

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

Case No. HC/OS 584/2018

In the matter of Section 23 of the Trade Marks
Act (Cap. 332)

And

In the matter of Section 182 of the Supreme
Court of Judicature Act (Cap. 322)

And

In the matter of Trade Mark Number:
40201716204Y

And

In the matter of Order 87 Rule 2 of the Rules of
Court (Cap. 322, R 5)

Between

LANGE COMMUNICATIONS PTE LTD
(Singapore UEN No. 200415586M)

...Applicant

And

ROLAND AMOUSSOU GUENOU
(France Passport No. 15FVO4189)

... Respondent

RESPONDENT'S REPLY SUBMISSIONS

For Hearing on 19 July 2018 at 10.00 a.m. at Court 3D

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Dated this 18th day of July 2018

RESPONDENT'S REPLY SUBMISSIONS

May it Please the Court,

I. Introduction

1. These Respondent's Reply Submissions and Bundle of Authorities Volume 4 are filed in response to the Applicant's Skeletal Submissions filed on 16 July 2018.
2. As previously stated in the Respondent's Skeletal Submissions, the Applicant's contentions and allegation in relation the grounds of passing off and copyright were not particularised in any of the five (5) affidavits filed by the Applicant. These belated submissions are therefore occasioned by the Applicant's imprecision in pleading its case. Be that as it may, the Respondent's responses to Applicant's Skeletal Submissions filed on 16 July 2016 are set out hereunder.
3. These Reply Submissions relate to the following issues:
 - (1) whether the Respondent's trade mark should be invalidated on the grounds of passing off; and
 - (2) whether the Respondent's trade mark should be invalidated on the grounds of copyright infringement.

II. Invalidity of Registration on the Ground of Passing Off

(1) Applicable Legal Principles

4. Under s 23(3)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed)¹ (“TMA”), a registered trade mark can be invalidated if it is shown that there is an *earlier right* in relation to which the condition set out in section 8(7) is satisfied.
5. Section 8(7)(a) provides that a trade mark shall not be registered if its use in Singapore is liable to be prevented by virtue of the law of *passing off*.²
6. Read together, a registered mark therefore may be invalidated if the party applying to invalidate that mark can show that a case of passing off by the respondent could be made out.
7. In *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618³ (“**Rovio**”) at [164], the High Court held that to show that the use of the mark was liable to be prevented by the law of passing off per s 8(7)(a) of the TMA, an opponent had to adduce sufficient evidence to establish a *prima facie* case on goodwill, misrepresentation and damage. The standard is set as *prima facie* because a passing off claim is not actually brought and any assessment is “*hampered by the lack of a full trial and detailed facts and evidence.*”

¹ Tab 1 of RBA Vol.1

² Tab 1 of RBA Vol.4

³ Tab 3 of RBA Vol.4

8. For the purposes of these submissions, the focus will be on the first requirement of goodwill.

9. Goodwill has been given an authoritative definition by the Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216⁴ (“**Aman**”) at [134] as being the “*benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in a custom...*” Notably, there is a presupposition of a “*business*.” This is borne out by the holding in *Future Enterprises Pte Ltd v Tong Seng Produce Pte Ltd* [1997] 3 SLR(R) 797⁵ (“**Future Enterprises**”) at [30] that “*to have goodwill there must be a business, trade or calling.*”

10. However, evidence of **general** goodwill is insufficient. As stated by the Court of Appeal in *Staywell Hospitality Group Pty Ltd v Starwood hotels & Resorts Worldwide, Inc* [2014] 1 SLR 911⁶ (“**Staywell**”) at [130], “*goodwill must exist in Singapore* (emphasis added).” As stated in *Future Enterprises* at [30], “*goodwill is territorial because it only exists where the trade exists.*” Thus, even where a party has a famous business in many countries worldwide (and is able to prove goodwill in the said countries), but not in Singapore, she may not be able to prove goodwill in Singapore.

⁴ Tab 2 of RBA Vol.4

⁵ Tab 1 of RBA Vol.4

⁶ Tab 4 of RBA Vol.4

11. Further, “*the first step to proving goodwill in a passing off action is to demonstrate that the claimant has a **business in Singapore***” (emphasis added) (*Rovio* at [172]). Again, there is an emphasis on having a business in Singapore. In *Staywell*, while the St Regis hotel chain was famous, the Court of Appeal ultimately concluded that it had no goodwill in Singapore at the relevant time because it did not actually have a hotel in Singapore, and there was no sufficient pre-trading activity (*Staywell* at [141]).
12. In *Aman* at [54], the Court of Appeal cautioned that domain names and websites featuring the name in which goodwill is said to exist “*will ordinarily be insufficient as proof.*” Active steps must be taken and on the facts of that case, the Court did not give weight to the fact that millions of hits were sufficient exposure as a factor in finding goodwill (limited goodwill was found on other grounds).

(2) *Applicable Facts*

13. For this Honourable Court to make a holding of *prima facie* passing off by the Respondent, the Honourable Court must first find that the Applicant has the necessary goodwill in Singapore.
14. The Applicant has not been able to show that it has established goodwill *in Singapore*. As the party seeking to invalidate, the onus is on the ***Applicant*** to establish that it has goodwill, and not the Respondent.

15. While we reject the assertions that the Respondent does not have goodwill in the mark, we nevertheless submit that it is immaterial whether he has goodwill in Singapore or not.
16. Turning now to the Applicant's claims that it has goodwill in Singapore, there is not a scintilla of evidence to support the necessary requirement of showing there was a "*business, calling or trade*" in Singapore.
17. With respect, evidence of the Applicant's Facebook page, which it cites in its Skeletal Submissions at [58], is insufficient, per the caution in *Aman* at [54]. More than that, the Applicant concedes that the fan base is *international* – there is no evidence establishing a presence of custom or following in Singapore. If millions of hits (the source of which could not be established) was insufficient in *Aman*, the Applicant's case falls well below the required threshold to show a business, calling or trade in Singapore.
18. There is further no evidence that the Applicant had any goodwill arising from commercial activity, because there was no such commercial activity in Singapore. The "*Colada*" Latin Dance Congresses relied on by the Applicant, whether 2016 or 2017, were held in Bangkok, and not Singapore. In any event, any goodwill arising out of these events should be attributed to the Respondent because it was his efforts that led to the success of these

events.⁷ It bears mention that it is undisputed that neither Ralf nor Vanessa have any networks, experience or expertise in the Latin dance industry.

19. The fact relied on that the Applicant had worked with various reputable dance studios situated in Singapore has not been particularised and is a bare assertion⁸. Neither should it be material that the Applicant hired a sole Singapore dance instructor or held a one-off event was held in Singapore⁹. Other events relied on such as concerts in Taipei are irrelevant, given they took place outside of Singapore. In particular, the Latin dance event averred to¹⁰ was held in Bangkok, and there cannot be reliance on the pamphlets or merchandise for that event to support a claim of goodwill in *Singapore*.
20. While the Applicant may have submitted at [60] of their Skeletal Submissions that it is not a requirement to have a physical shop in Singapore, the Applicant cannot dispute that there is still a requirement of showing an established presence, with actual or potential customers, to make out their assertion of goodwill in Singapore.
21. On the contrary, the Respondent has a legitimate claim to goodwill in Singapore through the marketing and use of the Facebook page he registered advertising his Latin Dance work and events.

⁷ Para 70 – 75 of the Respondent’s Skeletal Submissions filed on 16 July 2018

⁸ Para 50, RL-4

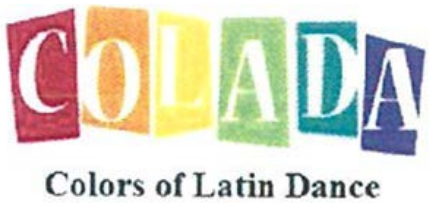
⁹ Para 56, RL-4

¹⁰ Para 53, RL-4

22. As the Applicant fails to establish the necessary goodwill in Singapore, it should not be allowed to invalidate the Respondent's registered mark on the grounds of passing off.

III. Invalidity of Registration on the Ground of Copyright

23. The Applicant avers that the "COLADA" mark is subject to copyright protection and by virtue of this alleged copyright, this Honourable Court should invalidate the Respondent's registration of the said mark.
24. Factually, the Respondent disputes that the Applicant has copyright protection in the "COLADA" mark, including the words "*Colors of Latin Dance*". On the evidence before this Honourable Court, all that is undisputed is that the Applicant commissioned First Step to create the "COLORS" logo, before the copyright in the said logo was transferred to the Applicant in the relevant Deed of Assignment.
25. All this proves is that the Applicant has copyright in the "COLORS" logo. This does not in any way prove the alleged copyright protection in the "COLADA" mark, coupled with the words "*Colors of Latin Dance*". To illustrate this point, the copyright "COLORS" logo and registered "COLADA" mark are reproduced as follows:

Copyright owned by Applicant according to Deed of Assignment 	Registered “COLADA” mark 
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26. The Applicant has economically stated that at [43] of the Applicant’s Skeletal Submissions that an employee, one Sandy Lim (“**Lim**”), used the “COLORS” logo and adapted it into the current form which is the “COLADA” logo, in tandem with the words “*Colors of Latin Dance.*” However, this is to ignore the entire history between the Applicant and the Respondent.
27. While the Respondent does not claim sole ownership over the “COLADA” logo, his role in the design and development of this logo since June 2016 cannot be ignored.
28. Primarily, the “COLADA” logo and crucially, the four words “*Colors of Latin Dance*” would not have existed without Roland’s input. It was his suggestion in July 2016 that the event “*Colors of Salsa*” be renamed “*Colors of Latin Dance*” that led to the inception of the said logo – given

“COLADA” is an abbreviation of “*Colors of Latin Dance*”¹¹. Further, there was significant discussion between the parties on this pivotal decision to rename the event “*Colors of Latin Dance*.” Without the input and taking of the said decision, the “COLADA” logo would not exist. Without the Respondent’s input and efforts to convince Ralf and Vanessa to change the name, there would be no way that the Applicant, would on its own accord, conceptualise or develop the “COLADA” logo.

29. This was part of the long-term joint project between the Applicant and the Respondent to develop the Latin dance scene, which relied heavily on the utilisation of the Respondent’s network and experience.
30. It is now disingenuous for the Applicant to assert that Lim, as an employee of the Applicant, had just conveniently created the logo “COLADA” with Adobe Photosop solely on her own effort or the Applicant’s effort¹². This completely ignores the vital conceptual inputs of the Respondent.
31. At its highest, factually, the Applicant can only show it has copyright in the “COLORS” logo, and not the “COLADA” logo.

¹¹ Para 30 – 35, RA-1

¹² Para 25 of the 1st Affidavit of Lim Mei Ling filed on 17 May 2018

I. Conclusion

32. In light of the foregoing circumstances, we urge this Honourable Court to reject the Applicant's attempts to invalidate the Respondent's registered "COLADA" mark on the grounds of of passing off and copyright.

Dated this 18th day of July 2018

Respectfully Submitted,



Solicitors for the Respondent

Messrs Peter Low & Choo LLC