

# Intellectual Property Office of Singapore Case Summary: Harvard Club of Singapore v President and Fellows of Harvard College [2019] SGIPOS 14

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Published: 17 October 2019

In this dispute, Harvard University (formally known as President and Fellows of Harvard College), crossed swords with Harvard Club of Singapore, an alumni club that was first officially recognised by the university as an authorised Harvard Club in the month of May, 1969.

Due to certain issues relating to the leadership of the club, in May 2015, Harvard University revoked the official alumni club status of Harvard Club of Singapore. At the same time, the university withdrew its consent for the club to use the university's trade marks (including "Harvard" and "Harvard Club"). In December 2014, which was prior to the termination of the 45-year long relationship between the parties, and while various demands were still being made, Harvard University applied to register the following two trade marks for "club services" in Class 41: "HARVARD CLUB OF SINGAPORE", and "HARVARD UNIVERSITY CLUB OF SINGAPORE" (collectively, the "Application Marks"). Harvard Club of Singapore filed to oppose the registration of the Application Marks. (For more details on the background, please see paras. 2 to 9 of the decision.)

The club initially pleaded various grounds of opposition but ultimately relied on three. First, that there was bad faith under s 7(6) of the Trade Marks Act ("TMA"). Second, that the Application Marks should be refused registration on the passing off ground under s 8(7)(a) TMA because the club, and not Harvard University, enjoyed the goodwill attached to the name "Harvard Club of Singapore". Third, that the use of "HARVARD CLUB OF SINGAPORE" was prohibited in Singapore by written law or rule of law and should be refused registration under s 7(5) TMA read with s 4(3)(c) of the Societies Act. (This third ground of opposition did not concern "HARVARD UNIVERSITY CLUB OF SINGAPORE".) Ultimately, the hearing officer dismissed the oppositions. An outline of his main reasons is as follows.

- (1) On the evidence, the parties were in a trade mark licensor-licensee relationship between May 1969 to May 2015. Although there was no formal signed agreement, he found the existence of an implied licence agreement based on objective assessment of the facts of the case and the conduct of the parties. It was by virtue of this licence agreement that the club was given the right to use the university's trade marks (including "Harvard" and "Harvard Club"). (A summary of the key facts is set out at para. 79 of the decision.)
- (2) The law on ownership of goodwill in licensor-licensee situations is that absent any agreement to the contrary, the licensor or franchisor is the owner of the goodwill. On the facts, the whole point of the trade mark relationship was to license the use of "Harvard" or "Harvard Club" to the club so that its use would not amount to passing off. There was no evidence of an agreement that the goodwill attaching to "Harvard Club of Singapore" would belong to the club. Therefore, the university owned the goodwill and hence the passing off ground could not succeed.
- (3) One key component of the club's case in relation to bad faith was that the Harvard Alumni Association (the department tasked with supporting the approximately 200 Harvard Clubs around the world) applied to register the Application Marks without obtaining authorisation from the university. However, it had no evidence to prove this. Conversely, there was evidence pointing the other way. (For details, see paras. 16 – 29, 32 – 33 and 38 – 43 of the decision.) In light of the fact that there was a licensing relationship between the parties, and that Harvard University owns all of the relevant goodwill, it was clear that it was well within Harvard University's right to file for the Application Marks at any point of time it deemed fit. Consequently, even though the university had filed for the Application Marks prior to termination, this did not amount to bad faith.
- (4) Section 4(3) of the Societies Act deals with the discretion of the Registrar of Societies, who may refuse to register a specified society in certain circumstances (e.g. there already exists a registered society with an identical name). However, the essential element of s 7(5) TMA is that the provision deals with instances involving actual use prohibited by any written law or rule of law. Because registration of a society (or a company) is different from actual use, s 4(3) of the Societies Act is not applicable to the present situation. Therefore, that ground of opposition failed.

*Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2019/harvard-club-of-singapore-v-president-and-fellows-of-harvard-college-2019-sqipos-14.pdf>.*