

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 1585466
FOR A DEVICE MARK IN CLASS 41 IN THE NAME OF
NAM YANG PUGILISTIC ASSOCIATION UK**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 43455 BY
DENNIS KAH SWEE NGO**

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

5

**IN THE MATTER OF APPLICATION NO 1585466
FOR A DEVICE MARK IN CLASS 41 IN THE NAME OF
NAM YANG PUGILISTIC ASSOCIATION UK**

10 **AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 43455 BY
DENNIS KAH SWEE NGO**

15

DECISION

20 On 15 September 1994 Mr Iain Armstrong filed application to register the mark shown in Annex 1 on behalf of the Nam Yang Pugilistic Association, UK Branch (NYPA). The application originally named Mr Armstrong and the Nam Yang Pugilistic Association, but was subsequently amended to be in the sole name of the Nam Yang Pugilistic Association.

25 The application, numbered 1585466, is in Class 41 with the following specification: Club services relating to Chinese martial arts, Chinese soft exercise and meditation and Chinese cultural activities.

30 Notice of Opposition was filed on 14 November 1995 by Mr Dennis Kah Swee Ngo. The grounds of opposition are in summary:

(i) that the opponent trades as Tiger-Crane Combination Kung Fu and is the unregistered proprietor of the words and mark applied for;

35 (ii) that the mark applied for so closely resemble the opponent's unregistered mark as to be likely to deceive and cause confusion to members of the public;

(iii) that the mark would not be distinctive of the applicants' goods or services;

40 (iv) that registration would be contrary to the law of Passing Off;

(v) that registration should be refused in the exercise of the Registrar's discretion.

45 The applicants filed a counterstatement denying the above grounds and claiming that the trade mark the subject of the application is an original work, the copyright of which is vested in the Singapore Branch of the Association. Both sides ask for the award of costs in their favour.

Both sides filed evidence. The matter came to be heard on 12 November 1998 when the opponents were represented by Mr Michael Edenborough of Counsel instructed by Sommerville & Rushton and the applicants by Mr David Campbell of Counsel instructed by Barlin Associates. Both Mr Armstrong, on behalf of the applicant, and the opponent gave oral evidence at the hearing, on which they were cross-examined, in addition to the written evidence already before me.

By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Summary of Evidence

Opponent's Evidence in Chief

The opponent filed a statutory declaration by Dennis Kah Swee Ngo dated 22 July 1996. Mr Ngo states that he is a professional martial arts instructor and trades as Tiger-Crane Combination Kung Fu (UK and Europe), a business of which he is the Chief Instructor. The core business activities are teaching a specific form of traditional Chinese martial art and related cultural activities. He states that traditional Chinese martial arts are ancient fighting systems which incorporate the natural fighting moves of various animals, notably the tiger, crane, monkey and snake. He exhibits a book entitled "Understanding the Principles of Kung Fu" which he says explains this principle.

He states that he was born in Singapore and began training in his early teens with the Nam Yang Pugilistic Association (Singapore), and that the words "Nam Yang" are dialect words for South East Asia, and not indicative of martial arts. The main system taught there was tiger-crane kung fu. He trained until 1976 when he came to the UK as a student at the London School of Economics, graduating in 1979. In 1979 he states that he was approached by a member of the Chinese Society of University College, London to teach kung fu to the Society's members and other students. He states that he sought the opinion of Tan Soh Tin, Honorary Secretary of the Singapore Association, and was given an authority to instruct by him on 12 September 1979. He continued to be a member of the Singapore Association in an individual capacity, and the club he founded and its members were distinct. He states that at this time he devised a mark for the T-shirts worn by his students. This mark is shown in Annex 2 to this decision, and corresponds to the drawing there numbered 1.

During the hearing, Mr Ngo said that there had been an error in the exhibits to his original statutory declaration. This was clarified during his examination in chief, and I think it is helpful to reproduce what he said. The passage from the transcript reads as follows, with the references being to the document reproduced as Annex 2:

Mr Edenborough: There are four diagrams here. Would you like to just state which is which?

Mr Ngo: Diagram 1 is what I drew. Diagram 2 is what Nam Yang Pugilistic was using at that time. Diagram 3 was what Singapore asked me permission for to use as their logo. Diagram 4 was the new logo that I thought would be better than just the tiger in the first logo and the second and third logo also.

5

The main components are a crane with its wings spread above the head of a roaring tiger, with a rising sun to the right and small clouds around the edge. Mr Ngo then refers to various exhibits which he states give confirmation that his UK club used this logo at various times from 1979 to 1984, while the Singapore Association used an entirely different design, which is that numbered 2 in Annex 2.

10

In mid to late 1985 he states that the Singapore Association adopted the mark designed by him in preference to the one they had previously used, and exhibits a letter of 9 October 1987 from them which has the logo incorporated into the letterhead. He states that the Singapore Association had his mark copyrighted as their own under the Singapore law of copyright. He states that this is the mark applied for by the applicants.

15

He then goes on to outline how his club expanded and states that it has been his only source of income since 1991. He had expanded the club to the position where some 300 students regularly trained. International students studying at London University were a source of further expansion when they returned home, and he refers to 150 members who trained in the towns of Kinna and Varberg in Sweden.

20

He exhibits a copy letter from his Solicitor dated 19 October 1994 addressed to the applicants' representatives that the mark would infringe his common law rights and be contrary to the law of passing off, and states that the applicant did not respond to this.

25

Mr Ngo then gives details of a correspondence between himself and the Singapore Association of 1994 in which he was asked officially to affiliate and pay a sum of \$6 Singapore per student per year to the association, an arrangement which he felt unacceptable. In August 1994 he states that he removed Mr Armstrong from his instructorship in his club, following which Mr Armstrong announced his intention to join the Singapore Association. Finally, Mr Ngo states his belief that if the application were to succeed it would be confusing to the martial arts community and members of the public and damaging to his trade and business.

30

35

Mr Ngo also submits statutory declarations from Mr Thomas Hibbert, Mr Timothy Stevenson and Mr David John Benson. It is more convenient to summarise these below, during discussion of my decision.

40

Applicants' Evidence in Chief

Mr Iain Armstrong has submitted a statutory declaration dated 30 January 1997 in which he states that he is the Chairman of the Nam Yang Pugilistic Association United Kingdom branch, which is a branch association of the Singapore Association of the same name. It has as its main object to promote, encourage, organise and develop the "tiger crane combination" form of self defence. He states that the UK Association was formally constituted in 1994 and

45

that before that date the Singapore Association had been represented in the UK by the opponent. He says that the opponent's conduct in the running of the UK branch was unsatisfactory and that he failed to pay a proportion of membership fees to the Singapore Association in accordance with conditions laid down at the time the opponent received
5 consent and approval for the formation of the UK branch.

Mr Armstrong goes on to state that he trained under the instruction of the opponent in 1981/82 and that it was clear to him that the opponent was running a club in the UK as the UK branch of the Nam Yang Pugilistic Association. He states that he became affiliated to the
10 Singapore Association and that it was always understood that the opponent was running a club as a branch and affiliation in the UK, and that he did not have the qualifications or eligibility to run an independent club. He then states that the device of a crane and a tiger are symbolic of and indicate a connection with the Nam Yang Pugilistic Association and that in or
15 about 1979/80 discussions took place between members of the Association about producing a new logo. He says that Mr Anthony Ong produced the original work which constitutes the logo in 1984 and which is the subject of the application for registration. He draws attention to various exhibits which he says confirm this and the status of the UK branch.

The details of the exhibits, where relevant, and the other statutory declarations submitted by
20 the applicant are more conveniently discussed at the relevant points in the decision below.

Decision

At the hearing counsel for both parties concentrated on the section 11 ground of the
25 opposition. However most of the territory covered during cross-examination of the witnesses was about proprietorship. This is understandable, because it is the basis of the opponent's case that he is the proprietor of a mark so similar to the mark applied for that confusion is inevitable. The applicant's case per contra depends on the assertion that the opponent does not
30 own the marks he relies on because he was simply acting as representative of the Nam Yang Pugilistic Association. Accordingly, any rights arising from the opponent's use accrue to the NYPA and not the opponent. So before I can consider whether the opposition under section 11 succeeds I need first to determine who has the better of this argument, and whether the opponent does indeed own the unregistered mark of which he claims to be proprietor.

35 The relevant case law on proprietorship is Al-Bassam 1995 RPC 511. I quote below from Lord Justice Morritt's judgement:

Page 522 lines 8-11:

40 Accordingly it is necessary to start with the common law principles applicable to questions of the ownership of unregistered marks. These are not in doubt and may be shortly stated. First the owner of the mark which had been used in conjunction with goods was he who first used it.

Page 522 lines 40-47

45 In my view it is plain that the proprietor is he who satisfies the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the

purpose indicated in the definition of trade mark contained in section 68 which I have already quoted. Ownership of the mark is a different concept to deceptiveness of the mark, the principles applicable to the two concepts are different and I do not see how one can determine whether there is likely to be confusion without first deciding who is the proprietor.

Page 524 lines 38-42

It is not disputed that a mark may be applied to goods in the United Kingdom on behalf of one who is not physically present in the United Kingdom so that consideration of those authorities rather than the facts of this case does not seem to me to help. Nevertheless it is necessary to consider why the mark was applied and in connection with whose business.

In line with this guidance I need in this case to determine who first used the mark relied on by the opponent in the UK, and in connection with whose business. In relation to the first part of this question, the evidence shows that the opponent used his original mark from at least as early as 1984. I refer in particular to exhibit 8 to the opponent's first statutory declaration, which consists of the original of a certificate of competence in the beginners grade awarded to Sharon Fallon, and signed by the opponent himself and dated 12 March 1984. This is supported by the statutory declaration of Thomas Hibbert, dated 22 July 1996. Mr Hibbert states that he is Hon Secretary of the Amateur Martial Arts Association, which he founded in 1971. At para 4 he states that he has known Mr Ngo and his club for 12 years or so, and that they had always to the best of his knowledge used the mark or logo exhibited at TH1, albeit with very minor stylistic modification. This exhibit is reproduced as Annex 3 to this decision.

Although in his evidence Mr Armstrong, for the applicant, has disputed aspects of the story of how or when the original logo came to be used, there is no dispute that at some stage between 1982 and 1986 the UK club was using as a mark a logo resembling diagram 1 on Annex 2. Thus I am satisfied on the evidence that the club established and run by the opponent first used this mark in the UK.

The question of which business this mark was used in connection with is more difficult, and there is direct conflict of evidence. The issue is whether Mr Ngo was using it on his own account, or whether it was in fact connected with the business of the Singapore Association. This question consumed a considerable amount of time at the hearing and was the subject of most of the cross-examination.

On the one hand Mr Edenborough sought to demonstrate that Mr Ngo was using the mark on his own account, and that any connection between him and the Singapore Association was a loose one. On the other, Mr Campbell argued that Mr Ngo was operating as a UK branch of the Singapore Association and that his use was accordingly in respect of the NYPA. To decide which of these lines of argument is the better one requires me to go into some detail concerning the evidence presented.

In favour of the applicants' case, there is the following evidence.

First, the affidavit of Tan Soh Tin, dated 26 February 1997, states that he is the Secretary of

the Nam Yang Pugilistic Association in Singapore, and that he has held this position since 1969. He goes on to state that in 1979 Mr Ngo applied to the NYPA for its authority to form and run an affiliated branch of the Association in England. He later says that his understanding is that Mr Ngo could not have successfully formed a club in England without the backing and approval of the Singapore Association because he would not have been seen as credible, and could not have obtained insurance cover. It was, he says, an agreed requirement of the formation of the UK branch that student members would pay a small subscription to the SA in return for certain benefits.

10 Next, we have the affidavit of Dougal St Clare Simmons, dated 26 February 1997. He says that he began training in early 1989 under the instruction of Mr Ngo, and continued such training until 1992. During this period, he says he paid an annual subscription fee of initially £15 increasing to £28, and that Mr Ngo informed him that the fee was payable in its entirety to NYPA of Singapore, and conferred the status of member to (sic) that Association, with various benefits, such as international recognition of gradings received, right to use equipment and facilities at the Associations HQ. He goes on to state that he was given to believe he was joining the club founded by Master Ang, the NYPA.

The statutory declaration of Mr Mark Alder, dated 26 February 1997, makes similar points. He states that he has been a student of Chinese Kung Fu since 1991 under the instruction of Mr Armstrong, who he says was between 1991 and 1994 associated with Mr Ngo, who he describes as the then sole representative of the Nam Yang Association, Singapore. He says he paid subscriptions which ranged from £25 to £30 to Mr Ngo, and that he was informed that this was for his membership to (sic) the NYPA. Mr Alder refers to benefits of membership in identical terms to those referred to by Mr Simmons.

Finally there is a statutory declaration dated 28 February 1997 by Mr Chris Ellerker, which states that he is Chairman of the British Council for Chinese Martial Arts (BCCMA), a body which he says regulates Chinese Martial Arts in the UK on the Sports Council's behalf. He says that NYPA is a member of the BCCMA and that he associates the logo in suit exclusively with the NYPA, and that he would expect such activities were directly connected with the NYPA.

Mr Ngo's evidence, on the other hand, both in his statutory declarations, and in cross-examination at the hearing, set out to deny that the link with the NYPA was as strong as a formal affiliation. His statutory declaration states that affiliation in the martial arts world denotes simply mutual respect, and Mr Edenborough submitted that throughout his cross-examination by Mr Campbell, Mr Ngo had remained firm in that position.

40 On Mr Ngo's side in this respect is the statutory declaration by Mr Thomas Hibbert MBE, to which I have referred above. This states that he associates the mark with its use for a long time by the Tiger Crane Combination Kung-Fu club run by Mr Ngo.

There is also the statutory declaration dated 19 July 1996 by Timothy Stevenson, who states that he is a compliance officer employed by the Inland Revenue. He says he has been a member of the Tiger-Crane Combination Kung Fu club since 1981 under the tuition of Mr Ngo and is now a senior instructor. He refers to exhibit TS4, which is a letter sent to him on 2

October 1994 by Tan Soh Tin announcing “**setting up formally and for the first time a UK branch of that Association**” [quotes and bold in original statutory declaration]. However I note that this is not in fact a direct quote from the letter. The relevant section reads, with the grammar as in the original: “We have formally branch out to UK and is in the process of being
5 accepted as an affiliation to the BCCMA. All these have been approved by our committee on the 1/8/94. It shall be known as the Nam Yang Pugilistic Association UK Branch.” Later the letter refers to Mr Ngo and says “His last letter was to withdraw affiliation to NYPA”.

10 There is also an affidavit of Mr David John Benson, dated 17 July 1996, in which Mr Benson states that he has trained under Mr Ngo since 1981, that he has maintained his connection with the club and Mr Ngo, and now holds the position of senior instructor. He explains that he had a role in improving the freehand appearance of the tiger in the mark and that the mark was subsequently adopted by the NYPA with the permission of himself and Mr Ngo for use in Singapore only.

15 Under cross-examination Mr Ngo stuck to the position that his relationship with the Singapore Association was an informal one based on mutual respect and that no affiliation fees were paid by his club to NYPA. He denied that he collected affiliation fees intended for the NYPA, and he also denied having discussed the purpose or destination of the subscription fees with the
20 former students Messrs Simmons and Alder. However during cross-examination by Mr Campbell this proved a difficult position to sustain. Two items of evidence in particular to which Mr Campbell referred appear to contradict Mr Ngo’s version of events. First, a set of accounts for the year ending 31 December 1989 exhibited to Mr Ngo’s first statutory declaration refer under “expenses” to a sum of £767 for “Affiliation Fees (Singapore)”.
25 Second, in a letter of 15 August 1994, which was part of a bundle of correspondence attached to Mr Tan’s affidavit, Mr Ngo asked in a final sentence “I am still waiting for the receipt for last year’s affiliation”. I was not persuaded by Mr Ngo’s attempts to explain these and other examples away.

30 What conclusions can be drawn from this evidence, which is unclear on the key point, and contains many conflicts?

In my view the opponent’s strongest point is the evidence that in 1984 the NYPA had a
35 different logo mark - which by agreement was identified as diagram number 2 in Annex 2. If Mr Ngo was indeed operating as the representative of the NYPA, it seems unlikely that he would have chosen a different device mark. And if the mark applied for was devised with the intention of identifying a single international organisation it seems odd that the UK club should design a variant logo in 1985/86 for their use in the UK. Furthermore, the only certificate issued in the UK and produced in evidence is from 1984 - DKNS8 - and is signed by the
40 opponent and carries his original mark - the one numbered 1 in Annex2. It makes no reference to the NYPA, as one would expect it might if he were indeed providing instruction services on their behalf in the UK.

45 There is no doubt that the club run by the opponent was in some way associated with the NYPA. The dispute over the affiliation fees shows that there was some connection and the evidence from the students shows that they thought they were paying affiliation fees for certain rights in the NYPA. But the evidence does not amount in my view to proof that he

presented the UK club as a branch of the NYPA - as part of their business. It seems clear to me on the evidence that the students initially became clients due to the initiative of Mr Ngo in starting a club in London - indeed there is no evidence that anyone became a member other than through these efforts. I do not believe it is likely that most of these students had before
5 that heard of the NYPA, or joined the club with the primary purpose of affiliating to it. There is no suggestion that Mr Ngo ever used the NYPA name as part of his club's name, which consisted of various permutations of the terms tiger crane and kung fu. They joined in order to learn a certain kind of martial arts. Once they joined, they and others paid various fees, including fees that they thought were being paid to the NYPA in order to receive benefits such
10 as insurance and support facilities. I do not think it matters for this purpose whether or not the affiliation fees were actually handed over. It is clear that at various times both Mr Ngo and the NYPA suffered financial hardship and that the question of the payment or otherwise of the affiliation fees became a bone of contention. It appears to have been this dispute that led the NYPA to adopt formal rules in 1994, and to write to the opponent with these and details
15 of the affiliation fees requested. It appears to have been an invitation to him to put his relationship with them on a more formal footing, but this was more than 10 years after he founded the UK club. There is no evidence as to the previous constitution and rules of NYPA and what affiliation meant to this organisation. The best conclusion therefore seems to me that the relationship between the parties was based on a loose agreement to affiliate. The fact
20 that the formal request was made so long after the formation of the UK club in my view supports the opponent's assertion that his business was in reality his own and separate from theirs.

I do not think that the fact that Mr Ngo needed certificates of affiliation in order to start his
25 business undermines this. People who wish to be instructed in any kind of skill, particularly one where safety may be an issue, naturally wish to see evidence of someone's competence to instruct, and be assured that they have insurance cover. This does not mean that they regard themselves as the clients of the organisation who has certified that competence or the facilities to which they were entitled.

30 Accordingly my conclusion on this point is that the opponent was the first to use the mark in the UK, and that it was primarily in respect of his own business.

35 Having determined that the opponent is indeed the proprietor of the unregistered mark, I can now turn to the question of whether the ground of opposition under section 11 succeeds.

Despite the volume of evidence and the extensive cross-examination, it was not in dispute that the mark originally used by the opponent and that applied for would were confusingly similar. If the opponent were to continue using his mark, as evidently it was his intention to do, there
40 can be no doubt that use also by the applicant would cause confusion or deception because people would be likely to assume that the services were being provided by the same person.

I note at this stage that the words "Tiger Crane Combination" and the device of a tiger and crane are descriptive. This means that the distinctive character of the mark is somewhat
45 slender and arises only from the particular form of presentation of the tiger and crane. The presentation of the opponent's mark and the mark applied for are so similar as to lead inevitably to confusion if used as trade marks by separate organisations.

Although the evidence contains conflicts and lacks clarity on key points I have to bear in mind that under the old law the onus is on the applicant to show that his use of the mark will not lead to confusion. I do not think he has discharged this onus, and I accordingly find that the opposition succeeds under section 11.

5

The question of copyright in the mark was also a subject of conflict. It was not formally pleaded, although some time was taken up hearing evidence on the point. It is however not material to the decision because I have determined that the opponent had the first use of a conflicting mark. Had the mark not been used, this might have been relevant. To quote again the guidance in Al-Bassam:

10

page 522 lines 25-27:

Third, in the case of an unused mark the person with the best right to use it was the designer or inventor.

15

As I have found in favour of the opponent under one of the mandatory statutory provisions the question of the Registrar's general discretion under section 17(2) does not arise.

20

Finally, I come to the matter of costs. Since the opponents have been successful they are entitled to a contribution towards their costs. I have to take into account not just the normal preparation of submissions and evidence, but also the fact that the lead declarants from both sides attended in person and were subject to cross-examination. At the hearing it was put to me that Mr Armstrong, the applicant, wished to have paid a sum for loss of earnings due to the attendance, his travel expenses having been settled. Agreement was not reached between the parties on this element and I was invited to settle the matter. However since the opponent has succeeded in these proceedings, it is not Mr Armstrong who is entitled to his costs, and I therefore see no need to issue a direction on this aspect. I accordingly order the applicant to pay the opponent the sum of £1000, which includes an element for Mr Ngo's attendance in person.

25

30

Dated this 4th day of November 1999

35

P H LAWRENCE

40

For the Registrar
the Comptroller-General

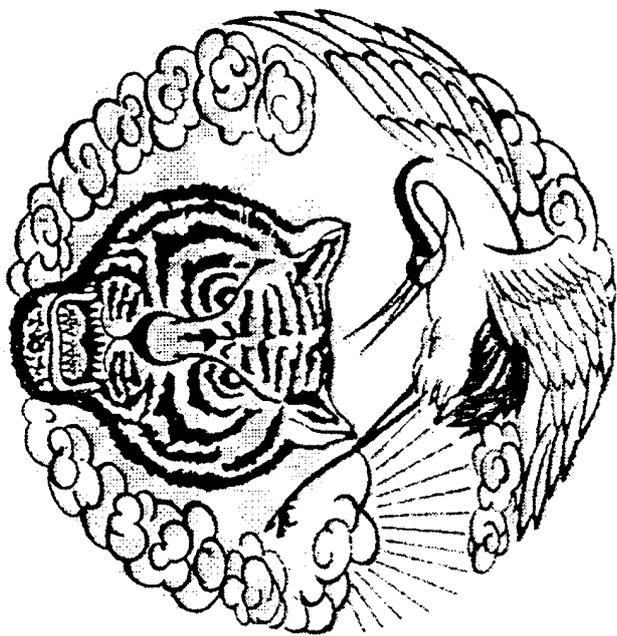


IMAGE FOR TRADE MARK NUMBER:1585466

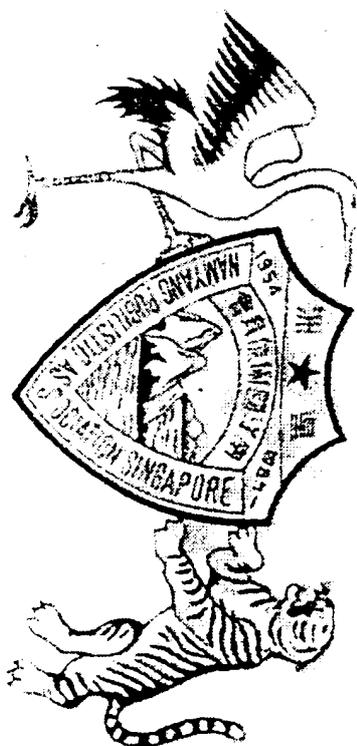
1



3



2



南洋

4



