

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

Trade Mark No. T0801770E
2 March 2017

IN THE MATTER OF A TRADE MARK REGISTRATION

IN THE NAME OF

VAN CLEEF & ARPELS S.A.

AND

APPLICATION FOR REVOCATION THEREOF BY

FMTM DISTRIBUTION LIMITED

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Ms Francine Tan (Francine Tan Law Corporation) for the Applicants
Mr Sukumar Karrupiah (Ravindran Associates) for the Proprietors

GROUND OF DECISION

1 As in most non-use revocation cases, the central issue is here is whether there is genuine use or trade mark use of the mark, with regard to the relevant goods, within the relevant time periods in question.

2 In the instant case, FMTM Distribution Ltd ("the Applicants") sought to argue that there was no trade mark use (i.e. use intended to signal to a consumer that a product originates from a particular undertaking, as discussed in greater detail below). In particular, the Applicants assert that the mark **MYSTERY SET** is descriptive of, or is a common name for, a characteristic of jewellery, where gemstones appear to be set with no visible mounting.

3 This raises an interesting side issue of a potential challenge an accomplished trade mark owner may face. A trade mark's very success may lead to a possible claim of general use of the mark to *refer* to the characteristic of the product itself¹.

4 However, having regard to the totality of *all* the evidence tendered, I am satisfied that there is sufficient evidence, on balance, to show that the subject mark has indeed been put into genuine use in respect of "jewellery".

5 As mentioned above, the subject of these revocation proceedings is Trade Mark No. T0801770E ("the Subject Mark"):

MYSTERY SET

6 The Subject Mark was registered on 7 January 2008 in Class 14 in respect of "jewellery, watches". The date of completion of registration was 23 April 2008.

7 On 1 October 2015, the Applicants filed an application for revocation of the Subject Mark on the grounds of non-use. Van Cleef & Arpels S.A. ("Proprietors") filed their counter-statement to resist revocation on 29 January 2016. The Proprietors also filed their evidence of use together with the counter-statement.

8 The Applicants filed evidence in support of the application on 17 May 2016. The Proprietors filed further evidence in support of maintaining the registration on 21 July 2016. The Applicants did not file any evidence in reply.

9 A Pre-Hearing Review (PHR) was held on 23 November 2016. Following the PHR, the Applicants wrote in on 28 November 2016 to drop the objection under section 22(1)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") such that the current action is now only based on section 22(1)(a)². The matter was set down for a full hearing on 2 March 2017.

10 Parties exchanged their written submissions on 1 February 2017 (Applicants) and 2 February 2017 (Proprietors)³. The Proprietors tendered written rebuttals to the Applicants' written submissions at the oral hearing. The Applicants initially objected to

¹ Or in the alternative, use of the mark to describe the characteristic of the product.

² Section 22(1)(a) relates to revocation for non-use within a period of 5 years following the date of completion of the registration procedure. On the other hand, section 22(1)(b) relates to revocation for non-use where the use has been suspended for an uninterrupted period of 5 years.

³ The due date for the exchange was 2 February 2017.

this. However, following clarification that this is allowed pursuant to HMD Circular 4/2015 Part F, the Applicants orally tendered their response to the same at the hearing.

11 At the end of the oral hearing, the Applicants requested that they be allowed to tender their oral submissions in writing since the Proprietors had tendered their rebuttal submissions in writing. The Registrar allowed the request as the Proprietors did not object.

12 However, when the Applicants submitted the same via their letter of 3 March 2017, their letter contained not only the oral submissions but also rebuttals which were *not* proffered at the oral hearing itself (“Additional Rebuttals”). On 6 March 2017, the Proprietors strongly objected to this on the basis that the original request was to submit a written copy of the oral submissions only. This deprived the Proprietors of their right of final reply to the Additional Rebuttals which they were entitled to since they have the burden of proof. The Proprietors submitted that no weight should be accorded to the Additional Rebuttals as the Applicants had the liberty to tender a written rebuttal at the hearing but did not do so.

13 Having regard to the circumstances, on 6 March 2017, the Registrar directed that the Proprietors be allowed to respond to the Additional Rebuttals, should they wish to do so, on or before 20 March 2017. The Registrar was of the view that the Additional Rebuttals were basic rebuttal submissions which did not prejudice the Proprietors but that the Proprietors should have the opportunity to exercise their final right of reply. Further, the Registrar also clarified that in light of developments, for the purposes of Rule 38 of the Trade Marks Rules (Cap 332, Rev. Ed. 2008), the date of filing of the closing submissions would be the date when the Proprietors file their response.

14 The Proprietors submitted their reply submissions on 16 March 2017. The Proprietors expressed their disappointment with the Additional Rebuttals being regarded as basic rebuttal submissions even though there were no directions for parties to tender additional submissions. The Proprietors registered their dismay that they were put to additional costs as a result of the above as they had no choice but to submit their reply.

15 In light of the above, each party tendered 3 sets of written submissions as follows:

(i) Applicants:

- (a) Applicants’ written submissions dated 1 February 2017 (AWS1);
- (b) Applicants’ written submissions filed on 3 March 2017 (AWS2). The paragraphs of AWS2 are not numbered, except for the headings. The references to the paragraphs below are my own and for ease of reference only;
- (c) Applicants’ reply submissions filed on 3 March 2017⁴ (AWS3).

(ii) Proprietors:

⁴ As indicated above, the Applicants’ reply submissions included not only their rebuttals made at the oral hearing but the Additional Rebuttals as well.

- (a) Proprietors' written submissions dated 2 February 2017 (PWS1);
- (b) Proprietors' written submissions dated 2 March 2017 (PWS2); and
- (c) Proprietors' written submissions dated 16 March 2017(PWS3).

Grounds of Revocation

16 As mentioned above, while the Applicants originally relied on Sections 22(1)(a) and 22(1)(b) of the Act, in the end they only sought to rely on the sole ground of Section 22(1)(a) in this revocation action.

Applicants' Evidence

17 The Applicants' evidence comprises a statutory declaration (SD) dated 10 May 2016 made by Ms Gwenaelle Vache, Intellectual Property Manager of the Frank Muller Group ("Applicants' SD").

18 At the outset, many pages of the Applicants' SD have to be disregarded as they are dated out of the relevant periods⁵. Further, it is unclear if the articles included in the exhibits of the Applicants' SD were dated the British way or the American way (i.e. whether "10/06/2015" should be understood as "10 June 2015" which is the British way or "6 October 2015" which is the American interpretation. Where the situation permits, I have adopted the British style for the simple reason that this accords with our local practice. For the avoidance of doubt, there were no submissions by either party in relation to this issue and importantly, even if I am wrong and the particular article should be disregarded, it does not in any way affect my final conclusion.

Proprietors' Evidence

19 The Proprietors' evidence comprises of the following:

- (i) A statutory declaration dated 29 January 2016 made by Ms Gonnet Pon Elise Marie, Regional Managing Director of Van Cleef & Arpels South Asia⁶ ("Proprietors 1st SD"); and
- (ii) A statutory declaration dated 18 July 2016 also declared by Ms Gonnet Pon Elise Marie ("Proprietors 2nd SD).

Burden of Proof

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

Background of Parties

⁵ There are two relevant periods (see below).

⁶ See further below as to the Proprietors' organizational structure.

21 The Applicants did not provide any information as to their background, either in Form TM 28 and their Statement of Grounds or in their evidence. However, a quick online search of publicly available records reveals that they own, amongst others, the “Franck Muller” trade mark for watches, amongst others⁷.

22 The Proprietors are a supplier of fine jewellery and luxury watches sold under the Van Cleefs & Arpels (VCA) trade mark. Established in France in 1896, VCA and their predecessors in title have been trading for over 100 years (see [1] of the counter-statement).

23 The Proprietors deposed at [1] and [2] of the Proprietors 1st SD that Richmond Luxury (S) Pte Ltd is the exclusive retailer and distributor of luxury goods manufactured by the Richmond Group which owns several of the world’s leading brands for luxury goods including jewellery, watches and writing instruments. Richmond Luxury (S) Pte Ltd has hired Ms Gonnet Pon Elise Marie as the Regional Managing Director of Van Cleef & Arpels South Asia.

24 The Richmond Group’s brands includes IWC, Chloe, Van Cleef & Arpels, Piaget, Vacheron Constantin, Jaeger-LeCoultre, Panerai, Cartier, Roger Dubuis, Alfred Dunhill and MontBlanc, to name a few.

MAIN DECISION

Ground of Revocation under Section 22(1)(a)

25 Section 22(1)(a), (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;

...

(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)...of subsection (1) if such use as is referred to in that paragraph is

⁷ See T9409224C.

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

26 The Applicants submitted that the registration of the Subject Mark should be revoked as:

- (i) there had been no genuine use of the Subject Mark by the Proprietors for a period of 5 years subsequent to 23 April 2008 (the date of completion of registration).

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

- (i) The registration procedure was completed on 23 April 2008. The 5-year period immediately following the completion of registration ended on 23 April 2013. Thus, the period of use (or non-use) in issue is ***24 April 2008 to 23 April 2013***.
- (ii) The application for revocation was filed on 1 October 2015. Thus, for the purposes of Section 22(4), the relevant 3-month period is ***1 July 2015 to 30 September 2015***.
- (iii) Following the above, the period for the purposes of Section 22(3) is ***24 April 2013 to 30 June 2015***.

28 For the avoidance of doubt, even though Section 22(3) was not specifically pleaded by the Applicants in Form TM 28 and their statement of grounds, the Registrar can still invoke this provision (see below).

Rationale for requiring genuine use of a trade mark

29 The Court of Appeal in *Société des Produits Nestlé SA and another v Petra Foods Ltd and another* [2017] 1 SLR 35 ("*Petra*") at [119] stated as follows:

[119] As Rajah JA explained in *Weir Warman* at [99]:

... It must be noted at the outset that this requirement of 'genuine use' is closely intertwined with the function of a trade mark and the purpose of

registration ... A trade mark serves to indicate the source of the goods to which it is affixed and registration facilitates and protects this function of the trade mark. There must be genuine use of the trade mark before its function is served and protection by registration is *justified*. Further, as the register also serves as a *notice* to rival traders of trade marks that [are] already in use, to allow a mark that is not *bona fide* in use to remain on the register would be deceptive and could permit the registered proprietor to *unfairly hijack or usurp a mark and/or monopolise* it to the exclusion of other legitimate users. These considerations underpinning the need for ‘genuine use’ of a registered trade mark must be borne in mind when assessing an application for revocation.

[Emphasis in italics mine]

30 The Proprietors’ evidence at [7] of the Proprietors’ 1st SD is as follows:

S/N	Date of invoice	Invoice No.	Description	Price (SGD) ⁸	Method of Payment	Address of Buyer
<i>24 April 2008 to 23 April 2013</i>						
1	18 Nov 2010	5001663	Mystery Set	467,500.00	Boutique account	Indonesia
2	1 Aug 2011	5002236	Mystery Set	175,300.00	Boutique account	Indonesia
3	19 Sep 2011	5002402	Mystery Set	282,400.00	Boutique account	Indonesia
4	16 Dec 2011	5002617	Mystery Set	2,918,000.00	Boutique account	Indonesia
5	9 Oct 2012	5003535	Mystery Set	256,542.00	<i>Not indicated</i>	Singapore
<i>24 April 2013 to 30 June 2015</i>						
6	10 May 2013	5004330	Mystery Set / <i>Mysterious Setting</i>	757,009.00	<i>Not indicated</i>	Indonesia
7	12 Jun 2014	5005983	<i>Mysterious Setting</i>	1,126,497.00	<i>Not indicated</i>	Indonesia
8	14 Jan 2015	5006996	Mystery Set	1,300,000.00	<i>Not indicated</i>	<i>Not indicated</i>
9	24 Jun 2015	5007763	Mystery Set	700,000.00	<i>Not indicated</i>	Indonesia

Each transaction has been supported by a corresponding invoice attached to Exhibit A of the same evidence.

⁸ Only those items which include a reference to the Subject Mark will be taken into account.

31 At the oral hearing, the Proprietors submitted that the evidence relating to the years 2013 to 2015 should be disregarded in light of the fact that the objection under Section 22(1)(b) has been dropped. However, it is necessary to include the said evidence for the reason that there is a second relevant period (see [27(iii)] above).

Use

32 The Proprietors have tendered, in the main, invoices to support their case. In this regard, the Proprietors argued, at [16] of PWS1, that section 27(4) is relevant. Section 27(4) provides as follows:

27.— (4) For the purposes of this section and sections 28, 29 and 31, a person uses a sign if, in particular, he —

- (a) applies it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
- (c) imports or exports goods under the sign;
- (d) uses the sign on an *invoice*, wine list, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or
- (e) uses the sign in advertising.

[Emphasis in italics mine].

33 The Proprietors argued (see [17] of PWS1) that even though the applicability of section 27(4) is expressly stated to be in relation to sections 27, 28, 29 and 31, the High Court in *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long and others (trading as Polykwan Trading Co)* [2003] 4 SLR(R) 92 (“*Bluestar*”) has expressly approved the use of section 27(4):

[53] Mr Gill also relied on *Kerly’s Law of Trade Marks and Trade Names* (13th Ed), at p 281, which opined that although (the UK equivalent of our) s 27(4) was expressed to be for the purposes of s 27 (only), the types of use set out therein are *equally applicable* when considering the question of use under (the UK equivalent of our) s 22. Mr Wong did not contest this submission.

[Emphasis in italics mine].

34 The Applicants argued at the oral hearing ([2.6] – [2.8] AWS2) that [53] of *Bluestar* only reflects counsel’s argument and was not contested by the other party. Importantly, there was no discussion by the High Court on this issue. The Applicants argued that had it been the intention to include “invoices”, the Act would have made a specific provision as such. For example, it would have been included in section 22(2) which provides:

22.— (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.

[Emphasis in italics mine].

35 The Applicants argued that the considerations for an infringement action are different. In an infringement action, it may be difficult to obtain evidence of infringing use justifying the inclusion of a wide array of items under section 27(4) ([2.9] AWS2). In contrast, in this instance, the Applicants argued that the Proprietors could have easily provided other types of evidence. This includes, for example, advertising and packing materials showing use of the mark ([13] of the AWS1). The Applicants argued that, in light of the above, section 116(g) of the Evidence Act (Cap. 97) (“EA”) should apply in this case such that an adverse inference should be drawn against the Proprietors.

36 The Proprietors relied on *Capitol Records LLC v Steven Corporation Pte Ltd* [2010] SGIPOS 14 (“*Capitol Records*”) where genuine use was found based on invoices alone:

[9] ...On the invoices and purchase orders indicating use of the "BLUENOTES" mark in the relevant period, the Proprietor claimed that as most of the earlier invoices were dated almost a decade ago, they were only able to retrieve a few invoices and purchase orders indicating use of the "BLUENOTES" mark within the relevant period. These invoices and purchase orders were filed as evidence of use at Annex A to the Proprietor's Counter-statement:

(a) Tax Invoice 74339 dated 31 March 2004 from Steven Corporation Pte Ltd to Robinson & Co. (S) Pte Ltd at Orchard Road for 250 quantities of “*RG-37A BLUE NOTE BOY's REV. SHORTS*”

...

(c) Tax Invoice 74224 dated 18 March 2004 from Steven Corporation Pte Ltd to Robinson & Co. (S) Pte Ltd at Orchard Road for 350 quantities of “*RG-37A BLUE NOTES BOY's REV. SHORTS*”

...

[27] I will now examine the relevant specific instances of use within the relevant period lodged by the Proprietor, *noting that use in invoices, purchase orders and packing lists would fall within the ambit of "use" in Section 27(4)(d).*

...

[31] Chow's SD is affirmed by the Director of Kiddy Palace Pte Ltd. Kiddy Palace Pte Ltd is in the business of retail of ready-made apparel and other merchandise catering to the children's market in Singapore. In Chow's SD, the deponent stated that he had been purchasing goods from the Proprietor bearing the "BLUENOTES"

trade mark for over 10 years up to the date of the SD. In particular, the deponent confirmed that he had purchased goods from the Proprietor carrying the "BLUENOTES" trade mark from 2003 to 2008...Although there is no documentary proof in the form of invoices within the relevant period, as a Statutory Declaration is a statement taken under oath, taken at face value, Chow's SD does show that there was "use" of the mark, "BLUENOTES" by the Proprietor through the sale of goods...under the said mark to Kiddy Palace Pte Ltd during the period 2003 to 2008 (which covers the relevant period), albeit that *I should not attach too much weight to this piece of evidence* since the statement is not substantiated with documentary proof.

[32] In summary, on the question whether there was "use", I find that the Proprietor has shown that there was use within the relevant period, *especially through the evidence in paragraph 9(a) and 9(c) and through Chow's SD.*

[Emphasis in italics mine].

37 In light of the above, ***Capitol Records*** is authority for:

- (a) The applicability of section 27(4) to section 22 (above); and
- (b) The fact that there is no strict requirement that the mark is to be applied *onto* the goods (since the tax invoices at [(9(a))] and [9(c)] in ***Capitol Records*** merely describes the product sold – see discussion below).

38 The Applicants sought to distinguish ***Capitol Records*** ([30] of AWS3) on the basis that photographs as well as physical samples were tendered in ***Capitol Records*** (which is not the case here). However, I agree with the Proprietors ([27] PWS3) that these had been disregarded by the learned Principal Assistant Registrar ("PAR") (see ***Capitol Records*** at [29]).

39 In any case, I do not think there is a need to determine if section 27(4) applies to section 22 as the categories of use under section 22 are not closed. As indicated above, the operative word is "includes":

22.— (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.

[Emphasis in italics mine].

This necessarily means that section 27(4) only provides *illustrations* of the types of evidence which can be considered, and that one can take into account other types of evidence.

40 Last but not least, it is noted that Professor Ng-Loy Wee Loon, who is a distinguished authority on trade mark law in Singapore, in her textbook on the *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2014 Rev Ed) (“***Law of Intellectual Property of Singapore***”) agreed with the applicability of section 27(4) to section 22:

[25.3.5] The non-exhaustive list of ‘use’ set out in s 27(4) for the infringement provisions is *relevant* for determining whether there has been use for the purposes of revocation proceedings.

[Emphasis in italics mine].

41 Following this line of thought, I disagree with the Applicants at [27] of AWS3 that:

“Proof...would logically consist in cases such as these of obvious items such as photographs, labels, brochures, advertisements etc...”

There is no obvious category of proof. What is relevant for each case will depend on the actual facts therein.

42 Thus there is no strict need to adduce evidence such as advertising materials or photographs ([35] of PWS3), although they may be helpful. Having said the above, clearly, the Proprietors are still required to comply with section 105 of the Act.

43 Further, the Applicants have repeatedly argued that the Subject Mark has not been applied *onto* the goods covered in the registration:

(i) AWS2 at page 4 at [4.4]:

“...there is no evidence the mark was even ever applied to the goods covered by the registration”;

(ii) AWS3 at page 7 at [9]:

“...there is not a single piece of evidence that the [Proprietors] applied the [Subject Mark to goods]”;

(iii) AWS3 at page 10 at [23]:

“Has the Registrant used the mark as a trade mark on the specified goods?”;

(iv) AWS3 at page 10 at [26]:

“...there is a strict need for the [Proprietors to meet their] burden of proof to show that the mark has been used as a trade mark on the specific goods”;

(v) AWS3 at page 11 at [28]:

“The reliance on Capitol Records...is misplaced where the [Proprietors have] not even shown that the [Subject Mark] is applied on goods as a trade mark”;

(vi) AWS3 at page 12 at [35]:

“...it is at this point that that the burden of proof to clearly show genuine use of the mark on the relevant goods in Singapore is increased to “overwhelming convincing proof”...”.

44 In addition to *Capitol Records*, there is no strict requirement to show that the Subject Mark has been applied *on / onto* the goods. If this is the requirement, section 22(1)(a) would have indicated as such. However, section 22(1)(a) 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...

[Emphasis in italics mine].

45 Further, section 22(2) provides:

22.— (2) For the purposes of subsection (1), ...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.

[Emphasis in italics mine]

Having regard to the word “includes”, applying the mark to the goods / materials are *not* exhaustive.

46 With regard to the applicability of section 116(g) of the EA, the learned PAR in the case of *Tan Jee Liang Trading As Yong Yew Trading Company v FMTM Distribution Ltd* [2016] SGIPOS 9 at [41] to [50], has provided (albeit *obiter dicta*) that the EA, does *not* apply to proceedings before IPOS, in particular, in relation to statutory declarations:

[52] In summary, my provisional views are as follows:

- a. SDs filed for the purposes of IPOS proceedings are *not* subject to Parts I, II and III of the EA. (See [41] – [50] above.)...

...

[56] For the avoidance of doubt, the views expressed in [41] to [55] above are provisional in nature and do not represent a final decision on the issue of whether the EA applies to IPOS generally.

[Emphasis in italics mine]

Whether the use is genuine

47 The Learned PAR has succinctly summarised some of the relevant legal principles in the recent decision of ***Bigfoot Internet Ventures Pte Ltd v Apple Inc*** [2017] SGIPOS 4 at [16]:

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

- 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 [quantitative] 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].) ...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.)

[Emphasis in italics mine]

48 Further, the Court of Appeal in *Petra* added at [122]:

[122] The question of whether there has been genuine use of a registered trade mark entails a *factual inquiry*. In *La Mer Technology Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2008] ETMR 9 at [57], which was cited in *Wing Joo Loong* at [41], the CFI elaborated on how an examination of whether a trade mark had been put to genuine use should be carried out:

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

[Emphasis in italics mine]

49 The Proprietors submitted at [26] of PWS1 that:

[26] The above evidence clearly demonstrates that there has been use of the [Subject Mark], in line with the uses as enumerated in section 27(4) of the Act, in the following material ways:

- (a) Sale and offering for sale of “**MYSTERY SET**” goods;
- (b) Importation and exportation of “**MYSTERY SET**” goods in and out of Singapore; and
- (c) Use of the “**MYSTERY SET**” mark on invoices.

50 The Applicants submitted that there is only one instance of use as only invoice 5003535 relates to a sale in Singapore (the address of the buyer is in Singapore – see [8] to [11] of AWS1) and the rest of the invoices were made out to buyers in Indonesia.

51 Further, these invoices only show use of the Subject Mark for the purposes of internal use, since there is a reference made to payment via ‘boutique account’ ([3.1] of AWS2). The Applicants argued ([12] of AWS1) that the indication “boutique account”

suggests that those instances are “business-to-business” transaction and possibly a sale to the Proprietors’ counter-part in Indonesia.

52 For ease of reference, the evidence above relating to the relevant periods is replicated below:

S/N	Date of invoice	Invoice No.	Description in Invoice	Price (SGD)	Method of Payment	Address of Buyer
<i>24 April 2008 to 23 April 2013</i>						
1	18 Nov 2010	5001663	Mystery Set	467,500.00	Boutique account	Indonesia
2	1 Aug 2011	5002236	Mystery Set	175,300.00	Boutique account	Indonesia
3	19 Sep 2011	5002402	Mystery Set	282,400.00	Boutique account	Indonesia
4	16 Dec 2011	5002617	Mystery Set	2,918,000.00	Boutique account	Indonesia
5	9 Oct 2012	5003535	Mystery Set	256,542.00	<i>Not indicated</i>	Singapore
<i>24 April 2013 to 30 June 2015</i>						
6	10 May 2013	5004330	Mystery Set / <i>Mysterious Setting</i>	757,009.00	<i>Not indicated</i>	Indonesia
7	12 Jun 2014	5005983	<i>Mysterious Setting</i>	1,126,497.00	<i>Not indicated</i>	Indonesia
8	14 Jan 2015	5006996	Mystery Set	1,300,000.00	<i>Not indicated</i>	<i>Not indicated</i>
9	24 Jun 2015	5007763	Mystery Set	700,000.00	<i>Not indicated</i>	Indonesia

53 The Proprietors argued that the fact that the buyers have an Indonesian address does not detract from the fact that they still reflect sales made in Singapore by the Proprietors ([42] of the PWS1). The Proprietors argued ([43] of the PWS1) that the Proprietors operate several retail shops offering for sale “Mystery Set” goods in Singapore. The invoices above all show the address of the Proprietors’ retail store address as the point of sale:

391 Orchard Road
#02-07/08 Ngee Ann City
Singapore 238872

Further the Proprietors pointed out that all the invoices indicated that the currency of the transaction is in Singapore dollars.

54 In support of their argument, the Proprietors referred to *Reemtsma Cigarettenfabriken GmbH v Hugo Boss AG* [2003] 4 SLR(R) 155 ([10] PWS2):

[14] Counsel for the applicant, Mr Low Chai Chong, drew my attention to the inadequacies of the respondent's affidavit evidence. Although Mr Low accepts that lighters are featured in the 1998/1999 and 1999/2000 catalogues, they do not prove that lighters were sold in Singapore. *Given the Hong Kong address and telephone/fax numbers printed on the order forms, the catalogues appeared to be for use in Hong Kong. There is no evidence that similar catalogues with pricing of the merchandise in Singapore dollars as well as the local addresses and telephone/fax numbers of the franchised shops in Singapore were despatched to Singapore, the manner of despatch, whether the catalogues reached Singapore or what was done with them.*

[Emphasis in italics mine].

55 The Proprietors further argued, at [14] of the PWS2, that even if the goods were intended solely for overseas markets, that is, for export purposes (which is not admitted), there is still use of the Subject Mark in Singapore. The Proprietors referred to section 22(2):

22.— (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.

[Emphasis in italics mine].

56 In addition, there is also no requirement that consumers in Singapore must have seen the products sold ([11] of the AWS1 and [3.2] of AWS2). I refer to *Law of Intellectual Property of Singapore* at [25.3.20]:

[25.3.20] ...These trademarked goods will *never* reach the end users or the retail market in Singapore⁹. This scenario is dealt with in s 22(2): it makes clear that application of the trade mark to these goods or its packaging constitutes use of the trade mark in Singapore.

[Emphasis in italics mine].

Further, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, Third Edition) by Tan Tee Jim, S.C. ("***Law of Trade Marks and Passing Off in Singapore***")

⁹ See also *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, Third Edition) by Tan Tee Jim, S.C. ("***Law of Trade Marks and Passing Off in Singapore***") at [9.072]:

[9.072] ...the import or export of goods bearing a trade mark can qualify as use (and also genuine use) of the mark if the import or export is part of a true entrepot trade and not a case of a proprietor importing and exporting back to himself or his associates to create a façade.

clarified that it does not matter that the export is to the Proprietors' or his related company overseas ([9.072] at footnote 123).

57 Thus, even if the Applicants' contention above is accepted (that the indication that payment made via "boutique account" implies that those instances are "business-to-business" transactions and possibly a sale to the Proprietors' counter-part in Indonesia), items 1 to 4, can still be taken into account on the basis that they were export transactions.

58 In the event that items 1 to 4 above are to be disregarded on the basis that they are internal transactions¹⁰, items 6 to 9 can be taken into consideration on the basis of section 22(3) above (replicated for ease of reference):

22.— (3) The registration of a trade mark shall *not* be revoked on the ground mentioned in paragraph (a)...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.

[Emphasis in italics mine].

59 The relevant transactions for the relevant period for the purposes of section 22(3) are:

S/N	Date of invoice	Invoice No.	Description	Price (SGD)	Method of Payment	Address of Buyer
<i>24 April 2013 to 30 June 2015</i>						
6	10 May 2013	5004330	Mystery Set <i>Mysterious Setting</i>	261,682.00 495,327.00	<i>Not indicated</i>	Indonesia
7	12 Jun 2014	5005983	<i>Mysterious Setting</i>	1,126,497.00	<i>Not indicated</i>	Indonesia
8	14 Jan 2015	5006996	Mystery Set	1,300,000.00	<i>Not indicated</i>	<i>Not indicated</i>
9	24 Jun 2015	5007763	Mystery Set	700,000.00	<i>Not indicated</i>	Indonesia

60 Two potential issues arise:

¹⁰ The Proprietors had tried to address the Applicants' argument by tendering evidence to the effect that goods bearing the Subject Mark were sold in Singapore, regardless of whether the customers were local or foreign (see [10] of the Proprietors' 2nd SD which made reference to [5] of the Applicants' 1st SD). While this is a statement made in the Proprietors' statutory declaration, the weight to be accorded to it will not be high as it is a bare statement without any corroborating evidence.

- (i) the marks in invoices 5004330 and 5005983 were partially¹¹ / totally described as *Mysterious Setting*.
- (ii) For the transaction under invoice 5006996, the address of the buyer has been redacted.

61 With regard to (i), the Proprietors indicated at [9] of the Proprietors' 1st SD that the trade mark has been erroneously referred to as "Mysterious Setting" rather than "Mystery Set". It seems to me that it is a typographical error, having regard to the fact that out of the two relevant items in invoice 5004330, only one item was incorrectly labelled. In any case, I am of the view that "Mysterious Setting" can be accepted on the basis of section 22(2) in that such use is in a form which does not alter the distinctive character of the Subject Mark¹²:

22.— (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...

[Emphasis in italics mine].

62 In relation to (ii), having regard to the fact that the point of sale was in Singapore and the transaction was in Singapore dollars, it is irrelevant where the buyer resides. After all, it is plausible that a tourist bought the product bearing the Subject Mark. Surely in such an instance, the sale can still be regarded to have been made in Singapore.

63 Even if I am wrong such that the items labelled as "Mysterious Setting" are to be disregarded, there are still two transactions, namely items 8 and 9 (invoices 5006996 and 5007763) where the goods were correctly labelled as "Mystery Set". To be precise, the transaction at item 6 (invoice 5004330) can partially be taken into account since one of the two relevant transactions in that invoice had correctly labelled the good with the Subject Mark. Thus, the relevant transactions for the period **24 April 2013 to 30 June 2015** are as follows:

S/N	Date of invoice	Invoice No.	Description	Price (SGD)	Method of Payment	Address of Buyer
24 April 2013 to 30 June 2015						
6	10 May 2013	5004330	Mystery Set	261,682.00	<i>Not indicated</i>	Indonesia
8	14 Jan 2015	5006996	Mystery Set	1,300,000.00	<i>Not indicated</i>	<i>Not indicated</i>

¹¹ "Partially" in that there are two potentially relevant items and one item is correctly described as the Subject Mark while the other has been described as *Mysterious Setting*. See more below.

¹² See more below where I indicated that I am of the view that the Subject Mark cannot be said to be descriptive of the relevant goods.

9	24 Jun 2015	5007763	Mystery Set	700,000.00	<i>Not indicated</i>	Indonesia
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64 Therefore, even in the Applicants' best case scenario, the *total* volume of transactions, in terms of sales value, for the following periods:

- (i) **24 April 2008 to 23 April 2013** (being the 5 year period since the completion of the registration procedure);
- (ii) **24 April 2013 to 30 June 2015** (being resumption of use under section 22(3))

are as follows:

S/N	Date of invoice	Invoice No.	Description	Price (SGD)	Method of Payment	Address of Buyer
24 April 2008 to 23 April 2013						
5	9 Oct 2012	5003535	Mystery Set	256,542.00	<i>Not indicated</i>	Singapore
24 April 2013 to 30 June 2015						
6	10 May 2013	5004330	Mystery Set	261,682.00	<i>Not indicated</i>	Indonesia
8	14 Jan 2015	5006996	Mystery Set	1,300,000.00	<i>Not indicated</i>	<i>Not indicated</i>
9	24 Jun 2015	5007763	Mystery Set	700,000.00	<i>Not indicated</i>	Indonesia

65 It has been indicated above that:

- (i) For use to be considered genuine, the use in question *does not have to be significant in the [quantitative] sense* provided it was in accordance with the *essential function of a trade mark* (i.e. to guarantee origin).
- (ii) There is no rule that *de minimis* use cannot constitute genuine use, such that one single use of the mark could satisfy the test provided that *overwhelmingly convincing proof* of the act is adduced.
- (iii) Crucially, the question of whether there has been genuine use of a registered trade mark entails a *factual inquiry*. That assessment entails a degree of *interdependence* among the factors taken into account.

Applying these principles to the transactions above, my comments are as follows.

66 As there is clearly more than one transaction (there are a total of four transactions for the period 2012 to 2015), there is no need to provide “overwhelming convincing proof”. At this juncture, it is apposite to deal with *Bentley Motors Limited v Aucera S.A.* [2016] SGIPOS 11 (“*Bentley*”) which the Applicants had relied on extensively ([19] of AWS1) for the following points:

- (i) The fact that goods are referred to by a particular name in an invoice does not always mean that the goods will bear that name (*Bentley* at [33]);
- (ii) The mere fact that the [Subject Mark] is used in invoices issued by just one single party, does not seem to...constitute overwhelmingly convincing proof (*Bentley* [34]). Specifically, the Applicants argued that this higher level standard of proof is applicable even if there is more than a single use (see [14] to [16] AWS3); and
- (iii) The fact that evidence for something which could easily be obtained by the Proprietors is not forthcoming from the Proprietors is an indication that the Proprietors have not done everything reasonably possible to prove its case to the level of being “overwhelmingly convincing” (*Bentley* [36]).

67 With regard to the first point, the learned PAR took pains to point out ([33] of *Bentley*):

[33] The fact that goods are referred to by a particular name in an invoice does not always mean that the goods will bear that name, and on the facts of this case, I do not think I can make this assumption. *I am not saying for a moment that use of a mark on an invoice can never amount to evidence showing use of the mark on the goods, only that in this case, I do not have evidence that such goods even exist.*

[Emphasis in italics mine].

68 With regard to the second and third points, it is noted that the learned PAR concluded as follows:

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

[Emphasis in italics mine].

Thus it would appear that the learned PAR did not apply the higher standard of “overwhelmingly convincing” proof in the end.

69 In any case, even if I am wrong and the learned PAR did apply the higher standard of “overwhelmingly convincing” proof in *Bentley*, I am of the view that the evidence tendered

in the current case exceeds that in *Bentley* such that the higher standard of “overwhelmingly convincing” proof does *not* apply. In this regard the specific circumstances of the case ([17] of PWS3) is as follows:

[23] Before I review the Proprietor’s evidence, I have two general observations about the Proprietor’s case...Secondly, the Proprietor’s entire case of use during the Relevant Period rests on the above *single chain of transactions*.

...

[25] I will not deal with each item of the evidence individually here but may refer to some of them later in my decision, except to say that *most* of the items of evidence either *do not relate* to use in Singapore, do not show use of the Subject Mark on the Goods or are undated, and are therefore not helpful to the Proprietor’s case. However, I will focus on the *first three items* of the evidence as the Proprietor’s case essentially hinges upon them.

[26] *Item 1* is an invoice issued by Yi Si Da to Kingdom Optical (S) dated 16 September 2013 and *item 2* is a consignee copy of a FedEx airway bill dated 17 September 2013 addressed to Kingdom Optical (S).

...

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

...

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

(a) *One act of import* of a quantity of 228 items of goods, with a consignment value of US\$6370 for goods with product codes bearing the BLO prefix

(b) *Two acts of sales* to local retailers amounting to a total quantity of 30 items of these goods for a value of S\$2092.92

...

[58] First and foremost, the period of the use in Singapore is *short*, amounting to a period of just 15 days (as evidenced at best) within the

relevant 5-year period...Coupled with this short period of activity is the unusual pattern of activity in the present case. There appears to be a *sudden rush of activity* in September to October 2013 to bring the goods into Singapore and to distribute the goods to local retailers but after the distribution there was an *equally sudden cessation to the use* in Singapore. These acts are not typically what one would expect to see as being consistent with an intention to establish a market in Singapore and would at least warrant some form of explanation from the Proprietor but none was provided. Neither did the Proprietor attempt to provide any reasons for non-use after 1 October 2013.

[Emphasis in italics mine].

70 In light of the above, it is no wonder that the learned PAR decided the way she did. The current case is clearly different. As has been shown above, there were several transactions spread out over a period of time, namely, October 2012 to June 2015.

71 In terms of the characteristics of the market, as the Proprietors argued at [32] of PSW1:

The singular sales of the “Mystery Set” goods by the [Proprietors] in the years...2012 can be justified by the fact that the goods sold under the “Mystery Set” mark are luxury goods...The [Proprietors’] mark is used on luxury items, not mass sale items. The former has [a] smaller consumer base than the latter.”

72 Further, at [33] of PWS1, the Proprietors submitted that the monetary value of the goods sold are by no means token. Taking the above four transactions, it amounted to a total of a hefty *SGD 2,518,224.00*, which averages out into *SGD 629,556.00 per year*.

73 The above stands in stark contrast to ***In the Matter Of Application No. 80118 by Societatea Comerciala “Farmec” SA for Revocation of Registration No. 1524782 standing in the name of S.C. Gerovital Cosmetics S.A. O-206-03 (“Farmec”)*** which the Applicants also relied on extensively ([21] to [23] AWS1). In this regard, I also agree with the Proprietors at [32] of the PWS3 that the main issue with ***Farmec*** is that there was no evidence that there was any payment made:

[17] I am prepared to accept that the items referred to in the English language invoices relate to goods that fall within the specification of the registration. Furthermore I have no reason to suppose that the transactions that are the subject of those invoices are in any way sham or ‘not genuine’ in a way that would immediately disqualify them from serving their intended purpose. But beyond that they fall some way short of persuading me that they are sufficient to show that a market has been created or preserved under the mark in this country. As the applicants point out *there is no evidence that the invoices were ever paid* unless one makes the inference that further orders would not have been taken until the first invoice was paid.

[Emphasis in italics mine].

74 Taking the relevant characteristics of the products or services on the relevant market into account, I am of the view that quantity as well as turnover of the relevant products constitute genuine use of the Subject Mark. In this regard, I agree with the Proprietors that the relevant goods are luxury items and as such have a smaller consumer base which justifies the low volume, high value transactions on an annual basis.

75 The last issue pertains to whether there was use of the Subject Mark in a trade mark sense. This is one of the main thrusts of the Applicants' attack. The Applicants argued and submitted evidence to the effect that there is descriptive use of the Subject Mark to refer to the method employed by jewellers for setting precious gemstones, usually rubies and sapphires, in close pattern such that one cannot see any trace of the metal prongs holding them together (AWS1 at [28]).

76 In this regard, I have already mentioned above that most of the evidence tendered by the Applicants (via pages of the exhibits) are to be disregarded as they are either dated out of the relevant periods or are undated.

77 Crucially, the Applicants argued ([30] of the AWS1) that even the Proprietors' themselves state as follows on their website (see Applicants' 1st SD at Exhibit GV-2 at page 63 – the excerpt is dated 27 May 2015):

“Mystery Set” *refers* to the unique technique associated with Van Cleef & Arpels ever since the Maison patented this dazzling invention in 1933. It consists of setting stones in such a way that no prongs are visible. The level of expertise required makes “Mystery Set” the exclusive realm of a very small number of master jewellers”

[Emphasis in italics mine]

78 I refer to pages 26 and 27 of Exhibit GV-1 of the Applicants' 1st SD, which is an article from “Luxury Jewels 24 Magazine”. It is unclear if the article is dated in the American style or British style. This issue is relevant as it determines whether it may be considered having regard to the relevant period **24 April 2013 to 30 June 2015**. If the American style is adopted, it would be dated 6 October 2015 which would fall out of the range. However, if the British style is adopted, the article would be dated as 10 June 2015 and can be taken into consideration.

79 As alluded to above, following general local convention, I will apply the British style and as such will discuss its relevance below. However, for the avoidance of doubt, in the event that I am wrong and the article should be disregarded, it does not affect my final decision¹³.

80 Coming back to the article:

¹³ This is because the content of this third party article simply corroborates the content on the Proprietors' own website (see below).

A Mystery Revealed: The Art and Innovation of Van Cleef and Arpels

[1] For centuries, the arts of precious metal jewelry creation and lapidary (hard stone carving) have formed a harmonious bond...Over the centuries, the artisan's abilities have become refined, in conjunction with the evolution of jewelry-making technologies, allowing for great advances in the art of gem cutting and jewelry production. One of these such advances is a variation of the channel setting technique, a practice perfected and patented by the legendary Paris atelier Van Cleef and Arpels in the early twentieth century. *Called mystère, or mystery setting*, the effect is a visually unbroken field of gemstones that appear to float on top of the supporting metal.

[2] *Patented in 1933, the mystery setting process innovated by Van Cleef and Arpels* begins with the art of lapidary...It is this delicate and meticulous cut that is crucial to creating the illusion of the seamless surface of the mystery setting.

[3] While the gemstones appear to be set with no visible mounting (hence, *the trade term "invisible setting"*), the complex process in the supporting metal beneath the gemstone contradict the effortless appearance...

[Emphasis in italics mine]

81 What can be gleaned from the above is that, (and this supports the content of the Proprietors' own website, discussed below):

- (i) "invisible setting" is the trade name of the technique where the gemstones appear to be set with no visible mounting;
- (ii) The Proprietors filed a patent for an "invisible setting" technique in 1933 and called it "Mystery Setting";

82 There is thus a need to emphasize that the *trade name* of the technique is "invisible setting" and the term "Mystery Setting" (or Mystery Set being the Subject Mark for that matter) is *coined* by the Proprietors to describe a variant of the technique which has been patented by them. Before I proceed any further, as indicated above, in relation to "Mystery Setting", I am of the view that "Mystery Setting" / "Mystery Set" all fall within section 22(2).

83 Further, I do not think the term "Mystery Set" or "Mystery Setting" / "Mysterious Setting" (see above) for that matter, can be regarded as descriptive of the particular mounting technique. It is not directly descriptive of the technique and thus it cannot be said to be descriptive of jewellery (specifically, a particular characteristic of jewellery / gemstones). Rather it describes the aura which is exuded by such a setting and thus can be considered to be allusive of the invisible setting technique and in turn, jewellery. In

particular, it looks as though there is nothing holding the gemstones such that there is a *mysterious* element as to the mounting technique / jewellery¹⁴.

84 Returning to the excerpt from the Proprietors' website above:

Mystery Set TM

"Mystery Set" refers to the unique technique associated with Van Cleef & Arpels ever since the Maison patented this dazzling invention in 1933. It consists of setting stones in such a way that no prongs are visible. The level of expertise required makes "Mystery Set" the exclusive realm of a very small number of master jewellers."

[Emphasis in italics mine]

85 My interpretation of the paragraph above is as follows¹⁵:

- (i) As mentioned above, the Subject Mark or *Mystery Set*, is at most *allusive* of the invisible mounting technique and thus the product, i.e. jewellery. The Proprietors had *conceived Mystery Set* to describe a variant of the technique which has been patented by them in 1933. In the context of the paragraph above, it is simply functioning as a trade mark identifying a particular product line of the Proprietors¹⁶.
- (ii) With regard to the reference to "master jewellers", in light of the context, it may be a reference to the master jewellers *within* the Proprietors' business.
- (iii) Last but not least, the Subject Mark has been annotated with the letters "TM" in superscript at the top of the website. This indicates the Proprietors' assertion that the Subject Mark is their trade mark.

86 The Proprietors at [38] and [39] of PWS2 referred to *Richemont International SA v Da Vinci Collections Pte Ltd* [2006] 4 SLR(R) 369 ("*Richemont*"), to support their argument that the mere fact that the Proprietors used the Subject Mark to differentiate a particular product line does not detract from the fact that the Subject Mark can serve to distinguish the Proprietors' jewellery in the "Mystery Set" line as an indicator of origin.

87 The following paragraphs from *Richemont* are particularly apposite:

¹⁴ The Proprietors also argued at [37] of PWS2 that the current action is a revocation action and not an invalidation action. However, there is no need to look into this in light of my conclusion that the Subject Mark is not descriptive of the product or a characteristic of the product.

¹⁵ The Applicants sought to rely on *Romanson Co., Ltd. v Festina Lotus, S.A.* [2015] SGIPOS3 at [115(iii)] for the proposition that there were no "active steps" taken in addition to the Proprietors' website ([31] of AWS1). However, this is not in issue here. The Proprietors had sought to rely, in the main, on their sales evidence as tendered via the Proprietors' 1st SD at Exhibit A.

¹⁶ This conclusion is also supported by the Proprietors' 2nd SD at [12].

[14] I now return to the question whether the Registered Mark could be said to have been put to genuine use where it appeared on the back of the watch while another trade mark “IWC” appeared on the face of the same watch. As earlier stated, it is well established in trade mark law that a product may have more than one trade mark. *Thus, secondary or even third-level product identifiers can function as trade marks if they indicate to the consumer that the product originates from a particular undertaking.*

[15] The case of *Safari Trade Mark* [2002] RPC 23 is instructive. That case concerned an application for revocation for non-use of the registered trade mark “Safari” on the basis, *inter alia*, that the mark “Safari” was being used as a description of the goods and not as a trade mark. The applicant argued that there was no “trade mark use” of the word “Safari” for two reasons: (a) the goods in question were identified primarily by the marks “Land Rover” and “Discovery”; and (b) *the word “Safari” was descriptive of the goods in respect of which the mark was used.* The Registrar hearing the matter held as follows at [21] and [22]:

Mr Blum submitted that the use shown by Rover Group Limited was not, in any event, used as a trade mark. As I understood it, this criticism took two forms. Firstly, that use of SAFARI was not used as a trade mark because the goods in question were primarily identified by the marks “Land Rover” and “Discovery”. *There is no rule that a secondary or even third level product identifier cannot be a trade mark.*

...The second leg of Mr Blum’s submissions is that the word SAFARI is descriptive of the goods in respect of which the mark was used: that the use of SAFARI was analogous to signs such as “five door” or “V8”. *It is not obvious to me what characteristic of the goods is described by the word “safari”. It is true that the promotion of the mark SAFARI by Rover Group Limited plays upon a safari “theme”.* The vehicle in question is said to come with a protection bar, running boards and a ladder, all of which may suggest that the vehicle is suitable for use on a safari. However, the vehicle also comes with metallic paint, five spoke sports alloy wheels, and a CD player. *The registered proprietor’s evidence suggests that Rover Group Limited used the mark SAFARI in a fanciful way in relation to a vehicle which whilst undoubted having off-road capabilities was, in reality, promoted as an up-market form of transport for the U.K. rather than as a specially adapted vehicle for use on “safari” in Africa or other distant places.*

[Emphasis in italics mine]

I agree. In this regard, I also agree with the Proprietors at [23] of PWS3 that the fact that ***Richemont*** involved a counter-claim for an order for revocation and a declaration of invalidity is irrelevant ([24] of AWS3).

88 The Applicants have also argued (see AWS2 at [2.3]) that the reference to the Subject Mark in the Proprietors’ invoices is merely a description of the composition of the item, for example, a ring. I am of the view that even if the invoice is describing the composition of a ring, this does not detract from the Subject Mark being used as a (subsidiary) mark in informing the would-be owner that the ring that he / she is intending to purchase comprises partly of the “Mystery Set” product line¹⁷.

89 Last but not least, another issue which is related to the claim that the Subject Mark is used in a descriptive sense is the Applicants’ claim of the interchangeable use of the Subject Mark with alternative descriptions to refer to a particular method of jewellery setting (see Part C of AWS1). The thrust of the objection here is that the Subject Mark has become a common name for invisible setting¹⁸. However, it is to be recalled the *sole* ground raised in this action is section 22(1)(a).

90 In *any* event, strong evidence is required to make out a case under section 22(1)(c). Specifically, it is not sufficient that a mark is a popular mark: see *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 853 at [59] and [66].

91 In conclusion, I am satisfied that the Subject Mark has been used in a trade mark sense based on the evidence tendered, specifically:

(i) the invoices below:

S/N	Date of invoice	Invoice No.	Description	Price ¹⁹ (SGD)	Method of Payment	Address of Buyer
24 April 2008 to 23 April 2013						
5	9 Oct 2012	5003535	Mystery Set	256,542.00	<i>Not indicated</i>	Singapore
24 April 2013 to 30 June 2015						
6	10 May 2013	5004330	Mystery Set	261,682.00	<i>Not indicated</i>	Indonesia
8	14 Jan 2015	5006996	Mystery Set	1,300,000.00	<i>Not indicated</i>	<i>Not indicated</i>

¹⁷ In this regard, I am also of the view that it is irrelevant whether the Subject Mark appears in the midst of other trade marks (see Applicants’ argument at [19] of AWS3).

¹⁸ In this regard, the Act provides under Section 22(1)(c):

The registration of a trade mark may be revoked on any of the following grounds:
that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered.

¹⁹ The relevant product is “jewellery” and as the Subject Mark is used for the purposes of identifying a particular line of product of the Proprietors and functions as a secondary mark, it would not be meaningful to apportion part of the sale price of a piece of item, for example, a ring, to those gems which form the subject matter of the Subject Mark.

9	24 Jun 2015	5007763	Mystery Set	700,000.00	<i>Not indicated</i>	Indonesia
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- (ii) the excerpt from the Proprietors’ own website (see [84] above); and
- (iii) the article *A Mystery Revealed: The Art and Innovation of Van Cleef and Arpels* (see [80] above).

92 In particular, the Subject Mark has been used in the invoices above to refer to a particular product line of the Proprietors, namely, *Mystery Set* gems or jewellery. The fact that the Subject Mark is used as a subsidiary mark, the main mark being “Van Cleef & Arpels” does not detract from the fact that it is being used in a trade mark sense.

93 Having regard to *all* of the above, I am of the view that there is solid and objective evidence that the Subject Mark has been used (in a trade mark sense) during the relevant period in Singapore such that Section 22(1)(a) has been made out in relation to “jewellery”²⁰.

Partial revocation

94 On the other hand, none of the invoices indicate the sale of watches ([7] of AWS1).

95 Section 22(6) provides:

22.— (6) Where grounds for revocation exist in respect of only *some* of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

[Emphasis in italics mine]

96 In this regard, at the hearing, the Proprietors conceded, applying *Bluestar*, that even if section 22(6) has not been specifically pleaded, the Registrar can still take into account of, and apply, the same:

[55] However, Mr Gill submitted that it was not open to Mr Wong to seek partial revocation because that part of the remaining prayer on which Mr Wong proceeded *ie* relying on s 22(1)(a) on the ground “that the mark has not been put to genuine use in the course of trade in Singapore in relation to some or all of the goods for which it is registered”, did not mention partial revocation. However, there was a reference therein to “some or all” of the goods. *I was of the view that the applicant was not precluded from attempting to rely on s 22(7) which could also be said to be ancillary to an attack under s 22(1)(a) although it would have been preferable if the application had specifically identified partial revocation as an alternative relief sought and the extent of such a relief.*

²⁰ The element of “consent” in section 22(1)(a) is not in issue here.

[Emphasis in italics mine]

97 For the avoidance of doubt, as alluded to above, it is on this same basis that Section 22(3) is applicable to the current case, even though it was not specifically pleaded.

98 Before I conclude, the Applicants had argued at [33] to [34] of AWS3 that the evidence tendered by the Proprietors is far from being “solid and objective”. In particular:

[34] While [the Proprietors’ evidence] are only 2 and 3 pages long respectively, Ms Gonnet was very careful not to state what [the Proprietors are] arguing in the Skeletal Rebuttal. But even if Ms Gonnet would have been clearer (and she is not), case law instructs that the proof required to show genuine use must be, at least, solid and objective...*Ms Gonnet is far from objective, being an employee of [the Proprietors]* and therefore with an interest in the outcome of these proceedings. The evidence provided by the SDs when [the Proprietors were] aware that [the Applicants are] clearly stating there is no application of the trade mark on any goods is far from being solid and as we stated above, simply non-existent.

[Emphasis in italics mine]

99 The requirement that the evidence tendered be “objective” does not necessitate that there must be evidence declared by third parties. While the deponent of the Proprietors’ evidence is an employee of the Proprietors, in making her declaration, she is subject to the penalties under the Oaths and Declarations Act (Cap 211). The Applicants have also not put forward any evidence that she is deliberately not being truthful.

Conclusion

100 The Proprietors have demonstrated use of the Subject Mark in Singapore within 5 years after the completion of registration for *jewellery* only, such that the application for revocation succeeds under Section 22(1)(a) of the Act in relation to *watches*. As such, the registration of the Subject Mark is revoked in relation to *watches* with effect from 1 October 2015, which is the date this application for revocation was filed.

101 The Applicants have only partially succeeded in their revocation, and further, in light of the unnecessary inconvenience which the Proprietors have put through (see [10] to [14] above), I am not inclined to award the Applicants full costs. I will hear parties further on costs.

Date of Issue: 16 June 2017