

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

Trade Mark No. T0720728D

Hearing Date: 18 July 2017

Date of Further Submissions: 1 August 2017

IN THE MATTER OF A TRADE MARK REGISTRATION BY

DAIDOH LIMITED

AND

APPLICATION FOR REVOCATION THEREOF BY

NEW YORKER S.H.K. JEANS GMBH & CO. KG

Hearing Officer: Ong Sheng Li, Gabriel
Assistant Registrar of Trade Marks

Representation:

Mr William Ong and Ms Amanda Soon (Allen & Gledhill LLP) with Ms Dhivya Mohan (Marks & Clerk Singapore LLP) for the Applicant

Ms Francine Tan (Francine Tan Law Corporation) for the Registrant (i.e. Registered Proprietor)

GROUNDΣ OF DECISION

Introduction

1 From time to time, the term “Pyrrhic victory” is used to describe the outcome of litigation. This dispute was Pyrrhic in the sense that a disproportionate amount of time and costs was expended by both sides for what, in essence, was a relatively straightforward case. But who was the victor? Perhaps it is too early to tell: After all, the parties are embroiled in parallel trade mark opposition proceedings, and it remains to be seen how the result of this skirmish impacts on the larger war.

Outline of dispute and outcome

2 This was an application by New Yorker S.H.K. Jeans GmbH & Co. KG. (the “Applicant”) to revoke Daidoh Limited’s (the “Registrant”) registered trade mark **NEWYORKER** (T0720728D) in Class 25¹ (the “Subject Mark”) on the basis of non-use under Section 22(1)(a) and/or (b) of the Trade Marks Act (Cap. 322, , Rev. Ed. 2005) (“TMA”). The application for revocation was filed on 19 March 2015.

3 A key aspect of the relief sought by the Applicant was that any order for revocation should backdated to a date “*on or before 6 September 2011*” (the “Backdating Request”) pursuant to Section 22(7)(b) TMA. To understand why the Applicant made the Backdating Request, one need look no further than its application (filed on 7 September 2011) to register **NEWYORKER** (T1205572A) for a wide variety of services in Class 35. As it turned out, after T1205572A was published for opposition, the Registrant filed to oppose it on the basis of, among other things, conflict with its Subject Mark. In response, the Applicant commenced this action to revoke the Subject Mark for non-use. The opposition proceedings have been held in abeyance pending the outcome of this dispute.

4 By default, an order for non-use revocation takes effect from the date on which the application for revocation was made. However, the Applicant considered this default position to be insufficient for its purposes. The reason? In trade mark opposition proceedings, the parties’ rights are assessed by reference to the date on which the trade mark was applied for. Because this action was commenced on 19 March 2015, whereas T1205572A was applied for on 7 September 2011, the Applicant wanted to obtain a revocation date on a day “*on or before 6 September 2011*” so that it would be able to effectively eliminate the Subject Mark from the opposition proceedings.

¹ Registered in respect of: “*Clothing; hats; neckties; shawls; underwear; socks; belts (clothing); boots; shoes; sandals; gloves (clothing); scarves; caps (headwear); garters; sock suspenders; braces for clothing (suspenders); bands (for wear); sweat bands for the head; sweat bands for the wrist; costumes (masquerade); sports clothes (other than golf gloves); shoes and boots for sports; suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; bathing drawers; bathing suits; breeches (for wear); top coats; collar protectors; combinations (clothing); cuffs; footwear; fur (clothing); gabardines (clothing); dressing gowns; half-boots; headgear for wear; hoods (clothing); hosiery; stuff jackets (clothing); jumpers (shirt fronts); muffs (clothing); overcoats; overalls; pajamas; parkas; pullovers; ready-made clothing; slippers; spats; waistcoats.*”

5 Throughout the proceedings, the Registrant did not raise any objections to the Backdating Request. But, this was not something that could be simply left unaddressed. A feature of the trade mark registration system in Singapore is that for the first 5 years of its life, assessed by reference to the date of the completion of the registration procedure, the proprietor enjoys a “grace period” during which the registration is *not vulnerable* to an action for non-use revocation. Here, the date of completion of the registration procedure for the Subject Mark was 2 January 2009, and the 5 year “grace period” would have lasted up to 2 January 2014. By seeking to have the date of revocation backdated to a date “*on or before 6 September 2011*”, the Applicant was essentially seeking relief within the “grace period”, something that it would not have been entitled to at that time.

6 During oral argument, I expressed my doubts concerning whether the Backdating Request could be granted. I drew the parties’ attention to HMD Practice Circular No. 1/2012 which stated, among other things, that where the registered mark sought to be revoked has never been put into use, the earliest possible effective date of revocation for non-use would be “*the date immediately following the fifth anniversary of the date of completion of the registration procedure*”. According to the guidance provided by the said Practice Circular, 3 January 2014 was the earliest possible effective date for revocation. Counsel for the Registrant was quick to agree with the guidance set out in HMD Practice Circular No. 1/2012, whereas counsel for the Applicant submitted that I could nevertheless allow the revocation to be backdated to a day “*on or before 6 September 2011*”. Both sides proffered some provisional views on the issue. However, it appeared that counsel for the Applicant was not prepared to fully discuss the point there and then. Since the issue was fundamental and related to the *raison d'être* of this action, I gave the Applicant leave to tender further written submissions. I also invited the Registrant to do the same if it considered it necessary to address me further on the issue. Both sides submitted further written submissions.

7 In my judgment, the Backdating Request was made on a fundamentally flawed premise. None of the authorities cited to me by the Applicant stood for the proposition that the effective date of revocation may be backdated to a day within the first 5 years from the date of the completion of the registration procedure. And, its arguments ultimately fell short of addressing why such relief can (and should) be granted when actions for non-use revocation cannot be commenced within the first 5-year period in the first place. Consequently, I rejected the Applicant’s submissions concerning the validity of the Backdating Request, and held that the Registrar has no power to backdate an order for non-use revocation to a day falling within the first 5 years after the date of the completion of the registration procedure.

8 On the substantive issue of whether the Subject Mark had been put to genuine use, after considering the evidence and submissions made in writing and orally,² I found that the Registrant was able to establish genuine use of the Subject Mark in respect of some,

² At the conclusion of the oral hearing, counsel for the Registrant tendered a document marked ‘Basic Rebuttal Submissions’. As the points in this document were substantially the same as those she had made in oral argument, counsel for the Applicant did not pursue the issue and I have not referred to it in this decision.

but not all, of the goods in respect of which it was registered. The Applicant addressed this in its alternative submission, and invited me to make an order for partial revocation. It provided me with a list of goods that, in its submission, should be struck out for non-use, having regard to the evidence. As for the Registrant, during oral argument, counsel submitted that it would be inappropriate to make an order for partial revocation, and in this connection cited authority for the proposition that the task for this Tribunal is to ask the question: “*What would be a fair specification of goods, having regard to the use that the proprietor has made of the mark, and assuming further that he will continue that use?*” In reply, counsel for the Applicant did not dispute the correctness of the fair specification approach, but urged me to look very carefully at the evidence and to avoid applying too broad a brush in my approach.

9 After consideration, I made an order for partial revocation, but not for all of the goods in the list that the Applicant provided to me. And, since I found that the Subject Mark had never been put to use in respect of certain goods, the order for partial revocation was made effective from the earliest possible date: 3 January 2014.

10 My orders and directions are set out in full at the conclusion of the decision, and my detailed reasons are as follows.

MAIN DECISION

Grounds of non-use revocation

11 Section 22(1)(a) TMA provides that a registered trade mark may be revoked for non-use on grounds 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”

As stated above, the date of completion of the registration of the Subject Mark was 2 January 2009.

12 Section 22(1)(b) TMA provides that a registered trade mark may be revoked for non-use on grounds that:

“... such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use”

13 In its Statement of Grounds (at [4] – [10]), the Applicant stated that it had conducted investigations on the Subject Mark. Based on and as a result of these investigations, it believed that the Subject Mark had not been put to genuine use in Singapore within the relevant time periods, which it identified as the following:

- a. Section 22(1)(a): 3 January 2009 to 2 January 2014 (“First 5 Year Period”).
- b. Section 22(1)(b): 19 March 2010 to 19 March 2015 (“Second 5 Year Period”).

14 The Registrant did not comment on the overlap between the two time periods. Instead, it focused on showing that the Subject Mark was put to genuine use in 2012 and 2013 (which fell within both relevant time periods identified by the Applicant).

Grounds for the Backdating Request

15 Section 22(7) TMA provides that:

- “(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.”

16 In its Statement of Grounds (at [12]), the Applicant requested that the Registrar exercise his discretion to backdate the effect of such revocation to a date “*on or before 6 September 2011*”. Although Section 22(7)(b) TMA was not expressly referenced, it was clear that the request was made pursuant to this provision.

Burden of proof

17 In trade mark non-use revocation cases, the central issue is whether the subject mark has been put into genuine use. The burden of proving genuine use is on the proprietor. The applicant for revocation does not have the burden of proving non-use. This is provided for in Section 105 TMA, which states that:

“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”

18 The allocation of the burden of proof in this manner reflects the reality that it is difficult to prove a negative fact. (See *Application for Cross-examination by FMTM Distribution and Objection Thereto by Tan Jee Liang Trading as Yong Yew Trading Company* [2016] SGIPOS 9 at [63]; *MCI Group Holding SA v Secondment Pty Ltd* [2014] SGIPOS 15 at [24] – [25].)

Evidence filed

19 The following statutory declarations (“SD(s)”) were filed in evidence:

- a. Registrant’s *prima facie* evidence of use (filed together with its Counter Statement):

- i. SD of Fumitaka Saito dated 23 July 2015 (“Saito’s First SD”). At the relevant time, Mr Saito was the Senior Executive Officer and General Manager of the Registrant.
- b. Applicant’s evidence in support of the action:
 - i. SD of Friedrich Knapp dated 10 February 2016 (“Knapp’s First SD”). Mr Knapp was the Applicant’s Chief Executive Officer.
 - ii. SD of Philip Tan See Wei dated 13 April 2017 (“Tan’s SD”). Mr Tan was the Managing Partner of Commercial Investigations LLP, the firm of private investigators that the Applicant had engaged.
- c. Registrant’s evidence of use:
 - i. SD of Fumitaka Saito dated 5 July 2016 (“Saito’s Second SD”). By this time, Mr Saito was holding the post of Director, Executive Officer of the Registrant.
 - ii. SD of Hideo Ui dated 21 May 2016 (“Ui’s First SD”). Mr Ui was a Director of NewYorker Ltd (a fully owned subsidiary of the Registrant).
 - iii. SD of Hiromitsu Kinoshita dated 1 July 2016 (“Kinoshita’s SD”). Mr Kinoshita was a Director of Style Works Pte Ltd (“Style Works”), a local distributor of the Registrant’s goods.
- d. Applicant’s evidence in reply:
 - i. SD of Friedrich Knapp dated 11 November 2016.
 - ii. SD of Lee Jun Hao Benjamin dated 8 November 2016 (“Lee’s SD”). Mr Lee was an investigator with Commercial Investigations LLP.
 - iii. SD of Tay Wei Liang dated 8 November 2016 (“Tay’s SD”). Mr Tay was an investigator with Commercial Investigations LLP.
 - iv. SD of Teo Chin Siang Hannes dated 8 November 2016 (“Teo’s SD”). Mr Teo was an investigator with Commercial Investigations LLP.
- e. Registrant’s further evidence in reply pursuant to leave granted at a Case Management Conference (“CMC”) on 11 January 2017:
 - i. SD of Fumitaka Saito dated 3 March 2017 (“Saito’s Third SD”).
 - ii. SD of Hideo Ui dated 24 February 2017 (“Ui’s Second SD”).

- iii. SD of Kazutoshi Imai dated 2 March 2017 (“Imai’s SD”). Mr Imai was the Managing Director of NewYoker Ltd and an Executive Officer of the Registrant.
- iv. SD of Masahiro Yoshino dated 7 March 2017 (“Yoshino’s SD”). Mr Yoshino was a Director of Takashimaya Singapore Ltd.

20 Neither party applied for cross-examination. Thus, the SDs before me formed the totality of the evidence in this dispute.

The private investigators’ evidence

21 Before delving into the substance of the Registrant’s evidence of use, it is convenient to first address the evidence from the private investigators (“PI(s)”) engaged by the Applicant, the Registrant’s response thereto, and the events thereafter.

22 Annexed to Knapp’s First SD were two Investigations Reports from Commercial Investigations LLP. The first was dated 22 December 2014, and the second was dated 6 October 2015.

- a. The first Investigations Report disclosed that prior to the commencement of this action, PIs had visited 40 businesses involved in the sale of goods in Class 25 (specifically: clothing, footwear and headgear) located across Singapore. However, the PIs could not locate any use of the Subject Mark in relation to goods in Class 25. (Notably, Takashimaya and Isetan were not among the 40 businesses visited by the PIs. The relevance of this will become clear shortly.)
- b. The second Investigations Report was in respect of investigations that took place after Saito’s First SD was filed. (In Saito’s First SD, he gave evidence that goods bearing the Subject Mark had been sold in Takashimaya and Isetan in 2012 and 2013. These goods had been imported into Singapore through a local distributor, Style Works Pte Ltd., which had obtained those goods from NewYoker Ltd., a wholly owned subsidiary of the Registrant.) According to the report, PIs visited Style Works Pte Ltd on 29 September 2015; Takashimaya Singapore on 29 September 2015 and 1 October 2015; and Isetan Scotts on 29 September 2015. The PIs eventually concluded, based on their investigations, that the Subject Mark had not been used in Singapore within the relevant time periods under consideration for non-use. The report also made reference to video footage taken by the PIs, but no video recordings were provided in Knapp’s First SD.

23 After Knapp’s First SD was filed, the Registrant requested that the Applicant disclose the video footage recorded by the PIs. The Applicant did so, and provided the Registrar with a copy. There were 9 video recordings in all. However, as the matter progressed, it turned out that the Applicant considered 4 of the 9 recordings to be material to the dispute.

These were captured at the following locations: (a) Isetan Scotts on 29 September 2015³; (b) Takashimaya Singapore on 29 September 2015⁴; (c) Style Works Pte Ltd on 29 September 2015⁵ (where the PIs were attended to by Mr Hiromitsu Kinoshita); and (d) Takashimaya Singapore on 1 October 2015,⁶ during a “NEWYORKER” sales event (where the PIs were attended to by Mr Hideo Ui). During a pre-hearing review on 27 March 2017, after parties confirmed that the remaining video recordings were not in dispute, directions were given for the 4 video recordings to be formally admitted into evidence. (Tan’s SD was filed later, together with the 4 video recordings in dispute.)

24 If I were to detail all of the events that took place between Knapp’s First SD and the hearing, this decision would be unnecessarily prolix. A summary is set out below:

- a. After the Registrant had obtained a copy of the PI video recordings from the Applicant, it engaged the services of Chambers Transcription Services (“CTS”). In their evidence, the Registrant’s deponents (see Saito’s Second SD, Ui’s First SD and Kinoshita’s SD) each made reference to the transcripts prepared by CTS. The thrust of their evidence was that the PIs were wrong in concluding that the Subject Mark had not been used in Singapore within the relevant time periods. Mr Ui and Mr Kinoshita both had a number of strong comments in this vein, given that they had each (separately) spoken to the PIs. (Mr Saito was not personally interviewed by the PIs but he too, had some comments based on CTS’ transcripts.)
- b. Once it had reviewed Saito’s Second SD, Ui’s First SD and Kinoshita’s SD, the Applicant sought the PIs’ comments. The PIs gave evidence that CTS’ transcripts did not accurately reflect what was said (see Lee’s SD, Tay’s SD and Teo’s SD). (Mr Lee visited Takashimaya Singapore on 29 September 2015. Mr Tay visited Takashimaya Singapore on 1 October 2015 and spoke to Mr Ui during that visit. Mr Teo visited Style Works on 29 September 2015 and spoke to Mr Kinoshita during that visit.) Each of the PIs proceeded to take the unusual step of *amending* the parts of the CTS transcripts relating to their respective visits, which they considered to contain “*some untruths and/or inaccuracies*”. They then substituted those parts with what they believed to be the correct version of the events, and exhibited the relevant amended transcript to their respective SDs. (Mr Knapp was not personally present during the investigations, but he too, had some comments on the amended transcripts.)
- c. In short, the parties could not agree on what was actually said and/or meant.
- d. When I reviewed the video recordings and read the CTS transcripts and the transcripts amended by the PIs, it appeared that the main reason why the parties took such diametrically opposed positions was that there were inherent

³ Tan’s SD at Exhibit PTSW-1, file name: JANC0940 20150929183757.

⁴ *Ibid*, file name: Style Works @ Pantech.

⁵ *Ibid*, file name: JALD0773_29092015185144.

⁶ *Ibid*, file name: Sales Event @ Takashimaya.

language difficulties. I mean no disrespect in saying the following. Japanese was obviously the first language of Mr Ui and Mr Kinoshita, and they spoke English (at times with slight difficulty) with a Japanese accent. On the other hand, while the PIs spoke in English, they did so in a distinctly Singaporean accent. (At other times, they spoke in “Singlish”). There were points where the PIs appeared to have difficulty fully understanding Mr Ui and Mr Kinoshita (and vice versa). What further complicated matters was that the audio in the recordings was not of the best quality at times (which was not surprising given that they were made in secret) and CTS’ transcriptions naturally reflected what the transcribers heard (not necessarily what the speakers said, let alone meant).

- e. A great deal of ink was spilled on both sides after the Applicant filed its evidence in reply (which included the PIs’ amended transcripts). Matters came to a head, and I convened a CMC on 11 January 2017 to discuss the way forward. (Other directions were also given at the CMC relating to further evidence in reply, but they concerned separate issues from the PI evidence.) After the CMC, the Applicant clarified, in writing, that it was not taking the position that CTS made false or untrue statements in the certified transcripts which it prepared. Neither was it alleging that CTS acted in an unfair or biased manner. Rather, the substance of its complaint was simply that the transcripts prepared by CTS had contained inaccuracies. It formally retracted the words “*untruths*” and “*untrue*” in relation to the transcripts provided by Chambers Transcription Services. (Directions had earlier been given to the effect that retraction by way of letter would be sufficient and that it would not be necessary to file an SD for the purpose.)
- f. Both sides were in agreement that the Hearing Officer should ultimately come to his or her own conclusions after watching and listening to the video recordings in question. Nevertheless, both sides stressed that in approaching these video recordings, one should take into consideration the position as set out in their deponents’ SDs.

25 I found that the Applicant’s PI evidence (i.e. the two Investigations Reports, the 4 video recordings, and the SDs filed by the PIs) showed that the Applicant had a reasonable basis for doubting that the Subject Mark had been put to genuine use within the relevant time periods. However, as it will be seen later in this decision, the Registrant did indeed have some documentary of use.

26 Even at its highest, the PI evidence did not have the effect of addressing, let alone negating, the Registrant’s evidence of use. As a whole, I found the Applicant’s PI evidence to have been of limited value to the overarching question: Had the Subject Mark been put to genuine use in relation to the goods for which it was registered, within the relevant time periods, so that the registration ought not be revoked under the first or second subsections of Section 22(1) TMA? It is to that question that I now turn.

The law

27 I begin with the policy rationale for why unused marks must be removed from the register. Briefly restated, they are as follows:

- a. First, the registration system facilitates and protects the essential function of a trade mark: To indicate trade origin. If the mark is not used as a badge of origin, this protection conferred by registration is no longer justified.
- b. Second, the register serves as a notice to rival traders and the public at large as to which trade marks 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. Third, the “hoarding” or “squatting” of trade marks is undesirable. Non-use revocation releases these marks back to the public domain so that other traders may use and/or register them.

(See *Weir Warman v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 (“*Weir Warman*”) at [42] and [99]; *MCI Group Holding SA v Secondment Pty Ltd* [2014] SGIPOS 15 at [42].)

28 The applicable legal principles are trite. An outline is set out below.

- a. The overarching issue that has to be decided is whether there was genuine, or *bona fide*, use of the mark, in the course of trade, in relation to the goods (or services) for which the mark is registered, within the relevant time periods. (There is no real or practical difference between the terms *bona fide* and *genuine* use: see *Nike International Ltd v Campomar SL* [2006] 1 SLR 919 (“*Nike*”) at [15].)
- b. Use need not be quantitatively significant to be genuine, provided it is sufficient to create or maintain market share in the goods or services concerned. There is no rule that *de minimis* use cannot constitute genuine use. However, token use for the sole purpose of preserving the rights conferred by the mark, or use which is just internal use by the proprietor concerned, is not genuine use. (*Weir Warman* at [99] and [100] citing *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 717.)
- c. There is no one single objective formula which applies to all situations; much would depend on the fact situation in each individual case. (*Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 at [44].) (Or, as the Registrant rightly put it, there is no hard and fast rule that can be applied across the board since “*the circumstances of proprietors of registered trade marks vary from one to another and the circumstances of a particular proprietor vary from time to*

time". (*Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd* [1994] 1 SLR(R) 330 at [32].⁷)

- d. As a general rule, the fewer the acts of use relied upon, the more solidly they need to be established. Where one single act is relied on, it ought to be established by, if not conclusive proof, overwhelmingly convincing proof. (*NODOZ Trade Mark* [1962] RPC 1, cited with approval in *Nike*.)
- e. Conversely, where there are a number of acts of use relied upon, it appears the ordinary civil standard (i.e. balance of probabilities) would apply. (*FMTM Distribution Ltd v Tan Jee Liang trading as Yong Yew Trading Company* [2017] SGIPOS 9 at [86].)
- f. For use to be genuine, or *bona fide*, it must be accordance with the essential function of a trade mark, which is to guarantee trade origin. In other words, genuine or *bona fide* use must be use *as a trade mark*. (*Société des Produits Nestlé SA and anor v Petra Foods Ltd and anor* [2017] 1 SLR 35.)

29 I now turn to the examine the Registrant's evidence of use.

Registrant's evidence of use

30 Most of the Registrant's documentary evidence of use was set out in Saito's First SD. Later on, more documents were adduced together with Saito's Second SD and Saito's Third SD to address certain criticisms levelled by Mr Knapp against his evidence. I set out the key aspects of Mr Saito's evidence below.

31 The Registrant manufactures and sells fashion apparel, fabrics, and manages commercial facilities. The Subject Mark, **NEWYORKER**, is the Registrant's flagship brand.⁸ Goods bearing the Subject Mark were first sold in Singapore in 2012,⁹ and the estimated retail figure of products sold and/or distributed in Singapore under the Subject Mark (up to the date of Saito's First SD) was S\$22,193.¹⁰ These goods under the Subject Mark had been imported into Singapore through a local distributor, Style Works Pte Ltd.,¹¹ which had obtained them from NewYorker Ltd., a wholly owned subsidiary of the Registrant.¹²

32 There was documentary evidence that goods bearing the Subject Mark had been shipped to Singapore. Mr Saito provided a copy of an Air Waybill dated 16 November 2012 and corresponding invoice (issued by NewYorker Ltd. to Style Works Pte. Ltd.) dated

⁷ Although this decision concerned the now repealed Trade Marks Act (Cap. 332, 1992. Ed.), the principle remains applicable.

⁸ Saito's First SD at [3].

⁹ Saito's First SD at [5].

¹⁰ Saito's First SD at [6].

¹¹ Saito's First SD at [8].

¹² Saito's First SD at [6] and Exhibit FS-2.

15 November 2012.¹³ Together, they showed that NewYorker Ltd. in Japan had shipped a total of 568 items to Style Works Pte. Ltd. in Singapore, valued at a total of US\$26,678.58. These items fell into the following categories:

- a. For women: jackets, skirts, pants, dresses, blouses, knitwear, pullovers, cardigans, stoles, and hats.
- b. For men: jackets, suits, coats, pants, polo-shirts, shirts, and ties.

It was also indicated on the abovementioned Air Waybill and invoice that the goods were shipped under the shipping mark “NEW YORKER” (followed by “SINGAPORE” below). The invoice also indicated that the brand of the goods was “NEWYORKER”. Notably, the heading of the invoice bore the Subject Mark, and was signed by Mr Kazutoshi Imai. Both the invoice and Air Waybill were addressed to Mr Hiromitsu Kinoshita. (Both Mr Imai and Mr Kinoshita gave evidence in these proceedings.)

33 The goods bearing the Subject Mark were sold in two locations: Takashimaya and Isetan.¹⁴ However, during the relevant time periods under consideration, there was no continuous sales of goods bearing the Subject Mark. Instead, sales took place during specific periods. For Takashimaya, the sales dates were: 4 – 10 December 2012 and 29 October – 3 November 2013. As for Isetan, the sales dates were: 11 – 21 July 2013. In this connection, Mr Saito provided copies of the following documents:¹⁵

- a. A postcard invitation to a **NEWYORKER** sales event on 4 – 10 December 2012. The Subject Mark was displayed on the front and the back of the postcard. (The text of the postcard was in the Japanese language.)
- b. An extract from the Takashimaya Singapore website wherein the 4 – 10 December 2012 **NEWYORKER** sales event (“the Takashimaya Sales Event 2012”), located at Studio O4, Level 4, was advertised. The Subject Mark was prominently displayed on the relevant segment of the website.
- c. Three photographs taken in Takashimaya Singapore of the Takashimaya Sales Event 2012. In these photographs, the Subject Mark could be seen prominently displayed on various signage together with the word “SALE”. The date stamp “2012/12/04” could be seen on one of the photographs. Although not entirely clear (there being no close up shot of the actual goods), it appeared from the photographs that both men’s and women’s clothing were being sold in connection with the Subject Mark. (In this connection, I should mention that in Ui’s Second SD, he attested to the fact that he was present at this sales event and took these photographs using a camera owned by NewYorker Ltd. Mr Ui

¹³ Saito’s First SD at Exhibit FS-2.

¹⁴ Saito’s First SD at [7].

¹⁵ Saito’s First SD at Exhibit FS-3

also gave evidence that goods bearing the Subject Mark were offered for sale and sold to customers during the said sales event.)

- d. Three photographs taken in Takashimaya of the 29 October – 3 November 2013 **NEWYORKER** sales event (“the Takashimaya Sales Event 2013”), located at Talking Hall, B1. In these photographs, the Subject Mark could be seen, together with the words “*LADIES’ BAZAAR UP TO 70% OFF*”. All three photographs were time stamped “2013 / 11 / 03”. Although there was no close up shot of the actual goods, it was obvious that women’s clothing was being sold under the Subject Mark. Two of the photographs were of what appeared to be signage, and the words “*Takashimaya November 2013*” could be seen. (These photographs were taken using Mr Kazutoshi Imai’s personal camera, and Mr Imai was personally present at this sales event.¹⁶⁾
- e. Four photographs taken in Isetan (Scotts) of the 11 – 21 July 2013 sales event (“the Isetan Sales Event 2013”). All four of the photographs were timestamped “2013 / 7 / 18”. One of the photographs was taken close up and the Subject Mark could clearly be seen on what appeared to be a men’s polo-shirt. In another photograph, there was also a sign which read: “*New Yorker Jacket Suit*”. Below that, it was indicated that the usual price of these was \$506 – \$979 but the sale price was \$202 - \$379. It could also be seen that men’s shirts, jackets, and ties were being sold in connection with the Subject Mark. (These photographs were taken using Mr Kazutoshi Imai’s personal camera, and Mr Imai was personally present at this sales event as well.¹⁷⁾

34 In Saito’s Second SD, he provided copies of the following further documents relating to the 2 sales events in Takashimaya in 2012 and 2013, and the sales event in Isetan (Scotts) in 2013: ¹⁸

- a. A signed quotation by Semba Singapore Pte Ltd, issued to NewYorker Co., Ltd.¹⁹ dated 20 November 2012 for the “*Installation of Signage for NEWYORKER @ Takashimaya S.C #04-04*”, together with a design layout it prepared for the Takashimaya Sales Event 2012.
- b. An authorisation for Requisition of Debit Note dated 1 November 2013 issued by Takashimaya Singapore Ltd to Style Works Pte Ltd for the cost of preparing and sending direct mailers to customers informing them of the Takashimaya Sales Event 2012. (This was for the postcard invitation referred to in the paragraph above.)

¹⁶ Imai’s SD at [3] and [4].

¹⁷ *Ibid.*

¹⁸ Saito’s Second SD at Exhibit FS-2 (note: not be confused with Exhibit FS-2 of Saito’s First SD).

¹⁹ This appears to be the same entity as NewYorker Ltd.

- c. A sign which read “*NewYorker up to 80%*”. (Although the sign was undated, it was indicated as being for Talking Hall B1 in Takashimaya Singapore, which was where the Takashimaya Sales Event 2013 was being held.)
- d. A written statement issued by and under the letterhead of Takashimaya Singapore Ltd., signed by Managing Director, Mr Tatsuo Yano, confirming that products bearing the Subject Mark were sold in Takashimaya during the Takashimaya Sales Event 2012 and the Takashimaya Sales Event 2013.
- e. A sales statement issued by Isetan (Singapore) Limited dated 6 August 2013 (for the month of July 2013) in respect of the sale of “*NEW YORKER*” products at the “*SCOTTS*” location). It was issued to Style Works Pte Ltd. Based on the sales statement, it appeared that there were *actual sales* of goods bearing the Subject Mark on 11, 12, 13, 14, 15, 17, and 18 July 2013. The total value of the Nett Sales was \$2,828.08.
- f. A “*sales by supplier*” sheet dated 10 December 2012 issued for the Takashimaya Singapore store, Ladies Wear department, by the supplier Style Works Pte Ltd, for “*New Yoker*” (an obvious misspelling of “*NEWYORKER*”). The total quantity of goods sold was 91 pieces.

35 In Saito’s Third SD, he provided a copy of a Delivery Order dated 19 November 2012 issued by Nissin Transport (S) Pte Ltd evidencing the receipt of goods by Style Works Pte Ltd. The references reflected on this document (with a signed and stamped receipt confirmation by Style Works Pte Ltd) corresponded to those on the Air Waybill dated 16 November 2012. It showed that the shipment of goods bearing the Subject Mark had indeed been delivered to Style Works Pte Ltd.²⁰

36 Mr Saito’s evidence concerning the two sales events at Takashimaya was corroborated by independent evidence from Mr Masahiro Yoshino, Director of Takashimaya Singapore Ltd. Mr Yoshino’s evidence was that he was personally aware of the arrangements for the events.²¹ He confirmed that the postcard direct mailers were sent for the Takashimaya Sales Event 2012, and that the “*NewYorker up to 80%*” signage referred to in Saito’s Second SD was indeed displayed at the Talking Hall at basement level 1 of the Takashimaya Singapore store.

37 Mr Saito’s evidence concerning the business relationship between the Registrant, its wholly owned subsidiary, NewYorker Ltd., and the fact that Style Works was its distributor in Singapore was corroborated by the evidence of Mr Kinoshita and Mr Ui.²²

Evaluation

²⁰ See Saito’s Third SD at Exhibit FSR-1.

²¹ See Yoshino’s SD at [3] – [6].

²² See Kinoshita’s SD at [2] and Ui’s First SD at [2].

38 As mentioned above, the Applicant did not apply to test the veracity of the Registrant's SD evidence in cross-examination. Instead, it was content to make written and oral submissions aimed at criticising (and nit-picking on) various aspects of the Registrant's evidence of use.²³ The main thrust of the Applicant's case was that there were pieces of the puzzle that were missing and without those missing pieces, it was not safe for me to find that the Subject Mark had been put to genuine use, in relation to the relevant goods, and within the relevant time periods under consideration.

39 Although I considered the Applicant's arguments to be unpersuasive, I will, for completeness, briefly deal with three of them: (a) the *Bentley* case; (b) the stylisation argument; and (c) the insufficient sales argument.

The Bentley case

40 There was an attempt by the Applicant to characterise this case as being similar to *Bentley Motors Limited v Aucera SA* [2016] SGIPOS 11 ("Bentley").²⁴

41 *Bentley* was a recent decision of this Tribunal wherein the registered mark "BENTLEY" (for eyewear in Class 9) was successfully revoked by Bentley Motors for non-use. The registered proprietor, Aucera SA, sought to rely, *inter alia*, on an invoice and an airway bill as being evidence of a shipment of goods being imported into Singapore under the subject mark "BENTLEY". The learned Principal Assistant Registrar ("PAR") Ms Tan Mei Lin found that she was unable to tell from the documents what goods were being shipped, let alone whether they bore the subject mark at all. There were also numerous other difficulties with the evidence in *Bentley* (see [28] – [36]) which I need not repeat here.

42 The Applicant sought to cast doubt on the Registrant's evidence and submitted, by reference to *Bentley*, that "*it is entirely possible that the Proprietor's goods bore brands or logos other than the Subject Mark*".²⁵ Such an argument was fanciful, to say the least. Clearly, there was documentary evidence, including photographic evidence, that the Subject Mark had been displayed on and in connection with clothing and related goods such as ties sold during the Takashimaya Sales Event 2012, the Takashimaya Sales Event 2013, and the Isetan Sales Event 2013. Ultimately, I was not at all persuaded that the factual situation in this case was anything like *Bentley*.

The stylisation argument

43 Another line of argument which the Applicant advanced related to the stylisation in the Subject Mark **NEWYORKER**. The kernel of this submission was that it was not enough for the Registrant to show that the plain "NEWYORKER" or "NEW YORKER" was used in relation to the goods. Instead (so the argument went), the Registrant had to show use in the specific font and style for it to qualify as being relevant use, given the "*particularly*

²³ See Applicant's Written Submissions at [11] – [38].

²⁴ See Applicant's Written Submissions at [18].

²⁵ *Ibid.*

*“eye-catching” nature of the first letter “N”, the fourth letter “Y” and the last letter “R” which meant that “use of the mark as a plain word mark or in an alternative stylisation is likely to alter the distinctive character of the Subject Mark as registered”.*²⁶

44 With respect, I found this submission to be without merit. Section 22(2) TMA provides that for the purposes of Section 22(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...”. Here, while there was *some* stylisation in the Subject Mark, it was relatively minimal. In my judgment, the use of the plain “NEWYORKER” or “NEW YORKER” would clearly be relevant in the assessment. Further and in any event, there was evidence that the Subject Mark had been used in the stylised form (as registered). (For a case wherein a similar argument failed because the use was found to be in a form differing in elements which did not alter the distinctive character of the mark, see *Capitol Records LLC v Steven Corporation Pte Ltd* [2010] SGIPOS 14 (“Capitol Records”) where the registered mark **BLUENOTES** had been used as “BLUE NOTE” and “BLUE NOTES”).²⁷)

The insufficient sales argument

45 The Applicant cited *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 717 (cited with approval in *Weir Warman*), where the European Court of Justice stated that “use does not have to be quantitatively significant to be genuine, provided it is sufficient to create or maintain market share in the goods or services concerned”. The Applicant also cited *Laboratorie De La Mer Trade Marks* [2002] FSR 51 at [27], where the old English position was discussed. Specifically, there were cases where it had been held that:

“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’”.

46 The Applicant also cited *Bentley* (at [58]), where the learned PAR referred to a footnote in paragraph [10-060] in *Kerly’s Law of Trade Marks and Trade Names* (15th Ed., London: Sweet & Maxwell) for the proposition that intermittent or temporary use is usually an indicator of non-genuine use, whereas steady use or use backed by an intention to establish a market indicates genuine use.

47 There are numerous other authorities on this point and it is not necessary to discuss them all. In my judgment, the following may be gleaned from the cases: When all is said and done, the court or tribunal must assess whether the use of the mark was genuine (or *bona fide*) in the sense that it was applied to the relevant goods or services for the purposes

²⁶ See Applicant’s Written Submissions at [21].

²⁷ Citing *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co)* [2003] 4 SLR(R) 92.

of use in the course of trade. Such use is to be distinguished from merely internal use or use designed simply to defeat an action for non-use revocation. In answering this question, the quantitative amount of use is relevant, but not determinative: The greater the use, the more likely that the use was genuine. Conversely, where the use was very slight, the court or tribunal must be careful to scrutinise the evidence, having regard to all of the relevant circumstances, with a view to assessing whether it was genuine (or *bona fide*) or not.

48 Having regard to the relevant legal principles, the Applicant argued that the following factors pointed towards a finding that there was no genuine use.²⁸ First, the value of sales under the Subject Mark in Singapore was small when viewed in the context of the Registrant's larger business worldwide. Second, any use essentially took place in connection with 3 sales events, each lasting only a few days: The Takashimaya Sales Event 2012 lasted for 7 days; the Takashimaya Sales Event 2013 lasted for 6 days; and the Isetan Sales Event 2013 lasted for 11 days. The Registrant had failed to give any explanation as to why there were only 3 sales events across over such a protracted period of time, or why it ceased use of the Subject Mark after the last sales event in 2013.

49 In my judgment, the evidence pointed towards an effort to launch both women's and men's clothing (and related items) bearing the Subject Mark in Singapore. It appeared to be a sequential process involving first bringing in limited quantities in established department stores to generate interest through sales events, before finally setting up a permanent location. The facts did not fit a theory that the Registrant was simply trying to sell a few items here and there in order to (pre-emptively) defeat an action for non-use revocation. I considered the following factors to be relevant in this regard.

- a. First, the completion of the registration procedure for the Subject Mark was on 2 January 2009. The mark would first be vulnerable to non-use revocation on 3 January 2014. The Subject Mark was first put into use quite some time before, in November 2012. This was not a situation where the registered proprietor had scrambled to put a registered trade mark into use at the eleventh hour with a view to defeating an action for non-use revocation. And, certainly, this was not a case where the use was internal: There were *actual sales* to customers in Singapore through department stores: Takashimaya and Isetan.
- b. Second, the shipment of goods in November 2012 to Style Works (as evidenced by the invoice) contained what appeared to be different product codes or "styles" of the same type of clothing. To use women's dresses as an example, they were itemised 26 to 36, and there were different product codes for each. There were 100% polyester women's dresses, there were 100% cotton women's dresses, and there were dresses in between such as those made of 50% rayon, 41% acetate and 9% cotton. The point is that there were more than 40 pieces of dresses in all, of varying material types. And the same could be said for women's pants, blouses, and so on. There was a total of 568 pieces of clothing (and other goods such as men's ties) in all – not a great number, but far from insignificant either. On the whole, this was consistent with the actions of a

²⁸ See Applicant's Written Submissions at [40] – [42].

foreign trader which had wanted to test the demand in the Singapore market before entering it, not one that was pre-empting an action for non-use revocation. Indeed, if the Registrant was simply concerned with portraying a façade of genuine use, why would it have bothered to bring in such a wide variety of goods, of a not insignificant quantity?

- c. Third, steps had been taken to advertise the **NEWYORKER** trade mark and the goods sold thereunder. Such steps included the direct mailers for the Takashimaya Sales Event 2012 (this was the postcard referred to at [33(a)] above) which was in the Japanese language and clearly aimed towards a specific niche market of Japanese living in Singapore and who would be familiar with the brand. Other steps included the fact that the Subject Mark was displayed on signage and on the Takashimaya website. In this connection, efforts had been made to secure the services of an external contractor (Semba Singapore Pte Ltd.) to construct signage for the Takashimaya Sales Event 2012 (see [34(a)] above). These acts appeared to be aimed towards genuinely promoting and selling the goods.
- d. Fourth, there was evidence from Mr Ui²⁹ that from 5 October 2015 onwards, the Registrant's **NEWYORKER** goods have been continually offered for sale in a permanent retail section in Takashimaya. This evidence was corroborated by that of Mr Yoshino from Takashimaya, who elaborated that this retail section was located on level 3 of the store.³⁰ (This permanent retail location had been preceded by the sales event on 1 October 2015, which the PIs had visited.) I note, of course, that this evidence was after the relevant periods under consideration, but I fail to see how it cannot be taken into account in assessing whether the Registrant's use of the Subject Mark was *bona fide*.
- e. Fifth, I acknowledge the (cynical) view that the Registrant could have set up the permanent retail section (in October 2015) *because* this action was filed (in March 2015). But it seems doubtful that it would have been able to move that quickly had it not already engaged a local distributor (Style Works Pte Ltd), shipped the relevant goods over, and secured a location with Takashimaya a long time prior to that. Commercial matters of this sort take time and it is only reasonable to conclude that the Registrant had been planning to enter the local market permanently (as opposed to holding temporary sales events) all along. There may have been a 2-year time gap between the October-November 2013 sales event and the eventual launch of the permanent retail location in October 2015 but this does not seem to be disproportionately long so as to impact on the issue of *bona fides*. After all, the time gap between the 2012 and 2013 sales events was about 1 year.

²⁹ Ui's First SD at [7].

³⁰ Yoshino's SD at [8].

- f. Finally, the fact that the Registrant has a large market or business outside of Singapore is of limited to no relevance *in this case*. While it may be important background information, I fail to see how the fact that the Registrant was engaged in various business activities and has sold fabric, clothing and other related goods in connection with other trade marks says anything meaningful about whether the Subject Mark has been put to genuine use in Singapore.

In the premises, I was unable to accept the Applicant's submission that the use of the Subject Mark was not genuine.

Conclusion on whether there was genuine use of the Subject Mark

50 If one sets out to find flaws in documentary evidence, one will find them one way or another. It is rare in litigation for there to be no missing pieces of the puzzle. But, one seldom needs all the pieces to tell what is being depicted. The evidence in this case speaks for itself. I have analysed it in detail above at various points and will not repeat my findings. All that needs to be said is that it was patently clear that the Subject Mark was used on and in relation to goods that were imported into Singapore by Style Works Pte Ltd, which had ordered them from the Registrant's wholly owned subsidiary, NewYorker Ltd., and after they were shipped into Singapore they were sold in Takashimaya and Isetan (Scotts). Even a Director of Takashimaya (Mr Yoshino) came forward to give evidence in support of the Registrant's case.

51 I am mindful that the fewer the acts of use relied upon, the more solidly they need to be established. However, in this case the acts of use culminated in three separate sales events (two in Takashimaya and one in Isetan), each ranging for a number of days. In these circumstances, the ordinary civil standard – a balance of probabilities – would have sufficed. Even if I am wrong in this regard, I take the view that the Registrant has provided conclusive or overwhelmingly convincing proof that the Subject Mark had been put to use in 2012 and 2013, which fell between *both* the First 5 Year Period and the Second 5 Year Period (see [13] above), in respect of the following:

- a. For women: jackets, skirts, pants, dresses, blouses, knitwear, pullovers, cardigans, stoles, and hats.
- b. For men: jackets, suits, coats, pants, polo-shirts, shirts, and ties.

52 For completeness, and although every case must necessarily turn on its own facts, I note that genuine use of a trade mark has been found on the basis of documentary evidence that was less, or at least similar, in both quantity and quality as compared to that which was tendered in this dispute. Examples of cases in this vein include:

- a. *Weir Warman*, a decision of the High Court, where the following were sufficient to constitute genuine use: three e-mail enquiries received by the proprietor from Singapore companies; a fax written by the proprietor to a

potential customer offering for sale the products in question; and a meeting in Singapore with a dealer of the products.

- b. *Capitol Records*, a decision of this Tribunal where the key documents were invoices evidencing sales transactions involving, among other things, a reputable retailer, Robinsons & Co. (S) Pte Ltd. There was also a statement from a director of another reputable retailer, Kiddy Palace Pte Ltd, that there had been sales of goods under the subject mark.
- c. *FMTM Distribution Limited v Van Cleef & Arpels S.A.* [2017] SGIPOS 6, a decision of this Tribunal where genuine use was found on the basis of several invoices relating to four transactions in Singapore over a period of 3 years.

Whether partial revocation should be ordered

53 The next issue is whether partial revocation should be ordered given that I have found the Subject Mark to have been used in relation to some, but not all of the goods.

54 The Applicant submitted, by reference to *Weir Warman* at [111], that in these circumstances, Section 22(6) TMA “*mandates*” partial revocation. It argued that there should be revocation of the goods in strikethrough,³¹ as follows:

Clothing; hats; neckties; shawls; ~~underwear~~; socks; belts (clothing); boots; shoes; sandals; ~~gloves (clothing)~~; scarves; caps (headwear); ~~garters~~; ~~sock suspenders~~; braces for clothing (~~suspenders~~); bands (for wear); sweat bands for the head; sweat bands for the wrist; costumes (masquerade); sports clothes (other than golf gloves); ~~shoes and boots for sports~~; suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; ~~bathing drawers~~; ~~bathing suits~~; breeches (for wear); top coats; ~~collar protectors~~; ~~combinations (clothing)~~; cuffs; ~~footwear~~; ~~fur (clothing)~~; gabardines (clothing); ~~dressing gowns~~; ~~half boots~~; headgear for wear; ~~hoods (clothing)~~; hosiery; stuff jackets (clothing); jumpers (shirt fronts); ~~muffs (clothing)~~; overcoats; ~~overalls~~; pajamas; parkas; pullovers; ready-made clothing; ~~slippers~~; ~~spats~~; ~~waistcoats~~.

55 During oral argument, Counsel for the Registrant submitted that partial revocation would not be appropriate. She cited *Capitol Records* for the proposition that the question to be asked is: “*what would be a fair specification of goods having regard to the use that the Proprietor has in fact made of the mark and assuming further that he will continue that use?*” (at [41]). In the Registrant’s submission, the specification of goods in respect of which the Subject Mark was registered was not unduly wide, bearing in mind the nature of its business in the manufacture and sale of clothing and fashion accessories.

56 Although counsel for the Applicant did not dispute the correctness of the fair specification approach, he urged me to look very carefully at the evidence (and in particular

³¹ Applicant’s Written Submissions at [46] – [49].

the documentary evidence). He gave the example of underwear and socks, and impressed upon me that there was no documentary evidence that such goods were ever sold under the Subject Mark. He cautioned that it would be incorrect to cast a broad characterisation and classify these (i.e. underwear and socks) under men's clothing. Instead, he stressed, I should look at the documents as the starting point for discerning the fair specification.

57 In oral reply, counsel for the Registrant contended that it would be artificial to simply “*cut out*” the goods in the way the Applicant had suggested. Importantly, these goods (with the exception of footwear) were all clothing and headgear of some sort, if not closely related to clothing and headgear. As regards the various types of footwear, counsel submitted that these were nevertheless related to clothing and headgear and should therefore not be struck out. She sought to impress upon me that a reasonably informed average consumer of clothing would not be surprised to see “NEWYORKER” shoes, sandals or footwear as well. This, in her submission, would be a natural extension of the business and allowing such goods would not be unduly wide in scope.

58 Apart from *Weir Warman* and *Capitol Records*, no other authorities were cited before me in argument. I should also record that the parties' submissions were made primarily at an abstract level and without reference to specific examples from the cases.

The law

59 I begin with *Weir Warman*. In that case, V K Rajah JA observed (at [112]) that:

“The approach in the UK toward partial revocation is that it is open to the court (or Registrar) to require the specification of goods or services to be re-written in order to achieve the required degree of revocation, such that the court may “dig deeper” into certain wider specifications and insert words of limitation into the specifications (see *ie, MINERVA Trade Mark* [2000] FSR 734; *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293; *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 586). Locally, in *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long* [2003] 4 SLR(R) 92, Woo Bih Li J explained that the task of the court in partial revocation was to limit the specification so that it reflected the circumstances of the particular trade and the way that the public would perceive its use.”

(emphasis added)

On the facts of *Weir Warman*, genuine use had been shown in relation to “*pumps and pump parts*”, but not “*milling equipment and valves*”. Accordingly, it was found that there should be revocation in respect of “*milling equipment and valves*”. However, V K Rajah JA did not find it necessary to insert any words of limitation to the remaining specifications (pumps and pump parts) in order to further confine the proprietor's registration to the particular *types* of pump parts which the defendant was able to adduce evidence of use for. To do so, in his view, would be “*unnecessarily confusing and restrictive as well as not in the interest of the public or the trade*” (see [113]).

60 *Capitol Records* (just like in this case) involved a registration in Class 25. The subject mark in that case was registered in respect of: “men’s t-shirts, shirts, jeans, shorts, vests, slacks, briefs, ladies’ t-shirts, blouses, slacks, jeans, skirts, shorts, boys’ t-shirts, boys’ suits, shorts, jeans and shirts, sports shirts”. The Hearing Officer, PAR Ms Lee Li Choon, considered that broadly speaking, this covered “men’s clothing, ladies’ clothing and boys’ clothing”. It was found that there was use in respect of boys’ shorts. There was also evidence that the mark had been used in respect of boys’ shirts, t-shirts, shorts, Bermudas, long pants (i.e. boys’ clothing generally). The question before the learned PAR was whether the specification should be narrowed. (The applicant for revocation had submitted that a narrower specification of “boys’ shorts” or “boy’s shirts, t-shirts, shorts, Bermudas and long pants” would be appropriate.)

61 In addressing that question, the learned PAR drew guidance from *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co)* [2003] 4 SLR(R) 92 (“*Bluestar*”), a decision of the High Court (which was also discussed in *Weir Warman*). As her summary and analysis of the law is particularly apposite, I reproduce it in relevant part below.

“[41] ... In [*Bluestar*], the trade mark was registered in respect of men's undergarments, briefs, socks, men's sports clothing, knitwear, singlets, swimwear. The registered proprietor could only prove use of the mark on socks, briefs, men's tshirts, singlets and swimwear. The applicant for revocation argued that the court should revoke the registration in respect of "men's undergarments and knitwear" and to replace "men's sports clothing" with "men's T-shirts". The learned Justice Woo Bih Lee at [57] went through at some length the relevant passages in the judgement of *Pumfrey J in Decon Laboratories Ltd v Fred Baker Scientific Ltd [2001] RPC 17* (“*Decon*”) where Pumfrey walked through the various approaches adopted by Neuberger J, Laddie J and Jacob J in respectively, *Premier Brands UK Limited v Typhoon Europe Ltd* [2000] FSR 767, *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850, and *MINERA Trade Mark* [2000] FSR 734. The learned Justice Woo Bih Lee then went on to quote Pumfrey J's conclusion in *Decon*, “In my judgement, the task is best performed by asking what would be a fair specification of goods having regard to the use that the Proprietor has in fact made of the mark and assuming further that he will continue that use.”

[42] The learned Justice Woo Bih Lee went on to note that Pumfrey J's judgement was cited with approval by Lord Justice Aldous in *Thomson Holidays (Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 (“*Thomson Holidays*”)) who said, “Pumfrey J was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described.” Lord Justice Aldous then said, “Pumfrey J in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when

deciding whether there is confusion under s10(2), adopts the attitude of the average reasonably informed customer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

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

However, the illustrations given in *Decon* and *Thomson Holidays* demonstrated that the court's approach towards partial revocation should not be as strict or narrow against the registered proprietor as Mr Wong was advocating. For example, he suggested that "men's sports clothing" should be revoked and replaced by "men's T-shirts". Mr Wong's point was that if the classification was narrowed, it would allow the applicant to use its mark for, say, shorts and trousers although not for briefs. Yet, in *Thomson Holidays*, Aldous J had said that a registration of motor vehicles would extend to motor bikes even though the proprietor of the registered trade mark had used it for motor cars only. In my view, the respondents' classification, as it was, was not unduly wide. For example, when the applicant had sought registration of its own mark under class 25, it had also used general words like "clothing", "underclothing", "headgear".

At the conclusion of her analysis, the learned PAR Ms Lee held that the specification covered by the registered mark was not unduly wide, and refused to narrow the specification.

Evaluation

62 Returning to the present case, the class heading of Class 25 covers "clothing", "headgear", and "footwear". As it can be seen from the specification of goods, the Registrant had claimed "clothing", and "footwear". And, although it did not claim "headgear" *per se*, it did claim "headgear for wear", which is substantially the same thing.

63 I have found that the Subject Mark was put to genuine use in respect of various articles of women's and men's clothing. The specification of goods in respect of which the Subject Mark was registered does not distinguish between gender and I do not think that any distinction needs to be made for present purposes. Taken together, it can be fairly said that the Subject Mark was put to use in respect of "clothing", including "jackets, skirts, pants, dresses, blouses, knitwear, pullovers, cardigans, stoles, suits, coats, polo-shirts, and ties". As regards "headgear for wear" there was evidence that the Subject Mark had been used in relation to "hats". However, there was no evidence of any use of the Subject Mark in relation to "footwear" of any sort.

64 To the Applicant's credit, in proposing which goods ought to be struck out from the specification of goods, it was not unfair in its approach. It did not dispute (under its alternative argument) that there had been use in respect of the following.

Clothing; hats; neckties; shawls; scarves; caps (headwear); sports clothes (other than golf gloves); suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; breeches (for wear); top coats; gabardines (clothing); headgear for wear; stuff jackets (clothing); jumpers (shirt fronts); overcoats; parkas; pullovers; ready-made clothing.

I agree that an order for revocation should not be made in respect of the above goods.

65 As regards the following goods, all of which fall within the scope of footwear, I agree with the Applicant's submission that there should be partial revocation in respect of these:

boots; shoes; sandals; shoes and boots for sports; footwear; half-boots; slippers; spats

My reasons are as follows:

- a. First, there was simply no evidence that the Subject Mark had ever been used in relation to *any* type of footwear (whether in the First 5 Year Period or the Second 5 Year Period). Although the cases indicate that actual use is but the starting point, it remains an important point.
- b. Second, I acknowledge that footwear and clothing are related in that they are both meant to be worn on the body. There may also be examples in the marketplace wherein traders and manufacturers of footwear (e.g. boots) offer clothing (e.g. shirts) and *vice-versa*. However, boots and shirts cannot be considered identical or overlapping goods. Indeed, it could certainly be argued in the context of an opposition or infringement proceedings that there is an appreciable difference between boots and shirts. (I am by no means saying that such goods are dissimilar; all I am saying is that in an appropriate case, that degree of difference might arguably be relevant.)
- c. Third, although in *Capitol Records* the learned PAR Ms Lee held that the specification should not be narrowed on the facts of that case, she opined *obiter* that the position "*may be slightly different if the specification covers clothing and footwear and there is use only on footwear as in such a case, there may be a greater reason to order partial revocation in respect of clothing in which there was no use*" (see [44]). This case is analogous to her hypothetical scenario, although the facts are reversed in that there was no use on footwear. Consequently, there is a greater reason to order partial revocation in respect of "*footwear*" and the various goods falling within that description.

- d. Having regard to all the circumstances, to allow the Subject Mark to continue to be registered in relation to the said goods would result in a specification of goods that is unduly and unfairly wide having regard to the use that the Registrant has in fact made of the Subject Mark.
- e. The attentive reader would note that I have not included “socks”, “garters”, “sock suspenders” and “hosiery” in the category of footwear that I have held should be revoked. This is intentional. For the purposes of partial revocation, it is not necessary to split hairs as to what is or is not footwear. As a matter of common sense and knowledge, those in the clothing trade are known to offer goods of such descriptions as well since they are usually made of softer fabric or other material. It is no stretch to manufacture cotton or woollen socks, for instance, if one is already manufacturing and selling cotton shirts and woollen knitwear. This is different from goods like boots and shoes and sandals which are often made of much more hardy material like rubber or hard leather and are meant for obviously different uses. It is true that socks and shoes are closely related goods – after all, one typically wears shoes over socks. But I would not go so far as to say that they are identical. Neither should their degree of similarity be overstated. (Here as above, I am by no means saying that such goods are dissimilar; all I am saying is that in an appropriate case, that degree of difference might arguably be relevant.)

66 This leaves the remaining goods below (the “Remaining Goods”):

underwear; socks; belts (clothing); gloves (clothing); garters; sock suspenders; braces for clothing (suspenders); bands (for wear); sweat bands for the head; sweat bands for the wrist; costumes (masquerade); bathing drawers; bathing suits; collar protectors; combinations (clothing); cuffs; fur (clothing); dressing gowns; hoods (clothing); hosiery; muffs (clothing); overalls; pajamas; waistcoats;

It is true that the evidence does not, in actual fact, show use of the Subject Mark specifically in relation to all of the Remaining Goods. However, as stated above, specific instances of use are only the starting point. My task is to arrive at a fair specification of goods having regard to the evidence and all the circumstances.

67 As stated at various points above, there was evidence of use in relation to various articles of “clothing”³² and “headgear for wear”.³³ When I look at the circumstances of the trade and the way in which notional consumers would regard that use, I arrive at the conclusion that apart from “costumes (masquerade)”, which are a highly specialised type of good for which there was obviously no use, the rest of the Remaining Goods could fairly be described as being similar in description (or at least closely related) to the goods in relation to which the Subject Mark had been put to actual use.

³² Specifically, “jackets, skirts, pants, dresses, blouses, knitwear, pullovers, cardigans, stoles, suits, coats, polo-shirts, and ties”.

³³ Specifically, “hats”.

68 Consider the following examples. Common experience would inform that manufacturers of shirts often sell related items such as collar protectors. Consumers would also be familiar with t-shirt and jeans traders that sell underwear and *vice versa*. And, the notional consumer of jackets and coats would surely not be surprised to learn that his or her favourite brand now sells waist coats too. Similarly, it is not too far-fetched to imagine that a seller of hats would sell exercise sweat bands as well. In all of these hypothetical examples, whether the Registrant did or did not sell a particular good is irrelevant: They are meant to illustrate that a fair specification of the goods under the Subject Mark would reasonably and logically entail including all of the Remaining Goods except “*costumes (masquerade)*”.

69 Now, it might be asked – how are these hypothetical illustrations different from the footwear scenario? The answer to that question is that for footwear, the Registrant was attempting to draw links between clothing or headgear on the one hand, and footwear on the other. In the context of the Remaining Goods (except for “*costumes (masquerade)*”), there was already evidence of use falling within the categories of clothing and headgear and it would be fair and reasonable to allow other goods within these sub-categories to remain. To go to the lengths of deleting, say, “*belts (clothing)*” when the Registrant has shown evidence of use for “*neckties*” would be “*unnecessarily confusing and restrictive as well as not in the interest of the public or the trade*”.

70 Moreover, the Applicant itself accepted under its alternative argument that revocation should not be ordered for “*clothing*” and “*headgear for wear*”. If one begins from the premise that “*clothing*” and “*headgear for wear*” would not be unduly wide a specification of goods for the Subject Mark, surely it must follow that allowing the Remaining Goods (save for “*costumes (masquerade)*”) to remain on the register would not result in an unduly wide specification either.

71 Accordingly, I hold that no partial revocation should be ordered in respect of Remaining Goods save for “*costumes (masquerade)*”.

72 The next question is when should be the effective date of partial revocation?

The Applicant’s Backdating Request

73 The Applicant’s further submissions (filed pursuant to leave given at the conclusion of the oral hearing) set out 4 reasons in support of the Backdating Request. I reproduce them, in relevant part, below:³⁴

- a. The Court of Appeal “*has acknowledged that the purpose of section 22(7)(b) [TMA] is to remedy situations such as the present one*”.
- b. “*There are no policy reasons to prevent the backdating of the revocation date to 6 September 2011*”.

³⁴ See Applicant’s Written Submissions dated 1 August 2017 at [3].

- c. The Applicant “*has successfully revoked the Registered Proprietor’s Singapore Trademark No. T9611792H [for “NEWYORKER BY DAIDOH”] and the Assistant Registrar has exercised her discretion to backdate the effect of the revocation to 6 September 2011*”.
- d. The guidance set out in IPOS’ HMD Practice Circular No. 1/2012 “*can be departed from in appropriate cases pursuant to the Court of Appeal’s interpretation of section 22(7)(b)*”.

Campomar v Nike

74 The Applicant’s first submission rested on the Court of Appeal’s decision in *Campomar SL v Nike International Ltd* [2011] 2 SLR 846 (“*Campomar*”).³⁵

75 *Campomar* was an unfortunate case. The Court of Appeal had to decide certain difficult questions arising out of its earlier decision in *Nike*³⁶ to uphold this Tribunal’s first instance finding that the mark “NIKE” (T8601301A) should be revoked for non-use. Revocation was on the ground that for the relevant period of five years immediately preceding the date of the application for revocation, there had been non-use of the mark by the proprietor of the mark, Campomar SL.

76 It is not necessary to go into detail regarding what those difficult questions before the Court of Appeal in *Campomar* were. It suffices to say that they arose from the fact that because no request for backdating had been made, the revocation date of “NIKE” (T8601301A) was the date on which the application for revocation had been made: 21 January 2002. Since this meant that the registration remained on the register up until that date, there was a conflict with Nike International Ltd’s application on 20 November 2001 to register “NIKE” (there being identical marks belonging to two different parties).

77 Against that backdrop, the Court of Appeal observed that to avoid such a conflict, an application could (and indeed should) have been made under Section 22(7)(b) TMA to backdate the revocation date of T8601301A. In that connection, the Court of Appeal considered (at [38]) that one of the objects of Section 22(7)(b) TMA:

“... must be to address the sort of problems that could arise like the present where the application to register a later mark was made before an application to have an earlier identical or similar registered mark revoked for non-use and there is evidence to show that the non-use occurred even before the commencement of the five-year period relied on in the application for revocation.”

78 In the present case, the Applicant’s bid to register a later mark, **NEWYORKER**, had been made before the instant application to have the Registrant’s Subject Mark,

³⁵ Neutral citation: [2011] SGCA 6

³⁶ [2006] 1 SLR 919 (see also [28(a)] above)

NEWYORKER, revoked for non-use. The Applicant argued that this was an appropriate case to apply the Section 22(7)(b) TMA remedy.

79 As for the Registrant, it submitted that the Applicant's reliance on *Campomar* was erroneous. It argued that the decision does not stand for the proposition that the backdating could be to a date that falls within the first 5-year period from the date of the completion of the registration procedure. Instead, *Campomar* merely clarifies that the purpose of Section 22(7)(b) TMA is to allow the backdating of the revocation to a date earlier than the date of the application to revoke if the circumstances allow for it (see [29]).³⁷

80 The Applicant's submissions were premised on the flawed assumption that the Court of Appeal's decision in *Campomar* supported their position. In my judgment, it did not. Nowhere in *Campomar* did the Court of Appeal hold that revocation may be backdated to within the first 5-year period from the date of the completion of the registration procedure.

81 Further, if one were to conduct a simple search on the register, one would see that the date of completion of the registration procedure of T8601301A was 30 December 1989, which meant that the earliest possible revocation date would have been 31 December 1994 (i.e. the day immediately after the fifth anniversary). On the facts in *Campomar*, it would have been sufficient for Nike International Ltd to obtain an order for revocation backdated to 19 November 2001, one day before its application to register "NIKE" on 20 November 2001, and there is nothing in the decision which even vaguely suggests that the Court of Appeal had in mind that the revocation should be backdated to a date as far back as 30 December 1994 (let alone an earlier date).

82 I consider that all *Campomar* stands for on this point is that: (a) Section 22(7)(b) TMA allows for the backdating of the effective date of revocation; (b) parties should be mindful of the need to request for backdating in certain cases (for example where the party seeking revocation has made a separate later-in-time application to register a conflicting identical or similar trade mark); and (c) whether the backdating request is granted will ultimately depend on the circumstances and in particular the evidence of use.

Policy arguments

83 On the face of it, Section 22(7)(b) TMA does not expressly limit or prohibit the Registrar or the Court from making an order for revocation "*at an earlier date*" that falls earlier than the fifth anniversary of the date of completion of the registration procedure. But simply looking at Section 22(7)(b) TMA in isolation does not carry the matter further one way or another. One must necessarily dig deeper.

84 In its written submissions, the Applicant argued there were no policy reasons to prevent backdating to within the first 5 years from the date of completion of the registration procedure. In so doing, it made the following points.

³⁷ Applicant's Further Submissions dated 1 August 2017 at [26] – [27].

- a. First, it compared Section 22(1)(a) with 22(1)(b) TMA – although the argument appeared to not have been fully developed, it seems that the Applicant was advancing the argument that if backdating could be allowed for the latter, there seemed to be no reason in principle why it should not be allowed for the former.
- b. Second, it argued that since the Registrar has the benefit of assessing all of the evidence from hindsight, the Registrar should take the sensible, pragmatic and realistic approach and backdate to within the first 5 years from the date of completion of the registration procedure if that was what was required on the evidence. In this connection, the Applicant cited *Campomar* wherein the Court of Appeal stated that Section 22(7)(b) may be utilised where “*there is evidence to show that the non-use occurred even before the commencement of the five-year period relied on in the application for revocation*” (at [38]).

85 It is convenient to begin by addressing the Applicant’s submissions on the Court of Appeal’s statement in *Campomar* (at [38]). (A brief outline of the salient points in *Campomar* and the related later decision in *Nike* is set out at [75] – [77] and [81] – [82] above.) That statement was made in the context of the Section 22(1)(b) TMA ground of revocation (and not 22(1)(a) TMA). Section 22(1)(b) comes into play where the mark may have been put to use but:

“... such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use”

It was recorded in the first instance decision of this Tribunal (*Nike International Ltd v Campomar SL* [2004] SGIPOS 2) which eventually reached the Court of Appeal in *Nike* that the parties had, at the very first instance, come to an agreement that the relevant period to be considered was the period beginning on 21 January 1997 and ending on 21 January 2002 (i.e. the date on which the application for revocation of T861301A had been made). In other words, the relevant period under consideration in *Nike* was the five years immediately preceding the date of the application for revocation. In *Nike* it was ultimately decided that the mark should be revoked for non-use. The fact that the Court of Appeal was able to make the observation that Section 22(7)(b) TMA may be used where “*there is evidence to show that the non-use occurred even before the commencement of the five-year period relied on in the application for revocation*” must mean that on those facts, Nike International Limited would likely have had little difficulty satisfying the Registrar or the Court that “*grounds for revocation existed*” on 19 November 2001 (see [81] above). The Court of Appeal’s observations in *Campomar* were made having regard to that background, and do not stand for the proposition that backdating can be made effective within the first 5-year period. For these same reasons, reference to Section 22(1)(b) TMA does not advance the Applicant’s position either.

86 My insuperable difficulty with the Applicant’s submissions on policy was that none of them addressed the critical point: If the Backdating Request was allowed, the Applicant would essentially be granted a form of relief that it would not have been entitled to in the

first place. Section 22(1)(a) TMA provides that a registered trade mark may be revoked for non-use on grounds 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”

One way of visualising Section 22(1)(a) TMA is to see it as a coin. On one side of the coin, third parties are provided with a statutory ground on which to make an application for revocation if the requirements are met. The flip side of the coin is that it confers upon the registered proprietor a “grace period” of a full 5 years to put his mark into genuine use. They are two sides of the same thing and you cannot have one without the other.

87 What the Applicant appears to have missed, or at least glossed over, is that Section 22(7)(b) is premised on the Registrar or the Court being “*satisfied that the grounds for revocation existed at an earlier date*”. To make an order for backdating is effectively to say that the grounds for revocation existed there and then. But how can grounds for revocation exist within the “grace period” if the provision is worded in such a way that the *entire* 5-year period must have elapsed before the cause of action (or: ground of revocation) even arises? To answer the rhetorical question: It simply cannot. One cannot simply melt and reshape the coin to suit one’s purposes.

88 Ultimately, I was not persuaded by any of the Applicant’s policy arguments.

The NEWYORKER BY DAIDOH backdating case

89 I now turn to address the Applicant’s reliance on the fact that it had previously successfully revoked the Registrant’s trade mark “NEWYORKER BY DAIDOH” (T9611792H) and “*the Assistant Registrar has exercised her discretion to backdate the effect of the revocation to 6 September 2011*”.

90 It is not necessary to go into the details of that dispute, but the essential point is that that was not a case wherein a request was made of the Registrar to exercise discretion to backdate the revocation date to within the first 5-year “grace period”. The subject mark, T9611792H, had a filing date of 31 October 1996 and the date of the completion of the registration procedure was 5 August 2000. The first 5-year period would have ended on 5 August 2005 and based on the guidance provided by HMD Practice Circular No. 1/2012, the earliest possible effective date of revocation would have been 6 August 2005.

91 Thus, the fact that backdating to 6 September 2011 was granted in that case is of no assistance to the Applicant in the present case.

The HMD Practice Circular

92 It was argued by the Applicant that the guidance set out in HMD Practice Circular No. 1/2012 can be departed from in appropriate cases, having regard to the Court of Appeal's decision in *Campomar*. It submitted that this was an appropriate case.

93 I take the view that a HMD Practice Circular is not formally binding on the Registrar and that the Applicant is right insofar as it has suggested that a HMD Practice Circular can be departed from in certain cases. However, unless it can be shown that the guidance is somehow incorrect, outdated (due to changes in the law), or should not be followed for some other compelling reason, the Registrar must necessarily adopt an approach consistent with that set out in the various practice circulars.

94 Above, I have rejected the Applicant's submissions which were based on an erroneous reliance on *Campomar*. The Applicant has not shown any valid reason why the guidance in the HMD Practice Circular should be departed from, and consequently I must be guided by it.

Outcome of the Applicant's Backdating Request

95 For the reasons above, I rejected the Applicant's submissions concerning the validity of the Backdating Request, and hold that the Registrar has no power to backdate an order for non-use revocation to a day falling within the first 5 years after the date of the completion of the registration procedure.

96 For completeness, I should add that the Registrant also helpfully drew my attention to two English cases (see *WIS Trade Mark* [2006] RPC 22 (a decision of the Appointed Person, Geoffrey Hobbs QC) and *In the matter of a Joint Hearing held in relation to Registration No. 2242946 in the name of Valent Biosciences Corporation* (O-094-07) (a decision of a hearing officer at the UKIPO)), and also an extract from the Hong Kong Trade Marks Registry's Work Manual (dated 5.6.2009) under the heading "*Revocation of Registration on Grounds of Non-use*". They appear to support the view that those jurisdictions also do not permit revocation within the first 5-year "grace period". My conclusion above is consistent with this view.

97 Notwithstanding my conclusion that the Applicant's Backdating Request was invalidly made insofar as the request was for a date "*on or before 6 September 2011*", I agree that the Registrar should take a sensible, pragmatic and realistic approach to backdating. Above, I have found that there was no evidence that the Subject Mark had ever been used in relation to: "*boots; shoes; sandals; shoes and boots for sports; footwear; half-boots; slippers; spats*" and "*costumes (masquerade)*". In the circumstances, I am satisfied that grounds for revocation in respect of these goods existed as at the earliest possible date of revocation: 3 January 2014. I am also of the view that this is an appropriate case for backdating the partial revocation to that earlier date.

Conclusion

98 For the above reasons, I make an order for partial revocation in the following terms:

(1) The Subject Mark (T0720728D) is to be partially revoked in that the revocation shall be in respect of the following goods in Class 25 only:

boots; shoes; sandals; shoes and boots for sports; footwear; half-boots; slippers; spats; costumes (masquerade)

(2) For the avoidance of doubt, the Subject Mark (T0720728D) shall not be revoked in respect of the following goods for which it is registered in Class 25:

Clothing; hats; neckties; shawls; underwear; socks; belts (clothing); gloves (clothing); scarves; caps (headwear); garters; sock suspenders; braces for clothing (suspenders); bands (for wear); sweat bands for the head; sweat bands for the wrist; sports clothes (other than golf gloves); suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; bathing drawers; bathing suits; breeches (for wear); top coats; collar protectors; combinations (clothing); cuffs; fur (clothing); gabardines (clothing); dressing gowns; headgear for wear; hoods (clothing); hosiery; stuff jackets (clothing); jumpers (shirt fronts); muffs (clothing); overcoats; overalls; pajamas; parkas; pullovers; ready-made clothing; waistcoats.

(3) Pursuant to the Registrar's power under Section 22(7)(b) TMA to backdate the effective date of revocation where the Registrar is satisfied that the grounds for revocation existed at an earlier date, the rights of the proprietor shall be deemed to have ceased to the extent stated in Order (1) above as from 3 January 2014.

99 I shall deal with costs in two parts:

- a. As regards the Backdating Request, the Registrant submitted during the hearing and in its further written submissions that it be awarded costs against the Applicant on this issue. During the hearing, counsel for the Applicant urged me to reserve costs until after I had reviewed the further written submissions. Now that I have found against the Applicant on the Backdating Request, costs should follow the event. They are to be taxed, if not agreed.
- b. As regards the substantive action, although there were some general arguments on costs made in the course of submissions, they were not made against the specific backdrop of my decision above. I will hear parties on costs.

100 As a parting observation, parties to contentious proceedings before this Tribunal should take care to be mindful of, and ensure compliance with, the various HMD Practice Circulars.

Date of Issue: 31 October 2017