

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

Trade Mark No. T9812571E
11 November 2016

IN THE MATTER OF A TRADE MARK REGISTRATION

IN THE NAME OF

APPLE INC.

AND

APPLICATION FOR REVOCATION THEREOF BY

BIGFOOT INTERNET VENTURES PTE. LTD.

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

Mr Alfean Samad and Mr Marco Notarnicola (Bigfoot Internet Ventures Pte. Ltd.) for the Applicants in person

Mr Cheah Yew Kuin and Ms Quek Jia Ling (Wong & Leow LLC) for the Registered Proprietors

Cur Adv Vult

GROUND OF DECISION

1 The subject of these revocation proceedings is Trade Mark No. T9812571E ("the Subject Mark"):

SHERLOCK

2 The Subject Mark was registered in the name of Apple Inc. (“the Proprietors”) in Class 9 in respect of "Computer software; all included in Class 9". The date of completion of registration is 5 March 2001.

3 On 12 March 2015, Bigfoot Ventures Pte. Ltd. ("the Applicants") filed an application for revocation of the Subject Mark on the grounds of non-use. The Proprietors filed their counter-statement and evidence in support of the Subject Mark on 15 July 2015.

4 The Applicants filed evidence in support of the application on 6 January 2016. A series of procedural issues was resolved in the period of January to April 2016. A Pre-Hearing Review was held on 4 May 2016, after which parties attempted to settle the dispute on a without prejudice basis. When it appeared to the Registrar that the parties’ dispute was unlikely to be settled in the foreseeable future, this application for revocation was fixed for a hearing which took place on 11 November 2016.

Grounds of Revocation

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

Proprietors' Evidence

6 The Proprietors' evidence comprises a Statutory Declaration made by John Donald, Principal Counsel of the Legal Department of the Proprietors, on 29 June 2015 in California, United States of America (“JD1”).

Applicants' Evidence

7 The Applicants’ evidence comprises a Statutory Declaration made by Marco Notarnicola, Representative of the Legal Affairs Department of the Applicants, on 5 January 2016 in Singapore (“MN1”).

Burden of Proof

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

Background

9 This dispute concerns the “Sherlock” trade mark, which was first used by the Proprietors as a software application in connection with version 8.5 of the Macintosh computer operating system, Mac OS. “Sherlock” was an integrated search tool which performed two main functions: First, it was an internet search engine. Second, it was capable of searching for (and finding) files within the Mac OS system.

10 Mac OS 8.5 was launched in Singapore on 17 October 1998. On 18 December 1998, the Proprietors applied to register, and eventually obtained registration of, the Subject Mark (i.e. SHERLOCK). Subsequently, newer versions of Mac OS were released. For a time, the “Sherlock” search tool was also progressively updated along with these newer versions of Mac OS. In Mac OS X 10.2, the “Sherlock” search tool was revised to remove the file finding functionality (although it continued to offer, among other things, the internet search function).

11 “Sherlock” was replaced by “Spotlight” and “Dashboard” in Mac OS X 10.4 Tiger (although it continued to be included with the default installation). The “Sherlock” search tool was finally removed altogether from Mac OS with the release of Mac OS X 10.5 Leopard in 2007. “Sherlock” is apparently incompatible with Mac OS X versions after Mac OS X 10.6 Snow Leopard.

12 The essence of the Proprietors’ case is that the Subject Mark has been in continuous use in Singapore ever since the launch of Mac OS 8.5 on 17 October 1998. In this regard, they place reliance on the existence of two software patches which contained the “Sherlock” search tool, namely the Mac OS X Update Combo 10.2.4 (first offered for download on 13 February 2003); and Mac OS X Update Combo 10.2.8 (first offered for download on 14 November 2007). Critical to the Proprietors’ case is the fact that the aforementioned Update Combos are still available for download today.

13 The Applicants’ case is that the events described above are insufficient to establish genuine use of the Subject Mark in Singapore within the relevant periods such that it ought not to be revoked under Sections 22(1)(a) or 22(1)(b) of the Act.

MAIN DECISION

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

14 Section 22(1)(a) and (b), (2), (3) and (4) of the Act reads:

22.—(1) The registration of a trade mark may be revoked on any of the following grounds:

(a) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;

...

(2) For the purposes of subsection (1), use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Singapore includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the 5 year period and before the application for revocation is made.

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

Relevant Dates

15 In line with the parameters of the Applicants' pleadings and the parties' agreement at the hearing, the relevant dates under consideration are as follows:

- a. **Section 22(1)(a):** The registration procedure was completed on 5 March 2001. The 5-year period immediately following the completion of registration ended on 5 March 2001. The period of use (or non-use) in issue is *6 March 2001 to 5 March 2006* (the "First 5-Year Period").
- b. **Section 22(1)(b):** The application for revocation was filed on 12 March 2015. The 5-year period prior to this filing starts from 12 March 2010. The period of use (or non-use) in issue is *12 March 2010 to 11 March 2015* (the "Second 5-Year Period").

Legal Principles

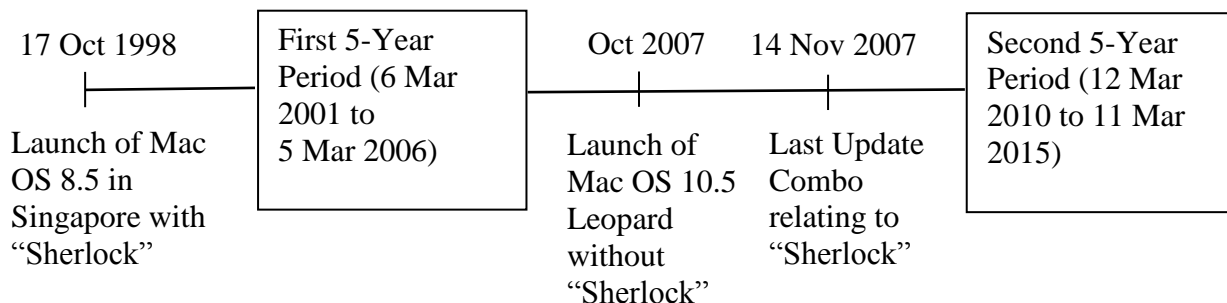
16 The following is an outline of the relevant legal principles.

- a. In an action for non-use revocation, the burden of proof is on the proprietor to show what use has been made of the mark. (See Section 105 of the Act, and *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 ("*Wing Joo Loong*") at [33] – [34].)
- b. The proprietor must show that the use of the trade mark was genuine or *bona fide*. There is no real or practical difference between the terms *bona fide* use and *genuine* use. (See *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919 ("*Nike*") at [15].)

- c. For use to be considered genuine, the use in question does not have to be significant in the qualitative sense provided it was in accordance with the essential function of a trade mark (i.e. to guarantee origin). 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. (See *Wing Joo Loong* at [38] – [39] and *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 (“*Weir Warman*”) at [99] – [100].) Although nothing turns on it, for completeness, I should add that in *Société des Produits Nestlé SA and anor v Petra Foods Ltd and anor* [2017] 1 SLR 35, a decision handed down after the date of this hearing, the Court of Appeal clarified that genuine use means *bona fide* use *as a trade mark*. Accordingly, in assessing whether there has been genuine use, one factor to consider is the nature of the use of the trade mark: see [121] – [123].
- d. There is no rule that *de minimis* use cannot constitute genuine use. No one single objective formula which applies to all situations can be laid down; much would depend on the fact situation in each individual case. (See *Wing Joo Loong* at [43].)
- e. One single use of the mark could satisfy the test provided that overwhelmingly convincing proof of the act is adduced. (See *Nike* at [15], although on those facts the Court of Appeal found that the threshold had not been crossed.)

Decision on Section 22(1)(a)

17 Although the key issue in relation to Section 22(1)(a) is whether there has been genuine use of the Subject Mark between the dates of 6 March 2001 to 5 March 2006 (i.e. the First 5-Year Period), the Proprietors’ case is that the Subject Mark was first used in Singapore *prior to* and thereafter throughout the First 5-Year Period. As such, I will first examine whether “Sherlock” was used in Singapore prior to the First 5-Year Period before going on to consider whether the Subject Mark was used in Singapore during the First 5-Year Period. For ease of reference, a basic timeline is set out below:



Whether “Sherlock” was used prior to the First 5-Year Period

18 According to the Proprietors, the key events relating to the time period immediately prior to the First 5-Year Period were as follows.

- a. November 1997: Operation of the Proprietors' Apple Store website (at <http://www.apple.com> (see JD1 at [5])).
- b. 17 October 1998: Launch of Mac OS 8.5 in Singapore (see JD1 at [6] and Exhibit B).
- c. 5 March 2001: Date of completion of registration of the Subject Mark.
- d. 6 March 2001: Start of First 5-Year Period.

19 Since the question of whether "Sherlock" was used in Singapore prior to the First 5-Year Period can be answered by reference to the evidence relating to the launch of Mac OS 8.5 in Singapore, I will leave aside the evidence relating to the Proprietors' websites for now.

20 Exhibit B of JD1, which Mr Donald describes as being "*official Apple communication documents*" (see JD1 at [5]), contains the following:

- a. An article titled "iMac to launch with Mac OS 8.5 in Singapore", dated 15 October 1998. This article records that "*Apple Singapore officially announced today that the iMac will be launched in Singapore this Saturday, October 17, with Mac OS 8.5 preinstalled*".
- b. An iMac Update Special Edition dated 16 October 1998, which was "*distributed by Apple Computer, Inc [i.e. the Proprietors] to subscribers of its iMac mailing list*". This iMac Update informed readers about Mac OS 8.5 and its features, one of which was Sherlock:

"... Well, there's really a lot to tell you about, Mac OS 8.5 offers over 70 new features and technologies,

There's Sherlock, for example..."

And later on in the same iMac Update, under the sub-heading "10 Great Reasons to Buy Mac OS 8.5", reason number 1 was:

"1. You can use Sherlock, revolutionary search technology that's available only in Mac OS 8.5 Why is Sherlock so impressive? Because Sherlock lets you: [and a list of its features follows]"

- c. "Singapore's iMac Pre-Launch Bash", dated 15 October 1998. This article describes how about 2,000 people attended the closed pre-launch bash event for industry insiders and AppleClub members (and their friends).

- d. “Brace Yourself!”, dated October 16, 1998. This article describes in some detail the Proprietors’ plans for the iMac launch in Singapore, including: placing a giant iMac blimp outside the Heeren in Orchard Road; balloon giveaways along Orchard Road; stocking the iMac at virtually every Apple retail store and Electric City outlet; a planned advertising blitz in the papers and on the airwaves, including iMac advertisements on prime-time TV and on the 10.30 news for a whole week starting from 18 October 1998.

21 I find that the evidence set out in Exhibit B is sufficient to establish that “Sherlock” was used in Singapore in relation to the goods claimed (computer software) prior to the First 5-Year Period. The documents show that “Sherlock” was advertised as being one of the features present in Mac OS 8.5, and that the iMac was launched in Singapore on 17 October 1988, in conjunction with Mac OS 8.5. It appears from the documents that buyers of new iMacs would have had their Mac computers pre-installed with Mac OS 8.5. There may have been others who would have purchased the standalone Mac OS 8.5 as well, of which, as noted above, “Sherlock” was a feature. In these circumstances, the use of “Sherlock” cannot be said to be *de minimis* or token.

22 The Applicants’ submission in relation to the Exhibit B documents is that they fall outside of the relevant period under consideration (see Applicant’s written submissions at [25]). Nevertheless, I consider that evidence showing that “Sherlock” was used prior to the First 5-Year Period is relevant and can be taken into account, because if the Proprietors can show that such use of “Sherlock” continued into the First 5-Year Period, the Subject Mark cannot be revoked for non-use under Section 22(1)(a).

Whether “Sherlock” was used during the First 5-Year Period

23 I now turn to the issue of whether there was genuine use of the Subject Mark during the First 5-Year Period (i.e. from 6 March 2001 to 5 March 2006). Although it may seem surprising, the most convenient way of answering this question is to begin with the end of “Sherlock”.

Evidence shows that “Sherlock” was discontinued from 2007

24 The Proprietors adduced some documentary evidence relating to the history of the “Sherlock” software. Exhibit C of JD1 contains an extract from the Apple Wiki outlining the history of the “Sherlock” application. From this document, the following facts emerge: (a) “Sherlock” started out life in Mac OS 8.5; (b) “Sherlock 2” debuted with Mac OS 9 (albeit with slightly different functionality than before); (c) “Sherlock 3” made an appearance with Mac OS X 10.2 (and again there were functionality changes); and (d) there was a separate “Sherlock” plug-in that could be installed on computers. However, the Proprietors’ evidence did not disclose the fact that “Sherlock” was eventually removed from Mac OS.

25 On the other hand, the Applicants adduced the following documents which showed that “Sherlock” was, in fact, no longer part of the Mac OS from around 2007 onwards.

- a. A Wikipedia entry relating to “Sherlock” (see MN1 at Annex 1). This entry states that “Sherlock” was eventually replaced by Spotlight and Dashboard in Mac OS X 10.4 Tiger, although Apple (i.e. the Proprietors) continued to include it with the default installation of that operating system. It further states that *“Since most of the standard plug-ins for Sherlock provided by Apple itself no longer function, it was officially retired and removed in the release of Mac OS X v 10.5 Leopard in 2007”*. The Wikipedia entry also indicates that “Sherlock” has been “Discontinued”. Under the “Current status” subheading, it is stated that *“As Sherlock was never released as a Universal binary, it is not compatible with Mac OS X versions after Mac OS X 10.6 Snow Leopard, and can’t be launched on Intel Macs without Rosetta”*.
- b. A printout from www.macnn.com which hosted an article titled “Apple kills Sherlock in Leopard”, dated 29 October 2007. The material part of the article reads: *“Apple has quietly killed Sherlock in its latest revision of Mac OS X, Leopard, according to several reports. Although it has not been officially announced, installing Leopard seems to delete the application from a users’ machine... Apple is most likely abandoning Sherlock in favor of providing its function through Widgets, as is evident from the new Movies widget. Sherlock’s advanced search functions were replaced with the integration of Spotlight in Mac OS X Tiger; Spotlight, integrated with the Finder in both Tiger and Leopard, is Apple’s built-in search function...”* It also appears from the article that Mac OS X Leopard had been released a few days prior.
- c. An article published on 7 December 2007, written for The Apple Core (which covers news and analysis on Apple technology) and published by ZDNet, with the heading “Believe it: Sherlock is really, really dead”. The contents generally track the points made in the Wikipedia entry, but there is an additional point of significance: according to the author of the article, Apple [i.e. the Proprietors] had *“advised users to forget about Sherlock... and not to be overly adventurous in copying Sherlock from old disks”*. What follows is an extract from the relevant segment of the Proprietors’ support page, which reads: *“Sherlock itself does not work with Mac OS X 10.5 Leopard. Manually copying Sherlock from a version of Mac OS X prior to Leopard is not supported (and you should manually remove Sherlock)”*.
- d. The support page referred to in sub-para (c) above was archived by the internet archive “WAYBACK MACHINE” and extracted and separately exhibited by the Applicants in Annex 4 of MN1. The support page also makes clear that the features *“formerly provided by Sherlock can now be found in Dashboard”*.

26 In the Proprietors’ written submissions (at [26]), they criticised the accuracy and reliability of the documents referred to in [25(a) – (c)] above. While it is fair to say that not all Wikipedia articles or reports posted on the internet are accurate and reliable, the fact remains that it was always open to the Proprietors to adduce documentary evidence in rebuttal. The fact that they did not (or, could not) do so speaks volumes, and strongly suggests that the statements made in these articles were, in fact, true. This is particularly so in revocation actions such as the present one, where the burden of proof lies on the Proprietors – for good policy reasons, as trade mark proprietors are generally in a better position to show the use made of their own trade marks as opposed to challengers bearing the burden to prove the non-use of the trade marks.

27 I also note that the High Court, in *Formula One Licensing BV v Idea Marketing SA* [2015] 5 SLR 1349 (“*Formula One*”) did take into consideration such evidence, at [40] read with [35(a),(b)] of the decision of Tay J (as he then was).

28 As regards the support page in Annex 4 of MN1 (see [25(d)] above), the Proprietors made two submissions: one, that the document did not state that use of “Sherlock” has ceased; and two, that this shows that features formerly provided by “Sherlock” “*can still be found and downloaded*”. However, these submissions miss the Applicants’ central point: “Sherlock” was no longer a part of the Mac OS from 2007 onwards.

29 And that really is the point. Having reviewed the evidence, it is clear to me that starting from Mac OS X 10.5 onwards (i.e. around October 2007), “Sherlock” was replaced. The proverbial nail in the coffin was when Mac OS X 10.6 Snow Leopard was released and “Sherlock” was incompatible with it (and later versions of Mac OS X).

“Sherlock” was put to genuine use within the First 5-Year Period

30 Two consequences flow from the fact that “Sherlock” was no longer a part of Mac OS as of late-2007.

31 First, *prior to 2007*, the Subject Mark was in genuine use in Singapore. The Proprietors may not have provided sales figures of Mac OS 9 (where Sherlock 2 made its debut) or Mac OS X 10.2 (which contained Sherlock 3) in Singapore, but it would only stand to reason that some of the consumers who purchased Mac OS 8.5 in 1998 would over the years have purchased or otherwise upgraded to these versions (Mac OS 9, Mac OS X 10.2) as well. It would be unrealistic for me to conclude otherwise. After all, Mac OS and the “Sherlock” application are computer software. Goods such as these are certainly not one-off purchases. Without an operating system there is very little that the average member of the public can do with a Mac computer. It follows that later versions of Mac OS (each of which also contained the “Sherlock” software in one incarnation or another, at least until the release of Mac OS X 10.5 in 2007) were also made available to, and purchased/used by, consumers in Singapore. The foregoing points towards the conclusion that the Subject Mark was put to use in Singapore within (and throughout) the First 5-Year Period.

32 Second, *after* 2007, the situation was very different. The fact that “Sherlock” was incompatible with Mac OS X 10.6 Snow Leopard and later versions of Mac OS means that the Proprietors have to put forth adequate evidence in order to satisfy the Registrar that the use of the Subject Mark was more than merely token, internal, or otherwise designed to preserve the rights conferred by the registration. I will come back to this point later under Section 22(1)(b).

33 Although I consider that my findings above are sufficient to dispose of the revocation action under Section 22(1)(a), in case I am wrong, I go on to examine two key inter-related issues: (a) whether post-sale product support can qualify as genuine use of the Subject Mark; and (b) if so, whether the provision of the Mac OS X Update Combo 10.2.4 on the Proprietors’ website, without corresponding evidence of downloads from Singapore, is sufficient to cross the threshold.

The “Sherlock” software updates argument

34 An outline of the Proprietors’ case relating to the software updates is as follows.

- a. In *Ansul BV v Ajax Brandbeveiliging BV* [2003] IP & T 970 (“*Ansul v Ajax*”), the proprietor had been selling fire extinguishers and associated products under the word mark MINIMAX. It eventually ceased selling fire extinguishers, but continued to sell component parts and substances for use in MINIMAX fire extinguishers, and also serviced and repaired MINIMAX equipment. The question was whether this amounted to genuine use of MINIMAX. The European Court of Justice held that the use of a mark in connection with goods that were no longer newly traded could nonetheless constitute genuine use provided that the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers for those goods.
- b. In this case, after the launch of Mac OS 8.5, “Sherlock” continued to be further supported through progressive upgrades. There were also periodic software updates on the Proprietors’ site at <https://support.apple.com>, including the Mac OS X Update Combo 10.2.4 which was made available for download within the First 5-Year Period, on 13 February 2003. Although Mac OS 8.5 was no longer newly traded, it continued to be supported with component parts (in this case, the updates) which were directly connected with goods previously sold (in this case Mac OS 8.5) and intended to meet the needs of customers for those goods. Therefore, there was genuine use of the Subject Mark.

35 The Applicants do not dispute the correctness of the principle in *Ansul v Ajax*. However, during oral argument they made the following point: in order to come within the scope of *Ansul v Ajax*, the parts of goods must be integral to the use of the goods themselves. In this case, the opposite happened. The “Sherlock” software was removed

from the Mac OS in 2007. Therefore, the software updates were insufficient, in and of themselves, to establish use of the mark in Singapore.

36 I am mindful that under Section 22(1)(a) the period under consideration is 6 March 2001 to 5 March 2006. At that time, Sherlock (in one form or another) was still part of the operating system Mac OS. Therefore, although the Applicants have a valid point (which I will consider) in respect of the Second 5-Year Period, the argument is inapplicable to the First 5-Year Period.

37 Although *Ansul v Ajax* is not binding on me, I consider its reasoning persuasive. Consequently, I hold that post-sale product support for “Sherlock” (such as upgrades and updates) within the First 5-Year Period *could* (independently of any new sales of the Mac OS) amount to genuine use of the Subject Mark in Singapore. The further question is whether the provision of the OS X Update Combo 10.2.4 (made available for download within the First 5-Year Period, on 13 February 2003), without corresponding evidence of downloads from Singapore, is sufficient to cross the threshold.

Whether merely providing the Update Combo 10.2.4 on a website was enough

38 The Applicants’ case in relation to the Update Combo 10.2.4 is that even though there was reference made to the Subject Mark, there is no evidence relating to the number of Mac OS X users in Singapore who had downloaded the update. It argued that such evidence of downloads in Singapore is necessary to support a finding of genuine use in this jurisdiction. It relies on the principle in *800-Flowers Trade Mark* [2002] FSR 12 (“*800-Flowers*”) that the mere offer of goods on a website, without something more, such as an “*active step*” on the part of the proprietor that “*goes beyond providing facilities that enable others to bring the mark into the area*”, is not enough. (Applicant’s written submissions at [28].)

39 In response, the Proprietors argued that this was not a case where the goods were simply offered on a website.

- a. Rather, the Subject Mark had been used in Singapore since the launch of Mac OS 8.5, and the additional step was taken when the Update Combo was provided in 2003. They drew my attention to a passage of the *800-Flowers* case (at [137] – [138], endorsed by the Singapore High Court in *Weir Warman* at [106]), which first stated the principle that an active step seems to be required, but went on to say that if persons in the relevant jurisdiction “*seek the mark on the Internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the advertisement or encouragement in itself is likely to suffice to establish the necessary use*”. In the Proprietors’ submissions, the existing consumers, i.e. the users of the Mac OS system (including users in Singapore), would access and download software updates such as the Update Combo 10.2.4, because they are integral to the development of the “Sherlock” software application.

- b. The Proprietors' evidence (see JD1 at [5]) is that their country-specific website for Singapore (that is, <http://www.apple.com/sg/>) has been in operation since mid-2000. (However, the Proprietors were only able to produce a screenshot of the site being in operation as at 22 April 2008: see Exhibit A.) In their written submissions, the Proprietors argued that the Singapore Apple Store website was in effect an extension of the main Apple Store website (i.e. without the /sg/). Accordingly, consumers who accessed the Singapore Apple Store website would also be able to download the update combos from the main support site. In other words, the Update Combo 10.2.4 would have been made available to Mac OS users from Singapore.

40 Having considered the evidence and the authorities carefully, I agree with the Proprietors' submissions insofar as they relate to the First 5-Year Period. It is clear that Sherlock was part of the Mac OS throughout that period, and that it was being actively supported by the Proprietors through updates such as the Update Combo 10.2.4. Ever since the launch of the iMac and Mac OS 8.5 in 1998, there were *existing* Mac OS users in Singapore, and if they wanted to update and/or upgrade their system to the newest version, they would have had to seek out the relevant software (including the Update Combo 10.2.4 offered by the Proprietors). This is a very different situation from a case where a foreign company simply offers goods on the internet without taking any active steps in Singapore under his mark. Further, the documents in Exhibit B of JD1 contain references to Apple retail stores and stores such as Electric City and Challenger SuperStore which had apparently "*returned to the Apple fold*" in 1998. There would have been new customers/users of Mac OS over the years, who would have made purchases either through brick-and-mortar retail shops or over the internet on the Singapore Apple Store website.

Conclusion on revocation under Section 22(1)(a)

41 For the reasons above, I find that the Subject Mark had been put to genuine use in Singapore within the First 5-Year Period and thus, the ground of revocation under Section 22(1)(a) is unsuccessful.

Decision on Section 22(1)(b)

Whether "Sherlock" was used during the Second 5-Year Period

42 For Section 22(1)(b), the relevant period under consideration is from 12 March 2010 to 11 March 2015. Two points are important to bear in mind.

- a. First, prior to this time period, the Proprietors posted another Update Combo which contained a reference to "Sherlock": Mac OS X Update Combo 10.4.11 on 14 November 2007. On the evidence, Update Combo 10.4.11 was the last Update Combo relating to "Sherlock".

- b. Second, by 12 March 2010, the start of the Second 5-Year Period, “Sherlock” had been discontinued (and without new software support) for more than 2 years.

43 The Proprietors’ arguments in relation to this Second 5-Year Period are essentially the same as their arguments in respect of the First 5-Year Period. As stated above at [37], I accept the proposition in *Ansul v Ajax* that the use of a mark in connection with goods no longer newly traded could constitute genuine use of the mark in certain circumstances.

44 However, as the Applicants rightly point out, the “Sherlock” software was removed from the Mac OS in 2007. This made all the difference. During oral argument, counsel for the Proprietors sought to persuade me that just because there was a newer operating system does not mean that older versions of the Mac OS were not being used, and that users of older Mac OS versions may still look to download the Update Combo. I have difficulty with this argument. Certainly, I am prepared to accept that when the last Update Combo was posted on 14 November 2007, there may have been some users from Singapore who would have downloaded it *in or around that time*. However, that was in the past. Typically, a user would only download a software update once. With the effluxion of time, and the obsolescence of the “Sherlock” application, in the absence of clear and convincing evidence that there are still downloads of the Update Combos from Singapore in the Second 5-Year Period between 12 March 2010 to 11 March 2015 (or indeed any other evidence of genuine use), I cannot arrive at the conclusion that the Subject Mark was put to genuine use in Singapore within the Second 5-Year Period. The burden of proof is on the Proprietors and in my judgment, they have failed to discharge it. For these reasons, I conclude that the Subject Mark was not put to genuine use during the Second 5-Year Period.

Whether there were any proper reasons for non-use

45 Under Section 22(1)(b), if there are proper reasons for non-use, the mark may not be revoked. However, the Proprietors have not adduced any evidence in this regard.

Conclusion on revocation under Section 22(1)(b)

46 For the reasons above, I find that the Subject Mark has not been put to genuine use in Singapore within the Second 5-Year Period and thus, the ground of revocation under Section 22(1)(b) is successful.

The EUIPO Decision

47 The Applicants drew my attention to a decision of the Cancellation Division of the EUIPO (No. 9870C, dated 14 March 2016) which concerns an action for non-use revocation of the Proprietor’s CTM registration for “Sherlock”. Although each case must necessarily turn on its own facts, it is interesting to note that the Cancellation Division arrived at the conclusion that the Proprietor was unsuccessful in establishing genuine use of “Sherlock” in the EU.

Overall Conclusion

48 As the Principal Assistant Registrar in *MCI Group Holdings SA v Secondment Pty Ltd* [2014] SGIPOS 15 helpfully noted at [49]:

49 ... Borrowing a colourful metaphor from Justice Jacob (as he then was) in the case of *Laboratoires Goemar SA v La Mer Technology Inc* [2002] ETMR 34, the Registered Mark is akin to an “*abandoned vessel in the shipping lanes of trade.*” Revoking the registration of the Registered Mark would be consistent with the policy reasons as to why unused marks must be removed from the register as set out in [42] above.

49 While the Proprietors have demonstrated use of the Subject Mark in Singapore within 5 years after the completion of registration, I have found that the application for revocation succeeds under Section 22(1)(b) of the Act in relation to the 5-year period immediately before the application. As such, the registration of the Subject Mark is revoked as from 12 March 2015, which is the date this application for revocation was filed. The Applicants are also entitled to costs to be taxed, if not agreed.

Dated this 10th day of February 2017

See Tho Sok Yee

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