

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

Trade Mark Nos. T8802249B, T0808259J and T0404547Z
29 June 2021

IN THE MATTER OF TRADE MARK REGISTRATIONS

IN THE NAME OF

UNILEVER PLC

AND

APPLICATIONS FOR REVOCATION THEREOF BY

TECHNOPHARMA LIMITED

Hearing Officer: Burton Ong
 IP Adjudicator

Representation:

Ms Ang Su-Lin and Ms Michelle Loi Choi Sieng (K L Tan & Associates) for the Applicants
Mr Kong Xie Shern (Wong & Leow LLC) for the Registered Proprietors

GROUND OF DECISION

1 Use it or lose it. Therein lies the crux of the statutory provisions found in the Singapore Trade Marks Act that allow for the revocation of registered trade marks that have not been put to “genuine use” in Singapore. Once they have been registered, trade marks have a potentially indefinite lifespan as long as the appropriate renewal fees and formalities are satisfied every ten years. By remaining on the trade marks register, such trade marks carve out a zone of exclusivity for their respective registered proprietors and operate as legal impediments to other traders seeking to register or utilise marks of their own that are identical or similar to the registered trade mark. This can be a source of commercial inconvenience to other traders seeking to subsequently enter the Singapore market with new products which have been developed or marketed elsewhere using marks that are similar or identical to trade marks that have already been registered in Singapore. One strategy for the new market entrant is to remove the earlier trade mark from the trade marks register by pursuing trade mark revocation

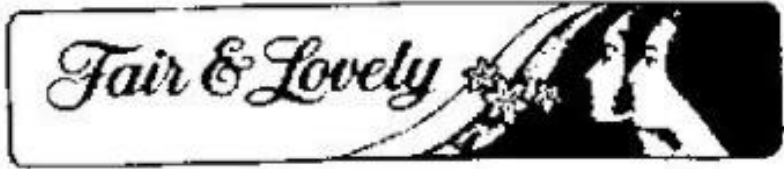
proceedings on the grounds that this conflicting trade mark has not been put to “genuine use” in Singapore in accordance with Sections 22(1)(a) and 22(1)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”). Non-use of a registered trade mark thus provides a legal basis for the forfeiture of a registered proprietor’s rights in that registered trade mark. This appears to be the commercial context in which the present case has emerged.

2 Aphorisms aside, the task of proving actual use of the registered trade mark, as required under the TMA in order to resist the revocation proceedings that have been invoked against it, can pose practical difficulties to a registered proprietor that are more challenging than might be immediately apparent. To begin with, the trade mark may have been registered decades ago, and records of its use by the registered proprietor may not have been accurately documented or catalogued. Different branding strategies that are pursued over the years may have resulted in alterations to the way the trade mark is applied to the proprietor’s goods, resulting in deviations from the form in which that mark appears on the register. These can raise tricky questions about whether the mark which has been actually used is *the* registered trade mark. The situation is further complicated when the registered proprietor is a multi-national corporate entity operating in multiple markets, managing multiple trade mark portfolios in dozens of jurisdictions with variations of the mark registered in different national trade mark offices. Goods bearing these trade mark variants, which have been developed primarily for consumption in much larger foreign consumer markets, might also be distributed in Singapore or find their way here via parallel importation. This raises the question of whether usage of these variant marks can be relied upon as evidence of use of the proprietor’s *Singapore trade marks*, which have been registered on the Singapore trade marks register in forms that are different from how they are registered as trade marks in other countries.

3 This decision addresses some of these questions within the context of an application made to the Singapore Registrar of Trade Marks to revoke a registered trade mark on grounds of non-use. In so doing, we will encounter issues of “trade mark metaphysics” that are an unintended consequence of the commercial complexities of modern-day cross-border trade, with seemingly mundane issues of trade mark usage posing conceptually challenging issues for Singapore’s trade mark law framework. In particular, the prevalence of trade mark usage by parallel importers of a registered trade mark raises legal questions that that deserve closer scrutiny in light of Singapore’s liberal trade policies which favour the unrestricted movement of genuine trade mark-bearing goods into Singapore, as exemplified by the principle of international trade mark exhaustion embedded within the TMA. To what extent can the registered proprietor rely on an unrelated third party’s use of its registered trade mark to establish “genuine use” of the registered trade mark? In what circumstances should a third party’s use of a registered trade mark be regarded as having occurred with the “consent” of the registered proprietor, thereby allowing the registered proprietor to rely on such usage as a basis for resisting an attempt to revoke its trade mark on grounds of non-use?

4 Unilever PLC are the Registered Proprietors (“the Proprietors”) of the following trade marks in Singapore:

Trade Mark No.	T8802249B
Registration Completion Date	20 July 1990

Mark	
Class	3
Specification	Soaps, cosmetics, skin creams and lotions, non-medicated toilet preparations.

Trade Mark No.	T0808259J
Registration Completion Date	16 October 2008
Mark (series of 2)	
Class	3
Specification	Soaps; essential oils; bath and shower preparations [non-medicated]; skin care preparations [non-medicated]; oils, creams and lotions for the skin [non-medicated]; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations [cosmetic]; cosmetics; make-up and make-up removing preparations; petroleum jelly [for cosmetic use]; lip care preparations [non-medicated]; talcum powder; cotton wool, cotton sticks [for cosmetic use]; cosmetic pads, tissues or wipes, all impregnated with non-medicated preparations for personal use; cleansing pads, tissues or wipes, pre-moistened or impregnated with cosmetic preparations; beauty masks, facial packs [cosmetic].

Trade Mark No.	T0404547Z
Registration Completion Date	24 September 2012
Mark	FAIR & LOVELY
Class	3
Specification	Perfumery; essential oils; deodorants and antiperspirants; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; cotton wool, cotton sticks.

(collectively referred to as “Subject Marks”)

5 For the purposes of this decision, T8802249B shall be referred to as the “Logo Mark”, T0808259J shall be referred to as the “Series Mark”, while T0404547Z shall be referred to as the “Word Mark”.

6 On 12 September 2019, Technopharma Limited (“the Applicants”) filed applications for revocation of the Subject Marks on the grounds of non-use. The Proprietors filed their counter-statements and evidence in support on 13 January 2020. It was not mandatory for the Applicant to file any evidence in support of the applications and indeed they did not do so. A pre-hearing review was held on 16 September 2020. The Applicants made a request for leave to amend their statements of grounds. Leave was granted to the Applicants to file their amended statements of grounds and these were filed on 21 April 2021. The parties made their oral submissions before me on 29 June 2021.

Grounds of Revocation

7 The Applicants rely on Sections 22(1)(a) and 22(1)(b) of the TMA in this revocation.

Proprietors’ Evidence

8 The Proprietors’ evidence comprises a Statutory Declaration made by Adam Wilder, Senior IP Counsel of the Proprietors (“Proprietors’ SD”), on 10 January 2020 in the United Kingdom.

Burden of Proof

9 Under Section 105 TMA, the Proprietors have the burden of showing that they have made genuine use of the Subject Marks in Singapore. The Applicants are not obliged to file any evidence to support their allegations of non-use, which can be rationalised on the basis that they cannot be expected to prove that something has not happened. It is clear, however, that the Applicants are entitled to challenge the adequacy of the evidence adduced by the Proprietors to the extent that what is disclosed in the Proprietors’ SD does not establish, on a balance of probabilities, that there has been actual use of the Subject Marks that falls within the scope of Sections 22(1)(a) and 22(1)(b) TMA.

Background

10 The Proprietors are a global consumer goods company, incorporated in the United Kingdom, whose business spans multiple product categories, including nutrition, hygiene and personal care. The Subject Marks owned by the Proprietors are associated with their skincare products which are marketed under the “Fair & Lovely” brand. The products under this brand have been produced and sold around the world since 1978. It is unclear when this line of skincare products was first available in Singapore. The Proprietors have asserted that these goods have been sold to Singapore customers through the following third party physical distribution channels and online sales channels, including internet-based retailers and electronic commerce (“e-commerce”) platforms.

Sales channels for Proprietors' "Fair & Lovely" brand of skin care products	Source
<p>Physical distribution channels (Proprietors' products sold to and by business-customers and distributors with physical stores in Singapore):</p> <ul style="list-style-type: none"> (i) Mohamed Mustafa & Samsuddin Co. Pte Ltd (ii) Hup Hin Ho (iii) Jothi Store and Flower Shop (iv) Classic Consumer Products Pte Ltd (v) U Distribution Pte Ltd (vi) CMM Marketing Management Pte Ltd 	<p>Proprietors' SD [10]-[26]</p> <p>[AW7, 269-274]: Sales volume [AW8, 276-277]: Sales volume [AW9, 279-333]: Delivery orders to distributors [AW10, 335-358]: Invoices to distributors [AW11, 360-362]: Letters and proposals to distributors</p>
<p>Online sales channels (including online retailers, websites operated by brick-and-mortar businesses and e-commerce platforms):</p> <ul style="list-style-type: none"> (i) www.indianproducts.com.sg (ii) www.jothi.com.sg (iii) www.qoo10.sg (iv) www.shopee.sg (v) www.lazada.sg 	<p>Proprietors' SD [9]-[10] and [28]</p> <p>[AW12, 364-369] [AW12, 370-373] [AW12, 374-376] [AW12, 377-378] [AW12, 379-380]</p>

11 Images of the product packaging bearing the Proprietors' trade marks that were distributed through the sales channels above are depicted in the Annexes of the Proprietors' SD. Unfortunately, the low resolution of many of the photographic images and the absence of any written details describing the products depicted in these images make it difficult to definitively identify each and every item, though they all appear to belong to the "Fair & Lovely" line of skincare products. These include fairness-themed face creams and face cleansing products.

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Images of product packaging appearing online at www.indianproducts.com.sg [AW12 – 365-367]



Images of product packaging appearing online at www.jothi.com.sg [AW12 – 371]



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Images of product packaging appearing online at www.qoo10.sg [AW12 – 374]



Images of product packaging appearing online at www.shopee.sg [AW12 – 377]



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Images of product packaging appearing online at www.lazada.sg [AW12 – 379]



12 The Applicants are a United Kingdom company that is part of a corporate group specialising in “skin whitening products” whose business activities have hitherto focused on the American and Caribbean markets. As part of its strategy to expand its trade beyond the Western hemisphere, the group developed a “NEW YORK FAIR & LOVELY” brand which the Applicant sought to register in Singapore (in Classes 3 and 5). Citing their own Subject Marks, the Proprietors opposed the Applicants’ application to register the mark “NEW YORK FAIR & LOVELY”. The Applicants then commenced the present trade mark revocation proceedings against the Proprietors on 12 November 2019 in response to those prior opposition proceedings, which have been held in abeyance pending the resolution of the present revocation action.

MAIN DECISION

Ground of Revocation under Sections 22(1)(a) and 22(1)(b)

13 Sections 22(1)(a), 22(1)(b) and 22(2) TMA stipulate that:

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.

...

(emphasis mine)

14 While the language of Section 22(1)(a) TMA indicates that the registration of the trade mark “may” be revoked on grounds of non-use of the registered trade mark, the Singapore courts have taken the clear position that the statutory directive to rescind the trade mark registration is not discretionary.¹ Instead, once it is established that a registered trade mark has not been put to “genuine use” in Singapore in respect of some or all of the goods and services specified in the registration, that registration must, accordingly, be fully or partially revoked.

15 While “genuine use” of a trade mark for the purposes of Section 22(1)(a) TMA entails the registered proprietor putting to use *a trade mark* which is in the same form as it appears on the trade marks register (i.e. in the *registered form* of the trade mark), Section 22(2) TMA also provides some leeway for use of *a trade mark* “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.” Any non-facsimile uses of a trade mark in forms that *do not alter the distinctive character* of the registered form of the mark also qualify as instances of “genuine use” of the registered trade mark that can defeat an action for trade mark revocation.

Relevant Dates

16 In line with the parameters of the Applicants’ pleadings, the relevant dates under consideration for the Subject Marks are as follows:

T8802249B (The Logo Mark)

(a) **Section 22(1)(a)**: The registration procedure was completed on 20 July 1990. The 5-year period immediately following the completion of registration ended on 20 July 1995. Thus, the period of use (or non-use) in issue is 21 July 1990 to 20 July 1995 (the “First 5-Year Period” for the Logo Mark).

(b) **Section 22(1)(b)**: The Applicants stated in paragraph 2 of the statement of grounds the following periods of use (or non-use) in issue:

(i) 29 December 2009 to 28 December 2014

(ii) 12 September 2014 to 11 September 2019

(the “Subsequent 5-Year Periods” for the Logo Mark)

T0808259J (The Series Mark)

(a) **Section 22(1)(a)**: The registration procedure was completed on 16 October 2008. The 5-year period immediately following the completion of registration ended on 16 October 2013. Thus, the period of use (or non-use) in issue is 17 October 2008 to 16 October 2013 (the “First 5-Year Period” for the Series Mark).

¹ *Reemtsma Cigarettenfabriken GmbH v Hugo Boss AG (No. 2)* [2003] SGHC 205 at [30] and *Weir Warman Ltd v Research & Development Pty Ltd* [2007] SGHC 59 (“*Weir Warman*”) at [98].

(b) **Section 22(1)(b)**: The Applicants stated in paragraph 2 of the statement of grounds the following periods of use (or non-use) in issue:

- (i) 29 December 2009 to 28 December 2014
- (ii) 12 September 2014 to 11 September 2019
(the “Subsequent 5-Year Periods” for the Series Mark)

T0404547Z (The Word Mark)

(a) **Section 22(1)(a)**: The registration procedure was completed on 24 September 2012. The 5-year period immediately following the completion of registration ended on 24 September 2017. Thus, the period of use (or non-use) in issue is 25 September 2012 to 24 September 2017 (the “First 5-Year Period” for the Word Mark).

(b) **Section 22(1)(b)**: The Applicants stated in paragraph 3 of the statement of grounds the period of use (or non-use) in issue is 12 September 2014 to 11 September 2019 (the “Subsequent 5-Year Period” for the Word Mark).

(collectively referred to as “Relevant Periods”)

17 These Relevant Periods are the specific timeframes during which the Proprietors must show that their registered trade marks have been put to “genuine use” in order to stave off the present application to revoke the registrations of the Subject Marks.

Narrowing the Scope of the Legal Contest

18 At the oral hearing, the documentary and photographic evidence submitted in the Proprietors’ SD of their use of the Subject Marks was reviewed to pinpoint the specific examples of alleged trade mark usage relied upon by the Proprietors before the parties delved into their main legal submissions. I will now set out my primary conclusions on the facts that emerged from this exercise and their legal ramifications:

- (i) While all the images of the Proprietors’ product packaging that were entered into evidence had the words “Fair & Lovely” appearing on them, the range of products featured in the Proprietors’ SD was limited to facial skincare products, including whitening creams, facial cleansers and sun-protection creams. There was no evidence indicating that the Proprietors had used the Word Mark on any goods that fall squarely within the specifications for which that mark was registered (i.e. “Perfumery; essential oils; deodorants and antiperspirants; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; cotton wool, cotton sticks”) though the Proprietors submitted that the Fair & Lovely facial cleansers should be regarded as “shaving preparations” and “pre-shave and aftershave preparations” because these products *could* be used as functional substitutes for shaving creams.
- (ii) Both parties agreed that there was *no evidence* of the Proprietors using either the Logo Mark or the Series Mark *in the exact forms* in which those marks were registered. In the absence of use of these marks in their registered forms, any “genuine use” of these two marks could only be established if the products adduced in evidence had trade marks applied to them in a form which satisfied the legal criterion in Section 22(2) TMA.

- (iii) Both parties accepted that the evidence of usage of the Proprietors' marks could be divided into three categories: (a) usage of marks on third party websites and products distributed via third party online sales channels; (b) usage of marks on products distributed by third parties via physical sales channels; and (c) usage of marks in marketing and promotional materials. The range of trade mark users, whether third parties with whom the Proprietors have dealt with directly or otherwise, will be examined further below.
- (iv) In relation to the marketing and promotional materials category, the evidence showed usage of the Proprietors' marks *outside* of Singapore to enhance customer brand awareness of their "Fair & Lovely" line of skincare products. Evidence of the Proprietors' trade mark usage efforts in this category related to various *foreign* media campaigns featuring this brand and their associated line of products. However, none of the examples submitted in the Proprietors' SD [AW5, 93-199] indicated that these were efforts targeted at Singapore customers. Instead, the evidence submitted included publications from India, ranging from branding reports and consumer surveys, as well as the screenplay for a videographic advertisement for the Proprietors' skin-whitening products. While the Proprietors tried to assert that there was evidence to show that these advertisements were broadcasted on several cable television channels in India that *could* also have been available to viewers in Singapore [AW5, 187-188], there was no evidence as to exactly when these advertisements were aired or if they were actually included in broadcasts televised (or made available over cable networks) in Singapore during the Relevant Periods.
- (v) In relation to the category of usage of the Proprietors' marks on products distributed via physical sales channels, the Proprietors acknowledged that the evidence tendered was limited to a face cream product, described as "FAIR&LOVELY CRM MVITAMIN" in delivery orders (from 2011 and 2013) and "FAIR&LOVELY FM ADV MVITAMIN" in tax invoices (from 2015 and 2016) addressed to one of the Proprietors' distributors, Mohamed Mustafa & Samsuddin Co. Pte Ltd, which operates a physical department store in Singapore. Also adduced in evidence were *undated* photographic images of the Proprietors' goods on the shelves of the Mustafa department store. While the written description of the products delivered to Mustafa department store *could*, when viewed in conjunction with these photographs, correspond to one of the skincare products featured on the websites described above in [11], it is difficult to draw any reliable inferences because the evidence also shows that different packaging variants of what could be the same product appear on different websites. This makes it impossible to tell exactly *which* variant of the Proprietors' product packaging was used on the products on sale in the Mustafa department store *during* the Relevant Periods because there was no indication of when these photographs (below) were actually taken.

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Images of products (undated) sold in a Singapore department store (Mohamed Mustafa & Samsuddin Co. Pte Ltd) [A W3 – 28, 30]



- (vi) As for the remaining category of usage of marks on third party websites and products distributed via online sales channels, both parties agreed that the evidence of such use was limited to the photographic images of the products featured on the webpage screenshots in the Proprietors' SD. Images of the product packaging to which the Proprietors' marks have been applied have been reproduced above at [11].

19 In light of the lack of evidence showing use of the trade mark in marketing and promotional activities in Singapore, and the lack of evidence showing in what specific form the Proprietors' trade marks were used on their goods when they were sold via physical distribution channels in Singapore, the remainder of the oral hearing focused on the evidence of the Proprietors' purported uses of their trade marks on third party websites and on products distributed via online sales channels.

20 Furthermore, the limited evidence of use of the Proprietors' Subject Marks meant that these trade marks were, from the outset, *prima facie* vulnerable to revocation or partial revocation on grounds of non-use to varying degrees. Firstly, the Word Mark should be revoked because it has not been used in relation to any of the categories of goods listed in its specification. I am not persuaded by the Proprietors' submission that we should treat evidence of use of the Word Mark on face creams and face washes as evidence that the Word Mark has been used on "shaving preparations" or "pre-shave and aftershave preparations", which are the categories of goods specified in the registration for the Word Mark. There is no evidence to show that consumers use these goods for shaving-related purposes. Moreover, just because a product *can* be used as a shaving preparation does not mean that it *should be regarded as* a "shaving preparation" or "pre-shave and aftershave preparation" for the purposes of the goods-classification system within the trade mark law framework. Otherwise, we might end up having to accept all sorts of lubricants, oils, gels and ointments as within these product categories simply because it is hypothetically possible for a resourceful (or desperate) individual to employ these products as functional equivalents for those products which are formulated specifically for shaving-related purposes. While points are awarded for the creativity of the argument, the Proprietors must accept the consequences of not ensuring that the breadth of the categories of goods specified in their Word Mark registration corresponds to the actual products that have been made available to consumers in Singapore.

21 Secondly, the Logo Mark and the Series Mark should, at the very least, be partially revoked to the extent that there is no other evidence of their use in Singapore beyond the specific types of skincare products that appear on third party websites and goods that are distributed via online sales channels, identified above in [11]. There is no evidence of use of the Logo Mark on “soaps... cosmetics... [or] non-medicated toilet preparations”. Neither is there any evidence of the Series Mark being applied to “depilatory preparations... cosmetics; make-up and make-up removing preparations; petroleum jelly...”. As with the Word Mark, the Proprietors have not ensured that the scope of their specifications corresponds to the actual products in Singapore to which their trade marks have been applied.

22 Thirdly, in light of the absence of evidence of trade mark usage in the exact registered forms of these trade marks (referred to in [18(ii)] earlier), the Logo Mark and Series Mark are saved from revocation *only* to the extent that the evidence demonstrates that they have been put to “genuine use” on the Proprietors’ goods “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered” as provided for in Section 22(2) TMA. Flowing from the conclusions reached in [18(vi)], proving “genuine use” of these registered trade marks will require a visual analysis comparing the registered forms of the Logo Mark and the Series Mark against the forms in which these marks have been actually used on the product packaging images found on third party websites and goods distributed via online sales channels in Singapore. Exactly which product packaging images have to be scrutinised will depend on which of these instances of trade mark use also fulfil the other legal criteria for “genuine use” under Section 22(1)(a) TMA, which will be further elaborated upon in the next section of this decision.

Revocation on grounds of non-use of registered trade marks – Methodological Framework

23 The trade mark revocation mechanism in Sections 22(1)(a) and 22(1)(b) TMA gives applicants the opportunity to prune entries in the trade marks register on grounds of non-use. Trade marks that have not been put to “genuine use” after they have been registered do not deserve to remain on the register, where the exclusive rights that they attract by virtue of their continued registration will impede other traders from utilising or registering identical or similar marks of their own.

24 The analytical framework for determining if the criteria for revocation on grounds of non-use have been satisfied can be found in the approach set out in *Lisbeth Enterprises Limited v Proctor & Gamble International Operations SA* [2015] SGIPOS 6 (“*Lisbeth Enterprises*”), where the Principal Assistant Registrar of Trade Marks framed the legal elements of Sections 22(1)(a) and 22(1)(b) TMA as revolving around five “W” Issues – “Where”, “When”, “Which”, “Who” and “What”. To defeat the application to revoke trade mark registration, the registered proprietor must show: (i) that the trade marks in question have been *used in Singapore* (the “Where” Issue); (ii) that those marks have been *used during* those relevant time periods defined by the statute (the “When” Issue); (iii) that those marks have been *used in relation to the goods for which the marks have been registered* (the “Which” Issue); (iv) that those marks have been *used by the proprietor or with his consent* (the “Who” Issue); and (v) that there has been *use of the mark*, either in the form in which it has been registered or in forms which does not alter the distinctive character of its registered form (the “What” Issue).

25 These five “W”s are cumulative requirements and if the Proprietors are unable to demonstrate a single instance where all the criteria are satisfied, then they would have failed to

show “genuine use” of the Series Mark or Logo Mark and the applications for revocation of the registered trade marks should be granted. In the present case, the preliminary conclusions drawn earlier at [18(iv)], [18(v)] and [19] effectively disable the Proprietor from establishing “genuine use” of the trade marks in two of the three categories of use identified in [18(iii)]. The evidence in the Proprietors’ SD does not demonstrate usage of their marks on products distributed via physical sales channels because it does not indicate which variant forms of packaging were used on the Proprietors’ goods during the Relevant Periods, making it impossible to determine whether or not the trade mark appearing on such packaging was in a form which did not alter the distinctive character of its registered form; on this front, the Proprietors have therefore failed on the “When” Issue and the “What” Issue. Similarly, the evidence in the Proprietors’ SD also does not demonstrate “genuine use” of their marks in marketing and promotional materials because there was nothing to indicate that such use took place within Singapore or was targeted audiences in Singapore; on this front, the proprietors have therefore failed on the “Where” Issue.

26 We are thus left with one category of alleged use of the Proprietors’ trade marks – usage of the marks on third party websites and products distributed via online sales channels – to which all five “W” Issues have to be applied. Before engaging in this inquiry, I should address several legal issues, arising from the parties’ written and oral submissions, which relate to the interpretation and application of Section 22(2) TMA.

Section 22(2) TMA: Non-correspondence between the forms in which a trade mark has been used and its registered form

27 In light of the findings of fact in [18(ii)] above, it is clear that the only way “genuine use” of the Series Mark and Logo Mark can be established in this case is if the Proprietors can show that there has been use of these marks in a form that qualifies under Section 22(2) TMA – that is, “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”. Before evaluating the applicability of Section 22(2) TMA to the product packaging images that appear on the third party websites identified above, it may be helpful to briefly summarise some of the observations made in *The Patisserie LLP v Aalst Chocolate Pte Ltd* [2019] SGIPOS 6 (“*The Patisserie*”). These observations provide a framework for interpreting the scope of Section 22(2) TMA in light of the policy rationales for revoking registered trade marks on grounds of non-use. They also consolidate the precedents from the United Kingdom and Singapore caselaw that have shaped the three-stage test proposed in *The Patisserie* as a guide to facilitate the application of Section 22(2) TMA.

28 The present case is similar to *The Patisserie* insofar as there is abundant evidence of a registered proprietor making use of variants of the registered form or a trade mark – that is, usage of trade marks in forms that *differ* from the form in which those marks have been registered. No issue arises as to whether the alleged acts of trade mark use were instances of *bona fide* use within the relevant time periods.² The Proprietors have most certainly engaged in authentic instances of trade mark usage – where trade marks have been applied to goods function as badges of origin or indicators of quality to consumers in the market – and there is

² *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919 at [15].

no debate as to whether the nature of their conduct should be regarded as merely token usage that should be disregarded.³

29 Instead, one of the key issues in the present case, as was the case in *The Pâtissier*, lies in the visible differences between the forms in which the Subject Marks appear on the packaging of the goods and their registered forms, and whether the use of these altered forms of the trade marks meets the legal standard set by Section 22(2) TMA that enables the Proprietors to satisfy the “genuine use” requirement in Sections 22(1)(a) and 22(1)(b) TMA. However, the present case also raises an additional, and intermediate, conceptual issue that was not addressed in *The Pâtissier*; this is concerned with identifying the precise “form(s)” in which the trade mark has been put to actual use, an elusive question which I will come back to later on in this decision.

30 The statutory purpose and breadth of Section 22(2) TMA must be interpreted with close reference to Sections 22(1)(a) and 22(1)(b) TMA, which mandate the revocation of registered trade marks on grounds of non-use. These provisions operate in tandem to promote the accuracy and currency of the entries found on the trade mark register, to eliminate the legal exclusivity enjoyed by a registered trade mark proprietor when the trade mark no longer deserves such protection because it has not been utilised as a badge of origin, and to prevent the opportunistic acquisition or accumulation of intangible property rights that might prejudice the interests of competing traders as well as the public interest in maintaining the integrity of the trade marks regime.⁴

31 Section 22(2) TMA gives registered proprietors some degree of flexibility to establish “genuine use” of their registered trade marks where they have not actually used their marks in the exact form in which they appear on the register. The statutory language in that provision sets out the legal threshold for when use of a non-identical variant of a registered trade mark is also regarded as use of *that* registered trade mark. As explained by European Court of Justice in *Specsavers International Healthcare Ltd v Asda Stores* (Case C-252/12) (2013) at [29], the wording in the equivalent European provision operates “by avoiding imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered... to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.” The following three-stage test was proposed in *The Pâtissier*, when applying Section 22(2) TMA to determine if the variant forms in which a trade mark has been put to actual use can nevertheless be relied upon by the registered proprietor to demonstrate “genuine use” of its registered trade mark:⁵

Identification Stage. Looking at the *form in which the trade mark was registered* as a whole, what should the Registrar (taking the viewpoint of the average consumer) regard as the “distinctive character” of the registered trade mark?

³ *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 at [38] – [39] and *Weir Warman Ltd v Research & Development Pty Ltd* [2007] SGHC 59 at [99] – [100].

⁴ See *The Pâtissier* at [21]-[22] for a more detailed discussion of “The inaccuracy rationale”, “The unjustified legal monopoly rationale” and “The unfair competition rationale” underlying the legislative mechanism for revoking registered trade marks on grounds of non-use.

⁵ See *The Pâtissier* at [52].

Comparison Stage. Turning to the *form in which the trade mark was actually used*, what changes have been made to the elements of the registered trade mark (including stylisation, additions, deletions, adjustments to size or other features of appearance) which differentiate it from the registered form of the trade mark?

Evaluation Stage. Looking at the differences between these two forms of the trade mark, has there been an alteration of the “distinctive character” of the registered form of the trade mark? If so, then the registered proprietor has not put the registered form of the trade mark to “genuine use” for the purposes of Section 22(1) of the TMA.

32 Butressing this three-stage test in *The Pâtissier* are the following underlying principles, distilled from a review of the relevant cases from the United Kingdom and Singapore, that should guide the analytical process:

- (i) As far as possible, the language of the statutory provision should be adhered to and directly applied to give effect to its legislatively intended meaning because “it is not always helpful to paraphrase a statutory test before applying it”.⁶ This was why the “central message of the mark” approach by the UK Comptroller General of Trade Marks was criticised by the UK Court of Appeal⁷ and why the “essential feature” approach was not followed in *The Pâtissier*.⁸
- (ii) The tribunal’s inquiry as to whether the form of the mark that has been actually used by the proprietor has altered the “distinctive character of the mark in the form in which it was registered” should be carried out through the eyes of the average consumer, or from the perspective of a registrar analysing the likely impact of the visual, aural and conceptual qualities of the mark on the average consumer.⁹
- (iii) The “distinctive character” of the form in which the mark has been registered should be analysed from a “non-technical” perspective – that is, in terms of the registered mark’s characteristics that make it “striking”, “outstanding” or “memorable”.¹⁰ Identifying the “distinctive character” of the registered trade mark requires that mark to be perceived as a whole, rather than focusing on any particular dominant element. A holistic assessment should be carried out of all the visual, aural and conceptual qualities of the registered trade mark, in combination with each other, as it appears on the trade marks register, rather than giving undue emphasis to the individual components of the mark.¹¹
- (iv) In light of the policy rationales underlying the availability of the revocation remedy on grounds of non-use of the registered trade mark, identified earlier in [30] above, the scope of Section 22(2) must be fairly narrow.¹² Taking a liberal approach that permitted the registered proprietor to retain his trade mark registration(s) when it has *only* actually put to use distinguishable *variant* forms of the registered mark on its goods or services

⁶ See *The Pâtissier* at [32], citing *Bud and Budweiser Budbräu Trade Marks* [2003] RPC 25 at [45] per Lord Walker.

⁷ See *The Pâtissier* at [32]-[33].

⁸ See *The Pâtissier* at [38]. The other reasons for rejecting the “essential feature” approach have to do with its incompatibility with the other first principles set out in bullet points (iii) and (iv) below.

⁹ See *The Pâtissier* at [31] and [33].

¹⁰ See *The Pâtissier* at [32], [47] and [51].

¹¹ See *The Pâtissier* at [33],[40] and [51].

¹² See *The Pâtissier* at [29], citing *Bud and Budweiser Budbräu Trade Marks* [2002] RPC 238 at [22] per Simon Thorley QC, and [49].

would be contrary to the public interest.¹³ In such circumstances, if the registered proprietor continues to desire exclusive rights over the use of the trade mark(s) that has/have actually been put to use in the marketplace, then the onus should be upon the registered proprietor to file a fresh trade mark application to update the register with an entry that accurately captures the trade mark in the form(s) in which the mark(s) has/have been used.

33 In the present case, both parties agreed that the three-stage test articulated in *The Patissier* should be used to determine the applicability of Section 22(2) TMA to the evidence tendered by the Proprietors. However, the Applicant made additional submissions about how the assessment of the “distinctive character” of the registered form of a trade mark should also involve considerations of “technical distinctiveness”, an issue which deserves closer scrutiny in light of the position taken on this issue in *The Patissier*, referred to above at [32(iii)].

Section 22(2) (Stage 1) Identifying the “distinctive character” of the mark “in the form in which it was registered” (“Technical” vs “Non-technical” distinctiveness)

34 Distinctiveness is a slippery concept in trade mark law, appearing in different contexts and stages of the trade mark registration system. As far as the TMA is concerned, it surfaces in the following sections of the legislative framework:

Section	Purpose of provision	Context	Focus of inquiry into distinctiveness
7(1)(b)	Sets out absolute grounds for refusal of registration if the trade mark is “devoid of any <i>distinctive</i> character”	Subsistence – registrability of trade mark	Inherent non-descriptive qualities of the mark
8(2)-(4)	Sets out relative grounds for refusal of registration for trade marks that are “similar” to earlier trade marks	Registration conflicts – opposition based on earlier trade marks	Distinctiveness of the earlier trade marks affects the mark-similarity inquiry
27(2)-(3)	Sets out scope of protection given to registered trade marks against infringement by use of “similar” marks	Infringement of registered trade marks	Distinctiveness of the earlier trade marks affects the mark-similarity inquiry
22(2)	Enables reliance on actual uses of trade marks in forms that do not alter the “distinctive character” of the registered form of a trade mark in order to demonstrate “genuine use” of the registered trade mark	Revocation of registered trade mark on grounds of non-use	To determine if there has been “genuine use” of <i>the</i> registered trade mark

¹³ See *The Patissier* at [51].

35 Lord Walker’s dichotomy between two types of “distinctiveness” has been embraced by the Singapore Court of Appeal in *Staywell Hospitality v Starwood Hotels & Resorts Worldwide* [2013] SGCA 65 at [22]-[25] (“*Staywell*”).¹⁴ On the one hand, there is distinctiveness in a non-technical sense of the term (“non-technical distinctiveness”) which refers to those qualities of the mark which make it “outstanding and memorable” such that they “tend to stand draw the consumer’s attention” and “tend to stand out in the consumer’s imperfect recollection”. On the other hand, there is distinctiveness in a technical sense of the term (“technical distinctiveness”) which refers to the inherent or acquired characteristics of the mark which give it “the capacity... to function as a badge of origin”, as opposed to being descriptive of the goods or services to which it has been applied.

36 At the oral hearing, the Applicants urged me to revise one aspect of the approach taken in *The Patissier* towards the interpretation and application of Section 22(2) TMA. It was submitted that “technical distinctiveness” should be given a role to play in identifying the “distinctive character” of a registered trade mark for the purpose of Section 22(2) TMA because of the following statement made by the Court of Appeal in *Staywell*:¹⁵

Where a particular element or component has a high degree of technical distinctiveness, this can have a bearing on whether as a result of this, that component or element is found to be the dominant and distinctive element of the mark in the non-technical sense.

37 If the Applicants’ submission was intended to refine the position taken in *The Patissier* by highlighting the *potential relevance* of technical distinctiveness towards the assessment of distinctiveness in a non-technical sense,¹⁶ then I would have to agree for two reasons. Firstly, the two types of distinctiveness are inextricably intertwined such that they necessarily overlap with each other. The more peculiar and non-descriptive a trade mark is for a particular category of goods or services – that is, the more technically distinctive the mark – then, the more likely the mark will be “outstanding or memorable” in the eyes of the customer with imperfect recollection (i.e. non-technically distinctive). Secondly, the nexus between the two types of distinctiveness was expressly recognised by Lord Walker in the UK Court of Appeal’s *Budweiser* decision, which had interpreted the UK equivalent of Section 22(2) TMA.

38 However, it appears that the Applicants were also seeking to expand the role of technical distinctiveness in the identification of the “distinctive character” of the registered form of the trade mark for the purposes of Section 22(2) TMA. This is evident from the Applicants’ argument that if I were to “apply the *Staywell* analysis” to the Series Mark or Logo Mark in the present case, I should reach the conclusion that “[t]he word component “FAIR & LOVELY” does not possess inherent distinctiveness as both of the words are descriptive of the goods... [and] the combination is common and equally descriptive of the goods”, and when juxtaposed against the more striking two-woman images, “the word component supports and describes the image component”; the Applicants also urged me to find the image component “dominant... [but] that it cannot be said that it is so dominant that use only of this component would not alter the distinctive character of the registered mark”.

¹⁴ Citing *Bud and Budweiser Budbräu Trade Marks* [2003] RPC 25 (“*Budweiser*”) at [39] per Lord Walker.

¹⁵ *Staywell* at [28].

¹⁶ One of the Applicant’s written submissions on this issue was that I should view “*Patissier* through the lens of “technical distinctiveness” as an aid to determining ‘non-technical distinctiveness’...”.

39 I am unable to agree with this analytical approach, which overstates the appropriate role of technical distinctiveness within the context of Section 22(2) TMA, for the following reasons. Firstly, while the Court of Appeal’s decision in *Staywell* is binding authority, the discussion of the different meanings of distinctiveness in that case occurred in the context of trade mark opposition proceedings, where distinctiveness (both in a technical and non-technical sense) was relevant to the assessment of the *similarity between the conflicting marks* at issue; in the context of Section 22(2) TMA, the focus of the inquiry is on the “distinctive character” of just one mark – the registered form of the proprietor’s trade mark – and only for the purposes of comparing that form of the mark against the form in which the proprietor has actually used that mark.

40 Secondly, an uncritical importation of this aspect of the “*Staywell* analysis” into the context of Section 22(2) TMA runs the risk of corrupting the evaluative exercise into an unnecessarily intractable debate about which technically distinctive elements are more “dominant” than others because of their inherent (or acquired) distinctiveness and whether or not the “distinctive character” of the registered form of a trade mark is preserved when only those “dominant” elements of the trade mark have been put to actual use; this would, in a roundabout way, lead us back to the “essential feature” test that was rejected in *The Patisserie*.

41 Thirdly, attaching undue weight to the technical distinctiveness of the components of a trade mark, when identifying the “distinctive character” of a trade mark’s registered form, might have unintended consequences on the operation of Section 22(2) TMA – which, in my view, is simply to give the registered proprietor a limited freedom to make use of slight variations of his trade mark (and still be entitled to retain his trade mark registration) by not insisting upon strict conformity with the registered form of his trade mark. For instance, a proprietor whose registered trade mark possesses a very high degree of technical distinctiveness, either inherent or acquired, might end up enjoying greater latitude to use altered forms of his trade mark that depart from the registered form of the mark, without being vulnerable to revocation proceedings, as compared to another proprietor whose trade mark possesses a relatively low level of technical distinctiveness.

42 Greater care should be taken to ensure that concepts of technical distinctiveness and non-technical distinctiveness are deployed appropriately in the different contexts in which the word “distinctive” is used within the statute. In the context of subsistence-registrability, what matters is the technical distinctiveness of the trade mark because the core issue there is whether the mark sought to be registered is going to be able to perform the origin or source-indicating functions of a trade mark. In the context of registration conflicts and infringement, both technical and non-technical distinctiveness matter equally because they interact with each other in the mark-similarity analysis to determine the breadth of the penumbra of protection that the registered trade mark should enjoy. These concepts of distinctiveness are deployed when comparing the marks used by different parties – the registered proprietor and someone else – and technical distinctiveness plays a significant role in evaluating the “strength” of the trade mark which, in turn, determines whether or not a rival mark is regarded as “similar” within the meaning of the relevant statutory provisions.

43 Finally, in the context of trade mark revocation on grounds of non-use, it is still my view that non-technical distinctiveness ought to be the focal point when evaluating the “distinctive character” of a registered trade mark since the inquiry is primarily concerned with whether or not there has been “genuine use” of a particular registered trade mark, which the applicant is seeking to revoke on grounds of non-use. The purpose of identifying the “distinctive character”

of the registered form of the trade mark is simply to provide a reference point against which to evaluate the form(s) in which the registered proprietor has actually put the mark to use, given that these latter instances of use are what the registered proprietor must rely upon to defeat the revocation action.

44 The comparison that is made in Section 22(2) TMA, between the form in which the mark has been recorded on the register and the form(s) in which it has been actually used, is a comparison between the marks of the same party – the registered proprietor – unlike in the context of registration conflicts or infringement. The issue is whether there is a sufficient degree of proximity (and I deliberately refrain from using the word “similarity” here) between these marks, such that the one which has been actually put to use can be regarded as the legal equivalent of the other (the form in which the trade mark has been registered). In the context of trade mark revocation on grounds of non-use, we are not concerned about the strength or propensity-to-connect-consumers-to-particular-source of a trade mark, which is measured in terms of its technical distinctiveness. The statutory reference to the “distinctive character” of the registered form of a trade mark should therefore be understood to be primarily concerned with what makes that form of the mark striking to the average consumer with imperfect recollection – that is, what makes it distinctive in a non-technical sense. Any qualities of technical distinctiveness possessed by the registered trade mark are relevant *only to the extent* that they make a significant or substantial contribution to the non-technical distinctiveness of that trade mark.

45 Having clarified the approach that should be taken towards identifying the “distinctive character” of the registered form of a trade mark for the purposes of Section 22(2) TMA, which is the issue in Stage 1 of the three-stage test in *The Pâtissier*, I now turn to a more elusive conceptual question that arose in the present case that may have an impact on the application of Stages 2 and 3 of that test. This is a question that relates to the *identification* of the form in which the registered proprietor has put his trade mark to use – the subject matter that will have to be compared (in Stage 2) against the registered form of the trade mark and evaluated (in Stage 3) to determine if it differs in elements which do not alter the distinctive character of the registered form of the trade mark.

Section 22(2) (Stage 1.5?) Identifying the “form” in which the trade mark has been actually used by the proprietor

46 The issue that arises in between the Identification stage (Stage 1) and the Comparison stage (Stage 2) of the three-stage test set out in *The Pâtissier* is concerned with identifying *what* should be regarded as the “form” in which the trade mark has been put to actual use by the registered proprietor. This raises the question of how to define the boundaries of the comparator mark that must be held up against the registered form of the mark to determine if the former has altered the “distinctive character” of the latter. It should be recalled that Section 22(2) TMA gives the registered proprietor some leeway to establish “genuine use” of its trade mark because:

“... 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 is was registered...”
(emphasis added)

47 Exactly, how does one delineate the scope of the “form” in which the trade mark has been actually used? And from whose perspective is the “form” of actual use determined? In my view, this is a live issue in the present case because all the visual evidence tendered by the

Proprietors depicts product packaging that incorporates approximations of the components of the composite Subject Marks blended alongside other descriptive and decorative elements on product packaging. While the words “Fair & Lovely” have been clearly used in all of these product pictures, any usage of the Word Mark by itself is irrelevant because of my earlier conclusions, at [20] above, about the limited scope of the specified goods associated with that registration. The legal questions which remain have to do with whether the Proprietors have actually used their trade marks in forms that do not alter the distinctive characters of the Series Mark and Logo Mark.

48 As a starting point, if we look at the language of Section 22(2) TMA itself, a plain-meaning interpretation of the phrase “use of a trade mark” requires us to make a cross-reference to Section 22(1) TMA which, presumably, is concerned with use of *the* trade mark which has been registered – that is, use of the trade mark in the exact form in which it is depicted in the specifications on the Trade Marks Register. Section 22(2) TMA thus expands what counts as *the* trade mark beyond the registered form of the trade mark, establishing a range of legal equivalence between that specific registered form and *some* forms of use that do not alter the registered form’s distinctive character. It follows that any attempt to identify such eligible variants of the registered form of the trade mark must start from the premise that these variants must be capable of being sensibly regarded as iterations of *the* registered trade mark.

49 In a more straightforward case, the variant form of the trade mark that is put to use might have specific additions, deletions or other easily measurable adjustments made to the registered form of the trade mark. In a more challenging scenario, such as the present case, the variants relied upon by the registered proprietor might be regarded as incorporating constituent elements extracted from the registered form of the trade mark, reconfiguring them in pursuit of whatever product packaging design objectives that operate in the background, and recombining them with other functional and aesthetic features before something resembling the registered form of the trade mark is finally applied to the registered proprietor’s goods. In such cases, there are at least two approaches that can be taken towards identifying the “form” of actual use of the trade mark that, in Stage 2, must be compared against the “distinctive character” of the registered form of the trade mark that has been identified in Stage 1.

50 The first approach is to focus solely on those aspects of the product packaging that serve trade mark purposes; these are elements which either serve as badges of origin (from an objective trader’s perspective) or are relied upon as indicators of a particular trade source (from an average consumer’s perspective). I will call this the “narrow form” approach, where analytical emphasis is placed on *what* the registered proprietor has, objectively, actually *used as a trade mark* to the exclusion of all other surrounding subject matter.

51 The second approach is to look at the product packaging in its entirety, to appreciate the overall impression that is created in the mind of the average consumer, when identifying the “form” of actual use of the trade mark. This entails looking at *how* the registered proprietor has made actual use of his mark (in combination with other descriptive or decorative elements). The emphasis is on the “form” of actual use of the trade mark, rather than identifying the trade mark that the registered proprietor has put to actual use. I will call this the “broad form” approach, where what really matters is the entire *context* in which a trade mark has been actually used.

52 To illustrate how these two approaches can affect the way in which Section 22(2) TMA is applied, consider how they could apply to the facts of the present case. The figure below

depicts the registered form of the Series Mark in the left column, while examples of the Proprietors’ product packaging relied upon to demonstrate actual use of that trade mark are shown in the right column. The “narrow form” approach, if applied, might identify the comparator to be used in Stage 2 of the test in *The Patissier* as the words within the green oval. The “broad form” approach, on the other hand, might identify the comparator as all the contents within the blue dotted-frame.

<p>The Series Mark (T0808259J) [Registered form of trade mark]</p>	<p>Examples of product packaging for Proprietors’ goods [Actual forms of use of trade mark]</p>
	<div style="display: flex; justify-content: space-around;"> <div style="text-align: center;">  <p>AW12-379</p> </div> <div style="text-align: center;">  <p>AW12-374</p> </div> </div> <div style="margin-top: 20px;"> <p>“Narrow form” approach → </p> <p>“Broad form” approach → </p> </div>

53 The “narrow form” approach, if adopted, would echo the “mark-for-mark similarity” analysis that the Singapore courts have embraced in the context of trade mark infringement, albeit with at least two important differences.¹⁷ Firstly, the trade mark infringement comparison is made between the proprietor’s earlier registered trade mark and a third party defendant’s later mark, as opposed to the section 22(2) TMA comparison between two variants of what are, ostensibly, the same trade mark belonging to the proprietor. Secondly, the purpose of the trade mark infringement comparison is to establish *similarity* between the registered trade mark and the allegedly infringing mark, as opposed to the Section 22(2) TMA determination of whether

¹⁷ See *Staywell* at [15]-[20] where the Singapore Court of Appeal reaffirmed the step-by-step approach towards trade mark infringement analysis and how “the assessment of marks similarity is mark-for-mark without consideration of any external matter”.

the variant form has *altered the distinctive character* of the registered form of the trade mark. In the present context, the *only* parallel drawn is the precise approach towards identifying and defining the subject matter that is compared against the earlier registered trade mark; it is worth reiterating the point that the comparison exercise under Section 22(2) TMA should *not* be conflated with the mark-similarity analysis carried out in trade mark infringement cases.¹⁸

54 The “narrow form” approach would invariably shorten the leash given to the registered proprietor’s freedom to disassemble and reconfigure the registered form of his trade mark when it is put to actual use, while still holding on to the registered form as *the* trade mark over which his property rights subsist. As a matter of policy, this approach may be more defensible because the registered proprietor’s intellectual property rights emanate directly from the graphic representation of the trade mark that it has entered into the Trade Marks Register – it is the registered form of the mark that is the source of the exclusive rights he can assert against third parties, making it entirely reasonable for Section 22(2) TMA to adopt a stringent approach which encourages a close approximation between the “forms” in which *the* trade mark have been registered and actually used.

55 On the other hand, the “broad form” approach would avoid the practical difficulties of trying to determine which part(s) of the packaging have been used with trade mark intent, from *whose* perspective to determine if something has or has not been used as a trade mark and the blinkered view that is taken when looking at the proprietor’s product packaging. This approach would also give the registered proprietor greater flexibility to adapt the appearance of his trade mark to suit his other commercial or aesthetic objectives without having to demonstrate a direct correspondence between *the* trade mark that has been registered and *the* trade mark that he has actually used on his goods.

56 It should be emphasised that choosing one approach over the other will not necessarily be dispositive of the outcome of the legal question posed in Section 22(2) TMA – whether or not the altered form in which the proprietor has used the mark should be regarded as a use of the trade mark that has been registered. The choice between these two approaches takes place between Stages 1 and 2 of a three-stage test, and the final outcome might be the same depending on how the comparative and evaluative stages of the test are carried out. However, the “narrow form” approach is arguably one that leads to more predictable outcomes simply because it narrows the scope of the subject matter that is to be compared, in Stage 2, against the registered form of the trade mark. In contrast, the “broad form” approach may result in greater uncertainty as to how the decision-maker might apply the comparative and evaluative stages of Section 22(2) TMA since the visual impact of surrounding non-trade mark subject matter may influence what is perceived and the conclusions that are ultimately arrived at.

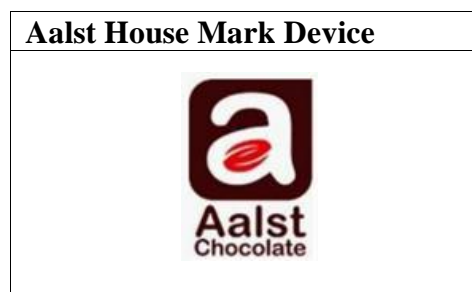
57 To illustrate how adopting the “narrow form” approach leads to a more straightforward line of analysis compared to the “broad form” approach, consider the facts of *The Patissier*: the registered form of the trade mark was a composite of at least two distinctive components, a “Patissier-hat” device and a word element (“By Aalst Chocolate”), that appears in the left column, while the packaging relied upon by the proprietor to establish actual use of this trade mark appears in the right column.

The Subject Mark	Examples of product packaging for Proprietors’ goods
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¹⁸ See *Bud and Budweiser Budbräu Trade Marks* [2002] RPC 238 at [22] per Simon Thorley QC, cited in *The Patissier* at [29].



[Registered form of trade mark]	[Actual forms of use of trade mark]
 <p data-bbox="225 568 440 663">"Narrow form" approach</p>  <p data-bbox="225 674 440 768">"Broad form" approach</p> 	 

58 In *The Patissier*, the registered proprietor also had a separate registered trade mark for an “Aalst house mark” which appeared in all its tax invoices and was frequently used in its product packaging, as depicted in the photographic images above.



59 When it came to applying the comparison stage of the three-stage test for Section 22(2) TMA, the approach taken in *The Patissier* was to just focus on the “Patissier-hat” device that was applied to the product packaging, and to ignore the Aalst house mark device because it

was a separate and independent trade mark of its own.¹⁹ This simplified the comparative and evaluative analysis to some degree, since it was unnecessary to consider the words in the Aalst house mark as part of the “form” in which the registered proprietor had put his trade mark to use.

Subject Mark (Form in which trade mark was registered)	Pâtissier-hat device (Form in which Proprietor has actually used his mark)
	

60 The end result in *The Pâtissier* was a finding of non-use of the registered trade mark by the registered proprietor because the “form” in which it was actually used omitted what was regarded to be one of its distinctive components (the “By Aalst Chocolate” word element) that, ultimately, resulted in the conclusion that the mark that was actually used had altered the distinctive character of the registered form of the trade mark. Such use of a variant form of the registered trade mark did not satisfy Section 22(2) TMA and was thus ineligible for the purposes of establishing “genuine use” of the registered trade mark. If a “broad form” approach had been taken in this case and the “form” of actual use had been defined to also include the Aalst house mark that was applied on the packaging alongside the Pâtissier-hat device, a greater element of uncertainty would have been introduced into the calculus, even if it had led to the same conclusion. The range of eligible variant marks that might qualify under Section 22(2) TMA would also be less clear since whatever appears on the product packaging, if correctly regarded as the “forms” of actual use by the registered proprietor, could deviate in infinite ways from what appears on the trade marks register.

61 In my view, an approach that promotes greater certainty in the application of Section 22(2) TMA is sensible. It should be recalled that one of the underlying policy rationales of the trade mark revocation mechanism is to ensure accuracy of the trade marks register so that this public record may properly perform its notification function of communicating which trade marks enjoy the protection prescribed by the TMA. Since property rights are created by the TMA, it is in the public interest that traders in the marketplace are able to tell, with some degree of certainty, where the boundaries to these legal monopolies lie so that they may navigate around them where necessary. Apart from consulting the trade marks register to glean such information relating to the subsistence of such intellectual property rights in registered trade marks, traders should *also* be able to rely to some extent on their market surveillance – looking at what trade marks registered proprietors have *actually applied* to their goods – as a proxy for identifying the subject matter for which these registered proprietors may have acquired legal protection through trade mark registration. This would be entirely consistent with the view taken by the UK courts that the UK-equivalent of Section 22(2) TMA should be understood as having a “narrow scope”;²⁰ to maintain their trade mark registrations, registered proprietors are

¹⁹ *The Pâtissier* at [56]-[57].

²⁰ *Bud and Budweiser Budbräu Trade Marks* [2002] RPC 238 at [22] per Simon Thorley QC.

expected to actually use the registered form of their trade marks or, at most, a form which comes very close to it (i.e. by not “differing in elements which do not alter the distinctive character of” the registered form).

62 Despite my view that it would be more principled to apply the “narrow form” approach towards identifying the “form” of actual use of a registered trade mark, for the purposes of Section 22(2) TMA, it may not be necessary for me to apply this approach in the present case. At the oral hearing, both parties agreed that I should compare the registered forms of the Subject Marks against the product packaging designs of the Proprietors’ goods as a whole (i.e. the “broad form” approach). I am prepared to do so, despite the views I have expressed on this matter above, because I do not believe that the choice between these two approaches would change the conclusions that are eventually arrived at in *this* case. This will be explained further down in the paragraphs below.

Application to the facts – has there been “genuine use” of the registered trade marks on third party websites and products distributed via online sales channels?

63 Returning to the remaining category of purported uses of the registered trade mark relied upon by the Proprietors to resist the Applicants’ revocation action, it is necessary to examine the evidence adduced in Exhibit AW12 of the Proprietors’ SD – consisting of screenshots taken from various third party websites – to determine if *all* the elements of “genuine use” are present in any of these purported instances of usage. If, and only if, the five “W”s are concurrently satisfied in a particular instance of trade mark usage, the Proprietors will have discharged their burden of proving the use of their Subject Marks for the purposes of Sections 22(1)(a) and 22(1)(b) TMA. To recapitulate, the relevant elements from these statutory provisions are set out in the table below and correlated against the five “W”s elaborated upon earlier at [23] to [26].

“W” Issue	“What”	“Where”	“Who”	“Which”	“When”
Element	Registered Trade Mark	Put to genuine use in Singapore	By the proprietor or with his consent	In relation to the goods and services for which TM is registered	Within 5 years of registration, or after initial 5-year period but at least 3-months before application for revocation

64 The “Which” and “When” Issues are the most straightforward and can be dealt with briefly. The photographic evidence in the Proprietors’ SD does not comprehensively describe each and every product that has been made available for sale on the third party websites. These products, which the Proprietors have claimed to have produced, appear to be an assortment of skincare products bearing the Proprietors’ trade marks, including face creams, facial cleansers and similar goods in plastic tube packaging or containers. These goods correspond to at least *some* of the categories of goods specified in the trade mark registrations for the Series Mark (T0808259J – e.g. “skin care preparations... creams and lotions for the skin...”) and the Logo Mark (T8802249B – e.g. “skin creams and lotions”). Thus, to the extent that there are at least some examples where trade mark-bearing goods correspond to the registration specifications, the “Which” Issue relating to trade mark use under Sections 22(1)(a) and 22(1)(b) TMA is partially satisfied.

65 As far as the “When” Issue is concerned, “genuine use” of the Subject Marks can be established if the Proprietors can show that these trade marks have been used during the Relevant Periods, identified in [16] above. Sections 22(3) and 22(4) TMA provide that if the registered trade mark has not been used during the Relevant Period, or if usage of the registered trade mark ceased during the Relevant Period, then any “commencement of resumption of use” of the registered trade mark which takes place in the 3-month period just before the date of the application for revocation “shall be disregarded”. As the date of application for revocation of the Subject Marks was 12 September 2019, the cut-off date for Section 22(4) TMA is 12 July 2019; any evidence of use of the Subject marks between 12 July 2019 and 12 September 2019 will only be relevant if there was evidence of “genuine use” of these marks prior to 12 July 2019. In the absence of any evidence of “genuine use” of the Subject Marks *prior* to 12 July 2019, any subsequent evidence of trade mark usage from that date till 12 September 2019 cannot be relied upon to defeat the revocation actions pursued by the Applicants.

66 The Proprietors have relied on the dates of screenshots taken from the third party websites to show when the Series Mark and the Logo Mark were used. The dates which appear on the print-outs of these screenshots are unchallenged, though the “eagle-eyed” Applicants have pointed out that the dating format for the print-outs should be understood as “Month/Day/Year” rather than “Day/Month/Year”. I accept this interpretation of the evidence in light of the contents of one of the screenshot print-outs [AW12, 374-375] which is dated “8/1/2019” on the top left hand corner and includes a customer’s feedback about a purchase made on “Feb 07, 2019”. The logical inference must be that “8/1/2019” means 1 August 2019 rather than 8 January 2019 since the customer’s feedback must have referred to a purchase that pre-dated the date of the screenshot.

67 Print-outs of screenshots taken outside of the Relevant Periods for the Series Mark and the Logo Mark cannot be relied upon to establish use of these trade marks for the purposes of Sections 22(1)(a) and 22(1)(b) TMA. Given that they are dated *after* 12 July 2019, the screenshots of the webpages from www.qoo10.sg, www.shopee.sg and www.lazada.sg can only be relied upon as purported instances of trade mark usage if there are other established occasions of “genuine use” of trade mark use prior to this date²¹. Otherwise, in the absence of “genuine use” of the Subject Marks prior to 12 July 2019, the operation of Section 22(4) TMA means that the screenshots of webpages from these three e-commerce platforms cannot be relied upon by the Proprietors to demonstrate use of their trade marks during the Relevant Periods. So until and unless we are satisfied that there was “genuine use” of the Subject Marks on the webpages found at www.indianproducts.com.sg and www.jothi.com.sg (relying on the Proprietors’ print-outs of *archived* screenshots – that is, images of what a webpage looked like at an earlier *archived date* within the Relevant Periods), we need not examine the screenshots of the webpages from these three e-commerce platforms. As for the other two websites, the Applicants were prepared to accept that the screenshots of the webpages found at www.indianproducts.com.sg and www.jothi.com.sg demonstrated trade mark use during the Relevant Periods (based on the *archived dates* of these screenshots) and could be relied upon to establish trade mark use during the Relevant Periods.

Website locations for screenshots	Print-outs from Proprietors’ SD	Type of website	Dates
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²¹ Or, if there are no such other established occasions of “genuine use”, preparations for the commencement or resumption of use began before the Proprietors became aware that the applications for revocation might be made.

www.indianproducts.com.sg	[AW12, 364-369]	Online retailer	Print-out date: 10 January 2020 Screenshot (archived) date: 6 April 2019
www.jothi.com.sg	[AW12, 370-373]	Online presence of physical retail store	Print-out date: 8 January 2020 Screenshot (archived) date: 3 June 2019
www.qoo10.sg	[AW12, 374-376]	Electronic Commerce platform	Print-out / screenshot date: 1 August 2019
www.shopee.sg	[AW12, 377-378]	Electronic Commerce platform	Print-out / screenshot date: 5 August 2019
www.lazada.sg	[AW12, 379-380]	Electronic Commerce platform	Print-out / screenshot date: 1 August 2019

68 As far as the “When” Issue is concerned, the screenshots of the webpages can be divided into two categories. In the first category, this facet of trade mark use is satisfied in relation to alleged uses of the Proprietors’ marks on the webpages of two websites, www.indianproducts.com.sg and www.jothi.com.sg because they occurred within the Relevant Periods prior to 12 July 2019. In the second category, this facet of trade mark use is established if there has been “genuine use” of the trade mark on the websites found in the first category because the dates of the screenshots for the webpages found on www.qoo10.sg, www.shopee.sg and www.lazada.sg fall within the 3-month period just before the date of the application to revoke the Subject Marks. As such, the discussion below will focus primarily on alleged instances of trade mark use on the webpages of www.indianproducts.com.sg and www.jothi.com.sg, which appear to have been operated by third party commercial undertakings as online retail channels for products manufactured by the Proprietors. The conclusions reached below about the webpages from the first category render it unnecessary for me consider the webpages from the second category as the dates of the screenshots in the latter category fall within the last 3 months of the Relevant Periods.

The “Who” Issue – Has the registered trade mark been used *by* the Proprietors, or with their consent?

69 Unlike other species of intellectual property that involve registration formalities, registered trade mark protection is not achieved simply by completion of a registration process that describes the protected subject matter and demonstrates satisfaction of the relevant eligibility criteria. Section 5(1)(e) TMA explicitly requires the registered proprietor (the then-applicant at the time of application) to declare that “the trade mark is being *used* in the course of trade, *by the applicant or with his consent*... or... that the applicant has a bona fide intention that the trade mark should be so used” (emphasis added). Registration of a trade mark must be accompanied by its “genuine use” for the statutorily created property rights to subsist, unless the trade mark applicant proceeds on the basis of a bona fide intention to use the mark for which registration is sought. This accounts for the symmetry in the statutory language found in

Sections 5(1)(e) and 22(1)(a) TMA, the latter provision introducing a revocation mechanism for registered trade marks on grounds of non-use.

70 Thus, to defeat an action to revoke its trade mark registration, the registered proprietor must be able to show that *it* is the party (“by the proprietor”) which has made use of the registered trade mark, or that use of the trade mark has occurred with *its* consent (“with his consent”). In other words, the registered proprietor cannot be a mere passive bystander to a third party’s usage of the registered trade mark. This requirement of a nexus between the use of the trade mark and the registered proprietor imposes a specific responsibility on the latter: it is not enough that customers in the Singapore market are incidentally exposed to the registered trade mark; the use of the trade mark must be attributable in a meaningful way to the registered proprietor. It is trade mark use *by* the registered proprietor (or third parties whose use “consent” has been given, within the meaning of Section 22(1) TMA, as discussed further below) that justifies the continued existence of the legal monopoly within Singapore’s trade mark system, under which the registered proprietor can restrict the freedom of other traders to use identical or similar marks of their own. Only those who have sown may reap.

71 Before determining “who” has used the registered trade mark, it is imperative to identify the specific activity alleged to constitute “use” of that mark “in the course of trade”. That the registered proprietor may have “used” the trade mark when it manufactured the goods, or had the mark applied to the packaging of those goods, does not amount to a relevant use of the trade mark if the trade-related activity relied upon to demonstrate “genuine use” of the trade mark under Section 22(1) TMA is, for instance, the *sale* of those goods bearing the trade mark by third parties. In the present case, the Proprietors can only rely on evidence of use of their trade marks on third party websites that serve as online distribution channels for their products. No evidence was adduced to establish actual sales of these products to customers via these online distribution channels, so any trade mark “use in the course of trade” is limited to acts of uploading images of trade mark-bearing product packaging onto webpages linked to www.indianproducts.com and www.jothi.com.sg. Since the images of the Proprietors’ product packaging bearing the Proprietors’ marks have been put up on websites operated by third parties, it is clear that such “use” of these trade marks is *not* use *by* the Proprietors. This means that it is necessary to inquire whether such third party use of the trade marks was done with the *consent* of the Proprietors.

72 The concept of “consent” in Section 22(1) TMA has been reviewed at great length by the Assistant Registrar in *Romanson Co. Ltd v Festina Lotus, S.A.* [2015] SGIPOS 3 (“*Festina*”), at [37]-[72], where a detailed analysis of English and European case law was carried out. The following conclusions were reached in that decision:

- (i) Where the use of the trade mark is made by an unrelated third party, the registered proprietor must prove that such use “has been authorised by him, whether expressly or impliedly”, though this did not extend to requiring the registered proprietor to prove that it exercised “control” over the use of the trade mark.
- (ii) “Consent” can take many different forms, including a licence given by a registered proprietor to the third party. It does not require participation by the registered proprietor in any quality control process and can be shown by relying upon the fact that the mark-

bearing goods were sold by someone with whom the registered proprietor is “economically linked”.²²

- (iii) No relationship of agency is necessary. There can be “consent” given by the registered proprietor to the third party to use the registered trade mark where the latter’s use is on its own account, rather than on behalf of the registered proprietor.²³
- (iv) “Consent” includes “implied consent”, which may be understood to mean “authorisation sufficient to ensure non-infringement” by the third party.²⁴ Consent may be implied from circumstances such as the use of the trade marks on third party invoice and order documents, which have been disclosed to the registered proprietor, that raise the inference that the third party’s actions had not been against the wishes of the registered proprietor.²⁵
- (v) To establish “consent” for the purposes of Sections 22(1)(a) and (b) TMA, there should be “an unequivocal demonstration of consent” on the facts. Having said that, it was also observed that “implied consent” might be shown where the proprietor has “actual or constructive knowledge of an unrelated third party that is selling goods which bear his trade mark, and acquiesces to the use of the trade mark **and** the sales of these goods (e.g. if the products are genuine products).”

The trade mark exhaustion origins of the “unequivocal demonstration of consent” requirement and its relevance to Singapore

73 The “unequivocal demonstration of consent” formulation, and the accompanying elaboration from *Festina*, has been embraced by the Principal Assistant Registrar in *Lisbeth* at [71]. Both *Festina* and *Lisbeth* also have common paragraphs discussing how a registered proprietor might be found to have consented to the use of its trade mark on parallel imported goods that are distributed in Singapore by third parties.

... it is likely that consent can be implied from circumstances in a ‘classic’ parallel import situation... as long as there is sufficient evidence of the circumstances that demonstrates an unequivocal demonstration of “consent” to the use of the mark by the proprietor... [but] due to the obvious differences in the wording of the legislation in Sections 29(1) and Section 22(1) of the Act... I would not go as far as to say that consent is *automatically* “deemed” by virtue of the fact that the good are genuine goods manufactured by the proprietor himself. The proprietor still bears the burden of proving factual consent.²⁶

74 At the oral hearing, the Proprietors contended that I should decline to follow the “unequivocal demonstration of consent” standard, which appears to have been drawn from the 2002 decision of Mr David Kitchin QC, *In the Matter of an Application under No.10491 by Dialog ABC Limited for Revocation of Trade Mark Number 1429292 in the name of Publicis Dialog* (“*Dialog*”). The Proprietors submitted two arguments why the Assistant Registrar in *Festina* had adopted the *Dialog* standard of “consent” in error. Firstly, she did not appreciate

²² Citing *Einstein Trade Mark* [2007] RPC 23 (“*Einstein*”) at [24].

²³ Citing *SAFARI Trade Mark* [2002] RPC 23 (“*Safari*”) at [19]-[20].

²⁴ Citing *Einstein* at [26].

²⁵ Citing *The Sunrider Corp v OHIM* (Case T-203/02) (8 July 2004) at [25]-[26] (“*Sunrider*”).

²⁶ *Festina* at [72]; *Lisbeth* at [71].

that this more stringent standard for consent was derived from the European context of the *community exhaustion* of trade marks, whereas a *different* standard for trade mark exhaustion is adopted in Singapore, with Section 29(1) TMA providing for the *international exhaustion* principle to apply to parallel imports. Secondly, the Assistant Registrar did not give adequate consideration to the equivocal nature of the observations that were made in *Dialog*:

The Applicant submitted that the meaning of “consent” must be the same in Article 5(1), Article 7(1) and Article 10(3). Accordingly, it was submitted, there must be an unequivocal demonstration of consent. I see some considerable force in that submission, although it must be recognised that the cases before the ECJ were concerned with whether or not the proprietors had renounced their rights to control the initial marketing within the EEA. *The ECJ was clearly conscious that consent would have the serious effect of extinguishing the exclusive rights of the proprietors to control such initial marketing, and it was in this context that that the court concluded that consent must be so expressed that an intention to renounce the rights must be unequivocally demonstrated.* In the event, I have come to the conclusion that *I do not have to reach a final decision as to what is required to establish consent in circumstances which do not involve initial marketing in the EEA, and I prefer not to do so* because, for the purposes of my decision, I am prepared to assume that consent must be unequivocally demonstrated.²⁷

75 On closer scrutiny of *Festina*, I am of the view that there is some merit to the Proprietors’ arguments. There seems to be a contradiction between the positions taken in *Festina* on two issues: firstly, whether the concept of “consent” that is applied in the context of defeating a revocation action for non-use of a trade mark should correspond to how “consent” is understood in the context of trade mark exhaustion; secondly, whether UK and EU decisions that interpret the meaning of “consent” should be regarded as persuasive in Singapore, given that the position taken under the European trade marks regime is to equate the meaning of “consent” in three contexts – trade mark revocation, trade mark exhaustion *and* trade mark infringement. This is evident in the following passage from *Einstein*, at [22], which was cited in *Festina*, at [48]:

I do not see how use of a trade mark in relation to goods “put on the market” in the United Kingdom “by the proprietor or with his consent” could be sufficient, in principle, to satisfy the requirements for exhaustion without also being sufficient, in principle, to support a claim for protection defined by reference to use or to defeat an application for revocation on the ground of non-use. I therefore think it is appropriate to adopt and apply the same basic concept of use “by the proprietor or with his consent” in all three contexts.

76 On the one hand, it seems clear from the discussion in *Festina* that, as far as Singapore is concerned, there should *not* be an equivalence drawn between the concepts of “consent” that arise in the contexts of trade mark revocation and trade mark exhaustion. This is evident from the Assistant Registrar’s comparison between the language found in Sections 22(1)(a) and 29(1) TMA, at [52]-[55] of *Festina*. This is entirely sensible, in my view, given that “consent” in one context is concerned with the scope of eligible uses of a trade mark that would justify the continued *protection* of a registered trade mark, while “consent” in the other context is concerned with demarcating the circumstances in which the registered trade mark is *not*

²⁷ *Dialog* at [25]. (Emphasis added)

protected (i.e. “exhausted”). Demonstrating “consent” in the former context reaffirms the valid subsistence of exclusive rights over the registered trade marks, while demonstrating “consent” in the latter context negates those exclusive rights of the registered proprietor whose goods have been put on the market.

77 On the other hand, *Festina* also chose to follow a line of UK and EU cases – *Sunrider*, *Einstein*, *Dialog* and *Safari* – that did in fact adopt a unified view of the meaning of “consent” across multiple contexts. The evidential threshold for “factual consent” that was endorsed in *Festina*, which requires an “unequivocal demonstration of consent”, is pegged at a relatively stringent level because it was derived from the “community exhaustion” principle of European trade mark law: it is entirely appropriate for the level of “consent” that must be shown in this context to reach the level of “an intention to renounce” one’s exclusive rights because, by “consenting” to the placement of the mark-bearing goods on the market within the European Community, the registered proprietor *loses* his exclusive rights in the trade mark applied to those goods.

78 The issue arising in the present proceedings is whether we should apply this stringent standard of “consent”, *derived from* case law concerned with the Community exhaustion principle of European trade marks *and extended to* the context of the EU and UK statutory provisions that are equivalent to Section 22(1) TMA, to the meaning of “consent” in Section 22(1) TMA. There is, arguably, no need for “consent” to be pitched at such an exacting level in Singapore, where the international exhaustion principle applies, since registered proprietors should *not* be construed as *surrendering* their exclusive rights when they “consent” to put their trade mark bearing goods on any market in the world. Instead, what Section 29(1) TMA does is to circumscribe the scope of the registered proprietor’s exclusive rights from the outset.

79 In the context of Singapore’s policy-driven inclination towards the international exhaustion of trade marks, where Section 29(1) TMA provides that there is no trade mark infringement when goods bearing a registered trade mark are put on a market “whether in Singapore or outside Singapore... by the proprietor of the registered trade mark or with his express or implied consent (conditional or otherwise)”, the requirement of “consent” has been deliberately diluted almost to the point of non-existence. Singapore’s pro-parallel import stance does *not* mean that the registered proprietor’s exclusive rights are *extinguished* when its “consent” to put the goods on the market is established, or that the proprietor who has given such “consent” has *renounced* its rights; rather, no rights to control the movement of genuine goods put on the market anywhere in the world actually accrue to the registered proprietor in the first place.

80 It must be reiterated that the present case does not involve any issue of trade mark exhaustion that requires me to interpret Section 29(1) TMA. I am merely expressing my doubts over the propriety of relying on a line of UK and EU cases that have adopted a unified meaning for “consent” – for the purposes of establishing trade mark usage in revocation proceedings – that is premised upon an entirely different approach towards the issue of trade mark exhaustion in these foreign jurisdictions.

81 However, even if the “unequivocal demonstration of consent” standard is misaligned relative to Singapore’s trade mark exhaustion context, might it nonetheless still be an appropriate threshold in the context of defeating a revocation action on grounds of non-use? The Proprietors contend that it is not. Curiously, the stance taken by the Proprietors is that the position in *Einstein* that interprets “consent” uniformly between contexts (i.e. the trade mark

exhaustion context and the trade mark revocation on grounds of non-use context) *should* be applied in Singapore, albeit with modifications to reflect the international exhaustion paradigm in Singapore. The Proprietor’s proposed test for “consent” is that if we are satisfied that “consent” has been given (or deemed to have been given) by the registered proprietor for the purposes of trade mark exhaustion involving genuine goods put on the market anywhere in the world, then we should also regard the registered proprietor as having given its “consent” to the parallel importer to use the trade mark when those genuine goods are sold in Singapore. According to the Proprietors, the trade mark owner should not be doubly disadvantaged by rules that disable it from preventing the sale of parallel imports in Singapore by third parties, while at the same time being unable to rely on such third party sales to establish “genuine use” of the registered trade mark.

82 The appeal of this argument is undermined by the fact that there is nothing, in principle, preventing a registered proprietor from actually giving or demonstrating his “consent” to the third party parallel importer’s use of the registered trade mark in the course of the latter’s trade in Singapore. This might be achieved by one or more steps taken by the registered proprietor to acknowledge the parallel importer’s use of the registered trade mark and some objective indication of the registered proprietor’s assent or approval. The test proposed by the Proprietors entails an *automatic presumption of “consent”* given by the registered proprietor to the third party parallel importer to use a registered trade mark merely because there is another statutory provision, in Section 29(1) TMA, that – for very specific policy reasons – has adopted a very liberal definition of “consent” (to put goods bearing the registered trade mark on the market) that disregards any geographical movement restrictions imposed by the registered proprietor. This is a startling proposition that I find difficulty agreeing with. If accepted, it would mean that any use of a registered trade mark by a third party parallel importer in relation to parallel imports of genuine goods would *always* have to be regarded as instances of trade mark use with the “consent” of the registered proprietor. This would significantly dilute the statutory requirement in Sections 22(1)(a) and 22(1)(b) TMA for “genuine use” of the trade mark *by* the registered proprietor to successfully stave off the trade mark revocation action. Integrating the meanings of “consent” between these two contexts is also, with respect, logically problematic: it seems peculiar to simultaneously take the position that, on the one hand, there has been deliberate statutory derogation from the property rights conferred upon the registered proprietor which disables it from blocking the movement or sale of parallel imports of genuine goods bearing the registered trade mark while maintaining that, on the other hand, the registered proprietor has presumptively “consented” to the third party usage of its registered trade mark when these goods are being sold by parallel importers whose actions may run contrary to the registered proprietor’s wishes.

83 Taking a step back, it is my view that it is quite unnecessary to struggle with this entanglement of the meanings of “consent” in the contexts of (i) showing “genuine use” (by the registered proprietor) of the registered trade mark to defeat a trade mark revocation action, and (ii) establishing that genuine goods bearing the registered trade mark have been put on the market (by the registered proprietor) to trigger the operation of trade mark exhaustion principles. As a matter of principle, if we accept that both contexts are distinct in Singapore, which appears to be the view taken in *Festina* after analysing the statutory language in Sections 22(1) TMA and 29(1) TMA, then there is no reason why there must be any correlation between the definitions of “consent” in these two settings. In addition, as a practical matter, the relevance of this definitional debate is confined to *a very specific set of factual circumstances* – where the registered proprietor is trying to assert, for the purposes of Sections 22(1)(a) and 22(1)(b) TMA, that he has given consent to a third party’s use of the registered trade mark in

relation to goods that are parallel imports to which Section 29(1) TMA applies. In the present case, we have narrowed down the scope of alleged actual trade mark use to those acts of uploading photographic images of trade mark-bearing product packaging onto third party websites. There is no indication from the evidence of the source of the products featured in these images, if they are even genuine goods in the first place, and no clear evidence of actual sales of parallel imported goods by these third parties. As such, I believe it is more productive to focus directly upon the precise legal question that is relevant to the present case: to satisfy the “consent” element in Sections 22(1)(a) and 22(1)(b) TMA, must the registered proprietor prove that it has made an “unequivocal demonstration of consent” to the third party for the latter to use the registered trade mark? What exactly should “consent” to use the registered trade mark by a third party entail?

Meaning and scope of “consent” in Sections 22(1)(a) and 22(1)(b) TMA

84 Apart from the Euro-centric contextual provenance (i.e. trade mark exhaustion) of the final *Festina* formulation for “consent” under Sections 22(1)(a) and 22(1)(b) TMA – that the registered trade mark proprietor must have made an “unequivocal demonstration of consent” to the third party before the latter’s use of the registered trade mark can be relied upon to establish the former’s “genuine use” of the mark, I am still uncomfortable accepting this definition in an unqualified manner because of the uncertainty surrounding exactly what it entails. My concerns relate primarily to the scope of this formulation and whether it should include “implied consent”, which was not – in my view – adequately explained in *Festina*.

85 As noted in *Festina*, there are marked differences between the legislative language in Sections 22(1)(a) TMA and 29(1) TMA that refer to the “consent” of the registered proprietor. Setting out an international trade mark exhaustion principle, Section 29(1) TMA makes explicit reference to the registered proprietor’s “express or implied consent (conditional or otherwise)”, whereas Section 22(1)(a) TMA simply requires there to be use of the registered trade mark by the registered proprietor or “with his consent” without any reference to implied consent. This difference in the statutory language cannot be ignored and suggests a legislative intention for “consent” to be a substantive criterion to be established by the registered proprietor if it has not itself put the registered trade mark to use and must instead rely on third parties’ acts of trade mark use. In other words, the registered proprietor cannot simply point to *any* occurrence of trade mark use in the Singapore market to resist an application for revocation on grounds of non-use; the *identity* of the trade mark user is also an integral part of the statutory definition of what counts as “genuine use” of a registered trade mark.

86 If we accept that the exclusive rights conferred by the trade mark system is part of a bargain which requires use of the registered trade mark *by the registered proprietor* to justify keeping its place on the trade mark register, then instances of *third party usage* of that trade mark that are relied upon by the registered proprietor to discharge its end of the bargain ought to be confined to situations where a similar justification also exists. Thus, the paradigm of such situations of third party use of a trade mark with the “consent” of the registered proprietor would be where the rights holder has licensed someone else to exploit its trade mark, either on behalf of the registered proprietor or on the third party’s own account. The third party use of the trade mark occurs with the authorisation of the registered proprietor, either through the agency, or with the cooperation, of the third party. Such third party uses of the trade mark are attributable to the registered proprietor, through the latter’s demonstration of “consent” (which has been unequivocally *given to* the third party), that they should be treated as legally equivalent to trade mark use *by* the registered proprietor. The “or with his consent” limb of

Section 22(1)(a) TMA thus extends the range of eligible instances of trade mark use that can be relied upon to defeat the revocation application, allowing the registered proprietor to show “genuine use” of its registered trade mark by relying on the conduct of others – those third parties whose acts of trade mark usage have been imbued with the registered proprietor’s consent. The scope of this class of eligible acts of trade mark usage by third parties is thus entirely dependent on the meaning of “consent” and how it can be demonstrated by the registered proprietor.

87 Interpreting the “consent” criterion in Section 22(1)(a) TMA as including “implied consent” would render the boundaries of this class of eligible acts of trade mark usage by third parties quite uncertain. The registered proprietor would not need to do anything to communicate its consent to the use of its trade mark by another party. Implied consent, as I understand it, means that no express consent has been given by the registered proprietor who is, nevertheless, regarded in the eyes of the law as a consenting party. Implied consent should be distinguished from a situation where express consent can be inferred from the surrounding facts. In *Festina* at [71], the scope of what constitutes “consent” is described in the following manner:

Having considered the cases of *Sunrider*, *Einstein*, *Dialog* and *Safari*, I am of the view that there should be an "unequivocal demonstration" of consent in order for it to be found on the facts. However, "consent" may be implied (as in *Sunrider*) as long as there is sufficient evidence that amounts to an unequivocal demonstration of consent. For example, a proprietor who has actual or constructive knowledge of an unrelated third party that is selling goods which bear his trade mark, and acquiesces to the use of the trade mark **and** the sales of these goods (e.g. if the products are genuine products), may be able to show that there is "implied" consent.

88 Apart from the legitimacy of interpreting the plain statutory reference to “consent” as including “implied consent”, it seems to me that a threshold requirement of an “unequivocal demonstration of consent” establishes a legal standard that cannot be satisfied if the registered proprietor merely had *constructive* knowledge of the third party use of the trade mark and has *acquiesced* to that use and the sales of those goods (i.e. by showing “implied consent” as described in *Festina*). Constructive knowledge is satisfied once a party has knowledge of sufficient facts that would put a reasonable person on inquiry, or to give him notice, of that fact. Acquiescence is essentially passive and appears incongruous with a legal standard that requires an unequivocal *demonstration* of consent. Taking the position that “constructive knowledge” is sufficient means that the “consent” of a registered proprietor can be established notwithstanding that it was previously *unaware* of the third party’s use of the registered trade mark, but solely on the basis that a reasonable person *ought* to have known of such usage in the circumstances that such use was taking place. These lower tiers of knowledge and conduct that are associated with “implied consent” would, in my view, denude the “consent” criterion of its substantive significance to Section 22(1)(a) TMA and render it superfluous.

89 The *Sunrider* case that was relied on as authority for “implied consent” also bears closer scrutiny. In that case, the Court of First Instance held, at [23]-[26]:

23 As is apparent from the invoices submitted by the other party to proceedings before the Board of Appeal, sales of products under the earlier trade mark were made by Industrias Espadafor SA rather than by the proprietor of the trade mark, although the latter's name also features in the name of the company in question.

24 Where an opposing party maintains that the use of an earlier trade mark by a third party constitutes genuine use for the purposes of Article 43(2) and (3) of Regulation No 40/94, he claims, by implication, that he consented to that use.

25 As to the truth of what that implies, it is evident that, if the use of the earlier trade mark, as shown by the invoices produced to OHIM, was without the proprietor's consent and consequently in breach of the proprietor's trade mark right, it would have been in Industrias Espadafor SA's interests, in the normal course of events, not to disclose evidence of such use to the proprietor of the trade mark in question. Consequently, it seems unlikely that the proprietor of a trade mark would be in a position to submit proof that the mark had been used against his wishes.

26 There was all the more reason for OHIM to rely on that presumption given that the applicant did not dispute that the earlier trade mark had been put to use by Industrias Espadafor SA with the opposing party's consent. It is not sufficient that the applicant argued generally in the course of the proceedings before OHIM that the evidence produced by the opposing party was not adequate to establish genuine use by the latter.

90 My reading of the above is that there was *no direct evidence* of actual express consent given by the registered proprietor to the third party who had sold products bearing the registered trade mark; instead, the third party had disclosed invoices that showed evidence of the third party's trade mark use to the registered proprietor, which is something it would not have done if it had not previously obtained consent from the registered proprietor. Otherwise, the third party would essentially be disclosing evidence of potentially infringing conduct to the registered proprietor. Moreover, the applicant had not challenged the third party's use of the trade mark as having been made without the registered proprietor's consent. Taken together, my understanding of what had happened there was that the registered proprietor *had expressly consented* to the third party's use of the registered trade mark, and that this "consent" was *inferred* from evidence tendered. The registered proprietor may not have been able to produce any written correspondence or witness testimony to indicate what had been previously communicated between itself and the third party, but from the indirect evidence that was adduced – including trade mark-bearing invoices submitted by the third party – when read in light of the surrounding circumstances, the court was satisfied that the registered proprietor must have actually consented to the third party to use the trade mark at an earlier point in time. This is, with respect, not the same as "implied consent".

91 If we confine the "consent" limb of Section 22(1)(a) TMA to instances of express consent from the registered proprietor, then two further ancillary issues need to be addressed. Firstly, what is the *state of knowledge* that the registered proprietor must have of the trade mark usage by the third party in order for the former to "consent" to the latter's actions? Secondly, apart from having knowledge of the third party's actions, *what else is expected* from the registered proprietor to support its claim that use of its registered trade mark has taken place with its "consent"? On the first issue, my view is that "consent" can only be meaningfully given or demonstrated by registered proprietors who have actual knowledge of the third party's use of their trade marks. One cannot expressly "consent" to the actions of another if one lacks awareness of those actions. But actual knowledge of the third party's actions is not enough. In addition to possessing such knowledge or awareness of the third party's actual use of the trade mark, it must be clear that no objections were raised by the registered proprietor to such use. Furthermore, for there to be an "unequivocal demonstration of consent", I am of the view that

the registered proprietor must also take positive steps that objectively indicate it has authorised, assented to or approved of the third party's use of the registered trade mark. Thus, on the second issue, merely tolerating or acquiescing to the third party's use of the trade mark is not enough for the proprietor to reap the benefit of someone else's actions to establish "genuine use" of the registered trade mark. The registered proprietor must *demonstrate* its "consent" to the acts of trade mark usage by the third party, either by communicating its "consent" to the third party or engaging in public acts that show its "consent" after the trade mark use by the third party has commenced.

92 The purpose of the "consent" limb in Section 22(1)(a) TMA is to establish a legal nexus between the registered proprietor and the actions of the third party such that the former can justifiably rely on the latter's use of the registered trade mark to establish "genuine use" of the trade mark. If all that mattered was the fact that the registered trade mark was doing its job as a badge of origin or guarantee of quality within the Singapore market, then there would have been no need to specify the identity of the user of the trade mark ("by the proprietor or with his consent"). In my view, there are two categories of trade mark usage by third parties where this legal nexus is established and where the registered proprietor can justifiably rely on the actions of the third party as if they had been carried out by the proprietor itself. In both these categories, the knowledge and actions of the registered proprietor allow for the third party's use of the registered trade mark to be hitched to the registered proprietor's wagon.

93 The first, and more obvious, category where the third party's use of the trade mark has taken place with the "consent" of registered proprietor consists of situations where the registered proprietor has *given* "consent" to the third party. This category would include licensing arrangements between the registered proprietor and the third party, or authorised distributorships of goods bearing the registered trade mark. The "consent" of the registered proprietor is established in a bilateral context where *permission* to use the registered trade mark has been communicated directly to the third party. A *causative* nexus is established between the third party's use of the trade mark and the registered proprietor. This provides a justification to attribute the trade mark usage by the third party to the registered proprietor for the purposes of showing "genuine use" of the trade mark under Section 22(1)(a) TMA. Cases of third party trade mark use falling within this category occur with the registered proprietor aware of the intended conduct of the third party; at the same time, the third party who makes use of the registered trade mark knows that its actions have been consented to by the registered proprietor.

94 A second category of situations of third party trade mark usage that I would be prepared to recognise as infused with the "consent" of the registered proprietor are those where the registered proprietor has *demonstrated* its "consent" to the third party's use of its trade mark after becoming aware of such usage. This may or may not involve any direct communication with the third party, but should comprise actions taken by the registered proprietor that are objectively understood to be unequivocal communications of its *assent* to the *continued or ongoing acts* of trade mark use by the third party. In such non-cooperative settings, a registered proprietor may unilaterally demonstrate its "consent" to the third party's use of its registered trade mark, even where the latter has neither sought nor acknowledged the former's consent. In this category of situations, an *associative* nexus between the third party's trade mark usage and the registered proprietor is established based on the latter signalling its *approval* of the former's actions, perhaps through some show of *support, encouragement or endorsement*. Admittedly, the precise boundaries of this category are less well-defined, not least because the "consent" being demonstrated by the registered proprietor takes place after the third party has

commenced using the registered trade mark. The “consent” that is demonstrated by the registered proprietor should *not* be regarded as retrospective, even though it is connected to acts of trade mark usage by third parties of which the registered proprietor was previously unaware. Instead, the “consent” that the registered proprietor demonstrates is prospective insofar as it relates to ongoing acts that persist *after* it has become aware of their existence, such as the appearance of the trade mark on the third party’s website. There is no need for contemporaneity between the commencement of third party’s use of the registered trade mark and the registered proprietor’s knowledge of the latter’s actions. Cases of third party trade mark use falling within this category occur without the registered proprietor necessarily being aware of the third party’s conduct from the outset, though the registered proprietor must eventually come to know that its trade mark is being put to use by that third party; on the other hand, the third party need not have actual knowledge of the registered proprietor’s acts of “consent” since it may not have had any direct dealings with the consenting party. The crux of the “consent” that is demonstrated in this category lies in the registered proprietor showing that (i) it had actual knowledge of the third party’s trade mark use and (ii) that it subsequently responded with conduct of its own that publicly, objectively and unequivocally, demonstrates its assent to the third party’s continued or ongoing use of the registered trade mark.

95 Given that the “Who” and the “When” facets of the legal requirements for “genuine use” of the registered trade mark have to be satisfied cumulatively and coincidentally for the purposes of Section 22(1)(a) TMA, the registered proprietor must show that its trade mark was used “with his consent” *during* the relevant (statutorily prescribed) time periods. This means that the registered proprietor must establish that both its awareness of the third party’s use of its trade mark, as well as any public demonstration of its assent to such trade mark usage, occurred during the relevant time periods in order to characterise the third party’s continued or ongoing use of the registered trade mark (*after* the registered proprietor became aware of the third party’s conduct) as taking place with the registered proprietor’s “consent”. Any instances of trade mark use by the third party prior to the registered proprietor having actual knowledge of such acts is, strictly speaking, irrelevant. The following diagram identifies the “zone” of a third party’s trade mark use which might be regarded as taking place with the “consent” of the registered proprietor:

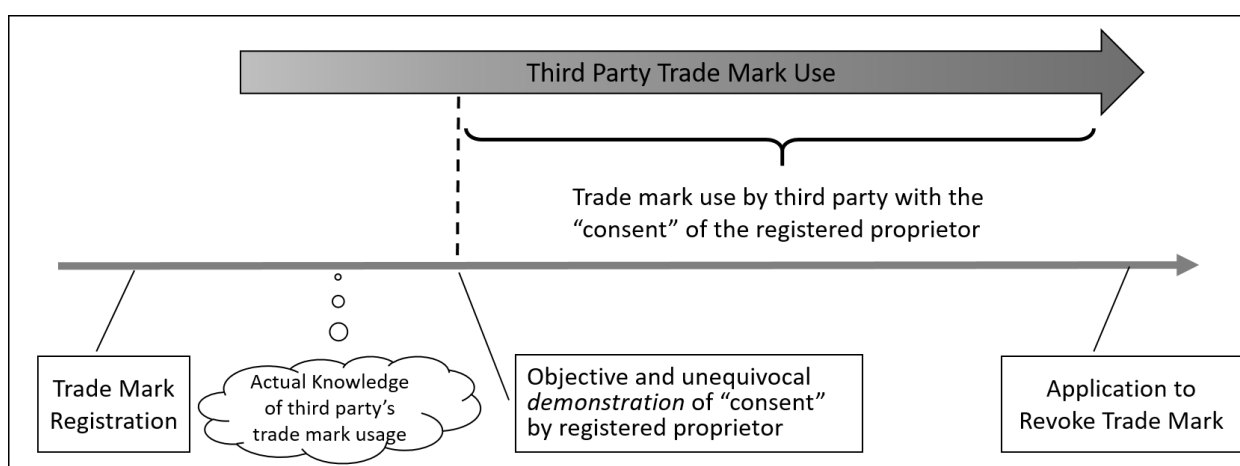


Diagram 1: Establishing “genuine use” of a registered trade mark, relying on acts of third party trade mark use that occur with the “consent” of the registered proprietor

96 The actions of third party parallel importers who make use of a registered trade mark could potentially fall into the second category of eligible third party trade mark usage described

above. This all depends on whether the third party's continued use of a registered trade mark in relation to parallel imports sold in Singapore can be regarded as occurring with the "consent" of the registered proprietor after the registered proprietor became aware of such usage. It is tempting to assume that parallel imports are viewed disfavouredly by registered proprietors who might otherwise want to exercise greater control over pricing and distribution-related matters. If the registered proprietors have not actually given consent to these parallel imported goods being brought into Singapore, how can they give actual consent to the use of the registered trade marks that have been applied to such goods? However, it is not inconceivable that registered proprietors might also be supportive of such parallel imports to the extent that they promote consumer awareness of their brands or help expand their domestic customer bases. In such scenarios, one might imagine registered proprietors indirectly demonstrating their "consent" to the use of their marks by third party parallel importers by engaging with the latter's customers through social media, promotional campaigns or other steps which indicate both its awareness of and assent to the trading activities of such third parties. A registered proprietor may go even further and provide repair or other after-sales services to purchasers of parallel imported products. Such actions, even in the absence of direct communication between the registered proprietor and the third party parallel importers, could arguably be enough to show that the third party's ongoing use of the mark takes place with the registered proprietor's "consent" after the registered proprietor has publicly adopted a supportive stance towards the commercial activities of the parallel importers.

97 In summary, I am of the view that if we adopt the *Festina* interpretation of "consent" under Section 22(1)(a) to require an "unequivocal demonstration of consent", the parameters of this legal criterion should be guided by the following principles:

- (i) A third party's use of a registered trade mark occurs with the "consent" of the registered proprietor where the latter has *expressly* consented to the third party's trade mark usage. Express consent may be inferred from the evidence adduced by the registered proprietor and can be established through indirect evidence.
- (ii) As the purported consenting party, the registered proprietor must prove that it had actual knowledge of the third party's acts of trade mark use that are alleged to have occurred with the registered proprietor's "consent".
- (iii) Apart from having actual knowledge of the third party's conduct, the registered proprietor must also show that it has taken positive steps that objectively indicate it has authorised, assented to or approved of the third party's use of the registered trade mark
- (iv) A third party's use of a registered trade mark takes place with the "consent" of the registered proprietor where the latter has explicitly *given* its consent to the former, with both parties in direct communication with each other. In addition, third party trade mark use can also take place with the "consent" of the registered proprietor even if the former has not received any direct, formal or prior authorisation from the latter. The registered proprietor can *demonstrate* its consent to a third party's use of the registered trade mark such that the former can rely on the actions of the latter to establish "genuine use" of the registered trade mark for the purposes of Section 22(1)(a) TMA. This requires the registered proprietor to, upon learning of the third party making use of the registered trade mark, respond with conduct of

its own that publicly, objectively and unequivocally, demonstrates its assent to the third party's continued or ongoing use of the registered trade mark.

98 In light of the above, the “Who” Issue in the present case requires us to determine whether the third party use of the registered trade marks, on the product images appearing on the webpages of the online retail stores found at www.indianproducts.com.sg and www.jothi.com.sg, amounts to use with the “consent” of the Proprietors.

99 Nothing in the evidence indicates that the Proprietors were aware of the e-commerce activities of www.indianproducts.com.sg before 10 January 2020 when the print-out of the archived screenshots was made, as discussed above in [67]. No direct supplier-distributor relationship between the operators of that website and the Proprietors has been established, making it impossible to show that the Proprietors had given their express consent to the former to make use of the registered trade marks. While the Proprietors submitted that they have met the standard of “implied consent” proposed in *Festina*, on the basis of their “constructive knowledge” of the website and their “acquiescence”, I am unable to agree that this is enough to be regarded as an unequivocal demonstration of “consent” from the Proprietors to www.indianproducts.com.sg to use these trade marks. Similarly, the Proprietors did not tender any evidence that they were actually aware of third party sellers offering products bearing “Fair & Lovely” trade marks on webpages from www.goo10.sg, www.shopee.sg and www.lazada.sg prior to August 2019, when screenshots were taken for inclusion in the Proprietors’ SD. There was also no evidence to indicate the source of these products whose images appear on these pages, preventing me from drawing any inferences that might support the Proprietors’ contention that these third party sellers had used made use of these trade marks with the Proprietors’ “consent”. Neither have the Proprietors tendered any evidence of any conduct on their part, after they became aware of these webpages, that publicly, objectively and unequivocally demonstrated their assent to the conduct of the third parties who have used the registered trade marks on these webpages.

100 On the other hand, I am satisfied that the third party use of the trade marks on www.jothi.com.sg was done with the consent of the Proprietors. The Applicants conceded this point as well because this website was operated by *Jothi Store and Flower Shop* and the evidence indicates that large quantities of Fair & Lovely skincare products were sold by the Proprietors to *Jothi Store and Flower Shop* during the Relevant Periods. Numerous delivery orders and sales invoices from 2012 and 2013 making reference to these products are found in the exhibits to the Proprietors’ SD. I am also prepared to infer that the Proprietors were indeed actually aware that their customer operated a physical store in Singapore as well as the website www.jothi.com.sg that featured the goods supplied by the Proprietors, and that their repeated supplies of products to this business customer should be regarded as some sort of authorised distributorship arrangement from which express consent, given by the Proprietors to this third party for this third party to use the Proprietors’ trade marks, should be inferred. So on the “Who” Issue, I would conclude that this facet of trade mark use has been established insofar as this website is concerned.

The “Where” Issue – Has the registered trade mark been used in Singapore?

101 That the trade mark use occurs on images of the Proprietors’ product packaging on the webpages of third party operated websites requires the Proprietors to prove that their trade marks have been used *in* Singapore, as required by Section 22(1)(a) TMA. Unlike some of the other “W” Issues addressed earlier, the law in this area is, thankfully, quite settled. When the

alleged use of a trade mark occurs in an online context, either as part of a website address or in the contents of a website or webpage, the Singapore courts have applied the following test, based on Buxton LJ's decision in *800-FLOWERS Trade Mark* [2002] FSR 12 at [138], to determine if such use has occurred within Singapore:

[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 [trade mark owner] that goes beyond providing facilities that enables others to bring the mark into the area.

Such "active step[s]" ... could take the form of "direct encouragement or advertisement by the [trade mark owner]"... which led consumers to the website featuring the trade mark in question...²⁸

102 On the facts of the present case, I am prepared to accept that the Proprietors have demonstrated that the two websites we are concerned with – www.indianproducts.com.sg and www.jothi.com.sg – have taken "active steps" to bring the trade marks to the Singapore market. This interpretation of the evidence was conceded by the Applicant as well. That these websites have ".sg" domain names suggest that they are targeted at a Singapore audience since they facilitate better search engine optimisation outcomes, where the website operator is able to maximise the number of visitors from Singapore by ensuring that the website appears high on the list of results returned by a search engine used by Singapore-based consumers. The print-outs of the webpages of these online stores also reveal other indicators that these websites were directly reaching out to Singapore customers. There is a banner labelled "Indian Products Online Store – Singapore [SG] Free Express Shipping on Order above 100SGD" on the webpage for www.indiaproducts.com.sg. Over on www.jothi.com.sg, the webpages include the contact details of the physical store in Singapore, with the store's street address in Little India and two Singapore land-line contact numbers displayed under headers labelled "Reach Us" and "Need Help? Contact Us".

103 It follows that, on the "Where" Issue, I would conclude that there has been use, *in* Singapore, of the Fair & Lovely trade marks, which are visible from the photographic images of product packaging to which such marks have been applied, on webpages found at these two websites. Given my conclusions above at [09]-[100], that only the instances of third party trade mark use associated with www.jothi.com.sg were made with the "consent" of the Proprietors, the scope of the remainder of the inquiry – the "What" Issue – has been whittled down to just this website.

The "What" Issue – Has the registered trade mark (or a legal equivalent that qualifies under Section 22(2) TMA) been used?

104 Applying the three-stage test from *The Patisserie* discussed above, at [31], to the instances of trade mark usage that have occurred on the webpages of www.jothi.com.sg, the analytical framework of Section 22(2) TMA requires comparative scrutiny of (i) the registered forms of the Series Mark and the Logo Mark, against (ii) the actual forms in which the trade marks were used on the product packaging images appearing on this website.

²⁸ This test has been cited and applied by the Singapore Court of Appeal in *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 at [54], the Singapore High Court in *Weir Warman* at [106] and the Intellectual Property Office of Singapore in *Lisbeth* at [24].

<p>Subject Marks</p> <p>(Forms in which the trade marks were registered)</p>	<p>Trade marks used on product images appearing on www.jothi.com.sg</p> <p>(Forms in which Proprietors have actually used their marks)</p>
<p>The Series Mark (T0808259J):</p>  <p>The Logo Mark (T8802249B):</p> 	

Stage 1 (Identification of distinctive character of registered forms of trade marks)

105 The Series Mark appears to have at least two visually distinctive components – the words “Fair & Lovely” with an oversized ampersand and printed in a cursive font with pronounced serifs, as well as a dual-head pictorial element comprising two female faces with contrasting skin tones. The lighter-tone face is visibly smiling while the darker-tone face has a more neutral expression. In my view, the overall distinctive character of this mark lies in the combination of these two components which are framed together within a rectangle, in portrait form, as a single trade mark.

106 The Logo Mark appears to have two visually distinctive components as well – the words “Fair & Lovely” in a single line and printed in a cursive font, as well as a black-and-white drawing of a composite image of two female faces in side-profile, incorporating stylised representations of their long flowing hair with what appears to be floral ornamentation. In my view, the overall distinctive character of this mark lies in the combination of these two components which are integrated into an elongated rectangular block, in landscape form, as a single trade mark.

Stage 1.5 (Identification of forms of actual use)

107 For the reasons I have given above at [61] – [62], I would have identified the forms of actual trade mark use as limited only to those features which, objectively, would be regarded by average consumers as badges of origin. In this case, the “narrow form” approach would have led me to focus only on the words that “Fair & Lovely” that appear on all the product packaging. However, as both parties in the present case take the position that the “broad form” approach should be applied, I will treat the forms of actual trade mark use as encompassing everything that surrounds the words “Fair & Lovely” – including the pictorial images, descriptive words and other design elements that have been incorporated into the product packaging of the different skin-care products featured on www.jothi.com.sg.

Stage 2 (Comparison)

108 Comparing the various product packaging images that appear on www.jothi.com.sg (on the assumption that these are indeed attempts by the Proprietors to make actual use of their registered trade marks) against the graphic representations of the Series Mark and the Logo Mark (the registered forms of the trade marks in issue), the following differences are likely to be immediately apparent to the average consumer.

- (i) As compared to the Series Mark, the product packaging images appear to partition the two visually distinctive components (the words “Fair & Lovely” and the photographic image) with words (too faint to read because of the poor image resolution) that presumably describe the purpose or functions of the goods.
- (ii) As compared to the Series Mark, the product packaging images do not include the rectangular portrait framing of the trade mark. Instead, the product packaging introduces a new framing element that is applied around the photographic images of the models’ faces, comprising asymmetrical curved lines that are consistent with other visual design elements elsewhere on the packaging.

- (iii) As compared to the Series Mark, the product packaging images depict varying photographic images of different models' faces. A pair of male faces appears on two product packaging images. While female faces appear in the other product packaging images, their faces are cropped and unsmiling. The relative proportions of the models' faces are clearly different when compared to the Series Mark. On the product packaging, the faces in the background occupy less than 20% of the space occupied by the faces in the foreground. In the Series Mark, the face in the background occupies about 80% of the space occupied by the face in the foreground.
- (iv) As compared to the Logo Mark, the product packaging images are in colour rather than in black-and-white. Rather than line-drawings of side profiles of female heads, photographic images of models' faces appear on the product packaging images.

Stage 3 (Evaluation)

109 It must be reiterated that the principal legal question to be answered in Section 22(2) TMA is whether there has been actual use of the registered trade mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. Whether or not the forms in which the trade mark has been actually used are *similar* to the registered form of the trade mark is *not* in issue, must less the degree of resemblance between them. Having compared the forms in which the trade mark have been used in the product packaging images found on www.jothi.com.sg, I am inclined towards the view that the additions, alterations and adaptations that have been made to the latter are significant enough to disqualify them as legal equivalents to Subject Marks, regardless of the visual similarities between them.

110 Under Section 22(2) TMA, the permissible margin for variation between the registered form of a trade mark and the form in which it has been actually put to use is narrow – for the reasons outlined above at [32(iii)]. Trivial or *de minimis* deviations from the registered form of the trade mark would presumably thus fall within the scope of Section 22(2) TMA because the distinctive character of the trade mark's registered form would, presumably, remain unchanged. However, other departures which result in *any* alteration of the distinctive character of the registered form is enough to render the form of actual use a non-equivalent use of the registered trade mark; there is *no need for* there to be a *significant* or *substantial alteration* of its distinctive character.

111 In the present case, the product packaging images found on www.jothi.com.sg relied upon by the Proprietors to defeat the Applicants' revocation action appear to exhibit visual cues that broadly correspond to the distinctive components of the Series Mark and Logo Mark, echoing the combination of the “Fair & Lovely” word element and the dual-head pictorial elements. However, given the numerous differences between the Series Mark and the Logo Mark – in terms of their composition, how their components have been expressed and the ideas that are visually conveyed by their components – it is necessary to evaluate each Subject Mark, individually, against the product packaging images depicted in [104] above.

112 Where the Logo Mark is concerned, what appears on the product packaging images substantially deviates from the registered form of the trade mark, without any trace of the rectangular landscape composition of the component elements or pictorial illustrations of the Logo Mark. The drawings of the female side-profiles in the Logo Mark have been replaced with photographs of models' faces in the product packaging images. The inescapable

conclusion reached is that these alleged instances of actual trade mark use on the product packaging images must be regarded as uses which “alter the distinctive character of the [Logo Mark] in the form in which it was registered” and thus cannot be relied upon to prove genuine use of this registered trade mark.

113 The task of evaluating the alleged instances of trade mark use on the product packaging images against the registered form of the Series Mark is less straightforward. It is common knowledge that the human eye (and mind) is predisposed to identifying patterns and making connections between separate objects. Some degree of circumspection is required because a side-by-side comparison of these images (which is unavoidable in the context of the current proceedings) may affect how we perceive them and the legal conclusions that we may draw from such perceptions, as opposed how these images might be viewed – separately – through the eyes of the average consumer with imperfect recollection. Furthermore, the average consumer is likely to spend only a fraction of the time that an adjudicator would have spent looking at the forms of a trade mark.

114 On the one hand, the following characteristics of the Series Mark appear to have been preserved in the product packaging images: the verticality of the composition and its constituent components, the word-arrangement format of the “Fair & Lovely” word element and the dual-head pictorial element, though the models’ faces and their relative proportions are clearly different. Arguably, the idea that is visually communicated by the dual-head pictorial element in the Series Mark – the transition from darker skin to lighter skin – also appear to have been carried though into the product packaging images, albeit less emphatically.

115 However, it also appears that elements of the Series Mark have been disaggregated, reconfigured and reconstituted alongside other additional design elements not found in the registered form of the trade mark. These additional design elements include aesthetic features (new colours, shapes and fonts) as well as descriptive details, which presumably communicate the qualities or intended functionality of the products, that are integrated into the overall product packaging designs. For example, the pictorial element seems to have been altered to reflect the gender of the intended customer and other consumer-marketing considerations. The rectangle frame around the word and pictorial elements is absent, while the image of the models’ faces on the product packaging is framed with curved lines instead. It would appear as if the distinctive components of the registered trade marks have been purposefully adapted to suit the design parameters of the product packaging variants for different “Fair & Lovely” skincare products. To borrow from the language of Copyright Law, while it appears as though some of the “ideas” embedded within the Series Mark have found their way into the product packaging images, the “expressions” of these ideas vary according to the design briefs associated with each product. The legal question posed by Section 22(2) TMA is whether these different “expressions” – the actual forms in which the mark have been allegedly used – have altered the distinctive character of the Series Mark’s registered form.

116 Upon reflection, my considered response to this question is “Yes”. The distinctive character of the registered form of a trade mark resides in that which has been visually expressed via the graphic representation found on the Trade Marks Register. While an average consumer with imperfect recollection looking at the product packaging images may possibly perceive elements or take in ideas that correspond to those that are found in the Series Mark, he or she cannot be said to have been meaningfully exposed to the source-indicating or quality-assurance functions of *that* registered trade mark. Genuine use of the Series Mark requires the use of a variant mark that exhibits the distinctive character of the registered form of that trade

mark, which must include the expressive forms of the distinctive components of *the* Series Mark. Otherwise, if trade mark use could be demonstrated simply by making use of variant marks that conveyed general ideas corresponding to those discernible from the registered form of the trade mark, then the breadth of Section 22(2) TMA would become intolerably uncertain. Registered trade mark proprietors would be entitled to hold on to their trade mark registrations, without making actual use of the specific forms in which their trade marks appear on the Register, simply by relying on their usage of variant marks that appeal to ideas or concepts that connect them to the registered forms of their trade marks.

117 When evaluating the product packaging images, depicted above in [104] above, against the entirety of the Series Mark, my view is that none of these different product packaging images have captured the distinctive character of the Series Mark – the combination of the “Fair & Lovely” word element and the dual-head pictorial element brought together, in a portrait layout, arranged within a rectangular frame. Some of these components have been extracted and recombined with numerous extra elements by the product packaging designers, including aesthetic flourishes and descriptive phrases that serve non-trade-mark purposes. The combined visual effect of these additions, alterations and adaptations is to convey product information to, and attract the purchasing interest of, potential customers who are exposed to these different product packaging designs rather than communicating that which gives the registered form of the trade mark its distinctive character. Average customers with imperfect recollection (or anyone else for that matter) looking at these product packaging images will not be able to perceive the registered form of the Series Mark, nor will they discern any variant mark that should be regarded as a legal equivalent of that registered form.

118 The analysis above leads to the conclusion that that which has been put to actual use on the product packaging images found online at www.jothi.com.sg are *not* the Logo Mark or the Series Mark; the Proprietors thus stumble on the “What” Issue because the marks that have been applied on these product packaging images do not qualify as eligible variants of the registered forms of these trade marks under Section 22(2) TMA. As a side note, I would have reached the same conclusion, but with much less struggle, had I adopted the “narrow form” approach discussed above (at Stage 1.5) and simply confined the comparative and evaluative process to the “Fair & Lovely” word mark, that appears on all the product packaging images, as the “form” in which the Proprietors have actually used their trade mark; these “forms” of actual trade mark use omit the dual-head pictorial element which, as a distinctive component of the registered form of the trade mark, would naturally have altered the distinctive character of the Series Mark and the Logo Mark.

Conclusion

119 As the Proprietors have not been able to demonstrate evidence of “genuine use” of the Subject Marks for the purposes of Section 22(1)(a) TMA – that is, actual use of the registered trade mark which cumulatively satisfies the five “W” Issues that have been analysed above – it follows that the Applicants’ action for trade mark revocation on grounds of non-use is successful.

120 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the revocation succeeds under both Sections 22(1)(a) and 22(1)(b) TMA. The Subject Marks are revoked as from the following dates, being the first day immediately following the end of each of their respective “First 5-Year Period”. The Applicants are also entitled to costs to be taxed, if not agreed.

Registration Number / Subject Mark	Date of Revocation
T8802249B (The Logo Mark)	21 July 1995
T0808259J (The Series Mark)	17 October 2013
T0404547Z (The Word Mark)	25 September 2017

121 I must also thank counsel for both parties for their indulgence in addressing some of the more esoteric issues encountered in the present proceedings and for their helpful written and oral submissions.

122 Upon completion of the trade mark registration process, the form in which a trade mark is registered is frozen in time, with the registered proprietor’s statutory trade mark rights crystallising around the graphic representation of the mark that had been entered into the trade marks register. As time goes by, and with periodic renewals of the registration, the registered proprietor can continue to, perhaps indefinitely, enjoy the bundle of exclusive rights conferred upon it by statute so long as it has put *that* registered trade mark to genuine use. In the real world of commerce, however, trade mark proprietors have to adapt their product design, marketing and branding strategies to ever-changing market conditions, where what might have been fashionable in the past may no longer be relevant, or appropriate, in the present when different socio-cultural norms prevail. To the extent that their earlier registered trade marks may appear anachronistic by contemporary standards, registered proprietors may have to file fresh trade mark applications for variant trade marks that more accurately reflect the contemporary forms of the trade marks that they put to actual use – assuming, of course, that they are still interested in continuing to enjoy trade mark protection. Otherwise, once the statutorily prescribed periods of time have elapsed, their trade mark “fossils” become vulnerable to revocation on grounds of non-use – a risk which has materialised, unfortunately for the Proprietors, in this case.

123 The burden of proving trade mark use that is borne by a registered trade mark proprietor, in order to defeat an action to revoke its trade mark registration, is not easily discharged. Not only must it prove that the trade mark which it has actually put to use is *the* trade mark that has been registered, it must also adduce evidence of when and where that use occurred (during the time periods prescribed by statute and within Singapore), show that the trade mark has been used in relation to the goods or services specified in the trade mark registration *and* demonstrate that such trade mark use was carried out by the proprietor or with its consent. Only registered proprietors whose efforts have enabled their trade marks to perform source-indication and quality-assurance functions in Singapore deserve to hold on to the exclusive rights conferred upon them by statute. Therein lies the *quid pro quo* which underlies the trade marks regime.

Date of Issue: 22 September 2021