

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

**[2024] SGIPOS 2**

Trade Mark No. 40202021511R, 40202021496R, 40202021510T,  
40202023159Q, 40202023161Q, 40202023160V, 40202021512P

**IN THE MATTER OF A TRADE MARK REGISTRATION  
AND TRADE MARK APPLICATIONS BY**

**POLYBIT INDUSTRIES FAR EAST SDN BHD**

*... Applicant / Opponent*

**AND AN APPLICATION FOR A DECLARATION OF  
INVALIDITY AND OPPOSITIONS THERETO BY**

**HENKEL POLYBIT INDUSTRIES LTD**

*... Proprietor / Applicant*

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**FOUNDATIONS OF DECISION**

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**Henkel Polybit Industries Ltd**  
**v**  
**Polybit Industries Far East Sdn Bhd**

**[2024] SGIPOS 2**

Trade Mark No. 40202021511R, 40202021496R, 40202021510T,  
40202023159Q, 40202023161Q, 40202023160V, 40202021512P

Principal Assistant Registrar Sandy Widjaja  
25 January 2024

25 April 2024



**Principal Assistant Registrar Sandy Widjaja:**

**Introduction**



1 This is a tussle between two formerly related business entities regarding the ownership of the copyright in various logos incorporating the name “Polybit” as well as the right to apply for trade mark applications which include these logos. It is no surprise that there are two competing versions of events one by Henkel Polybit Industries Ltd, which is the applicant for the declaration of invalidity as well as the opponent for the various trade mark oppositions (“Initiator”); and the other by Polybit Industries Far East Sdn Bhd, which is the proprietor in the invalidity proceedings as well as the applicant in the opposition actions (“Respondent”). For the reasons stated in this decision, I am inclined to accept the Initiator’s narrative.

2 This is a consolidated action for an invalidation and oppositions against the following marks:

<b>Invalidation</b>		
<b>S/N</b>	<b>Registered Mark</b>	<b>Goods</b>


1	 <p>40202021511R</p>	<p>Class 19</p> <p>Bitumen; Bituminous coatings for roofing; Bituminous products for building; Polymeric bitumen emulsion for waterproofing buildings; Roofing membranes.</p>
<b>Oppositions</b>		
S/N	<b>Application Mark</b>	<b>Goods</b>
2	 <p>40202021496R</p>	<p>Class 1</p> <p>Chemicals for use in industry and science; Chemicals for use in industry and science; Chemicals for use in industry and science; Adhesives for industrial purposes; unprocessed artificial</p>



<sup>1</sup> The words in small print in the mark are: *Bituminous waterproofing membrane*.

		resins; adhesives for wall tiles; unprocessed artificial resins; unprocessed artificial resins; agglutinants for concrete; adhesives for use in industry.
3	 <p><sup>2</sup> 40202021512P</p>	Class 19 Bitumen; Bituminous coatings for roofing; Bituminous products for building; Polymeric bitumen emulsion for waterproofing buildings; Roofing membranes.
4	 <p><sup>3</sup> 40202023160V</p>	Class 1 Chemicals for use in industry and science; Waterproofing chemical

<sup>2</sup> The words in small print in the mark are: *HDPE surfaced bituminous waterproofing membrane.*

<sup>3</sup> The words in small print in the mark are: *Elastomeric Liquid Applied Waterproofing Membrane.*

		<p>compositions; Liquid coatings [chemical]; chemicals for use in industry and science; Waterproof coatings [chemical]; Polymer coatings, other than paints; polymer solutions; adhesives for industrial purposes; Coatings for weatherproofing [chemicals]; Polyurethane coatings, other than paints.</p>
<p>5</p>	 <p><b>POLYSWELL</b></p> <hr/> <p>40202023161Q</p>	<p>Class 17                  Joint sealing compounds; Joint packings; Packing, stopping and insulating materials; Gaskets; Expansion joint fillers; Fillers for expansion joints; Water-tight rings; Caulking compounds; Rubber</p>

		stoppers; Padding materials of rubber or plastic; Sealant compounds for joints; Rubber stops; Synthetic rubber.
6	 <b>POLYCOAT</b> <hr/> 40202023159Q	Class 1 Chemicals for use in industry and science; chemicals for use in industry and science; unprocessed artificial resins; polymer solutions; unprocessed artificial resins; adhesives for use in industry; adhesives for use in industry; plasticisers.
7	 <b>Polyseal PS</b> <hr/> <small>Polysulphide Joint Sealant</small> <hr/> 40202021510T	Class 17 Rubber; gutta-percha; sealants for joints; asbestos; non-metallic sealing membranes; caulking

<sup>4</sup> The words in small print in the mark are: *Polysulphide Joint Sealant*.



		compounds; insulating materials; expansion joint fillers; flexible tubes, not of metal; caulking compounds; expansion joint fillers; sealant compounds for joints; padding materials of rubber or plastic; waterproof membranes for use in manufacture.
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### **Background facts**

3 The Initiator was established on 22 April 1995 in the United Arab Emirates (“UAE”). At the point of incorporation, it was known as “Polybit Industries Ltd” (“PIL”).<sup>5</sup> The Initiator deposed that it develops and produces water-proofing and corrosion-inhibiting sealants and coating for the construction industry.<sup>6</sup> The Initiator began its operations mainly in the Middle East, Africa and Asia.<sup>7</sup>

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<sup>5</sup> Statutory declaration by Mr Ali Binbrek, Head of Governmental Affairs & Collection of the Initiator (“Mr Binbrek”), dated 21 June 2022 (“Initiator’s AB 1<sup>st</sup> SD”) at [17].

<sup>6</sup> Initiator’s AB 1<sup>st</sup> SD at [6].

<sup>7</sup> Initiator’s AB 1<sup>st</sup> SD at [6].

4 Effective on 30 June 2005, Henkel AG & Co. KGaA (“Henkel”) acquired 49% shareholding and management rights in the Initiator.<sup>8</sup> As the Initiator joined the Henkel group of companies, it was renamed to what it is known as today.<sup>9</sup> In 2017, Henkel acquired the beneficial interest in the remaining 51% shares of the Initiator, making it a wholly owned subsidiary of Henkel.<sup>10</sup>

5 Today, the Initiator operates in at least 25 jurisdictions worldwide, including Singapore.<sup>11</sup>

6 The Respondent deposed that PIL, as a start-up, needed help to establish its business in the UAE and approached Corrosion Technical Services (“Corrotech”) to distribute its products and services in the UAE.<sup>12</sup>

7 The deponent for the Respondent, Mr Trichy Rajan John Martin Ravi (“Mr Martin”), who is its Director and Shareholder,<sup>13</sup> was then the sales manager and later General Manager of Corrotech.<sup>14</sup> Mr Martin deposed that, due to his hardwork, Corrotech was successful in expanding the business of PIL in the UAE.<sup>15</sup> Mr Martin deposed that he would regularly meet with the then shareholders, Mohamed Salim Mohamed Al Melehy (“Mr Melehy”), Jayan

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<sup>8</sup> Initiator’s AB 1<sup>st</sup> SD at [7].

<sup>9</sup> Initiator’s AB 1<sup>st</sup> SD at [7].

<sup>10</sup> Initiator’s AB 1<sup>st</sup> SD at [7].

<sup>11</sup> Initiator’s AB 1<sup>st</sup> SD at [7].

<sup>12</sup> Statutory declaration of Trichy Rajan John Martin Ravi, Director and Shareholder of the Respondent, dated 21 October 2022 (Respondent’s 1<sup>st</sup> SD) at [18].

<sup>13</sup> Respondent’s 1<sup>st</sup> SD at [1].

<sup>14</sup> Respondent’s 1<sup>st</sup> SD at [9].

<sup>15</sup> Respondent’s 1<sup>st</sup> SD at [9].

Paul (“Mr Paul”) and Tonse Rajendra (“Mr Kini”) <sup>16</sup> (collectively, “the Shareholders”), nearly on a weekly basis, to discuss how Corrotech could enhance the business of PIL in the UAE.<sup>17</sup> Mr Martin deposed that, as a result, in or around 1999, during of one of the meetings, he was *personally invited* by the Shareholders to set up an *independent* company in Malaysia.<sup>18</sup>

8 Mr Martin deposed that his efforts and relationship with the Shareholders culminated in an agreement dated 1 January 2002 (“Jan 2002 Agreement”).<sup>19</sup> Mr Martin deposed that under the Jan 2002 Agreement, the Respondent would be set up with the Shareholders and himself as beneficial holders, and with Ahmad Zaini bin Hj Ismail (“Mr Ahmad”) and his wife, Tan Wee Nie, holding the shares of the Respondent on trust for them.<sup>20</sup> Mr Martin was appointed as the managing director of the Respondent and it was verbally agreed that the profits of the Respondent would be split between the four beneficial owners in equal shares.<sup>21</sup>

9 The Respondent was incorporated in Malaysia on 13 November 2001.<sup>22</sup> Its business was supplying construction chemicals, water proofing membranes, joint sealants, liquid coatings and anti-corrosion products.<sup>23</sup> The Respondent is

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<sup>16</sup> Tonse Rajendra Kini (see Initiator’s AB 1<sup>st</sup> SD at [9]).

<sup>17</sup> Respondent’s 1<sup>st</sup> SD at [9].

<sup>18</sup> Respondent’s 1<sup>st</sup> SD at [9].

<sup>19</sup> Respondent’s 1<sup>st</sup> SD at [10] and Exhibit JM-1.

<sup>20</sup> Respondent’s 1<sup>st</sup> SD at [11].

<sup>21</sup> Respondent’s 1<sup>st</sup> SD at [11].

<sup>22</sup> Respondent’s 1<sup>st</sup> SD at [13] and Exhibit JM-2.

<sup>23</sup> Respondent’s 1<sup>st</sup> SD at [13].

based in Malaysia but it has been supplying, and continues to supply, its products to countries in South and South East Asia, including Singapore.<sup>24</sup>

### **Grounds of Invalidation and Opposition**

10 The grounds for invalidation and opposition are largely similar. The relevant provisions for invalidation are set out under s 23 of the Trade Marks Act 1998 (“Act”), which cross-refers to the grounds of opposition (discussed below), and read:

Grounds for invalidity of registration

23.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered *in breach of section 7*.

...

(3) The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in *section 8(1) or (2) apply*;

...

(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1 July 2004 — *the conditions set out in section 8(4) apply*; or

(b) that there is an earlier right in relation to which the condition set out in *section 8(7) is satisfied*, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(8) In deciding whether the registration of the later trade mark was applied for in bad faith, it is relevant to consider whether the applicant for the registration of the later trade mark had, at the time the applicant’s application was made, *knowledge of, or reason to know of, the earlier trade mark*.

(9) Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark must be declared invalid as regards those goods or services only.

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<sup>24</sup> Respondent’s 1<sup>st</sup> SD at [14].

(10) Where the registration of a trade mark is declared invalid to any extent, the registration is to that extent *deemed never to have been made*, but this does not affect transactions past and closed.

[Emphasis in italics mine]

For convenience, all references made to ss 7 and 8 of the Act shall hereinafter include references to the relevant provisions of s 23 of the Act.

11 The grounds for invalidation and opposition are brought, in the main, under the following sections of the Act:<sup>25</sup>

- (a) Section 7(6);
- (b) Section 8(2)(b);
- (c) Section 8(4)(b)(i);
- (d) Section 8(7)(a); and
- (e) Section 8(7)(b).

12 There are two additional grounds of opposition and they are set out under the following sections of the Act:<sup>26</sup>

- (a) Section 8(1); and
- (b) Section 8(2)(a).

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<sup>25</sup> Initiator's written submissions ("IWS") at [7] and [8].

<sup>26</sup> IWS at [7] and [8].

13 For ease of analysis, where it relates to the same ground, for example, s 7(6), I will deal with the invalidation and opposition causes of action at the *same time*.

14 At the hearing, pursuant to my request, the Initiator submitted that, for both the invalidation and oppositions, in terms of *priority*, the grounds of objection are set out under the following sections:<sup>27</sup>

- (a) Section 8(7)(b);
- (b) Section 7(6);
- (c) Section 8(7)(a);
- (d) Section 8(1);
- (e) Section 8(2); and
- (f) Section 8(4).

As such I will also deal with them in this order.




15 For completeness, the Respondent's marks ("Respondent's Marks") to which these grounds relate,<sup>28</sup> as well as the respective relevant dates "Relevant Dates",<sup>29</sup> are as follows:

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<sup>27</sup> See also IWS at [8].





<sup>28</sup> IWS at [7].

<sup>29</sup> IWS at [4].

<b>Invalidation</b>			
S/N	Registered Mark	Goods	Grounds (provisions of the Act)
1	 30 40202021511R Relevant date: 14 October 2020	Class 19	(a) s 7(6); (b) s 8(2)(b); (c) s 8(4)(b)(i); (d) s 8(7)(a); and (e) s 8(7)(b)
<b>Opposition</b>			
S/N	Application Mark	Goods	Grounds (provisions of the Act)
2	 40202021496R Relevant date: 14 October 2020	Class 1	(a) s 7(6); (b) s 8(1); (c) s 8(2)(a); (d) s 8(2)(b); (e) s 8(4)(b)(i); (f) s 8(7)(a); (g) s 8(7)(b);
3	 31 40202021512P	Class 19	(a) s 7(6); (b) s 8(2)(b); (c) s 8(4)(b)(i);

<sup>30</sup> As indicated at footnote 1 above, the words in small print in the mark are: *Bituminous waterproofing membrane*.

<sup>31</sup> As indicated at footnote 2 above, the words in small print in the mark are: *HDPE surfaced bituminous waterproofing membrane*.




	Relevant date: 14 October 2020		(d) s 8(7)(a); and (e) s 8(7)(b)
4	 <b>POLYTHANE CT</b> <small>Elastomeric Liquid Applied Waterproofing Membrane</small> <small>32</small> 40202023160V Relevant date: 5 November 2020	Class 1	
5	 <b>POLYSWELL</b> 40202023161Q Relevant date: 5 November 2020	Class 17	
6	 <b>POLYCOAT</b> 40202023159Q Relevant date: 5 November 2020	Class 1	
7	 <b>Polyseal PS</b> <small>Polysulphide Joint Sealant</small> <small>33</small> 40202021510T Relevant date: 14 October 2020	Class 17	

<sup>32</sup> As noted in footnote 3 above, the words in small print in the mark are: *Elastomeric Liquid Applied Waterproofing Membrane*.

<sup>33</sup> As noted in footnote 4 above, the words in small print in the mark are: *Polysulphide Joint Sealant*.



16 In addition, the Initiator relies on the following logos and sub-brands in this case (“Initiator’s Polybit Logos” and “Initiator’s Sub-brands” respectively):<sup>34</sup>

S/N	Initiator’s Polybit Logos	Comments
1	 <p>(“Polybit 1995 Logo”)</p>	
2	 <p>(“Polybit 2010 Logo”)</p>	
3	 <p>(“Polybit 2016 Logo”)</p>	
<b>Initiator’s Sub-brands</b>		
1	BITUPLUS	

<sup>34</sup> IWS at [6].

2	POLYSEAL	It would appear that these are used to refer to the actual goods as well. <sup>35</sup>
3	POLYCOAT	
4	POLYSEAL SWELL	
5	POLYTHANE	
6	BITUSTICK	

### Initiator's evidence

17 The Initiator's evidence comprises the following:

- (a) statutory declaration of Mr Ali Binbrek, Head of Governmental Affairs & Collection of the Initiator ("Mr Binbrek"), dated 21 June 2022 ("Initiator's AB 1<sup>st</sup> SD" as defined in footnote 5 above);
- (b) statutory declaration of Mr Chia Yam Seng, Allen ("Mr Chia"), sole proprietor of Cata Trading Enterprises ("Cata"), dated 21 June 2022 ("Initiator's AC 1<sup>st</sup> SD");
- (c) statutory declaration of Mr Shinosh Thamarassery, Brand Manager, Construction IMEA - Sealants & PU Foam, Henkel Adhesives Technologies ("ST"), dated 21 June 2022 ("Initiator's ST 1<sup>st</sup> SD");
- (d) statutory declaration of Mr Khairi Aziz, Export Sales Manager of Henkel (Malaysia) Sdn Bhd, dated 20 June 2022 ("Initiator's KA 1<sup>st</sup> SD");

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<sup>35</sup> Initiator's AC 1<sup>st</sup> SD, Exhibit 4 at pages 29-31 and 35-36.

- (e) statutory declaration of the same Mr Binbrek, dated 23 February 2023 (“Initiator’s AB 2<sup>nd</sup> SD”);
- (f) statutory declaration of the same Mr Chia, dated 10 February 2023 (“Initiator’s AC 2<sup>nd</sup> SD”); and
- (g) supplementary statutory declaration of the same Mr Binbrek, dated 9 August 2023 (“Initiator’s AB 3<sup>rd</sup> SD”).

### **Proprietor’s evidence**

18 The Respondent’s evidence comprises the following:

- (a) statutory declaration of Mr Martin, dated 21 October 2022 (“Respondent’s 1<sup>st</sup> SD” as defined in footnote 12 above);
- (b) supplementary statutory declaration of the same Mr Martin, dated 7 September 2023 (“Respondent’s 2<sup>nd</sup> SD”); and
- (c) statutory declaration in reply filed by the same Mr Martin, dated 17 October 2023 (“Respondent’s 3<sup>rd</sup> SD”).

### **Applicable law and burden of proof**

19 The applicable law is the Act. The undisputed burden of proof for both the invalidation and the oppositions fall on the Initiator.

### **Ground of Invalidation and Oppositions under s 8(7)(b)**

20 Section 8(7)(b) of the Act reads:

8(7)(b) 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* other than those referred to in subsections (1), (2) and (3) or paragraph

(a), in particular by virtue of the *law of copyright* or any law with regard to the protection of designs.

[Emphasis in italics mine]

21 The Initiator submitted that the Respondent's Marks ought to be invalidated and / or refused registration by virtue of the law of copyright.<sup>36</sup>

22 The Initiator correctly identified the key court decision covering this ground, which is *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] SGHC 216 ("*Rovio*"),<sup>37</sup> where Justice George Wei (as he then was) held that s 130 of the Copyright Act 1987 ("CA")<sup>38</sup> is relevant in deciding whether an opposition under s 8(7)(b) of the Act may succeed:<sup>39</sup>

[220] While I agree that s 130 of the CA only applies in actions brought under Pt V of the CA, *this does not mean that s 130 of the CA is irrelevant in deciding whether opposition under s 8(7)(b) of the TMA may succeed. Just like opposition under s 8(7)(a), opposition under s 8(7)(b) requires the court to consider a notional action for copyright infringement. The Opponent must at the very least establish a prima facie case of copyright infringement...If the plaintiff in the notional copyright infringement action is able to invoke the presumptions in s 130 of the CA, a court assessing opposition under s 8(7)(b) of the TMA should be permitted, and indeed, required, to consider the likely success of any copyright infringement proceeding in light of s 130 of the CA.*

[Emphasis in italics mine]

23 Section 130 of the CA reads:

Presumptions as to subsistence and ownership of copyright

130.—(1) In an action brought by virtue of this Part —

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<sup>36</sup> IWS at [13].

<sup>37</sup> See IWS at [14].

<sup>38</sup> This is also the version which is applicable as at the Relevant Dates.

<sup>39</sup> See *Rovio* at [220].

(a) copyright shall be presumed to subsist in the work or other subject-matter to which the action relates if the defendant does not put in issue the question whether copyright subsists in the work or other subject-matter; and

(b) where the subsistence of the copyright is established—the plaintiff shall be presumed to be the owner of the copyright if he claims to be the owner of the copyright and the defendant does not put in issue the question of his ownership.

(1A) Where the *defendant puts in issue* the question of *whether copyright subsists* in the work or other subject-matter or whether the plaintiff is the *owner* of the copyright, *but does not satisfy the court that he does so in good faith*, the presumption as to the subsistence or ownership of copyright under *subsection (1)(a) or (b)*, *as the case may be, shall apply notwithstanding* that the defendant puts that question in issue.

(1B) Where the defendant, in good faith, puts in issue the question of whether copyright subsists in the work or other subject-matter or whether the plaintiff is the owner of the copyright, an affidavit made on behalf of the plaintiff in which the plaintiff makes assertions of facts relevant to showing —

- (a) that copyright subsists in the work or other subject-matter; and
- (b) that he is the owner of the copyright,

shall be admitted in evidence and shall be prima facie proof of the matters stated therein until the contrary is proved, unless the court directs that oral evidence be adduced to prove those matters.

(2) Where *a defendant, without good faith, puts in issue* the questions of whether copyright subsists in a work or other subject matter to which the action relates, or the ownership of copyright in such work or subject-matter, thereby occasioning unnecessary costs or delay in the proceedings, the court may direct that any costs to the defendant in respect of the action shall not be allowed to him and that any costs occasioned by the defendant to other parties shall be paid by him to such other parties.

[Emphasis in italics mine]

24 I would add that I agree with the Initiator<sup>40</sup> that the *same approach* will apply in relation to s 23 read with s 8(7)(b) of the Act.

25 It will become apparent that the Respondent’s Marks are highly similar to the Initiator’s Polybit Logos. The main area of contention is the identity of the creator and thus ownership of the copyright in the Initiator’s Polybit Logos.

26 In this regard, I am of the view that the evidence provided by the Initiator as to the genesis of the Initiator’s Polybit Logos is more credible, as the Initiator was able to provide its reasons behind the design of the Initiator’s Polybit Logos. In contrast, the Respondent simply asserted without any further *relevant* details, that the Polybit 2010 Logo was created based on the “information” provided by Mr Martin about the business.

***Subsistence and ownership of copyright***

27 The Initiator submitted that s 130(1B) CA applies; specifically, the Respondent does not, in good faith, put in issue the question of whether copyright subsists in the work or whether the Initiator is the owner of the copyright.

28 The Initiator submitted extensively on the issue of *bad faith*.<sup>41</sup> The submissions overlap extensively with the ground under s 7(6) of the Act and as such I will deal with them in more detail below. For the purposes of this element under the current ground of objection, I am of the view that it has been *fulfilled*.

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<sup>40</sup> IWS at [19].

<sup>41</sup> IWS at [26] and [33].

29 The provisions in the CA relating to subsistence of copyright are as follows:

Original works in which copyright subsists

27(2) Subject to the provisions of [the CA], where an *original* literary, dramatic, musical or *artistic work* has been *published* —

- (a) copyright shall *subsist* in the work; or
- (b) if copyright in the work subsisted immediately before its first publication, copyright shall continue to subsist in the work,

if, but only if —

- (c) the first publication of the work took place in Singapore;
- (d) the *author* of the work was a *qualified person* at the time when the work was *first published*; or
- (e) the author died before that time but was a qualified person immediately before his death.

...

(4) In this section, “*qualified person*” means a citizen of Singapore or a person resident in Singapore.

[Emphasis in italics mine]

30 In addition, there is a need to refer to the Copyright (International) Regulations (“CR”):

Application of [the CA] to foreign countries

**3.—(1)** Subject to these Regulations, [the CA] shall apply in relation to —

(a) literary, dramatic, musical and *artistic works* and editions *first published* in a country that constitutes, or forms part of the territory of a *Convention country*...

*in like manner* as those provisions shall apply in relation to literary, dramatic, musical and *artistic works* and editions *first published*, and cinematograph films made or first published, *in Singapore*.

...

(4) Subject to these Regulations, the provisions of [the CA] relating to *works* and other subject-matter shall apply in relation to persons who, at a material time, are *citizens or nationals of a Convention country* in

*like manner* as those provisions shall apply in relation to persons who, at a material time, are *citizens of Singapore*.

(5) Subject to these Regulations, the provisions of [the CA] relating to *works* and other subject-matter shall apply in relation to persons who, at a material time, are *resident* in a country that constitutes, or forms part of, the territory of a *Convention country in like manner* as those provisions shall apply in relation to persons who, at a material time, are *resident in Singapore*.

(6) Subject to these Regulations, [the CA] shall apply in relation to *bodies incorporated* under the law of a country that constitutes, or forms part of, the territory of a *Convention country in like manner* as those provisions shall apply in relation to *bodies incorporated under the law of Singapore*....

[Emphasis in italics mine]

31 Justice Wei elaborated as follows:<sup>42</sup>

[236] To *establish a case that copyright does subsist in Singapore*, the CA requires proof of the following:

(a) That the material in question is copyright subject-matter, *ie*, a literary, dramatic, musical, *artistic work* or a sound recording, cinematograph film, broadcast, cable programme or published edition of works.

(b) That if what is claimed is a literary, dramatic, musical or artistic work, the work is *original*.

(c) If the above requirements are satisfied, it must also be shown that the *connecting factors* have been satisfied in respect of the nationality, residence and/or place of first publication.

[237] ...What is necessary is some evidence from which the court can make an assessment of whether the material in question is an *original artistic work*. In a copyright infringement action where subsistence and ownership is in dispute, evidence and submissions are often required on, *inter alia*, (a) who is the *author*, (b) whether the work is *original* to the author, (c) whether the material falls into one of the nine types of *copyright subject-matter*, and (d) the *basis for the claim to copyright* if

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<sup>42</sup> *Rovio* at [236] and [237].



the claimant is not the author (such as an *employment relationship*, or assignment).

[Emphasis in italics mine]

32 In summary, following Justice Wei’s guidance above, to establish a case that copyright does subsist in Singapore, the following must be shown:<sup>43</sup>

- (a) That the material in question is copyright subject-matter, *ie*, a literary, dramatic, musical or *artistic work*.
- (b) That if what is claimed is a literary, dramatic, musical or artistic, work, the work is *original*.
- (c) If the above requirements are satisfied, it must also be shown that the *connecting factors* have been satisfied in respect of the nationality, residence and /or place of first publication.

33 Further, in relation to the assessment of whether the material in question is an *original artistic work*, in a copyright infringement action where subsistence and ownership is in dispute, evidence and submissions are often required on, among other things:<sup>44</sup>

- (a) who is the *author*;
- (b) whether the work is *original* to the author;
- (c) whether the material falls into one of the nine types of *copyright subject-matter*; and



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<sup>43</sup> See above and *Rovio* at [236].


<sup>44</sup> See above and *Rovio* at [237].

(d) the *basis for the claim to copyright* if the claimant is not the author (such as an *employment relationship*, or assignment).

34 For ease of reference, the three original artistic works<sup>45</sup>, which are the Initiator’s Polybit Logos, are as follows:

S/N	Description	Comments
1	 <p data-bbox="379 1048 619 1081">Polybit 1995 Logo</p>	<p data-bbox="997 741 1294 831">This is <i>included</i> in the Respondent’s Marks.</p>
2	 <p data-bbox="379 1339 619 1373">Polybit 2010 Logo</p>	<p data-bbox="997 1149 1294 1238">This is <i>identical</i> to 40202021496R.</p> <p data-bbox="997 1301 1294 1447">It is also <i>included</i> in the Respondent’s Marks, specifically:</p> <ul style="list-style-type: none"> <li data-bbox="1018 1509 1289 1543">(a) 40202021511R;</li> <li data-bbox="1018 1606 1289 1639">(b) 40202021512P;</li> <li data-bbox="1018 1702 1289 1736">(c) 40202023160V;</li> </ul>

<sup>45</sup> IWS at [23]–[25] and [29]–[31].

		<p>(d) 40202023161Q;  (e) 40202023159Q; and  (f) 40202021510T.</p>
3	 <p>Polybit 2016 Logo</p>	<p>This is <i>included</i> in the Respondent’s Marks.</p>

35 I make some preliminary comments before I proceed to apply the law to the facts. First, it is obvious that the Polybit 2010 Logo encompasses both the Polybit 1995 Logo as well as the Polybit 2016 Logo. To be specific, the Polybit 2016 Logo makes up about 70% of the Polybit 2010 Logo, while the Polybit 1995 Logo constitutes about 30% of the Polybit 2010 Logo. Secondly, the Polybit 2010 Logo is *incorporated* into the Respondent’s Marks. In fact, it is *identical* to 40202021496R.


36 As such I will *focus* on the Polybit 2010 Logo.

37 At the same time, it is also necessary to have regard to the Polybit 1995 Logo as it forms an integral part of the Polybit 2010 Logo. In this regard, I

disagree with the Respondent that the Polybit 1995 Logo is “irrelevant” in these proceedings as it has not been “adopted in any of the [Respondent’s Marks]”.<sup>46</sup>

38 The Initiator deposed that the Polybit 1995 Logo was designed by one of its employees:<sup>47</sup>

[9] Since or around the inception of the Initiator in 1995, it has been

using, in the course of trade, “Polybit” and  [Polybit 1995 Logo] as a trade mark and trade name. The Polybit 1995 Logo is an *original work, created by an employee of the Initiator*. The triangular shape of the Polybit 1995 Logo was selected to *symbolise the three active original shareholders* of the Initiator’s predecessor-in-title, Mr Al Melehy, Mr Tose Rajendra Kini (“Mr Kini”), and [Mr Paul] (while the other original shareholder, Dr Philip Georg Philip, was a silent investment partner).

[Emphasis in italics mine]

39 In light of the above, the Initiator had a claim over the same by virtue of being the employer of the creator/employee and as such would be the owner of the copyright in the Polybit 1995 Logo.

40 To complete the picture, the Initiator tendered the registration certificate for the Polybit 1995 Logo in the UAE; it was registered with effect from 14 March 2001.<sup>48</sup>

41 My conclusion is that, based on the documentation above, there is evidence that the copyright in the Polybit 1995 Logo is owned by the Initiator.

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<sup>46</sup> Respondent’s written submissions (RWS) at [50].

<sup>47</sup> Initiator’s AB 1<sup>st</sup> SD at [9].

<sup>48</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB–24, although the owner is stated to be “Henkel Polybit Industries Company Limited LLC”.

42 Returning to the Polybit 2010 Logo, the Initiator submitted that the Polybit 2010 Logo was created and first published in the UAE some time in or around 2009 / 2010 and that the author of the work was ST:<sup>49 50</sup>

[5] At or around the turn of the decade in 2010, the Initiator decided to align the appearance of the Polybit Brand with its other brand CERESIT



which at that time, look as follows: (“Ceresit Logo”). It therefore introduced a refreshed brand identity and logo for



Polybit as follows: [Polybit 2010 Logo].

[6] The Polybit 2010 Logo was created and first published in the UAE sometime in or around 2009 / 2010. *The Polybit 2010 Logo is an original work created by me. In particular, I was the one who selected the font that was used in the Polybit 2010 Logo (and in fact in the Ceresit Logo)...*

[Emphasis in italics mine]

The Initiator also provided evidence of the “Ceresit” mark as used in “data sheets” to corroborate the above.<sup>51</sup>

43 Last but not least, it is useful to complete the story:

[7] In or around 2016, the Polybit 2010 Logo was slightly modified by the removal of the word “Polybit” from below the yellow triangular



device: [Polybit 2016 Logo]. The said modification was deemed to “clean” the Polybit 2010 Logo, to avoid difficulties in the proper display of the logo (in particular, the small letters

<sup>49</sup> IWS at [30].

<sup>50</sup> At [10(b)] Initiator’s AB 1<sup>st</sup> SD and Initiator’s ST 1<sup>st</sup> SD at [5] and [6].

<sup>51</sup> See also Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB–25 as to the use of the mark “Ceresit”; the evidence would appear to be dated around 2018 (page 66). There was also mention of “Ceresit” in Mr Paul’s email of 29 July 2009, attaching the “organisational announcement” that Mr Martin has joined the Initiator (see Initiator’s AB 1<sup>st</sup> SD at Exhibit AB-11 at page 143).

of “Polybit” in the triangular device) in electronic media and apparel. The Polybit 2010 Logo has been in use by the Initiator since.

[8] The Polybit 2016 Logo was created and first published in the UAE sometime in or around 2015 / 2016. *The Polybit 2016 Logo is an original work created by me.*

[9] I was, throughout the entire process of creation and publication of the Polybit 2010 Logo and the Polybit 2016 Logo, *a resident of the UAE, and duly employed the Initiator.*

[Emphasis in italics mine]

44 I am satisfied that the Polybit 2010 Logo, namely:



is an *artistic work*. Specifically, I am of the view that the Polybit 2010 Logo has sufficient “visual stylisation”<sup>52</sup> that qualifies it as an *artistic work*. It is trite that “simplicity *per se* does not prevent a work from acquiring copyright” (see *Auvi Pte Ltd v Seah Siew Tee* [1991] 2 SLR(R) at [33]).

45 One of the main issues in contention is the *identity of the author* of the Polybit 2010 Logo. Both parties have tendered evidence which seeks to show the identity of the same. While there are gaps in the evidence provided by both parties, and understandably so having regard to the passing of time, I am more inclined to accept the Initiator’s version of events.

46 As alluded to above, the Initiator was able to explain the *genesis* of the Polybit 1995 Logo which, as mentioned above, is an integral part of the Polybit 2010 Logo. The Initiator deposed (see above) that the “triangular shape of the

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<sup>52</sup> See Rovio at [238].

Polybit 1995 Logo was selected to symbolise the three active original shareholders of the Initiator’s predecessor in title”.<sup>53</sup>

47 The Initiator was also able to explain the source of the font for the word “Polybit” in the Polybit 2010 Logo. Specifically, it was chosen to align with the font of another brand of the Initiator, namely the “Ceresit” brand.<sup>54</sup>

48 In contrast, the Respondent’s evidence gave no details as to the source of inspiration for the design of the Polybit 2010 Logo except that it was created based on “information” provided by Mr Martin about the business. Loo Tai Fah (Loo)’s<sup>55</sup> evidence, in essence, simply stated that the Polybit 2010 Logo was “designed and approved”<sup>56</sup> by the Respondent “[a]fter several discussions”<sup>57</sup> with the Respondent, on the basis of “information”<sup>58</sup> by the Respondent, including “the registered name (Polybit Industries Far East Sdn Bhd), type of industry they are in, bituminous membrane color black, and other business information”.<sup>59</sup>

49 Finally, it is clear that the Initiator can be considered as a *qualified person* (s 27(2)(c) and s 27(2)(d) CA read with regulation 3 of the CR).

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<sup>53</sup> Initiator’s AB 1<sup>st</sup> SD at [9].

<sup>54</sup> Initiator’s ST 1<sup>st</sup> SD at [5] and [6].

<sup>55</sup> Loo is the sole proprietor of a business in the name and style of Joker Trading (formerly known as Joker Advertising) (see Respondent’s 1<sup>st</sup> SD, Exhibit JM-6, at [1]).

<sup>56</sup> Respondent’s 1<sup>st</sup> SD, Exhibit JM-6, at [4].

<sup>57</sup> Respondent’s 1<sup>st</sup> SD, Exhibit JM-6, at [4].

<sup>58</sup> Respondent’s 2<sup>nd</sup> SD, Exhibit JM-3, at [10].

<sup>59</sup> Respondent’s 2<sup>nd</sup> SD, Exhibit JM-3, at [10].

50 In *Rovio* (at [225]), Justice Wei observed:

[225] At this juncture, I would emphasise again the *practical difficulties* a court faces in determining issues of copyright subsistence, ownership, and infringement in trade mark opposition proceedings. Reference to the decision of the UK Trade Mark Registry in *Campbell's Trade Mark* [2008] ETMR 56 is helpful...An application for a declaration of invalidity was brought by the applicant under, *inter alia*, s 5(4)(b) of the TMA UK on the ground that the use of the trade mark was liable to be prevented by virtue of copyright. The question was *whether copyright subsisted* in the registered mark and, if so, *whether the applicant was the owner of the copyright*. The registered proprietor's position was that *she, rather than the applicant*, was the owner of the copyright. After considering the relevant authorities on originality and artistic works, the Hearing Officer came to the view that the configuration and typeface used in the logo (the figurative mark) was such that copyright subsisted in the registered trade mark. *What remained was the issue as to who was the owner of the copyright*...In deciding to prefer the evidence of the registered proprietor as to how the trade mark was created, and hence finding that the registered proprietor owned the copyright in the trade mark, the Hearing Officer noted that *there had not been any cross examination*, and that the registry was caught between "Scylla and Charybdis" in making the decision. The necessity of making a decision however meant that the Hearing Officer had to *choose which version of the truth he/she steered closer to*.

[Emphasis in italics mine]

51 Similarly in this case, the parties' positions are diametrically opposed and there has not been any cross examination. However, the "necessity of making a decision" means that I have to "choose which version of the truth [I] steered closer to" (see *Rovio* at [255]).

52 In this instance, for the reasons I set out above, I am inclined to accept the Initiator's version of events.

53 At the hearing, the Respondent submitted that the Initiator simply made a bare assertion that the Polybit 1995 Logo was created by one of its employees but that there is no evidence as to the *identity* of the employee. I do not think that this is critical given that it is not in dispute that the creator is an employee



of the Initiator. This is all the more so given the *totality* of the evidence provided by the Initiator as to the genesis of the Initiator’s Polybit 2010 Logo.

54 In light of all the above, the presumption under s 130(1B) CA applies such that copyright subsists in the Polybit 2010 Logo and the Initiator is the owner of the copyright, as at 14 October 2020.

**Copying**




55 The next step is to assess “whether ‘copying’ has taken place and, if so, whether the Respondent’s Marks have reproduced a substantial part of the claimed works” (see *Rovio* at [240]).






56 In *Rovio* (at [244]), Justice Wei stated:

[244] The first question that arises is what, if anything, did the Applicant’s designer copy from the copyright works? Thereafter, it is necessary to compare the part copied with the copyright works in order to decide whether the part copied was substantial. *Substantiality depends more on the quality of the part taken rather than the quantity with reference to the copyright works.*

[Emphasis in italics mine]

57 For ease of reference, the marks are replicated below:

S/N	Respondent’s Marks	Polybit 2010 Logo
1		
2		

	40202021496R	
3	 <b>BITUSTICK</b> <small>HDPE surfaced bituminous waterproofing membrane</small>	
4	 <b>POLYTHANE CT</b> <small>Elastomeric Liquid Applied Waterproofing Membrane</small>	
5	 <b>POLYSWELL</b>	
6	 <b>POLYCOAT</b>	
7	 <b>Polyseal PS</b> <small>Polysulphide Joint Sealant</small>	

58 As mentioned above, item 2 is *identical* to the Polybit 2010 Logo while the rest of the Respondent’s Marks *fully reproduce* the Polybit 2010 Logo. It is therefore clear that the Respondent’s Marks have reproduced a substantial part of (and indeed the whole of) the Polybit 2010 Logo.<sup>60</sup>

<sup>60</sup> For the avoidance of doubt, it is not necessary to have regard to the concept of “an independent distinctive role” (see IWS at [131]-[134]).

***Conclusion on ground of Invalidation and Oppositions under s 8(7)(b)***

59 Applying Justice Wei’s guidance, an “opposition under s 8(7)(b) requires the court to consider a notional action for copyright infringement” and the Initiator is to “establish a prima facie case of copyright infringement”.

60 Since these elements have been established, the invalidation and oppositions under s 8(7)(b) succeed.

**Ground of invalidation and opposition under s 7(6)**

61 Section 7(6) of the Act reads:

7(6) A trade mark must not be registered if or to the extent that the application is made in bad faith.

62 The legal test for determining the presence of bad faith is not in dispute and is encapsulated in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). The key principles were helpfully summarised by the Principal Assistant Registrar (“PAR”) in *Christie Manson & Woods Limited v Chritrs Auction Pte. Limited* [2016] SGIPOS 1 at [166]:

[166(a)] “Bad faith” embraces not only actual dishonesty but also dealings which would be considered as *commercially unacceptable by reasonable and experienced persons in a particular trade*, even though such dealings may otherwise involve ‘no breach of any duty, obligation, prohibition or requirement that is legally binding’ upon the registrant of the trade mark: *Valentino* at [28].

[166(b)] The test for determining bad faith is the *combined test* of bad faith which contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think). Thus, “bad faith” as a concept is *context-dependent*. In the final analysis, whether bad faith exists or not hinges on the *specific factual matrix* of each case: *Valentino* at [29].

[166(c)] Once a *prima facie* case of bad faith is made out by the [applicants], the burden of disproving any element of bad faith on the part of the [proprietor] would arise: *Valentino* at [36].

[166(d)] An allegation of bad faith is a *serious claim* to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference: *Valentino* at [30]...[However] this is not an absolute prohibition...in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115]...the High Court pointed out that a finding of bad faith is largely, if not invariably, based on *circumstantial evidence*.

[166(e)] Once bad faith is established, the application for registration of a mark must be refused *even though the mark would not cause any confusion*: *Valentino* at [20].

[Emphasis in italics mine]

63 In addition, *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 provided at [100] and [115]:

[100] 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 state of mind as at the date of application *can be taken into consideration*...

[115] ...despite the broad nature of the notion of bad faith, one must show *some sort of nexus* between the parties in dispute. Otherwise, the notion of bad faith would have to be decided in vacuum...In other words, while the finding of bad faith is largely, if not invariably, based on *circumstantial evidence*, the party alleging bad faith needs to show some link between the parties, perhaps by way of a *pre-existing relationship* or some acts of association with the proprietor or some *nexus between the two competing marks*.

[Emphasis in italics mine]

64 Similarly for the purposes of this ground, I find the Initiator's version of events more convincing due to the consistency in the narration of events. The Initiator was also able to provide supporting evidence from third parties. On the other hand, the Respondent's account of events, including the documentation provided, is fraught with issues.

65 The Initiator’s case on bad faith is premised on the following:<sup>61</sup>

[83(a)] [Mr Martin], the “*sole director and proprietor*” of the Respondent, has had a *long history of dealings* with the Initiator and its goods. Since 1995, through [Mr Martin], the Respondent *knew* of the [Initiator’s Polybit Logos and Initiator’s Sub-brands].<sup>62</sup>

[84(b)] The Respondent was a *representative* of the Initiator, and / or was the *distributor* of the goods sold under the [Initiator’s Polybit Logos and Initiator’s Sub-brands] since 1995. The Respondent *knew* that it was not the trade source of the goods in the market. Critically, the Respondent knew that the [Initiator’s Polybit Logos and Initiator’s Sub-brands], and the goodwill in the business under the [Initiator’s Polybit Logos and Initiator’s Sub-brands], belong exclusively to the Initiator.

[83(c)] The Respondent *knew* that it was *not permitted to use “Polybit”* as part of its company name, yet it continued to do so. It *intentionally hid* the existence of the Respondent from the Initiator, and its conduct was not above board.

[83(d)] There is *obvious resemblance* between the [Respondent’s Marks] and the [Initiator’s Polybit Logos and Initiator’s Sub-brands].

[83(e)] This is not a case where a particular agreement existed between the parties to govern the use and / or registration of the [Initiator’s Polybit Logos and Initiator’s Sub-brands] or variants of the marks. The [Respondent’s Marks] acted in bad faith by *blatantly stealing and copying* the Initiator’s trade name and trade marks, and brazenly applying to register the [Respondent’s Marks], without consultation and without the knowledge of the Initiator’s.

[Emphasis in italics mine]

66 In brief, the Initiator submitted that the sequence of events is as follows:<sup>63</sup>

(a) Since 1995, the Respondent via Mr Martin, *knew* of the Initiator, the Initiator’s use of the word “Polybit” and the Initiator’s Polybit 1995 Logo as a result of its role as a *representative* of the Initiator through

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<sup>61</sup> IWS at [83].

<sup>62</sup> See Schedule, rows 1 – 5.

<sup>63</sup> IWS at [39]–[77].

Corrotech, which only ceased to be the distributor of the Initiator’s goods in 2008;

(b) The Initiator’s Polybit Logos and Initiator’s Sub-brands, were first used in Singapore by or with the consent of the Initiator since as early as around 2004. Such use included use through Cata. Cata also sought regulatory approval from the relevant authorities, such as the Public Utilities Board (“PUB”) for goods to be used in construction-related projects;

(c) Since 2008, the Respondent via Mr Martin *knew* of the Initiator and of the Initiator’s use of the Polybit 1995 Logo, Polybit 2010 Logo, and Polybit 2016 Logo as a result of its role as a *direct representative* of the Initiator. Specifically, Mr Martin *acknowledged* on multiple instances that he / it was a *representative*, and was acting on behalf of the Initiator. In addition, in a trade sourcing and business matching portal, it was advertised that the Respondent “is a...*subsidiary office of Henkel-Polybit Dubai, [UAE]*” (emphasis in italics mine);<sup>64</sup> and

(d) The Respondent, via Mr Martin *knew* of the Initiator’s exclusive proprietorship of the Initiator’s Polybit Logos and Initiator’s Sub-brands since 1995. The Respondent, via Mr Martin thus acted in bad faith in *concealing* its use of the Initiator’s Polybit Logos and Initiator’s Sub-brands, and in claiming proprietorship of the Initiator’s Polybit Logos and Initiator’s Sub-brands.

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<sup>64</sup> Initiator’s AB 2<sup>nd</sup> SD, Exhibit AB-22, pages 24 - 27.

67 The Initiator submitted that the Respondent’s account of its use of the Respondent’s Marks is *unreliable*. In particular, the invoices issued in 2003 as well as 2009 are *not genuine*.

68 On the other hand, the Respondent’s main submission is that “there is absolutely no commercial dishonesty on the part of the [Respondent]”:<sup>65</sup>

(a) PIL was first incorporated in 1995 by the Shareholders. Mr Martin was sales manager of Corrotech which provided help to PIL to distribute its products in the UAE *from 1995 onwards*.

(b) Mr Martin was invited by the Shareholders to join them in setting up an *independent* entity in Malaysia in 1999 (i.e., the Respondent). The Jan 2002 Agreement *was signed on 1 January 2002*. Pursuant to the agreement, each of the Shareholders including Mr Martin, became the four beneficial owners in equal shares of the Respondent.

(c) With the commencement of the Respondent’s operations, the Respondent approached Loo to design the Polybit 2010 Logo in 2001 or 2002.

(d) The Respondent, which was incorporated in 2001, is based in Malaysia but had supplied and continues to supply products to other countries in Southeast Asia, including Singapore. During this time, the relationship between the Respondent and PIL was not one of principal and distributor. There is *no* written agreement between the parties.

(e) Following the above, the Respondent is the *first user* of the Respondent’s Marks in *Singapore*.

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<sup>65</sup> RWS at [45].

(f) *In 2009, Mr Martin and the Shareholders agreed for Mr Martin to buy out their shares in the Respondent. Mr Martin had also relocated to Malaysia permanently by 2009. The Respondent expanded its business activities in Malaysia and the Southeast Asian region including Singapore.*

69 As alluded to above, “bad faith” as a concept is context-dependent” and “[i]n the final analysis, whether bad faith exists or not hinges on the *specific factual matrix* of each case”.<sup>66</sup>

70 It is clear that there was a pre-existing relationship between the parties and Mr Martin (via Corrotech) was a distributor of the Initiator at one point in time. This *pre-existing relationship* as well as the *similarity of the marks* (see discussion above in relation to copyright) are the *nexus* between the parties and form the context of the bad faith ground.

#### ***Genesis of and resemblance between the marks and logos***

71 I have already dealt with these issues under the ground of s 8(7)(b) and I will only repeat the salient points here. For completeness, it will become apparent that there is no need for me to rely on the Initiator’s Sub-brands (above).

72 I have touched on the evidence pertaining to the genesis of the Respondent’s Marks (which incorporates the Polybit 2010 Logo) and the Initiator’s Polybit Logos above and I will not repeat them here. In brief, I find the Initiator’s version of events *more convincing*.

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<sup>66</sup> See above.



73 The Initiator was able to explain, amongst others, the significance of the triangular device and the font used for the word “Polybit”. On the other hand, Loo was only able to say that the Polybit 2010 Logo was “designed and approved”<sup>67</sup> based on the “information” provided by Mr Martin.<sup>68</sup>

74 I have also touched briefly on the issue of resemblance between of the Respondent’s Marks and the Initiator’s Polybit Logos under the issue of “copying”. They are *highly* similar. In fact, as mentioned above, 40202021496R is *identical* to the Polybit 2010 Logo, while the rest of the Respondent’s Marks *include* the Polybit 2010 Logo.

75 The resemblance is *striking* as:

- (a) the word “Polybit” is an invented word which has no correlation to the goods of interest;
- (b) the design of the device (the triangular shape with the word “Polybit” within a black strip at the base of the triangle) is identical; and
- (c) similar shades of the colours, yellow and black, are used.

In essence, I am of the view that the Respondent’s Marks have taken the whole, or at the very least the “distinctive components”, of the Initiator’s Polybit Logos.

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<sup>67</sup> Respondent’s 1<sup>st</sup> SD at Exhibit JM-6 at [4].

<sup>68</sup> Respondent’s 2<sup>nd</sup> SD at Exhibit JM-3 at [10].

***Knowledge of the Initiator’s Polybit Logos and prohibition to use the same***

76 I have already alluded to the backgrounds of both parties above and will only re-iterate some salient points for context here.

77 It is not in dispute that PIL was first established on 22 April 1995 in the UAE.<sup>69</sup> The Initiator deposed that since or around the inception of PIL in 1995, it has been using, in the course of trade, the word “Polybit” and the Polybit 1995 Logo as trade marks and trade names.<sup>70</sup> The Initiator also gave evidence as to the genesis of the Initiator’s Polybit Logos.<sup>71 72</sup>

78 It is also *not in dispute* that Mr Martin was then in the employ of Corrotech, as a General Manager<sup>73</sup> and Corrotech was a distributor for PIL *since its inception in 1995*.<sup>74</sup>

79 However, the parties’ respective narratives differed thereafter. The Initiator deposed that the above arrangement lasted until 2008,<sup>75</sup> when, “for reasons unknown” Mr Martin ceased to be in the employ of Corrotech.<sup>76</sup> On the other hand, the Respondent deposed that in 1999, pursuant to the Jan 2002 Agreement between each of the Shareholders and Mr Martin, an *independent* entity, namely the Respondent, was incorporated in Malaysia in 2001.<sup>77</sup>

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<sup>69</sup> Initiator’s AB 1<sup>st</sup> SD at [6].

<sup>70</sup> Initiator’s AB 1<sup>st</sup> SD at [9].

<sup>71</sup> Initiator’s AB 1<sup>st</sup> SD at [9]-[10].

<sup>72</sup> See also Initiator’s ST 1<sup>st</sup> SD at [4]-[9].

<sup>73</sup> Respondent’s 1<sup>st</sup> SD at [9].

<sup>74</sup> Respondent’s 1<sup>st</sup> SD at [8]. Also Initiator’s AB 1<sup>st</sup> SD at [23].

<sup>75</sup> Initiator’s AB 1<sup>st</sup> SD at [23].

<sup>76</sup> Initiator’s AB 1<sup>st</sup> SD at [24].

<sup>77</sup> Respondent’s 1<sup>st</sup> SD at [9].

80 The Initiator filed evidence of an email from Mr Paul who stated that:<sup>78</sup>

...[the Respondent] was 100% owned by [Mr Martin’s] wife when incorporated and *none* of us were partners...As far as I know; [Mr Martin] was our exclusive distributor prior to [the joint venture] with Henkel and we have asked him *not* to use POLYBIT name *several times* after we have signed [the joint venture] with Henkel...As a result he *changed* his name to Industries Far East [IFE] ...and the distributorship agreement was signed accordingly...When I left in 2012; business was continuing as a distributor in the name of [IFE].

[Emphasis in italics mine]

81 The Initiator deposed that in the course of the distributorship relationship with Mr Martin, they had dealt directly with Mr Martin and Industries Far East Sdn Bhd (“IFESB”)<sup>79</sup> as well as the representatives of IFESB,<sup>80</sup> until their discovery of the existence of the Respondent.<sup>81</sup>

82 The Respondent deposed that “the incorporation of [IFESB] was the *Shareholders’ idea*” (emphasis mine).<sup>82</sup> The Respondent explained that after the acquisition by Henkel in 2005, the Shareholders informed Mr Martin that Henkel had told them that they “*could not operate*” other companies “with company names including “Polybit”” (emphasis in italics mine).<sup>83</sup> Thus, the

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<sup>78</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB–21 page 17.

<sup>79</sup> Incorporated on 19 Aug 2011; see Initiator’s AB 1<sup>st</sup> SD at Exhibit AB–18.

<sup>80</sup> Initiator’s AB 1<sup>st</sup> SD at [31].

<sup>81</sup> Initiator’s AB 1<sup>st</sup> SD at [37].

<sup>82</sup> Respondent’s 1<sup>st</sup> SD at [62].

<sup>83</sup> Respondent’s 1<sup>st</sup> SD at [61(i)].

[IFESB] is used for “internal accounting purposes” when “dealing with the Initiator”.<sup>84</sup>

83 However, the Initiator pointed out that Mr Melehy was the only shareholder left in 2005, the other shareholders having transferred their shares to Henkel.<sup>85</sup>

84 The Initiator deposed that “[Mr Martin] and [IFESB] had intentionally hid and concealed the existence of the Respondent from the Initiator”.<sup>86</sup> On the other hand, the Respondent deposed that the Initiator was aware of the existence of the Respondent since payments were made to the same.<sup>87</sup>

85 Regardless of which narrative I accept, what is clear from the above is that, since 2005, the Respondent was *aware of the prohibition* against the use of the word, “Polybit”.

***First user of the marks / logos***

86 The Respondent argued that it is the genuine owner of the Respondent’s Marks by reason of being the first user in Asia. However, it is important to establish that what is required for the purposes of this case is the identity of the first user of the marks / logos in *Singapore*.

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<sup>84</sup> Respondent’s 1<sup>st</sup> SD at [61].

<sup>85</sup> Initiator’s AB 1<sup>st</sup> SD at AB-4 at page 31.

<sup>86</sup> Initiator’s AB 1<sup>st</sup> SD at [39].

<sup>87</sup> Respondent’s 1<sup>st</sup> SD at Exhibit JM–19.

87 The three invoices relied on by the Respondent were dated 2003 and also cannot be taken into account since they do *not* pertain to sales in *Singapore*.<sup>88 89</sup>

88 While the Respondent provided evidence of the sales in *Singapore* for the period 2001 – September 2022,<sup>90</sup> the earliest invoice in relation to Singapore was dated 29 September 2009 (“Earliest Singapore Invoice”).<sup>91</sup> The Respondent deposed that they were only able to provide “total sales (as opposed to a yearly breakdown)” for the years 2001 to 2012 for the following reasons:<sup>92</sup>

- (a) most of its documentation was stolen, misplaced or destroyed by a rogue employee in 2008;
- (b) the Respondent lost access to detailed accounts following a migration of accounting systems in or around 2012; and
- (c) the Respondent was only required to maintain records for the past seven years under Malaysia's income tax law / audit requirements.

89 On the other hand, the Initiator submitted that the invoices,<sup>93</sup> including the Earliest Singapore Invoice, are *not* genuine as the domain name, in particular

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<sup>88</sup> Respondent’s 1<sup>st</sup> SD at Exhibit JM-7 at pages 87-89.

<sup>89</sup> To complete the analysis, I agree with the Initiator that it is *odd* that the invoice numbers of these three invoices are simply dates, which coincide with the dates when the invoices were issued. I also observed that this unusual practice did not apply to the rest of the invoices issued by the Respondent (see Respondent’s 1<sup>st</sup> SD at Exhibit JM-5 at pages 72 and 73).

<sup>90</sup> Respondent’s 1<sup>st</sup> SD at [17].

<sup>91</sup> Respondent’s 1<sup>st</sup> SD at Exhibit JM-5 at page 72.

<sup>92</sup> Respondent’s 1<sup>st</sup> SD at [27] and at page 6, footnote 1.

<sup>93</sup> Apart from the earliest invoice above, see also page 73 of Exhibit JM-5 of Respondent’s 1<sup>st</sup> SD which is an invoice dated 12 May 2010.

“polybitfareast.com”, which can found on the said invoices was only created on 29 October 2010.<sup>94</sup>

90 The Initiator further submitted that its sole distributor, Cata, used the Polybit 1995 Logo since 2004.<sup>95</sup> The following evidence is relevant:

(a) a product brochure in relation to BITUTAPE 150 which reflected the Polybit 1995 Logo following a query from a customer on 31 August 2004;<sup>96</sup>

(b) a letter dated 6 September 2004 issued by the PUB, where approval was granted for the use of “*Polybit Bitutape 165 – Anti-corrosion wrapping tape*” (emphasis mine).<sup>97</sup>

(c) commercial invoices as well as packing lists issued by the Initiator, reflecting the Polybit 1995 Logo in black and white, in relation to the product “Bitutape” addressed to Cata in 2008;<sup>98</sup> and

(d) a purchase order dated 29 July 2009 issued by Cata addressed to PIL relating to “Bitutape”.<sup>99</sup>

91 The Respondent submitted at the oral hearing that there were no invoices issued by Cata. This is true. But taking into account the *totality* of the evidence,

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<sup>94</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB-23 at page 29.

<sup>95</sup> IWS at [53].

<sup>96</sup> Initiator’s AC 2<sup>nd</sup> SD at Exhibit 11 at pages 9-11.

<sup>97</sup> Initiator’s AC 1<sup>st</sup> SD at Exhibit 3.

<sup>98</sup> Initiator’s AC 1<sup>st</sup> SD at Exhibit 4 at pages 29-31 and pages 35-36.

<sup>99</sup> Initiator’s AC 1<sup>st</sup> SD at Exhibit 2 at page 10.

I am prepared to accept that the Initiator, via Cata, is the first user of the Polybit 1995 Logo (which is integral to the Polybit 2010 Logo) in Singapore.

***Appointment as distributor***

92 The Initiator also provided *documentary evidence* that Mr Martin was appointed as a distributor. The Initiator deposed that there was an “organisational announcement” that Mr Martin “has *joined* [the *Initiator*] as General Manager, Far East...to develop further business in Far East Region” (emphasis mine).<sup>100</sup> The above was via an internal memo attached to Mr Paul’s email dated 29 July 2009, from the “Executive Council” and addressed to the “Senior Managers – [the Initiator]” and signed off by Mr Paul as “Director Sales & Marketing”. I also observe that the email was addressed to two of the shareholders, Mr Melehy and Mr Kini.<sup>101 102</sup>

93 The Respondent deposed that Mr Martin “did not join the [Initiator] as its General Manager, Far East” and that “[he] was not sent or copied on the "Organisational Announcement" sent by Mr Paul to the [Initiator]’s staff”.<sup>103</sup> However, this is a bare denial, while the email was addressed to several of the Initiator’s staff, including two of the shareholders as alluded to above.

94 In light of the above, there is *at least some evidence in writing* as to the appointment even though there is no evidence of any distributorship agreement or employment agreement signed as alleged by the Respondent at the oral hearing.

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<sup>100</sup> Initiator’s AB 1<sup>st</sup> SD at [25]-[26]; see also Exhibit AB-11.

<sup>101</sup> Initiator’s AB 1<sup>st</sup> SD at Exhibit AB-11 at page 143.

<sup>102</sup> See Initiator’s AB 1<sup>st</sup> SD at [9] as to the identity of Mr Kini.

<sup>103</sup> Respondent’s 1<sup>st</sup> SD at [54].

***Holding himself / itself out as a representative***

95 The Respondent (via Mr Martin) made representations to the effect that it is a representative of the Initiator on several occasions:

(a) 15 June 2010: in his email to Cata, Mr Martin stated “[t]hanks for the enquiry sent to *our HQ in Dubai*” and referred to himself as “the *General Manager for the Far East Region* based in Malaysia”<sup>104</sup> and his signature block reads “John Martin, *General Manager - Far East Region, Henkel - Polybit Industries Ltd., UAE*” (emphasis in italics mine);<sup>105</sup>

(b) 24 June 2010: in another email to Cata, he stated that “[a]pologies...*our HQ Export Sales* has erroneously quoted prices to this [c]ompany in Singapore” (emphasis in italics mine);<sup>106</sup>

(c) 24 November 2016: in another email to Cata he stated as follows:<sup>107</sup> “...we have *supported you wholly and fully* over the past years...*Henkel HQ Germany*...wants *us* to be more pro-active on ‘anti-corrosive pipe wrapping tape’ in the *ASEAN regional market*...we have *given you complete exclusivity in Singapore*...” (emphasis in italics mine);

(d) 10 June 2019: Mr Martin emailed one of the Initiator’s employees who was leaving, Kaleemullan Khan,<sup>108</sup> stating: “[c]an [you]

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<sup>104</sup> Initiator’s AC 2<sup>nd</sup> SD at Exhibit 15.

<sup>105</sup> Initiator’s AC 2<sup>nd</sup> SD at Exhibit 15.

<sup>106</sup> Initiator’s AC 1<sup>st</sup> SD at Exhibit 6.

<sup>107</sup> Initiator’s AC 2<sup>nd</sup> SD at Exhibit 16.

<sup>108</sup> Initiator’s AB 1<sup>st</sup> SD at Exhibit AB-13 at page 149; this email was sent at 3.10pm.



please make sure that [Ingrid Estrada]<sup>109</sup> is aware...*as per our agreement with the Management, that all enquiries originating from [these] regional countries (Malaysia, Singapore, Vietnam), directly to the [Initiator] from our customers, for Polybit products, have to be forwarded to us directly for quoting & follow-up*” (emphasis in italics mine);<sup>110</sup>

(e) 15 August 2019: an email enquiry from a Vietnamese entity was *forwarded by Ingrid Estrada to Mr Martin* which was duly *acknowledged by Mr Martin* via an email on the same date;<sup>111</sup> and

(f) 4 January 2012: an email to Cata where Mr Martin referred to “our website”.<sup>112</sup> The Initiator deposed that Cata understood this to be referring to the Initiator’s website as the website address “polybit.com.my” was only registered on 18 October 2019.<sup>113</sup>

96 The Respondent sought to explain the email referred to in [95(b)] as follows:<sup>114</sup>

[56]...the email was related to [Mr Chia's] unhappiness that the Respondent had quoted/sold directly to customers in Singapore, whom he alleges were [Cata]'s customers. His email had no proof that the Respondent had actually sold directly to [Cata]'s customers. Nonetheless, to **alleviate** the situation, **I stated that it was a mistake**. I was *not* acknowledging that I was a representative or acting on behalf of the Initiator.

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<sup>109</sup> She took over from Kaleemullan Khan (see his email of 10 June 2019 at 2.29pm also at Initiator AB 1<sup>st</sup> SD Exhibit AB-13 at page 149).

<sup>110</sup> Initiator’s AB 1<sup>st</sup> SD Exhibit AB-13 at page 149.

<sup>111</sup> Initiator’s AB 1<sup>st</sup> SD at Exhibit AB-13 at pages 151 - 153.

<sup>112</sup> Initiator’s AC 2<sup>nd</sup> SD at Exhibit 13 at page 31.

<sup>113</sup> Initiator’s AC 2<sup>nd</sup> SD at Exhibit 14 at page 35.

<sup>114</sup> Respondent’s 1<sup>st</sup> SD at [56].

[Emphasis in bold and italics mine]

97 The above explanation is astonishing if, *per* what the Respondent submitted above, it was *not* a distributor but an independent buyer cum seller of the Initiator’s products.

98 At its highest, the Respondent will have to accept the consequences of this explanation - it was *putting itself out as a representative* of the Initiator.

99 At its lowest, the Respondent was *going against the crux* of its argument that it was incorporated as an *independent* company<sup>115</sup> pursuant to the Jan 2002 Agreement<sup>116</sup> and that it was simply a *buyer cum seller* vis-à-vis the Initiator.<sup>117</sup>

***Attempts to reach Singapore customers directly***

100 The Initiator deposed that “over the years, due to the established business relationship between the Initiator and [Cata], [Cata] was effectively the *sole distributor* in Singapore of the POLYBIT BITUTAPE goods.” (emphasis in italics mine)<sup>118</sup>

101 The understanding between the Initiator and Cata was that the Initiator would invoice Cata and Cata would pay the Initiator while the goods would be imported directly from the UAE.<sup>119</sup> This arrangement continued for a while when Mr Martin took over in 2009 / 2010 such that even though Cata was

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<sup>115</sup> Respondent’s 1<sup>st</sup> SD at [9] and [12].

<sup>116</sup> Respondent’s 1<sup>st</sup> SD at [10].

<sup>117</sup> Respondent’s 1<sup>st</sup> SD at [16].

<sup>118</sup> Initiator’s AC 1<sup>st</sup> SD at [10] and [12].

<sup>119</sup> Initiator’s AC 1<sup>st</sup> SD at [6] and [9].

communicating with Mr Martin, all the invoices continued to be issued by the Initiator<sup>120</sup> and the goods were imported from the UAE.<sup>121</sup>

102 However, the Initiator deposed that Mr Martin started to *quote directly to customers in Singapore*.<sup>122</sup> The Initiator deposed that sometime in 2017 – 2018, Mr Martin insisted that Cata place orders with the Respondent directly and alone.<sup>123</sup> Invoices were issued by the Respondent and the goods were exported from Malaysia.<sup>124</sup>

103 In fact, it was due to this that Mr Martin tried to allay Cata’s concerns back in 2010 by conveying his apologies in an email (above at [95(b)]).

104 Then sometime in or around 2020–2021, Cata noticed that there were other distributors of POLYBIT BITUTAPE in Singapore,<sup>125</sup> which contravened the arrangement Cata had with the Initiator where Cata is to be the sole distributor in Singapore.<sup>126</sup> As a result, Cata queried the Initiator in 2021<sup>127</sup> whereupon it discovered that all its orders placed for the period 2017– 2020, via Mr Martin, *did not reach and were not known* to the Initiator.<sup>128</sup>

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<sup>120</sup> Initiator’s AC 1<sup>st</sup> SD at [11] and at Exhibit 5, page 40 (invoice dated 4 February 2012).

<sup>121</sup> Initiator’s AC 1<sup>st</sup> SD at [11] and at Exhibit 5, page 41 (packing list dated 4 February 2012) and country of dispatch stated to be “United Arab Emirates”.

<sup>122</sup> Initiator’s AC 1<sup>st</sup> SD at [12].

<sup>123</sup> Initiator’s AC 1<sup>st</sup> SD at [13].

<sup>124</sup> Initiator’s AC 1<sup>st</sup> SD at Exhibit 7 at pages 60- 61 (email dated 27 June 2017 from Mr Martin to Mr Chia) and page 63 (invoice dated 28 June 2017).

<sup>125</sup> Initiator’s AC 1<sup>st</sup> SD at [14].

<sup>126</sup> Initiator’s AC 1<sup>st</sup> SD at [12]

<sup>127</sup> Initiator’s AC 1<sup>st</sup> SD at [14] and at Exhibit 8, page 110, Mr Chia’s email dated 25 February 2021 to Mr Binbrek.

<sup>128</sup> Initiator’s AC 1<sup>st</sup> SD at [14].

105 I am of the view that the Respondent’s actions above, especially those in 2017–2020 reek of bad faith, in light of the Respondent’s knowledge of the use of the Initiator’s Polybit Logos and the prohibition against using the same, and in particular in light of the previous incident in 2010 when the Respondent had to allay Cata’s concerns and assure Cata that it remained the Initiator’s sole distributor in Singapore (see above at [95(b)]).

***Issues with Respondent’s narrative***

106 The following are some of the issues which I have with the Respondent’s narrative.

***Validity of the Jan 2002 Agreement***

107 The first point of contention is whether the Jan 2002 Agreement, which was allegedly made pursuant to an “invitation” from the Shareholders to Mr Martin to set up an *independent* company in Malaysia in 1999,<sup>129</sup> was a valid document. The Respondent submitted at the oral hearing that the “document speaks for itself”.

108 However, the Initiator filed evidence of an email from one of the alleged signatories,<sup>130</sup> who was one of the Shareholders, Mr Paul, who stated that “[PIL] *never signed* [the Jan 2002 Agreement] with [Mr Martin] to establish [the Respondent]” and that he “*cannot recall* signing a beneficial ownership in

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<sup>129</sup> Respondent’s 1<sup>st</sup> SD at [9] and [10].

<sup>130</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB-21 at page 16.

[the Respondent] as a company or *individuals*<sup>131</sup> in 2002” (emphasis in italics mine).<sup>132</sup>

109 The Respondent submitted evidence by one Mr Ahmad, who was one of the signatories as well, regarding the “signing of [the Jan 2002 Agreement]”,<sup>133</sup> and in particular, the fact that “[Mr Paul] and other signatories did sign [the Jan 2002 Agreement]”.<sup>134</sup> However, this does not help the Respondent’s case as Mr Ahmad deposed that “[the Jan 2002 Agreement] was *already* prepared and signed by all beneficiaries<sup>135</sup>, *before* it was given to me for [signature]”<sup>136</sup> (emphasis in italics mine).

110 The Respondent also tendered evidence of one Tan Mau Kang (“Mr Tan”) to show that the Jan Agreement 2002 was “duly provided to the [relevant authorities to be stamped]” and that the Jan 2002 Agreement was “duly signed by the named signatories, including [Mr Paul].”<sup>137</sup> Again, Mr Tan’s evidence does not help as what he does verify is that, amongst others, he had “inscribed the date on [the Jan 2002 Agreement]”<sup>138</sup> and had “sent [the Jan 2002 Agreement] for stamping”.<sup>139</sup> There is nothing to indicate that he witnessed Mr Paul signing the Jan 2002 Agreement.

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<sup>131</sup> The Respondent submitted at the oral hearing that the Shareholders had entered into the Jan 2002 Agreement in their personal capacity.

<sup>132</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB-21 at page 16.

<sup>133</sup> Respondent’s 3<sup>rd</sup> SD at [8(i)].

<sup>134</sup> Respondent’s 3<sup>rd</sup> SD at [8(i)].

<sup>135</sup> That is, the Shareholders and Mr Martin.

<sup>136</sup> Respondent’s 3<sup>rd</sup> SD at Exhibit JM-1 at [9].

<sup>137</sup> Respondent’s 3<sup>rd</sup> SD at Exhibit JM-1 at [8(ii)].

<sup>138</sup> Respondent’s 3<sup>rd</sup> SD at Exhibit JM-2 at [6].

<sup>139</sup> Respondent’s 3<sup>rd</sup> SD at Exhibit JM-2 at [6].

111 Curiously, I observe that the stamp was only appended *ONE year* after it was signed and dated, in 2003.<sup>140</sup> Interestingly, Mr Tan deposed that he could not recall the date of the agreement as well as the date of stamping.<sup>141</sup>

112 In light of all of the above, the weight to be accorded to the Jan Agreement 2002, if any, is *low* at best.

113 Crucially, despite the Respondent’s claims that it is independent of the Initiator,<sup>142</sup> the Initiator filed evidence of a third party trade portal in Malaysia where it was stated that the Respondent is a “*subsidiary office of Henkel-Polybit Dubai, [UAE]*” (emphasis in italics mine).<sup>143</sup> While the copyright notice on this website was dated 2006-2007 and the printout was dated 2023, it is to be recalled that events after the Relevant Dates which may assist in determining the Respondent’s state of mind as at the Relevant Dates can be taken into account.

*Mr Martin “buying out” shares of the Shareholders*

114 The Respondent deposed that, in 2008, a rogue employee misappropriated its goods and a case was filed with the police in Malaysia.<sup>144</sup>

115 The Respondent also deposed that as a result of this incident, Mr Martin had a meeting with the Shareholders in the UAE, where the Shareholders informed him that they “did not wish to continue maintaining the business of

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<sup>140</sup> Respondent’s 1<sup>st</sup> SD at Exhibit JM-1 at page 30.

<sup>141</sup> Respondent’s 3<sup>rd</sup> SD at Exhibit JM-2 at [4].

<sup>142</sup> The Respondent was incorporated in 2001.

<sup>143</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB-22 pages 24-27.

<sup>144</sup> Respondent 1<sup>st</sup> SD at [27] and Exhibit JM-10 at pages 191–196 (English translation of the Police Reports).

Respondent or be related to the Respondent”<sup>145</sup> and that the Shareholders and Mr Martin agreed that Mr Martin “would buy out their shares by paying out all profits [Respondent] had made from 2001 to 2006”<sup>146</sup> such that Mr Martin would be the “sole director and proprietor of Respondent”.<sup>147</sup>

116 Unfortunately, there is *no evidence of this transfer* as the bank statements for the period 2002–2008 “did *not* show clearly which [telegraphic transfer] payments were made to the Shareholders’ accounts (e.g, the identity of the recipient)”<sup>148</sup> (emphasis in italics mine). The Respondent deposed that he was advised by the bank staff that this was due to the “migration of the bank’s computer systems”<sup>149</sup> and that the “[telegraphic transfer] images of the overseas transfer cannot be obtained since it is a different software system”.<sup>150</sup>

117 Last but certainly not least, the Initiator also filed evidence to the effect that Mr Paul “cannot recall” “selling any shares of [the Respondent] [in] 2009”.<sup>151</sup>

*Arrangement for “re-direction” of queries in 2009*

118 The Respondent deposed that despite the above, they were still on good terms such that there were discussions between the Shareholders and Mr Martin about how the parties could do more business.<sup>152</sup> It was then suggested that the

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<sup>145</sup> Respondent’s 1<sup>st</sup> SD at [28].

<sup>146</sup> Respondent’s 1<sup>st</sup> SD at [28].

<sup>147</sup> Respondent’s 1<sup>st</sup> SD at [28].

<sup>148</sup> Respondent’s 1<sup>st</sup> SD at [28].

<sup>149</sup> Respondent’s 1<sup>st</sup> SD at [28].

<sup>150</sup> Respondent’s 1<sup>st</sup> SD at [28].

<sup>151</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB-21 at page 16.

<sup>152</sup> Respondent’s 1<sup>st</sup> SD at [53].

Respondent try to purchase more of the Initiator’s goods.<sup>153</sup> In exchange, enquiries to the Initiator, which was “then controlled by the Shareholders”, for purchase of goods, were to be “re-directed” to the Respondent.<sup>154</sup>

119 The Respondent deposed that this “stop-gap” arrangement was meant to last only until the Respondent had “finalised its plans with the Shareholders for setting up independent manufacturing facilities in Malaysia”.<sup>155</sup>

120 The Respondent deposed that, unfortunately, “this arrangement was privately [*sic*] between the Shareholders and [Mr Martin] and *no* formal agreement was signed given [the] good relationship” (emphasis in italics mine).<sup>156</sup>

121 Last but not least, it has been alluded to above that, by 2005, Mr Melehy was the only shareholder left, the other shareholders having transferred their shares to Henkel.<sup>157</sup>

***Conclusion on ground of Invalidation and Oppositions under s 7(6)***

122 I am mindful that “[a]n allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence”.<sup>158</sup> Nevertheless, in light of *all* of the factors discussed, I am persuaded that the ground of bad faith has been ***made out*** and the invalidation and opposition under s 7(6) ***succeeds***.

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<sup>153</sup> Respondent’s 1<sup>st</sup> SD at [53(ii)].

<sup>154</sup> Respondent’s 1<sup>st</sup> SD at [53(iii)].

<sup>155</sup> Respondent’s 1<sup>st</sup> SD at [53(iv)].

<sup>156</sup> Respondent’s 1<sup>st</sup> SD at [53(v)].

<sup>157</sup> Initiator’s AB 1<sup>st</sup> SD at AB-4 at page 31.

<sup>158</sup> Above at [62].



123 In my view, it is particularly damning that the Respondent held itself out, on several occasions, as a representative of the Initiator. It is also telling that, as alluded to above, a third party trade portal described the Respondent as “a *subsidiary office of Henkel-Polybit Dubai, [UAE]*” (emphasis in italics mine).<sup>159</sup>

124 Finally, I should add that the above conclusion similarly applies to the element “but does not satisfy the court that he does so in good faith” referred to in s 130(1B) CA (see above at [28]).

### **Other grounds of invalidation and opposition**

125 Given that the Initiator has succeeded on the grounds under both s 8(7)(b) and s 7(6), there is *no* need for me to deal with the rest of the grounds. However, for completeness, I will deal with them very briefly here.

126 The other grounds which are sought to be relied on by the Initiator are:

- (a) Section 8(1);
- (b) Section 8(2);
- (c) Section 8(4)(b)(i); and
- (d) Section 8(7)(a).

I also note that the ground of objection under s 8(1) and s 8(2)(a) only relate to 40202021496R. However, for convenience, I will deal with all of the grounds at the same time.

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<sup>159</sup> Initiator’s AB 2<sup>nd</sup> SD at Exhibit AB-22 pages 24-27.

127 One of my difficulties in relation to these grounds is the requirement for the Initiator’s Polybit Logos, to be *well-known* to the relevant sector of the public. This is so as the Initiator does not have an earlier trade mark application to rely on, and therefore has to rely on s 2(b) of the Act.

128 Section 2 of the Act reads:

“earlier trade mark” means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, *at the date of application for registration* of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was *a well known trade mark*, and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

[Emphasis in italics mine]

129 In particular, the following sections of the Act are relevant to determine whether a mark is well known. Section 2(7)(a) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant...the degree to which the trade mark is known to or recognised by *any relevant sector of the public* in Singapore...

Section 2(8) of the Act reads:

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

Section 2(9) of the Act states:

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

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

[Emphasis in italics mine]

130 The above provisions have been the subject of further exposition by the Courts:

(a) Section 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because s 2(8) *deems* a trade mark to be well known in Singapore where it is determined to be well known to *any* relevant sector of the public in Singapore (see [139] of *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR (R) 216 ("*Amanresorts*").

(b) Aside from s 2(7)(a), the court is ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires and to take additional factors into consideration (*Amanresorts* at [137]).

(c) In relation to s 2(8), the Court of Appeal in *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 clarified that:

[101] ...we said in *Amanresorts* that it is “not too difficult” for a trade mark to be regarded as well known in Singapore<sup>160</sup>...

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<sup>160</sup> The Court of Appeal in *Amanresorts* commented that it is *not too difficult* for a trade mark to be regarded as “well known in Singapore” since the trade mark in question need only be recognised or known by “*any* relevant sector of the public in Singapore” which could in certain cases be *miniscule* (*Amanresorts* at [229]).

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

[Emphasis in italics mine]

(d) Last but not least, with regard to the ambit of s 2(9)(a), the inquiry is into the *specific goods or services* which the *Applicant's trade mark has been applied on* ([152] *Amanresorts*).

131 The Initiator submitted, amongst others, that Mr Martin was acting as a representative of the Initiator such that all of the Respondent's "use, sales, and benefits" relating to the Respondent's Marks would have "inured to the Initiator".<sup>161</sup>

132 Even so, the figures provided by the Respondent,<sup>162</sup> which span the period 2001 – September 2022, *lack specificity* in relation to the specific marks and particular goods (see above at [130(d)]).

### **Overall conclusion**

133 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the invalidation and oppositions under s 8(7)(b) and s 7(6) *succeed* such that:

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<sup>161</sup> IWS at [178].

<sup>162</sup> Respondent's 1<sup>st</sup> SD at [17].

- (a) 40202021511R shall be *deemed never to have been made*, but this does not affect transactions past and closed; and
- (b) *each* of the marks below *shall not proceed to registration*:
  - (i) 40202021496R;
  - (ii) 40202021512P;
  - (iii) 40202023160V;
  - (iv) 40202023161Q;
  - (v) 40202023159Q; and
  - (vi) 40202021510T.

134 The Initiator has requested that it file submissions on costs separately. As such, I will hear the parties on costs.

Sandy Widjaja  
Principal Assistant Registrar

Yvonne Tang, Edsmond Cheong and Jeanette Tang (Drew & Napier LLC)  
for the Initiator;

Alvin Lim and Valen Lim (Whitters KhattarWong LLP) for the  
Respondent