

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

[2022] SGIPOS 16

Trade Mark No. T0913773I

**IN THE MATTER OF A TRADEMARK REGISTRATION BY
SYMPHONY HOLDINGS LIMITED**

... Registered Proprietor

AND APPLICATION FOR REVOCATION THEREOF BY

SKINS IP LIMITED

... Applicant

GROUND OF DECISION

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Skins IP Limited
v
Symphony Holdings Limited

[2022] SGIPOS 16

Trademark No. T0913773I
IP Adjudicator Murgiana Haq
25 August 2022


23 November 2022

IP Adjudicator Murgiana Haq :

Introduction

1 It is vital for a purchaser of a trade mark registration to secure from the seller evidence of all prior use. In this revocation, the purchaser (who became the registered proprietor) would have been better placed to defend its registration had it done so at the time of purchase. It would also help to prevent a third party, aware of this weakness, from seizing the opportunity to revoke the trade mark registration for non-use.

2 This is a revocation action on the grounds of non-use against the following trade mark registration:

Trade Mark No.	Mark	Class	Specification
T0913773I	 ("the SKINS Mark")	10	Surgical and medical garments; pressure garments and devices; compression garments and devices; therapeutic compression garments; stockings for medical and therapeutic use; elastic supports, including elastic supports for stabilising injured areas of the

			body; all being goods in Class 10.
		18	Bags, including bags of leather and imitation leather; athletic bags; beach bags; backpacks; handbags; backpacks incorporating hydration packs; knapsacks; luggage; purses; wallets; key cases; satchels; shoulder bags; sports bags [other than adapted (shaped) to contain specific sport apparatus]; ball bags [other than adapted to contain specific sports apparatus]; bottle bags; boot bags; cricket bags [other than adapted to contain specific sports apparatus]; duffle bags; draw-string bags; football bags [other than adapted to contain specific sports apparatus]; gear bags [other than adapted to contain specific sports apparatus]; gym bags; holdalls; sports kit bags [other than adapted to contain specific sports apparatus] and team bags; travelling bags.
		25	Clothing, footwear, headgear; including clothing for men, women, children and babies; clothing for sports including football, gymnastics, cycling, golf and skiing; clothing for motorists and travellers; underwear including compression underwear; outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, T-shirts, pants, trousers, shorts, pyjamas, dressing gowns,

			bath robes; swimwear including bathing trunks and bathing suits; thermal clothing; wetsuits; waterproof clothing; sweatbands for the wrist; shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots; socks, stockings, tights; bandannas and headbands.
		28	Articles for use in exercise and other sporting activities including articles that support or enhance the body in sporting activities; protective padded articles for men, women, children and babies, all for use in playing a specific sport; sports articles, namely, protective pads or guards; sports guards including shin pads, knee pads and elbow pads; bags adapted for sporting articles; golf bags.

Procedural history

3 On 26 August 2019, Skins IP Limited (“the Applicant”) filed an application for revocation of the registration of TM No. T0913773I for the SKINS Mark on the grounds of non-use. The registered proprietor, Symphony Holdings Limited (“the Registrant”) filed its Counter-statement and evidence in support on 26 December 2019. The Applicant filed its Amended Statement of Grounds on 28 July 2020 and the Registrant filed its Amended Counter-statement on 11 August 2020.

4 The Applicant filed evidence in support of the application on 10 December 2020. On 4 June 2021, the Registrant filed further evidence in

support of maintaining the registration. The Applicant filed its evidence in reply on 3 August 2021. A Pre-Hearing Review was held on 1 September 2021. Further to the Pre-Hearing Review, the Registrant made a request for permission to file further evidence. Permission was granted and the Registrant filed its further evidence on 29 December 2021. Following that, the Applicant made a request for permission to file evidence in reply to the Registrant's further evidence filed on 29 December 2021. Permission was granted and the Applicant filed its further evidence in reply on 24 March 2022. The matter was set down for a full hearing on 25 August 2022 after it became clear that parties wanted the dispute to be adjudicated.

5 The Applicant elected not to attend and present oral submissions at the hearing and requested the matter to be decided on its Written Submissions. The hearing proceeded with oral submissions by the Registrant only.

Grounds of revocation

6 The Applicant relies on Section 22(1)(a) and (b) and Section 22(6) of the Trade Marks Act 1998 ("the Act") in this revocation.

Applicant's evidence

7 The Applicant's evidence comprises the following:

- (a) a Statutory Declaration made by Steven John Lane, Trade Mark Attorney of the Applicant, on 8 December 2020 in London;
- (b) a Statutory Declaration in Reply made by the same Steven John Lane on 27 July 2021 in London; and

- (c) a further Statutory Declaration in Reply made by the same deponent on 23 March 2022 in London.

Registrant’s evidence

8 The Registrant’s evidence comprises the following:

- (a) a Statutory Declaration made by Benjamin Fitzmaurice, Chief Operating Officer of the Registrant, on 24 December 2019 in Switzerland;
- (b) a Statutory Declaration made by Lim Lit Yuen, Business Development Manager of Leonian Singapore Pte. Ltd., on 31 March 2021 in Singapore;
- (c) a further Statutory Declaration made by the same Benjamin Fitzmaurice, on 23 December 2021 in Switzerland (“Further SD”); and
- (d) a further Statutory Declaration made by the same Lim Lit Yuen, on 17 December 2021 in Singapore.

Burden of proof

9 Under Section 105 of the Act, to defend its registration, the Registrant has the burden of showing the use made of Trade Mark No. T0913773I for the SKINS Mark in Singapore.

Ground of revocation under Section 22(1)(a) and (b)

10 Section 22(1)(a) and (b), (2), (3), (4) and (6) of the Act reads:

- (1) The registration of a trademark may be revoked on any of the following grounds:

(a) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use.

(b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use.

...

(2) For the purposes of subsection (1), use of a trademark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered and use in Singapore includes applying the trademark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes.

(3) The registration of a trademark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the 5-year period and before the application for revocation is made.

(4) Any commencement or resumption of use referred to in subsection (3) after the expiry of the 5-year period but within the period of 3 months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(6) Where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation must relate to those goods or services only.

Relevant dates

11 The relevant dates under consideration are as follows:

(a) **Section 22(1)(a):** The registration procedure was completed on 20 May 2011. The 5-year period immediately following the completion of registration ended on 20 May 2016. Thus, the period of use (or non-use) in issue is **21 May 2011 to 20 May 2016** (the “First 5-Year Period”).

(b) **Section 22(1)(b)**: Non-use for 5 consecutive years before the revocation application which is **26 August 2014 to 25 May 2019** (excluding the 3 months immediately preceding the revocation application) (the “Subsequent Period”).

12 In its Amended Statement of Grounds, the Applicant did not state the period of non-use it relied on under Section 22(1)(b). The Registrant raised this lack of information in its amended Counter-statement, written submissions and at the hearing with the result that it had to file evidence for both periods under Section 22(1)(a) and (b). The period of non-use under Section 22(1)(b) was only identified by the Applicant for the first time in its written submissions.

13 In its submissions, the Applicant combined the First 5-Year Period under Section 22(1)(a) with the Subsequent Period under Section 22(1)(b) and called it the “Relevant Period”. As Section 22(1)(a) and (b) are separate grounds, I shall treat the two grounds separately. I shall approach the revocation by first proceeding with the ground under Section 22(1)(b) as its outcome would determine the application for revocation under Section 22(1)(a).

Legal principles

14 The applicable legal principles are set out below.

(i) There must be genuine or *bona fide* use of the trade mark in relation to the goods (or services), in the course of trade, within the relevant time periods. There is no real or practical difference between the terms *bona fide* use and *genuine* use. (See *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919 (“*Nike*”) at [15].

(ii) For use of a trade mark to be considered genuine, it does not have to be significant in the qualitative sense, provided it was in accordance

with the essential function of a trade mark, which is to guarantee trade origin. However, token use for the sole purpose of preserving the rights conferred by the mark or use which is just internal use by the proprietor concerned is not genuine use. (See *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 [38]-[39] and *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 ("*Weir Warman*") at [99]-[100].)

(iii) There is no rule that *de minimis* use cannot constitute genuine use. No one single objective formula which applies to all situations can be laid down; much would depend on the fact situation in each individual case. (See *Wing Joo Loong* at [43].)

(iv) The fewer the acts of use relied on, the more solidly they need to be established. One single use of the mark could satisfy the test provided that overwhelmingly convincing proof of the act is adduced. (See *Nike* at [15].)

Background

15 The SKINS Mark was first registered by Skins International Trading AG, a Swiss company (the "Former Owner"). In January 2019, the Former Owner filed for bankruptcy and a Trustee was appointed to liquidate its assets which included the SKINS Mark under Trade Mark No. T0913773I in Singapore. On 31 July 2019, the Trustee sold the SKINS Mark together with the goodwill of the business to the Registrant. A few weeks later, on 26 August 2019, the Applicant filed its application to revoke the registration of the SKINS Mark in Singapore.

16 The Registrant produced a copy of a distribution agreement dated 15 May 2013 (the “Distribution Agreement”) between the Former Owner and its then distributor Transview Lifestyle Pte Ltd (“Transview Lifestyle”), a Singapore company. This Distribution Agreement covered the period 1 July 2012 to 30 June 2015 for 7 countries including Singapore. The Distribution Agreement also referred to an older distribution agreement from 1 February 2010 to 30 June 2012. Under the Distribution Agreement, the minimum purchase for Singapore alone was USD1,240,000 worth of goods. The minimum doors (sales channels) for Singapore were 132, which was the third highest in the region. The Applicant criticised that the Distribution Agreement itself was not conclusive as it did not show that the orders were fulfilled.

17 This Distribution Agreement was witnessed by Benjamin Fitzmaurice (“Fitzmaurice”) who was the Chief Executive Officer of the Former Owner. In November 2019, Fitzmaurice joined the Registrant as its Chief Operating Officer of the SKINS division of the Registrant. He was able to assist with information of use made by the Former Owner and executed two statutory declarations¹. In his Further SD, Fitzmaurice said that the SKINS Mark was applied onto the goods and their packaging. The Former Owner first used the SKINS Mark in Singapore in 2010. He confirmed that he had witnessed the signing of the Distribution Agreement to support his involvement and knowledge of the business of the Former Owner.

18 The Registrant also submitted evidence by Lim Lit Yuen (“Lim”), who was formerly the Business Development Manager of the Former Owner’s first distributor, Transview Lifestyle in Singapore. When Transview Lifestyle was

¹ [8] above

acquired by Leonian Singapore Pte Ltd (“Leonian”) who took over the distributorship, Lim became Leonian’s Business Development Manager.

19 Lim explained that they were handicapped in their search for past records as Transview Lifestyle did not keep its records after it was acquired by Leonian. Leonian also had changed to a new accounting system and it, too, did not retain all the old records.

20 Lim said he worked closely with Fitzmaurice since 2014. The main product line of the SKINS brand is compression wear, a type of tight-fitting clothing worn during or after exercise or sports or other strenuous activities and which is also used in the recovery process. SKINS brand was one of the pioneers of compression wear. The SKINS Mark is also used for a supplementary line of bags, such as hold-alls, back packs, duffle bags, sports bags. Most of these bags were given as gifts items with purchases of SKINS main products.

21 Lim was personally responsible for distributing SKINS products in Singapore and South-East Asia. He confirmed that the SKINS Mark was applied directly on the products and on their packaging. He referred to advertisements which showed the positioning of the SKINS Mark on various items, such as to the thigh portion of a pair of tights.

22 According to Lim, around 2011 and 2012, Leonian would order from the Former Owner 20,000 to 22,000 units of SKINS goods per year. Leonian alone would spend around USD750,000 to USD825,000 a year on SKINS goods shipped to Singapore. At its lowest, Leonian would order from the Former owner 7000 to 8000 units of SKINS goods per year in 2014 and 2015, amounting to USD250,000 to USD300,000 a year. Some of the goods would be distributed in Singapore and the rest to South-East Asia. Leonian continued to

order SKINS goods to Singapore in 2016 and 2017. When the Former Owner ran into financial difficulties, there was less marketing support and sales in Singapore.

Registrant's evidence of use

23 To prove bona fide use during the Subsequent Period, the Registrant produced the following:

Proof of Sales from Former Owner to Leonian

(a) Invoice No:104683 dated 1 December 2016 from the Former owner to Leonian for SKINS men and women's clothing amounting to USD22,646.50.

(b) Invoice No: IT SG 20170419 dated 26 May 2017 from Former Owner to Leonian for SKINS clothing amounting to USD31,282.00.

Proof of sales to third parties

(c) Invoice No: SIV-L16000713 dated 21 July 2016 from Leonian to Weston Corporation in Singapore

(d) Invoice No: SIV-L17000442 dated 16 March 2017 from Leonian to Joka Sports LLP for SKINS men's tights and tops

(e) Invoice No: SIV-0090002867 dated 3 January 2018 from Leonian to Joka Sports LLP for various types of SKINS men' tights and tops

(f) Invoice No: SIV-0090002058 dated 9 January 2018 to Lee Chee Hao of Eunus Primary School for SKINS women long black tights

E-commerce promotions

- (g) Joka Sports LLP’s Facebook photo in 2015 showing they were selling SKINS products
- (h) The Former Owner’s website at <http://store.skins.net> showing screenshots on 18 March 2015 and 10 August 2015
- (i) Running Lab’s Facebook pages from 13 June 2014 to 19 October 2017.

Standard of proof

24 The standard of proof is based on the balance of probabilities. The Registrant is not required to provide “*conclusive or overwhelming convincing proof*” as alleged by the Applicant. I need decide on the overall evidence produced by the Registrant, whether on the balance of probabilities there was genuine use of the trade mark by the Registrant in Singapore during the Subsequent Period. The Registrant had to rely exclusively on the use made by the Former Owner as it had acquired the trade mark shortly before the revocation application was filed. It claimed it was handicapped in its investigations for evidence of past use as it had no access to the data and documents secretly retained by the Former Owner.

Analysis

25 The Registrant’s evidence must be examined in the context of the analytical framework of the 5 Ws issues namely, “Which” “What” “Where” “What” and “Who”, used recently in *Technopharma Limited v Unilever Plc* [2021] SGIPOS 11 to determine if the criteria for revocation on the ground of non-use under Section 22(1)(b) is met.

The “Which” issue: Whether the SKINS Mark has been used in relation to the specified goods

26 Under the “Which” issue, I considered whether the SKINS Mark has been used in relation to the goods listed in [2] above.

27 The Registrant referred to use of the SKINS Mark on the First Owner’s website, <http://store.skins.net/> showing screenshots on 18 March 2015 and 10 August 2015 which it obtained using the digital archive tool Wayback Machine. The latter enables users to see archived versions of past webpages. The Registrant explained that these webpages are representative only and not exhaustive as the WayBack Machine has its limitations and is unable to archive every hyperlink on every page. These webpages showed various products for sale including compression apparel for men and women. The SKINS Mark appeared on the top left corner of each webpage. The SKINS Mark is also depicted affixed to the thigh portion of the compression tights, on the sleeves of compression tops, and on the side rib of a sports bra. These screenshots suffice to show the use of the SKINS Mark on goods such as compression garments, sports bras, exercise tights and shorts, tops, calf tights, jerseys, socks, and other products which I shall enumerate when I deal with partial revocation further down.

28 The products on which the SKINS Mark was used included the product series “A200”, “A400”, “C400” and “Essentials”, all of which were set out in Schedule 2 in the Distribution Agreement. The invoices issued by the Former Owner to Leonian referred to “A400” and SKINS. The invoices from Leonian to Weston Corporation, Joka Sports and Lee Chee Hoa referred to “A400”, “Essentials” and “A200”. The photographs on Joka Sports’ Facebook page referred to “A200”, “A400” and SKINS. The Registrant conducted a matching exercise following the case of *Bigfoot Internet Ventures Pte Ltd v Athleta*

(ITM) Inc. [2018] SGIPOS10 (“*Bigfoot*”). In *Bigfoot*, the order confirmation did not point to the use of the trade mark in relation to the goods. The Tribunal relied on a sampling of online product listings showing the product name, price and photograph and found that they corresponded to the items order. The Tribunal was persuaded that the transactions related to the goods bearing the trade mark.

29 The same matching exercise was undertaken by the Registrant to show that the product listing matched the invoiced items. For example, “A400” long tights corresponded with invoiced item “SKINS A400 Men’s’ long tights”. The Registrant has produced sufficient proof that the SKINS Mark was indeed applied to various types of compression garments, some types of clothing and bags. However, the SKINS Mark has not been used on the rest of the goods listed in [2] above.

The “What” issue: Whether there has been use in Singapore either in the form registered or in forms which does not alter the distinctive character of the registered form of the SKINS Mark

30 The mark in use was  whereas the SKINS Mark is registered as .

31 Section 22(2) explains that “*use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered*”. It is apparent that the differences in the two marks above are minor and do not alter the distinctive character of the registered SKINS Mark. The distinctive elements of the mark lie in the representations of the stylised letter “S” and the word SKINS, which are

retained in both versions. The mark as used did not alter the distinctive character of the registered form of the SKINS Mark.

The “Where” issue: Whether the SKINS Mark has been used in Singapore

32 The Registrant relied on the Former Owner and some of its retailers’ websites whereby direct on-line purchases could be made by customers in Singapore. It is settled law that where a Registrant refers to use on websites, active steps must be taken by the Registrant to target consumers in Singapore. Such “active steps” could take the form of “*direct encouragement or advertisement by the trade mark owner which led customers to the website featuring the trade mark in question*” (*Novelty Pte Ltd v Amanresorts Ltd and anor* [2009] 3 SLR(R) 216 at [54]).

33 The delivery tab on the Former Owner’s website <http://store.skins.net> shows that Singapore is one of the 10 countries from which on-line orders could be made and delivered. Singapore customers could place direct on-line orders with the Former Owner at the time. Active steps were taken by the Former Owner through this website to encourage direct sales with them. The Registrant referred to a Google Analytics report which showed 32,820 Singapore customers visited the site and 223 e-commerce transactions were made, generating a revenue of £23,818.59 from 1 January 2016 to 31 December 2018. The Applicant criticised the credibility of this report and referred to an article by freelance blogger Carlos Escalera and two forum discussions on the topic of fake visitor data. The Registrant explained that such an allegation is unjustified as the author was in fact telling readers that the bots and spams can be stopped by the pre-built-in filters in Google Analytics itself.

34 The Applicant pointed out that the Google Analytics report did not show what was purchased, nor did it show the trade mark on the goods and whether any of the transactions resulted in the goods being shipped to Singapore.

35 Applying *Weir Warman*, I find that this is not necessary as the High Court observed that “*genuine use can be established even if there is no evidence of actual sales*”. It is insignificant that there was no evidence that the goods were indeed shipped to Singapore. The Former Owner’s website did directly encourage customers in Singapore to make their purchase of the Former Owner’s goods and because of the Former Owner’s encouragement and advertisements, the SKINS Mark may already be in the minds of the Singapore customers.

36 Taking the totality of the evidence such as number of website visitors, the volume of transactions, the revenue generated and the delivery option of Singapore, it is reasonable to infer there were sales of SKINS products to Singapore.

37 I refer to the various invoices from the Former Owner to Leonian and from Leonian to various established sports goods retailers, such as Weston Corporation and Joka Sports, with billing addresses and physical stores in Singapore; and Running Lab’s Facebook pages from 13 June 2014 to 19 October 2017. The usefulness of Facebook pages was recognised in *Aussino International Pte Ltd v Aussino (USA) Inc.* [2019] SGIPOS 18 at [42]. The Tribunal was of the view that evidence which comprised of information taken from Facebook pages was reliable for the purpose of showing use of the mark in Singapore as it serves as a means of communication between a business and its customers: “*It is therefore likely to be accurate and accountable ... for the*

information which the Proprietor seeks to rely on ... such as, the products it sells, the promotions it currently rely on and the location of its stores”.

38 Taking the totality of the evidence, which in this matter was essentially of the Former Owner’s use, obtained through third parties and its website, the balance of probabilities favours the Registrant that there was bona fide use of the SKINS Mark in Singapore.

The “When” issue: Whether the SKINS Mark was used during the Subsequent Period

39 The Registrant relied on the evidence of use for the following years:

2015
Archived screenshots of 18 March 2015 and 10 August 2015
2016
Commercial Invoice dated 21 July 2016 from the Former Owner to Leonian
Tax Invoice 1046583 dated 1 December 2016 issued by Former Owner to Leonian Singapore
Tax Invoice SIV-L 6000713 dated 21 July 2016 from Leonian to Weston Corporation
2017
Commercial Invoice IT -SG 2017419 dated 26 May 2017 issued by the Former Owner to Leonian
Tax Invoice dated 18 March 2017 issued by Leonian to Joka Sports LLP

2018
Tax invoice SIV-L 0090002007 dated 3 January 2018 issued by Leonian Singapore to Joka Sports LLP
Tax invoice dated 9 January 2018 issued by Leonian to an individual Lee Chee Hao
Running Lab's Facebook pages from 13 June 2014 to 19 October 2017

40 The Applicant criticised that the quantities in these transactions were low. For the use of a trade mark to be genuine, it does not have to be significant in the qualitative sense provided it was in accordance with the essential function as a trade mark, which is to guarantee trade origin. *“While there is no rule barring de minimis use from being regarded as genuine use, no one single objective formula which applies to all situations can be laid down; much would depend on the fact situation in each individual case”*: **Wing Joo Loong** at [43]. The fact situation in this matter is that the Registrant was hampered by the difficulty in obtaining evidence from the Former Owner. It was fortuitous that it obtained the assistance of two key personnel of the Former Owner and its distributor respectively. Although the quantities in these invoices are rather low, there is nothing to suggest that they were other than bona fide transactions.

41 I am accordingly satisfied that the SKINS Mark was used during the Subsequent Period.

The “Who” issue: Whether the SKINS Mark has been used by the Former Owner or with its consent

42 To show that there was genuine use during the Subsequent Period, the Registrant relied on the transactions from the Former Owner to Leonian; and

from Leonian to Weston Corporation and Joka Sports respectively. The Applicant said that these invoices should not be taken into consideration, unless they are verified by the parties concerned.

43 The mere fact that there is no communication with the end user is not a fatal issue. Even the use of the mark in promotional materials may amount to genuine use of the mark: *Baidu Europe B.V. v Baidu Online Network Technology (Beijing) Co., Ltd* [2021] SGIPOS 8 (“*Baidu*”).

44 On an overall assessment of the six invoices and applying the test of the balance of probabilities, the transactions were genuine and suffice to demonstrate that the Former Owner supplied Leonian with SKINS products for distribution (on-line and physical) to Singapore retailers, namely Weston and Joka Sports. The six invoices are convincing proof of genuine use in Singapore with the consent of the Registrant’s predecessor-in-title during the Subsequent Period.

45 The Applicant also attacked the credibility of Fitzmaurice and Lim and the veracity of their evidence. The Registrant pointed out that it had repeatedly offered Fitzmaurice and Lim for cross-examination so that their credibility could be tested but the Applicant persistently declined. It is now not open to the Applicant to invite the Tribunal to disbelieve these witnesses (*Fox Racing, Inc. vs Fox Street Wear Pte Ltd* [2014] SGIPOS 13). There is no legitimate basis to not accept the evidence of these two deponents.

Conclusion on use

46 After assessing the totality of the evidence, I conclude that on the balance of probabilities, there was genuine use of the SKINS Mark in

Singapore, in relation to some of the goods listed at [2] above, with the consent of the Former Owner, during the Subsequent Period.

Revocation under Section 22(1)(a)

47 Having concluded that there was genuine use of the SKINS Mark during the Subsequent Period which is sufficient to defend the SKINS Mark registration, it is no longer necessary to consider the application to revoke for non-use under Section 22(1)(a) except for the purpose of deciding the Applicant's request for the effective date of revocation to be made retrospectively to the date of the expiry of the First 5-Year Period following the completion of the registration procedure, which I shall address later.

Partial Revocation under Section 22(6)

48 The Applicant's Amended Statement of Grounds stated at [4]:

Further and in the alternative, the Applicant makes this application for revocation of Trademark Registration No. T0913773I on the basis that the subject mark has not, *within the period of 5 years following the date of completion of the registration procedure*, been put to genuine use in the course of trade in Singapore by the Registrant or with its consent, in relation only to *some of the specified goods*, and there are no proper reasons for non-use.(emphasis is mine)

The Applicant specifically pleaded revocation in respect only of the registered goods not used during the 5 years following the completion of the registration procedure.

49 Partial revocation is allowed under Section 22(6) which provides:

Where grounds of revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation must relate to those goods or services only.

50 Section 22(6) applies only where there is a ground for revocation and does not refer to any specific period. Nevertheless, the Applicant had qualified its claim to refer to the period of 5 years following the completion of the registration procedure. The 5 years in question are from 21 May 2011 to 20 May 2016, as [11(a)] above defines the “First 5-Year Period”. The Applicant sought to revoke some of the goods not used during that period. The Applicant offered no explanation for its limited request. It is foreseeable that although a Registrant may not have used the registration on some of the goods within the First 5-Year Period, it could start using the mark on those goods during the years preceding the revocation application. The Applicant did not address this nor offered any explanation why its request is limited to the first 5 years. In this revocation, the Registrant has proved that there was bona fide use during the Subsequent Period. If indeed the request for partial revocation is intended to refer to non-use of some of the goods for the Subsequent Period, this unfortunately was not pleaded. It is unfortunate the Applicant’s counsel was not present to address this ambiguity and missed the opportunity to clarify its position.

51 As I have reached the conclusion that there was bona fide use under Section 22(1)(b), I shall now consider whether “*the grounds for revocation exist in respect of only some of the goods ... for which the trade mark is registered*”.

52 When considering whether there can be revocation for some of the goods as registered, I need be “*sensitive to the legitimate expectations of users of the trademark registration system “as it involves a direct interference with the pre-existing rights” (The Patissier LLP v Aalst Chocolate Pte Ltd [2019] SGIPOS 6 (“Patissier”) at [75]*).

53 “*If ... a tribunal had a completely free hand to amend the wording of these specifications in an unrestrained manner, the operational integrity of the*

trade mark registration system would almost certainly be jeopardised” (Patissier at [77]). The primary purpose of partial revocation is to achieve a “fair specification” which would still give the Registrant a “commercially sensible zone of activity” (Patissier at [77]). A fair specification may be arrived after giving “due consideration” to the “concerns of the applicant, the legitimate expectations of the trade mark proprietor, as well as the interests of the public. The public interest includes the interest of customers and trading community for whose benefit the registered trade mark serves as a badge of origin” (Patissier at [73]).

54 Our Courts in Singapore have taken a rather conservative approach towards partial revocation. In **Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co)** [2003] 4 SLR(R) 92, the High Court refused to restrict the registrant’s registration for “*men’s undergarments, briefs, socks, men’s sports clothing, knitwear, singlets, swimwear, all included in class 25*” to a narrower specification of goods, even though the registrant had used the trade mark only in respect of “*socks, briefs, singlets, t-shirts and swimwear.*” Woo Bih Li J held that “*it was not in the interest of the public or trade to try and narrow the description of the clothing ... further to the categories for which the registered trade mark was in fact used. To do so would result in confusion and invite litigation*”.

55 Applying the above principles, I shall assess whether there were registered goods not used under each class.

Class 10

56 The registered goods in this class are:

Surgical and medical garments; pressure garments and devices; compression garments and devices; therapeutic

compression garments; stockings for medical and therapeutic use; elastic supports, including elastic supports for stabilising injured areas of the body; all being goods in Class 10.

57 Elaborating on my analysis on the “Which” issue from [26] to [29] above, I find the Registrant has furnished evidence of genuine use for “*pressure garments and devices, compression garments and devices, therapeutic compression garments*” (which were the main products of the Former Owner produced from the very beginning) such as SKINS A200 Men & Women compression apparel, SKINS A200 Compression long tights. “SKINS Compression” was also advertised in Running Lab’s Facebook page exhibited in the Registrant’s Further SD, and the SKINS Mark is shown in product listings on the website <http://store.skins.net> and various SKINS tights are referred to in invoices and Schedule 2 of the Distribution Agreement. “*Compression garments*” may also be described as “*medical garments*” as these are used to prevent oedema and improve recovery, and to alleviate muscle pain after sports.

58 Use for “*stockings for medical and therapeutic use; elastic supports, including elastic supports for stabilising injured areas of the body*” is supported by the products described as “*Essential Sox*”, “*Essential Calfights mx*” and “*G400 Calfights with stirrups*” in Schedule 2 of the Distribution Agreement and the website www.skinscompression.com. The product SKINS DNAmic Mens L/S Top Leviathan/Atmos appeared on the website of internet retailer at sportsbrands24.de where the product was described “*as built to reduce body muscle fatigue by providing support to one’s core, back, shoulder and arms*”.

59 Although there is no evidence of use for “*Surgical ... garments*”, a fair specification considering the legitimate private and public interest would retain “*surgical garments*” in Class 10.

60 Accordingly, the Class 10 specification should remain in its entirety.

Class 18

61 The specification in this class reads:

Bags, including bags of leather and imitation leather; athletic bags; beach bags; backpacks; handbags; backpacks incorporating hydration packs; knapsacks; luggage; purses; wallets; key cases; satchels; shoulder bags; sports bags [other than adapted (shaped) to contain specific sport apparatus]; ball bags [other than adapted to contain specific sports apparatus]; bottle bags; boot bags; cricket bags [other than adapted to contain specific sports apparatus]; duffle bags; draw-string bags; football bags [other than adapted to contain specific sports apparatus]; gear bags [other than adapted to contain specific sports apparatus]; gym bags; holdalls; sports kit bags [other than adapted to contain specific sports apparatus] and team bags; travelling bags.

62 Lim had deposed that bags, such as drawstring bags, backpacks, gym bags, duffel bags, hold-alls, and other sports-related bags which could be used for storage of sports equipment, under the SKINS Mark were given away as promotional gifts during the Subsequent Period.

63 Promotional goods, other than sales, would come under other activities which can amount to genuine use (*Baidu* at [39] referring to *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon at [25.3.18 and [25.3.19]) as its purpose is to support the main product line. It is reasonable for an owner of sports apparel to also sell various sports bags which are products which fall within a commercially sensible zone of activity. Therefore, except for “*handbags*”, “*luggage*”, “*purses*”, “*wallets*”, “*key cases*”, “*shoulder bags*” and “*travelling bags*”, the rest of the registered goods in Class 18 could be described as goods of the same description as they are various sports-related bags.

64 The items “*handbags*”, “*luggage*”, “*purses*”, “*wallets*”, “*key cases*”, “*shoulder bags*” and “*travelling bags*” cannot be described as goods of the same description as bags for sports, and therefore, in the absence of evidence of use on these goods, they should be removed from the Class 18 specification.

65 The remaining Class 18 specification should then read:

Bags, including bags of leather and imitation leather; athletic bags; beach bags; backpacks; backpacks incorporating hydration packs; knapsacks; satchels; sports bags [other than adapted (shaped) to contain specific sport apparatus]; ball bags [other than adapted to contain specific sports apparatus]; bottle bags; boot bags; cricket bags [other than adapted to contain specific sports apparatus]; duffle bags; draw-string bags; football bags [other than adapted to contain specific sports apparatus]; gear bags [other than adapted to contain specific sports apparatus]; gym bags; holdalls; sports kit bags [other than adapted to contain specific sports apparatus] and team bags.

Class 25

66 The goods registered in Class 25 are

Clothing, footwear, headgear; including clothing for men, women, children and babies; clothing for sports including football, gymnastics, cycling, golf and skiing; clothing for motorists and travellers; underwear including compression underwear; outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers, sports jerseys, vests, shirts, T-shirts, pants, trousers, shorts, pyjamas, dressing gowns, bath robes; swimwear including bathing trunks and bathing suits; thermal clothing; wetsuits; waterproof clothing; sweatbands for the wrist; shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots; socks, stockings, tights; bandannas and headbands.

67 I considered what would be fair in the clothing trade from the perspective of a reasonably informed consumer. The term “*Clothing*” is wide in scope and would cover clothing for men, women, children, and babies (as the specification in fact already expresses). There is no evidence that the SKINS

Mark was used for clothing for children and babies. These products are not similar to clothing for men and women as there are numerous factors which differentiate them, such as different manufacturers and sales outlets. On the other hand, the SKINS Mark is used on “*clothing for men, women*” because the clothing items described in [67] and [68] can be worn by both men and women.

68 I examined the type of clothing the Registrant had used the SKINS Mark for. “Cycling tights” (SKINS Cycle DNAmic Mens ½ tights, SKINS Cycle DNA Womens ½ tights) and “thermal clothing” (A200 Thermal L/S Mck Neck, A200 Thermal long tights) are some of the products in the Distribution Agreement which the Registrant had to sell. Invoice No: SIV-L 16000713 dated 21 July 2016 from Leonian to Weston Corporation showed sales of men’s top, half tights, calf tights and men’s tights. SKINS sportswear was sold, or advertised in shops specializing in sportswear, such as running wear by Running Lab, football and rugby sportswear by Weston Corporation and football sportswear by Joka Sports.

69 The SKINS Mark was also used for vests and T-shirts, such as “Racer back top, Tank top, Top Long Sleeve, Top sleeveless” stated in Schedule 2 of the Distribution Agreement; “SKINS DNAmic L/S top, Leviathan/Atmos XS, SKINS DNAmic Flux Racer back top Black FM”, referenced in Invoice 1046583 dated 1 Dec 2016 from the Former Owner to Leonian; and “A400 Short Sleeve Top” offered by Joka Sports in its Facebook page dated 14 May 2015.

70 There is no evidence of use on the following goods: *clothing, footwear, headgear, including clothing for ... children and babies*”, “*clothing for motorists and travellers*”, “*outerwear, overcoats, leisure clothing, jackets, jumpers, pullovers*”, “*shirts*”, “*pyjamas, dressing gowns, bath robes, swimwear*”

including bathing trunks and bathing suits”, “wetsuits, waterproof clothing, sweatbands for the wrist”, “shoes and boots including football shoes and boots, gymnastic shoes, other sports shoes and boots”, “bandanas and headbands”.

71 The Registrant explained its difficulty in obtaining evidence of use on all the registered goods as it was kept by the Former Owner and therefore the available evidence of use submitted is not a comprehensive view of the use of the SKINS Mark.

72 I considered what would be a “fair specification”. Class 25 covers wide ranging goods under “clothing” and “footwear”. The core business under the SKINS Mark are compression garments and devices used in sports and medical therapy.

73 Applying the principle of a fair specification, I would allow the Registrant to retain the following specification after removing the goods in relation to which there has not been use (at [70]):

Clothing for men and women; clothing for sports including football, gymnastics, cycling, golf and skiing; underwear including compression underwear; sports jerseys, vests, T-shirts, pants, trousers, shorts, thermal clothing; socks, stockings, tights.

Class 28

74 The registered goods are:

Articles for use in exercise and other sporting activities including articles that support or enhance the body in sporting activities; protective padded articles for men, women, children, and babies, all for use in playing a specific sport; sports articles, namely, protective pads or guards; sports guards including shin pads, knee pads and elbow pads; bags adapted for sporting articles; golf bags.

75 There is no evidence of use in relation to the goods in the Class 28 specification.

76 I turn my mind to “*bags adapted for sporting articles, golf bags*”. Having decided that there was use in Class 18 on “*sports bags [other than adapted (shaped) to contain specific sports apparatus]*”, it would be splitting hairs to hold that “*bags adapted for sporting articles; golf bags*”, are different simply because these fall under another class and would also be contrary to the practice of cross-class similarities. These products are within the Registrant’s legitimate expectation for a commercially sensible zone of exclusivity and shall remain.

77 The Class 28 specification should then read:

Bags adapted for sporting articles, golf bags.

Effective date of revocation

78 The Applicant applied for backdating of the revocation to the end of the First 5-Year Period following the completion of the registration procedure. It is relevant to bear in mind the position of the Registrant during the said period. It was not the registered owner. It became the owner on 31 July 2019 through a bankruptcy sale by the Former Owner’s Trustee who sold the trade mark registration for value and with the goodwill. It would be reasonable to believe that this sale was made under hostile circumstances, with little or no assistance from the Former Owner. A few weeks after the purchase, the Registrant had to face this revocation. Unknown to the Registrant at the time, the Former Owner kept and controlled all relevant commercial information including the sales data and details. Given these extenuating and exceptional circumstances, partial revocation of the goods specified in Classes 18, 25 and 28 will take effect only from the date of the application of the revocation, 26 August 2019.

Overall conclusion

79 Having made an overall assessment and having considered all the relevant factors and the totality of the evidence, and applying the test of a balance of probabilities, I find that the application for revocation succeeds partially under Section 22(1)(b). The registration for the SKINS Mark is revoked partially as from 26 August 2019. The specification in Class 10 is maintained in its entirety and the remaining specifications in Classes 18, 25 and 28 are as set out at [65], [73] and [77] above. The parties are to bear their own costs.

Murgiana Haq
IP Adjudicator

Mr Christopher Woo, Ms Emma Qing (Quahe Woo & Palmer LLC)
for the Registered Proprietor;
Ms Francine Tan (Francine Tan Law Corporation) for the Applicant.

[The applicant for revocation / respondent to the appeal did not attend the appeal hearing. The registered proprietor's partial appeal (Classes 18 and 25) from this decision to the General Division of the High Court was successful.]