

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

Trade Mark No. T0501003C
2 February 2017

IN THE MATTER OF A TRADE MARK REGISTRATION BY

BIG BOX CORPORATION PTE LTD

AND

APPLICATION FOR DECLARATION OF INVALIDATION THEREOF BY

COURTS (SINGAPORE) PTE LTD

Hearing Officer: David Llewelyn
IP Adjudicator

Mr Melvin Pang and Mr Eu Jin Ong (Amica Law LLC) for the Applicants

Mr Just Wang and Ms Penelope Ng (Bird & Bird ATMD LLP) for the Registered
Proprietor

GROUND OF DECISION

1 Big Box Corporation Pte Ltd, is the Registered Proprietor (“the Proprietor”) of the following trade mark:

BIG BOX

(“the Subject Mark”), in Singapore in Class 35 in respect of “The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods in retail shops, supermarkets, hypermarkets, convenience stores, wholesale outlets, factory outlets, warehouse retail outlets, retail outlets and big department stores; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise internet web

site [sic] or by means of telecommunication; compilation of mailing lists; the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; telephone and all other communication and telecommunication ordering services; direct mail advertising; business advisory and business services; advertising services; display services for merchandise; publicity services; marketing and promotional services; market analysis and research; import-export agency services; procurement and buying of goods on behalf of a business; window dressing; sales and distribution services; sales promotion for others; advisory and consultancy services relating to the aforesaid services.” The Subject Mark was registered in Singapore on 26 January 2005.

2 Courts (Singapore) Pte Ltd (“the Applicant”) applied for a declaration of invalidity of the registration of the Subject Mark on 12 March 2015 (“this Application”). A Counter-Statement was filed on 11 May 2015 in defence of the registration of the Subject Mark.

3 The Applicant filed evidence in support of this Application on 15 October 2015. The Proprietor filed its evidence in support of the registration of the Subject Mark on 14 April 2016. The Applicant filed its evidence in reply on 13 October 2016. Following the close of evidence, a Pre-Hearing Review was held on 2 November 2016.

Grounds of Invalidation

4 The Applicant relies on a number of grounds in the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). These are contained in Sections 7(1)(b), (c) and (d), which, after a trade mark has been registered, may be relied upon by an applicant for invalidation under Section 23(1) of the Act. The latter provides that “The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7.”

Applicant’s Evidence

5 The Applicant’s evidence comprises the following:

- (i) A Statutory Declaration made by Kuah Mei Yin, Finance Director of the Applicant on 14 October 2015 in Singapore (“KMY-1”); and
- (ii) a Statutory Declaration in Reply made by the same Kuah Mei Yin on 11 October 2016 in Singapore (“KMY-2”).

Proprietor’s Evidence

6 The Proprietor’s (or Respondent’s) evidence comprises the following:

- (i) A Statutory Declaration made by David Black, Managing Director of Blackbox on 6 April 2016 in Singapore (“DB-1”); and
- (ii) a Statutory Declaration made by Tong Jia Pi Julia, Director of the Proprietor, on 13 April 2016 in Singapore (“JT-1”).

Applicable Law and Burden of Proof

7 The applicable law is the Act. By Section 101(c)(i) of the Act “the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of the validity of the original registration.” The burden in the present case falls on the Applicant to prove the ground of invalidity on the balance of probabilities. In the event the Applicant satisfies that burden, in order to avoid a declaration of invalidity the burden of proof would shift to the Proprietor to show, again on the balance of probabilities, that the Subject Mark has in fact acquired distinctiveness as a result of use by the Proprietor since its registration.

Background

8 As stated above (but it bears repeating), the Subject Mark was registered by the Proprietor on 26 January 2005 (“the relevant date” or “the Application Date”). In view of that fact, it should be made clear at the outset what this Application does not concern: it does not concern any allegation that the Subject Mark is susceptible to attack on the ground of five years’ continuous non-use (and it appears to be accepted by the Applicant that the Subject Mark has been used by the Proprietor at least in relation to some of the services in respect of which it is registered); nor that the application for the Subject Mark was made in bad faith. Instead, by this Application commenced more than ten years after registration of the Subject Mark, the Applicant seeks to establish that the Subject Mark was devoid of distinctive character, descriptive or generic at the Application Date and should be declared invalid *ab initio*.

9 The Applicant and the Proprietor were two of the four businesses (the others were the operators of the well-known IKEA and GIANT stores) which participated successfully in an Economic Development Board (“EDB”) initiative called the “Warehouse Retail Scheme” (“the Scheme” or “WRS”) launched on 28 April 2004. The WRS ran for three years and was aimed at encouraging the setting up of large, out of town retail warehouses by permitting retail activities that were previously not allowed within areas designated for warehouse or industrial use. The EDB media release for the Scheme announced “New industrial land regulations to introduce fresh retail concepts like warehouse outlets and ‘big box’ retailers to Singapore”. The Applicant applied for the Scheme in 2005 and thereafter sought and obtained from developers, including Ascendas REIT, proposals to develop a ‘Big Box’ Retail-Warehouse (the front page of the proposal from A-REIT is included in Exhibit 2 to KMY-1).

10 In December 2012 the Applicant opened a retail warehouse store in Tampines under the Scheme. In December 2014 the Applicant placed in the Straits Times advertisements for the Tampines store that described it as COURTS BIG BOX MEGASTORE (a copy of one of these advertisement forms Exhibit 2 of JT-1).

11 In early 2015 the Proprietor sent to the Applicant a cease and desist letter that alleged infringement of the Subject Mark by reason of the Applicant’s use of the words BIG BOX in those advertisements but, as at the date of the hearing (2 February 2017), had not commenced proceedings in respect of the same. As a result of the letter the Applicant applied for a declaration of invalidity in this matter on 12 March 2015.

12 The Proprietor opened a large warehouse retail mall under the Subject Mark in the Jurong Gateway area on 27 December 2014 and subsequently has engaged in extensive advertising of the BIG BOX mall in Chinese-, Bahasa- and English-language newspapers (copies of examples of each are included in Exhibit 9 of JT-1). The Jurong Gateway mall features prominently the Subject Mark in point-of-sale and other promotional materials throughout the location, including on shopping bags and trolleys, on ticket machines, on retail loyalty scheme materials (photographs of examples of each are also included in Exhibit 9 of JT-1), as well as on social media such as Facebook. Use of the Subject Mark appears consistently to be in the form of a device comprised of the words BIG and BOX, with the former on top of the latter, in a square box with a green background.

MAIN DECISION

13 A registered trade mark is a potentially valuable property right and the Trade Marks Register plays an important role both in recording the trade marks that have secured registration (obviously there are those that are used but are not registered, and they may be protected indirectly through a passing off action) and in providing honest traders wishing to check whether what they are planning to do might infringe a registered trade mark with an easily-searchable (and online) record of what those trade marks are. Traders who do not so check, or who check but ignore the results of their search, run the risk of a trade mark infringement action, or the threat of one, and so are usually well advised to do so on a regular basis. The Applicant found itself in the position of a trader who had not checked when it received a cease and desist letter (of which I have not been provided a copy) from the Proprietor early in 2015, by which time the Subject Mark had already been on the register for ten years.

14 Nevertheless, although it may be sensible to do so, there is no general duty imposed on traders by the Act to make themselves aware of what is on the Trade Marks Register, but failing to do so may have consequences, including making it more difficult to prove a state of affairs that allegedly existed some considerable time ago. A failure to check over a long period of time could also lead to unfair consequences for the owner of a registered trade mark (for example after a period of time which is longer than the statutory period for retention of records) and this seems to have been recognised in Singapore under the old law found in the Trade Marks Ordinance 1939, that was replaced in 1999 by the Act, in the provision that provided for incontestability of a registered trade mark seven years after it was first placed on the Register. However, the Act contains no such provision¹ and therefore an invalidity application on the grounds of the alleged state of affairs as at the date of registration may be brought at any time, even decades after the particular trade mark first appeared on the Register. Of course, although the burden on the applicant in such a case is the standard civil onus, the evidence required to satisfy it may be harder to adduce as a practical matter. It is also fair to note at this stage, however, that if an applicant for invalidity succeeds in adducing sufficient evidence to satisfy the burden, for example, that the challenged mark was generic or descriptive for a significant portion of the relevant public at the date it was applied for, there is logically very little, if anything, the mark's proprietor may do to

¹ Interestingly, an application for a declaration of invalidity that relies on Section 7(7), which prohibits the registration of a trade mark that conflicts with a geographical indication for a wine or spirit, may not be made after the expiry of five years from the completion of the registration procedure.

prove to the contrary (although it may be able to show that the registered mark acquired distinctive character as a result of use by its owner after the registration date, under Section 23(2) of the Act).

The absolute grounds for refusal (or invalidation) of a trade mark contained in Section 7

15 It is important to understand that, with the exception of Section 7(1)(a) which is not in issue in this case, the absolute grounds for refusal of a mark or, as here, invalidation of an already registered mark must be considered in relation to the goods or services in respect of which registration is, respectively, sought or has been obtained. Thus, to take an example of a mark that was used in argument by the Applicant's counsel at the hearing, ASPIRIN is devoid of distinctive character, exclusively descriptive and generic (and would therefore fall foul of Section 7(1)(b), (c) and (d)) if applied for, or (somehow) obtained, in respect of pharmaceutical preparations, but, on the other hand, it clearly has a capacity to distinguish and is a perfectly registrable mark if the application is in respect of clocks. To take two more examples, (i) SOAP and (ii) KOPITIAM. (i) The word SOAP undoubtedly falls within all three grounds for refusal when considered in respect of cleaning preparations but would have capacity to distinguish and be registrable for books (although, of course, such a registration would not be infringed if a third party published a book entitled "SOAP" that described the uses of soap over the years). (ii) The word KOPITIAM is unregistrable for services involving the provision of food and drinks (see *Kopitiam Investment Pte Ltd v RC Hotels (Pte) Ltd* [2008] SGIPOS 8, the Principal Assistant Registrar taking judicial notice that the term had been used for many years in local press reports to describe a traditional coffee shop, at [35]) but would have the capacity to distinguish and be registrable for shoes (although it may perhaps be difficult to envisage anyone wanting to use KOPITIAM as an indication of the trade origin of such goods).

16 Marks registered for retail services (such as those included in the Proprietor's specification of services) are a relatively recent phenomenon as the service of running a retail outlet was viewed by some to be one that was merely ancillary to the use of other more conventional trade marks for goods or readily identifiable services such as legal services and therefore not the proper subject matter for a trade mark registration. It was noted in the 15th edition (2011) of *Kerly's Law of Trade Marks & Trade Names ("Kerly's")* at [2-121] that "[t]he objection appeared to be based on policy grounds concerned with administrative burden, despite the fact that there are other trade mark systems which have accommodated registrations for 'retail services' and the like without apparent problem". However, the Court of Justice of the European Union ("CJEU") confirmed in *Praktiker Bau- und Heimwerkermarkte AG* [2005] E.T.M.R. 88 that the more liberal approach adopted by the UK Registry and by what is now known as the EU IP Office in relation to what were then called Community Trade Marks (now EU trade marks) was the correct one under EU trade mark law, subject only to there being a satisfactory description of those services in the specification. In Singapore, the Registry had already taken the step of permitting applications for registration of

marks for retail services and the Proprietor succeeded in registering the Subject Mark in 2005 without objection.²

17 In this case, the mark BIG BOX is registered in respect of a wide range of services provided in and to the retail sector, including “[t]he bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods”. The specification states that such a service may be provided in “retail shops, supermarkets, hypermarkets, convenience stores, wholesale outlets, factory outlets, warehouse retail outlets, retail outlets and big department stores”, as well as in relation to “general merchandise internet web site [sic] or by means of telecommunication” and “from a general merchandise catalogue by mail order or by means of telecommunications”. More generally, the specification covers “telephone and all other communication and telecommunication ordering services; direct mail advertising; business advisory and business services; advertising services; display services for merchandise; publicity services; marketing and promotional services; market analysis and research; import-export agency services; procurement and buying of goods on behalf of a business; window dressing; sales and distribution services; sales promotion for others; advisory and consultancy services relating to the aforesaid services.”

18 Once again, it is important to draw attention to what the Applicant is not applying for: it is not applying for a declaration of invalidity in relation to part only of the specification, as is permitted under Section 23(9) of the Act (although see below at [30]). Instead, it is contended that, as at the Application Date, the Subject Mark was devoid of distinctive character, was exclusively descriptive and was generic in relation to all the services contained in the specification. Thus, by way of example only, the Applicant is contending that use of the mark BIG BOX on a website or for a convenience store was not capable of performing the function of a trade mark, i.e. to indicate the trade origin of the services provided on or from those places, and likewise the use of the Subject Mark if used by the Proprietor in relation to general advertising, marketing and promotional services.

19 I now move to consider each of the three grounds relied on by the Applicant. In the context of invalidity proceedings, all three require first of all a consideration of the Subject Mark in relation to the services in respect of which it is registered but “**absent any consideration of its use, promotion or marketing by the [Proprietor] of the trade mark**” (emphasis in the original), *per* Chan Seng Onn J in *Love & Co Pte Ltd v The Carat Club Pte Ltd (“Love & Co”)* [2009] 1 SLR(R) 562; [2008] SGHC 158, at [53].

² The Registry issued a Circular clarifying its position in 2006 following the CJEU judgment (see also Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (3rd ed., 2014) at [6.088-6.089]). More recently, by Circular No.17/2014 (which replaces the earlier circulars on the issue), the Registry states that it will accept as a specification “the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods” *per se*, that is, without a need to qualify the means of bringing the goods together, for example on a website or in a convenience store. It also states in this Circular that it will accept the following very general descriptions of services in Class 35: (1) Retail sale services, (2) Retail store services, (3) Wholesale store services, (4) Online retail services, (5) Online wholesale services, (6) Online retail store services, and (7) Online wholesale store services.

20 In the event that I conclude that the Applicant has satisfied the burden of proof in relation to one or more of the three claimed grounds under Section 7(1), Section 23(2) states that:

“[a registered trade mark] shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

Therefore, once a trade mark is registered, if there is then a challenge to its validity that relies on Section 7(1)(b), (c) and/or (d) and the applicant satisfies the burden of proof, the proprietor has the opportunity of establishing on the balance of probabilities that, notwithstanding the position as at the application date, its mark has become distinctive (in a trade mark sense) by reason of its use by the proprietor after the application date. However, Chan Seng Onn J in *Love & Co* cautioned, at [95]:

“Needless to say, it will be an enormously difficult task to acquire or regain a de facto distinctive character where the various graphical features or the various meanings of the non-inherently distinctive mark have evolved into the “customary usage” in the particular trade, and where its usage by other traders has become entrenched. Indeed, it will be an uphill task in such cases ... to save such marks from deregistration under s 23(2) if they have been wrongly registered in breach of ss 7(1)(b), 7(1)(c) and 7(1)(d) in the first place.”

21 Thus, I must consider first whether a notional and fair use of the Subject Mark in connection with the retail and other services for which it is registered would have fallen within all or any of the three grounds as at the Application Date by reference to “the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed, observant and circumspect”, as explained by the Court of Appeal in *Société des Produits Nestlé SA v Petra Foods Ltd (“Kit Kat”)* [2016] SGCA 64 at [22], citing *Kerly’s* at para 8-016. When I come to consider Section 7(1)(d), I need to focus also on “the perception of the body of traders [who] may in turn be influenced by the perception of the average consumer and vice versa because of the close interaction between traders and consumers all the time”, *per* Chan Seng Onn J in *Love & Co* at [84].

22 In view of the fact that, in the words of George Wei J in *Han’s (F&B) Pte Ltd v Gusttimo World Pte Ltd* [2015] SLR(R) 825; [2015] SGHC 39 at [59], all of the three grounds are “in reality connected” and Section 7(1)(c) and Section 7(1)(d) are “particular examples” of the more general ground in Section 7(1)(b), that often acts as a ‘sweep-up’ provision, I will deal in order with the other two provisions first. The evidence adduced by the Applicant is relied on by it in relation to each of the grounds and I therefore deal with that evidence at the most appropriate juncture in my consideration of each of the three grounds but take it into account in relation to all three.

Ground of Invalidation under Section 7(1)(c)

23 Section 7(1)(c) of the Act reads:

“The following shall not be registered:

...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.”

Decision on Section 7(1)(c)

24 A trade mark may be refused registration, or as in this case removed from the Register on the grounds of invalidity,

“if at least one of its possible meanings designates a characteristic of the goods or services concerned ... it does not matter that there are other synonyms, other more usual signs or indications which can also serve to designate the same characteristic or other characteristics of the goods or services as s 7(1)(c) does not prescribe that the mark under examination should be the only way of designating the particular characteristic in question”, *per* Chan Seng Onn J in ***Love & Co*** at [70].

At this juncture it perhaps bears emphasising that the Subject Mark is not registered for warehouses or other types of buildings (in Class 6, if made of metal, or Class 19, if either transportable or not made of metal), but for a range of services that may be made available in a variety of ways and from a variety of locations.

25 We must now again turn to the services for which the Subject Mark is registered and assess whether “BIG BOX” designates a characteristic of those services. Taking the services contained in the specification in order, these are:

- (i) “[t]he bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods in retail shops, supermarkets, hypermarkets, convenience stores, wholesale outlets, factory outlets, warehouse retail outlets, retail outlets and big department stores”;
- (ii) “[t]he bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise internet web site [sic] or by means of telecommunication”;
- (iii) “[t]he bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications”
- (iv) “telephone and all other communication and telecommunication ordering services”
- (v) “direct mail advertising”;
- (vi) “business advisory and business services”;
- (vii) “advertising services”;

- (viii) “display services for merchandise”;
- (ix) “publicity services”;
- (x) “marketing and promotional services”;
- (xi) “market analysis and research”;
- (xii) “import-export agency services”;
- (xiii) “procurement and buying of goods on behalf of a business”;
- (xiv) “window dressing”;
- (xv) “sales and distribution services”;
- (xvi) “sales promotion for others”; and
- (xvii) “advisory and consultancy services relating to the aforesaid services.”

The services contained in (i)-(iii) can be properly characterised as retail services supplied to consumers, whereas those in (iv)-(xvii) would usually, although not necessarily exclusively, be supplied to other businesses.

26 As stated by the Court of Appeal in *Kit Kat* at [33], under Section 7 “the critical question to ask is whether the average consumer would appreciate the trade mark significance of the mark in question without being educated that it is being used for that purpose”. I consider that asking that question in relation to each and every one of the 17 different services included in the specification for the Subject Mark admits of no answer but an affirmative one, that at the Application Date the average consumer in Singapore would so appreciate. I do not consider that any of the evidence adduced by the Applicant which I deal with in detail below in relation to Section 7(1(d) affects this answer when considered in the context of this section.

27 In relation to this ground, the Applicant also submitted evidence of entries in two dictionaries (these form Exhibit 4 of KMY-1):

the Oxford dictionary, published on 8 October 2004, defines “big box” as “a very large store which sells goods at discount prices, especially one specializing in a particular type of merchandise”; and
the Merriam-Webster online dictionary defines “big-box” as “of, relating to, or being a large chain store having a box-like structure”.

It should be noted in relation to the first of these entries that the definition is described as “North American informal” and to the second that the copy of the entry to this American source is dated 14 September 2015. Thus, in the absence of significant further evidence that the average consumer in Singapore had adopted this North American term as at the Application Date, I do not consider that these entries can be given any weight in deciding what was the position in Singapore at the relevant time. In this context, I have read and considered carefully the authorities submitted by the Applicant to support its contention that I should give weight to these dictionary entries (*Nutricia International BV v Société des Produits Nestlé SA* [2009] SGIPOS 6 at [16], *G3 Enterprises Inc v Bacardi & Company Limited (“G3 Enterprises”)* [2014] SGIPOS 6 at [167], *Siemens AG v Sunonwealth Electric Machinery Industry Co Ltd* [2007] SGIPOS 4 at [1], and *Love & Co* at [88]), but do not consider they assist in this case.

28 In addition, the evidence referred to in [34] and [35] below and my conclusion on that evidence as far as it relates to the perceptions of the average consumer of the relevant retail and other services at the Application Date, contained in [37] below, apply *mutatis mutandis* in relation to descriptiveness under Section 7(1)(c) as they apply to Section 7(1)(d).

29 In its Written Submissions and at the hearing, the Applicant urged me to take into account the EU General Court (GC) judgment in *salesforce.com, Inc v European IP Office* (“EUIPO”) (Case T-134/15), in which the GC rejected an appeal against the refusal by the EUIPO examiner of the application to register the mark SOCIAL.COM in relation to a wide range of goods and services. To justify its rejection of the specification in its entirety, as the mark was descriptive in relation to all of it (therefore falling within article 7(1)(c) of the EU Trade Mark Regulation (the equivalent to Section 7(1)(c) of the Act)), the GC found, at [30], that “all the goods and services covered by the mark applied for and which are the subject of the present dispute are related to social media or social networks in a sufficiently direct manner and form a group of goods and services of sufficient homogeneity”. The Applicant argues that the case before me is comparable. I do not agree: the trade mark BIG BOX registered for the services contained in its specification cannot sensibly be compared with the patently descriptive mark SOCIAL.COM in relation to the goods and services in respect of which its registration was sought at the EUIPO.

30 Although the Applicant did not specifically request that I do so, I have considered whether the specification should be declared invalid under Section 23(9) in relation to part only of the specification of services, and particularly that relating to the provision of retail services in “hypermarkets and warehouse retail outlets”, but am satisfied that even in relation to those possible locations for the provision of the relevant service it should not be. On the basis of the evidence it has adduced, the Applicant has not satisfied me that at the relevant time the Subject Mark was descriptive (or generic or devoid of distinctive character) of services so provided.

31 Of course, this is not to say that the use by a third party of the words “big box” to describe a large retail warehouse such as that operated by the Applicant in Tampines would infringe the said mark as there is a defence available for descriptive use in Section 28(1)(b) of the Act: that is an entirely separate question that would depend on the facts and context (as do all alleged trade mark infringement matters). In its Written Submissions and at the hearing the Applicant referred to the note of caution rightly sounded by Jacob J (as he then was) in *Nichols Plc’s Trade Mark Application* [2005] RPC 12 (cited with approval in *G3 Enterprises* [2014] SGIPOS 6 at [189] and more recently in *In the Matter of a Trade Mark Application by Marvelous AQL Inc.* [2017] SGIPOS 3 at [58]):

“The problem with saying “registration will not harm the public: if a third party wants to use the mark descriptively he has a defence” is this: that in the practical world powerful traders will naturally assert their rights even in marginal cases. By granting registration of a semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark one is placing a powerful weapon in powerful hands. Registration will require the public to look to its defences. With such words and phrases the line between trade mark and descriptive use is not always

sharp. Moreover, it must not be forgotten that the monopoly extends to confusingly similar marks. In any marginal case defendants, SMEs particularly, are likely to back off when they receive a letter before action. It is cheaper and more certain to do that than stand and fight, even if in principle they have a defence.”

Much as I agree with the sentiments of the learned judge, this is not a case of a “semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark” for the services for which it is registered: in relation to those services (and that is what I have to consider) the Subject Mark is not descriptive of any characteristic but is inherently distinctive as an indication of trade origin, i.e. as a trade mark.

Conclusion on Section 7(1)(c)

32 The ground of invalidation under Section 7(1)(c) therefore fails.

Ground of Invalidation under Section 7(1)(d)

33 Section 7(1)(d) of the Act reads:

“The following shall not be registered:

...

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.”

Decision on Section 7(1)(d)

34 In its Written Submissions (at [13]), the Applicant contends that as at the Application Date the words “BIG BOX” were viewed by the body of traders in the retail and warehouse industries as a generic description of “a large retail or warehouse establishment”. In support of this contention, the Applicant refers to the EDB media release for the WRS referred to at [9] above; the 2004/5 annual report of SPRING Singapore which makes reference to “new industrial land regulations that allow fresh retail concepts like factory outlets and “big box retailers”” (a copy forms part of Exhibit 4 of KMY-1); and a reference in a 2004 issue of ‘The Retailer’, a quarterly publication of the Singapore Retailers Association, which states that through the WRS “fresh retail concepts such as warehouse outlets and ‘big box’ retailers that typically occupy 100,000 to 200,000 sq ft can now be set up in Singapore” (likewise a copy of the relevant page forms part of Exhibit 4 of KMY-2). In addition, the Applicant relies on five articles in ‘Business Times’, two in ‘Straits Times’, two in ‘The Edge Singapore’ and one on the website of Channel News Asia, dated between the first on 25 November 2002 in the Straits Times and the last on 20 December 2004 in The Edge Singapore (copies of all of which form part of either Exhibit 1 or 5 of KMY-1 or of Exhibit 1 of KMY-2).

35 In addition to this evidence of the position prior to and at the Application Date, the Applicant submitted copies of subsequent newspaper and internet articles, dated between 11 February 2005 and 26 May 2016 (these form Exhibit 2 to KMY-2), together

with a copy of a blogpost dated 21 October 2012 on the Frenzeelo online portal (that forms Exhibit 3 to KMY-2). This blogpost starts:

“When I hear the phrase ‘big box retailers’, I will immediately think of popular retailers in the US like Target, Walmart and Best Buy. Unfortunately, they did not make their presence in Singapore [sic] so we can’t enjoy affordable furniture, clothes, electronics and groceries. Not all is lost though. Singapore does have its own set of big box retailers in the east called Tampines Retail Park which consists of a Giant Hypermarket, Ikea Furniture Store and Courts Megastore. Let me give you a brief tour of all the three big box retailers here at Tampines Retail Park.”³

The Applicant contends that this indicates “clear consumer sentiment that the term “big box” refers to a large retail or warehouse establishment” (at [8] of KMY-2). On the other hand, the Proprietor contends that “the determination of whether “BIG BOX” is generic and customary in local Singapore parlance has to be taken from the perspective of the average man on the SBS Transit bus, who would in all likelihood simply think that “BIG BOX” refers to a large container” (at [65] of the Respondent’s Written Submissions). Although I can accept (with a slight modification to include women) the Proprietor’s characterisation of the relevant average consumer as ‘the man and woman on the SBS Transit bus’, it must be remembered, as I have already stated at [15] above, that the question whether a term is generic or not must be considered in the context of the relevant goods or services, here the provision of a range of services including retail services.

36 I am cognisant of the fact that, although post-dating the Application Date, this evidence set out in [34] above may assist me to draw inferences as to what the position was at and before that date. As was noted by Chan J in *Love & Co* in relation to use of the word “love”:

“for the purposes of s 7(1)(d), I cannot ignore evidence presented to me of the word ‘love’ post-dating 19 April 1999 [the application date] or showing usage of the word “love” outside Singapore whether pre-dating or post-dating 19 April 1999, to assist me in drawing inferences and conclusions on whether the word “love” has, on a balance of probability, crept into the jewellery trade lexicon and become customary ...”

37 The Applicant also relies on U.S. trademark registration No.4771225 that consists of ‘the words “BIG” and “BOX” in blue separated by a blue star, with a grey shadow to the upper right positioned behind the words “BIG” and “BOX” and the star’ registered for retail store services featuring a wide variety of goods. In the course of examination of the said trademark the examiner required a disclaimer that “No claim is made to the exclusive right to use “BIG BOX” apart from the mark as shown”. (Copies of relevant documents from the U.S. Patent and Trademark Office form Exhibit 5 of KMY-1).

³ I note in passing that the blogger appears to have had no difficulty with the notion that the word “GIANT” was used by a retailer in a trade mark sense, as an indication of trade origin of the retail services offered at the particular hypermarket in Tampines, in the same way as Ikea and Courts used their trade marks.

38 After a careful review, it is clear that, with a couple of exceptions only, the evidence adduced by the Applicant of the position in Singapore as at the Application Date relates to the WRS and much of it adopts wording identical or very similar to that used in the EDB media release on the launch of that Scheme. In my view, it is not possible to extrapolate from the choice of words of whoever drafted that EDB media release and those journalists who picked up its use of the term “big box”, together with a very few others who apparently used it more or less in the same sense independently, that the term was one in customary usage either by the average consumer or by the trade at the relevant date. Thus, I have concluded that this evidence in and of itself does not satisfy the burden of proof imposed on the Applicant in these invalidity proceedings.

39 The Applicant also submitted in support of its contention that “BIG BOX” was generic amongst traders in the retail and warehouse industries as at the Application Date both (a) copies of a number of articles published on U.S. or New Zealand websites that refer to ‘big box’ retailers in those countries (these form Exhibit 6 of KMY-1) and (b) copies of various reports on the North American retail and warehouse market (“*Big Box and Austin*”, “*Managing Maryland’s growth: ‘Big-Box’ Retail Development*”, “*Encouraging Mixed Use in Practice*” by a Canadian professor, and “*Supersize It: The Growth of Retail Chains and the Rise of the ‘Big-Box’ Retail Format*” by two U.S. professors together with an author from the U.S. Census Bureau: all forming Exhibit 7 of KMY-1). After careful review, I do not consider that these assist to any material extent the Applicant’s case, which concerns the position in Singapore at the relevant date.

40 The evidence of subsequent sporadic use adduced by the Applicant of the term “big box” in Singapore newspaper and internet articles over the span of 11 years since the Application Date (a number of which again refer to the WRS or to the situation outside Singapore, as well as illustrating a range of views as to the meaning of the term), together with an isolated blogpost (that itself starts by referring to U.S. retailers)(see [35] above), is insufficient to permit the drawing of inferences inconsistent with the conclusion I arrive at in [38] above and, despite that evidence published after the Application Date, I remain unconvinced on a balance of probabilities that the words BIG BOX were customary in either the current language or the bona fide and established practices of the trade as at the Application Date.

41 For completeness, I should state that I do not consider that the disclaimer included in U.S. trademark registration No.4771225 (referred to at [37] above) is to be given any weight in these proceedings: (a) U.S. trademark law and practice is different to that in Singapore, (b) both the trade mark and the specification of services are significantly different to the Subject Mark and its specification and (c) the retail market conditions of the United States of America are different to those in Singapore.

Conclusion on Section 7(1)(d)

42 The ground of invalidation under Section 7(1)(d) therefore fails.

Ground of Opposition under Section 7(1)(b)

43 Section 7(1)(b) of the Act reads:

“The following shall not be registered:

...

(b) trade marks which are devoid of any distinctive character”.

Decision on Section 7(1)(b)

44 On consideration again of all the evidence adduced by the Applicant and dealt with above in relation to either or both of Section 7(1)(c) and 7(1)(d), I consider that in relation to Section 7(1)(b) the Applicant has failed to discharge the burden of proof placed upon it in an invalidity action brought under Section 23 of the Act to satisfy me that, in relation to the various services for which it is registered (see [25] above), the Subject Mark was devoid of distinctive character (as a trade mark) as at the Application Date. Instead, I consider that at that time it was inherently distinctive and capable of performing its function as an indication of trade origin.

Conclusion on 7(1)(b)

45 The ground of invalidation under Section 7(1)(b) therefore fails.

Acquired distinctiveness

46 As I have rejected the Applicant’s application under Section 23(1) of the Act, relying on the grounds contained in Section 7(1)(b), (c) and (d) assessed as at the Application Date, it is unnecessary for me to consider whether the Subject Mark has acquired distinctiveness as a result of use made of it by the Proprietor since the Application Date.

47 However, in view of the market survey evidence submitted by the Proprietor, I think it appropriate that I make some observations on this and the use of market survey evidence in trade mark opposition and invalidation proceedings generally, as I am concerned that parties to such proceedings may spend large sums on adducing evidence that is of little or no probative value.

48 Guidelines for the conduct of surveys were set out by Chan J in *Ferrero SPA v Sarika Connaissanceur Café Pte Ltd* [2011] SGHC 176 at [134], after the learned judge had noted that “a number of cases have cautioned that great care and circumspection must be taken with respect to market surveys”, at [130].

49 As stated by the Respondent, the primary purpose of the survey in this case was “to determine if “BIG BOX” had any generic meaning in the sense that “BIG BOX” was customary in the current language in Singapore to designate a large retail establishment” (Respondent’s Written Submissions at [68]). In addition, the Respondent contends in its Written Submissions (at [121]) that, although not its primary purpose, the survey “goes some way towards proving that the Registered Mark has acquired distinctiveness through use.” Thus, the Respondent was seeking to rely on the survey results as evidence in support of both a negative (that BIG BOX was *not* generic) and a positive (that they had acquired distinctiveness) factual proposition.

50 The market survey was conducted on behalf of the Respondent by Blackbox Research Pte Ltd (“Blackbox”), a well-established research agency in Singapore which is a member of the Market Research Society of Singapore. According to Mr David Black, its Managing Director, Blackbox was “instructed [in January 2016] to conduct a representative survey on the meaning or association with the term “BIG BOX”, if any, among Singapore citizens and Permanent Residents.” (DB-1, at [8]).

51 To ensure both a relevant cross-section of the public and a statistically significant size, Blackbox recommended a survey size of 350 interviewees (DB-1, at [9]-[10]) and a survey questionnaire was agreed between the Proprietor’s legal advisers and Blackbox. Mr Black states (DB-1, at [10]): “we had to ensure that the questions asked were capable of being carried out [sic], and that the responses to questions asked were capable of being reported and documented accurately, transparently and objectively.”

52 After a question to ensure that the person approached was either a Singaporean or a Singapore PR, the interviewee was asked four screening questions on their ethnicity, gender, age (they were required to be at least 20 years old) and type of residence, followed by five possible questions relating to ‘the term “BIG BOX”’ as set out below.

SECTION A		
Q1. Does the term “BIG BOX” mean/describe anything to you? [SA]		
1. Yes	1	Proceed to Q3
2. No	2	
3. Maybe	3	Proceed to Q3
4. Not sure	4	Proceed to Q3
<i>Base: ALL RESPONDENTS WHO ANSWERED ‘NO’ IN Q1 [Q1=2]</i>		
Q2. Are you sure the term “BIG BOX” does not mean anything to you? [SA]		
1. Yes	1	[TERMINATE]
2. No	2	Proceed to Q3
3. Maybe	3	Proceed to Q3
4. Not sure	4	Proceed to Q3
Q3. What does the term “BIG BOX” mean/describe to you? [Record Verbatim]		
<hr style="border: 0; border-top: 1px solid black; margin-bottom: 10px;"/> <hr style="border: 0; border-top: 1px solid black;"/>		
Q4. Why does the term “BIG BOX” mean that to you? [Record Verbatim]		
<hr style="border: 0; border-top: 1px solid black; margin-bottom: 10px;"/> <hr style="border: 0; border-top: 1px solid black;"/>		

Q5. Thinking back more than 10 years ago (2005), would the term Big Box have meant something different to you then than it does now? [SA]		
1. Yes	1	
2. No	2	
3. Don't Know	3	

A sample interview form/questionnaire forms Exhibit 2 to DB-1.

53 Interviews were conducted at 15 different locations around Singapore, from Jurong West (encompassing both Lakeside MRT and Boon Lay MRT) in the west to Pasir Ris MRT in the east and Sembawang MRT in the north to Kallang MRT in the south. Mr Black states (DB-1 at [15]) that “[r]esponses from the interviewees were captured verbatim” and that interviewees were approached at a standard interval of every third person excluding children. He also says that reference was made to the Yearbook of Statistics, Singapore “to determine the appropriate proportions of each age group, gender, housing type, and area of residence, to represent a cross-section of the general public in Singapore” (DB-1 at [15(c)]). (In passing, I would note that it is difficult for a non-statistician to see how it was possible to identify ‘area of residence’ as none of the survey questions asked this. Given the efficiency and extent of the bus and MRT system and the general ease of movement around Singapore, it is perhaps unreasonable to assume that interviewees resided in the area they were interviewed.)

54 A total of 363 survey responses were adduced in evidence and form Exhibit 4 to DB-1.

55 By way of examples only of survey responses that give rise to some cause for concern as to their accuracy:

Interviewer ID 1180 at Hougang MRT appears to have spent exactly 1 hour 25 minutes speaking to 16 different people for exactly 5 minutes each, with no gaps at all between finishing one interview and finding and starting another.

Interviewer ID 1180 at Serangoon MRT, Interviewer ID 1432 at Tampines MRT and Interviewer 1432 at Bedok MRT all also took exactly 5 minutes with each interviewee, regardless of whether the interview was terminated after Q2, and needed either no time or exactly 5 minutes to find the next interviewee.

Interviewer ID 1384 (surprisingly, her name is recorded on the forms) in the interviews she conducted variously at Potong Pasir MRT, Book Keng MRT and Kallang MRT took exactly 10 minutes on each interview she conducted, with the exception of one only that took 5 minutes (questionnaire no.129, at pp311/312 of Exhibit 4 to DB-1). In this 5 minute interview, with a 59-year old Singaporean Chinese female, the verbatim answer to Q3 recorded is “many products sell in this big box” and to Q4 “Many things sell in this box”: in this example and many others it cannot reasonably be contended that the interviewee gave these verbatim responses only, there must have been additional words spoken (or, possibly, prompting by the interviewer) which were excluded from the written record by the interviewer.

56 It is worthwhile also referring to the responses recorded by Interviewer ID 1132 at Jurong East MRT, which is of course near where the Proprietor has its outlet and who

understandably recorded interviews with a significantly higher recognition proportion than any other interviewer. This interviewer took 4 minutes over his/her first interview with a 24-year old Singaporean Chinese female (including an apparent verbatim response to Q3 of “It’s a very big container. Warehouse concept shopping mall”) and then took 7 minutes to find his/her second one, a 31-year old Singaporean Chinese male. This interview took 3 minutes (culminating in a response to Q5, as to whether the term BIG BOX would have meant something different in 2005 (when he was 20 years old), that indicates he said ‘yes’ but without any indication as to what it meant to him at that point, which the questionnaire does not call for). This interviewer’s third subject, a 20-year old Singaporean Chinese male, who took 4 minutes to find and did the interview in 2 minutes, answered (somewhat confusingly) Q1 and Q2 with ‘no’ but then apparently gave a verbatim response to Q3 “shopping mall”, which seems somewhat terse and unlikely to be a verbatim recording of his answer. The fourth, a 27-year old male Singapore PR, who took 2 minutes to find, again answered both Q1 and Q2 with a ‘no’ and proceeded to answer to Q3 “consider like Courts mega mart” and Q4 “To me, it’s like a bigger shopping mall in Jurong East, like fair price [sic] selling IT products”: having answered Q1 with a ‘no’, it strains credulity to believe that the verbatim responses to Q3 and Q4 were unprompted. The next but one interviewee, a 20-year old Singaporean Malay female, who started her interview 1 minute after the previous one was completed, answered to Q1 ‘yes’, to Q3 “It’s a big mall but don’t know what’s inside”, to Q4 “From the outside, its [sic] looks like a big megamart. Looks like a box design. Probably has lots of stuff inside”, and to Q5 ‘yes’ (although she would have been 9 years old then). The interviewer then proceeded to interview two consecutive Singaporean females, the first a 26-year old Indian and the second a 21-year old Malay, who responded to Q4 with the identical words “went there before”, despite being interviewed six minutes apart.

57 It is plain from a careful reading of all 363 of the responses, of which the above are examples only, that the accuracy of recording varies and common sense dictates the conclusion that the questionnaire forms are incomplete records of what both the interviewers and interviewees actually said. As such, it is impossible to accord any weight to the survey results as evidence in support of the two propositions for which it is adduced by the Respondent: for the first and primary purpose, I assume that what the Respondent meant to say is that “BIG BOX” was not generic, in the sense that it was customary in the current language in Singapore, *at the relevant time* (i.e., the date of registration) (my emphasis added) and the secondary purpose was to support its contention that, if the Registered Mark was generic as at the relevant date, it had nevertheless acquired (or, more appropriately, regained) distinctiveness by use by the date of this Application.

58 In relation to that primary purpose, I have already noted at [14] above that if the Applicant succeeds in establishing that the Registered Mark was generic at the relevant date, it is almost impossible for the Respondent to adduce evidence that will prove a negative, that at the relevant time it was not generic. Certainly there is nothing in the answers given to Q5 contained in the survey responses that would give any support to such a contention, which in itself is hardly surprising given that interviewees were asked to speculate on what they thought 11 years before, in 2005, a time when 24% of them had not yet left behind their teenage years.

59 As regards the other purpose, of providing evidence that the Registered Mark had regained distinctiveness by the date of the invalidation action, I draw attention again to the words of Chan J in *Love & Co* quoted above at [20] and particularly his observation that “it will be an enormously difficult task to acquire or regain a de facto distinctive character”. If the Applicant had succeeded in satisfying the burden of establishing that the Registered Mark was generic at the date of its registration, the survey results fall far short of evidence sufficient to prove that the Respondent had completed successfully that “enormously difficult task”. Even if the best possible light is put on the evidence (and all inconsistencies and inaccuracies in the recording ignored), as the Respondent did at [124] of its Written Submissions by stating that 25.1% of those interviewed linked “BIG BOX” to the Respondent’s mall in Jurong East, this would still have been insufficient to show that “in consequence of the use which has been made of it, [the Subject Mark] has after registration acquired a distinctive character in relation to ... services for which it is registered” as required by Section 23(2) of the Act.

60 From experience in legal practice in England, I am aware that there is often pressure to conduct market surveys to try and find evidence to support factual contentions made in trade mark proceedings. However, my experience is also that such evidence is rarely determinative and is often disproportionately expensive to obtain; it is for that reason that the practice has grown up in England of using mini-market surveys as a method of finding witnesses prepared to give written statements (or appear as witnesses in court proceedings), on the basis that there is no substitute for a real person saying real things under oath (see the general section on ‘Surveys and questionnaires’ in the First Supplement (2014) to the 15th edition of *Kerly’s*, at [21-018] to [21-042s], and particularly [21-042q] to [21-42s] on surveys to prove meaning).

61 Of course, there remains a role for market survey evidence if that is the only sufficient evidence that can be obtained but, if so, very careful consideration needs to be given to the form of the questions and the process for administering them, and recording accurately and fully the responses, so as to ensure that the evidence goes to the factual questions in support of which it is intended it be adduced.

Overall Conclusion

62 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the present application for a declaration of invalidity fails on all grounds. The Proprietor is entitled to costs to be taxed, if not agreed.

Date of Issue: 2 May 2017

[The appeal from this decision to the High Court was dismissed.]