

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

Trade Mark No. T9604780F  
29 August 2016

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

**AUCERA S.A.**

**AND**

**APPLICATION FOR REVOCATION THEREOF BY**

**BENTLEY MOTORS LIMITED**

Hearing Officer: Ms Tan Mei Lin  
Principal Assistant Registrar of Trade Marks

Mr William Ong and Ms Amanda Soon (instructed by Marks & Clerk Singapore LLP) and  
Ms Candice Kwok (Marks & Clerk Singapore LLP) for the Applicant  
Ms Gillian Tan and Mr Mark Teng (instructed by Henry Goh (S) Pte Ltd) for the Registered  
Proprietor

*Cur Adv Vult*

**GROUND OF DECISION**

1 Aucera S.A. (“the Proprietor”) is the registered proprietor of Trade Mark No. T9604780F (“the Subject Mark”) for the following mark:

**BENTLEY**

2 The Subject Mark was filed on 11 May 1996 and its registration procedure was completed on 31 August 1998.

3 It is registered in Class 9 respect of the following goods (“the Goods”):

Eyeglass cases, eyeglass chains, eyeglasses, eyeglass frames, sunglasses and spectacles.

4 On 25 November 2014, Bentley Motors Limited (“the Applicant”), applied for the Subject Mark to be revoked for non-use<sup>1</sup>. The Applicant claims that the Subject Mark was not put to genuine use in Singapore in the five years following the completion of the registration process and there are no proper reasons for non-use. Consequently, it requests that the registration be revoked under Section 22(1)(a) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). In the alternative, the Applicant claims that use of the Subject Mark has been suspended for an uninterrupted period of 5 years and there are no proper reasons for non-use. Consequently, it requests that the registration be revoked under Section 22(1)(b) of the Act.

5 The Proprietor filed a counter-statement on 19 March 2015 stating that the Subject Mark has been put to genuine use in the course of trade in Singapore in relation to goods falling into Class 9 during the past 5-year period i.e. between 26 November 2009 to 25 November 2014. A statutory declaration of Cheng Chia-Hsiang dated 12 March 2015 was filed together with the counter-statement.

6 The Applicant filed evidence in support of the application for revocation on 20 October 2015 and the Proprietor filed evidence in reply on 19 February 2016. On 10 March 2016, a Pre-Hearing Review was held. The Proprietor filed supplementary evidence on 11 April 2016 and, on 19 May 2016, the Applicant filed their evidence in reply to the Proprietor’s evidence in reply.

7 The application for revocation was heard on 29 August 2016 with both parties in attendance.

## **Background**

8 The Applicant is a British luxury car company, and is the owner of several trade mark applications and registrations in Singapore in respect of the trade mark BENTLEY in various classes, including Class 9.

9 The Proprietor is a company incorporated in Switzerland and was founded in 1948. It designs, manufactures and offers various types of goods, including eyewear and watches. From my search of the Register in Singapore, the Proprietor similarly owns several trade mark registrations in respect of the trade mark BENTLEY, such as Classes 14, 20, 33 and 44. It also owns the website, <http://www.bentleyluxury.com>, which I visited and see that BENTLEY is described as “BENTLEY the watch brand” which has since “expanded its product portfolio to include fashion and lifestyle accessories as well as leather goods”.

10 On 10 March 2014, the Applicant applied to register BENTLEY in Class 9 in Singapore under Trade Mark Application No. T1403438A. The Subject Mark was however cited by the Registrar as an objection to the Applicant's trade mark application. On 25 November 2014 the Applicant commenced these proceedings and on 30 April 2015 the Applicant filed another application to register BENTLEY in Class 9 in Singapore under Trade Mark Application No. 40201507095R. This application also encountered a similar citation of the Subject Mark.

### **The Law**

11 The relevant parts of Section 22 of the Act read as follows:

**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 after the expiry of the 5 year period and before the application for revocation is made.

...

(7) 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.

### ***Relevant Dates***

12 As stated at [2], the registration procedure was completed on 31 August 1998. The relevant period under Section 22(1)(a) within which the Proprietor must prove use of the

Subject Mark in relation to the Goods is, therefore, the 5-year period from 1 September 1998 to 31 August 2003. Use within this period is not alleged or adduced by the Proprietor.

13 With regard to the ground under Section 22(1)(b), the Applicant did not specify the relevant period of alleged non-use, though this is a requirement stipulated in HMG Circular No. 1/2012. This omission was not raised as an issue by the Proprietor in these proceedings.

14 It is the Proprietor's case that the Subject Mark has been put to genuine use in relation to the Goods within the 5-year period preceding the revocation application and by virtue of this use, the mark should not be revoked. This is provided for in Section 22(3) of the Act as set out at [11] above.

15 For completeness, I should add that as the revocation application was filed on 25 November 2014, the end date of the use referred to under Section 22(3) should be 24 November 2014 and not 25 November 2014 as pleaded. This case thus turns upon whether there is a finding of genuine use of the Subject Mark in Singapore during the period between 25 November 2009 to 24 November 2014 ("the Relevant Period").

### **Burden of Proof**

16 Section 105 of the Act states:

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.

17 Accordingly, it is the Proprietor that has the burden of proving genuine use of the Subject Mark in Singapore in relation to the goods for which it is registered, or present valid reasons for non-use.

### **Proprietor's Evidence**

18 The Proprietor's evidence is lodged in three statutory declarations by its Director, Cheng Chia-Hsiang, as follows:

<b>Dated</b>	<b>Declared in</b>	<b>Referred to as</b>
12 March 2015	Taiwan	RP1
18 February 2016	Taiwan	RP2
8 April 2016	Taiwan	RP3

### **Applicant's Evidence**

19 The Applicant's evidence is lodged in 2 statutory declarations by its Corporate Counsel, Justine Pridding, as follows:

<b>Dated</b>	<b>Declared in</b>	<b>Referred to as</b>
12 October 2015	United Kingdom	A1
17 May 2016	United Kingdom	A2

## **MAIN DECISION**

20 The grounds on which the Applicant relies have been set out at [4] above. Despite the alleged periods of non-use, the critical period would be the Relevant Period as stated in [15] above. If the Proprietor establishes that there has been genuine use of the Subject Mark during the Relevant Period in relation to the Goods, it means that the revocation action must necessarily fail in respect of those goods for which use has been shown.

21 I will first consider whether on the evidence before me there is use of the Subject Mark in relation to the Goods before going on to consider whether such use could be considered genuine use taking into account all the circumstances.

### **Whether there is use of the Subject Mark in Singapore**

22 The Proprietor’s case of use of the Subject Mark is summarised in their written submissions as follows:

9. The [Proprietor] essentially relies on the importation of eyewear bearing the [Subject] Mark into Singapore by a local wholesaler, and the subsequent sale of these goods by the local wholesaler to local eyewear retailers in Singapore during the Relevant Period.

10. On 17th September 2013, goods bearing the [Subject] Mark were consigned by Yi Si Da Optical Ltd (“Yi Si Da”) to local eyewear wholesaler, Kingdom Optical (S) Pte Ltd (“Kingdom Optical (S)”). Yi Si Da is the manufacturer and supplier of eyewear bearing the [Subject] Mark to the [Proprietor’s] distributor in China, Tianshi Enterprise Co., Ltd (see paragraph 6 of [RP2]). The goods were shipped to Kingdom Optical (S)’s registered address at 10 Ubi Crescent #04-78, Ubi Techpark, Lobby D, Singapore 408564. The value of the consigned goods amounted to US\$10,474.00 (approximately SG\$14,113.00) in total. Some of the goods from the consignment were subsequently sold by Kingdom Optical (S) to Singaporean retailers, Emperor Optics & Contact Lens Centre (Parkway Parade branch) and Frames & Lenses Pte Ltd (Bugis Junction branch). Invoices in respect of these sales transactions were issued on 1st October 2013.

(Content in [square brackets] mine)

23 Before I review the Proprietor’s evidence, I have two general observations about the Proprietor’s case. Firstly, although the Goods in the registration cover “eyeglass cases” and “eyeglass chains”, the Proprietor does not allege use on goods other than “eyewear”. Secondly, the Proprietor’s entire case of use during the Relevant Period rests on the above single chain of transactions. It is trite law that the fewer acts of use relied upon, the more

solidly the acts need to be established. In *NODOZ Trade Mark* [1962] RPC 1 (followed by the Court of Appeal in *Nike International Ltd v Campomar SL* [2006] SGCA 2 ("*Nike CA*"), Wilberforce J (as he then was) concluded about the case before him as follows:

I am faced, therefore, with this question: on those documents, on that evidence, ought I to be satisfied that the respondents have discharged the onus of proof which I hold has shifted to them to establish actual user in this country? It seems to me that the position stands in this way. The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the 5 year period. It may well be, of course, that in a suitable case one single act of user of the trade mark may be sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that this single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, and it does not seem to me that the evidence which I have heard...is sufficient evidence to satisfy the onus which is required.

24 The evidence of use adduced by the Proprietor is summarised in the following table.

S/No	Summary of Evidence	Dated	Found In
1	Invoice issued by Yi Si Da Optical Ltd ("Yi Si Da") to Kingdom Optical (S)	16 September 2013	<b>RP1, CCH-1</b> at page 5
2	Consignee copy of FedEx airway bill addressed to Kingdom Optical (S)	17 September 2013	<b>RP1, CCH-1</b> at page 6
3	Tax invoices issued by Kingdom Optical (S) to two local retailers	1 October 2013	<b>RP1, CCH-1</b> at pages 7 to 8
4	Photographs of sunglasses bearing the BENTLEY mark offered for sale in optical retail store(s)	Undated	<b>RP1, CCH-1</b> at pages 9 to 12
5	The Proprietor's catalogue containing photographs of sunglasses bearing the BENTLEY mark	Undated	<b>RP1, CCH-1</b> at pages 13 to 101
6	Printouts from the Proprietor's website <a href="http://www.bentleyluxury.com">www.bentleyluxury.com</a> showing pictures of the Proprietor's retail stores	Undated	<b>RP2, CCH-2</b> at pages 6 to 22
7	List of the Proprietor's distributors worldwide	Undated	<b>RP2, CCH-3</b> at pages 24 to 25
8	Letter appointing Kingdom Optical Ltd as sole agent	5 September 2013	<b>RP2, CCH-4</b> at page 30
9	Letter from the Proprietor acknowledging the appointment of Kingdom Optical Ltd	5 September 2013	<b>RP2, CCH-5</b> at page 32

25 I will not deal with each item of the evidence individually here but may refer to some of them later in my decision, except to say that most of the items of evidence either do not

relate to use in Singapore, do not show use of the Subject Mark on the Goods or are undated, and are therefore not helpful to the Proprietor's case. However, I will focus on the first three items of the evidence as the Proprietor's case essentially hinges upon them.

#### Items 1 & 2

26 Item 1 is an invoice issued by Yi Si Da to Kingdom Optical (S) dated 16 September 2013 and item 2 is a consignee copy of a FedEx airway bill dated 17 September 2013 addressed to Kingdom Optical (S). The Proprietor relies on these two documents to show the importation of eyewear bearing the Subject Mark into Singapore by a local wholesaler.

27 While I can accept at face value that these documents show importation of goods into Singapore, I cannot tell from these documents what these goods are or whether they bear the Subject Mark at all. There is nothing in either of these documents that refers to the Subject Mark, or even the type of goods concerned. The FedEx airway bill simply describes the goods as "Metal frame with case HS76019000". As for the invoice, the goods are merely referred to by product codes such as BLO-01A04, BLO-01A02, GT-7040, GT-7041, etc. Further, I find it most puzzling that there is no attempt by the Proprietor to even explain how these documents or the codes are to be interpreted to show use of the Subject Mark. In fact, the Proprietor does not even say which of the product codes relate to BENTLEY goods in this registration and which do not.

28 It is only in its written submissions that the Proprietor (at [35]) attempts to co-relate the invoice, in particular, the product codes with BLO-prefix, to the Proprietor's eyewear catalogue (Item 5 at page 99) which refers to the codes and show photographs of the goods. However, the catalogue is undated and there is no evidence to support an inference that the two documents are contemporaneous in time to permit such a cross reference. More fundamentally, the Proprietor did not in any of its three statutory declarations attempt to co-relate the two documents or to invite this tribunal to make this association.

29 The Proprietor's evidence is sorely lacking in detail and specificity. All the Proprietor says in its evidence on these critical documents (RP1 at [5]) is:

The [Proprietor's] goods falling into Class 9 such as sunglasses have been offered for sale and sold in Singapore within the relevant past 5 year period i.e. between 26<sup>th</sup> November 2009 to 25<sup>th</sup> November 2014. There is now exhibited hereto and marked as "CCH-1" true copies of the following:

- (i) Invoice issued by [Yi Si Da], to local wholesaler, [Kingdom Optical (S)] dated 16<sup>th</sup> September 2013;
- (ii) Tax invoices issued by [Kingdom Optical (S)] to two local retailers dated 1 October 2013;
- (iii) Photographs of sunglasses bearing the "BENTLEY" mark offered for sale in optical retail stores(s); and

(iv) The [Proprietor's] catalogue containing photographs of sunglasses bearing the "BENTLEY" mark.

(Content in [square brackets] mine)

30 It is surprising to me that the Proprietor's own evidence itself falls short of saying that the Goods bear the Subject Mark. It therefore remains a mystery what kind of goods were imported into Singapore. Was it simply the Proprietor's goods (of unspecified brands) or was it goods bearing the Subject Mark?

### Item 3

31 Item 3 consists of two tax invoices issued by Kingdom Optical (S) to two local retailers. These two tax invoices show that a total of 30 items of goods were sold by Kingdom Optical (S) to Singaporean retailers, Emperor Optics & Contact Lens Centre (Parkway Parade branch) and Frames & Lenses Pte Ltd (Bugis Junction branch). The invoices were both issued on 1 October 2013 and were both acknowledged by the retailers.

32 These invoices are the only documents showing use of the Subject Mark in Singapore. In the invoices, the goods are referred to as BENTLEY together with the BLO product codes. While these invoices link the BLO product codes with BENTLEY, the issue still remains whether the goods bear the Subject Mark as alleged.

33 The fact that goods are referred to by a particular name in an invoice does not always mean that the goods will bear that name, and on the facts of this case, I do not think I can make this assumption. I am not saying for a moment that use of a mark on an invoice can never amount to evidence showing use of the mark on the goods, only that in this case, I do not have evidence that such goods even exist. On the facts I have, it seems to me that the eyewear market is a new market that the Proprietor was making plans to enter into in September 2013. How far the plans have gotten off ground is not clear on the evidence but the letter of acknowledgement from the Proprietor (Item 9) acknowledges that Kingdom Optical Ltd has been granted "exclusive distribution and manufacturing rights" for the Goods. This letter is dated 5 September 2013. While this letter states a retrospective effective date of 1 July 2013, it is not clear to me whether any BENTLEY eyewear goods have been manufactured by the time of the import, which is 16 September 2013, and the Proprietor's evidence does not address this point. The Proprietor contends that Yi Si Da is the manufacturer and supplier of BENTLEY eyewear but no evidence of this appointment has been tendered and we do not know the effective date of the appointment or the terms of the appointment. There is thus no evidence before me to show that goods bearing the BENTLEY mark exist during the Relevant Period, whether in Singapore or elsewhere. Items 4 - 7 of the Proprietor's evidence are undated and cannot assist the Proprietor.

34 Since it is the Proprietor's case that the Goods bear the Subject Mark, the Proprietor needs to show proof to that effect. The mere fact that the Subject Mark is used in invoices issued by just one single party, does not seem to me to constitute overwhelmingly convincing proof of that fact based on the evidence of the present case.

35 I further take the view that whether or not the goods do in fact bear the Subject Mark is a fact which can be easily proven by the Proprietor and in numerous ways. For example, Kingdom Optical (S) or any of the two local retailers could have been called to come forward to say so. The Director of Kingdom Optical (S), Mr Yong Hua Chew, appears to be readily available as he was approached by the Applicant's commercial investigators, Commercial Investigations LLP, on 8 April 2015 (see A1, Exhibit JP-4). The interval between the issuance of the documents, 1 October 2013, and the date of commencement of these proceedings, 25 November 2014, is also not too long such that it can be assumed that evidence must have been destroyed. Another way to prove this fact could be for the Proprietor to show evidence that Yi Si Da has been manufacturing goods bearing the Subject Mark since before the Relevant Period or produce some document trail leading to the placement of the order for the goods by Kingdom Optical (S) and the retailers which make reference to goods bearing the Subject Mark. These are just some examples of how the fact may be proven though the Proprietor is certainly not limited to these ways. However, the fact remains that the Proprietor did not produce any evidence to show the existence of goods bearing the Subject Mark, whether in Singapore or outside, during the Relevant Period.

36 The fact that evidence for something which could easily be obtained by the Proprietor is not forthcoming from the Proprietor is an indication to me that the evidence furnished is insufficiently solid and that the Proprietor has not done everything reasonably possible to prove its case to the level of being "overwhelmingly convincing".

37 In *Nike CA*, the Court of Appeal held that a party cannot be said to have proven its case to a level of being "overwhelmingly convincing" when the party has not done everything reasonably possible to obtain the necessary evidence to prove its case. The Court of Appeal said at [19]-[21]:

19 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. Even if Mr Bhojwani did not want to be involved, he could have been compelled. The court was not told why that was not done or what difficulties there were to that course being taken.

20 At the end of the day, we did not know if the goods had, in fact, arrived in Singapore and what the importer did to them. Thus, the judge below was left to postulate. Here we would quote again, for emphasis, what the judge stated ([1] *supra* at [55]):

Bhojwani's Pte Ltd *must have* sold and exported the NIKE products it had bought to someone in Indonesia or *must have* exported them there for sale. It must be remembered that Kalai was speaking to the private investigator in

April 2002 whereas the shipment of NIKE perfumes took place some eight months ago in August 2001. It was possible that she meant the company did not deal in NIKE perfumes at that time. It *was also unclear what the actual status of Kalai in the company was* and how long she had been in its employ. [emphasis in original]

However Anthony had deposed that the employee by the name of Kalai had claimed to be the person in charge of the office (see [6] above). There was no other evidence to the contrary.

21 Section 105 of the TMA reads:

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.

Therefore, the burden is clearly on the proprietor of the mark to prove the use made of the mark. The point we would underscore is that where a party is obliged to prove a certain fact to the level of being “overwhelmingly convincing”, that party must show that it has done everything reasonably possible to obtain the necessary evidence. To merely say that his lawyer had approached the importer who then refused to co-operate is woefully inadequate.

38 I think the point is worth reiterating. Proprietors concerned with proving use of their mark must make sure that the evidence they submit to prove the actuality of use is sufficiently solid and specific. This is not an unduly onerous burden and is the least proprietors should do bearing in mind that they are sitting on trade mark rights. It is only with sufficiently solid and specific evidence that this tribunal is able to conduct an evaluation of the scope of protection to which the proprietor is legitimately entitled, properly and fairly, having regard to the interests of the proprietor, the opposing party and the public.

39 The same message was also expressed by Jacob J (as he then was) in *Laboratorie De La Mer Trade Marks* [2002] F.S.R. 51 ("*Laboratorie*") where he said at [9]:

...Those concerned with proof of use should read their proposed evidence with a critical eye — to ensure that use is actually proved — and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted...

40 Furthermore, when it comes to proof of use for the purpose of determining the extent, if any, to which the protection conferred by registration of a trade mark can legitimately be maintained, what the evidence shows is as important as what the evidence does not show. In assessing the evidence for sufficiency as to proof of use, account will be taken of how much specificity there is in the evidence which addresses that use.

41 For the reasons indicated above, I find that the Proprietor has failed to furnish sufficiently solid evidence to support its claim that Goods bearing the Subject Mark were imported into Singapore and it was such Goods that were re-sold to local retailers.

42 The above decision effectively concludes the Proprietor's case. However, in case I am wrong and there is use of the Subject Mark on the goods during the Relevant Period in Singapore, I will go on to consider whether the use as submitted would constitute genuine use.

### **Whether the use amounts to genuine use**

43 Even if use of the Subject Mark is found, a further inquiry is necessary into whether the acts of use relied upon amount to genuine use. It is trite law that although minimal use may qualify as genuine use, not every proven act of use may automatically be deemed to constitute genuine use of the trade mark in question.

44 In *Laboratoires Goemar SA v La Mer Technology Inc* [2005] EWCA Civ 978 (“*Goemar*”), the English Court of Appeal held (at [22]-[23]):

Token use of a mark does not count as genuine use. Contrary to the tenor of some of his excellent submissions Mr James Mellor, appearing on behalf of La Mer, has never contended that this was a case of token use by Goemar, “serving solely to preserve the rights conferred by the mark.”

Although token use of a mark is obviously not genuine use, it would be illogical to assert that every case of non-token use qualifies as genuine use. *Ansul* [BV v Ajax Brandbeveiliging BV [2003] ETMR 85] and the reasoned order in this case are clear that, even if the use is not token, it is still necessary to consider other factors in order to decide whether or not the use of the mark is genuine. For example, internal use by the registered proprietor may not be token or sham, but it will fail to qualify as genuine use because it is internal only.

45 On how genuine use has to be proven, in *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Rooster CA*”), the Court of Appeal said at [44]:

...In *La Mer Technology (2008)* [[2008] ETMR 9] ([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 in original]

46 Turning to the facts of the present case, the Proprietor's evidence on use of the Subject Mark in Singapore can be summarised as follows:

- (a) One act of import of a quantity of 228 items of goods, with a consignment value of US\$6370 for goods with product codes bearing the BLO prefix
- (b) Two acts of sales to local retailers amounting to a total quantity of 30 items of these goods for a value of S\$2092.92

47 The scale of use, in terms of the number of goods involved, is modest, taking into consideration the fact that the goods, eyewear, are used by the public at large and the market for such goods in Singapore is of a significant size. In terms of the extent of use, it appears to me from the limited evidence that it is minimal and only three parties (the importer and two retailers) in Singapore have come into contact with the Subject Mark. As for the volume of use, while the import value of the goods is US\$6370, only 30 items of these goods or about 13% of the goods imported, were re-sold to local retailers. The Proprietor did not say what had happened to the remaining goods or whether or not they are still in Singapore.

48 While use of a trade mark does not have to be substantial or significant before it could be considered to be genuine and even minimal use of a trade mark or use by only a single importer could be sufficient to establish genuine use, the English Court of Appeal in *Goemar* held (at [48]) that, “the more limited the use of the mark in terms of the person or persons to whom it [was] communicated, the more doubtful any tribunal [might] be as to whether the use [was] genuine as opposed to token”.

49 The modest use of a mark, however, must be assessed in relation to other relevant factors, such as the length of the period during which the mark was used, frequency of the use and the nature of the use of the mark, in order to ascertain the intention of the Proprietor for the use and whether the use can be said to be genuinely for the purposes of creating a market for the goods in Singapore.

50 In *Rooster CA*, the Court of Appeal explained how examination of whether a trade mark had been put to genuine use should be carried out at [57] as follows:

To examine whether...[a] trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that [the] commercial volume achieved under the mark was not very high may be offset by the fact that use of the mark was extensive or very regular and vice versa. In addition, the turnover and the volume of sales of the product under the ... trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, [the] production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market.

51 The fact that there is modest use of the Subject Mark in terms of volume and quantum may thus be compensated by other factors such as regular use of the mark, length of period of use or other objective evidence which shows a genuine intent to create a market in

Singapore. However, it should not be for this tribunal to postulate on the basis of probabilities or suppositions.

52 The importance of showing a genuine intent to create a market in Singapore as opposed to mere use of the Subject Mark in Singapore cannot be over emphasised, after all the legislation requires “genuine use” and not just “use”. Regretfully, I do not think that the parties in this case addressed me sufficiently on the issue of genuine use. Before I proceed to consider the evidence as a whole in this case, it would be useful to look at the cases expounding on what genuine use means.

53 In *Laboratorie*, Jacob J (as he then was), in the context of explaining why a reference to the European Court of Justice was necessary, observed at [21]-[25]:

21 What, then, does put to genuine use mean? Mr Mellor contends that I posed the right test in Euromarket Designs Inc. v Peters (Crate & Barrel) [2000] E.T.M.R. 1025:

“It seems to me that ‘genuine use’ must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of the use. In part it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one United States city in a journal which happened to have a tiny United Kingdom distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be a ‘sham’. This to my mind shows that Miss Vitoria’s gloss on the meaning of ‘genuine use’ is not enough. And the only stopping place after that is real trade in this country. I think all the examples relied upon are examples of trade just in United States.”

22 The Crate & Barrel case involved 3 types of very minor use. The 3 uses were: a few items bought in America by American customers who asked the shop to send the goods as presents to people here, United Kingdom residents sending orders to the U.S. for goods to be supplied in the U.S. via a “wedding gift” scheme, and “spillover” circulation of U.S. magazines. The point was really whether any of those uses should be regarded as uses for a trade under the mark “Crate & Barrel” in this country. The point was not the same as in this case, which is whether a very limited amount of use definitely in this country can be regarded as sufficient to be “genuine”.

23 It is that question which seemed to me to be so important as to justify a reference to the European Court of Justice. The precise form of the question remains for discussion with Counsel.

### **My opinion**

24 Before I say more about it I will, as both sides asked, give my own provisional views on the question. I begin by recounting the experience which we had in this

country under our prior legislation. This required that there be “bona fide use” of a trade mark within a relevant period (see section 26 of the Trade Marks Act 1938). For many years it was thought that if a trader contrived to make small sales of goods under a registered trade mark, his purpose did not matter. Companies, particularly large ones, used to indulge in “trade mark protection programmes”. Any mark which they wished to protect from a non-use attack would be specially applied to a product normally sold under some other trade mark. Minor sales of these specially marked products were made often to friendly retailers; no real advertising or marketing efforts would support the sales. The idea was that any sales would do. That idea was exploded in a case called Imperial Group Ltd v. Philip Morris & Co. Ltd (NERIT Trade Mark) [1982] F.S.R. 72. Imperial wanted to stop Philip Morris from introducing a brand of cigarettes called “Merit”. They had a registration of the word “Nerit”. If valid, Merit would probably infringe. But Nerit had not been used. So Imperial arranged for packs of Nerit cigarettes to be prepared and sold on a limited scale. They were in fact just the same as Imperial’s Embassy brand. About a million Nerit cigarettes were sold, mainly from independent outlets. But the whole point of the exercise was to establish “bona fide” use of the mark and not to establish a brand which had profitable sales. The English Court of Appeal held that the use was not bona fide.

25 Following that case at least some companies dropped trade mark protection programmes. Whether they have been revived following the introduction of the CTM and the new European trade mark laws I do not know. I hope they have not, for it seems to me that the position as regards intention behind the use is a major factor in deciding whether a use is “genuine” within the meaning of the European legislation.

26 In other English cases, where there was no question of a hidden motive behind the use, the courts were prepared to regard even small quantities of sales under the mark as sufficient to constitute bona fide use. A little use coupled with genuine intention to establish a market in goods under the mark would suffice (Bon Matin Trade Mark [1989] R.P.C. 537).

27 Thus under our old law there was no rule of de minimis. If a use was only slight, that might, depending on other circumstances, show that the trader was not genuine in his activities...One would compare the use actually made with the size of the organisation, how it and other similar entities normally went about marketing and so on. A big trader who had made only limited sales would particularly have to explain what was going on. If the main or a principal motive was trade mark protection rather than simply making sales under the mark, then the use was not ‘bona fide’.

54 The Court of Justice elaborated on the concept of genuine use further in the case of *Ansul BV v Ajax Brandbeveiliging BV* [2003] ETMR 85 (“*Ansul*”):

36 Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be

consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37 It follows that “genuine use” of the mark entails use of the mark on the market for the goods or services protected by the mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create and preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may either be by the trade mark proprietor or, as envisaged in article 10(3) of the Directive, by a third party with authority to use the mark.

38 Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39 Assessing the circumstances of the case may thus include giving consideration, inter alia, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not therefore always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.

55 With the above guidance in mind, I proceed to examine the evidence to see what it reveals about the nature of the use, the intention behind the use and whether it shows use aimed at creating an outlet for the Goods in Singapore.

56 I bear in mind the need to look at the case as a whole and it cannot be ruled out that the totality of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts. In this regard, while the Applicant submits that the Proprietor has not proven that the consigned goods have arrived in Singapore, I do not think I can come to this conclusion. This is because the Proprietor has produced proof that the goods were delivered to two retailers in Singapore and there appears to be acknowledgment of receipt of the goods by both the retailers.

57 While I am of the view that the subject goods arrived in Singapore and were delivered to local retailers, it appears to me that the Proprietor has failed to address the issue of how these acts demonstrate an intention to establish a market for the goods in Singapore.

58 First and foremost, the period of the use in Singapore is short, amounting to a period of just 15 days (as evidenced at best) within the relevant 5-year period. As stated in a footnote to paragraph [10-060] in *Kerly's Law of Trade Marks and Trade Names* (15<sup>th</sup> ed., London: Sweet & Maxwell, 2001), "[i]ntermittent or temporary use is usually an indicator of non-genuine use, even though wealthy traders may be able to afford temporary use on a reasonably substantial scale. By contrast, steady use or use backed by an intention to establish a market indicates substantial use." Coupled with this short period of activity is the unusual pattern of activity in the present case. There appears to be a sudden rush of activity in September to October 2013 to bring the goods into Singapore and to distribute the goods to local retailers but after the distribution there was an equally sudden cessation to the use in Singapore. These acts are not typically what one would expect to see as being consistent with an intention to establish a market in Singapore and would at least warrant some form of explanation from the Proprietor but none was provided. Neither did the Proprietor attempt to provide any reasons for non-use after 1 October 2013.

59 The facts of the present case are also not one where there is evidence of further sales under the mark after the Relevant Period to support the Proprietor's case that the use during the Relevant Period is genuine. It is to be borne in mind that the Proprietor's latest statutory declaration, RP3, was made on 8 April 2016 and if there were further sales by this time, it could have relied on these sales as evidence of the genuineness of the activities during the Relevant Period.

60 In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] F.S.R. 38, the Court of Justice of the European Communities held that:

33 ...while the Directive makes the classification of use of the trade mark as genuine use consequential only on consideration of the circumstances which pertain in respect of the relevant period and which predate the filing of the application for revocation, it does not preclude, in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing...

61 On the face of the invoices to the two retailers, the sale of the goods to local retailers merit some explanation. The alleged sales to the two retailers appear to have taken place on the same date over the relevant 5-year period. The items sold are identical under the two invoices and no reason has been given for this. No evidence has been given as to how the sales to these retailers came about despite the lack of evidence of any advertisement or promotion of the Subject Mark in Singapore. No explanation is given as to whether other retailers in Singapore have been approached and the document trail pertaining to the sales is clearly not complete (see [66] below).

62 In *Laboratorie*, despite the limited sales of the goods during the relevant period, the Court found that based on the evidence tendered, “a reasonably clear picture emerges” of the genuineness of the trade in that case. In the words of Jacob J (as he then was):

35 I turn to the present case. No one suggests that the trade mark proprietor was, in making his limited sales to the customer in Scotland, doing anything other than trying (albeit ineffectually) to build up a profitable trade under the mark in this country. Apart from the actual sales, the evidence of other sales, and of a re-start after the relevant date support that. A reasonably clear picture emerges. The French company found a potential distributor here. That distributor bought goods within and without the specification. The distributor, however, failed. The French company remained interested in selling here and then found another distributor who has done a little better, albeit not within the relevant period and only for dietetic supplements, not Class 3 goods. The proprietor cannot rely upon any sales beyond those actually made for the relevant goods within the relevant period to establish use. But he can rely upon these other matters (the £6,000 worth of sales of other goods within the period and finding a new and more effective agent shortly thereafter), as evidence of the genuineness of his trade in general and so of the £800 worth of sales under the mark. They show it was not merely tokenism.

63 In comparison, it cannot be said that a reasonably clear picture has emerged from the evidence in this case. We do not know the reasons for the few acts of use in Singapore, or the sudden cessation of use in Singapore; there is no re-start of the use of the mark after the Relevant Period and we do not know how the sales to the retailers came about.

64 Against this backdrop of activities which are atypical of genuine trade to establish a market in Singapore, the Proprietor maintains its silence as to why and how Kingdom Optical (S) came to be importing and selling the goods. It is not alleged that Kingdom Optical (S) was ever an authorised retailer of the Proprietor’s goods and in fact, the evidence shows that the authorised retailer for the goods in Singapore is another entity, a.d. time son bud (Item 7) with an address in Malaysia. Even upon probing by the Applicant, all the Proprietor says about Kingdom Optical (S) is that “The [Proprietor] is satisfied and assured that Kingdom Optical Ltd is related to [Kingdom Optical (S)].” This statement is surprisingly unhelpful and goes no way towards establishing the Proprietor’s case that the transactions are real commercial activities intended to create a market for the goods. It does not shed any light on the background leading up to these activities or the reason for these activities and we cannot tell if these are genuine arm’s length transactions or not.

65 At the same time, the Proprietor does not allege that there have been any sales by the authorised dealer, a.d. time son bud, whether during the Relevant Period or outside.

66 Given the facts of the present case, where it is not alleged that there were any sales of goods bearing the Subject Mark to members of the public as consumers or end-users, the nature of the activity by the importer is most important. However, we do not have the benefit of any evidence from the importer or the two local retailers. The documents produced also do not help to paint a complete picture as to what was going on as documents

such as quotations, purchase orders and evidence of payment of the goods have not been produced, whether for the goods received by Kingdom Optical (S) or the goods received by the two local retailers. Surely there would have been some evidence showing the use of the Subject Mark in the course of correspondence between the relevant parties. The present case can thus be distinguished from the facts in *Weir Warman Ltd v Research & Development Pty Ltd* [2007] SGHC 59 , where sufficient evidence was tendered of the "three sales transactions, three e-mail enquiries from Singapore companies to the defendant regarding "Warman" pump parts, as well as a fax sent by the defendant to a potential customer for pump parts" (at [101], [25]-[27]).

67 Without the benefit of any narrative from the Proprietor, there is no way of establishing whether these acts of use relied on are genuine acts aimed at securing customers (whether these customers are retailers, importers or end-users does not matter) or whether they are something else more token or represent use which is internal. It would have been straightforward for the Proprietor to have provided more detail about the import and sale to retailers rather than the skeletal and uninformative information that it actually provided. The absence of sufficiently detailed evidence is one of the reasons why I find that the Proprietor's case falls on the wrong side of the line. Given the Proprietor's size, the scale of their activities, that it is a long established company, deals in various types of goods and with a presence in numerous countries, the evidence could have been better prepared.

68 Finally, I note from the Applicant's evidence, A2 at [7], that non-use cancellation proceedings were brought by the Applicant against the Proprietor in the USA in respect of the corresponding registration of the Subject Mark there. According to a search of USPTO's TTABVUE system which is publicly accessible, those proceedings were commenced on 10 September 2012, almost a year before the alleged incidences of use claimed by the Proprietor in these proceedings. Given this background, surely it becomes incumbent on the Proprietor to show that whatever use it has made of the Subject Mark in Singapore is genuine and not merely for the purpose of trade mark protection.

69 Taking all of the above into account, I find that the evidence does not show real commercial exploitation of the Subject Mark in Singapore. That being the case, I find that genuine use of the Subject Mark has not been shown to have been made within the Relevant Period in relation to any of the Goods for which the mark is registered. The application for revocation therefore succeeds.

#### **Whether the use submitted constitutes use by the Proprietor or with the Proprietor's consent**

70 Before concluding, I will deal briefly with another issue which the Applicant has raised. The Applicant submits that the invoices do not demonstrate use of the Subject Mark by the Proprietor or with its consent, since the invoices were issued by Kingdom Optical (S). Further, the Applicant submits that since the Proprietor has not explained the relationship between itself and Kingdom Optical (S), there has been no "unequivocal

demonstration of consent” from the Proprietor, and that there are also no circumstances from which to imply such consent.

71 I find, on the basis of the evidence before me, the use of the Subject Mark is with the implied consent from the Proprietor. Consent may be implied, in particular, from the fact that the Proprietor is able to produce the invoices issued by Kingdom Optical (S) which were issued to and signed by the local retailers. If the Proprietor had not consented to such use, it would not have been in the interests of Yi Si Da and Kingdom Optical (S) to disclose evidence of the use to the Proprietor since such use would constitute infringement of the Subject Mark. It would also not be in the Proprietor’s interest to rely on such use as it would amount to acquiescence to the act.

### **Conclusion**

72 The revocation succeeds under Section 22(1)(a) and (b). Pursuant to HMG Circular No. 1/2012, in the absence of any request for an earlier effective date of revocation, I will apply Section 22(7)(a) and order that the registration of the Subject Mark be revoked as from the date of the application for revocation, namely, 25 November 2014. Although this means that the Applicant’s Trade Mark Application No. T1403438A would still face citation from the Subject Mark, I note that the Applicant has a later application, namely, Trade Mark Application No. 40201507095R, filed on 30 April 2015, which is after the date of revocation of the Subject Mark. The Applicant is also entitled to costs to be taxed, if not agreed.

Dated this 11th day of November 2016

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Tan Mei Lin

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore

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<sup>1</sup> For avoidance of doubt, the propriety of the registration of BENTLEY is not an issue in these proceedings.