

Bad Faith and Trade Mark Registrations in Singapore

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One of the grounds on which a trade mark will be refused registration in Singapore (as is the case in the UK) is proof of "bad faith" on the part of the applicant in the application process. Although the concept of "bad faith" has been part of the corpus of trade mark law in Singapore and in other common law jurisdictions for some time now, its precise meaning and scope of application remain unclear. "Bad faith" is usually raised in trade mark opposition proceedings against marks which are, for example, immoral or offensive in nature, or as against applicants who do not have the intention to put them to genuine use in the course of trade. However, the High Court of Singapore has, in the recent decision of Rothmans of Pall Mall Limited v Maycolson International Ltd [2006] SGHC 51 and for the very first time, interpreted the element of "bad faith" in section 7(6) of the Trade Marks Act 1998 as imposing an affirmative duty on the applicant to make reasonable enquiries as to the bona fides of the proposed mark (particularly when the applicant has knowledge of parallel proceedings in other countries involving the same/similar marks). It is the aim of this paper to critically examine the test laid down by the High Court for "bad faith" as well as the legal duties imposed on trade mark applicants to make due inquiries into the bona fides of a mark before seeking registration in Singapore. Additionally, the authors will assess the legal bases upon which the High Court came to the conclusion that "bad faith" on the part of the applicant was made out in the present case (in particular, the fact that the trade mark applicant was cognizant of the existence of parallel proceedings in Europe involving the same/similar conflicting marks) as well as the various policy implications of the High Court's decision. At this preliminary stage, it seems to us that the burden placed by the High Court on prospective trade mark applicants (who now have a positive duty to investigate into the bona fides of a proposed mark) is somewhat onerous and questionable, the effect of which may be to impede rather than promote the smooth flow of day-to-day commerce.