

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

Trade Mark No. T8102365E
6 January 2015

IN THE MATTER OF A TRADE MARK REGISTRATION

IN THE NAME OF

PROCTER & GAMBLE INTERNATIONAL OPERATIONS SA

AND

APPLICATION FOR REVOCATION THEREOF BY

LISBETH ENTERPRISES LIMITED

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

Ms Elaine Tan (Amica Law LLC) for the Applicants

Cur Adv Vult

GROUNDINGS OF DECISION

1 The subject of these revocation proceedings is Trade Mark No. T8102365E ("the Subject Mark"):

Inspiré

2 The Subject Mark was registered on 1 June 1981 in Class 3 in respect of "Eau de Cologne, perfumes, essential oils, non-medicated toilet preparations, cosmetics, anti-perspirants, soaps, dentifrices and preparations for the hair". The date of completion of registration is 25 May 1984. After a series of assignments, the Subject Mark is currently in the name of Procter & Gamble International Operations SA, who shall for all intents and purposes be referred to as "the Proprietors" in these proceedings.

3 On 16 October 2008, Lisbeth Enterprises 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 16 February 2009.

4 The Applicants filed evidence in support of the application on 7 June 2010. The Proprietors filed evidence in support of the continued registration of the Subject Mark on 25 June 2012. The Applicants filed evidence in reply on 20 December 2012. A Pre-Hearing Review was held on 20 February 2013, and a second one scheduled for 10 September 2014 was vacated, after which the application for revocation was heard on 6 January 2015. Only the Applicants elected to attend the hearing.

Grounds of Revocation

5 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.

Applicants' Evidence

6 The Applicants' evidence comprises a Statutory Declaration made by Li Ping Yee Louisa, Chief Operating Officer of the Applicants, on 4 June 2010 in Hong Kong, as well as a Statutory Declaration made by Philip Tan See Wei, Managing Partner of Commercial Investigations LLP, on 4 June 2010 in Singapore. The Applicants' evidence in reply took the form of a second Statutory Declaration by Li Ping Yee Louisa on 11 December 2012 in Hong Kong.

Proprietors' Evidence

7 The Proprietors' evidence comprises a Statutory Declaration made by Nastassia Saint-Severin, Senior Counsel (Legal/IP) of the Proprietors, on 14 June 2012 in Geneva, Switzerland ("Saint-Severin's SD").

Burden of Proof

8 Under Section 105 of the Act, the Proprietors have the burden of showing use made of the Subject Mark.

Background

9 The Applicants operate fitness and beauty clubs in the Asia Pacific region, with branches in Singapore, Malaysia, Thailand and Hong Kong. Under their Phillip Wain brand, the Applicants have launched “Inspire for Men” in 2004 to provide beauty, slimming and massage services customized specially for men. Related to these services, the Applicants own various registered trade marks in Singapore (e.g. TM No. T0721117F



for **INSPIRE** by Phillip Wain in Classes 3, 5 and 35). The Applicants also applied, on 29 October 2007, to register **INSPIRE** as a plain word mark in Class 3 under TM No. T0721116H-03 but the Registrar cited the Subject Mark in objection. They thus commenced the present proceedings to revoke the Subject Mark, to overcome the Registrar’s objection.

10 The Proprietors, in essence, claim to have used the Subject Mark on a fragrance line endorsed by the American celebrity singer, Christina Aguilera:



MAIN DECISION

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

11 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

12 The Applicants submit that the registration of the Subject Mark should be revoked as:

- (i) there had been no genuine use of the Subject Mark by the Proprietors for a period of 5 years subsequent to 25 May 1984; and/or
- (ii) any use (which is not admitted) of the Subject Mark has been suspended for an uninterrupted period of 5 years prior to the filing of this revocation application between 2003 and 2008.

13 In line with the parameters of the Applicants' pleadings, the relevant dates under consideration are as follows:

- (i) The registration procedure was completed on 25 May 1984. The 5-year period immediately following the completion of registration ended on 25 May 1989. The period of use (or non-use) in issue is *26 May 1984 to 25 May 1989*.
- (ii) The application for revocation was filed on 16 October 2008. The 5-year period prior to this filing starts from 16 October 2003. The period of use (or non-use) in issue is *16 October 2003 to 15 October 2008*.

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

14 The essence of the Proprietors' defence is that the use of the Subject Mark started in September 2008, before the application for revocation was filed (on 16 October 2008) and that preparations for the commencement of use of the Subject Mark began before the Proprietors became aware that the application for revocation might be made.

15 Their purported evidence of preparation for the commencement of use, or of use itself, is as follows:

- (i) [Preparation for use] Email discussions between Wella Service GmbH's P&G Prestige and Professional division and one Christina Packham, Global Brand Manager of Christina Aguilera Fragrances and New Licenses, in October 2007 on the potential use of INSPIRE on a fragrance to be endorsed by Christina Aguilera
- (ii) [Preparation for use] Undated presentation slides indicating the launch of "Christina Aguilera INSPIRE" in the Fall of 2008. Saint-Severin's SD claims at paragraph 6 that these were dated January 2008 and were presented to distributor markets in January 2008, though none of these claims were substantiated in the exhibits
- (iii) [Commencement of use] Saint-Severin's SD claims at paragraph 7 that the fragrance "Christina Aguilera INSPIRE" was released worldwide in early September 2008
- (iv) [Corroborating "evidence of use"] Online reviews of the fragrance "Christina Aguilera INSPIRE" printed on 5 June 2015, with most reviews undated, one review (on <http://style.popcrunch.com>) dated 2 September 2008 and another main review (on www.nstperfume.com/2008) dated 1 October 2008, followed by 50 comments from 1 October 2008 to 13 November 2009.
- (v) ["Evidence of use"] Internet printouts dated 30 May 2012 showing that "Christina Aguilera INSPIRE" was available for sale on Singapore-based websites such as Perfume Hypermart (www.perfumehypermart.com) and Safa Fragrance (www.safafragrance.com)
- (vi) ["Evidence of use"] Internet printouts dated 30 May 2012 showing that "Christina Aguilera INSPIRE" was available for sale on eBay and Amazon.com websites.

16 In a revocation for non-use, the questions to be asked revolve around the "where", "when", "which", "who" and "what". I will consider them in turn below.

Issue 1: "Where" - Whether the evidence pertained to use in Singapore

17 It is clear from Section 22(1)(a) that for a registered proprietor to defend his registration successfully, the use of his registered trade mark must take place *in Singapore*.

18 The Proprietors' evidence is, with two items requiring further treatment below, not specific to Singapore. The most generic evidence that may ostensibly pertain to Singapore has been described at [15(ii) and (iii)] above, and perhaps corroborated by online reviews described at [15(iv)]. Saint-Severin's SD claims at paragraph 6 that the power point slides were "*presented to all distributor markets by Christina Packham in January 2008*". The same statutory declaration at paragraph 7 claims that "*Products bearing the Registered Trade Mark were released worldwide in early September 2008*". However, it was never made clear in these assertions, nor in the online reviews described at [15(iv)], that any use took place in Singapore. It is not lightly assumed, in the absence of clear evidence, that the Proprietors' distributor markets included Singapore. The phrase "*released worldwide*" in paragraph 7 of Saint-Severin's SD is also not to be read

literally as “released in every single country or place in the world”, but should be interpreted reasonably as “released in global distributor markets”. Again, it is not unequivocal that this worldwide release extended to Singapore.

19 The two items of evidence requiring further treatment relate to the evidence described at [15(v) and (vi)] above. There is always an inherent tension between use on the internet and the traditional tenet of territoriality in trade marks law.

20 With regard to the Proprietors’ internet printouts showing that the “Christina Aguilera INSPIRE” fragrance was available for sale on Perfume Hypermart (www.perfumehypermart.com), a prominent banner near the top of the webpage states “FREE DELIVERY on orders delivered within Singapore”. I am satisfied that the offer and advertisement for sale on this website targets Singapore consumers specifically and accept the nexus of such use with Singapore. However, this item of evidence is still subject to scrutiny on the remaining questions of “when”, “which”, “who” and “what” below.

21 As for the Proprietors’ internet printouts showing the “Christina Aguilera INSPIRE” fragrance on sale at Safa Fragrance’s website (www.safafragrance.com), the best evidence is the following extract of the website’s write-up:

Safa Fragrance is the first prominent company, based in Singapore, to provide priority and express delivery services. Formed in April 2009, we have obtained strong influential relationships with reputable large authorized dealers and retailers around Singapore and globally.

...

In addition to the extent, we offer meet-up services at customer’s own convenient (*sic*) and according to their timing respectively.

...

All prices are in SGD. Copyright 2012 SAFA FRAGRANCE.

22 Taking the totality of the above extract, I am persuaded that there is a sufficient nexus between the offer and advertisement for sale and the territory of Singapore. Nevertheless, issues of “when”, “which”, “who” and “what” relating to this item of evidence remain to be considered below.

23 As for the Proprietors’ internet printouts showing the “Christina Aguilera INSPIRE” fragrance on sale on eBay and Amazon.com websites, the decision in *Autozone Automotive Enterprise v Autozone Parts, Inc* [2013] SGIPOS 1 (“*Autozone*”) is relevant and cites two Singapore Court of Appeal decisions for the principles:

47 The legal position in Singapore is clear. The learned VK Rajah JA opined in *Weir Warman* at [106] as follows:

106 In *800-Flowers Trade Mark* [2002] FSR 12, Buxton LJ discussed the offer of goods under a trade mark on an Internet website. He stated at 220:

There is something inherently unrealistic in saying that A "uses" his mark in the United Kingdom when all that he does is to place the mark on the Internet, from a location outside the United Kingdom, and simply wait in the hope that someone from the United Kingdom will download it and thereby create use on the part of A.

He added further on the same page:

[T]he very idea of "use" within a certain area would seem to require some active step in that area on the part of the user that goes beyond providing facilities that enable others to bring the mark into the area. Of course, if persons in the United Kingdom seek the mark on the Internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the advertisement or encouragement in itself is likely to suffice to establish the necessary use. [emphasis added]

This succinct summary of the English position is persuasively logical and ought to be followed in Singapore.

24 *Autozone* also cited the Court of Appeal decision in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanresorts*") at [52]-[54]:

52 With regard to the 20 domain names which have been registered for the Respondents' "Aman" websites, no weight should be placed at all on the fact that those domain names were registered here - that is a purely technical matter which does not influence the extent of exposure of the "Aman" names. More importantly, it must be noted that although the Internet has the potential to be used for giving goods, services and businesses instant exposure across the entire world, it does not follow that any small, dinky business can set up a website and then claim that it has gained worldwide recognition. The Internet's power of exposure is only a *potential* power. This issue was given some consideration in *800-FLOWERS Trade Mark* [2000] FSR 697 ("the first instance decision in *800-FLOWERS*"), which concerned a dispute over the registration of a service mark. In that case, an application to register a name as a service mark was objected to on, *inter alia*, the ground that the name had not been used in the UK. The applicant sought to counter this argument by relying on its use of that name for its website. Jacob J observed very sensibly (at 705):

Mr Hobbs [counsel for the applicant] submitted that any use of a trade mark on any website, wherever the owner of the site was, was potentially

a trade mark infringement anywhere in the world because website use is in an omnipresent cyberspace: that placing a trade mark on a website was 'putting a tentacle' into the computer user's premises. I questioned this with an example: a fishmonger in Bootle who puts his wares and prices on his own website, for instance, for local delivery can hardly be said to [be] trying to sell the fish to the whole world or even the whole country. And if any web surfer in some other country happens upon that website he will simply say 'this is not for me' and move on. For trade mark laws to intrude where a website owner is not intending to address the world but only a local clientele and where anyone seeing the site would so understand him would be absurd. So I think that the mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world.

53 The requirement of "use" of a trade mark in a jurisdiction (in the context of trade mark law) is, of course, pegged at a higher standard than the standard which applies when determining whether goodwill exists in a name (in the latter context, exposure, as opposed to use, of the name in question is the relevant criterion). But, the principle that putting a name up on the Internet does not translate into instant global presence of that name is applicable *vis-à-vis* the analysis of goodwill in passing off actions.

54 It follows that evidence of the existence *per se* of domain names and websites featuring the name in which goodwill is said to exist will ordinarily be insufficient as proof of exposure of that name; something in addition to proof of the mere existence of such domain names and websites must be shown in order to establish that there has been sufficient exposure of the name in question. This approach is not dissimilar to that adopted by Buxton LJ in *800-FLOWERS Trade Mark* [2002] FSR 12 ("the appellate court's decision in *800-FLOWERS*"), which was the English Court of Appeal's decision on the appeal and the cross-appeal arising from the first instance decision in *800-FLOWERS*. In the appellate court's decision in *800-FLOWERS*, Buxton LJ commented, in the context of use of a trade mark, that (at [138]):

[T]he very idea of 'use' within a certain area would seem to require some active step in that area on the part of the [trade mark owner] that goes beyond providing facilities that enable others to bring the mark into the area.

Such "active step[s]" (*ibid*), the learned judge suggested, could take the form of "direct encouragement or advertisement by the [trade mark] owner" (*ibid*) which led consumers to the website featuring the trade mark in question...

25 The above principle requiring an "active step" was applied more recently in *Romanson Co., Ltd v Festina Lotus, S.A.* [2015] SGIPOS 3 ("*Festina*") (currently on appeal to the High Court) in relation to various items of evidence showing advertisements and offers for sale on websites such as www.festina.com and eBay.

26 On the facts of the present case, the Proprietors have not demonstrated any “active step” taken in relation to the Singapore market beyond web listings *per se* on the eBay and Amazon.com websites. Although the eBay website (www.ebay.com.sg) reflects a “Singapore” country code top-level domain, it does not necessarily follow that there has been an “active step” taken to attract custom from Singapore, beyond listing the fragrance on the website. The sellers also appear to be opportunistic ones from outside Singapore, in the United Kingdom. Accordingly, it cannot be concluded that there has been use *in Singapore* through the eBay and Amazon.com websites. Curiously, *Festina* also addressed similar evidence from eBay Singapore at [88]-[89] and came to the same conclusion. This underscores the importance, from a practical perspective, of adducing clear evidence of “active steps” taken when dealing with internet use, if a registered proprietor wishes to defend the registration of his trade mark.

Issue 2: "When" - Whether the evidence of use pre-dated the application for revocation and if so, whether it could still be regarded if it took place within 3 months before the application for revocation

27 From the items of evidence listed at [15] above, those described at [15(v) and (vi)] clearly post-date the application for revocation on 16 October 2008 and should be disregarded. Likewise the comments to the online reviews described at [15(iv)] which are made after 16 October 2008.

28 The use of the Subject Mark is claimed to commence in early September 2008 (paragraph 16 of Saint-Severin’s SD), when the fragrance line “Christina Aguilera INSPIRE” was launched in the month immediately preceding the application for revocation filed on 16 October 2008. Section 22(3) of the Act, read with Section 22(4), is applicable, to the effect that any use within the period of 3 months before 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”. To avail themselves of this saving provision, the Proprietors claim that preparations for the commencement of use took place from 2007, before they were aware that the application for revocation was filed. However, the Applicants counter that by September 2008, when the Proprietors’ fragrance was launched, the latter would be well aware that the Applicants had filed a corresponding application to revoke the latter’s Hong Kong Trade Mark Registration No. 19820079 on 18 February 2008.

29 On the balance, accepting the Applicants’ premise that the Proprietors would have been aware that an application for revocation might be made in Singapore following a similar application for revocation in Hong Kong (in relation to the mark “Inspire”), the relevant date would be 18 February 2008. There is no reason for me to disbelieve the Proprietors’ item of evidence described at [15(i)] above where the potential use of “INSPIRE” was discussed in 2007. Those discussions covered various points such as the compatibility of various options (of marks) with Christina Aguilera’s new image; and the concerns behind using “INSPIRED” (narrower specification and earlier German registration for “BE INSPIRED”) as opposed to “INSPIRE”. At no point did a concern

arise that the Subject Mark might be challenged for non-use, not in Singapore, not anywhere else where the same or similar mark is registered.

30 Hence, accepting that use of the Subject Mark started in September 2008 (focusing on the “when” and not the “where” at this juncture), on the issue of whether the Proprietors can rely on Section 22(4) of the Act to have such evidence of use taken into account, I would find in the Proprietors’ favour.

31 However, as I have found at [18] above under Issue 1 that the use of the Subject Mark in September 2008 has not been shown to extend to Singapore, applying Section 22(4) in the Proprietors’ favour under Issue 2 here does not assist them in the final analysis.

Issue 3: "Which" - Whether the evidence of use pertained to the goods claimed

32 It is also clear from Section 22(a) of the Act that any use must be "in relation to the goods or services for which it is registered".

33 In the present case, the Proprietors' case is that they have used the Subject Mark on a fragrance line endorsed by Christina Aguilera. However, the Subject Mark is registered in respect of a wider specification, namely "Eau de Cologne, perfumes, essential oils, non-medicated toilet preparations, cosmetics, anti-perspirants, soaps, dentifrices and preparations for the hair".

34 As such, even if there were the requisite, relevant use in Singapore within the relevant time period, the Proprietors would, at the most, have shown that there was use in relation to "Eau de Cologne, perfumes" but not the remaining goods "essential oils, non-medicated toilet preparations, cosmetics, anti-perspirants, soaps, dentifrices and preparations for the hair". If so, even if the evidence bore out genuine use of the Subject Mark in Singapore in the relevant time period, there would still be a revocation, albeit partial, of the registration in respect of "essential oils, non-medicated toilet preparations, cosmetics, anti-perspirants, soaps, dentifrices and preparations for the hair".

Issue 4: "Who" - Whether the evidence of use supported a finding of use by the Proprietors or with the Proprietors’ consent

35 The Assistant Registrar in *Festina* reviewed this issue in considerable detail, reaching some conclusions in [70] to [72]:

70 That being said, it is still necessary for the Registered Proprietors to prove that they have given consent to the third party to use the relevant trade mark in question. In all the cases considered above, there was clear evidence of the proprietor's consent, except for the case of *Sunrider*, where such consent was implied from the circumstances (and there was no denial that such consent was given). In *Sunrider*, the court accepted evidence from the registered proprietor (a man named Juan Espadafor Caba) consisting of proof of use of the trade mark in 14 invoices and orders (10 of which pre-dated the relevant date) even though

these invoices were in the name of a company called Industrias Espadafor SA. In both *Einstein* and *Dialog*, the proprietor tendered evidence in the form of witness statements from both the proprietor and the third party, showing that one gave consent to the other to use the registered trade mark in question, as sufficient to prove "consent". In *Einstein*, the Appointed Person noted that both parties had preferred for the matter to be decided on paper without submissions or cross-examination, hence the only evidence was in the form of witness statements. In *Dialog*, the Appointed Person noted that the evidence from the proprietor and the user were "direct and unchallenged evidence" and "no application was made to cross examine either deponent" (*Dialog* at [31]). In *Safari*, the proprietor tendered a declaration that showed that he had given consent to Rover to use the relevant trade mark in the UK, subject to the terms of an undertaking. There was a letter that authorised use of the mark by Rover and a copy of Rover's letter which confirmed the conclusion of this agreement. The agreement was entered into in 1988, prior to the dispute, which was filed on 26 February 1999. Rover accepted that the consent given by the registered proprietor was analogous with a bare licence. (See generally *Safari* at [2], [9], [13], [17])

Conclusion on what is required to establish "consent"

71 Having considered the cases of *Sunrider*, *Einstein*, *Dialog* and *Safari*, I am of the view that there should be an "unequivocal demonstration" of consent in order for it to be found on the facts. However, "consent" may be implied (as in *Sunrider*) as long as there is sufficient evidence that amounts to an unequivocal demonstration of consent. For example, a proprietor who has actual or constructive knowledge of an unrelated third party that is selling goods which bear his trade mark, and acquiesces to the use of the trade mark **and** the sales of these goods (eg. if the products are genuine products), may be able to show that there is "implied" consent. At the end of the day, it is a fact-sensitive enquiry. It is also important to remember that the crux of the enquiry under Section 22(1) of the Act is whether there has been "genuine use" in the course of trade in Singapore, and that the question of whether there has been "consent" is but a part of the enquiry.

"Consent" and Parallel Imports

72 Following from the cases of *Sunrider* and *Einstein* (discussed at paragraphs [67]-[70] above), it is likely that consent can be implied from the circumstances in a "classic" parallel import situation (for a definition of "parallel imports", see *Ng-Loy (2nd ed)* at [18.5.1]), as long as there is sufficient evidence of the circumstances that demonstrates an unequivocal demonstration of "consent" to the use of the mark by the proprietor. However, due to the obvious differences in the wording of the legislation in Sections 29(1) and Section 22(1) of the Act (see discussion at paragraphs [52]-[55] above), I would not go as far as to say that consent is *automatically* "deemed" by virtue of the fact that the goods are genuine goods manufactured by the proprietor himself. The proprietor still bears the burden of proving factual consent.

36 With regard to the item of evidence described under [15(iii)] above, paragraph 7 of Saint-Severin's SD declares that Procter & Gamble Manufacturing Cologne GmbH (who were the proprietors on record at the time Saint-Severin's SD was made in June 2012) were the exclusive licensee for the fragrance "Christina Aguilera INSPIRE" (which was launched in 2008 before a subsequent transfer of ownership of the Subject Mark to Procter & Gamble International Operations SA, the current Proprietors). This statement is curious, as the declarant suggests that the proprietors on record then and the exclusive licensee are one and the same entity. However, in the ordinary course of things, a trade mark proprietor already has the right to use the trade mark and need not obtain a licence to do so, much less license itself. Nevertheless, with regard to the launch of the fragrance "Christina Aguilera INSPIRE", I am inclined to believe that there was use (without addressing the question of "where") by the proprietors (of that time) or with the proprietors' consent by related companies in the Procter & Gamble group.

37 The issue of consent is also an interesting and live one when considering the items of evidence described under [15(v) and (vi)] above. These show the fragrance "Christina Aguilera INSPIRE" offered for sale on third party websites such as www.perfumehypermart.com and www.ebay.com.sg.

38 In the present case, the Proprietors purport to rely on "evidence of use" – sale of the fragrance "Christina Aguilera INSPIRE" on third party websites – but have not demonstrated that such "use" is with their consent. There are also no circumstances from which to imply such consent. As such, any use described under [15(v) and (vi)] above would not be relevant for the purposes of defending the registration of the Subject Mark.

39 However, this is by no means a static conclusion. *Festina* is currently on appeal and further jurisprudence on the issues surrounding "consent" may well be developed by the courts.

Issue 5: "What" - Whether it is the Subject Mark that was used

40 The Applicants have also argued that any use (which is not admitted) by the Proprietors only pertains to "INSPIRE" and not to ^{Inspiré} with the French acute accent over the letter "e". They submit that the Subject Mark as registered would be pronounced differently as "in-spee-ray" (actually, "un-spee-ray") as opposed to the English word "INSPIRE". The impression of the (French) Subject Mark pronounced the French way conveys sophistication and elegance, but this is not the case for the sign "INSPIRE", the Applicants contend. They would have the Registrar believe that even if there had been "use", such "use" was of a mark that is markedly different from the Subject Mark as registered and should therefore be discounted.

41 Section 22(2) of the Act makes clear that "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..." The issue here is whether the use of "INSPIRE" is "use in a form differing in elements which do not

alter the distinctive character” of  . The differing element is the letter “E” as compared to “é” and the distinctive character of  is more attributed to the word “Inspire” as a whole than to the French acute accent over the letter "e", such that the general public should perceive “INSPIRE” and  as substantially of the same distinctive character. As such, I am persuaded that should there be genuine use of a mark “INSPIRE”, it should not be discounted even though the form of the Subject Mark is .

42 There is another issue which the Applicants have not raised, and with which I will therefore only deal cursorily. This relates to the way the Proprietors claim to have used the Subject Mark, as follows:



43 It is evident from the above, and congruent with the motivations behind using celebrity endorsements to market products, that the dominant sign is “Christina Aguilera”. This appears above the word “INSPIRE” and occupies more “real estate” on the product packaging than does “INSPIRE”. Would this detract from the “use” of “INSPIRE” as a trade mark? Suffice it to say, probably not here, but the answer depends on the facts of each case. Compound trade marks are used all the time around us, for example in relation to cars: Hyundai Elantra and Hyundai Sonata, where “Hyundai” is rather more dominant and functions as a house mark denoting the car manufacturer whilst “Elantra” and “Sonata” function as trade marks for the respective models of Hyundai cars. At the same time, a note of caution is needed. The discussion here takes place in the context of an application for revocation on the grounds of non-use, and not in other contexts such as whether a registered mark has been infringed if it is used together with other more dominant marks by the alleged infringer.

44 Having considered the questions of “where”, “when”, “which”, “who” and “what” under Issues 1 to 5 respectively, there is no item of the Proprietors’ evidence which fulfils *all* the criteria for “use” in Section 22(1)(a) and (b), such as “use *in Singapore*”, “use within the relevant time”, “use in relation to the goods for which the mark is registered”, “use by the proprietor or with his consent” and “use of *the mark*”. The grounds of revocation under Section 22(1)(a) and (b) therefore succeed.

45 Quoting from the Principal Assistant Registrar’s decision in *MCI Group Holdings SA v Secondment Pty Ltd* [2014] SGIPOS 15 at [49]:

49 Any “use” of the Registered Mark by the Registered Proprietors is clearly not “*in Singapore*” and ... 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.

Conclusion

46 As the revocation succeeds under Section 22(1)(a) and (b), the registration of the Subject Mark is revoked as from 26 May 1989, 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 6th day of April 2015

See Tho Sok Yee

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