

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

Trade Mark Nos. 40201402804X and 40201402805W
Hearing Date: 16 July 2019
Further Submissions: 6 August 2019

**IN THE MATTER OF TRADE MARK APPLICATIONS BY
PRESIDENT AND FELLOWS OF HARVARD COLLEGE**

AND

**OPPOSITION THERETO BY
HARVARD CLUB OF SINGAPORE**

Hearing Officer: Ong Sheng Li, Gabriel
Principal Assistant Registrar of Trade Marks

Representation:

Mr Wun Rizwi (RHTLaw Taylor Wessing LLP) for the Opponent

Ms Vithyashree and Mr Jonathan Liang Tian Zhi (Ella Cheong LLC) for the Applicant

GROUND OF DECISION

Introduction

1 This dispute is between Harvard Club of Singapore (the “Opponent”) and President and Fellows of Harvard College (the “Applicant”), the body corporate which constitutes Harvard University. It arises out of the Applicant’s application to register the two trade marks below (collectively the “Application Marks”) and the Opponent’s attempt to stop this from happening.

- a. “HARVARD CLUB OF SINGAPORE” (40201402804X) in Class 41 for “*Club Services [education or entertainment]*”; and
- b. “HARVARD UNIVERSITY CLUB OF SINGAPORE” (40201402805W) in Class 41 for “*Club Services [education or entertainment]*”.

The Parties

2 Harvard University is consistently ranked as the top university, or at least one of the best, in the world. Not surprisingly therefore, it enrolls a significant number of international students (which comprise about a fifth of its total population) from more than 125 countries. More than a hundred students from Singapore are enrolled in Harvard each academic year.

3 Part of Harvard University's attraction lies in the fact that some of the best and brightest pass through its halls. Graduates enjoy access to alumni networks through, among other things, various Harvard Clubs. Indeed, with very limited exceptions, only Harvard graduates may be a member of a Harvard Club. There are over 195 Harvard Clubs located throughout the world. They are supported by the Harvard Alumni Association, or "HAA", an office within the University.

4 The Opponent in this dispute—Harvard Club of Singapore—has served Harvard alumni in Singapore for a long time. It was registered as a society in 1969 and for most of its existence was recognised by the university as the official Harvard Club in Singapore with all the attendant benefits that followed. There are approximately 1800 Harvard graduates currently living in Singapore, making it home to the ninth largest group of its alumni outside of the United States. Out of these, around 500 individuals were, at one time or another, members of the Opponent.

5 However, on 29 May 2015, the HAA terminated its relationship of 45 years with the Opponent and revoked its status as a recognised Harvard alumni club. This milestone event, which formed an essential part of the backdrop to this dispute, took place during Dr Lee Siew Mun Irene's tenure as President of the Opponent.

Background

6 Dr Lee first assumed office as President in November 2011. After taking office, she invested significant time and effort towards improving the administration and infrastructure of the Opponent as well as advancing the interests of Harvard alumni in Singapore. In this regard, Dr Lee worked closely with the HAA.

7 All seemed to go well at first between the HAA and the Opponent under Dr Lee's leadership. However, things changed dramatically later on. Between April 2014 to April 2015, the HAA indicated that it would like to see a change of leadership within the Opponent (which would entail, among other things, Dr Lee stepping down), and took steps towards that end. A brief timeline of events is set out below.

- a. In or around April 2014, HAA informed Dr Lee that the Opponent would benefit from a leadership transition. Nevertheless, Dr Lee stood for presidency in the November 2014 elections and was once again voted in as President.
- b. In or around March 2015, Mr Stephen Jacob, who signed off as Treasurer, wrote to Dr Lee. He petitioned that an Extraordinary General Meeting ("EGM") be called in May and alleged that the Opponent: (i) had not been operating according to its ByLaws; and (ii) was not in compliance with the HAA Club Operating Guidelines and/or the HAA Club Officer Handbook. Shortly afterwards, the Opponent received a request for Dr Lee to step down as President on grounds that HAA Club

Operating Guidelines provide that a President may serve no more than a three-year term. The request also asked whether the EGM would be held.

- c. In April 2015, the HAA wrote to Dr Lee twice, urging her to reconsider the refusal to call an EGM. In the first email, the HAA stressed that while each Harvard Club operated independently, it is the HAA that oversees the use of the Harvard name by the clubs. It was also made clear that if the request to call an EGM was not complied with, the HAA was prepared to revoke all support and services provided by the HAA and remove the Opponent from the HAA Club Directory. A second follow-up email was sent later in the month.
- d. There were differing accounts as to whether Dr Lee responded to the HAA's emails of April 2015. Dr Lee's version of the facts was that an attempt was made thereafter (albeit unsuccessfully) to resolve the matter amicably and privately with the HAA. According to the HAA, however, Dr Lee did not respond.

8 In any event, no EGM was called and Dr Lee remained in office as President of the Opponent. Consequently, the HAA terminated its relationship with the Opponent. The termination letter dated 29 May 2015 was signed by Mr Philip Lovejoy, Executive Director of the HAA. The letter made clear that in addition to revoking the Opponent's status as a recognised alumni club, the HAA was thereby withdrawing its consent for the club to use the names "Harvard" and "Harvard Club" (as well as all other University names and logos) with the full knowledge and support of the Vice Provost for International Affairs. Copied on the termination letter were five office holders within Harvard University, namely: Cynthia Torres (President of the HAA), Tamara Elliott Rogers (Vice President of Alumni Affairs and Development), Jorge Dominguez (Vice Provost for International Affairs), Rick Calixto (Harvard Trademark Program), and Peter Katz (Office of the General Counsel).

9 It was undisputed that from that point on, the Opponent was no longer an official Harvard Club. Subsequently, the HAA recognised the Harvard University Alumni Association of Singapore, or "HUAAS", as the official Harvard alumni club in Singapore.

The opposition actions

10 On 24 December 2014, in the midst of the events described earlier, the Applicant applied to register the Application Marks.

11 The Opponent filed to oppose the Application Marks. The two opposition actions (for there was one against each mark) were later consolidated. After the pre-hearing review ("PHR"), the Opponent confirmed that it would be relying on a narrower list of grounds of opposition than had originally been pleaded in the Notices of Opposition. The following were the grounds of opposition under the Trade Marks Act (Cap. 332, Rev Ed 2005) ("TMA") relied on at the final hearing.

- a. In respect of "HARVARD CLUB OF SINGAPORE": (i) bad faith under s 7(6) TMA; (ii) passing off under s 8(7)(a) TMA; and (iii) use prohibited in Singapore by written law or rule of law under s 7(5) TMA read with s 4(3)(c) of the Societies Act (Cap. 311, Rev Ed 2014).

- b. In respect of “HARVARD UNIVERSITY CLUB OF SINGAPORE”: (i) bad faith under s 7(6) TMA; and (ii) passing off under s 8(7)(a) TMA.

Statutory declarations filed

12 The following statutory declarations (“SD(s)”) were filed by the parties during the usual rounds of evidence. Dr Lee Siew Mun Irene, President of the Harvard Club of Singapore, led the bulk of evidence in support of the Opponent’s case by way of SD (“Lee’s First SD”). The Applicant’s main evidence was led by: Mr Philip Lovejoy, Executive Director of the HAA (“Lovejoy’s SD”). (This was the same Mr Lovejoy who signed the termination letter of 29 May 2015.) Dr Lee then gave evidence-in-reply (“Lee’s Second SD”).

13 The following individuals also filed evidence by way of SD as well: (a) Dr Russell Arthur Smith, member of the Opponent since 1992 (who gave evidence in support of the Opponent) (“Smith’s SD”); (b) Mr Adrian Foo Qijing, member of the Opponent from 2004 to 2012 and now a member of the HUAAS (who gave evidence in support of the Applicant) (“Foo’s SD”); and (c) Mr Bernardo Fajardo Abis and Mr Umar Bin Abdul Hamid, members of the Opponent since 2012 and 2015 (who gave evidence-in-reply in support of the Opponent).

The interlocutory disputes

14 Due to certain procedural skirmishes, the dispute was only ready for hearing about one and a half years later than initially expected. These battles began around the time of the PHR (which took place on 1 November 2017) and primarily arose from, or in connection with, the Opponent’s request for cross-examination. As it provides context to some of the Opponent’s arguments at the final hearing, as well as certain costs awards, a brief outline of what transpired is set out at [16] to [30] below.

15 By way of background, cross-examination in trade mark opposition proceedings is different from cross-examination in court. It is not a right. The Registrar has the discretion as to whether to allow it and to set certain terms (e.g. by limiting the time given and/or narrowing the scope of issues): see *Application for cross-examination by FMTM Distribution Ltd and objection thereto by Tan Jee Liang trading as Yong Yew Trading Company* [2016] SGIPOS 9 (“*Application for cross-examination by FMTM Distribution Ltd*”) and HMD Circular No. 4 of 2015 (“the Circular”).¹ Consistent with the fact that this forum is intended to be a low cost tribunal, the overarching principle is that the Registrar must be satisfied that cross-examination will facilitate the just, expeditious and economical disposal of the proceedings. For these reasons, the Circular states that an applying party must identify “*Specific issues to which cross-examination would, if allowed, be directed*”; and provide an “*Explanation of the relevance of those issues to the matters to be decided*”.

The Opponent’s cross-examination requests

16 The Opponent applied to cross-examine either Mr Lovejoy or a person in charge of the Applicant’s branding strategy and policies. Accompanying the request were allegations drawn from Dr Lee’s Second SD concerning the reliability of Mr Lovejoy’s evidence. Of these allegations, perhaps the most unusual was that “Harvard University” and “President and

¹ Tribunals elsewhere, e.g. at the UK Intellectual Property Office, also restrict the scope of cross-examination in trade mark opposition or invalidation proceedings: see e.g. *Ecotrade Europe Ltd v Kyle Martin (LA WEAVE)* (O-280-16), cited in *Application for cross-examination by FMTM Distribution Ltd* at [83].

Fellows of Harvard College” appeared to be different entities (hereafter the “Separate Entity Argument”). In addition, the Opponent attacked Mr Lovejoy’s authority and ability to give evidence on the Applicant’s behalf.

17 In response, the Applicant argued that the Opponent’s cross-examination request did not meet the requirements of the Circular and expressed confusion as to how the reasons given for requesting cross-examination were linked to the substantive issues to be decided in the oppositions. It also seemed puzzled by the Separate Entity Argument since “President and Fellows of Harvard College” is the legal name of the corporate body that constitutes the university, and “Harvard University” is the university’s main trade mark and name.

18 Regardless, the Applicant volunteered to file an additional SD with a view to clearing the air, and was granted leave to do so. Ostensibly to meet the Opponent’s challenge that someone familiar with the Applicant’s branding strategy and policies should have come forward to give evidence, the Applicant filed an SD by Mr Enrique Calixto, Executive Director of the Harvard Trademark Program (a department within the Applicant). It is worth mentioning that Mr Calixto was the one of the office holders that had been copied on the HAA’s letter of 29 May 2015: see [8] above. (In that letter, his given name “Enrique” was abbreviated to “Rick”).

19 In essence, Mr Calixto’s evidence was that he was authorised by the Applicant to give evidence on its behalf and that Mr Lovejoy, Executive Director of the HAA (a department within the Applicant), not only had authority but was well placed to give evidence on the history between the Applicant and the Opponent. As regards trade mark matters, his evidence was that Mr Lovejoy regularly liaised with the Harvard Trademark Program department in relation to trade mark issues relating to Harvard University. And in order to prove that “President and Fellows of Harvard College” is simply the legal name of the university, he exhibited a copy of the certificate of legal existence for President and Fellows of Harvard College, issued by the Commonwealth of Massachusetts, USA (the state in which it is incorporated).

20 The Opponent, which was given leave to file evidence in reply, filed Dr Lee’s SD in reply (“Lee’s Third SD”). In it, the Opponent not only stuck to its guns on the Separate Entity Argument but fired another volley. Annexed to Lee’s Third SD were two documents which suggested that “Harvard University” and “President and Fellows of Harvard College” were distinguishable from each other. The first was an extract from a civil rights complaint submitted against Harvard University by a coalition of Asian-American Associations. The complaint was made against: “*Harvard University and the President and Fellows of Harvard College*”. Inherent in this was the suggestion that they must be separate entities: for why else frame the complaint in that way? The second document was an extract from a university rankings website which referred to “Harvard University” an educational institution. Dr Lee also maintained that there were issues relating to Mr Lovejoy’s authority to give evidence.

21 After the further SDs were filed, the Opponent made its second request, seeking leave to cross-examine both Mr Lovejoy as well as Mr Calixto. At this point, it seemed that there were reasons for and against the Opponent’s cross-examination request. I elaborate.

- a. On one hand, it did not seem too far-fetched a possibility that the Opponent had an ace or two up its sleeve that would be revealed during cross-examination. After all, the Opponent had been the Applicant’s sole recognised alumni club in Singapore for many years and Dr Lee had worked closely with the HAA. In the premises, it was not completely inconceivable that the Opponent was going somewhere with

the Separate Entity Argument, and with the attacks on Mr Calixto's authority to give evidence on behalf of the Applicant.

- b. On the other hand, apart from those two documents annexed to Lee's Third SD, there was no evidence in support of the Separate Entity Argument. And those two documents did not seem to carry the matter much further. The civil rights complaint document did not expressly state that "Harvard University" and "President and Fellows of Harvard College" were different entities, and even if it had done so, a complaint document was not exactly the best evidence for what Dr Lee sought to prove. As for the university rankings website extract, this was really neither here nor there because educational institutions can be, and often are, corporate bodies. Above all, it remained unclear how the Separate Entity Argument and the other points raised were relevant to the key issues to be decided in the dispute.

22 What further complicated matters was the fact that both Mr Lovejoy and Mr Calixto were based in the US. This meant that they would either have to fly to Singapore to be cross-examined in person or alternatively be cross-examined via video-conferencing. The Circular's guidance on this is that requests for cross-examination may not be allowed where "*the deponent to be cross-examined is based overseas, and cross-examination is used by the requesting party as a litigation strategy to force the opposite party to incur unnecessary costs*". Thus, as a first step, I sought to obtain greater clarity about the Opponent's cross-examination request through discussions at case management conferences ("CMC(s)").

23 At the first of these CMCs that I conducted, I raised the concerns touched on above. In response, Mr Wun, counsel for the Opponent, alluded to the cross-examination request as being tied to bad faith, one of the grounds of opposition. However, when pressed for more information, Mr Wun demurred and said that disclosing too much would prejudice his client's cross-examination strategy. In an attempt to cut the Gordian knot, I proposed to leave open the possibility of cross-examination while first exploring the possibility of further SDs—framed in a manner akin to a response to interrogatories or a request for particulars in court—for the Applicant to answer.

24 Although it raised several concerns about the approach—which resulted in further CMCs being convened to discuss the matter—the Opponent eventually came up with a broad list of issues. In brief, they fell into three interconnected categories, namely: (a) what exactly did Mr Lovejoy and Mr Calixto mean when they referred to "Harvard"; (b) what was the relationship between "Harvard University" and the Applicant; and (c) were Mr Lovejoy and Mr Calixto authorised to give evidence on behalf of the Applicant? The Applicant was then directed to prepare a draft SD in response to those issues. The purpose of preparing an SD in draft form was that objections, if any, could be taken at that stage. After giving the necessary directions, I emphasised that if the SD adequately addressed the issues raised, no cross-examination would likely be permitted. Otherwise, cross-examination would likely be allowed.

25 The Applicant once again called upon Mr Calixto to give evidence. His draft did not encounter any objections or comments from the Opponent and so it was finalised, formalised, and filed ("Calixto's Second SD"). After reviewing it, I informed the parties that it appeared to be a *prima facie* response to the issues raised in the Opponent's list and refused cross-examination. The Opponent was also given leave to prepare a final SD in response in draft format. Express directions were given that the SD should contain only fresh evidence in reply

to the Applicant's latest SD, and that any statements not in the nature of evidence (e.g. arguments or criticism) would be disallowed.

Opponent's request for interlocutory hearing

26 Despite having been forewarned, the Opponent submitted a draft SD which appeared to consist exclusively of arguments or criticism, without any actual statements in the nature of evidence. No documents were proposed to be exhibited either. As per standard protocol (see *Application for cross-examination by FMTM Distribution Ltd* at [26]), I issued a preliminary view indicating a proposed direction: that the proposed SD should be disallowed and that the dispute should proceed to a hearing unless reasons could be put forward to show why this ought not to be the case.

27 After learning of my preliminary view, the Opponent objected by way of letter and asked to be heard in an interlocutory hearing. In that same letter, Opponent's counsel stated that his instructions were that the statements in the draft were meant to question the relevance of certain aspects of Mr Calixto's Second SD, as well as to clarify "*any ambiguous statements*" made. Since this explanation seemed quite unsatisfactory, I convened a CMC to discuss the issue.

28 During the CMC, Mr Wun disclosed that his client was concerned that my refusal to allow the proposed SD would mean that Calixto's Second SD would go unrebutted and thus automatically admitted into evidence. In response, I observed that the mere fact that an SD is filed in trade mark opposition proceedings does not mean that it is automatically admitted; it could, apart from or in addition to cross-examination, be challenged through legal arguments.

29 After the CMC, the Opponent withdrew its request for an interlocutory hearing, saying that it would raise the necessary objections at the full hearing. Although Mr Wun had hinted during the CMC that the Opponent was considering the possibility of making a further request to cross-examine Mr Calixto in connection with Calixto's Second SD only (for this was not something that I had ruled out), no such request was eventually made.

Applicant's request for cross-examination

30 The Applicant also made a cross-examination request of its own. I initially indicated that I was prepared to allow cross-examination of Dr Lee but only in relation to certain specific issues. However, nothing turned on it: the request was ultimately withdrawn at the final CMC where the Opponent's interlocutory hearing was being discussed. In the grand scheme of things, much less time was spent on the Applicant's request in comparison to the Opponent's requests.

The hearing

31 Counsel from both sides tendered written submissions and made oral arguments at the hearing. I discuss the salient points, where relevant and necessary, throughout this decision.

32 In the course of the hearing, the Opponent finally revealed the reason for wanting cross-examination in the first place: in gist, it suspected that the Application Marks had been filed for in accordance with instructions given by Mr Lovejoy and/or the HAA, in the name of the Applicant, but without the Applicant's knowledge or authorisation. According to the Opponent, this was all part of a plan to put pressure on Dr Lee to comply with the HAA's demands (see [7] above) and, failing which, to usurp the Opponent's role as *the club* for Harvard alumni in

Singapore. It was also implied that after opposition proceedings were commenced, Mr Lovejoy (and perhaps Mr Calixto as well) had to then continue the charade by giving evidence in the name of the Applicant.

33 When Mr Wun had finally laid the Opponent’s case theory out in full, lead counsel for the Applicant, Ms Vithyashree, expressed incredulity. First, there was no evidence of these allegations. Second, implicit in the Opponent’s case was the suggestion that the Applicant’s legal representatives on record, Ella Cheong LLC, had been taking instructions from unauthorised individuals. Ms Vithyashree assured me that this was not the case and that they had been taking instructions from the university itself, and I saw no reason to disbelieve her.² Third, the impression that the Opponent had given the Applicant (and this tribunal) prior to the hearing—whether intentionally or not—was that the Opponent’s lack-of-authority argument had something to do with the Separate Entity Argument.

34 Lest there be any misunderstanding, I do not mean to say or imply that there was anything wrong or improper about the way counsel advanced the Opponent’s case during the procedural journey or at the hearing itself. Mr Wun was simply acting upon instructions and advocating for the Opponent to the fullest extent, having regard to the circumstances.

35 At the end of the hearing, I directed the parties to address me in further submissions on how costs should be awarded in respect of the various interlocutory disputes. (The parties were also given the opportunity to file further submissions in relation to one of the grounds of opposition: see [105] below.) Both sides did so in accordance with the specified timelines.

PRELIMINARY DECISION

36 I shall first dispose of two preliminary issues: (a) whether any of the Applicant’s evidence was inadmissible; and (b) the Separate Entity Argument.

Admissibility of evidence

37 As it said that it would do when it withdrew the request for an interlocutory hearing (see [29] above), the Opponent challenged the admissibility of certain portions of the Applicant’s SDs in written submissions. It did so in the context of the bad faith ground (under s 7(6) TMA).

38 The Opponent’s logic went something like this: if the Application Marks were filed without the Applicant’s permission, in bad faith, and Mr Lovejoy had no authority to give evidence on behalf of the Applicant in the proceedings, then it would follow that the whole of Lovejoy’s SD was inadmissible as evidence. As regards Mr Calixto’s evidence, the Opponent’s primary line of argument appeared to be that Mr Calixto was not in a position to speak as to Mr Lovejoy’s authority or to ratify or confirm what Mr Lovejoy had said.

39 I reject these arguments and find their evidence admissible for the following reasons.

² Ms Vithyashree conceded that this could be criticised as “evidence from the bar”. Nevertheless, I saw no reason to reject what she said since: (a) these were matters within her personal knowledge as one of the advocates and solicitors on record having conduct of the matter; and (b) if the Opponent had specifically raised the issue earlier (which it did not), she (or one of her colleagues) could have given evidence on SD to rebut any such allegations.

- a. The authority of Mr Lovejoy and Mr Calixto to submit evidence on the Applicant's behalf clearly flowed from the positions that they held as Executive Directors of the HAA and the Harvard Trademark Program respectively. If there was any doubt, it was dispelled through the documents that Mr Calixto produced as proof of his authority, including a notarised Secretary's Certificate signed by the Applicant's Secretary which certified that Mr Calixto: (i) held Office as Executive Director of the Harvard Trademark Program; and (ii) had the authority to sign, and delegate to other employees (which would include Mr Lovejoy) the authority to sign, documents relating to trade marks owned or controlled by Harvard University.
- b. The Opponent sought to criticise or downplay the link between Mr Lovejoy and Mr Calixto's proof-of-authority documents. However, I was not persuaded. As an office holder and representative, Mr Lovejoy was entitled to give evidence on the Applicant's behalf. Surely, if Mr Lovejoy had been engaged in any fraudulent, improper or shady activity in relation to the filing of the Application Marks, or if the marks had been filed without the authorisation of the Applicant, Mr Calixto who headed the Harvard Trademark Program would have said so. Instead, Mr Calixto's evidence corroborated that of Mr Lovejoy's. In any case, the Opponent was not able to produce any evidence of wrongdoing by Mr Lovejoy or Mr Calixto.

40 During the hearing, Mr Wun also argued that the hundreds of pages of copies of trade mark registration certificates exhibited to Calixto's Second SD were irrelevant. The implication was that it was improper to include evidence of this sort as further evidence.

41 I disagree. In his SD, Mr Lovejoy originally provided documentary records of the Applicant's trade mark registrations and applications,³ but he did not include the certificates for countries and jurisdictions outside of Singapore. In the list of issues posed by the Opponent (see [24] above), it asked: "*Has the Applicant authorised the filing of similar trade marks in other countries and under what circumstances?*" It was thus unsurprising that the Applicant perceived this as a challenge regarding the missing trade mark certificates, and so took the opportunity to include them. In any case, the trade mark registration certificates were relevant in that they showed that "HARVARD" and "HARVARD UNIVERSITY" trade marks across the globe were filed for in the name of "President and Fellows of Harvard College".

Separate entity argument

42 Dr Lee had the opportunity to furnish further evidence in support of her assertion that "Harvard University" and "President and Fellows of Harvard College" appeared to be separate entities. However, none was produced in the final draft SD (see [26] above). Not surprisingly therefore, the Opponent did not seriously pursue the point at the hearing.

43 I accept Mr Calixto's evidence that "President and Fellows of Harvard College" is the legal name of the corporate entity constituting "Harvard University" and that both the HAA and the Harvard Trademark Program are departments within the university.

MAIN DECISION

³ Lovejoy's SD at Annex 15

44 Although allegations of bad faith were at the front and centre of the Opponent’s case, for reasons that will reveal themselves in short order, it is convenient to first discuss the passing off ground of opposition before returning to the bad faith ground. I thus deal with the grounds of opposition in the following order: s 8(7)(a) TMA, s 7(6) TMA and finally s 7(5) TMA read with s 4(3) of the Societies Act.

Opposition under s 8(7)(a) TMA: Passing Off

45 Section 8(7)(a) TMA provides that a trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented “by 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”.

46 To succeed under s 8(7)(a) TMA, the Opponent must establish a *prima facie* case of passing off (*Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd* [2015] 5 SLR 618 at [164]). The classical elements of the tort of passing off are: (a) goodwill; (b) misrepresentation; and (c) damage. For present purposes, it is not necessary to go into a detailed exposition of the law, and it suffices to say that the fundamental principles relating to each element have been discussed in a number of decisions of the Court of Appeal, including *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] 4 SLR 86 and *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216, which I have had regard to.

47 Although the tort of passing off is most often associated with the goodwill of traders, the protection it confers can also extend to non-commercial organisations. As the Court of Appeal in *The Singapore Professional Golfers’ Association v Chen Eng Waye and ors* [2013] 2 SLR 495 (“SPGA”) made clear, associations typically benefit from, and indeed depend on, voluntary membership, subscriptions, donations or support. The existence of such support is a reflection of goodwill which can be protected by the tort of passing off. (See *SPGA* at [23].) As regards the segment of the public that is relevant to the assessment, the guidance provided by the Court of Appeal (*SPGA* at [49]) is that:

“... the relevant segment of the public would consist of all those persons who have an actual or potential interest, whether directly or indirectly, in the claimant's products, services or activities. These would be persons who are drawn to the claimant, [...] or, particularly in the context of non-commercial organisations, when seeking membership or directing donations and sponsorships to support the work of the organisation in question, or when considering or seeking accreditations, references or endorsements.”

48 The following points were agreed, or at least undisputed, by the time of the hearing: (a) that non-commercial entities such as Harvard University and the Harvard Club of Singapore could enjoy goodwill; (b) that the Applicant owned registrations for various trade marks in Singapore including “HARVARD” and the goodwill which attached to the “Harvard” name and mark belongs to the Applicant; and (c) for present purposes, the relevant segment of the public would be primarily comprised of actual and potential Harvard alumni.

49 So, what was the Opponent’s argument? The Opponent built its arguments along the following lines. First, just because the Applicant owns the goodwill attached to “Harvard” does not mean that it is entitled to the goodwill in respect of all variations of trade marks that contain “Harvard”. Second, as a result of, *inter alia*, its long use of “Harvard Club of Singapore”, the Opponent (and no other) owns the goodwill attached to its full name. Third, this gave it the

right to prevent any other party, including the Applicant, from registering the Application Marks. The foundation underpinning the Opponent's case was that it is and has always been a separate entity that has operated independently of the Applicant.

50 In response, the Applicant made it clear that it was not disputing that goodwill attached to "Harvard Club of Singapore". However, its case was that it (that is, Harvard University) ultimately owned all of this goodwill. The reason? In its submission, while each authorised Harvard Club may operate independently, each of them (including the Opponent up till the point its recognised status was revoked) are trade mark licensees of the Applicant and the law is clear that in such cases, goodwill generated in connection with the licensed name or mark would belong to the licensor.

51 The Opponent's response to the Applicant's trade mark licence argument was that this was not supported on the evidence. In this regard, Mr Wun stressed that the HAA provided the Opponent with no funding and had "*zero involvement*" in the Opponent's activities. It was also argued that the Opponent's right to continue using its name, which is on the registry of societies, is not conditional upon remaining an official club of the university.

A licensor-licensee relationship?

52 In *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 ("*Weir Warman*"), one issue before the High Court was whether a trade mark licence had been established. After considering the authorities, V K Rajah JA affirmed the principle that "*a trade mark licence arrangement between the plaintiff and the defendant may only be established if the plaintiff exerts some manner or form of control or supervision over the defendant's goods*" (*Weir Warman* at [68]).

53 Although *Weir Warman* was a commercial dispute, one of the authorities which the court considered in arriving at its decision was not. That case, *Villanova University v Villanova Alumni Educational Foundation, Inc* 123 F Supp 2d 293 (E.D. Pa. 2000) ("*Villanova*"), was a decision of the U.S. District Court for the Eastern District of Pennsylvania. I will discuss the facts of *Villanova* later, but for now it suffices to say that the decision was cited with approval in *Weir Warman* (at [67]) for the proposition that "*the existence of an implied licence requires evidence that permission was given to use the mark, coupled with an exercise of reasonable control over such use*" and that this is to be "*assessed by the objective conduct of the parties*".

54 On the facts of this case, there was no formal signed trade mark licence agreement. This was not unusual given that the parties are not commercial entities, and the Opponent was but one club in Singapore out of approximately 195 Harvard Clubs located around the globe. Accordingly, the key issue is whether an implied trade mark licence existed on the facts of this case. In order to answer that question, I now turn to analyse the evidence before me.

The early years: 1969 to 1975

55 In or around early 1969, a group of approximately 30 Harvard University alumni living in Singapore took steps to form the Harvard Club of Singapore. On 20 February 1969, the group's Acting Secretary, Mr Michael Wilsey, wrote to the Applicant's Alumni Association indicating that they had plans for an inaugural meeting on 24 March, and wanted "*guidance as to how we might conduct our affairs and gain recognition from the Alumni Association*". The letter went on to say that information on "*procedures and activities of other clubs could be most*

helpful". No reply was received and on 3 April 1969, Mr Wilsey sent a follow-up letter.⁴ The founding members eventually proceeded to register the Harvard Club of Singapore as a society with the Registrar of Societies on 26 May 1969.⁵

56 On 29 May 1969, the Associated Harvard Alumni (which would later become part of the HAA) replied, apologising for the delay, saying "*recent events since the occupation of University Hall have caused us to fall in arrears on our correspondence*". They indicated that they were "*very pleased to hear of the formation of the Harvard Club of Singapore*" and that they would be sending over a sample Constitution, a Club Officers Handbook, and a sample annual report. The Opponent was also informed that they would soon be receiving a list of alumni in Singapore. The letter went on to say that the formation of the club would be reported to the Associated Harvard Alumni Board and that steps would be taken to support it. The Opponent was also asked to complete and return a form regarding its officers.⁶

57 Also exhibited to Lovejoy's SD were copies of early correspondence dated 1970 – 1975 between the Opponent and the office within the Applicant that handled alumni affairs.⁷ It is unnecessary to go into each of them in detail, and I shall but mention three. The first is a letter from Associated Harvard Alumni, dated April 1971, thanking the Opponent for sending over a list of new officers of the Harvard Club. The second is a letter from the Opponent to Mr Phifer, Assistant Secretary for Clubs at Harvard University, dated January 1975, which began with the words "*We have received and perused with great interest the 1975 Handbook for Harvard Club Officers*". The third was a Memorandum by Mr Isadore Paisner, Regional Director of the Associated Harvard Alumni, dated 4 June 1973. Chronicled in it was a report of Mr Paisner's visits that year to Harvard Clubs in Bangkok, Singapore, Hong Kong and Japan. Among other things, Mr Paisner recorded his views on the club's present and future leadership (and I quote: "*The leadership [of all four clubs] ... is uniformly good... The Singapore Club also appears to have good material waiting to take over*").

58 All things considered, the documents from those early years showed that: (a) the Opponent's officers sought and received recognition and support from Harvard University's alumni office; (b) the Harvard Club of Singapore also complied with basic requirements such as sending over a list of officers and taking guidance from the Harvard Club Officer's Handbook; and (c) the university was closely connected with its alumni network and was interested in having strong Harvard Club leadership all around the world.

Harvard Club of Singapore: 2000s to 2011

59 Fast forward to the 2000s, which was about the time the internet became well and truly mainstream. Mr Lovejoy's evidence was that Harvard Club leaders around the world were provided with two extensive online resources: (a) the Harvard Alumni Club and Special Interest Groups website (located at <http://alumni.harvard.edu/haa/clubs-sigs/>);⁸ and (b) an Officers' Lounge website (located at <http://officerslounge.clubs.harvard.edu>), which contains resources

⁴ Lovejoy's SD at [16] – [18] and Annex 10

⁵ Lee's First SD at [6]

⁶ Lovejoy's SD at [18] and Annex 10

⁷ Lovejoy's SD at [19] and Annex 10

⁸ Lovejoy's SD at Annex 8

for Harvard Club officers.⁹ These resources were, according to him, promoted at Club Leader meetings including those attended by the Opponent's officers over the years.¹⁰

60 The Harvard Alumni Club and Special Interest Groups website contained, among other things, the HAA Club Requirements. They state that Harvard Clubs are required to meet fundamental criteria known as HAA Club Standards. Per these standards, clubs are required to provide a President's Annual Report and an Officer Listing every year in June. Completion of these documents is what allows a club to be eligible to receive HAA services (e.g. website hosting, a post.harvard.edu club email forwarding address, eligibility for sponsored programs and events, and an invitation to the HAA's annual Alumni Leadership Conference).

61 Mr Lovejoy's evidence in relation to the President's Annual Report and the Officer Listing was that in the 8 years leading up to 2011, the Opponent provided the HAA with an Annual Report every year. Copies of some of these annual reports and officer lists were exhibited to Lovejoy's SD. This evidence was largely corroborated by the evidence of Mr Adrian Foo Qijing who also confirmed that annual reports, updated officer listings, membership details, and a list of activities were provided by the Opponent from 2006 to 2011.¹¹ I find Mr Foo's evidence and the documents exhibited to Mr Lovejoy's SD to be significant because the Constitution and By-Laws¹² of the Harvard Club of Singapore did not mention the need to file annual reports or officer lists with the HAA, and yet the Opponent did so, which meant that its officers were aware of the requirement. (I observe in this connection that the Opponent knew that it had to provide officer list updates from the very beginning: see [56] above.)

62 The Officers Lounge website contained resources relating to Club Operating Guidelines, which included a set of Minimum Standards required of all Harvard Clubs. Among other things, they made it clear that the "*University grants Harvard Clubs permission to use the "Harvard Club" name*" and that Harvard Clubs need to comply with various policies promulgated on the Harvard Trademark Program's website (at <http://trademark.harvard.edu/>). One of the Minimum Standards is that "*Harvard Club Presidents shall not serve more than three consecutive years. Longer or additional terms must be discussed with, and receive consent from, the HAA Regional Director or the HAA*". Harvard Clubs were warned that non-compliance may result in the Club's loss of the right to use the "Harvard" name. According to Mr Lovejoy, it was through such measures that alumni throughout the world could expect Harvard Clubs to be operated in accordance with HAA's guidelines.

63 Mr Lovejoy's evidence was that the Opponent was aware of the 3-year presidential limit in the Minimum Standards. As proof of this, he exhibited the Opponent's 2011 Annual Report to his SD. That year was noteworthy because the HAA had conducted a survey which the Opponent responded to. Question 9 of the survey asked: "*What is your club President's term limit?*" The Opponent responded: "*3 years*". Two things are interesting about this document. First, it was submitted in 2011 during the final presidential term of Ms Nina Yang (Dr Lee's immediate predecessor). And, at that time, Dr Lee was already serving in the Opponent's Executive Committee (as Activities Co-Chair).¹³ Second, the 3-year presidential term limit was not written into the Opponent's Constitution and By-Laws and yet its officers knew about it.

⁹ Lovejoy's SD at Annex 9

¹⁰ Lovejoy's SD at [12] – [15]

¹¹ Foo's SD at [6]

¹² A copy of which was exhibited to Lee's First SD as Exhibit 1

¹³ Lovejoy's SD at Annex 11, p 212

64 A different picture was painted in Lee’s First SD. Dr Lee’s evidence was that from the time she joined the Opponent’s Executive Committee up to April 2014 (when the HAA wrote to Dr Lee regarding the change of leadership that they would like to see: see [7(a)] above), there was “*never any mention from anyone in the HAA about the necessity*” to follow those standards. It was also her evidence that “*the existence of the HAA Handbook and of the HAA Guidelines, let alone the need to adhere to them, was first brought to my attention only in April 2014*”. She also pointed out the club’s Constitution and By-Laws did not mention the HAA or any of its standard-setting documents.¹⁴

65 Mr Lovejoy’s rebuttal evidence was that the Handbook (and other guidelines) were on the HAA website during the time that Dr Lee became President and gave documentary evidence of this.¹⁵ He opined that she should have regularly accessed the website as part of her duties whether as President of the Harvard Club of Singapore or in her previous post as Treasurer of the Harvard Club of Rhein-Main (a position she held from 2010 to about 2013). Various other things were said, but his main observation was simply this: it was difficult to believe that Dr Lee did not know of the HAA’s rules and regulations for Harvard Clubs.

66 I accept Mr Lovejoy’s evidence and would add the following. First, the Handbook was nothing new. A version of it appears to have been sent to the Opponent shortly after its formation in 1969, with another version in 1975. Second, Dr Lee did not actually deny personal knowledge of HAA’s various rules and regulations for Harvard Clubs. All she said was that they were not incorporated into Opponent’s Constitution and By-Laws,¹⁶ and that HAA did not bring them to her attention before April 2014.¹⁷ Third, as far as I can tell from the evidence, all of the Presidents prior to Dr Lee abided by the 3-year term limit. Finally, I note Dr Lee’s evidence that the term limit was “*not uniformly and consistently applied to all Presidents of Harvard Clubs*” and that Presidents of Harvard Clubs in Malaysia, Indonesia and the Rhein-Mein had exceeded this limit.¹⁸ However, even if that were so, this did not assist the Opponent’s case because the point is that such rules exist and in any case the Club Operating Guidelines allow the HAA to give consent for “*Longer or additional terms*”: see [62] above.

67 Having regard to the evidence, I find that in the years prior to Dr Lee’s presidency, the Harvard Club of Singapore was clearly aware of, and abided by, the various rules and regulations promulgated by the HAA to govern Harvard Clubs all around the world.

Dr Lee’s presidency: 2011 to 2014

68 I now turn to Dr Lee’s first three years as President of the Harvard Club of Singapore.

69 In my assessment, there was sufficient evidence that in Dr Lee’s first three years as President, the Harvard Club of Singapore recognised the trade mark rights of the Applicant and conducted itself in a manner consistent with a trade mark licensee. Perhaps the clearest demonstration of this was a series of email exchanges relating to “Harvard Alumni in Singapore”, an organisation unrelated to the Harvard Club of Singapore headed by an individual known as Oscar Tan. A brief summary of the episode follows.

¹⁴ Lee’s First SD at [10] – [11]

¹⁵ Lovejoy’s SD at [44] and Annex 17

¹⁶ Lee’s First SD at [11]

¹⁷ Lee’s First SD at [10]

¹⁸ Lee’s First SD at [25.1(k)]

70 In or around late 2011, Dr Lee discovered that Mr Tan had formed a Facebook group and LinkedIn page that had made use of some of the Applicant's marks, including the "VERITAS" shield mark. (There are a number of variants of this shield mark, one of which is represented at [74(b)] below.) In essence, this group appeared to hold itself out to be an authorised Harvard alumni club in Singapore. Obviously unhappy with the state of affairs, Dr Lee wrote to the HAA's representatives several times to object and to request that it enforce its trade mark rights against Oscar Tan's unauthorised use. Extracts of her emails are reproduced below.

- a. In an email dated 26 December 2011 to Peter Weldon (one of the HAA directors for Asia), she wrote: "*Oscar Tan has no right to use the word Harvard and the VERITAS shield nor form a parallel 'Harvard Alumni' group in cyberspace without the authorization of Harvard University.*"¹⁹
- b. In an email dated 26 December 2011 to Peter Weldon, Jennifer Flynn (Director of Clubs, Shared Interest Groups and International Affairs, HAA), and Brad Quigley (also from the HAA), she wrote: "*I do not believe that it is legal for [Oscar Tan] to use the Harvard logo and form his own competition Harvard alumni group without the consent of Harvard University.*"²⁰
- c. In an email dated 23 February 2012 to Jennifer Flynn, she wrote: "*[p]lease note that the use of the Harvard Veritas logo by this Linked in group is unauthorized ... It is the property of Harvard University & it is my duty to inform Harvard. Harvard should send the owner of the Group a warning or take legal action.*"²¹
- d. In an email dated 9 March 2012 to Jennifer Flynn, she reproduced an excerpt from Peter Weldon's email of 13 December 2011, saying: "*I see this as the kinds of grounds needed to pursue the Harvard Club of Singapore's Facebook page and the pages of a lot of other Harvard organization which are [using] the name and shield*". She then cited a portion of the Applicant's trade mark policy in support:

*"HPAIR is a student-run organization at Harvard College. 'Harvard,' 'Harvard College,' the VERITAS shield, and other Harvard University trademarks remain the sole property of the Presidents and Fellows of Harvard College and are being used by permission of Harvard University. They may not be copied, redistributed, or otherwise used without prior written permission from Harvard University."*²²

71 In Lee's Second SD, Dr Lee tried to explain away the above emails, calling it "*a stretch of the imagination to suggest that I was asking the HAA to enforce the trade mark rights of the University*".²³ She went on to say that she was only asking Flynn and Quigley whether the HAA had given permission to Oscar Tan to use the Harvard name, and that she was not asking for help to enforce. Various other things were said in this vein.

72 I find Dr Lee's explanation unconvincing, to say the least. It was clear from her emails that she recognised and affirmed the Applicant's ownership and control of its various marks.

¹⁹ Lovejoy's SD at Annex 11, p 243

²⁰ Lovejoy's SD at Annex 11, p 243

²¹ Lovejoy's SD at Annex 11, p 291

²² Lovejoy's SD at Annex 11, pp 313 and 229

²³ Lee's Second SD at [15]

She even made reference to the Applicant’s trade mark policies, and urged it to send a warning or take legal action. Dr Lee might not have been conversant with the technicalities of the law of passing off, but she was certainly acquainted with the concept of trade mark rights. Yet she never once mentioned that the Opponent had some sort of independent rights that it could assert. These were the actions consistent with that of a licensee, not a rights holder.

73 Before I conclude my sketch of the evidence, I should address Mr Wun’s argument that the Applicant had “*zero involvement*” in the Opponent’s activities (see [51] above). I find that the submission was not borne out by the evidence. Peppered across the documentary exhibits annexed to Lovejoy’s SD was evidence (e.g. relating to technical support, lists of alumni in Singapore and other contact information) that the Applicant had actively supported the Harvard Club of Singapore.²⁴ There was also corroborating evidence from Mr Foo, who went on to observe that if the HAA had not provided the Opponent with personal information of Harvard alumni in Singapore, the Opponent would not have been able to effectively perform its role as the official recognised alumni association.²⁵

74 To further illustrate the point, I shall discuss the evidence relating to the Harvard Club of Singapore Annual Dinner 2012,²⁶ an event which took place during Dr Lee’s first three years in office. It was a high-profile event and the Straits Times even ran a report on it.

- a. In the days leading up to the Annual Dinner, Dr Lee requested for urgent help from the HAA and she received it. The Guest-of-Honour was the then Minister for Education, Mr Heng Swee Keat. In response to her request for a suitable gift for the Minister, the HAA couriered over a Photo Book titled “Explore Harvard: The Yard and Beyond”, published in honour of Harvard University’s 375th anniversary. The HAA also sent over 150 Harvard 375th anniversary pins, which were presumably ordered by the club for the dinner attendees.
- b. Other administrative assistance was rendered by the Applicant as well. For instance, the Opponent was provided with the 375th anniversary logos as well as the Harvard “VE RI TAS” shield mark (reproduced below) so that they could be displayed during the Annual Dinner:



- c. After the Annual Dinner, Rebekah Strasburger from the HAA helped to draft a “Club Story” with materials sent over by Dr Lee, and obtained her approval for the wording before publishing a story about it on the Harvard Alumni Clubs and Special Interest Groups page.

²⁴ Lovejoy’s SD at Annex 11

²⁵ Foo’s SD at [5]

²⁶ Lovejoy’s SD at Annex 11, pp 321 to 329

Quite obviously, the above support was given because the Opponent was an authorised and recognised club at the time. An independent club would not have received such treatment.

75 For completeness, I should mention that I have considered the statements made by Mr Umar Bin Abdul Hamid and Mr Bernardo Fajardo Abis in their respective SDs (filed in support of the Opponent). Both of them expressed the opinion that the Opponent was operating independently of the university and indeed continues to serve the interests of Harvard alumni in Singapore. While statements of opinion are not *per se* inadmissible before this tribunal (and may perhaps be helpful in some other context), they did not materially advance the Opponent's position, and I accord no weight to them.

Evaluation

76 While each case must necessarily turn on its own facts, it is still helpful to consider cases with similar facts involving an implied trade mark licence. I will discuss two. The first is *Villanova* which, as mentioned earlier, was cited with approval in *Weir Warman*. The second (also an American case) is *Alumni Ass'n of N.J. Inst. of Tech. v. N.J. Inst. of Tech.*, 2014 N.J. Super. DOCKET NO. C-179-08 (2014), a decision of the Superior Court of New Jersey, Chancery Division, Essex County ("*NJIT*"),²⁷ wherein *Villanova* was considered and applied.

77 The material facts of *Villanova* were these. The plaintiff, Villanova University, operated a sports program since the 1920s in connection with the marks "Wildcat" and "Villanova Wildcats". From 1969 to 1971, some alumni approached the plaintiff for permission to form the defendant "Wildcat Club" for the purpose of fundraising in support of the plaintiff's sports program and athletes. In 1972, verbal permission for the Wildcat Club was obtained, and verbal guidelines were given as to the conditions under which it should operate. The defendant generally operated in accordance with these ground rules. Whenever they were not complied with, steps were taken to enforce them, and new or revised rules were promulgated. In 1992 the parties finally entered into a formal affiliation agreement, and a revised agreement was later entered into. In 1997, two years after the revised agreement had expired (during which time the parties continued to abide by the terms of the revised agreement), the university gave the Wildcat Club notice of termination, coupled with a demand that it cease-and-desist from using "Wildcat Club". When the defendant did not comply, the plaintiff brought an action. The issue of an implied licence arose in the context of certain defences relied on by the defendant. These defences could only work if no licence agreement existed. In concluding that there was an implied licence from 1972 to 1997 (and therefore no defences), the judge found that the university had exercised a sufficient degree of control over the defendant's operations.

78 In *NJIT*, the plaintiff was a former alumni association of the defendant, the New Jersey Institute of Technology. Due to certain events, the longstanding relationship between the two collapsed and the defendant sent the plaintiff a notice of the university's decision to disaffiliate. Coupled with the disaffiliation notice was a statement that made it clear that from the termination date, the plaintiff would not have permission to use "NJIT" or "New Jersey Institute of Technology" or any of its other marks, nor shall it have permission to hold itself out as affiliated with the defendant. The court cited *Villanova* for the following propositions: (a) that an affiliate is permitted to use another's trade and service marks only during the period of affiliation; and (b) it is irrelevant whether the parties actually call their arrangement a licence or think of it as such; the test for whether or not an implied licence exists is based solely on the

²⁷ *NJIT* was upheld by the Appellate Division and the US Supreme Court declined to hear a further appeal.

objective conduct of the parties. It then went on to hold (at [60]) that on the facts, the realities of the situation were that the affiliation in itself created a licence, and when the affiliation dissolved, so did the former alumni association's privilege to use NJIT's names and marks.

79 Having considered the evidence before me in light of the applicable principles, I have no difficulty accepting the Applicant's submission that the parties were in a trade mark licensor- licensee relationship. I summarise my reasons below.

- a. First, as *Weir Warman, Villanova* and *NJIT* make clear, the assessment is ultimately an objective one based on the facts of the case and the conduct of the parties. The representatives of Harvard University and the officers of the Harvard Club of Singapore may not have described the relationship as being a licensor- licensee relationship, but the parties certainly conducted their affairs as such.
- b. Second, it was immaterial whether or not the founding members of the club sought permission to use "Harvard" or "Harvard Club of Singapore" before the formation of the club in 1969. The more important point is that Mr Wilsey wrote twice to the Alumni Association on the behalf of the founding members of the club seeking guidance on how they might conduct their affairs and gain recognition. They even waited for about a month and a half after the second letter was sent before finally proceeding with the formation when no reply was received. Clearly, the founders regarded the university as the fount of authority for their fledgling club.
- c. Third, the Harvard Club of Singapore received formal recognition (through the Associated Harvard Alumni's letter dated 29 May 1969) and support very shortly after it was registered. In *NJIT*, the court found that affiliation in itself created a licence. Although I do not need to go so far—even though such a finding would be defensible—what I will say is that implicit in its authorised club status was the permission for the Opponent to use the "Harvard" and "Harvard Club" names and trade marks, subject to requirements (which is the next sub-point below).
- d. Fourth, the university exercised reasonable control and supervision over such use. For instance, the officers that led the Opponent up to 2011 were clearly aware of, and complied with, the various rules and regulations which the Applicant promulgated for Harvard Clubs all around the world. The fact that the club in Singapore had copies of the Officer's Handbook, provided officer list reports, and submitted Annual Reports was evidence of this.
- e. Finally, not only was there permission and control, but the Opponent in fact acted in a manner consistent with that of a licensee. Among other things, it directly recognised the Applicant's trade mark rights and sought the Applicant's help in enforcing the university's trade mark rights against an unauthorised alumni body. This was also powerful evidence that in its dealings with the Applicant the Opponent did not regard itself as an independent rights holder in respect of "Harvard" or "Harvard Club of Singapore".

80 In conclusion, I find that a trade mark licence was created on 29 May 1969 or alternatively at some point of time near that date and lasted all the way until 29 May 2015. It was by virtue of this licence agreement that the Opponent was given the right to use the university's trade marks including, among other things, "Harvard" and "Harvard Club".

81 There is an additional but very important point I should make for completeness. Technically speaking, an unregistered trade mark (unlike a registered one) is not in itself a species of property. I am well aware that the Applicant's registered trade marks in Singapore e.g. "HARVARD" and the "VE RI TAS" shield were first registered in 1991 (with other registrations to follow in the years thereafter),²⁸ and there was no evidence that the university had any registered trade marks in Singapore in 1969. But, this does not undermine my finding of a licensor-licensee relationship in any way, because the term trade mark licence is wide enough to encompass common law rights as well. As such, when I use terms such as "trade mark license" or "licensor-licensee relationship", what I really mean is that in addition to any licence relating to registered rights, the terms of the licence also cover any use by the Opponent of Harvard University's marks in a manner that would otherwise amount to passing off.

Who owns the goodwill attached to "Harvard Club of Singapore"?

82 My finding that the parties were in a licensor-licensee relationship leads to a follow-up question: who owns the goodwill attached to the name "Harvard Club of Singapore"?

83 The law on ownership of goodwill in licensor-licensee situations appears to be well settled. In the absence of some sort of agreement to the contrary, the default position is that the licensor or franchisor is the owner of the goodwill. In support of this proposition, the Applicant referred me to a helpful summary of the law in Professor Wadlow's text, *The Law of Passing Off: Unfair Competition by Misrepresentation* (5th Ed) ("Wadlow") at [7-105], which I reproduce below.²⁹

"One approach to ownership of goodwill might formerly have been to say that each individual franchised business owned a goodwill of its own, and that the goodwill of the franchisor related solely to the granting of franchises to businesses. This would be unduly restrictive. The public may or may not know that a franchising relationship exists, but they do appreciate that one person is responsible for the standards of every franchised outlet. That person is in fact the franchisor, who therefore owns the relevant goodwill *quoad* the public, absent agreement to the contrary. (In fact, of course, any agreement between franchisor and franchisee is more or less bound to provide that goodwill accrues to the former, as any other arrangement would be self-defeating). It is only if the franchisor is perceived to have abandoned control of the business, or surrendered it to the franchisee(s), that the situation contemplated in *Coles v Need*³⁰ arises and the franchised name or format may become *publicii juris*, or distinctive of someone other than the franchisor. This is not to say that individual franchised outlets have no goodwill of their own, but their status as franchisees does not entitle them to a share of that portion of the general goodwill which attaches to the franchised name or format. Their position is roughly equivalent to that of a tied public house, or a retail shop selling nationally advertised brands of goods."

(emphasis added)

And elsewhere in *Wadlow* at [3-150] the learned author stated:

²⁸ Lovejoy's SD at Annex 15

²⁹ This same passage from the 4th edition of *Wadlow* was endorsed by the UK Court of Appeal in *Fine & Country Ltd v Okotoks Ltd (Formerly Spicehaart Ltd)* [2014] F.S.R 11.

³⁰ [1934] A.C. 82; R.P.C. 379 PC

“If the commercial purpose of an agreement is to license the use of a distinctive name or mark in respect of which the licensor has (or is agreed to have) goodwill, to a licensee with no such goodwill, and in circumstances where the licensee’s use would otherwise be actionable as passing-off, then in the absence of agreement to the contrary or other supervening factors, the goodwill in the business so carried on by the licensee under the licensed name or mark will accrue to the licensor rather than the licensee. The licence may be express or implied...”

(emphasis added)

Although the above restatements of the law in *Wadlow* were made in relation to commercial arrangements, I see no reason why they should not apply to the present dispute as well.

84 The Opponent’s response to the above was to stress that a distinction must be drawn between “Harvard” and “Harvard Club of Singapore”. In the club’s submission, the Applicant’s rights to “Harvard” did not extend so far as to “Harvard Club of Singapore”. The Opponent sought to compare this case to *Harrods Limited v Harrodian School Limited* [1996] EWCA Civ 1315 (“*Harrods*”) where the renowned department store, Harrods of Knightsbridge, was unsuccessful in bringing a passing off action against a private preparatory school in Barnes, UK, named “The Harrodian School”. During oral argument, Mr Wun placed emphasis on Millett LJ’s pithy observation in *Harrods* that:

“... The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all-embracing. To be known to everyone is not to be known for everything.”

85 During the hearing, I expressed two difficulties I had with the Opponent’s reliance on *Harrods*. First, it concerned a dispute between two parties in very different fields of commercial activity: one was a department store and the other a school. This case, however, involved a school and one of its alumni clubs. This necessarily meant that the fields of activity were the same or very close. Second, unlike the *Harrods* case (where the key components “Harrods” and “Harrodian” were not identical), the Opponent’s name “Harvard Club of Singapore” wholly incorporated the Applicant’s distinctive trade mark: “Harvard”. If that element were to be removed, then only “Club of Singapore”—a meaningless descriptive term—would be left.

86 Mr Wun’s response was an invitation to consider *SPGA* and in particular the fact that “Singapore Professional Golfers’ Association”, a term with some descriptiveness, had nonetheless acquired, as a result of around 40 years of use, a secondary meaning “*by virtue of their clearly being identified with [the association] and with the activities that it organises and promotes*” (*SPGA* at [40]). He argued that “Harvard Club of Singapore” was analogous and that the Opponent’s use of its full name for 45 years meant that the term had acquired a secondary meaning as designating the Opponent’s services and activities exclusively. A related argument advanced by the Opponent was that disaffiliation or termination did not mean that it had therefore surrendered all the goodwill it had built up over those many years.

87 With respect, I am unable to accept any of these arguments. “Harvard Club of Singapore” cannot be likened to “Singapore Professional Golfers’ Association”. “Harvard” is a distinctive trade mark which designates the Applicant as its source and origin. And, there is evidence that the vast majority of the authorised Harvard alumni clubs adopt the format “Harvard Club of

[Location]”.³¹ Therefore, “Harvard Club of Singapore” inherently suggests to actual and potential alumni that the club is authorised by the university. On the other hand, “Singapore Professional Golfers’ Association” is “*in essence a straightforward description of an association for professional golfers*” (SPGA (at [39])). Each word therein is descriptive. Comparing the two would be inappropriate: as the saying goes, they are apples and oranges.

88 Earlier, I have found that it was because of the implied trade mark licence granted by the Applicant that the Opponent was able to make use of “Harvard” and “Harvard Club”. The whole point of the trade mark relationship was to license the use of “Harvard” or “Harvard Club” to the Opponent so that its use would not amount to passing off. There was no agreement that the goodwill attaching to “Harvard Club of Singapore” would accrue to the Opponent. Consequently, in accordance with established principles of law, it is the Applicant and not the Opponent that enjoys the goodwill connected with “Harvard Club of Singapore”. For this reason, the issue of surrender of goodwill does not even arise.

89 Accordingly, I find that the Opponent has no goodwill with which to sustain an action in passing off against the Applicant. Thus, the first element of the tort is not made out. Since this makes it unnecessary for me to analyse the second and third elements of the tort, all I will say is that it logically flows from my findings that there cannot be any actionable misrepresentation or damage to the Opponent. On the contrary, it may well be open for the Applicant to pursue an action in passing off against the Opponent in court. But, since such matters are beyond the purview of this tribunal, I go thus far and no further.

90 For the reasons above, the opposition against the Application Marks on the basis of passing off under s 8(7)(a) TMA is unsuccessful.

Opposition under s 7(6) TMA: Bad faith

91 I now turn to the bad faith ground of opposition.

92 The leading case on the Section 7(6) TMA ground is the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). A restatement of the key principles in *Valentino* that are relevant to this case is set out below.

- a. 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] referring to *Nautical Concept Pte Ltd v Jeffery Mark Richard and anor* [2007] 1 SLR(R) 1071 at [15].) (However, as observed in Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 at [21.4.1] (“*Law of Intellectual Property of Singapore*”), footnote 109, this does not mean that there is an absolute prohibition against drawing inferences. In support of this observation, the learned author cited the decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)
- b. Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons

³¹ Lovejoy’s SD at Annex 20

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] referring to *Weir Warman* at [48].)

- c. The test for determining the presence of bad faith is a “combined” one, in that it contains both a subjective element (*viz.*, what the particular applicant 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. (*Valentino* at [29] referring to *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [105] – [117].)
- d. The legal burden of proof needed to substantiate an action on this ground lies on the party bringing the application (here: the Opponent). (*Valentino* at [21] referring to *Wing Joo Loong* at [33].) (See also *Montford Services Sdn Bhd v USA Pro IP Limited* [2018] SGIPOS 3 at [13] which makes it clear that the applicable standard of proof is the civil standard—i.e. on a balance of probabilities.)

93 It is well established that the relevant time for determining whether there is bad faith is the time of filing the application for registration. (See *Leonid Kovalkov v Tan Siew Keng Angeline* [2016] SGIPOS 10 at [29], wherein the learned IP Adjudicator cited *Kerly’s Law of Trade Marks and Trade Names* (15th Ed) (Sweet & Maxwell, 2011) at [8-263], which referred in turn to the decision of the European Court of Justice in *Chocoladefabriken Lindt & Sprungli AG v Franx Hauswirth GmbH* (C-529/07) for this proposition.)

94 However, the rule that bad faith must be assessed as at the time of filing the application for registration does not exclude the consideration of matters which occurred after the date of application; they may assist in determining the applicant’s state of mind at the date of registration. (*PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2010] 2 SLR 109 at [91] citing *Ferrero SpA’s Trade Marks* [2004] RPC 29 and *Tesco Stores Ltd’s Trade Mark Applications* [2005] RPC 17.)

95 The Opponent’s case on bad faith was advanced along three main lines of argument.

96 The first line of argument was that the Application Marks were filed by the HAA in the Applicant’s name, but without any authority: see [32] above. However, there was no evidence of this, or that Mr Lovejoy and/or the HAA acted as rogue agents: see also [38] – [39] above. On the contrary, when I sieved through the documents, I saw evidence that the termination of the Opponent as a recognised alumni club had taken place with the full knowledge and support of the Vice Provost for International Affairs as well as several other key office holders, including Mr Calixto (see [8] above). Further, Mr Calixto from the Harvard Trademarks Program—the very department charged with protecting and managing the university’s trade marks—came forward to give evidence. He would not have done that if the Application Marks were made without the Applicant’s knowledge. I therefore reject this first line of argument without any hesitation whatsoever.

97 The second line of argument was multi-pronged and involved allegations with one common theme: dishonest, improper or some other unacceptable conduct falling within the scope of bad faith. Under this thematic umbrella, the Opponent argued that the timing of the

Application Marks and the fact that the application for “HARVARD CLUB OF SINGAPORE” was identical to the Opponent’s name was no coincidence. It alleged that the Application Marks were designed to put pressure on Dr Lee to comply with the HAA’s demands to step down (see [7] above), and that the trade mark applications were designed to interfere with the club’s activities with a view to usurping its role as a club for Harvard alumni in Singapore. (In Smith’s SD, filed in support of the Opponent’s case, Dr Russel Arthur Smith also expressed a related concern that the new club, the HUAAS, was causing “*confusion over which body is the peak alumni organization in Singapore*” that “*represents the Harvard Alumni in Singapore*”.³²)

98 I have given due consideration to the second line of argument but am not persuaded that any inference of bad faith should be made. As I have found above in the context of passing off, the Applicant is the owner of the goodwill attached to “Harvard Club of Singapore” and the Opponent was but a licensee. Lest it be forgotten, this was not a commercial licence, and the Opponent paid no licence fees for the right to use the Applicant’s trade marks. Instead, as an official alumni club of the university, the Opponent’s right to use was contingent on the Applicant’s continued recognition of affiliation. What the Applicant could give, it could also take away (or indeed give another). There was no usurpation or surrender of rights, for all of the rights already belonged to the Applicant. It was the Applicant’s right to file for the Application Marks, and it could do so at any point of time it deemed fit. Therefore, the fact that the Application Marks were filed for before the termination letter was issued made no difference.

99 The third line of argument was that it was bad faith for the Applicant to file for two trade marks at the same time for club services in Class 41 without *bona fide* intention to use them. The Applicant’s simple response was that it has every intention to use those marks.

100 With respect, I fail to see how this third argument points towards a finding of bad faith. The obvious flaw in the argument is that trade marks and society names (or company names, for that matter) are not the same thing. A registered society (or company) can be registered in one name and yet use different marks to denote its services. In reality, it happens all the time. Further, if what the Opponent is suggesting is that the Applicant cannot use “HARVARD CLUB OF SINGAPORE” as a trade mark because it is the Opponent’s name, well, that is an issue for the courts to decide if parties are unable to resolve the dispute elsewhere. Lastly, a registered trade mark proprietor does not have to put its marks into use immediately: a registered mark only becomes vulnerable to a non-use attack after 5 years from the date of the completion of the registration procedure.

101 For the above reasons, the opposition against the Application Marks on the ground of bad faith under s 7(6) TMA is unsuccessful.

Opposition under s 7(5) TMA: Use prohibited by law

102 I now come to the last ground of opposition, s 7(5) TMA, which was relied on against “HARVARD CLUB OF SINGAPORE” (40201402804X) only.

103 Section 7(5) TMA states:

³² Smith’s SD at [5] – [6]

“A trade mark shall not be registered if or to the extent that its use is prohibited in Singapore by any written law or rule of law”

104 The “*written law or rule of law*” that was relied upon by the Opponent was s 4(3) of the Societies Act. In particular, the Opponent cited s 4(3)(c)(i) and (ii) of the Societies Act, which are reproduced below:

“(3) The Registrar may refuse to register a specified society if -

(c) it appears to him that the name under which the specified society is to be registered -

- (i) is likely to mislead members of the public as to the true character or purpose of the specified society or so nearly resembles the name of some other society as is likely to deceive the members of the public or members of either society;
- (ii) is identical to that of any other existing society; or
- (iii) [...]”

(emphasis the Opponent’s)

(For convenience, I shall refer to s 4(3)(c)(i) of the Societies Act as the “Deceptive Resemblance” ground, and s 4(3)(c)(ii) of the Societies Act as the “Identical Name” ground.)

105 At the conclusion of the hearing, leave was given to both sides to file further written submissions in relation to the s 7(5) TMA ground of opposition.

106 The Opponent’s case under this ground was somewhat convoluted. To the best of my understanding, its strongest argument (drawn from both its written submissions as well as its further written submissions) ran along the following lines.

- a. The Registrar of Societies may refuse to register a society on either the Deceptive Resemblance ground or the Identical Name ground. There was evidence from Mr Lovejoy that the Registrar of Societies refused to allow “HARVARD UNIVERSITY CLUB OF SINGAPORE” to be registered as a society name having regard to the full name of the Opponent (which is already registered as a society). This was an example of the Deceptive Resemblance ground at work on the facts of this dispute.
- b. The application mark in issue is “HARVARD CLUB OF SINGAPORE” in Class 41 for club services. The logical inference is that the Applicant intends to form a new registered society under that name and there is some evidence to suggest that this might happen.
- c. Therefore, s 7(5) TMA applies because if an attempt is made to register a society under that name, the Registrar of Societies would have to refuse it on the basis of the Identical Name ground because of the Opponent’s name. The Registrar of Societies’ decision (or inevitable decision, should a club be formed under such a name) amounts to a prohibition against the use of “HARVARD CLUB OF SINGAPORE” under “*any written law or rule of law*”.

107 The Applicant’s response was that the Opponent’s reliance on s 7(5) TMA was wholly misconceived. It advanced the following arguments.

- a. First, Section 7(5) TMA is not meant to cover this situation. Although there is no local judicial authority on s 7(5) TMA, there is some local academic authority which sheds light on the situation. In *Law of Intellectual Property of Singapore*, Professor Ng-Loy opined at [21.5.3] that the “*real targets of s 7(5) are trade marks the use of which is prohibited by, for example, other legislation such as the Singapore Tourism Board Act³³ (on the use of the Merlion symbol) and the Geneva Conventions Act³⁴ (on the use of the symbol associated with the Red Cross)*”. In this connection, the Applicant also cited the IPOS TM Work Manual, Version 3 (June 2017) at pp 12-13 and referred to the following other examples of situations which s 7(5) TMA is meant to cover: namely, the use of the Singapore Coat of Arms and the Singapore flag (see rr 3 and 9 respectively of the Singapore Arms and Flag and National Anthem Rules (Cap. 296, R1, Rev Ed 2004)).
- b. Second, the societies register and the trade marks register are wholly different regimes. Ultimately, s 4(3) of the Societies Act concerns registration as a society, and not a trade mark. It would be against public policy to permit a registration on the registry of societies (or by extension, the companies register) to block a trade mark registration or vice versa. If this were the intention of Parliament, it would have been made express. And in any case, such a position does not accord with current practice. For example, the Registrar of Trade Marks does not conduct prior mark searches on the societies register.
- c. Third, s 7(5) TMA is one of the absolute grounds of refusal. It is not a relative ground. Therefore, one cannot import relative ground concepts like comparing another sign or mark under s 7(5) TMA. In support, the Applicant cited Mr Tan Tee Jim, SC’s textbook, *Law of Trade Marks and Passing Off in Singapore* (Singapore: Sweet & Maxwell, 2014) at [7.148], where the learned author noted that: “*the grounds of refusal of registration in section 7 are intended to relate to the intrinsic characteristics of the sign or mark whose registration is sought whereas the grounds in section 8 are to be considered in relation to another sign or mark*”. The Applicant further pointed out that Professor Ng-Loy also took a similar view in [21.5.4] of *Law of Intellectual Property of Singapore*.

108 In its further written submissions, the Applicant made a very important point. In essence, its argument was that the legislative provision (i.e. s 7(5) TMA) prohibiting the registration of trade marks such as the Merlion, the Red Cross, the Singapore flag and the like were meant to catch instances of “use” that intersected with the trade marks regime. On the other hand, s 4(3) of the Societies Act dealt purely with registration as a society and has nothing to do with “use”. A related point which came up during oral argument—a point which I believe is correct as a matter of legal principle—is that the mere registration of a society (or company) name does not, without more (e.g. actual activity or trade) amount to actual use in the trade mark sense.

109 Interestingly, the Applicant’s arguments relating to “use” turned out to be somewhat prescient. A few weeks after the parties filed their further written submissions, the High Court handed down its decision in *Scotch Whisky Association v Isetan Mitsukoshi Ltd* [2019] SGHC 200, an appeal against an unrelated decision of this tribunal involving the issue of whether an

³³ See s 24 of the Singapore Tourism Board Act (Cap. 305B, Rev Ed 1997)

³⁴ See ss 8 and 9 of the Geneva Conventions Act (Cap. 117, Rev Ed 1985)

opposition against “ISETAN TARTAN” should be allowed (“*Isetan Tartan*”). The High Court’s decision appears to contain the first local judicial pronouncement on s 7(5) TMA.

110 In *Isetan Tartan*, the alleged prohibited use under “*any written law or rule of law*” concerned the “use” of a geographical indication. Arguments were advanced in relation to what such “use” meant in the context of the Geographical Indications Act 1998 (Cap. 117B, 1999 Rev Ed) (“GIA 1998”) as well as s 7(7) TMA. In particular, the Scotch Whisky Association (or SWA) argued that “use” in that context should be interpreted broadly so as to encompass forms of use other than direct use of a geographical indication. It argued that “indirect commercial use” or alternatively “evocation” of a geographical indication should suffice. These arguments were designed to facilitate the submission that “ISETAN TARTAN” should be refused registration because it would, under the broader definition of “use”, be evocative of “Scotch Whisky” in that both are from Scotland. The SWA also argued in the alternative that the application should be refused because “tartan” in “ISETAN TARTAN” is a geographical indication. The judge was not persuaded and rejected the broader definition approach. In short, his holding was that “use” under the GIA 1998 meant direct use (and therefore not evocative use). As regards the SWA’s alternative argument, this was rejected as well following his finding that “tartan” is not a geographical indication.

111 Of course, “*the written law or rule of law*” relied on here is not the GIA 1998 and *Isetan Tartan* is not directly applicable in that sense. However, there are two very important takeaway points that must be mentioned. First, in *Isetan Tartan* the relevant provisions of the GIA 1998 (namely, see ss 3(2)(a), 3(2)(b) and 3(2)(d)) relied on all had to do with acts of *actual* use. Second, those provisions of the GIA 1998 set out causes of action that an interested party may bring against certain uses of a geographical indication, and for which an injunction and damages could be obtained in court. (To use a trade marks analogy, these sections roughly approximate an action for “infringement” relating to unauthorised use of a geographical indication.)

112 What does all this mean? In short, *Isetan Tartan* is consistent with the Applicant’s argument that s 7(5) TMA is directed against actual “use” in the real world (as opposed to mere registration on the societies or companies register). At the same time, *Isetan Tartan* appears to suggest that the words “*use is prohibited in Singapore by any written law or rule of law*” in s 7(5) TMA are broad enough to entail a comparison of rights as between two or more parties (e.g. an interested party on one hand and the trade mark applicant on the other).

113 Returning to the present, I must say that the Opponent’s arguments (or what I understood of them) appeared to hold some attraction at first blush. However, upon further reflection, I prefer the view that the trade mark register and the societies register are wholly separate regimes which do not intersect on this particular issue as a matter of law, policy and practice.

114 In my judgment, s 4(3) of the Societies Act deals purely with the discretion of the Registrar of Societies, who “*may refuse to register a specified society*” in certain circumstances. For the purposes of s 7(5) TMA, a legal prohibition relating to use can fall into one of two categories: the first is express prohibition under written law (e.g. relating to the Merlion symbol, the Red Cross, or the Singapore flag under their respective governing legislative provisions), and the second is a more general type of prohibition against use (e.g. in the *Isetan Tartan* case). But in either event, the essential element is that the “*written law or rule of law*” must be directed against actual use.

115 Because *registration* of a society and *actual use* of a trade mark or name are different, the exercise of the Registrar of Societies' discretion to allow or refuse registration of a specified society on grounds set out in s 4(3) of the Societies Act does not amount to a prohibition under "*written law or rule of law*" prohibiting the *use* of a name or mark in Singapore within the scope of s 7(5) TMA. Put another way, s 4(3) of the Societies Act does not prohibit or regulate the use of "HARVARD CLUB OF SINGAPORE" as a trade mark, in relation to club services.

116 Therefore, the opposition against "HARVARD CLUB OF SINGAPORE" (40201402804X) on the basis of s 7(5) TMA read with s 4(3) of the Societies Act must fail.

Overall conclusion

117 For the reasons set out above, I would dismiss the oppositions and allow the applications for "HARVARD CLUB OF SINGAPORE" (40201402804X) and "HARVARD UNIVERSITY CLUB OF SINGAPORE" (40201402805W) to proceed to registration.

Costs orders

(1) Costs of the substantive dispute

118 I have dismissed the opposition actions against the Application Marks. The usual costs order is that costs are to follow the event. Thus, I order that the costs of the main substantive dispute be paid by the Opponent to the Applicant. They are to be taxed if not agreed.

(2) Costs of the interlocutory disputes

119 I have considered the parties' further submissions on how costs should be awarded in respect of the various interlocutory disputes. In brief, each side sought to lay the blame on the other for the fact that so much time and costs had gone into dealing with the issues.

120 The Opponent argued that it was the Applicant's inability or failure to satisfactorily explain and give evidence of Mr Lovejoy's authority that led to this unfortunate situation; as a result, all the costs that flowed therefrom should be paid for by the Applicant to the Opponent. It also argued that the whole of Lovejoy's SD and certain portions of Calixto's Second SD were irrelevant and hence costs incurred in respect of reviewing these documents should also be paid for by the Applicant to the Opponent. Finally, the Opponent argued that it should be awarded costs in relation to the Applicant's cross-examination request which was discontinued. Although the Opponent did not spell out the quantum of costs which it sought, the Opponent observed that there were a total of 6 CMCs convened to discuss these interlocutory issues.

121 The Applicant described the Opponent's conduct of the entire proceedings as "*disappointing*" and "*neither helpful [nor] compliant*" in moving the matter along. Among other things, the Applicant pointed out that if the Opponent had not been so vague about its objections, a great deal of time and costs could have been saved; after all, it was only at the final hearing itself that the Opponent revealed—without any evidence to substantiate the allegation—that its concern was that Mr Lovejoy and Mr Calixto were acting without authority. The Applicant concluded by saying that "*there were strong reasons to believe that the entire exercise was a delaying tactic on the Opponent's part*". The Applicant submitted that it should be awarded costs of \$10,000.

Costs in relation to the Opponent's cross-examination requests

122 While I would not go so far as to say that the Opponent engaged in delay tactics, I do accept that significant time and costs could have been saved if the Opponent had explained up front why it wanted to cross-examine Mr Lovejoy and/or Mr Calixto. I would also add that further time and costs were expended in connection with Dr Lee's draft SD (for which leave to file was refused). As regards the Opponent's challenge to the admissibility of parts of Applicant's evidence, this was something that I have rejected at [37] – [41] above.

123 In the premises, I would award the Applicant the costs of the following: (a) preparing for and attending the various CMCs insofar as they relate to the Opponent's cross-examination requests; (b) preparing and filing Calixto's First SD and Calixto's Second SD; and (c) reviewing Lee's Third SD and Dr Lee's draft SD.

124 Since this dispute was commenced prior to 31 January 2017, it is the pre-Trade Marks (Amendment) Rules 2017 version of the Scale of Costs set out in the Fourth Schedule to the Trade Marks Rules (Cap. 332, Rev. Ed 2008, R 1) ("TMR") that will apply. Under the applicable rules, the maximum amount that the Registrar can award for: (a) preparing for and attending 6 CMCs; (b) preparing and filing 2 SDs; and (c) reviewing 2 SDs is \$10,800.

125 Having considered the parties' submissions and all the relevant circumstances, I consider it fair, just and reasonable to fix the costs arising out of the Opponent's cross-examination requests at \$9,000, to be paid by the Opponent to the Applicant. (I consider the costs of the PHR to be part of the main action and have not taken them into account.) In awarding this sum, I would stress that costs awards in trade mark opposition disputes are "*not intended to compensate the parties for the expense to which they may have been put*": see rule 75(2) TMR.

Costs in relation to the Applicant's cross-examination request

126 As for the Applicant's cross-examination request, I note the Opponent's point that even though the request was withdrawn, time had to be spent in relation to it. However, as observed earlier, I did indicate to the parties that I was willing to allow the request albeit in relation to certain specific issues only. Having considered the parties' submissions and all the relevant circumstances, I consider it fair, just and reasonable to order that the parties bear their own costs in relation to the Applicant's cross-examination request.

Date of Issue: 10 October 2019

[The appeal from this decision to the High Court was dismissed.]