

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

Trade Mark No. T0902223J
2 April 2018

IN THE MATTER OF A TRADE MARK REGISTRATION

IN THE NAME OF

ATHLETA (ITM) INC.

AND

APPLICATION FOR REVOCATION THEREOF BY

BIGFOOT INTERNET VENTURES PTE. LTD.

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

Mr Alfean Samad (Bigfoot Internet Ventures Pte. Ltd.) for the Applicants

Mr Freddy Lim (Lee & Lee) for the Registered Proprietors

Cur Adv Vult

GROUND OF DECISION

1 Athleta (ITM) Inc. are the Registered Proprietors (“the Proprietors”) of the following trade mark:

ATHLETA

(“the Subject Mark”), registered in Class 25 in respect of “Clothing, footwear, headgear and clothing accessories” (“the Specification”) under Trade Mark No. T0902223J (“the Registration”). The date of completion of registration is 9 June 2009.

2 On 9 March 2017, Bigfoot Ventures Pte Ltd (“the Applicants”) filed an application for revocation of the Subject Mark on the grounds of non-use. The Proprietors filed their counter-statement and evidence in support on 3 July 2017. It was not mandatory for the Applicants to file any evidence in support of the application and indeed they did not do so. A Pre-Hearing Review was held on 6 December 2017. The matter was set down for a full hearing on 2 April 2018.

3 Parties elected to only file written submissions without appearing at the hearing to make oral submissions. After both parties filed their written submissions on 2 March 2018, the Proprietors filed written submissions in reply on 29 March 2018

Grounds of Revocation

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

Proprietors’ Evidence

5 The Proprietors’ evidence comprises a Statutory Declaration made by Patricia McMahon, Vice President of the Proprietors, on 28 June 2017 in San Francisco, California, United States of America (“McMahon’s SD”).

Burden of Proof

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

Background

7 The Proprietors are a Californian company founded in 1998. In 2008, the company was acquired and became a wholly-owned subsidiary of Gap Inc. and the “ATHLETA” brand was incorporated into Gap’s family of brands. The Proprietors claim to be one of the premier brands in the rapidly growing women’s sports and active apparel markets. Their goods are mainly sold through the online website www.athleta.com, which now redirects to <http://athleta.gap.com/> following the acquisition by Gap Inc. Shipment to more than 90 countries, including Singapore, is available. The Proprietors have no bricks-and-mortar retail outlets in Singapore, though they have more than 133 Athleta stores in major American cities.

MAIN DECISION

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

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

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

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

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

...

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

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

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

Relevant Dates

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

- (i) **Section 22(1)(a):** The registration procedure was completed on 9 June 2009. The 5-year period immediately following the completion of registration ended on 9 June 2014. Thus, the period of use (or non-use) in issue is 10 June 2009 to 9 June 2014 (the "First 5-Year Period").
- (ii) **Section 22(1)(b):** The application for revocation was filed on 9 March 2017. The 5-year period prior to this filing starts from 9 March 2012. The period of use (or non-use) in issue is 9 March 2012 to 8 March 2017 (the "Second 5-Year Period").

Legal Principles

10 The applicable legal principles are set out below.

- (i) There must be genuine or *bona fide* use of the trade mark in relation to the goods (or services), in the course of trade, within the relevant time periods. 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].)

- (ii) For use of a trade mark to be considered genuine, it does not have to be significant in the qualitative sense provided it was in accordance with the essential function of a trade mark, which is to guarantee trade 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 Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*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].)
- (iii) 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].)
- (iv) The fewer the acts of use relied on, the more solidly they need to be established. One single use of the mark could satisfy the test provided that overwhelmingly convincing proof of the act is adduced. (See *Nike* at [15].)

Decision on Section 22(1)(a) and (b)

11 To defend his registration successfully, a registered proprietor needs to show genuine use of his registered trade mark by him or with his consent, in relation to the relevant specification, in Singapore, within the relevant time period(s). Even if there is no use within the First 5-Year Period, Section 22(3) allows later use to “save” the registration subject to Section 22(4). (If there is no use, a registered proprietor would need to show proper reasons for non-use; but this is not pleaded and not relevant in the present case.)

The First 5-Year Period

12 [8] of McMahon’s SD declares that “the Respondent has maintained steady sales of its Athleta products to Singapore through its online website”; and the paragraph goes on to state the total sales value in Singapore between 2010 and 2016 as being “close to S\$190,000”, averaging “more than S\$25,000” per year. The transaction described in the following paragraphs is one example of use in the First 5-Year Period (from 10 June 2009 to 9 June 2014), and the only one that is substantiated by documentary support.

13 I turn my attention to the email correspondence dated 14 and 16 September 2013 between Gap Inc (of which the Proprietors are a wholly-owned subsidiary) and one Constance See, a customer of “ATHLETA” goods in Singapore.

14 The email of 14 September 2013 was from Ms See to Gap Inc’s customer service department. She writes:

Dear Gap

I did not receive the Pilayo Braid Headband. I had received the other items. Please check and let me know. Thanks.

Constance

In this email, the above message was followed by an order summary setting out the order date, merchant, order number, billing details, shipping details, payment details, order description, and order details (including the cost breakdown).

15 The email of 16 September 2013 was a reply to Ms See's email above. The customer service consultant writes:

Dear Constance,

Thank you for your email. Please accept our apologies for any confusion associated with your recent Athleta order #17F8YSM. As we were processing your order, we found that the head band was no longer available in the size and colour you requested. This resulted in this item being canceled from your order. We apologize for any disappointment this may cause. Please be assured that your order total has been adjusted to reflect any necessary changes.

We again apologise for any disappointment this causes. We hope you will visit our website at Athleta to place an order for alternate (*sic*) merchandise.

...

Sincerely,

Maliea
Customer Service Consultant

16 I observe a few things from this email correspondence:

- (i) While the customer wrote to Gap Inc, the customer service consultant's reply referred to "your recent Athleta order" and "our website at Athleta". The fact that the Proprietors' parent company, Gap Inc, is involved is no surprise. McMahon's SD explains the Proprietors' business model, especially post-acquisition by Gap Inc. In any case, it is clear from the official email reply that the order from Singapore relates to Athleta ("your recent Athleta order"), and the customer was encouraged to visit "our website at Athleta to place an order for alternate merchandise".
- (ii) The order description in Ms See's email shows that she placed orders for a T-shirt, a tank top, a pair of skorts (or *a* skort, depending on how one views the two-in-one apparel, essentially a pair of shorts covered by a flap in front to resemble a skirt) and a headband. The first three are clearly items of clothing; the last, an item of headgear and clothing accessory (the latter specifically as an item of headgear – since the term "clothing

- accessories” is broad and may fall under different classes depending on its nature). This corresponds to various goods items in the Specification.
- (iii) The shipping address is clearly in Singapore. Out of privacy concerns, this decision will not disclose Ms See’s address.
 - (iv) Ms See’s email clearly indicates that she has received the three items of clothing described in (ii) above.
 - (v) While she did not receive the headband, it is clear that Ms See was able to place an order for the item in the first place. The customer service response explains that the specific size and colour ordered was not available. It is reasonable to infer that this is probably an inventory issue, and not a case where the headband had never been available at all for order, purchase and shipment to Singapore. It is also plausible that headbands of *other* sizes or colours could be available for sale on the Proprietors’ website, hence the invitation to Ms See to visit the Athleta website to “place an order for alternate (*sic*) merchandise”. The High Court observed in *Weir Warman*, at [104], that “*It is, however, pertinent to note that it now seems fairly settled that genuine use can be established even if there is no evidence of actual sales being made...*” The present scenario seems such a case.

17 In light of the above, I conclude, on a balance of probabilities, that the Proprietors used the Subject Mark in Singapore on clothing, headgear and clothing accessories in the First 5-Year Period. This is evinced by the sale or making available for sale of these goods to a customer in Singapore.

The Second 5-Year Period

18 I now turn my attention to the Second 5-Year period from 9 March 2012 to 8 March 2017. The most relevant set of evidence of use is found in Exhibit 3 of McMahon’s SD. These are order confirmations (sent after customers make their orders) with details as follows:

S/N	Order Date	Order Number	Currency	Purchases
1	20 October 2014	TT8XQ47	SGD	4 items of clothing
2	18 November 2014	TT2ND1N	SGD	6 items of clothing
3	1 December 2014	TSSP573	SGD	3 items of clothing
4	17 December 2014	TSYTK4Q	SGD	6 items of clothing
5	3 February 2015	TSXXKY2	USD	13 items of clothing
6	3 May 2015	TS5MWGT	SGD	5 items of clothing
7	10 October 2015	TRVHCW3	SGD	4 items of clothing
8	2 January 2016	TQL876D	USD	3 items of clothing
9	23 April 2016	TQ4FSXH	USD	4 items of clothing
10	10 July 2016	TPMK964	SGD	4 items of clothing
11	18 November 2016	TYT4CNL	SGD	3 items of clothing 3 items of headgear / clothing accessories (headbands)

12	2 January 2017	TYHM559	SGD	5 items of clothing
13	2 March 2017	TY9H8SC	USD	15 items of clothing

19 The following observations can be made of the evidence relating to the above transactions:

- (i) At the top of each order confirmation is a ribbon of *five* marks / brands: Gap, Old Navy, Banana Republic, Piperlime and Athleta. The first sentence of each order confirmation says “Thank you for shopping with Gap Inc.” Thus, viewed on their own in isolation, the above order confirmations do not unequivocally point to the use of the Subject Mark in relation to clothing and headgear. However, the Proprietors have also taken care to reproduce, at Exhibit 3 of McMahon’s SD, a sampling of online product listings from <http://athleta.gap.com/> that correspond to the items ordered. These product listings show the name of the product in question, photographs, price, available colours, customer reviews and other related information. Importantly, the Subject Mark appears prominently next to the product name at the top left corner of each online product printout e.g. “Chaturanga Yoga Knicker | Athleta”, “Camo Fastest Track Muscle Tank | Athleta”. The Subject Mark also appears centrally above the navigation bar of the Proprietors’ website, and cannot be missed by users when they visit the website. Therefore, when the order confirmations are interpreted with the Athleta website product listings, I am persuaded that the above transactions relate to goods sold in relation to the Subject Mark.
- (ii) The orders were made in respect of items of clothing and headgear / clothing accessories. These descriptions are found in the Specification.
- (iii) All the order confirmations show shipping addresses in Singapore. In other words, the Athleta goods ordered are due to be shipped to Singapore.
- (iv) No doubt the order confirmations strictly only show that Athleta goods have been ordered and will be shipped to Singapore. They do not show that the goods reached the customers in Singapore. However, the Proprietors have exhibited, by way of example, a complete set of transaction documents to substantiate one particular sale. The documents comprise (1) an order confirmation with order number TNPN8W9, showing the customer’s name, one Ms Naomi Woldemar, the shipping address in Singapore and two items of clothing ordered on 25 May 2017, (2) a printout from the Proprietors’ order management system reflecting the same order number, customer name, shipping address, order date and two items of clothing ordered; and an additional reference number called the “Borderfree Order #: E4X001039251475” and (3) a shipping tracking record with a reference number E4X001039251475 that showed successful delivery to the customer in Singapore on 9 June 2017. The eagle-eyed reader will realise that this transaction takes place *after* the Second 5-Year Period. However, the value of this chain of transaction documents is not to show the specific instance of sale under order number TNPN8W9. Rather, it is to demonstrate that the Proprietors have in place a logistical structure to process orders from Singapore and deliver the ordered goods to Singapore. There is no reason for me to believe that a system to process orders and deliver goods to Singapore did not exist

before 25 May 2017 such that the thirteen orders tabulated above were not fulfilled by the Proprietors. On the contrary, especially having regard to the span of the thirteen orders over time from 2014 to 2017, by thirteen distinct customers with thirteen distinct shipping addresses in Singapore, and the variety of clothing and headgear items ordered, the reasonable inference from the totality of evidence is that the orders were *bona fide* and very likely to be fulfilled if the ordered goods were in stock.

20 Thus, I am persuaded that the Proprietors used the Subject Mark in Singapore on clothing, headgear and clothing accessories in the Second 5-Year Period.

Conclusion under Section 22(1)(a) and (b)

21 The Specification reads “Clothing, footwear, headgear and clothing accessories”. The Proprietors have established use of the Subject Mark in Singapore in respect of clothing, headgear and clothing accessories in both the First and Second 5-Year Periods. However, they have not done so in respect of footwear, which is also covered by the Specification. Section 22(6) provides that:

(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.

22 The Applicants are therefore partially successful in their revocation under Section 22(1)(a) and (b) in respect of “footwear”.

23 The critical issues of this revocation action have been determined. However, I will go on to address, in passing, other related issues that have arisen in the course of the parties’ submissions.

Must Evidence of Use Originate From an Independent Third Party to be Reliable?

24 The Applicants argue that McMahon’s SD does not originate from an independent third party, and as such, has low probative evidential value towards indicating genuine use of the Subject Mark. They claim that this is due to the notion that the perception of an involved party in the current proceedings may be affected by its personal interests in the matter.

25 The Applicants are misguided in this respect. As observed at [6], the Proprietors have the burden of showing the use made of the Subject Mark in Singapore. Registered proprietors are in a better position to prove use (a positive proposition) than applicants for revocation are in, to prove non-use (a negative proposition). To establish *bona fide* use, regard is commonly had to transactions relevant to actual use, such as marketing, advertising, distributorship, sales, payment, shipment and delivery. Registered proprietors themselves would be in one of the best positions, if not the best position, to adduce evidence relating to these transactions, to support their claim to have used their registered marks. Perhaps the Applicants had thought that the actual customers in Singapore could have made statutory declarations instead. While this is not impossible, such customers would not be privy to certain information on the use of the Subject Mark: for example, McMahon’s SD exhibits transactional documents that customers

would not have (printout from the Proprietors' order management system at page 66 of Exhibit 3, shipping tracking records at page 70 of Exhibit 3); as well as total sales figures to customers in Singapore at [8] of McMahon's SD. As to the Applicants' concern that "the perception of an involved party in the current proceedings may be affected", the evidence in a defence against revocation has to come from more than "perception". As referred to above, McMahon's SD declares the total sales figures in Singapore and exhibits relevant transactional documents relating to sales in Singapore. Regardless of the "perception" of a deponent, these items of evidence are relatively objective and not so vulnerable to a deponent's "perception" (unless the deponent decides not to adduce such evidence at all, which is not realistic because it would be counter-productive to the party's defence against revocation).

26 More generally, there is no requirement that evidence tendered in support of one party's position must be from an independent third party to be reliable. Although Patricia McMahon is Vice President of the Proprietors, in making her declaration, she is subject to the penalties under the Oaths and Declarations Act (Cap 211, 2001 Rev Ed): Section 14(1)(a) read with Section 14(3). The Applicants have also not put forth any evidence that she had not been truthful. In *FMTM Distribution Limited v Van Cleef & Arpels S.A.* [2017] SGIPOS 6 ("*Van Cleef & Arpels*"), the Principal Assistant Registrar said at [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.

27 The Applicants' objection here cannot stand.

Website Use and "Active Step"

28 The Applicants contend that the Proprietors' website does not show genuine use in Singapore because no "active step" was taken to target consumers in Singapore. The facts that the website is accessible from Singapore, and that it is possible to view the prices of the Athleta goods in Singapore dollars, are inconclusive in showing actual and active advertising in Singapore.

29 The issue of internet use has been discussed in *Autozone Automotive Enterprise v Autozone Parts, Inc* [2013] SGIPOS where, at [47], I cited *Weir Warman* for the principles:

The legal position in Singapore is clear. The learned VK Rajah JA opined in *Weir Warman* at [106]-[108] as follows:

106 In *800-Flowers Trade Mark* [2002] FSR 12, Buxton LJ discussed the offer of goods under a trade mark on an Internet website. He stated at 220:

There is something inherently unrealistic in saying that A "uses" his mark in the United Kingdom when all that he does is to place the mark

on the Internet, from a location outside the United Kingdom, and simply wait in the hope that someone from the United Kingdom will download it and thereby create use on the part of A.

He added further on the same page:

[T]he very idea of "use" within a certain area would seem to require some active step in that area on the part of the user that goes beyond providing facilities that enable others to bring the mark into the area. Of course, if persons in the United Kingdom seek the mark on the Internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the advertisement or encouragement in itself is likely to suffice to establish the necessary use. [emphasis added]

This succinct summary of the English position is persuasively logical and ought to be followed in Singapore.

30 In finding that the Proprietors have used the Subject Mark in Singapore above, I have not relied on their evidence of purported advertising on their website. I am aware that their website printouts post-dated both the First and Second 5-Year Periods; and in any case, there was better evidence of use, that of actual sales in a series of transactions over the years. In passing, I would suggest that registered proprietors defending revocation actions adduce website printouts within the relevant time periods instead. One useful tool is the Wayback Machine (wayback.com), a digital archive which enables users to see archived versions of webpages across time.

31 In the instant case, the sustained sales over a number of years could indicate that the Proprietors' website did directly encourage customers in Singapore to make their purchases of Athleta goods. Alternatively, the sustained sales may lead one to infer that the Subject Mark is already in the consciousness of some customers in Singapore because of the Proprietors' encouragement and advertisement in the past (e.g. in the case of expatriate customers who have relocated to Singapore, who still order Athleta goods), and the Proprietors cater to this demand for their goods by making it possible to place orders from Singapore on their website. In any case, since I have not relied on "website use" to find some use of the Subject Mark, nothing turns on this and I make no finding on whether there had been any "active step" taken by the Proprietors to target customers in Singapore through their website.

32 I further address another issue relating to the Proprietors' website. The Applicants' written submissions point out that there was no use of the Subject Mark in relation to footwear. I have made the same observation, and the attendant finding, above. The Proprietors' written submissions in reply attempt to plug this gap in their evidence in McMahon's SD. First, the Proprietors point out that the printouts from <http://athleta.gap.com/> in McMahon's SD show various product categories at the top of the webpages, one of which is "Shoes & Accessories". Second, they append screenshots of the webpages when the "Shoes & Accessories" tab is clicked. These website printouts were not adduced in evidence but the Proprietors attempt to surmount this difficulty by submitting that their website as a whole had already been adduced in evidence in McMahon's SD. I reject this latter argument, being mindful, particularly,

that websites are dynamic media that can change very quickly. If any party desires to rely on specific content on a webpage from a website, it has to adduce that very webpage in evidence, and such content must be within the relevant time period.

33 In any case, for the satisfaction of the Proprietors, I have seen the purported use of the Subject Mark under the “Shoes & Accessories” tab described above. A closer look at the screenshots, despite the tiny font size of 1 mm in height, discloses that the shoes on sale were of other brands, namely New Balance, Asics and Adidas. None of the shoes show use of the Subject Mark. If they indeed used the Subject Mark on footwear, the Proprietors have not put this in evidence and I cannot find use on this count.

34 Still on the subject of website use, I will also briefly comment on the Proprietors’ reliance on purported use of the Subject Mark in Singapore through the Krisflyer Spree website at <https://www.krisflyerspree.com/sport-and-fitness/athleta>. The evidence in this regard is sparse, thus attracting challenge from the Applicants. The most salient aspects of this evidence are that the Subject Mark appears in the website printout; there is a reference to *Singapore Airlines*; and that the description makes reference to the goods as apparel (“we fashion our apparel to take on your entire active lifestyle... Our apparel is designed and developed by women athletes for women athletes”). As I have not relied on this item of evidence in finding some use of the Subject Mark, suffice it to say that the Proprietors could have given more details in evidence on the customer profile of KrisFlyer Spree to establish a nexus between the online advertisement and the purported target audience from Singapore. They should also use online printouts that are within the First and Second 5-Year Periods as the use to be shown needs to fall within these time periods.

Must the Proprietors Have a Physical Presence in Singapore? Must Goods Bearing the Subject Mark be Sold at Physical Locations in Singapore?

35 The Applicants take issue with the Proprietors not having a physical presence in Singapore, not even through a local distributor. They point out that the customer service contact for customers in Singapore is still a US telephone number, and that goods have to be returned to the US, not Singapore, for a refund. These indicate that the Proprietors do not have an operations base in Singapore for the Singapore consumer. They purport to cast doubt on the Proprietors’ evidence by submitting that “*Most importantly, the Proprietor has remained silent on whether goods bearing the Subject Mark can be purchased as (sic) physical location (sic) within Singapore ... The lack of evidence pertaining to goods bearing the Subject Mark sold at physical locations in Singapore is indicative that there are none, and as such, there (sic) Subject Mark has not been genuine (sic) used in Singapore, in the course of trade*”.

36 The Applicants’ concept of genuine use is too narrow. The crux of genuine use is that it must be “*consistent with the essential function of a trade mark*”. **Weir Warman** at [109] categorically states:

Once the mark was communicated to a third party in such a way as can be said to be “consistent with the essential function of a trade mark” (i.e., as a badge of origin), that would be “genuine” use for the purposes of revocation...

37 Thus, despite the Proprietors not having physical retail outlets, distributors or operations in Singapore, I am persuaded of genuine sales transactions between them and customers in Singapore, and have found that they have used the Subject Mark in Singapore to some extent.

Effective Date of Revocation

38 In their pleadings, the Applicants prayed for the revocation to take effect from 10 June 2009, just one day after the date of completion of the registration of the Subject Mark.

39 Section 22(7) of the Act reads:

22. –(7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –
(a) the date of the application for revocation, or
(b) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

40 The above provision makes clear that the effective date of revocation can take effect from the date of the application for revocation (Section 22(7)(a)) or from an earlier date if the grounds for revocation existed at that earlier date (Section 22(7)(b)).

41 The Applicants’ proposition had also been canvassed by another applicant for revocation in an unrelated case. *New Yorker S.H.K. Jeans Gmbh & Co. KG v Daidoh Limited* [2017] SGIPOS 16 (“*New Yorker*”) discusses the effective date of revocation at [5] – [6]:

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

6 ... I drew the parties’ attention to HMD Practice Circular No.1/2012 which stated, among other things, that where the registered mark sought to be revoked has never been put into use, the earliest possible effective date of revocation for non-use would be “*the date immediately following the fifth anniversary of the date of completion of the registration procedure*”.

42 Here, the date of completion of registration procedure for the Subject Mark was 9 June 2009. The relevant period of non-use of the Subject Mark is from 10 June 2009 to 9 June 2014 (“grace period”). Therefore, the earliest possible effective date for revocation is 10 June 2014. The Registrar has no power to grant an order for revocation to take effect on 10 June 2009, a day which still falls within the grace period.

Order for Revocation

43 The Proprietors have only shown use of the Subject Mark in Singapore during the First 5-Year Period and the Second 5-Year Period in respect of “clothing”, “headgear” and “clothing accessories” but not “footwear”. As such, the Applicants succeed partially under Section 22(1)(a) and (b). Accordingly, the Registration is partially revoked in respect of “footwear” in Class 25 from the earliest possible effective date of 10 June 2014.

Costs

44 The parties were directed on 6 March 2018 to make further written submissions on the issue of costs in the event of partial revocation. The Proprietors submitted, in writing on 13 March 2018, that no order as to costs should be made given that neither party has fully prevailed. On the other hand, the Applicants submitted, also on 13 March 2018, that costs should be awarded proportionate to their success in partially revoking the registration.

45 I have considered and adopt the approach of this tribunal in recent unreported decisions on costs, following findings of partial revocations (*Van Cleef & Arpels* and *New Yorker*). The approach can be understood as follows.

46 This dispute is by nature an application for revocation, initiated by the Applicants and defended by the Proprietors. The principle is that, ordinarily, in the absence of other intervening factors, costs follow the event. Here, the event is a (partially successful) revocation action. Hence, costs should be awarded to the Applicants.

47 What percentage of costs to be awarded is a distinct issue that follows a decision to award costs to the successful initiator of the action. In the present case, the Applicants succeeded to a limited extent in that the registration is partially revoked in respect of “footwear”, out of the original specification of “Clothing, footwear, headgear and clothing accessories”. This is not a strict numbers game with a rigid mathematical formula based on the number of goods items revoked out of the total number of goods items in the original specification. I have taken into account the substance of the Applicants’ challenge to the Registration. They have chosen to belabour a significant number of points that are non-starters, and can hardly expect to receive contribution in costs for such in a costs award.

48 The Applicants are hereby awarded 20% of their costs, to be taxed, if not agreed.

Date of Issue: 2 July 2018