

## FEBRUARY 2008 Singapore: Singapore recognizes first well-known mark

01 Feb 2008

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Amanresorts Limited and Amanresorts International Pte Ltd (Amanresorts) are two companies under the umbrella of the Amanresorts Group. Amanresorts are the owners of various trade marks comprising the word "Aman" and/or the prefix "Aman" including "Amanusa" around the world (but their "Amanusa" mark in Singapore was not renewed at the relevant time). Amanresorts operate many exclusive and luxurious hotels and resorts around the world and "Amanusa" is one of Amanresorts' exclusive high-end resorts in Bali.

Amanresorts discovered that a Singapore real estate developer, Novelty Pte Ltd (Novelty), had named one of its local condominium projects "Amanusa". Consequently, Amanresorts brought an action of passing off against Novelty. Amanresorts also claimed that their "Aman" marks are well-known and therefore sought protection under section 55 of the Trade Marks Act.

Amanresorts presented substantive evidence to prove their case and claimed that Novelty's use of its trade mark would lead to the "whittling away" and "erosion of the uniqueness and exclusivity" connected with their mark, the loss of branding fees and the loss of opportunity "to use the name Amanusa or other Aman-prefixed name for their own real estate developments in Singapore...".

Novelty, on the other hand, contended that Amanresorts did not have the requisite goodwill and reputation in their "Aman" marks in Singapore. Further, the customers who purchased and/or were interested in purchasing a unit in the condominium project were not persuaded by the "Amanusa" name, and thus the "Amanusa" name did not help in their sales. Further, they argued that they had invented the name "Amanusa" by combining two common Malay words together. Another argument Novelty raised in support of its case was the fact that the Street and Building Names Board had approved the name unconditionally, which would not have been the case if they were aware of another development with a similar name and the possibility of a likelihood of confusion. Since the name was approved unconditionally by the said Board, Novelty did not conduct any further checks on the name "Amanusa".

The Court decided that if Novelty continued to use the name "Amanusa" for its development, this was likely to cause damage to the goodwill and reputation of Amanresorts, which runs a well-known luxury resort in Bali also called Amanusa. Although Singapore home owners who had purchased units in the uncompleted project did not think it was related to Amanresorts, allowing Novelty to call its project "Amanusa" may cause the name to lose its uniqueness. The Court rejected Novelty's argument that the name was invented through the combination of two Malay words "Aman", which means peace and "Nusa", which means island. It was too coincidental for Novelty to have thought of the same two words and decided to join them in exactly the same way as Amanresorts. If Novelty had conducted a search of the name on the internet, it would have surely come across Amanresorts' Bali resort. Novelty did not make any such internet searches.

Based on the facts and evidence presented, Amanresorts won its legal action against Novelty. The Court decided that there was passing off, i.e. there was goodwill and reputation in the "Aman" and "Amanusa" trade marks; there was a real risk of misrepresentation (a likelihood of confusion); and there was a probability of damage (intangible damage) to Amanresorts if Novelty was allowed to maintain the name of its project as "Amanusa". The Court also agreed that the Amanresorts' trade marks are well-known and granted the injunction to restrain Novelty from using the name "Amanusa". As a result of this decision, Novelty had no choice but to change the name of its condominium project.

In 2004, the Trade Marks Act in Singapore was amended to expand the well-known trade mark provisions. Section 55 of the Trade Marks Act governs the protection of well-known marks in Singapore. Whether a trade mark is well-known in Singapore is decided by the courts, who will consider the following non-exhaustive list factors:

- the degree to which the mark is known to or recognized by any relevant sector of the public in Singapore;
- the duration, extent and geographical area of any use or promotion of the mark;
- any registration or application for registration of the mark in any country or territory in which the mark is used or recognized, and the duration of such registration or application;
- any successful enforcement of any right in the mark in any country or territory, and the extent to which the mark was recognized as well-known by the competent authorities of that country or territory; and
- any value associated with the mark.

This is a landmark decision for Singapore as it is the first case where the Singapore courts have recognized a trade mark as being well-known and hence restrained another party from using the said name. Although provisions have been made for the protection of well-known marks in Singapore, the courts had not enforced such protection until this case.



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