

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

Trade Mark Nos. T0403049I
28 October 2014

**IN THE MATTER OF
TRADE MARK REGISTRATION BY**

SECONDMENT PTY LTD

AND

**APPLICATION FOR
REVOCATION THEREOF BY**

MCI GROUP HOLDING SA

Hearing Officer: Mr Mark Lim Fung Chian
Principal Assistant Registrar of Trade Marks

Mr Sukumar Karuppiah (instructed by IP Hub Asia Pte Ltd) and Ms Siti Nurhuda Ahmad (IP Hub Asia Pte Ltd) for the Applicants

Mr Kenneth Young (Managing Director of the Registered Proprietors) for the Registered Proprietors

Cur Adv Vult

GROUNDINGS OF DECISION

1 On 23 August 2011, MCI Group Holding SA (“**the Applicants**”) filed their application for revocation on the ground of non-use under Section 22(1)(a) and (b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**the Act**”) in relation to the following registered trade mark (“**the Registered Mark**”):


| | |
|-----------------------|--------------------------------------------------------------------------------------|
| Registered Proprietor | Secondment Pty Ltd (“the Registered Proprietors”) |
| Trade Mark No. | T0403049I |
| Mark | MCI |
| Class | 35 |
| Goods | Consultancy related to business management and migration and relocation of business. |

2 Section 22(1)(a) and (b) 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...

3 A chronology of the relevant dates in these proceedings is set out below. There have also been several interlocutory and other proceedings arising from certain procedural objections by the Registered Proprietors. These are mentioned at [8] below in the context of yet another procedural objection raised by the Registered Proprietors at the hearing of this matter.

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|-----|------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| (a) | 9 January 2004 | Registration date of Registered Mark |
| (b) | 23 February 2005 | Date of completion of registration |
| (c) | 16 July 2010 | Applicants filed a trade mark application for the mark  (“mci & device”) in Classes 35, 39 and 41 (“the Applicants’ Mark”). [This was an international application designating Singapore, but full details of the application are not relevant to the current revocation proceedings.] The Registered Mark was cited against the Applicants’ Mark. |
| (d) | 23 August 2011 | Applicants filed an application for revocation on the ground that there has been no genuine use of the Registered Mark: (a) within the period of 5 years following |

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| | | <p>the date of completion of the registration procedure (i.e. from 24 February 2005 to 23 February 2010); and/or</p> <p>(b) for an uninterrupted period of 5 years before the date of the application for revocation (i.e. from 23 August 2006 to 22 August 2011).</p> |
| (e) | 22 December 2011 | <p>Registered Proprietors filed Counter-Statement, together with a Statutory Declaration of their Director, Kenneth Young, dated 16 December 2011 (“K. Young’s 1st SD”), setting out the alleged use of the Registered Mark.</p> <p>[Note: Under rule 58(3) of the Trade Mark Rules (Cap. 332, Section 108, 2008 Rev. Ed.) (“the Rules”), the Registered Proprietors are required to file “<i>evidence of the use by him of the trade mark.</i>”]</p> |
| (f) | 16 July 2012 | <p>Applicants filed a Statutory Declaration affirmed by Olivier Giauque and Maryvonne Lazzarotto (Directors of the Applicants) on 5 June 2012 (“the Applicants’ SD”) in reply to the Counter-Statement and the Registered Proprietors’ Statutory Declaration.</p> |
| (g) | 29 August 2012 | <p>Registered Proprietors wrote to the Registrar requesting for an extension of time to file their Statutory Declaration in reply. Applicants objected to the request. The Registrar, by letter dated 24 September 2012, gave the Registered Proprietors a final extension of time up till 19 January 2013.</p> |
| (h) | 15 January 2013 | <p>Registered Proprietors wrote to the Registrar requesting for a further extension of time to file their Statutory Declaration in reply. Applicants again objected to the request. The Registrar, by letter dated 29 January 2013, gave the Registered Proprietors a further final extension of time up till 19 March 2013.</p> |
| (i) | 4 April 2013 | <p>As the Registered Proprietors did not file their Statutory Declaration in reply or file a further request for an extension of time, the Registrar, by letter dated 4 April 2013, informed the Registered Proprietors that they are “<i>deemed to</i></p> |

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| | | <i>admit to the facts alleged by the Applicant under Rule 33(3) and Rule 59(2)(d) of the Trade Mark Rules.”</i> |
| (j) | 25 August 2014 | Issuance of Registrar’s Notice informing the parties that the revocation matter has been fixed for hearing on 28 October 2014. The parties were also asked to file: (a) their written submissions and bundle of authorities by 26 September 2014; and Form TM13 before the date of the hearing if they intended to appear at the hearing. |
| (k) | 26 September 2014 | Applicants filed (and served on the Registered Proprietors) their written submissions and bundle of authorities. [Note: The Registered Proprietors did not file any written submissions or bundle of authorities.] |
| (l) | 15 October 2014 | Applicants filed (and served on the Registered Proprietors) Form TM13 (Notice to the Registrar of Attendance at Hearing). |
| (m) | 27 October 2014 | Registered Proprietors filed (but did not serve on the Applicants) Form TM13 (Notice to the Registrar of Attendance at Hearing). [Note: Under rule 37(3) of the Rules, there is no legal requirement that Form TM13 be served on the opposite party.] |

4 On the day of the hearing, the Registered Proprietors indicated that they had not prepared any written submissions and would be making oral submissions. The Applicants had no objections to this.

Preliminary Issues

5 Before discussing the substantive merits of the application for revocation on the ground of non-use, it is necessary for me to deal with numerous procedural issues which have arisen.

Preliminary Issue 1: Whether Mr Sukumar (instructed counsel) could appear at the hearing

6 At the start of the hearing, the Registered Proprietors objected to Mr Sukumar appearing on behalf of the Applicants. Mr Sukumar clarified that he was engaged as counsel by the Applicants’ agents on record and not directly by the Applicants. The Registered

Proprietors were unable to submit any authorities in support of their objection. I allowed Mr Sukumar to appear and now briefly set out my reasons for doing so.

7 The practice of a law firm (or, in this case, the Applicants' agents on record) instructing counsel to argue a case is a common practice both before the courts and the Registrar. Surprisingly, this practice does not appear to be entrenched in legislation (or at least I was unable, from a quick review, to find specific provisions in statutes such as the Legal Profession Act (Cap 161, 2009 Rev Ed), nor did Mr Sukumar point me to any relevant statutory provision). However, it is evident that this practice is well-established, recognised and accepted, as indirectly evidenced (for example) by:

- (a) Supreme Court Practice Direction 13A (Attendance at Hearings in Chambers), paragraph (2) which states that "*the Court may, in its discretion, permit interested parties, such as **instructing solicitors...** to attend hearings in chambers*" (emphasis added); and
- (b) Rule 52 (Responsibility for fees) of the Legal Profession (Professional Conduct) Rules (Cap. 161, Section 71, 2010 Rev. Ed.) which provides that "*[e]xcept where otherwise agreed, **an advocate and solicitor** or a law practice, as the case may be, **who instructs another advocate and solicitor** or law practice shall be responsible for the payment of the latter's fees*" (emphasis added).

These provisions would make no sense if it was not possible to instruct another counsel.

8 I note that this is not the first time that the Registered Proprietors have raised similar types of objections. The other objections have been dealt with and are listed below:

- (a) Objection by Registered Proprietors that Form TM28 (Application for Revocation), Statement of Grounds, and accompanying letter) were not properly signed – The objection was dismissed by the Registrar after an interlocutory hearing on 2 May 2012. The Registered Proprietors' application for leave for judicial review was not granted by the High Court after a hearing on 29 November 2013.
- (b) Objection by Registered Proprietors that IPHub Asia Pte Ltd does not have the authority to file Form TM28 (Application for Revocation) on behalf of the Applicants - After an interlocutory hearing on 23 June 2014, the Registrar by letter dated 25 August 2014 dismissed the objection.

I have not set out full details of the objections by the Registered Proprietors in these previous instances as they have already been dealt with and are irrelevant to the case on hand.

9 Interestingly, instructed counsel argued the case on behalf of the Applicants at both the interlocutory hearings on 2 May 2012 and 23 June 2014. I also note that the Form TM13 (Notice to the Registrar of Attendance at Hearing) filed by the Applicants and served on the Registered Proprietors (see [3(1)] above) states clearly that "*the hearing before the Registrar... will be attended by [the Applicants'] agent, IPHub Asia Pte Ltd and counsel engaged by them, Mr. Sukumar Karupiah.*"

10 In view of all the above, I find that there is clearly no merit to the Registered Proprietors' objection.

Preliminary Issue 2: Objection by Applicants to adduction of fresh evidence by Registered Proprietors

11 On the day of the hearing, in the course of their submissions, the Registered Proprietors sought to adduce two additional statutory declarations, namely, a statutory declaration of Kenneth Young, dated 22 October 2014 ("**K. Young's 2nd SD**") and a statutory declaration of one Justisa MacKenneth Young, the Managing Director of Young Consulting Pte Ltd (Singapore) dated 15 October 2014 ("**J. Young's SD**"). For J. Young's SD, the Registered Proprietors sought to adduce a copy as the original was allegedly in the process of being couriered from Hong Kong; it was received by the Registrar on 5 November 2014. The Registered Proprietors were unable to provide a satisfactory explanation as to why the evidence could not have been adduced at an earlier stage. Prior to the hearing, the Registered Proprietors did not give any indication to either the Registrar or the Applicants that they would be seeking to adduce additional evidence via these two statutory declarations at the hearing.

12 The Applicants objected strongly to the adduction of the statutory declarations on the basis that this amounted to ambushing on the part of the Registered Proprietors and that it would cause grave injustice to the Applicants if the evidence was admitted at such a late stage.

13 In reply, the Registered Proprietors claimed that the statutory declarations were merely for clarification and did not add substantively to K. Young's 1st SD. However, the Registered Proprietors refused to delete any portion of the new statutory declarations which could be described as adding new evidence. Instead, the Registered Proprietors simply asserted that the fresh evidence should be allowed in the interest of justice so that all relevant evidence is placed before the Registrar.

14 I noted the Applicants' strenuous objections, and indicated that I would decide on the admissibility of the fresh evidence when delivering my grounds of decision.

15 As noted at [3(i)], the Registered Proprietors did not file their Statutory Declaration in reply to the Applicants' SD. Accordingly, the Registrar, by letter dated 4 April 2013, informed the Registered Proprietors that they are "*deemed to admit to the facts alleged by the Applicant under Rule 33(3) and Rule 59(2)(d) of the Trade Mark Rules.*" The Registrar's practice in this regard is also set out in HMG Circular No. 2/2011 dated 8 April 2011 (Proprietor's Evidence in Trade Mark Revocations).

16 Further, rule 35 (read with rule 59) of the Rules provides that after the "evidence" phase of proceedings (as set out in rule 59 read with rules 32-34 of the Rules), "*[n]o further evidence may be filed by either party except that... the Registrar may at any time, if he thinks fit, give leave to either party to file further evidence...*"

17 HMG Circular No. 1/2011 dated 8 April 2011 (Application to File Further Evidence) sets out the procedure to be followed:

“The requesting party should submit a draft statutory declaration setting out the further evidence that is sought to be admitted and state why the evidence is relevant but could not have been adduced earlier. At the same time, the other party must be copied on the request and his consent must be sought.”

This procedure was not followed in the present case.

18 As explained in the same Circular:

*“... the Registrar does not allow further evidence to be filed simply as a matter of course. **Whether leave would be granted depends on the facts and circumstances of each case.** In considering whether to grant leave for the further evidence, the Registrar will conduct a **balancing exercise, involving a consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its merits in the interest of justice between the parties.** In particular, the Registrar will carefully weigh the following **non-exhaustive factors** on a case by case basis:*

- (i) **why the party seeking to file the further evidence did not do so earlier when the main evidence or evidence in reply fell due; it should be shown that the evidence could not have been obtained earlier with reasonable diligence***
- (ii) **whether the further evidence is necessitated by the evidence filed by the other party***
- (iii) **whether the other party would suffer any real prejudice which cannot be compensated with costs if the further evidence is allowed***
- (iv) **whether allowing the further evidence will allow the substantial issues to be satisfactorily and fully considered and determined or whether the application is only a tactical manoeuvre and allowing the further evidence would result in prejudice to the other party***
- (v) **the stage of the proceedings at which the further evidence is sought (e.g. at the Pre-Hearing Review in contrast to one day before the hearing), considerations of disruption to proceedings and extra costs generated by the delay being relevant.***

*“All relevant factors will be considered, though the **main weight is attached to the desirability of having the substantial issues satisfactorily and fully considered and determined.** However, this factor may be outweighed by the totality of the other factors in certain cases.”*

(emphasis added)

19 As submitted by the Registered Proprietors themselves (at [13] above), the new statutory declarations were merely for clarification and did not add substantively to K. Young’s 1st SD. I briefly summarise the contents of the various statutory declarations from the Registered Proprietors:

- (a) K. Young’s 1st SD - Asserts that the Registered Proprietors have authorised Young Consulting Pte Ltd to use the Registered Mark on the relevant services of interest. Various letters and invoices are also annexed to the statutory

declaration. Among other things, these documents purport to evidence the provision of services by the Registered Proprietors in Japan and Australia to two Japanese customers regarding certain business opportunities in Singapore.

- (b) K. Young's 2nd SD – Re-arranges and organises the documents annexed to his 1st SD into various groups. Adduces additional documents (passport pages) evidencing that Kenneth Young and one Mr Yamazaki were in Japan or Australia on certain dates; these documents were presumably sought to be introduced to rebut an aspersion at [25.5] of the Applicants' written submissions (referred to at [3(k)] above) that it was doubtful whether meetings in Japan took place on these dates as it "*is rather curious and simply does not make commercial sense how one can justify such a low fee to attend a meeting in Japan*"; the fees charged for each meeting were either S\$200 or S\$250.
- (c) J. Young's SD – Seeks to confirm that Young Consulting Pte Ltd has used the Registered Mark on the relevant services of interest to the Registered Proprietors as authorised by the Registered Proprietors, and that the invoices referred to in K. Young's 1st SD were for services rendered and have been settled; this again was presumably introduced to rebut the Applicants' assertion in their written submissions (at [25.1]-[25.4] and [25.6]) that there is no evidence that such services have been rendered.

20 Having reviewed the contents of the new statutory declarations, and weighing the relevant factors, I am of the view that the evidence should not be allowed. Among other things, I note that:

- (a) the Registered Proprietors could have sought, but did not seek, to adduce the new evidence at an earlier stage of the proceedings;
- (b) the Registered Proprietors had an opportunity to, but did not, file their statutory declaration in reply to the Applicants' SD (see [15] above);
- (c) the Registered Proprietors did not submit the draft statutory declarations or follow the applicable procedures for seeking leave to file further evidence in accordance with HMG Circular No. 1/2011 (see [17] above);
- (d) the new evidence was sought to be adduced only on the day of the hearing itself, and even then, not at the start of the hearing, but in the course of the Registered Proprietors' submissions;
- (e) indeed, until the day of the hearing itself, it was unclear whether the Registered Proprietors would even be appearing at the hearing; and
- (f) the new statutory declarations do not add much to what was already included in K. Young's 1st SD (see [19] above).

21 I should add that my decision on the application for revocation would be the same even if the evidence had been allowed as explained at [41]-[49] below, with particular reference to [44].

Preliminary Issue 3: Whether Applicants are required to adduce some evidence in support of the Application for Revocation

22 In the Applicants' Statement of Grounds of Revocation filed with their application for revocation (at [4] and [5]), the Applicants simply stated that "[a]fter making due inquiries, the Applicant has ascertained" that there has been no genuine use of the Registered Mark during the relevant periods. Apart from this bare assertion, the Applicants did not present any evidence of non-use on the part of the Registered Proprietors. This is also the case with the Applicants' SD.

23 In contrast, in the case of *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919 ("*Nike (No. 1)*") at [6]-[9], which is one of the cases included in the Applicants' Bundle of Authorities, the appellants (i.e. Nike International Ltd) "*filed four statutory declarations to substantiate its claim of non-use by Campomar.*" Among other things, the appellants had engaged a private investigator whose enquiries "*at ten major shopping centres in Singapore showed that no NIKE perfumes were sold at those centres. [The investigator] also made some discreet inquiries at Bhojwani's [a company to which Camponar had allegedly shipped NIKE perfumes] and was told by a female employee who claimed to be in charge of the office ("Kalai") that it did not sell any perfumes in Singapore but only in Indonesia. Kalai also informed [the investigator] that it did not deal in NIKE perfumes.*"

24 When I asked the Applicants whether it was sufficient for them to simply assert that the Registered Proprietors had not made genuine use of the Registered Mark without providing details of the evidence relied upon, the Applicants simply cited Section 105 of the Act, which provides:

105. If in any civil proceedings under this Act 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.

25 I agree with the Applicants that the rationale for the reversal of the burden of proof is that "*it is difficult to prove a negative fact, i.e. that the proprietor has not used the mark*": see *Halsbury's Laws of Singapore, Volume 13(3): Intellectual Property (LexisNexis, 2007)* at [160.620], footnote 13. This is, however, a different issue from whether the Applicants are required to put forward at least some evidence in order to initiate the revocation application on the basis of non-use, and if so, what evidence is required.

26 In this regard, the Applicants submitted that a bare assertion as described at [22] above was sufficient. The Applicants added that they also take on the risk of not being in a position to rebut any evidence of use put forward by the Registered Proprietors. On the other hand, the Registered Proprietors simply asserted that the Applicants would have to provide at least some evidence and could not rely on a bare assertion of non-use. Neither party was able to point to any cases discussing this issue.

27 I have perused some of the leading textbooks in this area to see if this issue has been discussed previously. Intriguingly, the textbooks I have looked at all adopt a slightly different approach to the issue.

Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore*, 2nd Ed (Sweet & Maxwell, 2014) ("*Ng-Loy*") at [25.3.4] simply refers to Section 105 of the Act, which places the burden

on the registered proprietor to show use of a trade mark in non-use revocation proceedings. Interestingly, however, in the relevant cases cited in *Ng-Loy* (see [25.3.4], footnote 19) in support of this proposition, the applicants did in fact adduce some evidence of non-use, typically in the form of a market survey carried out by an investigator: see *Nike (No. 1)* (discussed at [23] above) and *Reemtsma Cigarettenfabriken GmbH v Hugo Boss AG* [2003] 4 SLR(R) 155 at [6]-[10]; the other cases cited involved different issues.

Susanna H.S. Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) (“*Susanna Leong*”) at [31.009] provides that “*it is sufficient in the first instance for the applicant... to adduce some evidence that the registered trade mark in question has not been put to genuine use during the relevant five-year period. Thereafter, the evidential burden shifts to the proprietor of the registered trade mark to prove genuine use*” (emphasis added). However, there is no discussion on precisely what evidence on the part of the applicant is required. In relation to a different point, *Susanna Leong* at [31.008] cites the Court of Appeal judgment in *Swanfu Trading Pte Ltd v Beyer Electrical Enterprise Pte Ltd* [1994] 1 SLR (R) 330 (“*Swanfu*”) decided under the previous Trade Marks Act 1938, which held that the legal burden rests on the applicant to establish non-use, and notes that the position under the current Act is different in that the legal burden is on the registered proprietor to prove genuine use of the mark. In *Swanfu*, at [10]-[12], [14]-[15] and [18]-[20], a simple assertion by the applicant’s managing director that “*I am aware from my own knowledge of the gas cooker market that [Swanfu] have not made any bona fide use of the said registered mark for at least the last five years.*” (see [10]) was held to be sufficient to establish a *prima facie* case of non-use, thus shifting the evidential burden to the registered proprietor to establish genuine use. However, there was also evidence that the managing director had been in the relevant industry for more than a decade and that it was part of his job to be familiar with the brands of the relevant goods being sold in the market.

Tan Tee Jim, S.C., *Law of Trade Marks and Passing Off in Singapore*, 2nd Ed (Sweet & Maxwell Asia, 2005) (“*Tan*”) at [7.12] states that the grounds of revocation “*must be sufficiently particularised.*” However, the case cited in support of this proposition, namely, *Geobank Trade Mark* [1999] RPC 682, was concerned with an application for a declaration of invalidity based on the applicants’ alleged earlier right in passing off, and not an application for revocation on the basis of non-use.

In *Kerly’s Law of Trade Marks and Trade Names*, 15th Ed (Sweet & Maxwell, 2011) (“*Kerly’s*”) at [10-014], footnote 13, the learned authors express the view that “*an application for revocation for non-use must have some substance to it, otherwise it would be frivolous, vexatious and/or an abuse. Penalties are likely to be visited on frivolous applications or applications based on allegations which are untrue. Of course, the way in which the proprietor shows that an application is frivolous is by putting in evidence of: (1) his use, and (2) that the applicant knew of his use.*” No changes to the position are discussed in the *First Supplement* (2014) to *Kerly’s*.

Based on this preliminary review, it appears to be unclear: (1) what evidence (if any) an applicant is expected to adduce when applying to revoke a registered mark on the basis of non-use, and (2) what the consequences of not adducing the requisite evidence (if any) are.

28 Apart from the above, I note that when a person applies to register a trade mark in Singapore, under Section 5(1)(e) of the Act, he simply needs to state “*that the trade mark is being used in the course of trade*” or that he “*has a bona fide intention that the trade mark*

should be so used”; Singapore does not impose any requirement that actual evidence of use be provided. It may well be that as a counterpoint to the lax requirement regarding proof of use of the trade mark at the application stage, an applicant for revocation on the basis of non-use is similarly not required to provide specific evidence of non-use on the part of the Registered Proprietors.

29 In the current case, I also note that the Registered Proprietors had not previously raised any objection on this basis until the date of the hearing itself. Instead, the Registered Proprietors have put forward their purported evidence of use, which is already before the Registrar. Further, there is no indication that, since the date of the application for revocation, the Registered Proprietors have commenced any other types of alleged use of the Registered Mark save for the types described at [41], [43] and [46] below. Accordingly, the Applicants could conceivably simply file a fresh application for revocation, and this would entail unnecessary time, expense and inconvenience for both parties to file their pleadings and evidence, and raise the same arguments at a subsequent hearing.

30 In view of the clear language of Section 105 of the Act, in the absence of any clear authority to the contrary, and in the circumstances of the present case, I find that the Applicants’ bare assertion that there has been no genuine use of the Registered Mark during the relevant periods is sufficient. In this regard, I am also mindful of the adversarial nature of opposition proceedings and the failure of the Registered Proprietors to draw my attention to any case or other authority supporting their position. Notwithstanding my decision on this issue, I should add that I would be open to reconsidering the position in a subsequent case where full arguments on this issue are canvassed.

Preliminary Issue 4: Whether the Registered Mark (assuming the grounds for revocation are made out) should be revoked from a date prior to 16 July 2010 (i.e. the date of application of the Applicants’ Mark)

31 I have one final preliminary issue to deal with before discussing the substantive merits of the application for revocation. As mentioned at [3(d)] above, the current application for revocation on the ground that there has been no genuine use of the Registered Mark is made on two alternative bases, namely that there has been no genuine use of the Registered Mark:

- (a) within the period of 5 years following the date of completion of the registration procedure (i.e. from 24 February 2005 to 23 February 2010); and/or
- (b) for an uninterrupted period of 5 years before the date of the application for revocation (i.e. from 23 August 2006 to 22 August 2011).

This preliminary issue relates to the second basis for revocation.

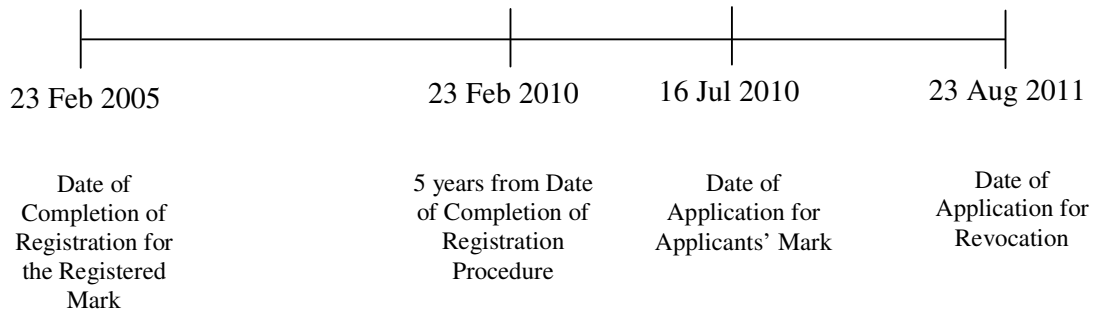
32 At the hearing, and in their written submissions (at [43] to [50]) filed and served on 26 September 2014, the Applicants sought to persuade the Registrar to apply his discretion under Section 22(7) of the Act to revoke the Registered Mark from a date prior to 16 July 2010.

Section 22(7) provides that:

Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from —

- (a) the date of the application for revocation; or
- (b) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

33 A timeline setting out the relevant dates will show the reason for the Applicants' request:



34 As noted at [3(c)] above, the Registered Mark was cited against the Applicants' Mark. If the Registered Mark is only revoked from the date of application for revocation (i.e. 23 August 2011), it would still be valid and subsisting as at the date of application of the Applicants' Mark (i.e. 16 July 2010). As held in the Court of Appeal decision in *Campomar SL v Nike International Ltd [2011] 2 SLR 846* ("*Nike (No. 2)*") at [30], [38] and [41], this would mean that the Registered Mark would continue to be an obstacle to the registration of the Applicants' Mark; in *Nike (No. 2)*, the court observed that to permit registration of the applicants' mark would lead to an unacceptable situation where there would be two registrations for "Nike" co-existing on the register at the same time (i.e. for the period between the date of application for the applicants' mark and the date of application for revocation).

35 The solution proposed in *Nike (No. 2)* (at [29], [30], [38], [40] and [41]) was for the registered mark to be revoked from a date prior to the date of application of the applicants' mark, which is a possibility envisaged under Section 22(7)(b) of the Act. However, no such application under Section 22(7)(b) of the Act had been made in *Nike (No. 1)*, (mentioned at [23] above), when Nike had applied to revoke Camponar's trade mark. The issue in this case is whether this should be permitted in the present case.

36 In this regard, I note that the Applicants did not indicate either in their application for revocation or in the Applicants' SD that they were seeking to revoke the mark from a date prior to the date of application of the Applicants' Mark. Significantly, in both these documents, the Applicants simply asserted that "[a]fter making due inquiries, the Applicant has ascertained that for an uninterrupted period of 5 years before the date of [the application for revocation] there has been no genuine use of the [Registered Mark]." There was no allegation by the Applicants that the Registered Mark had not been used for an uninterrupted period of 5 years before the date of application for the Applicants' Mark.

37 As mentioned in HMG Circular No. 1/2012 dated 21 December 2012 (Relevant Dates in Revocations on Grounds of Non-Use) (in Section C):

... it is important and essential that the Applicant clearly states the requested effective date of revocation.

If no effective date is stated and the revocation is successful, the Registrar will typically apply Section 22(7)(a) to revoke the registered trade mark from the date of the application for revocation.

This position is consistent with the position in the UK: see *Omega SA v Omega Engineering Inc* [2003] FSR 893 at [11].

38 The Applicants in this case are relying on the evidence put forward by the Registered Proprietors to argue that there has not been genuine use of the Registered Mark for the 5 years preceding the date of application for the Applicants' Mark. Although this may arguably be the case, I am of the view that it would be unfair to expect the Registered Proprietors to "defend" a position which has not been pleaded by the Applicants, and which is not even part of the "evidence"/assertions set out in the Applicants' SD. Even assuming the Applicants succeed in their application for revocation (discussed below), I would decline to exercise my discretion under Section 22(7)(b) of the Act to order the revocation of the Registered Mark to take effect from a date prior to the date of application for the Applicants' Mark.

39 I should add that this issue is academic if the Applicants succeed on their alternative pleaded case under Section 22(1)(a) of the Act that the Registered Mark be revoked from 24 February 2010 (i.e. immediately after the period of 5 years following the date of completion of the registration procedure).

MAIN DECISION

40 Having dealt with the numerous procedural issues, I now turn to the substantive decision on the merits of the application.

41 The Registered Proprietors rely on two types of activities in support of their position that there has been genuine use of the Registered Mark:

- (a) Firstly, they rely on consultancy services regarding proposed investments in Singapore, which were provided in Japan and Australia; and
- (b) Secondly, they rely on the advertisement and sale to customers in Japan of a report about doing business in Singapore ("**the Singapore Report**").

42 Before considering whether these activities would constitute "use" so as to defeat an application for revocation on the basis of non-use, it would be helpful to briefly set out the policy reasons why unused marks must be removed from the register. These reasons are set out in the High Court case of *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 ("*Weir Warman*") at [42] and [99], and summarised in *Ng-Loy* at [25.3.3] as follows (sub-paragraphing mine):

- (a) First, trade marks serves to indicate the origin of goods and the registration system facilitates and protects this function. This protection given by

registration is no longer justified if the mark is not used in the capacity as a badge of origin.

- (b) Secondly, the register serves as a notice to rival traders of trade marks which are already in use. To allow unused marks to remain on the register is to jeopardise this function of the register as an accurate record.
- (c) Thirdly, this ground for revocation prevents traders from ‘hoarding’ trade marks or ‘squatting’ on trade marks which, for some reason or other, they have abandoned. Revocation releases these trade marks back to the public domain for other traders to use and/or to register.

As indicated in *Weir Warman* at [99], “[t]hese considerations underpinning the need for ‘genuine use’ of a registered trade mark must be borne in mind when assessing an application for revocation.” With these considerations in mind, I turn now to examine the activities relied upon by the Registered Proprietors.

Consultancy Services regarding Proposed Investments in Singapore, which were provided in Japan and Australia

43 From K. Young’s 1st SD and the exhibits annexed thereto, it appears that:

- (a) the Registered Proprietors market their “*management, marketing and migration consulting services*” via a single-page flyer on their letterhead, which reflects their address in Australia (as they are an Australian company), and which depicts the Registered Mark; potential customers can contact the Registered Proprietors or “*any of [their] consultants in Singapore or Hong Kong*”; the Singapore consultants are reflected as a company known as Young Consulting Pte Ltd (“**YCPL**”) (see Exhibit “A”); according to the Registered Proprietors, they have authorised YCPL to use the Registered Mark;
- (b) the Registered Proprietors have met with Japanese customers in Japan and Australia, during which the Registered Proprietors provide advice regarding proposed investments and business activities in Singapore (see correspondence between Registered Proprietors in Australia and customers in Japan exhibited as Exhibits “C”, “F”, “G”, “J”, “K” and “O”); and
- (c) YCPL (Singapore) invoices the customers for these meetings (see Exhibits “B”, “D”, “E”, “H”, “U” and “V”).

44 As discussed at [19] above, the Applicants in their written submissions challenge the veracity of this evidence on the basis that there is no evidence that these meetings actually took place, and that the sums charged for attending meetings in Japan (which amounted to S\$200 or \$250 for each meeting) were too low to justify having a meeting in Japan. The Registered Proprietors had therefore sought to admit further evidence of these meetings. I have rejected this further evidence for the reasons set out at [20] above. I should add, however, that I am prepared to accept that such meetings did take place in the absence of evidence to the contrary or concrete reasons from the Applicants as to why the Registered Proprietors should not be believed.

45 However, I agree with the Applicants that such “use” by the Registered Proprietors should be disregarded as the meetings clearly did not take place in Singapore, as expressly required by Section 22(1) of the Act. It is trite law that “*the registered proprietor must satisfy the geographical requirement that the trade mark has been put to ‘genuine use’ in Singapore. Use of the trade mark outside of Singapore will certainly not satisfy the requirement of ‘genuine use’ in Singapore*”: see **Susanna Leong** at [31.013(B)(b)] (emphasis in original) (see also **Ng-Loy** at [25.3.19] to [25.3.25] for examples when the registered proprietor was able to establish use in Singapore; the facts in the current case do not come close to any of the situations considered in the cases cited by Professor Ng-Loy).

Advertisement and Sale of the Singapore Report to Customers in Japan

46 From K. Young’s 1st SD and the exhibits annexed thereto, it appears that:

- (a) the Singapore Report is marketed via a 2-page marketing brochure of YCPL, which depicts the Registered Mark (see Exhibits “L”, “M” and “N”);
- (b) the Registered Proprietors have not provided a copy of the Singapore Report; according to YCPL’s marketing brochure, it is “*a confidential report for foreign nationals who intend to do business or investing in Singapore. The report will give useful information on Singapore, including political, legal and economic aspects, the local market, the financial system, the vehicle/entity to conduct business/investment and the expatriate personnel.*”;
- (c) from the evidence furnished, orders for the Singapore Report are placed by the Registered Proprietors’ customers in Japan with the Registered Proprietors in Australia (see Exhibits “J” and “K”); and
- (d) the reports are then sent to the Japanese customers by YCPL from Singapore, and YCPL also invoices the customers for the reports (see Exhibits “O” to “T”).

47 Here again, there is an issue as to whether any relevant activities can be said to have taken place in Singapore (see discussion at [45] above). The nexus to Singapore is perhaps closer as compared to the consultancy services provided by the Registered Proprietors since the reports were sent from Singapore. On the one hand, the customers are evidently not in or from Singapore. On the other hand, Section 22(2) of the Act expressly provides that “*use in Singapore includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes*”, though it is unclear whether this provision applies only to “goods” (as opposed to “services”), and there is also no evidence that the mark was “*appl[ie]d... to [the report] or to materials for the labelling or packaging of [the report] in Singapore.*”

48 However, it is not necessary to decide this issue as there is a further fundamental reason why such “use” should be disregarded. The Registered Mark is registered in respect of “*consultancy related to business management and migration and relocation of business*” in Class 35. However, the activities of the Registered Proprietors in relation to the advertisement and sale of the Singapore Report cannot be equated with the provision of such consultancy services. As noted in **Ng-Loy** at [25.3.7], **Susanna Leong** at [31.013(B)(b)] and

Tan at [7.50]-[7.52], the use in question must be “*in relation to the goods or services for which [the Registered Mark] is registered*” as expressly provided in Section 22(1) of the Act.

Conclusion

49 Any “use” of the Registered Mark by the Registered Proprietors is clearly not “*in Singapore*” and, in respect of the advertisement and sale of the Singapore Report, also not “*in relation to the... services for which [the Registered Mark] is registered*” as expressly required under Section 22(1) of the Act. Borrowing a colourful metaphor from Justice Jacob (as he then was) in the case of ***Laboratoires Goemar SA v La Mer Technology Inc [2002] ETMR 34***, the Registered Mark is akin to an “*abandoned vessel in the shipping lanes of trade.*” Revoking the registration of the Registered Mark would be consistent with the policy reasons as to why unused marks must be removed from the register as set out in [42] above.

50 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the application for revocation succeeds under Section 22(1)(a) and (b) of the Act. The Registered Mark is accordingly revoked with effect from 24 February 2010. The Applicants are also awarded costs to be taxed, if not agreed.

Dated this 5th day of December 2014

Mark Lim Fung Chian

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore