

## Intellectual Property Office of Singapore Case Summary: Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd [2017] SGIPOS 5

Source: <https://www.ipos.gov.sg/resources/hearing-mediation>

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The trade mark “BIG BOX” has been registered in Singapore since 26 January 2005, 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 registered proprietor is Big Box Corporation Pte Ltd (“the Proprietor”). The Proprietor opened a large warehouse retail mall under the “BIG BOX” 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.

Courts (Singapore) Pte Ltd (“Courts”) received a letter in early 2015 from the Proprietor of the “BIG BOX” registered trade mark warning that they were infringing the registered mark by advertising their Tampines store as “COURTS BIG BOX MEGASTORE”. However, no legal action for trade mark infringement was brought; instead Courts applied in March 2015 for a declaration that the trade mark should not have been allowed on the Register in 2005 and should be removed. It argued that “BIG BOX” was at that time: (a) descriptive of characteristics of the services for which it was registered, (b) that it had become customary in the current language and practices of the trade, and/or (c) it was devoid of distinctive character as an indication of the trade origin of the services for which it was registered.

Courts supported its application with evidence of the use of the term “big box” before and after 2005 as a description of a large retail or warehouse establishment, some from Singapore but also from elsewhere and particularly from North America.

In his Decision, the IP Adjudicator noted that there is no general duty imposed by the law on traders to check what is on the Trade Marks Register. Nevertheless, the (online) Trade Marks Register at IPOS plays an important role both in recording the trade marks that have been successfully registered 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 record of what those trade marks are. He cautioned that if traders do not check the Register periodically, they run the risk of being threatened (at the very least) with a legal action for infringement of someone else’s trade mark that they are not even aware is registered.

Considering it from the perspective of the average consumer in Singapore, who he characterised in this case as ‘the man and woman on the SBS Transit bus’, the IP Adjudicator was not persuaded by the evidence put forward by Courts that in 2005 he or she would have viewed “BIG BOX” as descriptive, generic or devoid of distinctive character as an indication of the trade origin of the retail services for which it was registered.

The application for the “BIG BOX” registered trade mark to be removed from the Register was therefore refused. However, the IP Adjudicator emphasised this did not mean that others could never use the words “big box” as a description of a large retail or warehouse establishment without infringing the Proprietor’s trade mark; whether they infringed would depend on all the circumstances as the Trade Marks Act provides honest traders with a defence if their use is genuinely as a description.

*Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.*