

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

[2025] SGIPOS 2

Trade Mark Nos. 40202127856Q and 40202127857S

**IN THE MATTER OF A TRADE MARK APPLICATION
AND A REGISTERED TRADE MARK
IN THE NAME OF**

FM SKINCARE PTE LTD

...Respondent

AND

**AN OPPOSITION AND AN APPLICATION FOR A
DECLARATION OF INVALIDITY BY**

CHUA BENG HOCK

...Initiator

GROUND OF DECISION

TABLE OF CONTENTS

INTRODUCTION.....	1
OVERVIEW	1
THE PARTIES	2
THE SUBJECT MARKS	2
PLEADINGS.....	3
STATUTORY DECLARATIONS	5
THE HEARING AND AFTERWARDS	7
THE EVIDENCE.....	7
ROXY SQUARE: THE PARTNERSHIP	7
“FACE OF MAN”: EVOLUTION AND EXPANSION	11
RXIPL: THE BEGINNING.....	12
<i>Asiawide Business Consultants.....</i>	<i>12</i>
<i>Ampersand & the FM Logos.....</i>	<i>14</i>
RXIPL: FRANCHISOR & OPERATOR.....	16
USE OF “FACE OF MAN” NAME AND GET-UP	17
ADAM’S DEPARTURE IN 2017 AND AFTERWARDS	18
PASSING OFF: S 8(7)(A) TMA	20
GOODWILL	21
<i>Who owns goodwill?</i>	<i>22</i>
<i>Observation: can Adam rely on FOMPL’s goodwill?</i>	<i>33</i>
MISREPRESENTATION.....	34
DAMAGE	35

BAD FAITH: S 7(6) TMA	35
COPYRIGHT: S 8(7)(B) TMA	41
WELL KNOWN TRADE MARKS: S 8(4)(B) TMA	43
OUTCOME	47
COSTS	48

Chua Beng Hock
v
FM Skincare Pte Ltd

[2025] SGIPOS 2

Trade Mark Nos. 40202127856Q and 40202127857S
Principal Assistant Registrar Ong Sheng Li, Gabriel
19 December 2024, 23 December 2024, 6 January 2025

4 April 2025

Principal Assistant Registrar Ong Sheng Li, Gabriel:

Introduction

1 Mr Chua Beng Hock (“Adam”) and Mr Chua Beng Hwa (“Chris”) are brothers. In the 1990s, they first became partners in a business which operated a men’s skincare salon in Singapore known as “Face of Man”. Over the years, the “Face of Man” business evolved in different ways. These changes formed the backdrop to, and in some ways served as fuel for, disputes between the siblings. This conflict concerns the right to register two trade marks, both of which contain “faceofman”.

Overview

2 Before me are two sets of proceedings brought by Adam. Where the context requires a degree of formality, I will refer to Adam as the “Initiator”. The first action commenced by the Initiator was a trade mark opposition (the

“Opposition”) against an application to register the “ faceofman” trade mark (TM No. 40202127856Q) (the “Composite Mark”). The Initiator later brought a second action, an application for a declaration of invalidity (the

“Invalidation”) in respect of the registered “**faceofman**” (TM No. 40202127857S) trade mark (the “Word Mark”). Subsequently, the parties agreed that the two proceedings should be consolidated and heard together. This agreement was endorsed and formalised by way of Registrar’s directions.

The parties

3 The Initiator, Adam, is a Singapore citizen. Adam’s case in these proceedings was founded on the premise that he enjoyed certain rights to control the registration and use of “Face of Man”. Adam claimed that these rights arose from the fact that he was a former owner and co-founder of the first “Face of Man” skincare salon and has been involved in the business for many years.

4 FM Skincare Pte Ltd (the “Respondent”) is a company incorporated in Singapore. Chris is a director and shareholder of the Respondent. Adam also used to be a director and shareholder of the Respondent; however, he resigned and sold his shares some years prior to the Respondent’s application to register the Work Mark and the Subject Mark. I will discuss the origins of the Respondent and its relationship with the first “Face of Man” skincare salon later.

The Subject Marks

5 On 18 November 2021 (the “Relevant Date”), the Respondent filed to register the Word Mark and Composite Mark (collectively, the “Subject Marks”). The Subject Marks were applied for in respect of the same goods in Class 3 and services in Class 44. I reproduce the specification in full below.

Class 3

Facial care preparations; Facial care products [cosmetics]; Facial care products in the form of creams [cosmetics]; Facial care products in the form of lotions [cosmetics]; Facial care products in the form of milks [cosmetics]; Cosmetic

preparations for slimming purposes; Slimming aids for cosmetic use; Cosmetic creams for skin care; Cosmetic preparations for care of the skin; Cosmetic preparations for skin care; Cosmetic products in the form of aerosols for skin care; Cosmetic skin care preparations; Essences for skin care; Exfoliants for the care of the skin; Foot masks for skin care; Hand masks for skin care; Non-medicated preparations for the care of the skin; Non-medicated products for skin care; Non-medicated skin care beauty products; Non-medicated skin care oils; Non-medicated skin care preparations; Non-medicated skin care products; Powders for skin care; Skin care creams; Skin care lotions; Skin care lotions [cosmetic]; Skin care mousse; Skin care oils; Skin care preparations; Sun skin care products [cosmetics]; Toiletry preparations for the care of the skin of domestic animals; Wrinkle removing skin care preparations; Slimming preparations for cosmetic use.

Class 44

Advisory services relating to slimming; Consultancy relating to slimming; Slimming salon services; Slimming treatment services; Consultancy relating to skin care; Consultation services relating to skin care; Leasing skin care equipment; Rental of skin care equipment; Services for the care of the skin; Skin care salon services

6 As alluded to earlier, after the Subject Marks were published for opposition, the Initiator filed the Opposition. However, he did not oppose the Word Mark. It was said that the Word Mark was registered unopposed due to an oversight.¹ After it was discovered that the Word Mark had been missed, the Initiator took the step of attacking it through the Invalidation.²

Pleadings

7 The grounds of invalidation against the Word Mark and grounds of opposition against the Composite Mark overlap but are not identical.

¹ This explanation was given by Initiator’s counsel during the hearing.

² The fact that the Initiator did not oppose the Word Mark at first has no bearing on the outcome of the proceedings.

8 The following two grounds of challenge are common. First, bad faith under s 7(6) of the Trade Marks Act 1998 (“TMA”). (For the Invalidation, s 7(6) must be read with s 23(1) TMA.) Second, passing off under s 8(7)(a) TMA. (For the Invalidation, s 8(7)(a) must be read with s 23(3)(b) TMA.) As touched on above, these grounds are linked by one common theme: the contention that Adam was primarily or largely responsible for building up goodwill in connection with the “Face of Man” business. This assertion flowed into the argument that Adam therefore had the right to stop the registration of the Subject Marks which were applied for without his consent.

9 In addition to the abovementioned common grounds, the Initiator also raised two separate grounds, one against each mark. The first, relied upon as a ground of opposition against the Composite Mark, was s 8(7)(b) TMA which relates to copyright. The second, which took aim at the Word Mark registration, was s 23(3)(a)(iii) read with s 8(4)(b)(i) TMA—a provision which protects trade marks that are well known to the relevant sector of the public in Singapore.

10 The Respondent’s answer to the passing off ground was that the Initiator did not possess the requisite goodwill; on the contrary, goodwill was wholly (or at least partially) owned by the Respondent which had (either directly or through its predecessors) been actively using and controlling the use of the various “Face of Man” trade marks. Therefore, the Initiator would not be able to sustain an action in passing off against the Respondent. Similar arguments were advanced to the effect that for the same reasons, the Initiator could not rely on well known trade mark protection against the Word Mark.

11 In response to the bad faith charge, the Respondent’s case was that there was simply no evidence that the Subject Marks had been applied for in bad faith. And as for copyright infringement, the Respondent’s counter was

fundamentally that the Initiator had not proved ownership of the copyright in the claimed artistic work which was used as the premise for the ground of challenge; instead, the work was designed by an external design studio.

Statutory declarations

12 In line with the usual procedure, the parties gave evidence through statutory declarations (“SD(s)”)³. Below, I list the individuals who gave SD evidence in relation to the Opposition.

(a) For the Initiator:

(i) Adam (Chua Beng Hock), the Initiator, gave evidence⁴ and evidence in reply.⁵

(ii) Chia Yoong Sin (“Chia”) also gave evidence for the Initiator.⁶ Chia was previously a partner in the business which operated the “Face of Man” skincare salon at Roxy Square.

(b) For the Respondent:

(i) Chris (Chua Beng Hwa), a Director of the Respondent, gave evidence on its behalf.⁷

³ Some of the SDs were later re-executed through a supplementary SD to comply with certain formalities. Nothing substantive turns on the difference. To minimise confusion and for convenience, I treat the re-executed SDs as the same as the original ones and refer to each SD by function rather than date.

⁴ Adam’s SD in the Opposition (“ASDO”)

⁵ Adam’s SD in Reply in the Opposition (“ASDRO”)

⁶ Chia’s SD in the Opposition (“Chia’s SD”)

⁷ Chris’ SD in the Opposition (“CSDO”)

(ii) Teo Soon Lam James (“James”), a Director of the Respondent, also gave evidence on its behalf.⁸

(iii) Erica Wong Suet Hung (“Erica”), sole proprietor of Studio Ampersand (“Ampersand”), gave evidence relating to the design of certain “Face of Man” logos.⁹

13 In the agreement to consolidate the two proceedings, it was resolved that the evidence filed in the Opposition would also constitute evidence in the Invalidation. It was also agreed that both sides would only submit additional evidence in the Invalidation relating to the well known trade marks ground of challenge under s 8(4)(a)(b)(i) TMA. Accordingly, Adam gave evidence¹⁰ in the Invalidation solely in support of the claim that certain “Face of Man” trade marks were well known to the public in Singapore. Chris gave evidence in response,¹¹ and Adam gave evidence in reply.¹²

14 Neither party applied for cross-examination. To be fair, statistically speaking, applications for cross-examination in contentious proceedings at the Intellectual Property Office of Singapore are rare. That said, given the nature of the claims made and the conflict between the parties’ versions of the facts, this is a case in which cross-examination would likely have been helpful.

15 Be that as it may, I must proceed as best as I can on the evidential statements and documents before me and weigh them accordingly. It is trite but

⁸ James’ SD in the Opposition (“James’ SD”)

⁹ Erica’s SD in the Opposition (“Erica’s SD”)

¹⁰ Adam’s SD in the Invalidation

¹¹ Chris’s SD in the Invalidation

¹² Adam’s SD in Reply in the Invalidation

worth repeating that ultimately the burden of establishing the pleaded grounds of opposition and invalidation lies on the Initiator.

The hearing and afterwards

16 The hearing took place on 19 December 2024. Both sides were ably represented by counsel.

17 During oral argument, I asked clarificatory questions but did not request for further submissions. Nevertheless, on 23 December 2024, counsel for the Initiator wrote in by way of letter with a view to addressing some of the concerns which I had expressed. The letter essentially contained further legal submissions. Even though leave was not sought beforehand, since the arguments canvassed were useful to the overall assessment, I did not disallow them. Instead, I directed the Respondent to respond if it wished to. The Respondent did so through a letter from counsel on 6 January 2025.

The evidence

18 I first detail the parties’ evidence relating to the origins and ownership of the “Face of Man” business and how it evolved over time. Thereafter, I touch on some of the background facts relating to the rift between the key players to provide some context to the bad faith ground of attack.

Roxy Square: The Partnership

19 It is convenient to begin with Adam’s account of the genesis of “Face of Man”. Where appropriate, I touch on Chia’s evidence (which corroborated Adam’s testimony) and discuss Chris’ evidence (which presented a different—sometimes conflicting—version of the facts).

20 In 1983, Adam came to know Chia, an aesthetician. At the time, Chia was operating a men’s skincare treatment centre known as “Faceline Salon”. It was located at 21 Cuscaden Road, in a now-defunct shopping mall known as Ming Arcade. Adam was one of Chia’s customers. Eventually, Adam started working for Chia in Faceline Salon as a freelance aesthetician.¹³

21 According to Adam, sometime between 1986 and 1992, he and Chia discussed the possibility of opening and running a facial salon together. It was said that when he was on holiday with Chia in Sydney, Australia, they were inspired by a salon known as “Face of Man”. It was decided that they would use this name for a new business in Singapore. These talks eventually culminated in the opening of the “Face of Man” skincare salon in the Roxy Square mall located at 50 East Coast Road.¹⁴ (For convenience, I refer to the outlet as “Roxy Square”). Chia gave evidence to similar effect.¹⁵

22 Roxy Square was operated under a partnership under the same name: “Face of Man” (UEN No. 47568400A). The “Face of Man” business (which appears to have started out as a sole proprietorship) was first registered by one Foo Seck Meng (“Foo”).¹⁶ However, as far as Adam was aware, Foo was just an aesthetician and Roxy Square was ultimately owned and operated by Chia.¹⁷ This point was echoed by Chia, who emphasised that at the material time he remained in charge of overseeing the daily management and operations of Roxy

¹³ ASDO at [4]-[5]

¹⁴ ASDO at [6]-[7]

¹⁵ Chia’s SD at [6]

¹⁶ CSDO at [10] and accompanying Exhibit CBH-1, Tab A

¹⁷ ASDO at [8]

Square.¹⁸ Chris’ evidence on the other hand was that he saw Foo single-handedly managing and operating Roxy Square whereas he did not see Chia working.¹⁹

23 Foo did not give evidence.

24 On 4 March 1994, Foo withdrew from the “Face of Man” business and transferred ownership of it to Chia. According to Adam, this was done in preparation for Adam’s entry into the business.²⁰ Both Adam and Chia gave statements that sometime that same month, pursuant to an agreement between the two men, the latter transferred ownership of “Face of Man” and Roxy Square to the former for the sum of S\$30,000.²¹ However, no supporting documents recording this agreement were exhibited in evidence.

25 Chris presented the facts in a different way: in his account, Chia sold the business to Adam and himself (not to Adam alone). Chris also pointed out that he agreed to pay S\$25,000 for a half-share of the business (and that Adam had told him that the purchase price was S\$50,000). Since Chris did not have the necessary funds at the time, he claimed that the arrangement between the brothers was that Adam would make the initial full payment whereas Chris would repay Adam (for his half-share) through monthly instalments. Chris adduced a copy of a signed partnership agreement dated 10 October 1994 (which I note was not exactly contemporaneous) between Adam and himself to that effect.²²

¹⁸ Chia’s SD at [7]

¹⁹ CSDO at [14]

²⁰ ASDO at [9]

²¹ ASDO at [10], Chia’s SD at [9]

²² CSDO at [15]-[17] and accompanying Exhibit CBH-1, Tab B

26 On 8 March 1994, Adam was formally included as a partner in “Face of Man”. Although Adam’s evidence was that Chia had sold the business to him, the Accounting and Corporate Regulatory Authority records show that Chia remained as a partner until 24 November 1997. Chia’s explanation was that he had stayed on as partner after selling the business to assist Adam with his experience and expertise.²³ From this point onwards, I refer to the original “Face of Man” entity which operated the Roxy Square business as the “Partnership”.

27 On 24 March 1994, Chris was added to the Partnership. There were differing accounts as to how Chris first became involved in Roxy Square. Chris’ version was that he had reconnected with Foo (whom he met in 1992) after leaving his job with Singapore Airlines in February 1994. Thereafter, Foo employed Chris to work as a skincare consultant and aesthetician at Roxy Square.²⁴ This contradicted Adam’s evidence that it was he (not Foo) who employed Chris in March 1994 to help manage the operations of Roxy Square on an informal profit-sharing basis.²⁵

28 It is not necessary to make findings as to the exact circumstances of Chris’ entry into the Partnership. Nothing turns on it. In the same vein, it is also a mere background fact that “Face of Man” was first owned and registered by Foo who then transferred ownership to Chia. Nothing turns on that fact either. What is truly important is that from the time Chris joined (on 24 March 1994), the Partnership (and hence Roxy Square) was effectively owned and controlled by Adam and Chris (with apparently minimal involvement from Chia despite

²³ Chia’s SD at [9]

²⁴ CSDO at [11]

²⁵ ASDO at [12]

him being a partner until November 1997: see [26] above) until it was legally terminated on 28 February 2003.

“Face of Man”: evolution and expansion

29 The Partnership’s end was merely the beginning of the “Face of Man” story. From late 2002 to 2003 onwards, the skincare business conducted under “Face of Man” expanded through franchising and other means.

(a) The Partnership portion of the business which operated Roxy Square lived on through several business vehicles. The business of Roxy Square was first transferred to Face of Man Pte Ltd (incorporated on 7 January 2003). On 8 August 2006, the company was converted into a limited liability partnership known as Face of Man LLP (“FOMLLP”). On 17 April 2009, FOMLLP was succeeded by a company known as FOM Pte Ltd (“FOMPL”) which operated and continues to operate Roxy Square. Over time the actual salon outlet location shifted, but it always remained within the premises of that name in East Coast Road.

(b) The expanded part of the business dealt with brand licensing, which was to be conducted through a franchising company known as RX International Pte Ltd (“RXIPL”). I will discuss the licensing business shortly, but I should first explain the link between RXIPL and the Respondent. On 25 July 2006, RXIPL was converted into a limited liability partnership known as RX International LLP (RXILLP). And on 16 April 2009, the Respondent (FM Skincare Pte Ltd) was incorporated to take over the business of RXILLP. In effect therefore, the Respondent was the ultimate successor of the business of RXIPL.

RXIPL: the beginning

30 I now describe the circumstances in which RXIPL was set up.

31 This chapter begins with James, who was Adam’s secondary school classmate. James later became a director of the Respondent and gave evidence on its behalf (see [12] above). James’ evidence was that he was looking for new business opportunities in mid-2002. He approached Adam and Chris to gauge if they were interested in starting a new “Face of Man” outlet. After discussions with the brothers, it was decided that instead of starting a new outlet, they would expand the business through franchising.²⁶

32 On 3 October 2002, RXIPL was incorporated in accordance with the plan (involving Adam, Chris and James) to franchise the “Face of Man” skincare business. Adam and Chris each held 35% of the share capital in RXIPL, with the remaining 30% held by James.²⁷ RXIPL did two key things in furtherance of the plan. First, RXIPL engaged Asiawide Business Consultants (“ABC”), a consultancy firm, to help it develop a system to franchise the “Face of Man” brand to skincare salons.²⁸ Second, RXIPL engaged a designer, Ampersand, to design a new corporate identity for the “Face of Man” brand.²⁹

Asiawide Business Consultants

33 As part of its services, ABC formulated a Franchise Concept Paper for RXIPL. ABC also helped RXIPL to develop a Franchise Operation Manual to operationalise the system.

²⁶ James’ SD at [5]-[7]

²⁷ ASDO at [15], CSDO at [19]

²⁸ CSDO at [20] and Exhibit CBH-1 at Tabs D and E

²⁹ CSDO at [23]

34 One of the key recommendations in the Franchise Concept Paper prepared by ABC, which was accepted and implemented by RXIPL, was to have the origin story of “Face of Man” retold in a different way to make the brand more attractive to potential franchisees and presumably customers as well. In this retelling, the “Face of Man” men’s skincare salon was portrayed as being the “brainchild of 2 brothers, Adam and Chris Chua”.³⁰ Although both sides now take the position that this characterisation is not entirely accurate (for the reasons described earlier), the point is that it was this version of the tale that was told to potential business partners and the public (see [76] below).

35 The Franchise Concept Paper also proposed a framework for how the franchising arrangements should be structured. However, it is not entirely clear from the Franchise Concept Paper (and indeed the evidence as a whole) precisely how the parties intended to order their affairs. For instance, paragraph 6 of the document reads as follows.

FRANCHISE CORPORATE ORGANIZATION

For the franchise expansion business, Face Of Man represented by Adam and Chris Chua has incorporated a new company called [RXIPL]. This company is headed by director and shareholder, James Teo. Essentially, Face Of man [sic] has a 70% equity stake in [RXIPL] and the balance of 30% is held by James. This Company will then represent Face Of Man as the Franchisor. Therefore, all future franchise agreements will be entered into between the prospective franchisee and [RXIPL].

While it is clear enough from the above extract that RXIPL was to act as franchisor, it is unclear who was to be regarded as the ultimate owner of the “Face of Man” brand: was it RXIPL or Adam or Chris? Or was it the business

³⁰ ASDRO at [8] referencing the introduction to the Franchise Concept Paper exhibited at CSDO at Exhibit CHB-1 at Tab E

at Roxy Square which was represented by Adam and Chris? Or some iteration of the above? I return to these points later.

36 The Franchise Concept Paper also contemplated the licensing of intellectual property rights. For instance, paragraph 8.6 (which concerned Corporate Identity) recommended that “The Identity of the Face of Man which include the trade-marks, interior and exterior designs... will be reviewed and strengthened”. And the next paragraph (which related to Intellectual Property Rights) mentioned that “Face of Man will work with intellectual property professionals in order to secure the necessary protection of the trade-name/mark and copyright of all its intellectual property rights”. However, these paragraphs did not directly deal with ownership or control of intellectual property.

37 Perhaps because the key partners were family and friends, some of these ownership and licensing issues were—as far as I can tell—never fully resolved. To Adam,³¹ there was no evidence that RXIPL was to be assigned sole ownership of the “Face of Man” brand and so Roxy Square continued to use the name and marks as it had always done. Further, in Adam’s view, there was no evidence of a licence agreement in place.³² These observations are undoubtedly correct insofar as they relate to written documents: no formal licence or assignment was ever entered.

Ampersand & the FM Logos

38 I now turn to the evidence of Erica, sole proprietor of Ampersand: a graphic design studio. Although Erica was called by the Respondent to give evidence, her statement appeared to be largely independent and neutral.

³¹ ASDRO at [17]

³² *Ibid*

39 Erica’s evidence was that in March 2003, James, an old friend, had contacted her to redesign the corporate identity of a skincare salon business called “Face of Man”. She attended various meetings to discuss the proposed new corporate identity. In her recollection, James, Adam and Chris were present at most of the meetings. However, her primary point of contact was James. She was told that she was designing for “Face of Man Skincare”, but the client’s intention was to eventually stop using the word “skincare”.³³

40 Eventually, Erica created two logos: the first was “” and the other was “ faceofmanskinicare” which placed greater emphasis on “faceofman” and less on the “skincare” element (collectively the “FM Logos”). She also drew up a corporate identity manual to be provided to potential franchisees which explained how the logos should be used in business and advertising.³⁴

41 A careful reader would observe that the key features of the FM Logos designed by Erica of Ampersand are almost identical to the Composite Mark “ faceofman” and the Word Mark “**faceofman**”. The difference is that the word “skincare” is omitted from the Subject Marks.

³³ Erica’s SD at [6]-[10]

³⁴ Erica’s SD at [11]-[12] and Exhibit EW-2

RXIPL: franchisor & operator

42 Late 2003 onwards saw the birth of several new “Face of Man” outlets. Some of them were directly opened and operated by RXIPL (later RXILLP, then the Respondent). Others operated as franchisees.

(a) Two franchises were awarded over the years. The first, in December 2003, was to Hislink LLP, which opened a “Face of Man” outlet in Ang Mo Kio. The second was Team FM LLP, which opened a “Face of Man” outlet in Holland Piazza.

(b) The following outlets were operated directly by the Respondent or its predecessors under the “Face of Man” name: (i) from October 2002 to October 2005, an outlet in Bukit Timah Plaza; (ii) from September 2003 onwards, an outlet in The Adelphi; and (iii) from March 2006 to May 2018, an outlet in International Building on Orchard Road.

43 For completeness, I should mention that the above were not the only corporate vehicles involved in the “Face of Man” business. Two others were set up by Chris and James. Neither of them is a subsidiary of the Respondent (or its predecessors). Nor was any formal license agreement between them and the Respondent exhibited in evidence.

(a) In November 2014, a new company known as FM Team Pte Ltd (“FMTPL”) was incorporated to take over the business of the outlet in Ang Mo Kio formerly operated by Hislink LLP. Chris and James were FMTPL’s directors and shareholders. Chris described the arrangement as a franchise buy-back which Adam did not wish to be involved in.

(b) In December 2021, a new company known as FM Vision Pte Ltd (“FMVPL”) was incorporated with Chris and James as its directors.

FMVPL opened an outlet with the “Face of Man” branding at Vision Exchange on Venture Drive. Adam was not involved in FMVPL.

44 The only outlet that was not fully under the Respondent’s (or its predecessors’) direct or indirect management was the first of them all: Roxy Square. This does not mean that Roxy Square acted independently. On the contrary, for the most part, it was an integral part of the overall business.

Use of “Face of Man” name and get-up

45 I now discuss how the “Face of Man” branding (and more specifically the use of the name and get-up) changed over time.

46 At Roxy Square (which was the only “Face of Man” outlet from 1992 to 2003), apart from using the name “Face of Man”, the outlet also used the device



“” from 1998 onwards.³⁵ And in 2003, after Erica designed the FM Logos, there was a rebranding exercise following which Roxy Square started using the



so-called Full Logo: “  faceofmanskincare ”.³⁶

47 In 2006, a new brand name “fmskincare” was introduced by the partners (Adam, Chris and James). The intention was to attract female customers. In line with this, some of the other outlets were renamed “fmskincare”. However, all the outlets (except for one in Orchard Road: see [42(b)(iii)] above) continued to use the Full Logo. Although some of the marketing materials for Roxy Square

³⁵ ASDO at [27]

³⁶ ASDO at [20]

contained the word mark “FM Skincare” / “fmskincare”, Adam insisted that the focus should be on “faceofman” since that was what Roxy Square had been known by and changing the brand would dilute its impact and integrity.³⁷

48 In 2009, Adam expressed the opinion that “faceofmanskinicare” was too lengthy and started using “faceofman” (without “skincare”) as well as the “



” logo at Roxy Square for some marketing materials.³⁸ However, the

signage at Roxy Square and the use of the standalone “  ” logo did not change. The Respondent had a slightly different account: in 2012, James and



Chris decided to use  faceofman (that is, the Composite Mark) across all “Face of Man” outlets.³⁹ To complicate matters, it seems that Erica had already been told of this plan to eventually phase out the use of “skincare” when she was given her design brief (see [39] above). In sum, the parties’ evidence conflicted on the question of who was responsible for first omitting “skincare” from the use of the marks.

Adam’s departure in 2017 and afterwards

49 On 6 September 2017, Adam transferred his entire shareholding in the Respondent to his wife, Lee Soke Chin Wendy (“Wendy”). (Wendy was later appointed as a director of the Respondent.) On that same day, Adam also transferred his entire 50% shareholding in FOMPL, which operates Roxy

³⁷ *Ibid*

³⁸ ASDO at [31]

³⁹ CSDO at [47(f)]

Square, to Wendy. (As a result, both Wendy and Chris each held 50% of the shares in FOMPL.) Adam relinquished his position as director of FOMPL but he remained as company Secretary of and consultant to the company.

50 The final act of the story began sometime in May 2019 when Wendy took over as Operations Director of FOMPL. It was claimed by Adam that Chris took advantage of Wendy’s inexperience and made decisions which hindered Wendy’s management and operation of Roxy Square. Adam accused Chris of having effectively abandoned Roxy Square and spending all his time on the other outlets. It was also alleged that Chris had been taking steps to divert business away from Roxy Square towards the other outlets.⁴⁰

51 In March 2021, Wendy was not reappointed as a director of the Respondent. In October 2022, Wendy commenced proceedings in the High Court against Chris for oppression in respect of certain acts in relation to FOMPL.⁴¹ During the hearing, counsel for the Initiator clarified that the oppression lawsuit had since been discontinued.

52 For present purposes, the nub of Adam’s complaint in his evidence was that Chris had taken various steps to alienate FOMPL from the rest of the “Face of Man” brand by, among other things, removing references to the Roxy Square outlet on the social media pages of the “Face of Man” brand. The application to register the Subject Marks was, to Adam, an attempt to seize control of the brand. I will return to this later in the context of bad faith.

⁴⁰ ASDO at [46]-[48]

⁴¹ ASDO at [48] and Exhibit OSD-8 (Statement of Claim in the lawsuit)

Passing off: s 8(7)(a) TMA

53 The Initiator does not own any earlier trade mark registration for “Face of Man” or any variants thereof. This is why rights ownership in relation to unregistered marks has taken centre stage. As a preliminary note, an unregistered trade mark is not in itself a species of property. In other words, it is technically incorrect to describe oneself as the owner of an unregistered trade mark. Rather, in an unregistered trade mark licence, what is licensed is the right to use the mark in a manner which the tort of passing off would otherwise prevent (see *Harvard Club of Singapore v President and Fellows of Harvard College* [2020] SGHC 77 at [47]).

54 Section 8(7)(a) TMA provides as follows.

8.—

(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;

55 The Initiator relied on s 8(7)(a) TMA in the Opposition against the

Composite Mark ( faceofman) and in the Invalidation (read in conjunction with s 23(3)(b) TMA)⁴² against the Word Mark (**faceofman**). In both actions, the Initiator’s case was that he was the lawful owner of the

⁴² This section provides that the registration of a trade mark may be declared invalid on the ground that there is an earlier right in relation to which the condition set out in s 8(7) is satisfied.

“Face of Man” and “faceofman” trade marks and all the goodwill and reputation connected to them.

56 To succeed under s 8(7)(a) of the Act, the Initiator must establish a notional case of passing off: see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]. The classic elements of the tort of passing off are trite. They are: (a) goodwill; (b) misrepresentation; and (c) damage.

Goodwill

57 Goodwill is the bedrock of the tort of passing off (see, for example, *New Ping Ping Pauline v Eng’s Noodles House Pte Ltd and ors* [2021] 4 SLR 1317 (“*Eng’s*” at [122]). It is both “a reflection of a public state of mind on the one hand, and... legal property on the other” (*Eng’s* at [123] citing Christopher Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (Sweet & Maxwell, 5th Ed, 2016) at [3-138]).

58 In *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 the Court of Appeal observed at [39] that:

... 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’ ...

59 It is undisputed that goodwill should be assessed at the Relevant Date.

60 On the facts of this case, there was evidence that the various skincare salons bearing the name of “Face of Man” and its associated get-up had been actively trading in Singapore for some years and had a certain following. There was undoubtedly goodwill connected with the skincare business conducted

under and by reference to “Face of Man”. That goodwill exists *somewhere* was not disputed by the Respondent. However, what was disputed is who (or which business) owned that goodwill and the effect, if any, of that ownership.

61 One of the difficulties in ascertaining ownership of goodwill here is that the key players never expressly agreed among themselves as to who (or more precisely which entity) held ultimate control over the “Face of Man” name and get-up. It was only now, after a falling out between the parties, that each side sought to lay claim to the whole of the goodwill. The problem was described in Christopher Wadlow, *Wadlow on the Law of Passing Off* (Sweet & Maxwell, 6th Ed, 2021) (“*Wadlow 6th Ed*”) at [3-292] in the following way.

[...] Goodwill is created by trading activities, but it often happens that more than one business is involved in the sequence which results in goods or services being made available to the consuming public. If so, then the question arises of which of those businesses is the owner of goodwill which the law recognises as damaged when a person passes off his good or business as those with which the public is acquainted. The problem arises in two main contexts. One is where two or more businesses which have previously worked together fall out. The other is where a passing-off action is brought by a claimant who considers himself damaged by the activities of the defendant but who is not, in law, the owner of any relevant goodwill.

(emphasis added)

Who owns goodwill?

62 Given the circumstances, it falls to this tribunal to assess ownership of goodwill on a careful assessment of the facts. In *Eng’s*, the General Division of the High Court endorsed the following tests proposed by Professor Wadlow for determining ownership (*Eng’s* at [125]).

[125] The fundamental question at hand is the ownership of the goodwill. Prof Wadlow suggests the following tests for determining the ownership of goodwill (at para 3-140):

One is to ask who is in fact more responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.

(emphasis added)

63 In this regard, *Wadlow 6th Ed* (at [3-295]) suggests that the following questions would help evaluate who in fact owns goodwill.

[...] the following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, mutatis mutandis, a business for the provision of services: (1) Are the goods bought on the strength of the reputation of an identifiable trader? (2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory? (3) Who is most responsible in fact for the character or quality of the goods? (4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? [...]

(emphasis added)

64 Similar signposts were provided in Tan Tee Jim SC, *Law of Trade Marks in Singapore* (Fourth Edition, Sweet & Maxwell Singapore), where the learned author observed thus.

[19.078] As the tort of passing off protects the goodwill attached to the business of the goods or services which are supplied to the relevant public under a trade mark, it follows that the owner of the business would be the owner of the goodwill. This is the default position. However, in practice, ownership of goodwill can be a difficult question of fact which calls for a close analysis of the particular facts of each case. In this regard, two issues are relevant to resolve the question.

[19.079] The first issue is: who is responsible for the business of the goods or services carried on under the mark? Typically, the owner would be the manufacturer of the goods or the supplier of the services. He can also be the person who exercises legal and practical control over the way the mark is used and

the manner in which the goods or services are provided by his distributor, franchisee or licensee under the mark in Singapore.

[19.080] The second issue is: what is the significance of the mark to customers in Singapore? Or, who does the customers associate the mark with? [...]

(emphasis added)

65 With those guiding principles in mind, I briefly outline the parties’ cases. In so doing, I am mindful that on the facts of this case, public perception is relevant but does not provide a definitive answer because there were multiple individuals and physical salon outlet locations associated with the “Face of Man” skincare salon business. In these circumstances, the issue of who exercised control over the services in question is particularly significant.

66 The Initiator’s case was that he was entitled to bring the Opposition and Invalidation proceedings based on FOMPL’s goodwill. Adam contended that all the goodwill acquired by FOMPL was accrued by and through him. It was said that on the evidence, the public attributed the goodwill in the “Face of Man” business at Roxy Square to Adam and perceived him as the founder of the brand. Apart from evidence of public perception, the Initiator also pointed to instances which showed that he was ultimately responsible for—and exercised control over—the products and services offered at Roxy Square under “Face of Man”.

67 The Respondent’s case was broadly organised along the following lines.

(a) First, there was never any formal agreement or informal understanding to the effect that Adam (and/or the business operating at Roxy Square which started with the Partnership and now lives on through FOMPL) was or would be the sole owner of the goodwill in the entire expanded business (including the franchised and directly operated

outlets) conducted under the “Face of Man” name / mark. Therefore, ownership of goodwill must be ascertained on the facts.

(b) Second, the evidence does not support the Initiator’s claim to sole goodwill ownership during the period when the Partnership was operating Roxy Square. As for the time period from 2003 onwards (when the business expanded through RXIPL), the Initiator’s claim to goodwill ownership should be regarded as even weaker still: after all, decisions were taken by all the key shareholders (Adam, Chris and James) collectively and the evidence showed that it was RXIPL (and its successors) not Adam and/or FOMPL (or its predecessors) which exercised control over the other “Face of Man” entities and their use of the branding features.

(c) Third, even if the Initiator has some claim to ownership of goodwill (which is denied), on 6 September 2017 (some years prior to the Relevant Date) the Initiator sold his ownership interest in FOMPL and the Respondent to his wife, Wendy. At the relevant time, Adam was the appointed Secretary of FOMPL and was employed as a consultant of the company. This means that he had effectively relinquished any ownership claim to the business and the fact that Adam remained an employee of FOMPL at the Relevant Date does not detract from this.

68 Before setting out my decision, I should discuss one final point. It relates to the issue of whether sole, or exclusive, ownership of goodwill is required to bring an action under the tort of passing off.

69 It appears that under English law, a co-owner of goodwill *cannot* succeed in establishing passing off against another co-owner. Authority for this proposition, which the Respondent helpfully drew to my attention, may be

found in *Gromax Plasticulture v Don & Low Nonwovens Ltd* [1999] RPC 367 (“*Gromax*”), a decision of the Chancery Division of the English High Court. The dispute in *Gromax* involved a manufacturer and a distributor of plastic crop covers marketed and sold under the name “Gro-Shield”. The court found (at 390) that the goodwill in the business in respect of “Gro-Shield” was jointly owned by the parties and that for that reason the action for passing off could not succeed. I reproduce the court’s reasoning in relevant part below.

I have not found any one factor as determinative but having regard as best I can to all of them I do not see the goodwill as at June 7, 1990 as belonging wholly to either side; rather I hold that as at that date the goodwill and the business associated with the "Gro-Shield" name was vested in DLN and Gromax jointly. Moreover, adopting the proposition I have mentioned as to the effect of the distributorship agreement, the same was in my judgment the case as at July 8, 1996 and at the date of Gromax's proceedings. [...] By the last of the dates mentioned, ownership would, if anything, have moved in Gromax's favour but would still, in my judgment, have been joint.

That being the case, I am led, corresponding to the view taken by the Court of Appeal in *Robinson v. Finlay* [(1878) 9 Ch. 487 CA], to a conclusion that Gromax has not discharged the onus falling upon it as plaintiff in its passing-off claim of proving itself to have the monopoly and sole right to the use of the mark. [...]

(emphasis added)

70 During the hearing, after considering the circumstances of the business conducted at Roxy Square by the Partnership and the various ways in which the “Face of Man” business expanded thereafter, it appeared to me arguable that goodwill was not necessarily exclusively owned by one individual or entity. In other words, the facts of this case appeared to fall within the *Gromax* situation. As such, I asked counsel for the Initiator whether Adam and/or FOMPL could succeed in a passing off action against the Respondent in the event a finding of co-owned or shared goodwill is made. Counsel did not immediately respond.

71 After the hearing, Initiator’s counsel wrote in to draw my attention to *Sir Robert McAlpine Ltd v Alfred McAlpine plc* [2004] EWHC 630 (“*McAlpine*”). That case had to do with two companies in the construction industry both using the McAlpine name. They had a shared history but were for many years trading as unrelated companies. The complaint brought by the claimant, Robert McAlpine, was that the defendant, Alfred McAlpine, after 70 years of using “Alfred” as a distinguishing sign, had rebranded itself as simply “McAlpine”. Ultimately, the court found for the claimant on passing off. One of the observations made by the court (at [18]) was that there was “apparently no reported case of a successful action by one joint owner of goodwill against the other, but it was not suggested [*by counsel*] that in appropriate circumstances such an action could not succeed”. From this, Initiator’s counsel reasoned that even if a finding of joint goodwill is made, passing off could still be established.

72 However, as counsel for the Respondent pointed out (and I respectfully agree), joint ownership of goodwill was not fully argued in *McAlpine* and *Gromax* did not feature in the court’s analysis at all. Notably, Prof Wadlow also took the view that on closer examination *McAlpine* should not be considered a joint ownership case at all; rather, it was a situation where each party had an independent goodwill in its own business (under Robert McAlpine and Alfred McAlpine) and each had the right to use McAlpine as part of their respective names but not in a manner which amounted to passing off (see *Wadlow 6th Ed* at [3-394]-[3-395]).

73 In my view, *McAlpine* at best leaves open the possibility that there could be some circumstances in which a joint owner of goodwill could succeed against another in passing off. But it does not provide guidance as to what those circumstances might be. That being so and given that the facts of this case are closer to *Gromax* than *McAlpine*, I see no reason why I should not apply the

proposition that one co-owner of goodwill cannot establish passing off against another co-owner. I therefore hold that unless Adam and/or FOMPL can demonstrate exclusive ownership of goodwill, the ground of challenge under s 8(7)(a) TMA will fail under this first element of the tort.

74 Turning to the facts, I will organise my analysis along the two tests proposed by Professor Wadlow: that of public perception and actual control.

75 I begin with public perception.

76 Who did the public perceive as being responsible for the character and quality of the goods or services? Adam argued that ample evidence had been tendered showing that the public attributed the goodwill to him as founder. It was said that Adam was inextricably tied to the “Face of Man” brand. However, I find that this contention was not borne out by the documents exhibited by Adam in evidence. On the contrary, Chris’ involvement in the “Face of Man” business was given due weight as well.

(a) This point is perhaps best illustrated by a picture extracted from the evidence. Below, I reproduce a callout quote from an interview with Adam and Chris Chua for the July 2002 edition of “lifestyle” magazine which featured Chris alongside Adam. The interview did not focus on Adam or Chris. Both were quoted in equal measure about the origins of their foray into men’s skincare, the reasons for setting up shop at Roxy Square (where Chris was quoted as saying “We wanted a place where men would be comfortable and where information on personal grooming and maintaining their appearance could be shared without self consciousness”), and other aspects of the men’s skincare business.⁴³

⁴³ ASDO at Exhibit OSD-16, pg. 216



(b) To give another example, in August 2017, a blogger with the handle “JTJEJON” posted an advertorial on his blog (<https://jthejon.blogspot.com/2017/08/adv-face-of-man-review.html>)⁴⁴ about his experience with Face of Man’s skincare treatment. In his post, it was stated: “Face of Man is Singapore's original MEN'S skincare centre. Opened by Adam and Chris Chua in November 1992, these innovative twins have revolutionized the male skincare industry with one vision: to provide men with skincare solutions of the highest standards combined with excellent customer service”. In other words, both Adam and Chris were mentioned as the individuals who opened “Face of Man”.

⁴⁴ ASDO at Exhibit OSD-16, p 222

(c) In the October-December 2003 edition of the Asia Franchise Business Opportunities publication, the “Face of Man” business was advertised in the following way to potential franchisees (extract reproduced below). Notably, the salon was described as the “brainchild of twin brothers Adam and Chris Chua”.⁴⁵

face of man (fm) Skincare salon, the brainchild of twin brothers Adam and Chris Chua, offers men comprehensive skincare services of the highest standards through an integrated approach of aesthetic science and advance technology. Established in 1991, the business has grown from a single room skincare salon located at Roxy Square, to two salons comprising eight personalized facial rooms. Each location is equipped with aromatherapy facilities, reception and waiting lounge. A third salon will open in Oct 2003 in the heart of the city to be followed by another three in 2004.

77 For completeness, I should mention that the Initiator also relied on certain documents which showed Adam’s involvement in setting and ensuring standards for the skincare products to be used by franchisees,⁴⁶ and in corresponding with suppliers and regulatory authorities in relation to products and packaging for products to be used in “Face of Man” skincare salons.⁴⁷ I have no doubt that Adam was very closely involved in setting and maintaining standards. However, I do not think that in totality the evidence went so far as to show that Adam would have been regarded by the public as being solely responsible for the character and quality of the products and services offered under the “Face of Man” skincare brand.

78 In sum, I find that the public would have regarded Adam and Chris as being equally or jointly responsible for the character and quality of the goods or services offered under the “Face of Man” name and mark. The fact that this was

⁴⁵ CSDO at Exhibit CBH-1, TAB J, pg. 100

⁴⁶ CSDO at Exhibit CBH-1, TAB F, pg. 64

⁴⁷ ASDRO at Exhibit OSD-17, Tab 3

the message telegraphed to the public should not come as any surprise; after all, this was in line with the brand story which ABC proposed that the Partnership should adopt in the Franchise Concept Paper (see [34] above). Even if some in the trade (e.g. suppliers of skincare products) might have dealt more with Adam in certain ways, I do not think that they would perceive him as being solely responsible.

79 Next, I turn to the issue of actual control.

80 Here the evidence also does not bear out the Initiator’s contention that Adam (and/or FOMPL) had full control over the “Face of Man” name and get-up. I find that in the days of the Partnership, ownership of and control over the goodwill in the business of Roxy Square must have been held by Adam and Chris jointly. Evidence of this was recorded in the Franchise Concept Paper (see [35] above). Whether the term that “[RXIPL] will then represent Face Of Man as the Franchisor” amounted to assignment of goodwill or whether it was a type of licence for goodwill is not something I need to decide. Even if it was a licence, the point is that both Adam and Chris were the representatives of Face of Man. For a licence of this sort to be commercially workable, it would have to be either irrevocable or revocable only through the actions of Adam and Chris acting jointly. Put simply, Adam had no exclusive control. He could not withdraw consent unilaterally even if he wanted to. And he had no authority to represent “Face of Man” without Chris’ involvement.

81 I agree with the Respondent that from 2003 onwards (when the business expanded through RXIPL), Adam and/or FOMPL’s claim to sole goodwill ownership must be perceived as even weaker still. RXIPL’s key decisions were taken by all the key shareholders (Adam, Chris and James) collectively. For instance, after Erica had designed the FM Logos for RXIPL, all three of them

agreed on 22 May 2003 that all “Face of Man” outlets would use the “



” logo on signages and on shopfronts.⁴⁸ More can be said about the evidence, but the essential point remains: Adam and/or FOMPL did not have any exclusive control. Instead, control was wielded by RXIPL (and its successors) and through the collective actions of James, Adam and Chris. This was wholly consistent with the Franchise Concept Paper’s proposal that “all future franchise agreements will be entered into between the prospective franchisee and [RXIPL]”.

82 To conclude, after examining the evidence, I find Adam (and/or FOMPL) was at best a joint or co-owner of goodwill. I also find that the Respondent was, at the very least, also a co-owner of the goodwill. To be crystal clear, it is unnecessary for me to, and I do not, make any findings on the following issues:

- (a) Whether the Initiator was in fact a joint owner of goodwill at the Relevant Date;
- (b) The extent of Adam’s share of the goodwill, if any; or
- (c) Whether the Respondent owned the whole of the goodwill.

To reiterate: my finding is a very narrow one. It is simply that on these facts, Adam cannot be said to be anything more than a co-owner of goodwill. Since the evidence, even on a most generous interpretation, does not show that the

⁴⁸ CSDO at [29] and Exhibit CBH-1, Tab H

Initiator enjoyed the whole of the goodwill, the attack under s 8(7)(a) TMA against the Subject Marks must fail.

Observation: can Adam rely on FOMPL's goodwill?

83 Before moving on, I would add some passing comments in relation to goodwill. Implicit in the Initiator's case was the assumption that Adam could rely on FOMPL's goodwill for the purposes of an attack under s 8(7)(a) TMA. However, FOMPL is not a joint or co-initiator in the Opposition or Invalidation.

84 If one adopts a strict view of goodwill (i.e. that which was espoused by the Privy Council in *Star Industrial v Yap Kwee Kor* [1976] F.S.R. 256 PC ("*Star Industrial*")), it is arguable that the failure to join FOMPL to the proceedings means that any goodwill owned by it cannot be invoked. As Prof Wadlow observed in a footnote to the passage in *Wadlow 6th Ed* at [3-292] discussed at [61] above, to avoid problems such as those in *Star Industrial*, "it is normal to join as claimants every company with a plausible claim to the goodwill affected". This principle also likely explains why in *Eng's* the claimant chose the common law derivative action route as a means of accessing and activating the company's goodwill. Below, I reproduce the court's observations on this point without further comment (*Eng's* at [127]).

[127] Goodwill is personal property and may be assigned: Wadlow at para 3-195. When the Company was incorporated, Mr Ng operated through the Company. As such, the goodwill owned by Mr Ng and the Hawker Business attached itself to the business of the Company. This goodwill was still used by the Company after Mr Ng's passing, up until the time the Company ceased operations. This was the reason that Pauline used a common law derivative action in order to assert rights to the marks: her case rested on the fact that the goodwill was associated with the business of the Company, and her action was brought to secure what she characterised as the intellectual property of the Company.

(emphasis added)

85 To be clear, this discussion is not about *locus standi*.⁴⁹ There is no doubt in my mind that Adam had the legal standing to bring proceedings against the Subject Marks. The question is whether he possessed the necessary goodwill to sustain an action in passing off. The fact that Adam was not a director or shareholder of FOMPL is relevant because of the general rule that employees do not acquire goodwill in the business and any goodwill arising from their actions accrues to the business and not those who work for it (see *Wadlow 6th Ed* at [3-371]). But that does not completely dispose of the matter. Adam did something even more fundamental. He relied on and invoked FOMPL's goodwill against the Respondent for the purposes of s 8(7)(a) TMA and it is not clear what authority Adam had to act in that way. If he had no right, it stands to reason that Adam could only succeed if he was able to show that he (and no other, including FOMPL) exclusively held the goodwill.

86 That said, my earlier findings make it unnecessary for me to decide any of the issues highlighted above. Moreover, the parties' arguments did not directly engage them head on. I raise these observations because the implications on the Initiator's case are significant, and in case they may be of assistance elsewhere.

Misrepresentation

87 If there was no goodwill, the issue of misrepresentation does not arise.

88 Even if I am wrong and the Initiator was able to establish the element of goodwill, it does not follow that the application to register the Subject Marks amounted to misrepresentation. The Subject Marks were essentially the same

⁴⁹ See Initiator's Written Submissions at [29] referencing *Tomy Inc v Dentsply Sirona Inc* [2020] 5 SLR 424 at [35] for the proposition that any person may bring opposition or invalidation proceedings.

marks that the Respondent (and its predecessors beginning with RXIPL) had been using and authorising the franchisees to use. This case is unlike *McAlpine* where there had been concurrent use of McAlpine by the parties for many decades in conjunction with the additional first name “Robert” on the one hand and “Alfred” on the other. To reiterate: the successful action for passing off was in respect of the defendant’s use of “McAlpine” alone (see [71]-[73] above). As observed in *Wadlow 6th Ed* at [5-64], “it cannot be passing-off truthfully to advertise a subsisting or former connection with the claimant because there is no element of misrepresentation in doing so”. If I had to decide the point, for the reasons stated, I would find that there was no misrepresentation.

Damage

89 This element does not arise for consideration. However, if the Initiator had been able to establish goodwill and misrepresentation, since the Subject Marks are identical or very similar to the marks used by the Initiator and/or FOMPL, and the parties are in the same field of business, there would be damage or likelihood of damage in the form of lost sales.

Bad faith: s 7(6) TMA

90 Section 7(6) TMA provides that a trade mark “shall not be registered if or to the extent that the application is made in bad faith”. The legal principles that are relevant are well-settled and not in dispute. They are for the most part set out in the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”).

- (a) First, an allegation of bad faith is a serious claim to make, and it must be sufficiently supported by the evidence. A finding of bad faith

needs to be distinctly proved, and this will rarely be possible by a process of inference (*Valentino* at [30]).

(b) 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. (*Valentino* at [28]).

(c) The test for determining the presence of bad faith is a “combined” one, in that it contains both a subjective element (*viz*, what the particular applicant knew) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Bad faith as a concept is context-dependent and hinges on the specific factual matrix of each case (*Valentino* at [29]).

(d) The legal burden of proof lies on the party bringing the application (here: the Initiator). Once a *prima facie* case is made out, the burden of disproving any element of bad faith lies on the other party (here: the Respondent). (See *Valentino* at [36].)

91 Bad faith “is to be determined as at the date of application and matters which occurred after the date of application which may assist in determining the applicant’s (here: the Respondent’s) state of mind as at the date of application can be taken into consideration”: *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”) at [100].

92 In *Festina*, the High Court endorsed the view (at [103]) that instances of bad faith could be placed into three categories: (a) where there is no intention

to use the mark; (b) where there is an abuse of a relationship; and (c) where the applicant was aware that a third party had some sort of claim to the goodwill in the mark. Under the “abuse of a relationship” category, a finding of bad faith can also be made in the following circumstances (*Festina* at [107]).

[...] where the applicant was aware that someone else intends to use and/or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the specific country [...]

93 Ultimately, “the concept of bad faith is extremely wide in the sense that the courts can infer instances of bad faith and decide according to the justice of individual cases”, although in so doing “the court should also be cautious in not over-extending this concept lest it becomes a weapon of terror against competitors of trade mark proprietors”: *Festina* at [114].

94 The Initiator’s case in relation to bad faith largely tracked its arguments under the passing off ground. It was built on the contention that Adam was responsible for the success of the Roxy Square outlet (which was later owned and operated by FOMPL) and therefore the Initiator and/or FOMPL possessed earlier and superior rights in relation to “Face of Man” / “faceofman” and was their true owner. Consequently, or so the argument went, every other “Face of Man” outlet took advantage of the goodwill acquired by the business at Roxy Square. And by applying to register the Subject Marks, the Respondent had acted in bad faith by attempting to usurp the goodwill for itself.

95 The Respondent’s case was that it had a *bona fide* belief that it held a legitimate claim to the goodwill subsisting in the “Face of Man” business. After all, the Respondent had been actively controlling the business conducted over the years under “Face of Man” / “faceofman” either directly (through outlets

which were opened and operated by the Respondent or indirectly (through franchisees and others such as FMTPL and FMVPL which had been given consent to operate). In contrast, the Initiator was unable to demonstrate exclusive ownership of goodwill. Given this, applying to register the Subject Marks was something that the Respondent was well within its rights to do.

96 Above, in the context of passing off, I found that at the Relevant Date the Initiator did not own the whole of the goodwill in respect of the business conducted under the “Face of Man” name and get-up. I also found that the Respondent was, at the very least, a co-owner of the goodwill. Those findings apply here equally. In the days of the Partnership, the rights in relation to the Roxy Square business were held by Adam and Chris jointly. But from 2003 onwards, whether through an assignment or a licence that could only be revoked through Adam and Chris jointly, RXIPL was given the authority to act as franchisor on behalf of “Face of Man”. In practice, the key decisions were made by RXIPL acting through Adam, Chris and James collectively. Thus, it was RXIPL that engaged ABC, RXIPL that engaged Erica, and RXIPL through which the business expanded its operations. These actions could only have been executed by a business that owned and controlled goodwill.

97 At the Relevant Date, the business first carried on by RXIPL lay in the hands of the Respondent. Further, Adam sold all his shares in FOMPL and the Respondent in 2017 (almost 4 years before the Relevant Date). From an objective third party standpoint, it would be reasonable to think that Adam had effectively relinquished any claim to whatever goodwill which he might have owned in the past. In the premises, I do not think that the Respondent’s application to register the Subject Marks would be regarded by external parties in the trade as amounting to something commercially unacceptable. On the contrary, it seems commercially expedient and sensible for the Respondent to

apply to register the Subject Marks to protect the “Face of Man” business. After all, it had—and still has—an ongoing business to protect and control.

98 How does FOMPL’s ongoing use of the various “Face of Man” trade marks at Roxy Square, which it traces to the time of the Partnership, feature into this assessment? In my judgment, the fact that Roxy Square was the first user of “Face of Man” is relevant only insofar as it is arguable that the Respondent cannot succeed in a trade mark infringement lawsuit in Singapore against FOMPL because of the prior user defence encapsulated in s 28(2) TMA. Of course, whether a social media platform (see paragraph below) applying its own rules in response to takedown requests follows such an approach is another matter entirely. But it does not follow that only FOMPL could register the Subject Marks. In any case, as outlined in my concluding observations on the passing off ground (at [83]-[86] above), FOMPL is not a party to these proceedings, and it is unclear what authority the Initiator had to act on its behalf.

99 Before concluding, I will touch on the Initiator’s arguments relating to alleged attempts by Chris to alienate and exclude the Roxy Square outlet operated by FOMPL from the rest of the “Face of Man” business. In summary, Chris was accused of, among other things, the following actions.

- (a) Being increasingly absent from Roxy Square’s operations from August 2021 onwards despite being a 50% shareholder in FOMPL;
- (b) Changing the Roxy Square outlet’s contact details on its Facebook page and on Google search to Chris’ personal number;
- (c) Removing mention of Roxy Square from the list of outlets on the www.faceofman.com.sg website and other social media platforms;

- (d) Actively hindering the operations of Roxy Square by preventing Wendy from using the internal platform used to manage the email accounts of FOMPL’s employees;
- (e) Preventing skincare product suppliers from dealing with Roxy Square directly without his approval; and
- (f) Using the registered Word Mark, “faceofman”, to launch platform takedown requests against Roxy Square’s new Facebook page and YouTube channel.

100 I would observe that these were broadly the same allegations raised by Wendy in the now-discontinued oppression lawsuit.⁵⁰ Even though most of them took place after the Relevant Date, the Initiator sought to portray them as evidence of the Respondent’s ill-intentions in applying to register the Subject Marks as part of a wider effort to divert FOMPL’s business towards the Respondent and the other “Face of Man” outlets.

101 The Respondent met these accusations with a counterattack. Although counsel had put it in gentler terms, the underlying thrust was that after Wendy took over, Roxy Square had gone rogue⁵¹ in failing to comply with the Respondent’s instructions relating to branding. The chief objection was that Roxy Square had deviated from the intended overall corporate identity for “Face of Man”. Consequently, the Respondent’s actions were not an attempt to alienate and exclude FOMPL; rather, they were meant to ensure that Roxy Square acted consistently with the overall “Face of Man” branding.

⁵⁰ ASDO at Exhibit OSD-8

⁵¹ My expression, not the Respondent’s.

102 After careful consideration, I think that it does not meaningfully advance the matter in either direction to discuss the whys and wherefores of Chris’ actions vis-à-vis Roxy Square. There was no cross-examination and the documents and witness statements before me can only go so far. (Moreover, Chris is not the Respondent. One might also observe that at the Relevant Date Chris was a shareholder of FOMPL and remained so afterwards. It is difficult to see how damaging FOMPL’s business would advance Chris’ interests.) Since it is not necessary for me to make findings on the various allegations to dispose of this ground, I will refrain from further comment. The determinative point is this. If one takes the view—as I have—that the Respondent had a legitimate business interest in respect of the Subject Marks as franchisor and business operator, trying to bring Roxy Square in line or failing which excluding it altogether is not something which reasonable persons in the skincare/beauty trade (or indeed any business) would regard as amounting to dishonesty or something commercially unacceptable. Quite the opposite, in fact.

103 I would thus dismiss the Opposition and Invalidation under s 7(6) TMA.

Copyright: s 8(7)(b) TMA

104 Section 8(7)(b) TMA was relied on as ground of opposition against the

Composite Mark “  faceofman”. The section provides, in material part, that “a trade mark must not be registered if, or to the extent that, its use in Singapore is liable to be prevented by virtue of an earlier right”, in particular, “copyright”.

105 Adam’s evidence was that he created the Composite Mark by removing

the word “skincare” from the “” logo prepared by Erica and

shifting “faceofman” to the right of “”.⁵² The claim was that these modifications were sufficient to confer on him ownership of the copyright in respect of the Composite Mark. He did not, however, claim to have designed

the “” logo which he accepted was designed by Erica.

106 In my view, there were critical problems with the Initiator’s case which made it clearly unsustainable.

107 First, there was no documentary evidence to support Adam’s bare claim. Unlike Erica, who in line with her engagement as designer, produced drawings and a corporate identity manual explaining to potential franchisees how the logos should be used, including in stationery, retail applications, and advertising,⁵³ the Initiator tendered no drawings or contemporaneous documents to prove his assertion that he was responsible for re-arranging Erica’s work to form the Composite Mark.

108 Second, counsel for the Initiator cited *PropertyGuru Pte Ltd v 99 Pte Ltd* [2018] SGHC 52 for the principle that the copying, enlargement or resizing of an artistic work does not automatically make the resulting image a work protected by copyright; instead, whether the resultant work enjoys copyright

⁵² ASDO at [31]

⁵³ Erica’s SD at [12] and Exhibit EW-2

depends on whether material alterations or embellishments were made, and this is a question of fact and degree. While this is indeed the law, I find it difficult to see how simply deleting the word “skincare” and shifting the “faceofman”

element to the right of “”—a feature which was designed by Erica, not Adam (and he did not deny this)—is sufficient in the circumstances to constitute a material alteration or embellishment. In other words, even if it is true that Adam was truly the first to use the Composite Mark, it does not mean that a separate copyright subsists in the work or that it is owned by Adam.

109 Overall, I prefer the view that the copyright in the FM Logos designed by Erica belonged to the Respondent. Its predecessor RXIPL commissioned and paid Erica to create the FM Logos in 2003 for the purposes of the “Face of Man” corporate identity. I am unable to see how Adam has any sustainable claim to copyright ownership over the alleged works. Accordingly, I would dismiss the ground of opposition under s 8(7)(b) TMA.

Well known trade marks: s 8(4)(b) TMA

110 The Initiator relied on s 8(4)(b) read with s 23(3)(a)(iii) TMA in the Invalidation against the Word Mark. In layperson terms, s 8(4)(b) TMA prohibits the registration of trade marks which conflict with an earlier well-known trade mark provided certain conditions are met. Here, the allegedly well known trade mark is “faceofman”, which is identical to the Word Mark.

111 I reproduce s 8(4) and subsections (a) and (b)(i) TMA in full below.

(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)

112 Section 2(1) TMA defines a “well known trade mark” as:

(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)

Together, the underlined portions above reinforce the point that s 8(4)(b) TMA seeks to protect the interests of the *owner* of the trade mark that is claimed to be well known. It is the interests of the *proprietor* that are relevant.

113 The Initiator’s case was that he was the lawful owner of the “faceofman” mark that was well known in Singapore. It was contended that the Word Mark should be invalidated because its use would indicate a connection between the goods and services thereunder and the Initiator as the proprietor of the well known “faceofman” mark. This connection, it was said, would be likely to damage the Initiator’s interests.

114 In my view, the key question is whether the Initiator can show that he was in fact the owner of the unregistered “faceofman” mark. Before going further, I should preface my analysis by observing that technically speaking, ownership in the well known trade marks context is not strictly tied to goodwill since the definition of “well known trade mark” in s 2(1) TMA expressly contemplates situations in which the owner of the unregistered mark may not be conducting business or possessing any goodwill in Singapore. Typically speaking, that might be where the owner of the claimed well-known mark has some reputation and fame in a business conducted overseas and ownership of that well known trade mark of foreign origin can be proved through, for example, evidence of trade mark registrations in jurisdictions outside of Singapore. But this case is not about foreign business. All the parties are domestic and there was in fact business conducted here.

115 Given the factual matrix, the only possible way of identifying the owner of an unregistered trade mark that has been used in Singapore is by applying the test for goodwill in passing off: who owned the goodwill in the business conducted under the trade mark?

116 Earlier, in the context of s 8(7)(a) TMA, I held that to succeed in passing off in these circumstances it must be shown that Adam and/or FOMPL had exclusive ownership of goodwill. I found that the Initiator did not meet this threshold and was at the very most a co-owner of goodwill. It stands to reason that the same must apply to the situation under s 8(4)(b) TMA: I find that Adam could not be regarded as the owner or proprietor of any well known trade mark.

117 Since that the Initiator did not own any “well known trade mark”, the question of whether “faceofman” was in fact well known to the relevant public in Singapore does not even arise. For these reasons, the Invalidation under s

8(4)(b) TMA cannot succeed.

118 Although the above is sufficient to dispose of the matter, I should also briefly touch on an alternative way of reaching the same conclusion. The Respondent argued that even if it is not clear on these facts which party is the proper proprietor or true owner of the “faceofman” mark, the Initiator’s case cannot succeed because he would not have shown that the Respondent’s use of the Word Mark would cause damage to the proprietor’s interests. Counsel for the Respondent helpfully drew to my attention *Tan Buck Hai v United U-LI Projects Pte Ltd* [2017] SGIPOS 14 (“*U-LI*”), a decision of this tribunal which essentially held that the “connection” in s 8(4)(b)(i) TMA must be an “inaccurate” for the objection to be made out.

119 *U-LI* involved a dispute between an ex-director and shareholder of a distributor who sought to assert ownership over the contested “U-LI” mark. The evidence did not clearly show who the proprietor was. On the issue of whether s 8(4)(b)(i) TMA had been established, the IP Adjudicator hearing the matter stated at [42]-[43] as follows.

Moving on to the third and fourth elements, the Applicant is required to show that “use of the subject mark in relation to the goods or services for which the subject mark is registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark” and that “such use of the subject mark is likely to damage the interests of the proprietor of the earlier trade mark”

It might be trite but I think it is useful to state that the objective of establishing the third and fourth elements would be effectively to show that the connection that is made between the goods or services for which the subject mark is registered and the proprietor of the earlier trade mark is an “inaccurate” one. It would be inaccurate as the said goods or services to which the subject mark is applied would not purportedly originate from the proprietor of the earlier trade mark or not with that proprietor’s consent or approval. This inaccurate connection is then, in turn, likely to damage the interests of the proprietor of

the earlier trade mark since the reasoning follows that consumers of the goods or services on which the subject mark is used may mistakenly purchase such goods or services thinking that they originate from or are associated with the proprietor of the earlier trade mark, when they are not. By the same reasoning, it follows that no issue would arise if the proprietor of the subject mark and the proprietor of the earlier trade mark are in fact the same or are associated to the extent that the fourth element would not be established in such a situation.

(emphasis added)

120 Returning to the present case, there are two possible lines of analysis under the “inaccurate” connection approach. If the Respondent was in fact the true owner of the Word Mark, it follows that the use (and registration) of the Word Mark by the Respondent would accurately denote the goods and services of the Respondent and therefore there is no “inaccurate” connection between the two. Alternatively, if the Respondent was a joint-owner of the Word Mark together with the Initiator, any association between the Subject Marks and the co-owners would likewise not be “inaccurate” because the parties were in fact economically connected businesses operating under the same marks.

121 Whichever path one takes, whether focussing on lack of exclusive ownership of goodwill, or the fact that there is no inaccuracy of connection, the outcome is the same: the ground of attack under s 8(4)(b)(i) TMA fails.

Outcome

122 For the reasons set out above, I conclude that the grounds raised against the Subject Marks are not made out. The Opposition is dismissed and I allow the Composite Mark to proceed to registration. The Invalidation against the Word Mark is also dismissed.

Costs

123 The current practice is to award costs summarily. Both parties have submitted on the appropriate costs to be awarded in an annex to their written submissions. I have considered them with reference to the Scale of Costs in the Fourth Schedule of the Trade Marks Rules.

124 The usual rule, which I see no reason to depart from, is that the losing party should pay the winning party's costs. I fix the costs to be paid by the Initiator to the Respondent in respect of the Opposition and the Invalidation collectively at \$18,000.00 which consists of: (a) party and party costs for the two actions: \$12,000.00; and (b) disbursements for the two actions: \$6,000.00 (of which \$5,360.00 constitutes Official Fees).

Ong Sheng Li, Gabriel
Principal Assistant Registrar

Zachery Tan and Jason Chan (Amica Law LLC) for the Initiator;
Brendan Loy and Oh Pin-Ping (Bird & Bird ATMD LLP) for the
Respondent
