

Newsletter

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In This Issue:

Indonesia and Thailand
Join the Madrid Protocol

Amendments to Patents
Act and Registered
Designs Act Come Into
Force for Singapore

*Daidoh Limited v. New
Yorker S.H.K. Jeans
GmbH & Co. KG [2017]
SGIPOS 16*

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Thailand and Indonesia Join The Madrid Protocol

Thailand and Indonesia have recently acceded to the Madrid Protocol, bringing the total membership of the Madrid System to 100 members.

The Madrid System allows local brand owners to protect their marks in any Madrid System member territory, by filing a single international application and paying a single set of fees. It provides for an easy method to expand protection into new markets, and is also cost-effective for brand owners who seek to build up a global trade mark portfolio.

Thailand deposited its instrument of accession on 7 August 2017, and the Protocol will enter into force for Thailand on 7 November 2017. Indonesia acceded to the Protocol on 2 October 2017, and it will come into force for Indonesia on 2 January 2018.

More information can be found in WIPO's press releases [here](#) (for Thailand) and [here](#) (for Indonesia).

Amendments to Patents Act and Registered Designs Act Come Into Force for Singapore

The Patents (Amendment) Act 2017 was passed in Parliament on 28 February 2017 and has come into force on 30 October 2017.

The amendments to the Patents Act broaden the scope of the grace period for patent applications, and requires patent applications which are filed after a prescribed date (1 January 2020) to undergo local or mixed search and examination routes, eliminating the option of having a foreign patent office conduct the search and examination report for the application. This will ensure that the patents granted by the Singapore patent office are of consistent quality, as all granted patents will have to meet the requirements for patentability under Singapore law.

A public consultation on these amendments to Singapore's patents regime was conducted in July 2017. More information on this can be found in our client alert [here](#).

The Registered Designs (Amendment) Bill was read on 3 April 2017 and has come into force on 30 October 2017. Key changes include:

- (1) A widened scope of registrable designs;
- (2) Shifting ownership from the commissioning party to the designer; and
- (3) Simplifying the procedural scheme for filing registered designs.

More details of these changes can be found in an earlier edition of our newsletter [here](#).



Daidoh Limited v. New Yorker S.H.K. Jeans GmbH & Co. KG [2017] SGIPOS 16

Facts

New Yorker S.H.K. Jeans GmbH & Co. KG. (the “**Applicant**”) filed an application to revoke Daidoh Limited’s (the “**Registrant**”) registered trade mark

NEWYORKER (T0720728D) in Class 25 (the “**Subject Mark**”) on the basis of non-use. The specifications of the Subject Mark are as follows:

"Clothing; hats; neckties; shawls; underwear; socks; belts (clothing); boots; shoes; sandals; gloves (clothing); scarves; caps (headwear); garters; sock suspenders; braces for clothing (suspenders); bands (for wear); sweat bands for the head; sweat bands for the wrist; costumes (masquerade); sports clothes (other than golf gloves); shoes and boots for sports; suits; jackets; shirts; knitwear (clothing); clothing of knitted textiles; pants; skirts; coats; dresses; vests; blouses; sweaters; trousers; outerclothing; bathing drawers; bathing suits; breeches (for wear); top coats; collar protectors; combinations (clothing); cuffs; footwear; fur (clothing); gabardines (clothing); dressing gowns; half-boots; headgear for wear; hoods (clothing); hosiery; stuff jackets (clothing); jumpers (shirt fronts); muffs (clothing); overcoats; overalls; pajamas; parkas; pullovers; ready-made clothing; slippers; spats; waistcoats."

The Applicant sought to have the order for non-use revocation backdated to 6 September 2011, as it had filed for its own mark " **NEWYORKER**" (T1205572A) which conflicted with the Subject Mark, on 7 September 2011. The Registrant filed an opposition against the Applicant's mark and in response, the Applicant commenced this revocation action. The opposition proceedings were held in abeyance until this revocation action resolved.

The Applicant had also engaged private investigators to make site visits to Takashimaya and to the Registrant's local distributor, Style Works Pte Ltd. Video recordings of these visits were submitted as evidence, along with a statutory declaration from the private investigator. These gave the Applicant a reasonable basis for doubting that the Subject Mark had been put to genuine use within the relevant time period (i.e., 2 January 2009 to 2 January 2014).

The Registrant's evidence included invoices, advertisements displayed in Singapore, photographs of retail locations featuring products which bore the Subject Mark, a letter from Takashimaya Singapore Ltd. confirming that the products bearing the Subject Mark were sold at the relevant time periods, amongst others.

Ultimately, the burden of proving genuine use of the Subject Mark fell on the Registrant, which successfully adduced evidence to prove use of the Subject Mark in 2012 and 2013.



Decision

(i) *Revocation for non-use*

Notwithstanding the Applicant's evidence which showed reasonable doubt of genuine use of the Subject Mark, the Registrar found that even at its highest, such evidence could not negate the Registrant's evidence of use of the Subject Mark.

The applicable legal principles regarding genuine use are:

- (a) There must be genuine / *bona fide* use of the Subject Mark, in the course of trade, in relation to the goods for which the Subject Mark is registered, within the relevant time periods.
- (b) Use need not be in large quantities, and there is no *de minimis* threshold before the use can be considered genuine. However, token use for the sole purpose of preserving rights, or internal use, does not constitute genuine use.
- (c) Ascertaining whether there has been genuine use is highly fact-specific, and there is no single objective formula to apply across the board.
- (d) The fewer the acts of use relied upon, the stronger the evidence must be to establish that such acts actually took place.
- (e) Conversely, where there are a number of acts of use relied upon, the Registrant would have to prove on a balance of probabilities, that those acts actually took place.
- (f) For use to be genuine / *bona fide*, it must be used as a badge of origin.

On the evidence, the Registrar found that the Registrant had put the Subject Mark to genuine use, in respect of some, but not all of the goods for which it had been registered, during the relevant 5 year period following registration of the Subject Mark.

The test for determining which goods should be retained was "*what would be a fair specification of goods having regard to the use that the Proprietor has in fact made of the mark and assuming further that he will continue that use.*" (at [61]).

Accordingly, the Registrar ordered a partial revocation to remove footwear (and all types of footwear described) from the specifications of the Subject Mark, as he found that there was no evidence that the Subject Mark had ever been used in relation to footwear within the relevant 5-year period. After deliberating on the goods which the Registrant did not actually deal with, but which were mentioned in the specifications, the Registrar also ordered that "*costumes (masquerade)*" should be removed from the specifications.



(ii) *Backdating of Order*

As to whether the Registrar could backdate the order for partial revocation to a period that fell within the "grace period" of 5 years after a mark had been registered, the relevant provision is Section 22(7) of the Trade Marks Act ("**TMA**"):

"(7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from —

(a) the date of the application for revocation; or

(b) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date."

The Registrar rejected the arguments raised by the Applicant, as by allowing the backdating to a date which fell within the 5-year time period, the Applicant would be granted a form of relief that it would not have been entitled to in the first place under section 22(1) of the TMA. Section 22(1)(a) of the TMA provides:

"[A registered trade mark may be revoked for non-use if] 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."

Based on a plain reading of Section 22(1)(a), the Registrar was of the view that it essentially allowed third parties to revoke an earlier mark for non-use, but it also gave the registered proprietor a "grace period" of 5 years to put the mark to genuine use — and this ground of revocation can only arise after the relevant 5-year time period. This position was supported in other Commonwealth jurisdictions, by cases in the United Kingdom and well as an extract from the Hong Kong Trade Marks Registry's Work Manual.

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Comments

This case is notable for clarifying that any backdating of the revocation cannot fall within the 5-year "grace period", as such an order is not within the Registrar's powers, based on Section 22(7) read in conjunction with Section 22(1)(a) of the TMA.

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