

**IN THE HEARINGS AND MEDIATION DIVISION OF  
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T9610194J  
30 September 2010

**IN THE MATTER OF A TRADE MARK REGISTRATION IN THE NAME OF**

**STEVEN CORPORATION PTE LTD**

**AND**

**APPLICATION FOR REVOCATION THEREOF BY**

**CAPITOL RECORDS LLC**

Hearing Officer: Ms Lee Li Choon  
Principal Assistant Registrar of Trade Marks

Mr Sukumar (M/s Parwani & Co), with Mr Parwani for the Proprietor  
Ms Lim Siow Wen (Drew & Napier LLC) for the Applicants

*Cur Adv Vult*

**GROUND OF DECISION**

1 Steven Corporation Pte Ltd is the registered proprietor ("the Proprietor") of Singapore Trade Mark Registration No., T9610194J, for the mark,

**BLUENOTES**

in respect of "men's t-shirts, shirts, jeans, shorts, vests, slacks, briefs, ladies' t-shirts, blouses, slacks, jeans, skirts, shorts, boys' t-shirts, boys' suits, shorts, jeans and shirts, sports shirts" in Class 25 ("the registered mark"). The

application was made on 23 September 1996 and the registration certificate was issued to the Proprietor on 3 October 2000.

2 Capitol Records LLC (“the Applicants”) applied to revoke the registered mark on 15 December 2008. The Proprietor responded by filing their Counter-statement and evidence of use on 15 April 2009. Pursuant to a case management conference held on 18 June 2009, the Counter-statement was amended and the amended Counter-statement was filed on 27 July 2009.

3 The Applicants filed evidence in support of the application on 7 August 2009. The Proprietor filed evidence in response on 8 October 2009. Subsequently, the Applicants filed their evidence in reply on 9 February 2010. A Pre-Hearing Review was held on 30 March 2010. Subsequently, the Proprietor filed further evidence on 10 May 2010 and 19 July 2010 respectively. The application for revocation was heard on 30 September 2010.

### **Grounds of Revocation**

4 The Applicants initially relied on Section 22(1)(a) and Section 22(1)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this application. Subsequently, at the hearing, the Applicants confirmed that they would drop the ground under Section 22(1)(a) and that they would only pursue their application under Section 22(1)(b). Under Section 22(1)(b) of the Act, the basis for the application to revoke the registered mark is that the use of the registered mark has been suspended for an uninterrupted period of 5 years and there are no proper reasons for the non-use. The relevant uninterrupted period of 5 years as asserted by the Applicants is 12 December 2003 to 12 December 2008 (see paragraph 4 of the Statutory Declaration in Reply affirmed on 4 February 2010 by Alasdair McMullan, Assistant Company Secretary of the Applicants).

### **Proprietor’s Evidence**

5 The Proprietor’s evidence comprises the evidence of use filed together with the Counter-statement on 15 April 2009 (see Annex A to the Counter-statement), a Statutory Declaration affirmed on 8 October 2009 by Vishindas Ramchand Thadani @ Vishnu Thadani, Director of the Proprietor, (“Thadani's SD”), a Statutory Declaration affirmed on 7 May 2010 by Chow Sze Wee, Director of Kiddy Palace Pte Ltd (“Chow's SD”) and a Statutory Declaration affirmed on 12 May 2010 by Perry Trisianto Tedja, (“Perry's SD”).

### **Applicants’ Evidence**

6 The Applicants’ evidence comprises a Statutory Declaration affirmed on 21 July 2009 by Alasdair McMullan, Assistant Company Secretary of the Applicants (“McMullan's SD1”) and a Statutory Declaration in Reply affirmed on 4 February 2010 by the same Alasdair McMullan (“McMullan's SD2”).

## Applicable Law and Burden of Proof

7 In a revocation action based on Section 22(1)(b) of the Act, the burden of proof lies on the Proprietor to show that the Proprietor has used the registered mark,

**BLUENOTES**

on the goods covered by the registration. This is because, Section 105 clearly provides that, where a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

## Background

8 In the application for revocation lodged on 15 December 2008, the Applicants stated that they had filed an application to register the trade mark, **BLUE NOTE**, on 17 November 2008 under Trade Mark Application No. T0815951H in Class 25 for, "clothing, footwear, headgear".

9 In the Counter-statement, the Proprietor stated that since the registration of the

**BLUENOTES**

mark, , they have made bona fide use of the mark in relation to the relevant goods in Singapore. The Proprietor claimed that the goods bearing the mark have been sold for the last few years to various established departmental stores in Singapore including, John Little, Robinsons, Seiyu, Kiddy Palace, CK Tang, Isetan, Takashimaya, Tom & Stefanie and Mustafa Centre. The Proprietor further claimed that there had been no suspension of use of the registered mark for an uninterrupted period of 5 years. On the invoices and purchase orders indicating use of the "BLUENOTES" mark in the relevant period, the Proprietor claimed that as most of the earlier invoices were dated almost a decade ago, they were only able to retrieve a few invoices and purchase orders indicating use of the "BLUENOTES" mark within the relevant period. These invoices and purchase orders were filed as evidence of use at Annex A to the Proprietor's Counter-statement:

- (a) Tax Invoice 74339 dated 31 March 2004 from Steven Corporation Pte Ltd to Robinson & Co. (S) Pte Ltd at Orchard Road for 250 quantities of "RG-37A BLUE NOTE BOY's REV. SHORTS"
- (b) Purchase Order 0180114372 dated 11 March 2004 from Steven Enterprise to 010 Robinsons Raffles City for 250 quantities of "BLUE NOTE REVERSIBLE CHK SHORT RG-34/37"
- (c) Tax Invoice 74224 dated 18 March 2004 from Steven Corporation Pte Ltd to Robinson & Co. (S) Pte Ltd at Orchard Road for 350 quantities of "RG-37A BLUE NOTES BOY's REV. SHORTS"
- (d) Invoice No.007/AIR/X/2001 dated 11 May 2001 from CV Reza Indo Jaya in Indonesia to Steven Enterprise at Kaki Bukit Road, Singapore for 150 quantities of "BLUE NOTES KT-43 TODDLER BERMUDA"

and 152 quantities of "BLUE NOTES KT-44 TODDLER LONG PANTS"

- (e) "Packing List" (undated) from CV Reza Indo Jaya in Indonesia to Steven Enterprise at Kaki Bukit Road, Singapore for 150 quantities of "BLUE NOTES KT-43 TODDLER BERMUDA" and 152 quantities of "BLUE NOTES KT-44 TODDLER LONG PANTS"
- (f) "Packing List" (undated) from CV Reza Indo Jaya in Indonesia to Steven Enterprise at Kaki Bukit Road, Singapore for 120 quantities of "BLUE NOTES RJ-201 BIG BOY'S 2 PCS SUIT"; 120 quantities of "BLUE NOTES RJ-201 BIG BOY'S 2 PCS SUIT"; 120 quantities of "BLUE NOTES RJ-201 BIG BOY'S 2 PCS SUIT"; 120 quantities of "BLUE NOTES RJ-202 BIG BOY'S 2 PCS SUIT"; 120 quantities of "BLUE NOTES RJ-202 BIG BOY'S 2 PCS SUIT"; 120 quantities of "BLUE NOTES RJ-202 BIG BOY'S 2 PCS SUIT"; 57 quantities of "BLUE NOTES RJ-201 BIG BOY'S 2 PCS SUIT"; 52 quantities of "BLUE NOTES RJ-202 BIG BOY'S 2 PCS SUIT"
- (g) Invoice No.010/REZA/2000 dated 30 October 2000 from Reza Indo Jaya in Indonesia to Century Freight Forwarders for 154 quantities of "BLUE NOTES LT-61 MEN'S LONG PANTS" and 150 quantities of "BLUE NOTES LT-62 MEN'S BERMUDAS"
- (h) Invoice No.006/AIR/III/2001 from CV Reza Indo Jaya in Indonesia to Steven Enterprise at Kaki Bukit Road, Singapore dated "12 Maret 2001" (which essentially is "12 March 2001") for 108 quantities of "BLUE NOTES BN-110A MENS BERMUDA" and 104 quantities of "BLUE NOTES BN-110B MENS LONG PANTS"

10 In Thadani's SD, the Proprietor had copies of photographs of at least 12 different types of goods bearing the mark, "BLUENOTES" (see exhibit VRD-1 of Thadani's SD) which the Proprietor claimed are available at various places including the Mustapha Centre along Serangoon Road. Exhibit VRD-2 of Thadani's SD showed copies of 3 invoices from Steven Corporation Pte Ltd to Mohamed Mustafa & Samsuddin Co. Pte Ltd dated 10 July 2009, 6 October 2009 and 18 August 2009 showing sale of quantities ranging from 11 to 24 to 30 of "BLUE NOTES" men's shirts and men's s/s shirts. In Chow's SD, the deponent deposed that she (on behalf of Kiddy Palace Pte Ltd) had been purchasing goods from the Proprietor bearing the "BLUENOTES" mark for over 10 years from the date of her SD. In addition the deponent also confirmed that she had purchased goods bearing the mark, "BLUENOTES" from the Proprietor from 2003 to 2008. In Perry's SD, the deponent deposed that he was aware of the Proprietor's registration for the "BLUENOTES" mark in Singapore in 1996. In that SD, the deponent said he was the registered proprietor of the stylised trademark known as "BLUENOTES" in Class 25 registered in Indonesia bearing registration No. 336992, which first registration was on 10 August 1990. The deponent said he was not interested in the Singapore market and that it was the Proprietor who built their own goodwill and reputation to the "BLUENOTES" mark in Singapore.

11 In the 2 Statutory Declarations filed by the Applicants, the Applicants reviewed the evidence of use filed by the Proprietor and disputed that the Proprietor has shown use of the mark on relevant goods during the relevant period in Singapore.

## MAIN DECISION

### Ground of Revocation under Section 22(1)(b)

12 The relevant provision of the Act reads:

**22.** – (1) The registration of a trade mark 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; (*emphasis mine*)

### *Proprietor's' Submissions*

13 On the issue of “use”, the Proprietor pointed out that the legal principle is as stated by the High Court in *Weir Warman v Research & Development [2007] SGHC 59* (“*Weir Warman*”) - “there must be *genuine use* of the trade mark before its function is served and protection by registration is justified.” As regards what constitutes “genuine use”, the Proprietor relied on what was stated in *Weir Warman* that, “if the mark was used “for the purposes of trade, then it is almost certainly genuine””. The Proprietor therefore said that if there was sale or promotion of goods under the trade mark, then there was genuine use. That said, the Proprietor's submissions is that the “use” need not be substantial for the purpose of resisting an application for revocation and they relied on the case of *Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd [1994] 1 SLR 625* (“*Swanfu*”) for the proposition. The Proprietor also pointed out that in the case of *Weir Warman*, the evidence of use of the mark on pump parts which had been put forward by the registered proprietor only comprised (a) 3 email enquiries received by the proprietor from Singapore companies; (b) fax written by the proprietor offering for sale the products in question and (c) a meeting in Singapore with a dealer of products. In support of the principle that genuine use did not have to be substantial or significant, the Proprietor further relied on the following 4 cases: (a) *Ansul BV v Ajax Brandbeveiliging BV [2003] RPC 717* (“*Ansul*”); (b) *Laboratoires Goemar SA v La Mer Technology Inc [2005] EWCA Civ 978* (“*Laboratoires Goemar*”); (c) *ELLE Trade Marks [1997] FSR 529*; (d) *Floris Trade Mark [2001] RPC 329*; and (e) *800-Flowers Trade Mark [2002] FSR 12*.

14 Applying the law to the facts, the Proprietor submitted that the evidence lodged clearly demonstrates that there has been sale and/or import of "BLUENOTES" goods in and into Singapore and that the quantities and amounts (which range from 100 pieces to over 300 pieces) are also far from scanty or nominal. In particular, the Proprietor pointed out that invoices dated 18 March 2004 and 31 March 2004 (see paragraph 9(a) and paragraph 9(c) above) are of particular importance. The Proprietor also submitted that evidence of import is also evidence of use of the registered mark and as such, the tax invoices issued by the Indonesian company CV Reza Indo Jaya in Indonesia to the Proprietor is also evidence of use of the registered mark.

15 In addition to the above, the Proprietor also submitted: (i) that Chow's SD shows that Kiddy Palace Pte Ltd had been purchasing from the Proprietor goods bearing the "BLUENOTES" trade mark for over ten years from the date of Chow's SD (that is, the period May 2000 to May 2010); (ii) that the deponent of Chow's SD has confirmed that she had purchased the goods from the Proprietor carrying the BLUE NOTES trade mark from 2003 to 2008; (iii) that Perry's SD shows that use of the mark in Singapore is on goods sold by the deponent to the Proprietor (and the deponent has stated that the Proprietor was formerly known as Steven Enterprise) and that the goods bearing the registered mark include men's and children's T-shirts, shorts, jeans, vests, slacks, ladies T-shirts and blouses.

16 In response to the Applicants' point that the mark is used in a different form from that which was registered and therefore did not amount to use of the registered mark, the Proprietor cited the case of *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co) [2003] 4 SLR(R) 92 ("Bluestar")*. In that case, the mark consists of the words "BLUE STAR" with a star device above the words. The High Court in that case held that use of the mark with the star device next to the words "BLUE STAR" constituted use. The High Court held that alteration in the size and positioning of the star device did not alter the distinctive character of the mark, which consisted of the words "BLUE STAR".

### *Applicants' Submissions*

17 The Applicants cited paragraph 7.48 of *Tan Tee Jim, S.C.'s Law of Trade Marks and Passing-Off in Singapore (Second Edition)* as authority for the following principle -

The registered trade mark must be used in Singapore. This includes use in relation to goods or services which are promoted, offered for sale or sold in Singapore. If the mark is not used on the goods themselves but on advertisements or other promotional goods published or distributed outside Singapore, there is no use in Singapore if they are not directed at customers in Singapore.

18 The Applicants submitted that the Proprietor has failed to discharge the burden to show use of the registered mark. The Applicants pointed out that out of all the evidence of use submitted by the Proprietor, only two Tax Invoices fall within the relevant period, namely, the Tax Invoices issued to Robinson & Co.(S) Ptd Ltd (see paragraph 9(a) and

paragraph 9(c) above). The Applicants dismissed the other tax invoices and the packing lists in the Annex of the Proprietor's Counter-statement as being irrelevant as the dates of these fall outside the relevant period. As for the copies of photographs of shirts and t-shirts annexed as exhibits in Thadani's SD, the Applicants said that they did not show that the products were owned by the Proprietor or that they were sold in Singapore. As for the invoices from Steven Corporation Pte Ltd to Mohamed Mustafa & Samsuddin Co Pte Ltd, the Applicants dismissed them as irrelevant as they did not fall within the relevant period. As for Chow's SD, the Applicants' contention is that the evidence contained bare and unsubstantiated statements. The Applicants' main contention with regard to Perry's SD is also that the evidence comprises only bare and unsubstantiated statements.

19 On the question of use, the Applicants cited the case of *Nike International Ltd v Campomar SL [2006] 1 SLR(R) 919* for the proposition that if there was only one single act of use, the single act ought to be established by, if not, conclusive proof, at any rate overwhelmingly convincing proof and that, the fewer the acts relied on the more solidly ought they to be established. The Applicants also cited *Laboratories Goemar* for the point that the smaller the amount of use, the more carefully must it be proved and the more important it will be for the trade mark owner to demonstrate that the use was not merely "colourable" or "token". The Applicants argued that in this case, the amount of use is very small – only two transactions within the relevant period. The Applicants argued that the evidence was wholly inadequate and did not support the sales transactions to Robinson & Co.(S) or use of the registered mark in Singapore during the relevant period.

20 The Applicants also argued that in relation to the two Tax Invoices issued to Robinson & Co.(S) Ptd Ltd which fell within the relevant period, the Proprietor did not show use of the registered mark as the registered mark is "BLUENOTES" whereas use in the two Tax Invoices show use of the mark, "BLUE NOTE" or "BLUE NOTES". The Applicants argued that thus, the use did not amount to 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 as required under Section 22(2) of the Act. As illustration, the Applicants cited the cases in which the court held that the distinctive character of the mark has been altered – *NALLI 0/314/02*; *SPRING 0/101/04*; *ELLE Trade Marks [1997] FSR 529*. The Applicants contended that the difference between the "BLUENOTES" mark as registered and "BLUE NOTE" or "BLUE NOTES" as used is apparent because the former is a conjoined term with no meaning whereas either of the latter consists of two separate English words that convey a meaning. The Applicants therefore submitted that the Proprietor had not used the registered mark in the manner as registered.

21 The Applicants further contended that even if there was use of the registered mark, the use related only to one item, i.e., boys' shorts. On this basis, the Applicants asked that the registered mark be revoked in relation to the other items covered in the specification. The Applicants argued that there exists important policy considerations in ensuring that the specification of goods covered by a trade mark registration must not extend beyond the actual use made of the mark. The Applicants cited Section 27(7) for the power to revoke a registered mark partially.

22 One final issue raised by the Applicants was the lack of bona fide proprietorship in the "BLUENOTES" mark by the Proprietor due to the fact that the Proprietor's goods are manufactured in Indonesia by Perry Tristiano Tedja who in turn owns an Indonesian registration no.336992 for a stylized version of the mark, "BLUENOTES". The Applicants contended that the Proprietor was merely an importer or distributor of Perry Tristiano Tedja's products and therefore questioned if the Proprietor could show bona fide use of the trade mark as a symbol of origin.

***Decision on Section 22(1)(b)***

23 In this revocation application under Section 22(1)(b), as stated above, the burden to show "use" of the registered mark lies with the Proprietor. As for the element of "use", reference to "such use" in Section 22(1)(b) refers to "genuine use in the course of trade in Singapore" as stated in Section 22(1)(a). Thus, the Proprietor has to show that there was genuine use of the registered mark in the course of trade in Singapore.

***Relevant period for the purpose of determining if there was "use"***

24 In this case, as stated by the Applicants in McMullan's SD2 (see paragraph 4), the relevant uninterrupted period of 5 years for the purpose of determining if there was "use" is the period 12 December 2003 to 12 December 2008. On this issue of the relevant period, it should be noted that Section 22(3) of the Act states that, "The registration of a trade mark 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." Section 22(3) is further qualified by Section 22(4) which provides that, "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." The application for revocation was made on 15 December 2008. Thus, any use outside of the relevant period (12 December 2003 to 12 December 2008) but before 15 December 2008, if indeed there was such use since this window period is but a few days, would not be relevant in light of Section 22(3) read with Section 22(4).

25 Looking at the specific instances of use lodged by the Proprietor in the Annex to the Counter-statement (see paragraph 9 above), only the instances of use as shown in paragraphs 9(a), (b) and (c) fall within the relevant period. Paragraphs 9(d) and (h) were instances of use in 2001; paragraph 9(g) shows an instance of use in 2000; and instances of use in paragraphs 9(e) and (f) were undated. Thus, as far as the specific instances of use lodged via the Annex to the Counter-statement by the Proprietor are concerned, only the instances of use as found in paragraphs 9(a), (b) and (c) are relevant for my consideration as to whether the Proprietor has discharged his burden of showing that there was "such use" during the relevant period under consideration.



*What constitutes "use"*

26 Section 27(4) of the Act provides a non-exhaustive list of "use" for the purposes of infringement proceedings and this list is also relevant for the purpose of determining if there was "use" in non-use revocation proceedings. Under Section 27(4), there is "use" if a person:

- (a) applies the mark to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the mark;
- (c) imports or exports goods under the mark;
- (d) uses the mark on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or
- (e) uses the mark in advertising.

*Evidence of "use"*

27 I will now examine the relevant specific instances of use within the relevant period lodged by the Proprietor, noting that use in invoices, purchase orders and packing lists would fall within the ambit of "use" in Section 27(4)(d). Close examination shows that a purchase order dated 11 March 2004 was raised in relation to the sale of 250 quantities of "BLUE NOTE REVERSIBLE CHK SHORT RG-34/37" to be sold from a "STEVEN ENTERPRISE" to "010 ROBINSONS RAFFLES CITY" (see paragraph 9(b) above). It may be that, corresponding to this purchase order, a tax invoice (No.74339) for 250 quantities of "RG-37A BLUE NOTE BOY'S REV. SHORTS" was subsequently issued by "STEVEN CORPORATION PTE LTD" to "ROBINSON & CO. (S) PTE LTD" (see paragraph 9(a) above). The entity in paragraph 9(b) appears to be "Steven Enterprise" and it was represented at the hearing that "Steven Enterprise" was the former name of "Steven Corporation Pte Ltd" and that both are the same entity and this representation was not disputed by the Applicants. During oral submissions at the hearing, the Proprietor did not rely on the evidence in paragraphs 9(a) and 9(b) above as showing two separate instances of use. As such, they will be combined and considered as showing only one instance of use.

28 I will now look at the evidence in paragraph 9(a), that is, the Tax Invoice No.74339. Based on Tax Invoice No.74339, the evidence shows there was a sale of 250 quantities of boy's shorts bearing the mark, "BLUE NOTE" by the Proprietor to "Robinson & Co. (S) Pte Ltd" at Orchard Road in Singapore. This piece of evidence falls within the relevant period. The next piece of evidence is : Tax Invoice 74224 dated 18 March 2004 from Steven Corporation Pte Ltd to Robinson & Co. (S) Pte Ltd in Orchard Road for 350 quantities of "RG-37A BLUE NOTES BOY'S REV. SHORTS" (see paragraph 9(c) above). Again, this piece of evidence falls within the relevant period and shows sale of 350 quantities of boy's shorts bearing the mark, "BLUE NOTES" by the Proprietor to "Robinson & Co. (S) Pte Ltd" at Orchard Road in Singapore. Leaving aside the question of whether the mark in use was in an altered form, looking at the evidence at

face value, there were 2 specific instances of use within the relevant period that fall within the ambit of "use" in Section 27(4)(d).

29 Other than the specific instances of use lodged by the Proprietor in the Annex to the Counter-statement, the Proprietor also lodged other evidence through Thadani's SD, Perry's SD and Chow's SD. Thadani's SD shows a copy of a letter from the Proprietor's solicitors to the Applicants' solicitors. In that letter dated 12 February 2009, it was stated that the Proprietor's products are continuously sold at various places including Mustafa Centre along Serangoon Road. There were also copies of photographs of goods such as men's shirts, t-shirts bearing either the mark, "BLUENOTES" or "BLUE NOTES" annexed as Exhibit VRD-1 to Thadani's SD. At the hearing, the physical samples as found in the photographs were tendered for inspection. In addition, annexed to Thadani's SD under Exhibit VRD-2 are 3 copies of invoices from "Steven Corporation Pte Ltd" to "Mohamed Mustafa & Samsuddin Co Pte Ltd" in Chander Road, Singapore, with these dated respectively as 10 July 2009, 6 October 2009 and 18 June 2009. As the photographs are undated and Thadani's SD did not state the use to be within the relevant period, they shall be disregarded. As for invoices to "Mohamed Mustafa & Samsuddin Co Pte Ltd", as these were outside the relevant period, they shall also be disregarded.

30 In Perry's SD, the deponent stated that he was the registered proprietor of the stylised trade mark known as "BLUENOTES" in Indonesia bearing registration No 336992 (mark was first registered in Indonesia on 10 August 1990 in class 25) and that he was aware that the Proprietor had registered the "BLUENOTES" mark in the Proprietor's own name in Singapore in 1996. The deponent stated that he had no objections to the Proprietor's registration for "BLUENOTES" in his own name. The deponent also stated that he had a very long working relationship with the Proprietor and he had been selling goods such as men's and children's T-shirts, shorts, jeans, vests, slacks, ladies T-shirts and blouses to the Proprietor. As Perry's SD does not show goods bearing the registered mark being sold by the Proprietor nor does it show goods bearing the registered mark being imported by the Proprietor within the relevant period, there is no relevant evidence of use to be gleaned from Perry's SD.

31 Chow's SD is affirmed by the Director of Kiddy Palace Pte Ltd. Kiddy Palace Pte Ltd is in the business of retail of ready-made apparel and other merchandise catering to the children's market in Singapore. In Chow's SD, the deponent stated that he had been purchasing goods from the Proprietor bearing the "BLUENOTES" trade mark for over 10 years up to the date of the SD. In particular, the deponent confirmed that he had purchased goods from the Proprietor carrying the "BLUENOTES" trade mark from 2003 to 2008. It was stated that the goods purchased were primarily boy's shirts, t-shirts, shorts, Bermudas and long pants. It was also stated that the invoices issued by the Proprietor do not always carry the "BLUENOTES" trade mark but rather, the description of the goods. I will venture to speculate that it may perhaps be for this reason that there are no exhibits annexed to Chow's SD as evidence of such sale of goods from the Proprietor to Kiddy Palace Pte Ltd. Although there is no documentary proof in the form of invoices within the relevant period, as a Statutory Declaration is a statement taken under oath, taken at face value, Chow's SD does show that there was "use" of the mark,

"BLUENOTES" by the Proprietor through the sale of goods such as, boy's shirts, t-shirts, shorts, Bermudas and long pants, under the said mark to Kiddy Palace Pte Ltd during the period 2003 to 2008 (which covers the relevant period), albeit that I should not attach too much weight to this piece of evidence since the statement is not substantiated with documentary proof.

32 In summary, on the question whether there was "use", I find that the Proprietor has shown that there was use within the relevant period, especially through the evidence in paragraph 9(a) and 9(c) and through Chow's SD.

*Whether "use" was genuine*

33 It is clear that "such use" referred to in Section 22(1)(b) refers to "genuine use". On the question of what constitutes "genuine use", *Ng-Loy Wee Loon* in her book, *Law of Intellectual Property of Singapore (2008 Edition)* said at [25.3.13] that "genuine use" has the same meaning as "bona fide use" which was the expression used under the old Trade Marks Act 1939. Thus, cases decided under the old law are applicable. In this connection, the Court of Appeal in *Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd [1994] 1 SLR 625* ("*Swanfu*") at [632] gave the following guidance:

[T]he primary meaning of 'bona fide'...is 'genuine', as opposed to 'fictitious', 'pretended' or 'colourable'...The primary question in a case under [the revocation section] is whether there has been a bona fide use in the sense of use by way of trade. As the circumstances of proprietors of registered trademarks vary from one to another and the circumstances of a particular proprietor vary from time to time, there is no reason to have a hard and fast rule that the use must be substantial for the purposes of resisting an application under this section.

34 In addition to 'non-fictitious' or 'pretended' or 'colourable' use, the High Court in *Weir Warman Ltd v Research & Development Pty Ltd [2007] 2 SLR(R) 1073* ("*Weir Warman*") at [100] held that genuine use must also not be token use which is use that is intended merely to preserve the validity of a trade mark or use which is internal to the proprietor, although it is clear that the use does not have to be quantitatively significant to be genuine.

35 It is noted that the two specific instances of sale to Robinsons were separate instances and they involved a total quantity of 600 pairs of boys' shorts. Although the sale is not "quantitatively significant", it is by no means insignificant or unconvincing as the sale transactions involve a reputable retailer that is well-known in Singapore, Robinsons & Co.(S) Pte Ltd. In addition to the two specific instances of use, I also take into account Chow's SD which contains plain statements by the director of another reputable retailer of children's merchandise and clothing, Kiddy Palace Pte Ltd, that there had been sale of "BLUENOTES" goods from the Proprietor to Kiddy Palace Pte Ltd during the relevant period. I draw an analogy to the facts of *Weir Warman* wherein the High Court found that it was good enough to establish barely sufficient evidence of "genuine use" from the adduced evidence of three sales transactions involving the "Warman" mark, three email enquiries from Singapore companies regarding "Warman" pump parts, as well as a fax sent to a potential customer for pump parts. The High Court in *Weir Warman* found the

following observations of Chao Hick Tin JA in *Nike International Ltd v Campomar SL [2006] 1 SLR(R) 919* at [15] helpful:

..The essential standard of proof required to defeat a revocation application is to show a genuine use of the mark during the relevant five-year period. One single use of the mark could satisfy the test provided that overwhelmingly convincing proof of the act is adduced..

35 On the whole, I found that the "use" shown by the Proprietor is by no means 'fictitious', 'pretended', 'colourable', 'token' or 'internal to the Proprietor'. I am therefore satisfied that there was sufficient evidence of "genuine use" by the Proprietor of the mark, "BLUE NOTES" or "BLUE NOTE" on clothing, in particular, boys' shorts or the mark, "BLUENOTES" on boy's shirts, t-shirts, shorts, Bermudas and long pants.

*Whether "use" was in Singapore*

36 The instances of "use" in paragraph 9(a) and paragraph 9(c) were instances of use in Singapore. Further, taken at face value, Chow's SD also show sale of boy's shirts, t-shirts, shorts, Bermudas and long pants bearing the mark, "BLUENOTES" to a retailer operating a retail chain in Singapore dealing in goods for children. Thus, there is no doubt that some of the evidence of "use" adduced clearly pertain to use in Singapore.

*Whether the mark in use was in an altered form from that which was registered*

37 Section 22(2) of the Act provides, "For the purposes of subsection (1), 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 interesting to note that Section 22(2) actually broadens the scope of "use" of a registered mark for the purposes of revocation proceedings to encompass use of a mark in a different form from that which was registered as long as the form of the mark in use does not differ in elements which alter the distinctive character of the registered mark.

38 *Ng-Loy Wee Loon* in her book, *Law of Intellectual Property of Singapore (2008 Edition)* said at [25.3.8] that, "For the purposes of s22(2), 'distinctive character' of the registered trade mark refers to the 'essential feature' of the trade mark. The question to be determined here is, what are the elements that constitute the distinctive character of the mark? As the registered mark comprises only of words, it is clear to me that the distinctive character of the mark are the combination of the words, "BLUE" and "NOTES". In the registered form, the two words are joined together with no spacing in between and "NOTES" is in the plural form. The Applicants' contention is that in use, there is spacing between the two words and that the form of the mark in use alters the distinctive character of the mark. I do not think so. This is because, whether in the joined form or with the spacing between the words, it is clear that the mark comprises of the two words, "BLUE" and "NOTES" when read aurally and when looked at visually. The joining of the two words, "BLUE" and "NOTES" does not render a new word with a different pronunciation or with a different look. The distinctive character in

"BLUENOTES" and "BLUE NOTES" is the same which is essentially, the words, "BLUE" and "NOTES". I note that the word "NOTES" is in the singular form in the instance of use in paragraph 9(a) and in the plural form which is the same as that which was registered in the instance of use in paragraph 9(c). The next question is, does it matter that some use show use of the word, "NOTES" in the plural form and in some instances, "NOTES" is in the singular form of "NOTE"? Again, I do not think this fact changes the finding that the mark in use does not differ in elements that constitute the distinctive character of the mark as it has to be taken into consideration that in commerce, it is reasonable for some minute details to be overlooked or glossed over. The fact that there is inconsistency in the references to the mark concerned in the invoices shows that the inconsistency stems more from such glossing over than from a real intention of the Proprietor to alter the mark from one conjoined term comprising of the two words, "BLUE" and "NOTES" to one comprising of two separate words, "BLUE" and "NOTE" in use. Thus, use of "BLUE NOTE" or "BLUE NOTES" is considered as use of "BLUENOTES" by virtue of Section 22(2) since the former do not differ in elements which alter the distinctive character of the mark as registered in the latter.

*Whether use is only in respect of some goods and whether a partial revocation is appropriate*

39 Section 22(7) of the Act provides that, where the grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only. In a case where a trader has obtained registration of his mark for a wide range of goods or services but subsequently confines the use of the mark to a smaller range of goods or services, partial revocation will ensure that he cannot continue to monopolise his mark over the trade of goods or services he has not gone into. The basis for the Applicants' contention that if there was use, there was only use of the mark in relation to "boys' shorts" is from the fact that in the instances of use in paragraph 9(a) and paragraph 9(c), the use of the mark was in relation to "boys' shorts".

40 The range of goods which is covered under the registered mark is, "men's t-Shirts, shirts, jeans, shorts, vests, slacks, briefs, ladies' t-shirts, blouses, slacks jeans, skirts, shorts, boys' t-shirts, boys' suits, shorts, jeans and shirts, sports shirts". Broadly speaking, the specification covers men's clothing, ladies' clothing and boys' clothing. The goods sold in the instances of use in paragraph 9(a) and paragraph 9(c) are boys' shorts which come under boys' clothing. In Chow's SD, it was deposed that Kiddy Palace Pte Ltd has been purchasing goods bearing the "BLUENOTES" mark from the Proprietor for over 10 years, up to the date of her SD and in particular, during the period 2003 to 2008 and that the goods purchased were primarily boy's shirts, t-shirts, shorts, Bermudas and long pants. In Chow's SD, there was specific mention of use of the mark, "BLUENOTES" on boys' clothing.

41 The question is, should the registration of the mark be narrowed to "boys' shorts" as advocated by the Applicants or at least to "boy's shirts, t-shirts, shorts, Bermudas and long pants" since the evidence of use (whether through the evidence in paragraph 9(a) or

9(c) or Chow's SD) at best shows only such use? To answer this question, I shall draw guidance from the statements of learned Justice Woo Bih Lee in *Bluestar Exchange (Singapore) Ptd Ltd v Teoh Keng Long [2003] 4 SLR 92* ("*Bluestar*"). In that case, the trade mark was registered in respect of men's undergarments, briefs, socks, men's sports clothing, knitwear, singlets, swimwear. The registered proprietor could only prove use of the mark on socks, briefs, men's t-shirts, singlets and swimwear. The applicant for revocation argued that the court should revoke the registration in respect of "men's undergarments and knitwear" and to replace "men's sports clothing" with "men's T-shirts". The learned Justice Woo Bih Lee at [57] went through at some length the relevant passages in the judgement of Pumfrey J in *Decon Laboratories Ltd v Fred Baker Scientific Ltd [2001] RPC 17* ("*Decon*") where Pumfrey walked through the various approaches adopted by Neuberger J, Laddie J and Jacob J in respectively, *Premier Brands UK Limited v Typhoon Europe Ltd [2000] FSR 767*, *Mercury Communications Ltd v Mercury Interactive (UK) Ltd [1995] FSR 850*, and *MINERA Trade Mark [2000] FSR 734*. The learned Justice Woo Bih Lee then went on to quote Pumfrey J's conclusion in *Decon*, "*In my judgement, the task is best performed by asking what would be a fair specification of goods having regard to the use that the Proprietor has in fact made of the mark and assuming further that he will continue that use.*"

42 The learned Justice Woo Bih Lee went on to note that Pumfrey J's judgement was cited with approval by Lord Justice Aldous in *Thomson Holidays (Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32* ("*Thomson Holidays*") who said, "*Pumfrey J was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described.*" Lord Justice Aldous then said, "*Pumfrey J in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s10(2), adopts the attitude of the average reasonably informed customer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.*"

43 Justice Woo Bih Lee then went on to refuse the contention of the applicant for revocation in *Bluestar* and opined that:

However, the illustrations given in *Decon* and *Thomson Holidays* demonstrated that the court's approach towards partial revocation should not be as strict or narrow against the registered proprietor as Mr Wong was advocating. For example, he suggested that "men's sports clothing" should be revoked and replaced by "men's T-shirts". Mr Wong's point was that if the classification was narrowed, it would allow the applicant to use its mark for, say, shorts and trousers

although not for briefs. Yet, in *Thomson Holidays*, Aldous J had said that a registration of motor vehicles would extend to motor bikes even the proprietor of the registered trade mark had used it for motor cars only. In my view, the respondents' classification, as it was, was not unduly wide. For example, when the applicant had sought registration of its own mark under class 25, it had also used general words like "clothing", "underclothing", "headgear".

44 Based on the principle of what is fair in the trade of clothing as seen from the perspective of the average reasonably informed customer of clothing products, I find that the specification covered by the registered mark is not unduly wide. It is common for traders in this trade to seek protection of their mark in general categories of goods such as, for example, "clothing". It may be slightly different if the specification covers clothing and footwear and there is use only on footwear as in such a case, there may be a greater reason to order partial revocation in respect of clothing in which there was no use. To borrow the words of the learned Justice Woo Bih Lee at [60], "*...I was of the view that it was not in the interest of the public or the trade to try and narrow the description of the clothing in the respondents' classification further to those specific categories for which the [registered mark] was in fact used. To do so would result in confusion and litigation.*" For practical reasons, it is also pointless to narrow the specification to "boys' shorts" or "boy's shirts, t-shirts, shorts, Bermudas and long pants" as this does not mean that the Applicants or any other third party can obtain registration for a similar mark for "men's shorts" or "men's t-shirts" since the Proprietor's mark would still stand against such registration. It is also noted that like the applicant for revocation in *Bluestar*, the Applicants themselves sought for a wide coverage of "clothing, footwear, headgear" in Class 25 in their application to register the trade mark, **BLUE NOTE**, on 17 November 2008 under Trade Mark Application No. T0815951H.

*Whether there was an issue of bona fide proprietorship*

45 Now, the only remaining issue to be decided is the issue of whether the Proprietor can claim bona fide proprietorship of the mark, "BLUENOTES" as a source of origin. The Applicants alleged that the Proprietor cannot claim to have bona fide proprietorship by virtue of the fact that there is an Indonesian manufacturer who has a similar registration for "BLUENOTES" in Indonesia and that the Proprietor bought the relevant goods from this Indonesian manufacturer. However, the Applicants have not adduced any evidence to show that the Proprietor were not the rightful owner of the mark, "BLUENOTES" here in Singapore. Through Perry's SD, the Proprietor's evidence shows that the deponent in Perry's SD is an Indonesian manufacturer who sells the goods to the Proprietor on which the mark, "BLUENOTES" is applied and used. It is made clear in that SD that the deponent does not contend the Proprietor's proprietorship or ownership of the mark, "BLUENOTES" in Singapore. In fact, the deponent is aware of the Proprietor's registration for the mark, "BLUENOTES" in Singapore and that the Proprietor has been using the mark in Singapore. The deponent has also made it clear that he is not interested in the Singapore market. Thus, as far as the Singapore market is concerned, the mark, "BLUENOTES" in relation to the concerned goods denotes goods

originating from the Proprietor. Therefore, this point raised by the Applicants has not been made out on the facts of the case.

46 The ground of revocation under Section 22(1)(b) of the Act therefore fails as the Proprietor has shown that there was use of the registered mark during the relevant period (in particular, through evidence in paragraph 9(a) and 9(c) above and Chow's SD). On the whole, therefore, this application for revocation fails.

### **Conclusion**

47 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the revocation on the ground in Section 22(1)(b) of the Act fails. The Proprietor is therefore entitled to costs to be taxed, if not agreed.

Dated this 19<sup>th</sup> day of November 2010

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Lee Li Choon

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Division

Intellectual Property Office of Singapore