

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

Trade Mark No. T9003431A
1 April 2015

IN THE MATTER OF A TRADE MARK REGISTRATION

IN THE NAME OF

WIDDY TRADING PTE LTD

AND

APPLICATION FOR REVOCATION THEREOF BY

CHEANEY SHOES LIMITED

Hearing Officer: Ms See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

Gooi Chi Duan (Donaldson & Burkinshaw LLP) for the Registered Proprietors
Rishi Ganiswaran (Ella Cheong LLC) for the Applicants for Revocation

Cur Adv Vult

GROUND OF DECISION

1 The subject of these revocation proceedings is Trade Mark No. T9003431A ("the Subject Mark"):

CHEANEY

2 The Subject Mark was registered on 14 May 1990 in Class 25 in respect of "Footwear". The date of completion of registration is 30 November 1991. The registered proprietors of the Subject Mark are Widdy Trading Pte Ltd ("the Proprietors").

3 On 25 May 2012, Cheaney Shoes Limited ("the Applicants") filed an application for revocation of the Subject Mark on the grounds of non-use. The counter-statement in support of the Subject Mark was filed on 24 September 2012, together with the Proprietors' evidence.

4 The Applicants filed evidence in support of the application for revocation on 13 December 2013. The Proprietors filed evidence in reply on 2 June 2014. The Applicants filed evidence in reply on 2 October 2014. A Pre-Hearing Review was held on 29 October 2014, after which both parties filed supplementary evidence on 29 December 2014.

5 The application for revocation was heard on 1 April 2015 with both parties in attendance.

Grounds of Revocation

6 The Applicants rely on Sections 22(1)(a) and 22(1)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") in this revocation.

Proprietors' Evidence

7 The Proprietors' evidence comprises the following:

S/No.	Declarant	Designation	Date	Declared in	Referred to as
1	Chai Hian Kwong	Director of Widdy Trading Pte Ltd	24 September 2012	Singapore	SD1
2	Chai Hian Kwong	Director of Widdy Trading Pte Ltd	29 May 2014	Singapore	SD4
3	Chai Hian Kwong	Director of Widdy Trading Pte Ltd	29 December 2014	Singapore	SD7

Applicants' Evidence

8 The Applicants' evidence comprises the following:

S/No.	Declarant	Designation	Date	Declared in	Referred to as
1	Jonathan Church	Joint Managing Director of Cheaney Shoes Limited	9 September 2013	United Kingdom	SD2

2	Natalija Marcinska	Private Investigator of Farncombe International Ltd	9 December 2013	United Kingdom	SD3
3	Jonathan Church	Joint Managing Director of Cheaney Shoes Limited	26 September 2014	United Kingdom	SD5
4	Natalija Marcinska	Private Investigator of Farncombe International Ltd	22 August 2014	United Kingdom	SD6
5	Jonathan Church	Joint Managing Director of Cheaney Shoes Limited	16 December 2014	United Kingdom	SD8

Burden of Proof

9 Under Section 105 of the Act, the Proprietors have the burden of showing use made of the Subject Mark. This was not disputed by either party.

Background

10 The Applicants make and sell men’s shoes under the brand “Cheaney”. They claim that “Cheaney’ is a world-renowned and popular brand for men’s shoes. These have been made in the United Kingdom since the creation of the brand in 1886. It is claimed to be well known for the high quality and classical design of men’s footwear. The latter has been exhibited at international trade fairs such as MICAM in Milan, Italy; PITTI in Florence, Italy; GDS in Dusseldorf, Germany; and PLATFORM in Las Vegas, USA. The Applicants are the registered proprietors of trade marks comprising or incorporating “Cheaney” in countries worldwide, in respect of goods in Class 25. Such countries include the UK, Japan, France and Hong Kong. The Applicants sought to protect “Cheaney” in Singapore under International Registration No. 1078845 (Singapore TM No. T1111718I). However, they encountered a citation of the Subject Mark in Singapore. They thus commenced the present proceedings to revoke the Subject Mark, in order to overcome the citation.

11 The Proprietors, in essence, claim to have sold footwear bearing the Subject Mark at their retail shops since 1985. They had a retail shop at Fu Lu Shou Complex from 1985 to around 2008 or 2009. Thereafter, they relocated their retail shop to Block 178, Toa Payoh Central, with a second shop at Block 210, Bedok Central. The Proprietors claim to operate a small business, dealing mainly in low cost footwear, with transactions mainly on cash terms. As such, they do not as a matter of practice issue receipts setting out the details, including the brand, of their footwear sold. I will return to this point later.

MAIN DECISION

Grounds of Revocation under Section 22(1)(a) and (b)

12 Section 22(1)(a) and (b), (2), (3) and (4) 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;

...

(2) 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, and 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.

(3) 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.

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

Relevant Dates

13 The Applicants plead and submit that the registration of the Subject Mark should be revoked as:

- (i) under Section 22(1)(a) of the Act, there had been no genuine use of the Subject Mark by the Proprietors for a period of 5 years subsequent to 30 November 1991; and/or
- (ii) under Section 22(1)(b) of the Act, such use has been suspended for an uninterrupted period of 5 years prior to the filing of the present application on 25 May 2012; and/or
- (iii) under Section 22(1)(b) of the Act, such use has been suspended for an uninterrupted period of 5 years between a date as early as 30 November 1991 and a date as late as 25 May 2012;

and there are no proper reasons for non-use.

14 In line with the practical parameters of the Applicants' pleadings, the relevant dates ("the Relevant Dates") under consideration are as follows:

- (i) The registration procedure was completed on 30 November 1991. The 5-year period immediately following the completion of registration ended on 30 November 1996. The period of use (or non-use) in issue is *1 December 1991 to 30 November 1996*.
- (ii) The application for revocation was filed on 25 May 2012. The 5-year period prior to this application for revocation starts from 25 May 2007. The period of use (or non-use) in issue is *25 May 2007 to 24 May 2012*.
- (iii) Any five year period between 30 November 1996 and 25 May 2007. The period of use (or non-use) in issue is *1 December 1996 to 24 May 2007*. I disagree with the Applicants' pleadings and submissions at [13(iii)] above that the relevant period of 5 years here (as distinguished from the relevant period of 5 years referred to in [13(i)] and [13(ii)]) is between a date as early as 30 November 1991 and a date as late as 25 May 2012. Rather, as a practical point, to avoid rendering the Applicants' own earlier points needless, the 5-year period should occur in the intervening period not covered by the 5 years following the date of completion of the registration procedure nor by the 5 years prior to the filing of the present application. In any case, nothing turns on this.

Essence and Purpose of Revocation Proceedings

15 It bears reiteration that the essence of revocation proceedings under Section 22(1)(a) and (b) is that of "use". As disgruntled as an applicant for revocation may be over the apparent misappropriation of his mark, he does not succeed in his application because the marks in question are confusingly similar or even identical. Neither does he succeed in a revocation action by crossing the high threshold to prove bad faith on the part of the registered proprietor. Such grounds rightly fall within the purview of invalidation proceedings under Section 23 of the Act, which have not been instituted by the Applicants in this case.

16 When it comes to Section 22(1)(a) and (b) of the Act, a number of elements relating to "use" also need to be properly established. These elements generally correspond to the questions of "what", "where", "when", "which", "how" and "who" as follows:

What: Did the use relate to *the mark*?

Where: Did the use take place *in Singapore*?

When: Did the use take place within the *relevant time*?

Which: Was the use in relation to the *goods/services* for which the mark is registered?

How: Was the use *in the course of trade*?

Who: Was the use by the *proprietor* or *with his consent*?

17 Certainly, the above elements are not exhaustive and from time to time, related issues of the nature of the purported use itself; whether such use was genuine; and whether the evidence itself was convincing, also arise in revocation proceedings.

18 The Principal Assistant Registrar in *MCI Group Holdings SA v Secondment Pty Ltd* [2014] SGIPOS 15 (“*MCI*”) succinctly summarised the policy reasons why unused marks must be removed from the register at [42]:

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.”

19 The decision in *MCI* closes vividly at [49] as follows:

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.

and it is with this “*colourful metaphor*” that the analysis of this case begins.

Decision on Section 22(1)(a) and (b)

20 The Proprietors' position is that they have been using the Subject Mark in Singapore in relation to footwear since 1985.

21 Their purported evidence of use is as follows:

S/No.	Summary of Evidence	Dated	Found In
1	Photographs of footwear bearing Subject Mark	Undated	SD1, Exhibit B, pp 7-22, 25-26
2	Photographs of footwear in a shoe shop setting; Subject Mark not seen	Undated	SD1, Exhibit B, pp 23-24
3	Photographs of children and other persons in a shoe shop setting; Subject Mark not seen	Mostly undated. Photographs of children dated 16 November 1996. Photograph of man with boy dated 10 February 2000.	SD1, Exhibit B, pp 27-32
4	Statement by Proprietors' Managing Director	26 June 2012	SD1, Exhibit D, p 42
5	Letter from manufacturer in China	22 February 2006	SD1, Exhibit D, p 43
6	Invoice and order forms from manufacturer in China	8 November 2011	SD 4, Exhibit F, pp 9-11 and SD 7, Exhibit G, pp3-4

22 I will deal with each item of evidence in [21] sequentially.

23 At first glance, Item 1 of the Proprietors' purported evidence of use appears convincing. The Subject Mark has been clearly applied to the goods in respect of which it is registered, namely footwear. However, the inquiry does not end here. The Applicants rightly pointed out that the photographs are undated and do not establish that the goods have been sold by the Proprietors or sold in Singapore.

24 Further, even given that I am prepared to accept evidence of the application of the Subject Mark to the goods in the course of trade as evidence of its use (Section 27(4)(a) of the Act read with *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co)* [2003] 4 SLR(R) 92 at [53]) without requiring the Proprietors to demonstrate *sale* of goods bearing the Subject Mark, this item of evidence is still sorely lacking in its time and geographical markers.

25 Item 2 of the Proprietors' purported evidence of use comprises two undated photographs. The first of these shows rows of shoes on display in what is apparently a shoe shop. Shoe boxes, bags on sale and some plastic stools are also visible in the photograph. The second photograph is a shot of a shopfront with a signboard over the length of the entrance that says "Widdy TPLS 01-725". On the right section of the second photograph appears the rows of shoes, shoe boxes, bags on sale and plastic stools

that were seen in the first photograph. The Subject Mark is not sighted in either of these two photographs. The proper inference to draw from Item 2 of the evidence at [21] is that at some point in time, there existed a shoe shop trading under the name “Widdy TPLS” at unit number 01-725. The photographs here do not disclose the use of the Subject Mark, and there is no need to go further into the other factors such as date and locality.

26 Item 3 of the Proprietors’ purported evidence of use comprises twelve photos, mostly undated, of children and other persons in a shoe shop setting. Like Item 2, the use of the Subject Mark is not seen here, obviating the need to delve further.

27 The question may arise whether Items 1, 2 and 3 of the evidence at [21] may somehow be combined to support a finding of evidence of use. After all, Mr Chai Hian Kwong did declare, at paragraph 5 of SD1, that “*The Respondents’ footwear bearing the Subject Mark has continuously been sold and offered for sale in Singapore at their retail shops since 1985. The Respondents were operating their retail shop at Fu Lu Shou Complex from 1985 to around 3 to 4 years ago. Thereafter, the Respondents relocated their retail shop to Toa Payoh Central at Block 178. A second shop of the Respondents is located at Bedok Central at Block 210. Exhibited hereto and marked “B” are copies of the photographs of footwear bearing the Subject Mark as well as current and old photographs of the Respondents’ shops.*”

28 I am mindful of the words of the Court of Appeal in ***Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd*** [2009] S SLR(R) 814 (“***Wing Joo Loong***”) at [44]:

Pursuant to s 105 of the current TMA (see [33]–[34] above), it is incumbent on the First Defendant to show that there was genuine use of the Opposed Mark during the Relevant Period. In *La Mer Technology (2008)* ([41] *supra*), the European Court of First Instance stated, based on its past decisions, that “genuine use of a trade mark [could not] be proved by means of probabilities or suppositions” (at [59]), but must instead be “demonstrated by *solid and objective evidence* of effective and sufficient use of the trade mark on the market concerned” [emphasis added] (*ibid*).

29 In view of the standard of evidence required by the Court of Appeal in ***Wing Joo Loong***, it would be too much of an evidentiary stretch to assume that the footwear bearing the Subject Mark (Item 1) are sold in the shoe shops (seen in Items 2 and 3), without more. Even if I were to provisionally accept that they are, the lack of evidence whether such use took place within the Relevant Dates and in Singapore further hinders a finding of genuine use of the Subject Mark.

30 Moving on to Item 4 of the Proprietors’ purported evidence of use, this statement of Chai Moi Chin, Managing Director of Widdy Trading Pte Ltd, states:

26 June 2012

I, Chai Moi Chin of NRIC No. [redacted], hereby declare that I have been working in **WIDDY TRADING PTE LTD** since 1990, at 149 Rochor Road #02-19 Fu Lu Shou Complex up till present day at other branches. Thus, I would be able to assure that “CHEANEY” shoes have been on sale since then.

WIDDY TRADING PTD (sic) LTD

[signed]
CHAI MOI CHIN
Managing Director

31 Remarkably, the Proprietors have not seen fit to adduce the above as a sworn statement under the Oaths and Declarations Act (Cap. 211), in order to support their position. Neither has any reason been proffered for the inability of the Proprietors’ Managing Director to do so. The Applicants submitted that *“any statement from the Respondent’s Managing Director, without being supported by any evidence, should be viewed as not relevant and/or unreliable. Moreover, the said declaration was not solemnly declared by affirmation or on oath before a Notary Public, and merely annexed as an exhibit. As a result, the Applicant submits that its reliability and authenticity should be cast in doubt.”* At best, I am prepared to accept the above statement for the fact that it was made, but not for the truth of the statement itself.

32 Moving on, Item 5 of the Proprietors’ evidence at [21] is a copy of a letter in Chinese. It is not accompanied by any translation and is purportedly from the Proprietors’ manufacturer in China. At paragraph 6 of the Proprietors’ SD1, Chai Hian Kwong states that *“... since 2006, Shun Sheng Shoe Company in China, one of the Respondents’ manufacturers/suppliers, has been manufacturing footwear for the Respondents. The Respondents have also authorised Shun Sheng Shoe (sic) Company to apply the Respondents’ registered trade marks, including the Subject Mark, on the footwear. Exhibited and collectively marked “D” ... (is)... the ... letter from Shun Shing (sic) Shoes Company certifying production of footwear (sic) the Respondents since the year 2006.”* At paragraph 11 of the Proprietors’ SD4, Chai Hian Kwong explains that this letter is *“for the purpose of certifying the start of the business relationship with the Respondents. It is meant for use in China with the Chinese customs, freight forwarders and other trade parties.”*

33 This item of evidence does not add to the Proprietors’ case. It is not translated into the English language for one to begin apprehending its content. It is also an unsworn statement that cannot stand up to scrutiny in adversarial proceedings. Crucially, it does not refer to the Subject Mark at all. A list of thirteen numbers (apparently model numbers) is sighted on this letter, but there is nothing to link this with the Subject Mark.

34 Item 6 of the evidence listed in [21] is described at paragraph 9 of SD4 as *“copies of the invoice and order forms dated 8 November 2011 for the manufacture of various*

models of footwear under the Respondents' CHEANEY brand for export to the Respondents." These have been obtained from the Proprietors' manufacturer in China, Shun Sheng Shoes Company. The evidence reflects the order date (8 November 2011), the delivery date (10 December 2011), the Subject Mark and the Proprietors (shown on the invoice/purchase order as customer of the order). However, there is no indication of where the footwear bearing the Subject Mark were delivered. In the order form, the customer is indicated as "Mr. Cai (Singapore)"; this is the closest reference to Singapore as a locality. However, it still cannot be assumed that an order from a customer in Singapore is always to be delivered to the location of the customer. In the world of trade, it is not uncommon for finished goods to be delivered directly to the customer's downstream customers elsewhere in the world.

35 The Court of Appeal in *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919 ("*Nike*") opined at [18]-[19]:

... The invoice and the bill of lading were no more than *prima facie* evidence of the goods being shipped. However, that was no proof that the goods had in fact arrived in Singapore. While the facts in this case may appear a little stronger than "*NODOZ*" Trade Mark in the sense that here a bill of lading was produced, we did not think it satisfied the requirement of overwhelmingly convincing proof. Campomar should have produced evidence relating to the goods' arrival in Singapore. Other than a bland statement made by counsel of Campomar to the judge below that he had approached the importer, Bhojwani's, to give evidence and the importer had declined, no further explanation or details as to the efforts made were offered by Campomar...

There must be some document trail in relation to the goods' arrival in Singapore. However, such documents were not adduced as evidence in court. There was also no evidence as to the receipt of payment for the goods. We were unable to see how the evidence adduced by Campomar could be described as "overwhelmingly convincing" when not a single piece of evidence from Singapore was produced. It must be borne in mind that what was required to be established was the goods' arrival in Singapore.

36 Comparing *Nike* with the present case, the latter's evidence is even thinner. At best, Item 6 of the Proprietors' evidence in [21] proves that on 8 November 2011, a Mr Cai. (Singapore) from Widdy Tading (*sic*) Pte Ltd ordered a number of shoes corresponding to various model numbers, colours and sizes from a company in Guangzhou, China, called Shun Sheng Shoes Company. The "Goods Requirements" specify "Brand: Cheaney" and "Black inner box without wordings"; and the total cost is ¥46335. The delivery date of 10 December 2011 as it appears on the order forms and the invoice/purchase order cannot, without more, prove that the goods were in fact delivered on this date. Proof of export could be evinced by a bill of lading (as was so in *Nike* but is absent in the present case) and, further, because revocation proceedings concern the use of a mark *in the territory of Singapore*, proof of arrival in Singapore is required.

37 In light of the above, the Proprietors have not established that the shoes bearing the Subject Mark were shipped and entered Singapore during the Relevant Dates. Item 6 of the evidence listed in [21] therefore falls short by a few steps and does not assist the Proprietors' case.

Conclusion on Grounds of Revocation under Section 22(1)(a) and (b)

38 As the Proprietors have not discharged their burden of proof to show the relevant use of the Subject Mark in Singapore at any time, the revocation succeeds on both grounds, under Section 22(1)(a) and (b) of the Act.

Ancillary Observations

39 The line of inquiry has effectively ended with the above finding, and I now take the opportunity to make a few ancillary observations on the conduct of these proceedings as follows.

(1) Small Scale Operation of Proprietors

40 Harking back to the introduction at [11] above, the Proprietors have said more than once, both in their evidence and in their submissions at the hearing, that they were a small family business and did not keep records of inventory or sales by brand. Transactions were mainly by cash and no receipts are issued. They claimed that if they had known they would be faced with the present revocation proceedings, they would have kept better records. As they could not turn back the clock, the Proprietors declared that they have tried to give the best evidence they had and which they could obtain within reasonable means.

41 Whether the Proprietors had indeed given the best evidence they had and could obtain within reasonable means is uncertain. Evidence that should have been readily available from the Proprietors, for instance, a declaration made under the Oaths and Declaration Act, instead of an unsworn statement, by the Proprietors' Managing Director was curiously not adduced. Likewise, the Proprietors would be in the best position to possess evidence of the arrival in Singapore (if any) of the shipment of footwear from Shun Sheng Shoes Company in China; and yet, the best evidence before us were only copies of the invoice/purchase order and order forms.

42 Leaving aside the issue of whether the Proprietors have given their best, reasonably available evidence, the larger point is that there are strong policy reasons (see [18]-[19]) why unused marks must be removed from the register. Against this backdrop, a registered proprietor has the burden of showing use made of the Subject Mark (Section 105 of the Act) – which is the fairer position as he would be in the best position to show such use in contrast to the applicant for revocation's position. Being a business with small scale operations (and poor record-keeping) in itself will not salvage a case where the evidence does not show genuine use of the mark in Singapore.

43 This is also a cautionary tale to registered proprietors, who, in the euphoria of obtaining official registration for their trade marks, may forget that their marks are vulnerable to challenge, post-registration. Basic intellectual property management, such as tracking the renewal deadlines of trade mark registrations and documenting evidence of use within the relevant time periods, is not the preserve of large, wealthy and sophisticated companies. It is incumbent on every trade mark owner.

(2) *“Evidence of Non-Use”?*

44 The parties have also expended much effort in their evidence and submissions dealing with the Applicants’ evidence by their private investigator Natalija Marcinska. No less than five out of the eight statutory declarations (namely SD2, SD3, SD4, SD5, SD6) relate to the private investigation report. Much of the contention was over Natalija Marcinska’s report of a telephone conversation with an alleged personnel of the Proprietors, in which the latter was reported to have said “Oh, Cheaney! It was a long time ago, I don’t remember when... This brand is a UK brand, these shoes are from the UK, I don’t sell them now; it was previously, long time ago.” As expected, objections of hearsay and factual inaccuracies surfaced.

45 It is important, in the heat of adversarial proceedings and in the flurry of exchanges, to keep the right perspective in view. Revocation proceedings turn on evidence of use, with the burden of proof on the registered proprietor. It is rather odd for the Proprietors to claim that the Applicants have not adduced any credible evidence of non-use, as if the latter had a burden to prove non-use. Rule 59(1A)(a) of the Trade Marks Rules (Cap 332, 2008 Rev Ed) provides that the applicant may file a statutory declaration *“setting out the evidence he wishes to adduce in support of his application”*. This is optional, as the burden is ultimately on the registered proprietor to demonstrate genuine use of his mark in Singapore. An applicant for revocation may typically submit a private investigation report in evidence, in any case, but this is more to show some ground for believing that the mark in question is not used, rather than because of any duty to prove non-use.

46 The stark reality is that even if the Applicants’ evidence does not demonstrate non-use, this does not help the Proprietors where they have not shown genuine use of the Subject Mark in Singapore.

(3) *Cost-effectiveness of Conduct of Proceedings*

47 At [15], I had reiterated that the essence of revocation proceedings under Section 22(1)(a) and (b) is that of “use”. The Applicants might be indignant that another trader had possibly misappropriated their mark (paragraph 17 of SD2, paragraph 15 of SD5), but these are revocation proceedings before us, not invalidation proceedings. Although the Applicants have couched it as *“... the Deponent... intended to take advantage of the reputation CHEANEY had abroad at the time of filing. Therefore, the Respondent’s feeble and untruthful attempt to claim ignorance of the CHEANEY brand from the UK must be taken as casting very serious doubt on the quality and accuracy of the sworn statements by the Deponent in the present revocation proceedings”*, and are entitled to do

so, the fact is these proceedings could have been conducted in a more cost-effective manner.

48 The Applicants' SD5 alone is 266 pages long. Much of this is devoted to (i) evidence that purports to show the Proprietors' history in registering or seeking to register foreign trade marks or colourable imitations thereof (e.g. "Havarina", evoking the Brazilian brand "Havaianas"; "Trackers", evoking the UK brand "Tricker's"); and (ii) evidence showing use of the Applicants' own "CHEANEY" trade mark (e.g. copies of Catalogues of Cheaney (UK) shoes from 1979 to 1990) and annual sales figures therefor in Asia. Again, the Applicants are entitled to adduce the latter evidence, in response to the Proprietors' claim, at paragraph 12 of SD4, that "*There is also no evidence that the Applicants have business operations and have sold their CHEANEY shoes in Singapore or elsewhere in Asia prior to 1990.*" However, both parties seem to have lost sight of the essence of the proceedings, which centres on use of the Subject Mark. Hence, the Proprietors' claim at paragraph 12 of SD4 is misguided as it is irrelevant to its defence (that there has been use of the Subject Mark); and the Applicants have expended much resources responding to an irrelevant claim with a statutory declaration with voluminous exhibits. The Proprietors may have had the wisdom to elect revocation, rather than invalidation, proceedings as the issues are narrower; a pity then that unnecessary costs were incurred in the conduct of these proceedings.

49 In the end, this case was decided on the evidence relating to purported use of the Subject Mark by the Proprietors at [21], and not on the evidence described at [44], [47]-[48] above. Being a low cost tribunal, the Registrar awards costs that do not fully compensate a party for the expenses actually incurred. As such, the practical onus is on the parties and their agents to conduct their case with circumspection and prudence, with an eye on the proportionality between costs incurred and costs that may be recovered, so as to concentrate limited resources on the true issue(s) in dispute.

Conclusion

50 As the revocation succeeds under Section 22(1)(a) and (b), the registration of the Subject Mark is revoked as from 1 December 1996, which is the first day after the 5-year period following completion of registration. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 30th day of June 2015

See Tho Sok Yee

Principal Assistant Registrar of Trade Marks
Hearings and Mediation Group
Intellectual Property Office of Singapore