

**In The Matter Of A Trade Mark Registration No. 1301/86
In The Name Of Campomar Sociedad Limitada**

And

**Revocation By
Nike International Ltd**

*Before Principal Assistant Registrar Anne Loo
12 Jan 2004*

Trade Mark Registration – Application for revocation - burden of proof - whether mark used within 5 years from completion of registration procedure - whether any subsequent commencement of use for uninterrupted period of 5 years prior to revocation application - whether any proper reasons for non-use - section 22(1)(a) and (b) of the Trade Marks Act 1992.

The mark “NIKE” was registered in class 3 in respect of “perfumery with essential oils” in the name of Campomar Sociedad Limitada, (“the Proprietor”). The mark was registered on 30 December 1989 and was effective from 2 April 1986. By an application dated 21 January 2002, Nike International Limited (the Applicant) filed an application for revocation under section 22(1) of the Trade Marks Act Cap 332 1992 Edition (the Act) on the grounds that the mark had not been put to genuine use by the Proprietor or with his consent in Singapore either within the period of five years following the date of completion of the registration procedure and there has been no subsequent commencement of use, or for an uninterrupted period of five years prior to the filing of the revocation request and there are no proper reasons for non use. Parties agreed before hearing that the relevant period to be considered was the period beginning on 21 January 1997 and ending 21 January 2002.

Held, allowing the application

1. The onus of proving the use which has been made of the mark in an application for revocation on non use lies with the proprietor of the registered mark.
2. In the only invoice which the Proprietor seeks to rely to show that there was genuine use of their mark “NIKE” in Singapore, “NIKE” was only mentioned once as “NIKE Woman EdP N/S 7.5 ml” and it is doubtful if this product was finally shipped to Singapore.
3. There are purported products bearing “NIKE” listed in the invoice, with the products listed with the initials “NC”, “NW” and “NM”. However, there was no legend in the invoice to show what the initials mean. There was only the declaration of the Proprietor’s principal manager stating that these terms meant “NIKE MAN”, “NIKE WOMAN” and “NIKE”.
4. There were also promotional materials in the invoice listed with the initials “NC”, “NW” and “NM”. It was not clear from the invoices what mark appears on the promotional materials.
5. There is insufficient evidence to decide whether the invoice related to the use of “NIKE” and whether there was sale on perfumery with essential oils with the NIKE mark within Singapore within the relevant period. The Proprietor had not discharged the onus of showing that his mark has been put to genuine use in the course of trade in Singapore in relation to the goods for which it is registered.
- 6.

Provisions of legislation discussed:

- Trade Marks Act (Cap 332,1999 Ed) section 22 and 105.

Cases referred to:

- Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd [1994] 1SLR 625
- “NODOZ” Trade Mark [1962] RPC 1
- Laboratories Goemar SA’s Trade Marks [2002] FSR 51
- Reemtsma Cigarrettenfabriken GmbH v Hugo Boss [2003]
- Prosimmon Golf (Aust) Pty Ltd v Dunlop Australia Ltd 9 IPR 425
- Re Trade Mark Brandivco [1979] 1 NZIPR 254
- Re Trade Mark Cameo [1974] 1 NZIPR 1
- Re Revue Trade Mark [1979] RPC 27

Representation:

- Mr Christopher Woo and Mrs Ang Su-Lin (Harry Elias Partnership) for the Applicant
- Mr Patrick Yap (KL Tan & Associates) for the Proprietor

Note:

A Notice of Originating Motion for appeal against the decision of the Assistant Registrar was lodged by Messrs KL Tan & Associates on the 6 May 2004. The Appeal was heard and allowed by the Honourable Justice Tay Yong Kwang on the 28 March 2005.

The Respondents represented by Messrs Harry Elias Partnership have filed a Notice of Appeal against the decision of the High Court on the 27 April 2005.

The decision of the High Court was reversed in the Court of Appeal and IPOS' decision was upheld.