant realise that its applications to register the Application Marks would be regarded as breaching the acceptable commercial behaviour observed by reasonable and experienced persons.

114 Second, the timing of the applications to register the Application Marks, which the Opponent claims are belated and therefore evince bad faith,[61] is consistent with Thean J's findings in the *Eng's* HC Decision that the Ng family came to be genuinely concerned about the use of the name "Eng's" by Eng's Wantan Noodle Pte Ltd following the breakdown of their relationship with the Opponent and Jason. After ENHPL lost the lease for the 287 TKR Premises to Eng's Wantan Noodle Pte Ltd in or around March 2018, NML and NMH scrambled to find alternative premises for the Ng family's wantan mee business (under the Applicant) before commencing operations on 13 May 2018.[62] The Relevant Dates came shortly after the Applicant commenced operations. I therefore accept the Applicant's evidence that the Applicant applied to register the Application Marks on the respective Relevant Dates, to protect what NMH

[61] OWS at [139].

[62] *Eng's* HC Decision at [99] (Desmond's SD at p. 85).

and NML saw as their family's "previous inheritance and use of [their] father's name".[63]

115 This is buttressed by the finding in the *Eng's* HC Decision, where Thean J found at [100] that:

> I am satisfied that the Ng family was genuinely concerned about the use of the name "Eng's" by [Eng's Wantan Noodle Pte Ltd]. The family members who testified at trial presented a unified and convincing narrative – The "Eng's brand" was threatened when a new tenant took over the [287 TKR Premises] looking to set up a similar business. The Ng family then rallied together to protect the "Eng's brand".

116 Third, the Opponent appears to rely on the Applicant's knowledge that there could be no licensing arrangement between the Ng family and ENHPL, as this was rejected by the High Court in the Eng's HC Decision. However, the Eng's HC Decision is dated 22 December 2020 – well after the Relevant Dates.

117 It should not be forgotten that bad faith in Section 7(6) of the Act captures conduct that falls short of the moral standards observed by the reasonable and honest man.

118 Given that the overarching question in the bad faith inquiry is whether, in light of all the circumstances of the case, an honest person possessing the Applicant's knowledge would have considered it appropriate to apply to register the Application Marks, I find the response in this case to be a resounding "yes".

[63] Desmond's SD at [24] and [31].

***Intention to prevent the Opponent and her associates from using the Application Marks***

119 For completeness, I now deal with the Opponent's submissions that the Applicant's bad faith is evinced by the Applicant's intention to prevent the Opponent from using the Application Marks.[64]

120 Given my finding at [106] to [118] above that as of the relevant application dates, the Applicant truly believed that it was entitled to register the Application Marks in its name, I find it inconsequential in this case whether the Applicant sought the registration of the Application Marks to prevent the Opponent and her associates from using these marks. While I note that this may be a relevant factor in assessing whether there was bad faith (*Tomy Inc v Dentsply Sirona* [2020] 5 SLR 424 ("*Tomy*") at [32](d)]), per the High Court in *Tomy*, bad faith requires a holistic assessment and whether an applicant intended to prevent a third party from continuing to use such a sign is merely one of the factors in this assessment and not conclusive of bad faith.

121 Even if this was the case, the overarching test for bad faith is whether an honest person possessing the Applicant's knowledge would have considered it appropriate to apply to register the Application Marks (which I find the Applicant would have). Accordingly, whether the Applicant's motivations for filing these applications was to prevent the Opponent from using the Application Marks is not determinative of bad faith.

[64] OWS at [116] – [117].

**Conclusion on opposition under Section 7(6)**

122 For the reasons above, and in particular having regard to the high threshold required to establish an allegation of bad faith, I am of the view that the ground of opposition under Section 7(6) therefore fails.

**Overall conclusion**

123 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the opposition fails on both grounds. The applications will proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Andy Leck
IP Adjudicator

Mr Leo Cheng Suan, Ms Teresa O'Connor, Ms Millicent Lui and Ms Lee Shu Xian (Infinitus Law Corporation) for the Applicant;
Ms Laurel Loi (Elohim Law Corporation) for the Opponent.