

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

**[2022] SGIPOS 3**

Trade Mark No. 40201904595S

**IN THE MATTER OF A TRADE MARK APPLICATION BY  
ALTUNIS - TRADING, GESTÃO E SERVIÇOS, SOCIEDADE  
UNIPESSOAL, LDA**

*... Applicant*

**AND**

**IN THE MATTER OF AN OPPOSITION THERETO BY  
HOTEL CIPRIANI S.P.A.**

*... Opponent*

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**FOUNDATIONS OF DECISION**

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**Hotel Cipriani S.P.A.**  
v  
**Altunis - Trading, Gestão E Serviços, Sociedade Unipessoal,  
LDA**

**[2022] SGIPOS 3**

Trade Mark No. 40201904595S  
Principal Assistant Registrar Ong Sheng Li, Gabriel  
16 December 2021

11 March 2022

**Principal Assistant Registrar Ong Sheng Li, Gabriel:**

**Introduction**

1 Belmont Hotel Cipriani is a high-end hotel located in Venice, Italy. It is owned and operated by Hotel Cipriani S.P.A. (“Opponent”), the Italian company that commenced this trade mark opposition. Prior to the addition of the “Belmond” moniker in 2014 (after the Orient Express Hotels group of companies that the Opponent was a part of was renamed the Belmond Group), it was—and to many, continues to be—known as “Hotel Cipriani”. The hotel first opened its doors to the public in 1958. Since that time, Hotel Cipriani has acquired a reputation as a leading luxury destination.

2 On 1 March 2019 (“Relevant Date”), Altunis - Trading, Gestão E Serviços, Sociedade Unipessoal, LDA (“Applicant”), a Portuguese company, applied to register trade mark number 40201904595S in Class 43 (“Application Mark”) in Singapore in respect of “[s]ervices for providing food and drink; temporary accommodation; restaurants; bars; catering (food and drink-); hotels; motels; hotels reservations” (“Application Services”). The Application Mark, which is essentially a composite mark featuring an image of a bartender above the word “CIPRIANI” against a black border, is reproduced below.



3 On 14 October 2019, the Opponent filed this action to oppose the registration of the Application Mark.

### **Grounds of opposition**

4 The Opponent does not have any earlier trade mark registrations in Singapore. It relied on sections 8(7)(a), 8(4)(b)(i), and 7(6) of the Trade Marks Act (Cap. 332, Rev. Ed. 2005) (“Act”). If any one of the grounds of opposition is established, the Application Mark must be refused registration.

### **Statutory declarations**

5 The Opponent’s main evidence was set out in a Statutory Declaration (“SD”) made by Abigail Hunt (“Hunt’s SD”), a solicitor of England and Wales, and an employee of Belmond (UK) Limited who provided legal advice to the Belmond Ltd. sub-group of LVMH Moët Hennessy Louis Vuitton SE, of which both Belmond (UK) Limited and the Opponent are wholly owned subsidiaries. The Applicant’s evidence was set out in a SD made by Natalia Paladino (“Paladino’s SD”), a Legal Representative of the Applicant. The Opponent’s evidence in reply was set out in a SD made by Robert Koren, a director of the Opponent. Since there was no cross-examination, these SDs formed the entirety of the evidence before this tribunal.

## **Facts**

### ***The Opponent***

6 The Opponent traces its roots to the company that was founded to own and operate Hotel Cipriani. It was established in 1956 by, among others, Mr Giuseppe Cipriani Senior (“Mr Cipriani”). In 1976 the entire issued share capital in the Opponent was acquired by a group of companies—later known as the Belmond Group—that owns a number of prestigious hotels around the world. In 2019, the Belmond Group was acquired by LVMH Moët Hennessy Louis Vuitton SE, a world leader in luxury goods and services (including hospitality services) and the parent company of fashion houses such as Christian Dior, Marc Jacobs and Givenchy.

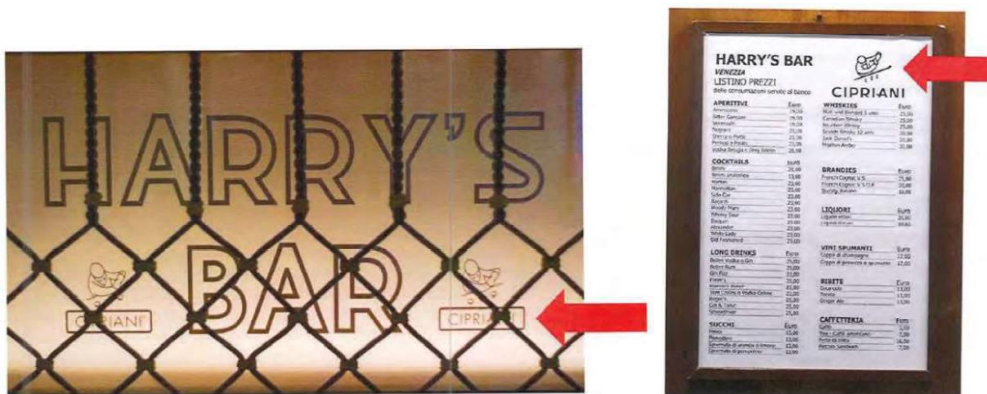
7 Apart from owning and operating Hotel Cipriani, the Opponent also licenses “HOTEL CIPRIANI” and “CIPRIANI” to other members of the Belmond Group to operate restaurants and bars under those names. For instance, there is a “RISTORANTE VILLA CIPRIANI” at Belmond Reid’s Palace hotel in Madeira, a “RISTORANTE HOTEL CIPRIANI” at Belmond Copacabana Palace hotel in Rio de Janeiro (awarded 1 Michelin star in 2019), “CIP’S BY CIPRIANI” at Belmond Cap Juluca, Anguilla, and “DELIZIE BY CIPRIANI” at Belmond Grand Hotel Europe, St. Petersburg, Russia. Hotel Cipriani itself is home to “CIP’s CLUB” (“CIP” being a contraction of “CIPRIANI”), a restaurant with a terrace overlooking the Venice lagoon.

### ***The Applicant***

8 The Applicant is a company within the Cipriani Group of companies, a conglomerate owned by Mr Cipriani’s family. The Applicant’s business operations are run by Arrigo Cipriani and Giuseppe Cipriani (which are

respectively the son and grandson of Mr Cipriani). The Cipriani Group started out in the food and beverage industry and has since expanded its business to the development and operation of luxury apartments, residences, and hotels.

9 The origins of the Cipriani Group can be traced to the famous Harry's Bar in Venice, which opened in 1931 and was declared a national landmark by the Italian Ministry of Cultural Affairs in 2001. Not long after its opening, Harry's Bar became wholly owned and managed by Mr Cipriani. It was there that Mr Cipriani invented the now-classic Bellini cocktail, as well as beef carpaccio. As it can be seen from the images below, the signage at Harry's Bar as well as its menus bear the Cipriani bartender logo. It is essentially this same sign that is sought to be registered under the Application Mark except that "CIPRIANI" appears in white block letters against a black background (instead of black letters against a white background).



### Hotel Cipriani

10 Hotel Cipriani is an exclusive destination with just 95 rooms and suites. The rates of the suites at the hotel can cost upwards of €9,350 a night. On average, the hotel room rates may range between €1,000 to €2,500 a night. The hotel has received many international awards, including World Travel Awards

for “Europe’s Leading Hotel” in 2000 and 2003, “Italy’s Leading Hotel” in 2006, 2013 and 2014, “Europe’s Leading Luxury Hotel” in 2014, and “Europe’s Leading Hotel Suite” in 2014. It was also highly ranked and positively reviewed by various other publications such as International Traveller, Travel+ Leisure magazine, Condé Nast Traveller, The Telegraph, and Huffington Post.

11 Throughout its history, Hotel Cipriani has attracted rich and famous guests, some of whom are regulars. Its celebrity guest list includes but is not limited to famous individuals such as George Clooney, Tom Hanks, Steven Spielberg, Charlize Theron, Jim Carrey, Giorgio Armani and Pierre Cardin. In 2006, Hotel Cipriani was featured in the James Bond film “Casino Royale”, starring Daniel Craig. In 2014, Hotel Cipriani hosted part of the wedding celebrations of George Clooney and Amal Alamuddin. The wedding, as well as the hotel itself, was widely covered in the media.

***Background to the dispute***

12 Mr Cipriani was responsible for establishing and developing Hotel Cipriani. At the time when the hotel opened (in 1958), he owned approximately 40% of the shares of the Opponent. However, his proportion of shareholding in the Opponent changed over time. Importantly, on 21 March 1967, Mr Cipriani sold all of his shares in the Opponent by way of a written agreement (the “1967 Agreement”) to Stondon, Ondale and Patmore Company Ltd (“SOP”), a Canadian company. It is undisputed that thereafter the Cipriani family, as well as the Cipriani Group entities associated with them, had no further shareholding or management connection with the Opponent.

13 There is a long-running dispute between the Opponent and the Applicant (and more broadly, the Cipriani Group) as to the proper interpretation and effect of certain clauses in the 1967 Agreement (which was drafted in Italian and is

governed by the laws of Italy) relating to the use of the Cipriani name. I will touch on the details later, but for now it suffices to say that both sides took the position that the 1967 Agreement conferred upon them the exclusive right to use (and arguably also register) the trade mark “CIPRIANI”. The parties’ divergent positions on the 1967 Agreement and subsequent actions spawned a number of trade mark infringement lawsuits and trade mark registration disputes across many jurisdictions. Some of them resulted in court decisions or tribunal rulings in favour of one side or the other.

***Applicant’s other “CIPRIANI” marks in Singapore***

14 The Applicant has various trade mark applications and registrations for the “CIPRIANI” word mark and the Cipriani bartender logo in Singapore. I do not propose to discuss all of them. For the purposes of setting out the relevant background, it is sufficient to focus on the filings in 2011—which was when the Applicant started seeking trade mark registrations in Singapore.

15 Here is a list of the marks filed by the Applicant in 2011:

- (a) “CIPRIANI” word marks:
  - (i) T1102722H (registered and subsisting) in Class 35 for “*Business management of hotels*”,
  - (ii) T1102448B (registered and subsisting) in Class 36 for “*Leasing and rental of apartments, homes and condominiums*” as well as various real estate services,
  - (iii) T1111568B (revoked but formerly registered) in Class 43 for, among other things, “*Hotel services*”,

- (iv) T1102503I (revoked but formerly registered) in Class 43 for, among other things, “*Restaurant, bar and cocktail lounge services*”,
- (b) Cipriani bartender logo (with “CIPRIANI” in black letters against a white background):
  - (i) T1102505E (registered and subsisting) in Class 36 for “*Leasing and rental of apartments, homes and condominiums*” as well as various real estate services,
  - (ii) T1111569J (revoked but formerly registered) in Class 43 for, among other things, “*Hotel services*”,
  - (iii) T1102450D (revoked but formerly registered) in Class 43 for, among other things, “*Restaurant, bar and cocktail lounge services*”.

16 Based on public records, in August 2021, the Opponent applied for the revocation of trade mark nos. T1111568B, T1102503I, T1111569J and T1102450D. In each instance, the action was recorded on the register as having been successful following a “*Non response from Proprietor*”.

### **Parties’ cases**

17 I now outline the salient aspects of the parties’ positions in relation to the three pleaded grounds of opposition.

18 It is convenient to deal with the first two grounds of opposition together. In brief, s 8(7)(a) of the Act relates to the tort of passing off whilst s 8(4)(b)(i) of the Act protects earlier well known trade marks in Singapore. The common thread running between these two grounds is that they do not require the



Opponent to have a prior trade mark registration. Through them, the Opponent was seeking to protect its unregistered rights in connection with the marks “HOTEL CIPRIANI” and “CIPRIANI”,<sup>1</sup> which it had used in connection with hotel services as well as restaurant and bar services which were advertised and sold to customers all around the world (including Singapore). The Opponent’s central objection was that the Application Mark contains “CIPRIANI” and was sought to be registered in Class 43 for the Application Services (which clearly overlapped with its fields of business).

19 Although the Applicant acknowledged that the marks coincided in the name “CIPRIANI”, it denied that the elements of the grounds of opposition under ss 8(7)(a) and 8(4)(b)(i) of the Act had been made out. Among other things, it pointed out that the Opponent did not have a hotel in Singapore. It also argued that the Opponent was unable to show that it had any business in Singapore. For these and other reasons, the Applicant contended that the Opponent did not have goodwill in Singapore to sustain an action in passing off under s 8(7)(a) of the Act. As for s 8(4)(b)(i) of the Act, the Opponent submitted that “HOTEL CIPRIANI” and “CIPRIANI” were not well known trade marks in Singapore and so the threshold requirement to trigger the provision could not be met. The Applicant also responded to the Opponent’s objection to the “CIPRIANI” element in the Application Mark by arguing that the marks were dissimilar because of the presence of the bartender device.

20 I turn next to s 7(6) of the Act, which prohibits the registration of trade marks in bad faith. Here, the Opponent’s case was that the Applicant was aware of the Opponent’s exclusive proprietary rights in “CIPRIANI” because of the

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1 In its pleadings, the Opponent also relied on a third trade mark: “IL CIPRIANI”, which translates to “THE CIPRIANI”. However, “IL CIPRIANI” did not materially feature in the Opponent’s evidence.

1967 Agreement. Further or alternatively, it claimed that the Applicant was aware that the Opponent had made prior use of “HOTEL CIPRIANI” and “CIPRIANI” in Singapore whereas the Applicant had not used “CIPRIANI” in Singapore and had no existing trade in Singapore.

21 Naturally, the Applicant denied that the Application Mark was filed in bad faith. It contended that the mark was applied for as part of a legitimate attempt to expand its business under the “CIPRIANI” mark to Singapore. Additionally, the Applicant pointed to the fact that it had earlier successfully registered “CIPRIANI” as well as the Cipriani bartender logo in Singapore. As regards the 1967 Agreement, the Applicant’s position was that it allowed the Cipriani family to use “CIPRIANI” for their businesses. According to the Applicant, this interpretation was supported by a number of legal decisions from different jurisdictions ruling in its favour.

### **Late amendment to Notice of Opposition**

22 The full hearing of this dispute was originally fixed for 30 November 2021 (with a corresponding deadline of 30 October 2021 for parties to file their written submissions and bundles of authorities).

23 However, on 29 October 2021, Opponent’s counsel wrote in to seek leave to amend the Notice of Opposition, together with: (a) a request for an extension of time for parties to file their written submissions and bundles of authorities; and (b) a request for the hearing to be refixed to a later date if deemed necessary by the Registrar. The letter also informed the Registrar that the Applicant had given consent to all of the foregoing requests, whilst reserving the right to reply to the amended Notice of Opposition.

24 Since the Applicant had no objections, the Opponent's requests were allowed by the Registrar. Thereafter, and in accordance with the stipulated timelines, the parties filed their amended pleadings. These were followed by the parties' written submissions and bundles of authorities which took into account the new matters raised by the amendments.

25 As it turned out, the Opponent's amendments and the arguments which flowed therefrom were meant to plead and flesh out a case of issue estoppel (or more specifically: transnational issue estoppel, since the judgment relied on was a foreign judgment) in the context of the bad faith ground of opposition. The Opponent's starting point was that the interpretation of the 1967 Agreement had been settled in its favour by the English High Court in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Ltd and others* [2008] EWHC 3032 (Ch) ("*Hotel Cipriani UKHC*"), and the point was undisturbed on appeal (see *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Ltd and others* [2010] EWCA Civ 110) ("*Hotel Cipriani UKCA*"). From that premise, the Opponent submitted that transnational issue estoppel prevented the Applicant from arguing an interpretation of the 1967 Agreement that was inconsistent with the decision and/or denying knowledge of the Opponent's rights in relation to "CIPRIANI".

26 Given the complex nature of the transnational issue estoppel argument, a fair amount of time was spent dealing with it during the hearing. At the end of the hearing, I invited counsel to address me on how the costs arising from the late amendment to the pleadings should be dealt with. Both sides were content to leave the issue of costs to this tribunal's discretion.

### **Section 8(7)(a): Passing Off**

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;

28 To succeed under s 8(7)(a) of the Act, the Opponent must establish a notional case of passing off: see *Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]. The classic elements of the tort of passing off are trite. They are: (a) goodwill; (b) misrepresentation; and (c) damage. The key principles in relation to each element have been discussed in various decisions of the Court of Appeal, including the following: *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 (“*Amanresorts*”), *The Singapore Professional Golfers’ Association v Chen Eng Waye and others* [2013] 2 SLR 495 (“*SPGA*”), *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 (“*Singsung*”), and *Tuitiongenius Pte Ltd v Toh Yew Keat and another* [2021] 1 SLR 231 (“*Tuitiongenius*”).

### ***Goodwill***

29 Goodwill has famously been described as the attractive force that brings in custom. The legal property that the law of passing off protects, goodwill essentially describes the state of the trader’s relationship with his or her customers. In a passing off action, goodwill is not concerned specifically with the get-up (meaning the mark, brand or logo) used by a trader. Rather, it is concerned with the trader’s business as a whole. (See *Tuitiongenius* at [81]; *Singsung* at [32]-[34].) In practice, goodwill may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear (*Singsung* at [34]).

30 The Opponent tendered documentary evidence to substantiate its claim that it had made sales to customers in Singapore and had expended money, time and effort in advertising the hotel to customers worldwide (including Singapore). In response, the Applicant argued that: (a) the Opponent did not have a hotel in Singapore and did not conduct any pre-trading activities or business here; and (b) there was no evidence that the Opponent had any intention to enter the Singapore market in the future.

31 To my mind, the fact that the Opponent does not have a hotel in Singapore was insufficient to dispose of the issue in the Applicant’s favour. It is instructive to refer to the situation in *Amanresorts*, a case which bears similarities to this one. There, the respondents were the operators of ultra-luxury resorts under “AMAN-” names, including “AMANUSA” in Bali, Indonesia. They commenced an action to, among other things, restrain the appellant—a real estate developer—from naming one of its residential projects “AMANUSA”. However, there was no “AMAN-” resort in Singapore. All of them were located overseas in exotic or relatively inaccessible locations not often frequented by mainstream tourists from Singapore. Its advertising was highly selective and targeted high-income individuals. Nevertheless, the respondents did have an international corporate office and international reservations office in Singapore and there was evidence that a small number of Singaporeans had visited Amanusa Bali. The Court of Appeal ultimately held that the respondents enjoyed goodwill in Singapore among their actual and potential customers as well as those who were in the category of once-in-a-lifetime guests and aspirants. In arriving at its decision, the Court of Appeal considered it unnecessary to deal with the so-called “foreign business problem” (which concerns the circumstances under which foreign businesses can bring a claim for passing off) because it would not be strictly correct to think of the

business as a foreign one since it had two offices (including its headquarters) in Singapore and an actual customer base here (see *Amanresorts* at [67]-[68]).

32 Returning to the present case, I am satisfied that the Opponent did in fact enjoy goodwill in this jurisdiction at the Relevant Date. I also take the view that the Opponent, much like the respondents in *Amanresorts*, cannot be strictly treated as a foreign business and can therefore bring rely on the tort of passing off to oppose the Application Mark under s 8(7)(a) of the Act. Below, I outline the salient aspects of the evidence that led me to these conclusions.

33 First, it was clear that the Opponent had *actual customers* in this jurisdiction which had paid for, travelled to, and stayed at Hotel Cipriani on various dates between 2014 to 2019. In 2014 alone, the number of nights stayed by guests from Singapore was a total of 34, corresponding to a revenue of over €86,000. And from January 2015 to June 2019, a total of 228 nights at Hotel Cipriani were booked by customers from this jurisdiction, valued at approximately €355,367 in revenue. These were corroborated by extracts from the Opponent’s reservations system as well as copies of emails relating to hotel reservations made by customers from Singapore.<sup>2</sup>

34 Second, there were a variety of ways through which individuals in Singapore could (and in some cases did) make a booking at Hotel Cipriani, including the following: (a) the reservation office in Singapore (which handled bookings for the Belmond Group—including the Opponent); (b) the Hotel Cipriani segment of the Belmond Group website (here, the Opponent’s evidence was that nine booking transactions had been made for stays at Hotel Cipriani by users from Singapore between March 2014 and March 2019 valued at a total of

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<sup>2</sup> Hunt’s SD at [25] and corresponding Exhibit 13

€34,022.20)<sup>3</sup>; (c) credit card concierge services e.g. the American Express Centurion Travel Service as well as the American Express Fine Hotels & Resorts Programme (here, the Opponent submitted extracts from their reservations system showing bookings made by American Express on behalf of cardholders in Singapore)<sup>4</sup>; (d) travel agencies (e.g. Scott Dunn Singapore Pte. Ltd. and Lightfoot Travel Pte. Ltd.)<sup>5</sup>; and (e) travel booking websites (e.g. [www.tripadvisor.com.sg](http://www.tripadvisor.com.sg), [www.expedia.com.sg](http://www.expedia.com.sg), and [www.booking.com](http://www.booking.com)).

35 Third, the Opponent has promoted Hotel Cipriani in Singapore at least as early as 2012. In 2012, Heavens Portfolio Pte Ltd was appointed as a sales and marketing representative in the region (including Singapore). This partnership continued even after the Belmond rebranding in 2014. Over the years, Heavens Portfolio Pte Ltd worked with: (a) travel agencies such as Lightfoot Travel Pte. Ltd., “Eurotours-sg” and “Aurelius Circle” (note: the full names of the latter two companies did not appear to have been provided); and (b) American Express (through its abovementioned cardholder programmes) to promote Hotel Cipriani to customers in Singapore.<sup>6</sup> Hotel Cipriani was also profiled and advertised to the public in Singapore through various other means, including over the internet and traditional media. In any event, what is important is that these promotional activities did ultimately result—evidenced by, among other things, American Express cardholders which made bookings through the concierge service—into actual sales for Hotel Cipriani.

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<sup>3</sup> Hunt’s SD at [23] and corresponding Exhibit 12

<sup>4</sup> Hunt’s SD at Exhibit 13, pp 176 to 187, 194 to 195

<sup>5</sup> Hunt’s SD at [27] and corresponding Exhibit 15

<sup>6</sup> Hunt’s SD at Exhibit 15, pp 222 to 265

36 Finally, it bears mention that the hotel is not situated on the main island in Venice, Italy. Instead, it is situated on Giudecca Island, which requires transportation by ferry. This suggests that those who make reservations at Hotel Cipriani treat it as a luxury destination in and of itself, rather than just one of many up-market hotels to stay at near Venice’s main tourist attractions. To be fair, there might be some who choose to stay at the property because it is a “Belmond” hotel. But the evidence also supports the overall conclusion that a significant number of guests would choose the destination because it is *the* Hotel Cipriani (sometimes referred to by the media as well as private individuals as “Belmond Cipriani” or “The Cipriani”). All of these considerations point towards a finding that “HOTEL CIPRIANI” and “CIPRIANI” have goodwill: the requisite attractive force which brings in custom.

### ***Misrepresentation***

#### *Distinctiveness*

37 Distinctiveness is a threshold inquiry in the context of determining whether an actionable misrepresentation has taken place. If a mark or get-up is not distinctive of the plaintiff’s (here: Opponent) products or services, the mere fact that the defendant (here: Applicant) has used something similar or even identical in marketing and selling its products and services would not amount to a misrepresentation that the latter’s products or services are the former’s or that the two are economically linked (see *Singsung* at [38]).

38 The Opponent’s case on distinctiveness was that “HOTEL CIPRIANI” and “CIPRIANI” are inherently distinctive and in any event had acquired distinctiveness through use and advertising. The Applicant did not argue against the claim that “CIPRIANI” is inherently distinctive (which makes sense since that it had other registrations for “CIPRIANI” and the Cipriani bartender logo).



39 In my judgment, the marks “HOTEL CIPRIANI” and “CIPRIANI” were, at the Relevant Date, distinctive of the Opponent’s hotel services. Even though “CIPRIANI” may be an Italian name, it is not one that would be familiar to the public in Singapore. It does not have any dictionary meaning in the English language, nor describe the services in question in any way. Consequently, it would be regarded by the public as inherently distinctive. Furthermore, Hotel Cipriani had actual customers from Singapore and there was evidence that the public in this jurisdiction would have been exposed to the marks “HOTEL CIPRIANI” and “CIPRIANI” either directly through targeted advertising (e.g. by American Express or tour agencies) or indirectly (e.g. in movies, magazines, or other media).

40 In contrast, despite claims in Paladino’s SD that the Application Mark had been used in Singapore either directly or with the Applicant’s consent as early as 2017 in relation to products bearing the Application Mark;<sup>7</sup> and that the Application Mark (which is featured in signages, menus, and other insignia at the restaurants operated by the Cipriani family around the world) had been made well known to Singaporeans through the Applicant’s worldwide operations and other advertising efforts,<sup>8</sup> no documents were adduced to substantiate these assertions. Consequently, there was no evidence that the relevant public in Singapore would associate the distinctive “CIPRIANI” sign with the Applicant or the Cipriani Group. (Hypothetically speaking, if there had been evidence of use and advertising under the Application Mark or “CIPRIANI” in relation to Singapore, depending on its nature and quality, the Applicant may have been able to attempt the argument that the parties concurrently owned the goodwill

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<sup>7</sup> Paladino’s SD at [45]

<sup>8</sup> Paladino’s SD at [49]

in the name “CIPRIANI” in Singapore and so neither side could raise a case of passing off on that basis against the other.<sup>9</sup>)

*Misrepresentation as to origin or trade connection*

41 A common form of misrepresentation (and indeed the very form relied on in this case) is where a defendant (here: Applicant), by its choice of mark or name, misrepresents to the relevant segment of the public that its goods or services are those of, or are related to or associated with, the claimant (here: Opponent): see *SPGA* at [25]. To be actionable under the law of passing off, the misrepresentation must give rise to confusion (or the likelihood thereof) (see *Singsung* at [40]). In the assessment for actionable misrepresentation, some (non-exhaustive) factors which a court or tribunal may consider include: (a) the strength of the public’s association with the claimant’s sign; (b) the similarity of the claimant’s and the defendant’s respective signs; (c) the proximity of the parties’ respective fields of business; (d) the characteristics of the market; and (e) the defendant’s intention. (See *SPGA* at [54].)

42 Apart from the bartender logo, the Application Mark contains a sole word: “CIPRIANI”. It was sought to be registered for “[s]ervices for providing food and drink; temporary accommodation; restaurants; bars; catering (food and drink-); hotels; motels; hotels reservations” in Class 43. The question is whether, in the circumstances, the relevant public would likely be confused into thinking that the Application Services offered under the Application Mark originate from or are otherwise commercially connected with the Opponent.

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<sup>9</sup> In *Hotel Cipriani UKHC*, the defendants (which were from the Cipriani Group) argued that they enjoyed concurrent goodwill with the Opponent in the UK in relation to “CIPRIANI” in respect of hotels and restaurants. However, having regard to the evidence in those proceedings, the argument was rejected both at first instance as well as on appeal: see *Hotel Cipriani UKCA* at [50]-[51].

43 In arguing that misrepresentation had been established, the Opponent submitted (among other things) that “HOTEL CIPRIANI” and “CIPRIANI” were distinctive of its services, and that the competing marks are visually similar to a high degree, aurally identical (in the case of the Opponent’s “CIPRIANI” mark), and conceptually identical. It also emphasised that the Application Services overlap with and are identical to the Opponent’s services relating to hotels, catering, restaurants, bars, and clubs.

44 While the Applicant had to concede that the parties’ marks coincided in the “CIPRIANI” element, it sought to distinguish the Application Mark based on the presence of the bartender device (and the absence of the word hotel). The Applicant emphasised that bar/pub and restaurant services were not ancillary to hotel services and were instead of a different nature. In addition, the Applicant also argued that there was no misrepresentation made to the Opponent’s customers in Singapore: a small segment of the public who could afford to pay high prices for hotel accommodation overseas and would not be easily deceived or hoodwinked as to trade source.

45 In my assessment, allowing the Application Mark to be registered would likely lead to misrepresentation as to origin or trade connection for the following reasons. First, as I have found earlier, “HOTEL CIPRIANI” and “CIPRIANI” were distinctive of the Opponent’s hotel services. Consequently, the public (which would include the Opponent’s actual and potential customers) would associate “HOTEL CIPRIANI” and “CIPRIANI” with the Opponent. Second, I find that the marks are highly similar on account of the identical distinctive “CIPRIANI” component. The word “HOTEL” is plainly descriptive of hotel services. Moreover, while the bartender device in the Application Mark makes a strong visual impression, it would not—without use in this jurisdiction (of which there was no evidence)—be regarded as distinctive in relation to the

Application Services. Therefore, these elements do not serve to meaningfully distinguish the marks from each other. The dominant distinctive element in the marks is “CIPRIANI”, and there is a strong similarity between them having regard to the common “CIPRIANI” element. Third, the Application Services (which are: “[s]ervices for providing food and drink; temporary accommodation; restaurants; bars; catering (food and drink-); hotels; motels; hotels reservations”) are identical or at least highly similar to the Opponent’s services. Apart from operating Hotel Cipriani (also home to “CIP’s CLUB”), the Opponent was also in the business of licensing “HOTEL CIPRIANI” and “CIPRIANI” to other members of the Belmond Group to operate restaurants and bars under those names. Quite clearly, hotel services are by nature closely intertwined with food and beverage services.

46 Before moving on, I should address the Applicant’s arguments as to the characteristics of the relevant public. It is true that Hotel Cipriani caters to the well-heeled who can afford its high prices, and many of these high-spending individuals are likely to be discerning. However, the sting of the misrepresentation lies in the common “CIPRIANI” element and the bartender logo in the Application Mark would not be enough to differentiate the competing marks. No matter how discerning the relevant public may be, they would likely still be confused on account of the common word “CIPRIANI”. Furthermore, it is apposite to bear in mind that the relevant sector of the public is not limited to the Opponent’s actual customers but includes also potential customers as well (see *Amanresorts* at [73]). These potential customers may be once-in-a-lifetime guests or those who aspire to stay at Hotel Cipriani once their financial situation improves. These potential customers would also be deceived by the misrepresentation inherent in the “CIPRIANI” element.

***Damage***

47 The third and final element of the tort is damage, or the likelihood thereof, to the claimant’s goodwill. Here, the Opponent argued that damage to its goodwill would result through: (a) diversion of custom leading to loss of sales, which is typical in cases where the parties are in the same fields of business (see *Singsung* at [87]); and (b) blurring. The latter involves a situation when the claimant’s get-up, instead of being indicative of only the plaintiff’s goods and services also becomes indicative of the defendant’s goods and services. Blurring occurs when the business, goods or services of the parties are in competition with or are at least substitutes for each other. The damage in the case of blurring manifests itself in sales being diverted from the claimant to the defendant. (See *Amanresorts* at [97].)

48 To my mind, there is little practical difference between the two “heads” (or types) of damage relied on by the Opponent. By this, I mean that the Opponent’s central objection under both categories of damage was that the use of the Application Mark would likely lead to diversion of business and hence loss of sales. I agree that damage in the form of diverted sales is likely given the nature of the misrepresentation. After all, the Opponent’s business activities conducted under the “HOTEL CIPRIANI” and “CIPRIANI” marks fall squarely within, or are highly similar to, the Application Services.

49 For the reasons above, I find that the Opponent has established a notional case in passing off under s 8(7)(a) of the Act. Consequently, I would refuse registration of the Application Mark.

**Section 8(4)(b)(i): Well Known Trade Marks**

50 Put simply, s 8(4)(b)(i) of the Act prohibits the registration of trade marks which conflict with an earlier well known trade mark provided certain conditions are met. In order to succeed under this ground of opposition, the Opponent must establish the following elements: (a) “HOTEL CIPRIANI” and/or “CIPRIANI” were well known in Singapore at the Relevant Date; (b) the whole or an essential part of the Application Mark is either identical with or similar to “HOTEL CIPRIANI” and/or “CIPRIANI”; (c) the use of the Application Mark in relation to the Application Services would indicate a connection between those services and the Opponent; and (d) the connection is likely to damage the Opponent’s interests.

51 In general, the analysis in respect of the second, third and fourth elements outlined above follows similar contours as the analysis in the context of s 8(7)(a) of the Act. For the most part, the tests relating to misrepresentation and damage are substantively the same as the tests relating to the connection requirement and the likelihood of damage requirement. (See *Amanresorts* at [234], which applies by logical extension to trade mark opposition cases under s 8(4)(b)(i) of the Act.) Thus, my findings and conclusions above would likewise apply here as well.

52 So then, the only remaining question that needs to be answered under s 8(4)(b)(i) of the Act is whether “HOTEL CIPRIANI” and/or “CIPRIANI” were well known to the public in Singapore as at the Relevant Date. Sections 2(7) to 2(9) of the Act are the starting point in the assessment for whether a mark is “well known in Singapore”. They provide as follows:

(7) 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:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of —

(i) any use of the trade mark; or

(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;

(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;

(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;

(e) any value associated with the trade mark.

(8) 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.

(9) 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.”

53 In *Amanresorts*, the Court of Appeal expressed the view (at [139]) that because of the (deeming) provision in s 2(8) of the Act, “*it can be persuasively said that s 2(7)(a) is arguably the most crucial factor when determining whether*

*a trade mark is well known in Singapore*". On the facts of that case (which I have outlined briefly at [31] above), the Court of Appeal concluded that the "AMAN" names were well known in Singapore.

54 In *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 ("*Caesarstone*"), the Court of Appeal referred to its earlier decision in *Amanresorts* and emphasised that while the relevant sector of the public need not be large in size, this should not be read as standing for the more general proposition that the threshold for a trade mark to be regarded as well known is a low one. The relevant paragraphs are reproduced below.

"Not too difficult"

101 Although we said in *Amanresorts* that it is "not too difficult" for a trade mark to be regarded as well known in Singapore (see [100] above), the Judge thought that this comment should not be taken to mean that the hurdle that trade mark owners had to cross was minimal. Rather, the comment had to be applied with judicious caution to the actual facts and circumstances of each case.

102 We do not think that this comment in *Amanresorts* was made to lay down a general principle. In this regard, we agree with the Respondent's submission that 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.

On the facts of *Caesarstone*, the Court of Appeal found that while the appellant had a tangible business in Singapore (as demonstrated by, among other things, its sales figures which ranged from around S\$3.4 million in 2002 to just above S\$200,000 in 2006), the evidence as a whole did not go so far as to show that the appellant's stylised "CAESAR" mark (registered and used for tiles and related building materials) was well known in Singapore.



55 Returning to the present case, I agree with the Opponent that the relevant sector of the public in Singapore would be high-income (or high-spending) individuals who have stayed at Hotel Cipriani or who would have been exposed to the Opponent’s advertising, as well as once-in-a-lifetime guests and aspirants. In addition, it would also be relevant to consider the persons and businesses involved in the sales and distribution of the Opponent’s services (here: third parties such as American Express, travel agencies, and so on).

56 I have made the requisite findings as to recognition, use and promotion of the Opponent’s “HOTEL CIPRIANI” and “CIPRIANI” marks above, and would for those same reasons find that the marks were well known to the public in Singapore. While the revenue figures in this case may not have been spectacular when viewed in isolation, just like in *Amanresorts* (where arguably the evidence relating to sales revenue was weaker than in this case given that there was no evidence as to the proportion of the sales generated by actual customers in Singapore), there was sufficient evidence relating to advertising and exposure of the brand to potential customers. In any case, it is not meaningful to compare the revenue generated by an exclusive travel destination with just 95 rooms and suites as against mass market goods or services (or, for that matter, tiles and building materials such as in *Caesarstone*).

**Section 7(6): Bad faith**

57 Section 7(6) of the Act provides that a trade mark “*shall not be registered if or to the extent that the application was made in bad faith*”.

58 The essential legal principles underlying this area were not in dispute. In summary, 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 Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”) at [28].) The test for determining bad faith is a “combined” one, in that it contains both a subjective element (*viz.*, what the particular applicant knows) and an objective element (*viz.*, what ordinary persons adopting proper standards would think). 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. An allegation of bad faith is a serious claim to make, and it must be sufficiently supported by the evidence. It needs to be distinctly proved and this will rarely be possible by a process of inference. (*Valentino* at [29]-[30].)

59 By the time of the hearing, the Opponent’s case on bad faith had been sharpened along two angles of attack. The first line of argument involved the 1967 Agreement. In the Opponent’s submission, the agreement gave it the exclusive right to use and register “CIPRIANI” as a trade mark and by applying to register the Application Mark in Singapore, the Applicant had breached the 1967 Agreement either in letter or in spirit. It was also contended that Applicant was estopped from relying on any other interpretation of the 1967 that was inconsistent with the ruling in *Hotel Cipriani UKHC*. The second line of argument was premised on the Applicant’s alleged knowledge of the Opponent’s prior use of “HOTEL CIPRIANI” / “CIPRIANI” in Singapore. According to the Opponent, by applying for the Application Mark, the Applicant had deliberately taken unfair advantage of and was attempting to ride on the Opponent’s reputation and goodwill in its business in Singapore.

60 As outlined in the introduction to the parties’ cases, the Applicant’s overarching argument was that the Application Mark had been applied for as part of a legitimate attempt to expand its business under the “CIPRIANI” mark

to Singapore. Its case on the 1967 Agreement was the Cipriani family (and hence the Cipriani Group entities associated with them) had the right to use “CIPRIANI” for their businesses. In this regard, it pointed out that there were jurisdictions which had issued decisions ruling in favour of the Applicant’s interpretation. In responding to the transnational estoppel argument, the Applicant’s position was that the requirements of establishing issue estoppel based on a foreign English judgment had not been met and in any event the transnational issue estoppel argument could not be sustained in the face of conflicting rulings from foreign jurisdictions. The Applicant also pointed out that it had earlier registered various “CIPRIANI” trade marks (including the Cipriani bartender logo in Singapore).

### ***The 1967 Agreement***

61 The long-running dispute relating to the 1967 Agreement centred around Clauses 3.1 and 3.2 of the agreement (originally drafted in Italian and governed by Italian law). In *Hotel Cipriani UKHC*, the agreed English translation of those clauses—which was also relied on in this case—was as follows. (By way of background: “the Company” refers to the Opponent; “You” refers to Mr Cipriani; “We” refers to SOP, the company which purchased all of Mr Cipriani’s shares in the Opponent; “Hotel Villa Cipriani” has no direct relevance to these proceedings; and “Locanda Cipriani”, which is owned by the Cipriani Group, also has no direct relevance to this dispute.)

3.1 You agree that the Company may retain its current name and that the Hotel Villa Cipriani di Asolo may retain its current logo and, in general, that the Company and the Hotel Villa Cipriani will have the right to use the name 'Cipriani' on an exclusive basis, even after any participation by you or your family in the capital of the Company has come to an end, and even in the event that you or your son cease to be on the Company's board of management. You also agree to refrain, and to see to it that every member of your family refrains, for a period of five years from today, from starting new businesses

with the name 'Cipriani', or new businesses that are apt to divert customers from the Company or Hotel Villa Cipriani, except with our consent. It is, however, understood that you and your successors in interest may continue to use the name 'Cipriani' for the Locanda Cipriani in Torcello.

3.2 We agree to refrain, for a period of five years from today, [from] starting new businesses with the name 'Cipriani', except with your consent.

62 After hearing expert evidence as to Italian law and the parties' submissions, the English High Court in *Hotel Cipriani UKHC* held as follows. (By way of background: the "Claimants" were the Opponent and related entities in the Orient Express Hotels Group, which later became the Belmond Group; the "Defendants" were members of or affiliated to the Cipriani Group; and Giuseppe Senior referred to Mr Cipriani.)

[98] Turning to clause 3.1 of the 1967 Agreement, this can [be] broken down into three parts:

i) Giuseppe Senior agrees that the Company may retain its current name (*denominazione*) and that Hotel Villa Cipriani can retain its current sign (*insegna*), and in general that the Company and Hotel Villa Cipriani will have the right to use the name (*nome*) Cipriani on an exclusive basis (*in via esclusiva*), even after Giuseppe and his family cease to own any shares in, or be represented on the board of, the Company.

ii) Giuseppe Senior agrees to refrain (and to see that his family refrains) for 5 years from starting (a) any new business with the name Cipriani and (b) any new business (i.e. with any name) that is apt to divert customers from the Company or Hotel Villa Cipriani, except with SOP's consent.

iii) SOP agrees that Giuseppe Senior and his successors may continue to use the name (*nome*) Cipriani for the Locanda Cipriani.

[99] It is not clear to me that clause 3.1 was drafted by someone with a detailed knowledge of Italian trade mark law, since it contains no reference to trade names (*ditta*) or trade marks (*marchi*), although the draftsman may well have had some knowledge of the subject. Nevertheless, it was common ground between the experts that it is appropriate to interpret clause 3.1 against the background of Italian trade mark law as it then stood. It was also common ground between the experts that the second part of clause 3.1 reflects Articles 2557 and 2596 of the

Civil Code, in that it is a non-compete provision which lasted for the maximum duration permissible under those Articles. (The same applies to clause 3.2.)

[100] The Defendants contend, in short, that these words merely mean that the Company and Hotel Villa Cipriani have the exclusive right to use the name Cipriani in relation to those hotels (i.e. as part of the names Hotel Cipriani and Hotel Villa Cipriani). The Claimants contend, in short, that they mean that the Company and Hotel Villa Cipriani will have the exclusive right to use the name Cipriani (meaning names including the word Cipriani) in relation to any hotel or restaurant business (subject to the permission to use the name Locanda Cipriani conferred on Giuseppe Senior by the third part of clause 3.1). Although the limitation to any hotel or restaurant business is not explicit, the Claimants say it is implicit.

[101] In my judgment the Claimants' interpretation is to be preferred. The Defendants' interpretation is inconsistent with the fact that it is the name 'Cipriani' which the Company and Hotel Villa Cipriani can use on an exclusive basis, not their respective full names. Furthermore, on the Defendants' interpretation the third part of clause 3.1 would be redundant. There is no inconsistency between this interpretation of the first part of clause 3.1 and the third part, which gives SOP additional protection during the five year period.

[102] Given that subsequent conduct is an admissible aid to interpretation under Article 1362 of the Civil Code, this interpretation is also supported by the fact that Giuseppe Senior and Arrigo acted in a manner consistent with it for over 30 years. They did not set up any hotels or restaurants under the name Cipriani, or a name which included the word Cipriani, in Italy (or elsewhere in Europe) until about 2000 when the Cipriani Porto Cervo was opened.”

(emphasis added)

63 The Opponent argued that the underlined portions above vindicated its interpretation that it had the exclusive right to use “CIPRIANI” in relation to any hotel or restaurant business. The Opponent also pointed out that the English decision on this point was undisturbed on appeal and the same interpretation was also preferred by the General Court of the European Union in T-343-14 *Arrigo Cipriani v European Union Intellectual Property Office (EUIPO)*. From this starting point, it built a case of transnational issue estoppel which essentially

sought to prevent the Applicant from arguing any interpretation of the relevant clauses that conflicted with the decision. In this regard, the Opponent submitted that the English decision was issued in 2008, long before the Relevant Date.

64 Prior to the hearing, I wondered whether Opponent’s reliance on *Hotel Cipriani UKHC*’s interpretation of the 1967 Agreement was misplaced. In that case, Justice Arnold (as he then was) agreed with the claimants’ interpretation on Clause 3.1 insofar as the issue of the right to “use” was concerned. But he did not accept the claimants’ further argument that by virtue of the 1967 Agreement the Opponent had the exclusive right to *register* “CIPRIANI” as a trade mark in respect of hotel and restaurant services (the “right-to-register argument”). The court gave the following three reasons (see [104]-[107]) for rejecting the right-to-register argument.

- (a) It was common ground between the experts that the 1967 Agreement said nothing about trade marks.
- (b) On the evidence, Italian law considered that the legal rights in trade names and signs were rather different from trade marks.
- (c) The subsequent conduct of the parties was inconsistent with the interpretation the claimants were seeking to advance. On the issue of conduct, the court observed that: (i) although the Opponent applied to register CIPRIANI as a trade mark in Italy in 1969, one of the Cipriani Group entities did the same in 1975 and the Opponent did not apply for a declaration that the registration was invalid or complain about it; and (ii) the Opponent did not complain about the increasing use of the word Cipriani as a trade mark by the Cipriani Group from the mid-1980s onward. Although Arnold J noted the possibility (at [108]) that the Opponent might have a possible argument that “*it had the exclusive right*

*to register CIPRIANI as a trade mark by virtue of the 1967 Agreement in combination with the second paragraph of Article 13 [of the Italian trade mark statute (Royal Decree n.929 of 21 June 1942)]”, he preferred not (and so declined) to express a conclusion on the point.*

65 During the hearing, I asked Ms Girvin and Mr Cheong (both of whom made oral submissions on behalf of the Opponent) to explain the Opponent’s reliance on *Hotel Cipriani UKHC* having regard to [104]-[107] of the decision (which did not appear to have been expressly addressed in their written submissions). They clarified that they were indeed making<sup>10</sup> the same right-to-register argument that Arnold J (as he then was) declined to express a conclusion on. However, they also took pains to stress that it was in any event sufficient, for the purposes of bad faith, that the Applicant knew of the Opponent’s right under the 1967 Agreement to use “CIPRIANI” in respect of hotel and restaurant services.

66 I have carefully considered the Opponent’s arguments relating to the 1967 Agreement. As mentioned above, my primary issue with the Opponent’s reliance on *Hotel Cipriani UKHC* was that the court did not find that the 1967 Agreement conferred upon the Opponent the exclusive right to register “CIPRIANI” in respect of hotel and restaurant services. The ruling was limited to the issue of the right to use. Therefore, *Hotel Cipriani UKHC* only assists the Opponent to that limited extent and no further. It does not support the argument that the Opponent had, under the 1967 Agreement, the exclusive right to register “CIPRIANI” as a trade mark for hotel and restaurant services.

67 As regards the Opponent’s invitation to decide on the right-to-register argument, my difficulty was that expert evidence as to Italian law on this specific

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<sup>10</sup> Opponent’s Written Submissions at [174]

point was not formally introduced before this tribunal. That said, the Opponent did include (in Hunt's SD): (a) a copy of an expert report prepared by one Gabriel Cuonzo (on behalf of the Opponent) dated 20 October 2008 in relation to the interpretation of the 1967 Agreement; and (b) a copy of an expert report dated 27 October 2008 prepared by Fabio Angelini, who gave evidence for parties related to the Applicant.<sup>11</sup> It appears that these were the same reports that were tendered in evidence before the English court in *Hotel Cipriani UKHC*. However, the reports did not seem to directly address the precise issue of whether the 1967 Agreement could be read in combination with the second paragraph of Article 13 of the Italian trade mark statute to support the Opponent's right-to-register argument. In the circumstances, it would not be right for me to go where Arnold J (as he then was) declined to tread.

68 I turn to the next hurdle in the way of the Opponent's reliance on the 1967 Agreement in conjunction with the *Hotel Cipriani UKHC* decision. Even if I accept that the English courts' interpretation of Clause 3.1 is the correct one, the problem is that no findings were made by Arnold J (as he then was) concerning the effect of Clause 3.1 outside of Italy or Europe. Indeed, on its face, it is not clear from the supplied translation of the 1967 Agreement that Clause 3.1 was meant to have world-wide effect. Whatever the true situation might be, the point is that the English litigation, strictly speaking, did not decide that Clause 3.1. gave the Opponent the exclusive right to use "CIPRIANI" in relation to any hotel or restaurant business *anywhere around the world*. Therefore, it is not meaningful to rely on *Hotel Cipriani UKHC* in the context of issue estoppel. Even if I am wrong in this regard, there is a further obstacle in the Opponent's way: a contractual right to *use* a sign is separate and distinct from the contractual right to *register* that same sign as a trade mark. It would be wrong to conflate the two.

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<sup>11</sup> Hunt's SD at Exhibit 1



69 For the reasons above, I think that the Opponent’s transnational issue estoppel argument was, with respect, misguided. By this, I am not concluding that there cannot be issue estoppel based on the foreign judgments relied on by the Opponent. I do not need to decide that issue. All I am saying is that given the present facts and circumstances I think the estoppel argument does not lead anywhere of consequence. More specifically, I do not think *Hotel Cipriani UKHC* (and *Hotel Cipriani UKCA*) can be weaponised in conjunction with the 1967 Agreement to compel a finding by this tribunal that there was something dishonest or commercially improper about the Applicant’s act of applying to register the Application Mark in Singapore.

***The prior use argument***

70 The Opponent’s second line of argument was structured as follows. First, although “HOTEL CIPRIANI” and “CIPRIANI” were not registered in Singapore, they have been used in Singapore. Second, given the history between the parties, the Applicant must have known of the Opponent’s use of its marks in Singapore or at least conducted a search. Third, there was no evidence that the Application Mark (or any “CIPRIANI” mark) had been used by the Applicant in Singapore. Fourth, the Applicant has extensive experience in business, and must have sought to extract some sort of commercial advantage from the Opponent through applying for the Application mark.

71 My main difficulty with the Opponent’s arguments here is that they essentially revolved around the central theme of: “I had customers in Singapore first and they should have known about it”. To my mind, this mere fact, without more, is insufficient to show that the Application Mark was applied for in bad faith. The nature of hotel and restaurant/bar services (based abroad) and internet or media advertising is that it would not necessarily be obvious to others—even a

potential competitor seeking to offer its services and perhaps goods here—that the Opponent had made sufficient use of “HOTEL CIPRIANI” and “CIPRIANI” in this jurisdiction.

***Conclusion on bad faith***

72 As mentioned above, the test for determining bad faith is both subjective as well as objective. Having regard to the various issues identified above, I think that both elements cannot be satisfied. The 1967 Agreement, as interpreted by *Hotel Cipriani UKHC*, does not clearly prohibit the Applicant from applying to register the Application Mark in Singapore. Furthermore, in applying to register the Application Mark, the Applicant was merely seeking to protect a sign which it had used in connection with Harry’s Bar and its business elsewhere. The name “CIPRIANI” in the Application Mark is the name of the family connected with the Applicant and the Cipriani Group. The parties have a long-running dispute in various jurisdictions with rulings and decisions going both ways. In such circumstances, I fail to see how ordinary persons in the trade adopting proper standards would regard the Application Mark as having been applied for in circumstances that were dishonest or commercially unacceptable. There is nothing wrong about seeking to expand one’s business into Singapore.

73 Therefore, I find on a balance of probabilities that bad faith has not been clearly established. For the avoidance of doubt, I do not think that anything really turns on the Applicant’s other applications and registrations for “CIPRIANI” in Singapore (some of which have been revoked by the Opponent). I recorded it as part of this decision to flesh out the relevant background, but it did not affect my conclusion one way or the other.

**Overall conclusion**

74 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition succeeds under ss 8(7)(a) as well as 8(4)(b)(i) but fails under s 7(6) of the Act. Consequently, the Application Mark is refused registration.

75 Given the circumstances, I would award the Opponent two-thirds of its costs of the action. However, this does not include the costs of reviewing the late amendment to the Notice of Opposition and making the consequential amendments to the Counter-Statement, which I award to the Applicant.

Ong Sheng Li, Gabriel  
Principal Assistant Registrar

Ms Cecelia Girvin and Mr Edsmond Cheong (Drew & Napier LLC)  
for the Opponent;  
Mr Patrick Chow (UTC Intellectual Property Pte. Ltd.) for the  
Applicant.

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