

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

Trade Mark No. T0626526D  
7 January 2019

**IN THE MATTER OF A TRADE MARK REGISTRATION**

**IN THE NAME OF**

**AALST CHOCOLATE PTE LTD**

**AND**

**APPLICATION FOR REVOCATION THEREOF BY**

**THE PATISSIER LLP**

Hearing Officer:     Burton Ong  
                                  IP Adjudicator

Ms Teresa O'Connor (Infinitus Law Corporation) for the Applicant

Mr Darrell Low, Mr Samuel Wee and Ms Jacinth Chua (Yusarn Audrey) for the  
Registered Proprietor

**GROUND OF DECISION**

1     When an application to register a trade mark is made to the Registrar of Trade Marks, the applicant is required to submit “a clear representation of the trade mark”, “list the goods or services in relation to which the applicant seeks to register the mark” and state “that the trade mark is being used in the course of trade... in relation to those goods or services” or “that the applicant has a bona fide intention that the trade mark should be so used”.<sup>1</sup> What happens if, after securing his trade mark registration, the proprietor decides to use an altered form of the trade mark that he has registered? Should the proprietor be entitled to keep his trade mark registration if the trade mark he

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<sup>1</sup> Section 5, Trade Marks Act (Cap 332, 2005 Rev Ed).

has actually put to use on his goods diverges from the form in which he has represented his trade mark on the register of trade marks?

2 Trade mark revocation proceedings for non-use of a registered trade mark may be pursued when the registered trade mark proprietor has not made genuine use of the mark for a 5-year period following the date of completion of the registration procedure. Where an applicant seeking the revocation of a registered trade mark is successful in such proceedings, the unused trade mark is expunged from the trade marks register, making it possible for other traders to register, or make use of, marks that are identical or similar to the registered trade mark. In many cases, the focus of the non-use inquiry is on *whether* the registered trade mark had been put to use by the proprietor in relation to his goods and services and the *extent* of such usage. In such cases, the question to be addressed is whether he has used the trade mark as part of a genuine effort at supplying goods and services to the market, or whether such use “colourable” or “token” in nature. This case is different insofar as there is ample evidence that the registered trade mark proprietor has made extensive use of *a* trade mark, but in a form that is undeniably different from the form in which his mark appears on the trade marks register. So the dispute here is concerned with *what* the registered trade mark proprietor has put to use after successfully registering a particular trade mark. Should the registered proprietor’s use of a mark, where the *form in which it was actually used* differs from the *form in which it was registered*, be regarded as a genuine use of *that* registered trade mark? Where the registered proprietor of a trade mark makes use of the mark in a form which diverges from the form in which his trade mark has been recorded on the trade marks register, should he be entitled to retain the legal monopoly derived from his trade mark registration and keep his registered trade mark on the trade marks register?

3 Aalst Chocolate Pte Ltd is the Registered Proprietor (“the Proprietor”) of the following trade mark:



(“the Subject Mark”), in Singapore in Class 30 in respect of “Chocolates; chocolate-based products; cocoa products; chocolate chips; chocolate bars; chocolate candy; chocolate creams; chocolate extracts; chocolate-based beverages; chocolate beverages with milk; chocolate sauce; chocolate fudge; liqueur chocolates; milk chocolate; chocolate coated nuts; chocolate truffles and sweets; cocoa; coffee-based beverages; snack foods consisting principally of chocolate; chocolate base aerated beverages; cocoa-based beverages; chocolate wafers; confectionery; biscuits; cakes; coffee; tea; tea-based beverages; caramels [candy]; candy for food; cookies; prepared desserts [chocolate based]; flavorings, other than essential oils, for beverages; ice cream; pastry; pies; sugar confectionery; puddings; fondants [confectionery]; mousse confections; bread and bakery products; buns; prepared snack foods; tarts, all included in class 30” (“Specification of Goods”). Registration of the Subject Mark was completed on 24 July 2008. The Proprietor is a Singapore-based company in the business of manufacturing and selling chocolates and chocolate-based products.

4 On 28 September 2017, The Patisserie LLP (“the Applicant”) filed an application for revocation of the Subject Mark. The Proprietor filed its counter-statement and evidence in support on 18 January 2018.

5 The Applicant filed evidence in support of the application on 30 April 2018. The Proprietor filed further evidence in support of maintaining the registration on 21 May 2018. The Applicant filed supplementary evidence in support of the application on 30 August 2018. Further to that, the Applicant made a request for leave to cross-examine the Proprietor’s witness, Kwan Hoi Chee Deborah Connie. Leave was not granted as the Applicant’s request for leave to cross-examine was not adequately supported by good reasons. The parties then made their oral submissions before me on 7 January 2019. Subsequently, within two weeks of the oral hearing, the parties filed supplementary written submissions on the partial revocation issue.

### **Grounds of Revocation**

6 The Applicant relies on the grounds of non-use under Section 22(1)(a) and (b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”) in this revocation. In the alternative, the Applicant sought partial revocation of the Subject Mark, by virtue of Section 22(6) of the TMA, in respect of some of the goods for which the trade mark has been registered.

### **Proprietor’s Evidence**

7 The Proprietor’s evidence comprises the following:

- (i) a Statutory Declaration made by Kwan Hoi Chee Deborah Connie, Chief Operating Office and Director of the Proprietor on 18 January 2018 in Singapore (“Proprietor’s SD1”) and
- (ii) a Statutory Declaration made by the same Kwan Hoi Chee Deborah Connie (“Proprietor’s SD2”), on 14 May 2018 in Singapore.

### **Applicant’s Evidence**

8 The Applicant’s evidence comprises the following:

- (i) a Statutory Declaration made by Tan Siang Oon, the acting partner of the Applicant on 26 April 2018 in Singapore (“Applicant’s SD1”) and
- (ii) a Supplemental Statutory Declaration made by the same Tan Siang Oon, on 27 August 2018 in Singapore (“Applicant’s SD2”).

### **Burden of Proof**

9 Under Section 105 of the TMA, the Proprietor has the burden of showing that he has made genuine use of the Subject Mark in Singapore.

### **Background**




10 The Applicant is a Singapore-based company in the business of selling pastries, sweets, candies, chocolates, confectionery and cakes. The Applicant is the registered

proprietor of Trade Mark Nos. T0518520H and T0518521F, registered in Classes 30 and 35, for “ *The Pâtissier* ”.

11 Apart from the current proceedings, there are separate, but related, ongoing cross-disputes between the parties, with the Proprietor seeking to invalidate the Applicant’s registered trade mark, while the Applicant is opposing other trade mark applications made by the Proprietor in 2017 for marks comprising the word “pâtissier” as one of their components.

12 In the current proceedings, the crux of the Applicant’s case is that the registration for the Subject Mark should be revoked because the Proprietor has not used the mark in the form in which it was registered. In the Applicant’s written submissions (“AWS”) and during the oral hearing, without disputing that the Proprietor had clearly sold its goods in packaging that bore various trade marks, the Applicant focused on the fact that the forms in which these marks appeared on the Proprietor’s goods were different from the form in which the Subject Mark was recorded on the trade marks register. The evidence tendered by the parties indicates that, during all the relevant time periods, the Proprietor had applied individual components from the Subject Mark as discrete marks, albeit “in close proximity” towards each other, on the packaging of their chocolate-based products. So the central legal question to be addressed in this case is whether the form in which the mark has been used by the Proprietor should be regarded as a “genuine use” of the registered trade mark for the purposes of Sections 22(1) and 22(2) of the TMA.

13 There are essentially three components to the Subject Mark: (i) the word “Pâtissier” in cursive, (ii) the toque or chefs’ hat device and (iii) the “by Aalst Chocolate” text block. For the purposes of this case, components (i) and (ii) can be combined together and will be referred to in this decision as the “Pâtissier-hat” device, while element (iii) will be referred to as the “Aalst Chocolate” word element.

Subject Mark	Pâtissier-hat device	Aalst Chocolate word element
		

14 The Proprietor also owns a separately registered trade mark (Trade Mark No. T0620036GD) which combines a picture of the lower case letter “a” in large font, incorporating what looks like a cocoa fruit or cocoa bean, together with the words “Aalst Chocolate”. This trade mark, which I shall refer to as the “Aalst house mark” device, appears in the letterhead of all the tax invoices issued by the Proprietor which were admitted into evidence as exhibits supporting the Proprietor’s SD1. The Aalst house mark device has been frequently used on the Proprietor’s product packaging in

conjunction with the Pâtissier-hat device. Two of the strongest examples of the concurrent usage of the Aalst house mark device alongside the Pâtissier-hat device, taken from the Proprietor’s statutory declarations, are set out below.



Example of Proprietor’s usage of Pâtissier-hat device (alongside Aalst house mark device)	Source (dates of usage)
	<p>Proprietor’s SD1 [7](1) and Tab B pg73</p> <p>Packaging Design for “1 kg Standing Pouch” (Around 2007)</p>
	<p>Proprietor’s SD1 [7](iv) and Tab B pg 79</p> <p>“Tub of Pâtissier Chocolate” (Around 2007)</p>

15 In the Proprietor’s written submissions (“PWS”) and at the hearing before me, the Proprietor’s main argument to support its use of the Subject Mark hinged on its

claim that the “components” of the Subject Mark (i.e. the Pâtissier-hat device and the Aalst Chocolate word element) “have always been used in close proximity” on its product packaging, with reliance placed on the fact that the words “Aalst Chocolate” in the Aalst Chocolate word element can also be found within the Aalst house mark device (PWS at [10] and [13]). References were also made by the Proprietor in its submissions and evidence to numerous product invoices issued to its customers over the years that contained the words “Aalst Chocolate” and “Patisser” (a misspelt reference to “Pâtissier”) to support its contention that “the average consumer... is likely to associate such brand as originating from Aalst” (PWS at [11] and [14]).

16 However, during the hearing, the Proprietor conceded that there was *no evidence of any use* of the Subject Mark *in the exact form* in which it had been registered. At that stage, the focus of the hearing turned to the legal question of whether the Proprietor’s usage of the Pâtissier-hat device, on its own, qualified under Section 22(2) TMA as a “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”. If so, then such usage could be relied upon to repel the allegation of non-use on which this revocation application is premised. If not, then the application to revoke the Subject Mark for non-use of the trade mark should be granted. The parties then proceeded to give their legal submissions on how the statutory test in Section 22(2) TMA should be interpreted and applied to the facts of this case.

17 In the alternative, should the Proprietor’s use of the marks fall within the scope of Section 22(2) TMA and genuine use of the Subject Mark is established, the Applicant sought to have the Proprietor’s trade mark registration partially revoked, pursuant to Section 22(6) TMA, to the extent that the Subject Mark had *not* been used on various categories of goods listed in the Proprietor’s Specification of Goods. As the parties were not prepared to address the partial revocation issue in detail during the oral hearing, they were directed to make supplementary written submissions and propose how the Specification of Goods might be narrowed down if partial revocation was granted.

## MAIN DECISION

### Ground of Revocation under Section 22(1)(a) and (b)

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

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

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

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

...

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

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

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

(emphasis mine)

19 While the language of Section 22(1) 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 is not discretionary.<sup>2</sup> Once it is established that a registered trade mark has not been put to “genuine use” over the relevant statutory time periods, that registration must be revoked. Starting from the premise that the “genuine use” of the trade mark referred to in Section 22(1) requires use of the trade mark in the form in which it was registered (i.e. the graphical representation on the record of the trade marks register), it is clear from the italicised portions of Section 22(2) above that Parliament intended to give trade mark proprietors some latitude as to what counts as a “use” of the registered trade mark. The registered trade mark proprietor is statutorily permitted to rely on usages of the 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” to establish that that the registered trade mark has been put to “genuine use”.

### Relevant Dates

20 In line with the parameters of the Applicant’s pleadings, the relevant dates under consideration are as follows:

- (i) **Section 22(1)(a)**: The registration procedure was completed on 24 July 2008. The 5-year period immediately following the completion of registration ended on 24 July 2013. Thus, the period of use (or non-use) in issue is 25 July 2008 to 24 July 2013 (the “First 5-Year Period”).
- (ii) **Section 22(1)(b)**: The application for revocation was filed on 28 September 2017. The 5-year period prior to this filing starts from 28 September 2012. The period of use (or non-use) in issue is 28 September 2012 to 27 September 2017 (the “Second 5-Year Period”).

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

## Revocation of Registered Trade Marks – First Principles

21 Before identifying and analysing the legal test(s) to be applied under Section 22(2) TMA to determine whether the Proprietor has put the registered trade mark to genuine use, it may be helpful to set out the underlying policy rationales behind the trade mark revocation mechanism within the trade mark law framework.<sup>3</sup> Non-use of a registered trade mark can result in the revocation of the trade mark registration because of:

- (i) *The inaccuracy rationale.* The accuracy of the trade marks register is jeopardised by the continued presence of the registered trade mark within the trade mark registration system. As a public record of all the statutorily created intellectual property rights protected by the TMA, the trade marks register performs an important notification function to rival traders and the public at large. By communicating what trade marks have been registered for use by their proprietors, entries found on the trade marks register “notify rival traders dealing in similar products of their rights over particular trade marks possessed by the registered proprietor” (per VK Rajah JA, *Weir Warman* at [42]). The accuracy and currency of entries in the trade mark registration system matters because they influence the commercial choices made by rival traders as to what signs they can, or should, use themselves when marketing their goods, and what steps should be taken to avoid infringing upon trade mark monopolies already in existence. Public confidence in the fidelity of the trade mark registration system will be undermined if the trade marks register is not kept up to date, where registered trade marks which have not been put to genuine use by their proprietors are not expunged from the trade marks register.
- (ii) *The unjustified legal monopoly rationale.* The registered proprietor no longer deserves to enjoy the proprietary rights created by the trade mark registration when the registered trade mark is not performing the origin-indicating function that justified the existence of the legal monopoly in the first place. The exclusive rights created by the registration of a trade mark do not subsist for the personal amusement or gratification of the registered trade mark proprietor. The legal monopoly sustained by the continued registration of a trade mark is legitimate only to the extent that the registered mark continues to perform, through its usage in the marketplace, as an indication of source or origin for the goods and services of the registered proprietor. In other words, the rights and benefits conferred upon the registered proprietor by the trade mark regime should only last for so long as his trade mark actually serves the public interest by operating as a badge of origin.
- (iii) *The unfair competition rationale.* The continued grant of a legal monopoly to the registered proprietor might facilitate acts of unfair competition, which runs contrary to the objectives behind the trade mark regime. If a user of the registered trade mark system were allowed to accumulate trade mark registrations, and keep his registered trade marks on the trade marks register even though they have not been put to genuine use, then the property rights

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<sup>3</sup> A concise summary can be found in *New Yorker S.H.K. Jeans GmbH & Co. v Daidoh Limited* [2017] SGIPOS 16 at [27], drawing from *Weir Warman* at [42] and [99].



acquired through such trade mark registrations can be weaponised against other traders with legitimate interests in exploiting trade marks that are identical or similar to these registered trade marks. Such behaviour, which includes so-called acts of trade mark “hoarding”, “squatting” or other opportunistic behaviour by trade mark “trolls”, falls within the umbrella of “unfair competition” that is antithetical to the basic objectives of trade mark law. Such varieties of extortionate behaviour are potentially harmful to the victims targeted by the registered proprietor, as well as the public interest in maintaining the integrity of the trade mark regime.

22 Two further observations can be made about the rationales behind the revocation of registered trade marks on grounds of non-use. Firstly, revoking a registered trade mark on such grounds frees up “space” in the trade marks register for the benefit of other traders by removing a legal obstacle that would have prevented them from registering or using a mark identical or similar to the registered trade mark. If a registered trade mark owner has not put his registered trade mark to genuine use, he should not be permitted to behave like a dog in the manger. Secondly, apart from advancing the interests of individual traders or users of the trade mark regime, the trade mark revocation mechanism also serves a wider public interest, which includes the interests of consumers and the trading community, insofar as it contributes towards enhancing the fairness and overall coherence of this intellectual property framework.

### **Usage of a Trade Mark in a Form Which Differs from the Form in which It Was Registered**

23 Having registered his trade mark under the TMA, the registered trade mark proprietor is expected to make use of *that* trade mark in relation to the goods or services specified in his trade mark registration within the subsequent 5-year period. In a straightforward case where the mark is completely unused, or used in some trivial way that cannot be regarded as “genuine”, then his trade mark registration is vulnerable to revocation proceedings under Section 22(1) of the TMA. In addition, non-use of the registered trade mark can also occur when the form in which the mark is *actually* used by the registered proprietor should be regarded, *from a legal point of view*, as not *that* trade mark which has been registered.

24 The TMA does make *some* allowance for the registered proprietor to use his mark in a form which deviates from the form in which the trade mark was registered – as embodied by the statutory language found in Section 22(2) of the TMA – where “use of a trade mark” is defined as including “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”. The statutory language thus sets out a legal threshold for when use of a non-identical variant of a registered trade mark can count as use of *that* registered trade mark. By implication, the use of a mark that one might regard as similar, or perhaps substantially similar, to *that* registered trade mark will *not* suffice. It appears, however, that the Singapore courts have not laid down concrete rules for how the contours of this statutory test should be interpreted or given clear guidance on the appropriate breadth of the “wriggle room” given to registered trade mark proprietors under this provision. To determine whether the scope of this subsection is wide enough to apply to the marks used by the Proprietor in this case, it is necessary to examine the statutory language

found in Section 22(2) of the TMA in the context of the relevant legal precedents, principles and policies that operate within the sphere of trade mark revocation proceedings.

25 Even though the TMA does not provide explicit statutory guidance on how to determine when the “distinctive character of the mark” has been altered, the issue of when non-identical trade marks should be regarded as possessing sufficient legal proximity to each other is relevant in another statutory provision of the TMA. Arising in the context of when non-identical trade marks are eligible to be registered together under a single trade mark application, Section 17 of the TMA permits a “series of trade marks” to be the subject of a single trade mark application, with Section 17(2) providing that:

... ‘series of trade marks’ means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark<sup>4</sup>

26 While the wording of Section 22(2) of the TMA requires the actually used form of the trade mark to possess the “distinctive character” of the registered form of the trade mark so as to avoid the latter’s revocation on grounds of non-use, the language of Section 17(2) states that the members of a “series of trade marks” can differ “only as to matters of a non-distinctive character” that do not “substantially” affect “the identity of the trade mark”. Adopting an approach towards statutory interpretation that promotes internal consistency between Sections 17 and 22 of the TMA would suggest a substantial overlap between the breadth of Section 17(2) and Section 22(2). Non-identical trade marks that qualify as part of a “series of trade marks” because they “resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the mark” could also be regarded as trade marks which share the same “distinctive character”. In other words, each trade mark belonging to a single “series of trade marks” should be regarded as possessing a form “differing in elements which do not alter the distinctive character of” the other members of that series. So when a registered trade mark proprietor makes use of one member of his “series of trade marks”, his use of that trade mark should also be regarded as a use falling within Section 22(2) of the TMA in relation to the other trade marks belonging to the same series. If I am correct in drawing this parallel between these provisions of the TMA, then there should be some correspondence between the breadth of Section 22(2) of the TMA and the scope of the test for when non-identical trade marks qualify as a “series of trade marks”.

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<sup>4</sup> Chapter 8 of the Trade Marks Work Manual, published by IPOS, sets out the following guidance (“General requirements of a series”), at page 4: (a) Each mark in the series must resemble each of the others in the series in their material particulars, that is, the main features in each of the trade mark must be essentially the same. (b) The differences between the marks must comprise only matters which, when considered as separate elements of the mark, be non-distinctive in nature. (c) The differences between the trade marks must not comprise matters which, in the context of the trade mark as a whole, substantially affect the identity of the trade mark. Elaborating on requirement (c) above, the Manual takes the position that the “visual, phonetic and conceptual identity” of the trade marks must be “substantially the same” for them to constitute a series, and that it is *not* enough that they “would be regarded as confusingly similar to each other if used by unrelated undertakings.” The illustrative examples set out in this publication suggest that a relatively narrow approach is taken by the Trade Marks Registry when determining if different marks should qualify for the same series.

## The United Kingdom Approach

27 One of the leading UK cases in this area is *Bud and Budweiser Budbräu Trade Marks* [2003] RPC 25 (“*Budweiser UKCA*”), where the English Court of Appeal had to review the legal tests applied by the High Court and the Registrar of Trade Marks in revocation proceedings under the UK Trade Marks Act 1994. One of the appeals was concerned with the registered proprietor’s trade mark, comprising the words “Budweiser Budbräu” in a stylised script. An application to revoke the “Budweiser Budbräu” trade mark was made on the basis that the mark had not been used in the form as registered. The registered proprietor had made use of the word “Budweiser Budbräu” in block capitals printed in a circle around pictorial elements on a label, imitating the appearance of a red wax seal, around the neck of beer bottles.

28 Applying Section 46(2) of the UK Trade Marks Act 1994, which is *in pari materia* to Section 22(2) of the TMA, the Registrar dismissed the application to revoke the mark for non-use because he took the view that the actual use made of the mark by the registered proprietor was, indeed, “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. In reaching his conclusion, the Registrar adopted the following approach. He found that what made the mark distinctive were the words “Budweiser Budbräu” and that presenting these words in a different font from the font in which the mark was registered did not “detract from... the central message” communicated to the “average consumer” because the other elements on the label were “relatively indistinct in themselves when compared to the words, and even when considered collectively do not overcome the basic tenet that words speak louder than devices.”<sup>5</sup> The UK High Court, in *Bud and Budweiser Budbräu Trade Marks* [2002] RPC 238 (“*Budweiser UKHC*”), reversed the decision of the Registrar on this issue, criticising the Registrar on two grounds. Firstly, the Registrar should not have focussed on “what the average consumer’s reaction to a mark is” when the assessment of the distinctive character should be made “through the eyes of the registrar”. Secondly, the Registrar “was wrong in seeking to ascertain what was the central message of the mark” because “[t]his was not the statutory test”. The UK High Court judge held that this over-emphasis on the words being “the most striking feature” of the mark would lead to the untenable outcome that “in a majority of cases use of a trade mark in ordinary letters, whether in upper or lower case, would constitute use of a stylised version of the mark”.<sup>6</sup>

29 The UK High Court judge, Simon Thorley QC emphasised that, given the precise wording of the statutory subsection, the approach taken towards interpreting Section 46(2) should not be conflated with the comparative mark-similarity analysis that is carried out in cases where trade mark infringement is alleged. He also took the view, which the UK Court of Appeal did not dissent from, that Section 46(2) was of narrow scope:

Next, it is to be noted that the language of section 46(2) does not use a comparative when defining alterations that can be accepted. It does not state that the alteration must not “substantially” alter the distinctive character. The requirement is that the alternative form may only differ in elements which do not alter the distinctive character of the mark. In my judgment this is indicative

<sup>5</sup> *Budweiser UKCA* at [6], referring to [20] and [23] of the Registrar’s decision.

<sup>6</sup> *Budweiser UKCA* at [7], referring to [30] of the High Court’s decision.

that the subsection is of *narrow scope*. Alterations which would be immaterial for the purpose of infringement, in that the alleged infringing mark was confusingly similar to the registered mark, are irrelevant. It is thus necessary for any tribunal seeking to apply section 46(2) to determine *what is the distinctive character of the mark and which are the elements that, in combination, contribute to that distinctive character*. Thereafter it must enquire whether any alteration to any of those elements is of *sufficient immateriality as not to alter that overall distinctive character*.<sup>7</sup>

30 The UK Court of Appeal allowed the appeal against the UK High Court’s decision on this issue, albeit with reservations about the way the Registrar had framed his analysis of Section 46(2). The decision of the Registrar was upheld because he could not be said to have made an error of principle, even though “he might have expressed his view more clearly” and had reached a conclusion which, while “surprising... [could not be] described as clearly wrong”.<sup>8</sup>

31 While agreeing that the assessment of form in which the mark was put to use had to be viewed through the eyes of the Registrar, Sir Martin Nourse took the position that “the registrar, in assessing the distinctiveness of the mark, would necessarily have to view the matter through the eyes of the average consumer”.<sup>9</sup> Lord Walker observed that “[t]he *distinctive character* of a trade mark (*what makes it in some degree striking and memorable*) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis”,<sup>10</sup> and did not see a direct conflict arising from “the issue of ‘whose eyes? – registrar or ordinary consumer’ because:

It is for the registrar, through the hearing officer’s specialised experience and judgement, to analyse *the ‘visual, aural and conceptual’ qualities* of the mark and make a ‘*global appreciation*’ of its likely impact on the average consumer, who:

‘normally *perceives a mark as a whole* and does not proceed to analyse its various details.’<sup>11</sup>

32 On the correctness of the “central message of the mark” approach taken by the Registrar, Lord Walker observed that “it is not always helpful to paraphrase a statutory test before applying it”, emphasising that what mattered was that the analysis included an understanding of the “essential ‘visual, aural and conceptual’ qualities which combine to give a mark its distinctive character”.<sup>12</sup> Articulating an approach which adhered more closely to the language in the statutory provision, Lord Walker reframed the legal test to be applied to determine whether the actual use of the mark fell within the scope of Section 46(2) in the following way:

The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences

<sup>7</sup> *Budweiser UKHC* at [22] (emphasis added).

<sup>8</sup> *Budweiser UKCA* at [12] (per Sir Martin Nourse) and [53] (per Lord Walker). At [52], Lord Walker noted that if he had a free choice between the hearing officer’s (Registrar’s) decision and that of the deputy judge (Mr Simon Thorley QC, High Court), he would “unhesitatingly choose the latter”.

<sup>9</sup> *Budweiser UKCA* at [10].

<sup>10</sup> *Budweiser UKCA* at [44] (emphasis added).

<sup>11</sup> *Budweiser UKCA* at [45] (emphasis added).

<sup>12</sup> *Budweiser UKCA* at [47].

have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?<sup>13</sup>

33 Taking both the UK High Court and UK Court of Appeal decisions in this case together, I would make the following observations about the UK approach towards the interpretation of Section 46(2) of the UK Trade Marks Act 1994. Firstly, there is a clear preference towards directly applying the statutory language in Section 46(2) – in particular, to identify the “distinctive character” of the registered trade mark, as the reference point against which to determine if the altered form of the mark actually used by the registered proprietor ought to be considered a use of the registered trade mark. Secondly, the inquiry of whether the actually used form of the trade mark altered (not substantially altered) the distinctive character of the registered form of the trade mark should be carried out from the perspective of the average consumer. This point of view would, necessarily, be considered by a tribunal when evaluating the forms in the which mark has been registered and used. Thirdly, identifying the “distinctive character” of a registered trade mark entails an appreciation of *all* its different qualities and elements *as a whole*, before a decision is taken as to whether the form in which the mark has actually been used alters (not substantially alters) this “distinctive character”.

### **The Singapore Experience with Section 22(2) of the TMA**

34 Cases concerned with trade mark revocation proceedings in Singapore, where allegations of non-use of the registered trade mark have been made because the registered proprietor has used a form of his mark that differs from the form in which it was registered, do not appear to have clearly articulated a clear legal test for how Section 22(2) of the TMA ought to be interpreted and applied. Local decisions cited to me in these revocation proceedings were cases where the surrounding elements have been added to the form in which the trade mark has been registered, or where changes have been made to the dimensions or positioning of the elements of the registered trade mark.

35 In *Nation Fittings (M) Sdn Bhd v Oystertec plc* [2006] 1 SLR(R) 712 (“*Nation Fittings*”), the Singapore High Court had to consider whether the registered trade mark could be said “to be used if it is incorporated into another mark or is surrounded by other elements and used in conjunction with them”.<sup>14</sup> Phang J (as he then was) held that while there had been a literal use of the mark, there had not been use of the mark “in a legal sense” because the registered trade mark had been “subsumed within other elements to the extent that it is no longer recognisable as such”.<sup>15</sup>

36 In *Capitol Records LLC v Steven Corporation Pte Ltd* [2010] SGIPOS 14 (“*Bluenotes*”), the Hearing Officer had to decide if the registered mark, “BLUENOTES”, had been put to genuine use in Singapore when the actual use by the registered proprietor on its tax invoices consisted of marks in the form of “BLUE NOTES” and “BLUE NOTE”. The Hearing Officer cited Professor Ng-Loy Wee Loon’s book, *Law of Intellectual Property in Singapore (2008 Edition)* at [25.3.8], that “[f]or the purposes of s.22(2), the ‘distinctive character’ of the registered trade mark

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<sup>13</sup> *Budweiser UKCA* at [43].

<sup>14</sup> *Nation Fittings* at [122].

<sup>15</sup> *Nation Fittings* at [123].

refers to the ‘essential feature’ of the trade mark”<sup>16</sup> and went on to conclude that the “distinctive character in ‘BLUENOTES’ and ‘BLUE NOTES’ is the same which is essentially, the words ‘BLUE’ and ‘NOTES’” and that the distinctive character of the registered trade mark was not altered by either the insertion of a space between the two words or a change from the plural to the singular form of the word “note”:

As the registered mark comprises only of words, it is clear to me that the distinctive character of the mark are the combination of the words, "BLUE" and "NOTES". In the registered form, the two words are joined together with no spacing in between and "NOTES" is in the plural form. The Applicants' contention is that in use, there is spacing between the two words and that the form of the mark in use alters the distinctive character of the mark. I do not think so. This is because, whether in the joined form or with the spacing between the words, it is clear that the mark comprises of the two words, "BLUE" and "NOTES" when read aurally and when looked at visually. The joining of the two words, "BLUE" and "NOTES" does not render a new word with a different pronunciation or with a different look. *The distinctive character in "BLUENOTES" and "BLUE NOTES" is the same which is essentially, the words, "BLUE" and "NOTES"*. I note that the word "NOTES" is in the singular form in the instance of use in paragraph 9(a) and in the plural form which is the same as that which was registered in the instance of use in paragraph 9(c). The next question is, does it matter that some use show use of the word, "NOTES" in the plural form and in some instances, "NOTES" is in the singular form of "NOTE"? Again, I do not think this fact changes the finding that the mark in use does not differ in elements that constitute the distinctive character of the mark as it has to be taken into consideration that in commerce, it is reasonable for some minute details to be overlooked or glossed over. The fact that there is inconsistency in the references to the mark concerned in the invoices shows that the inconsistency stems more from such glossing over than from a real intention of the Proprietor to alter the mark from one conjoined term comprising of the two words, "BLUE" and "NOTES" to one comprising of two separate words, "BLUE" and "NOTE" in use. Thus, use of "BLUE NOTE" or "BLUE NOTES" is considered as use of "BLUENOTES" by virtue of Section 22(2) since the former do not differ in elements which alter the distinctive character of the mark as registered in the latter.<sup>17</sup>

(emphasis mine)

37 The origins of “the essential feature” approach towards analysing the forms of the registered trade mark and the mark actually used by the registered proprietor can be traced to a stray line from the Singapore High Court’s judgment in *Richemont International SA v Da Vinci Collections Pte Ltd* [2006] 4 SLR 369 (“*Da Vinci*”), where the court held that there had been use of the registered mark (“DA VINCI” in block capitals) in Singapore through the plaintiff’s use of the words “Da Vinci” in cursive or stylised form because “the words ‘Da Vinci’ remain distinctly the essential

<sup>16</sup> *Bluenotes* at [38]. The same sentence can be found at [25.3.10] of the 2014 edition of Professor Ng-Loy’s book, which was submitted by the Applicant in its bundle of authorities.

<sup>17</sup> *Bluenotes* at [38]. The italicised portion indicates how the “essential feature” approach was applied to identify the “distinctive character” of the registered trade mark.

feature”<sup>18</sup> of the registered trade mark.<sup>19</sup> It is not clear from the judgment that the High Court intended for “the essential feature” approach to be the general legal test for Section 22(2) of the TMA. In that case, the Singapore High Court was simply endorsing the classic trade mark law principle, derived from the old English authority of *In the Matter of Morny Ld’s Trade Marks* (1951) 68 RPC 131, at 145, that a trade mark comprising a word registered in plain block capitals was put to genuine use whenever the letters of the word were used in “various stylised forms”.

38 In my view, there are several other reasons why “the essential feature” approach should not be taken as the general legal test for Section 22(2) of the TMA. Firstly, paraphrasing the language used in that subsection runs the risk of inadvertently distorting the contours of the statutory test, a danger illustrated by the UK courts’ dissatisfaction with the “central message” test in *Budweiser UKHC* and *Budweiser UKCA* cases. Does a trade mark *always* have an essential feature? Can a trade mark have *more than one* essential feature? In what sense is a feature of the trade mark “essential” – what is it essential “for” or essential “to”?

39 Secondly, “the essential feature” approach may only work in a more limited range of cases where the trade mark is used in an altered form, compared to the form in which it was registered. Trying to identify what is “the essential feature” of a registered trade mark as a proxy for identifying “the distinctive character” of the trade mark works best if the alteration of form in which the mark is presented is confined to relatively more superficial changes, such as a change in the font of the lettering of a word mark or the insertion of a space between letters in a word mark, rather than a case where larger components of the mark have been removed from, or added to, the form in which the trade mark was registered.

40 Thirdly, “the essential *feature*” approach may be incompatible with the inherently holistic inquiry that should be pursued when identifying the “distinctive *character*” of the registered trade mark. Rather than deconstructing the specific features of the form in which the trade mark has been registered to identify which one(s) are “essential”, before going on to see if it/they can also be found in the form in which the mark has been actually used by the registered proprietor, the “distinctive character” concept found in Section 22(2) of the TMA seems to require a holistic assessment of all the elements and qualities of the mark in combination with each other. The distinction between *a* “feature” of, and *the* “character” of, a registered trade mark echoes the contract law distinction drawn between the “attributes” and the “identity” of an individual person in mistaken identity cases.

41 Fourthly, adopting “the essential feature” approach runs the risk of substituting the statutory test in Section 22(2) of the TMA for something akin to a mark-similarity test that one would use in trade mark infringement proceedings, a concern that was

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<sup>18</sup> *Da Vinci* at [24].

<sup>19</sup> The “essential feature” concept is also a relic from older trade mark cases, decided under the old *Trade Marks Act* (Cap 332, 1985 Rev Ed) which did not have a provision like Section 22(2) TMA. See, for example, *Swanfu Trading Pte Ltd v Beyer Electrical Enterprise Pte Ltd* [1994] SGCA 19 at [34]-[36] where it was affirmed that there was non-use of a registered composite trade mark since the actual use of the mark left out the “Swanfu” word element, which was “an essential feature of the mark” because it “would be recognized in its function of distinguishing Swanfu’s goods from similar goods of other traders” and “its omission from the mark used affected the identity and form of the mark both to the eye and the ear”.

flagged in Mr Simon Thorley QC’s decision in *Budweiser UKHC*. Instead of asking whether the form in which a mark has been put to use has altered the distinctive character of the trade mark in the form it was registered, the inquiry may – consciously or unconsciously – morph into whether the form in which the mark has been put to use has incorporated or reproduced “the essential feature” of the form in which that trade mark was registered.<sup>20</sup> This may lead the inquiry down a path that considers what are the dominant or distinctive elements of the registered trade mark and whether the alterations present in the form in which the mark was actually used were substantial or not, none of which are relevant to the specific question raised by Section 22(2) of the TMA: does the form in which the mark was actually used differ in elements which do not alter the distinctive character of the mark in the form in which it was registered?

42 In my view, rather than comparing the form in which the mark has been registered with the form in which the mark has been actually put to use, in order to determine if “the essential feature” of the former is discernible in the latter, the ultimate focus of the statutory test in Section 22(2) of the TMA must revolve around what should have been identified from the outset – the “distinctive character” of the trade mark in the form in which it has been registered. Thereafter, the focus of the inquiry shifts to the form in which the mark has been used and requires an evaluation of the extent to which alterations have been made by the registered proprietor to the registered form of the trade mark. Before setting out in detail the approach I will take in this case, it is necessary for me to consider another decision of the Singapore High Court which was raised during the oral hearing.

43 In *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long* [2003] SGHC 169 (“*Bluestar*”), the court decided that the registered trade mark (“RTM”) (the words “BLUE STAR” with a large star device above the words) had been put to genuine use in Singapore even though the mark actually used by the registered proprietor took the form of the words “BLUE STAR” with a smaller star device repositioned beside, or below, the words. Woo J held that “the distinctive character of the RTM was not the star device notwithstanding its size” because star devices were “used in many marks belonging to others”.<sup>21</sup> Adopting a mode of analysis which bears some resemblance to “the essential feature” approach discussed above, the court concluded that:

The RTM should not be considered in isolation as a registered trade mark. Here, the business was the manufacture and sale of clothing to the public. In my view, the trade and public would refer to the RTM simply as “Blue Star” and not “Blue Star with a star device”... in my view, the use of a smaller star device and the insertion of the star device in a different location, for example, below or beside or in between the words “BLUE STAR” did not alter the distinctive character of the mark. The distinctive character, which was the words, had been enlarged while the star device had become smaller. Such an enlargement did not, in my view, run afoul of s 22(2). Accordingly, it was not necessary for me to decide whether the use of:

- (a) the words without the star device;
- (b) the words in different forms of lettering; and

<sup>20</sup> This may be illustrated, in my view, by the highlighted portion of the excerpt above accompanying footnote 17.

<sup>21</sup> *Bluestar* at [36]-[38], referring to the use of star devices in conjunction with other brands like “CONVERSE”, “U.S. MASTER” and “HARLEM STAR”.



(c) the mark with a more graphic design of the star device would run afoul of s 22(2) because all the products sold in Singapore had, at least, a tag and/or label with the words “BLUE STAR” in similar lettering as the RTM and the star device.<sup>22</sup>

44 In deciding that the “distinctive character” of the trade mark “was the words”, Woo J had, effectively, designated the words “BLUE STAR” as “the essential feature” of the registered trade mark – thus leading him to the conclusion that there would be use of the mark within the meaning of Section 22(2) of the TMA so long as the words “BLUE STAR” had been used by the registered proprietor. The changes made to the size, positioning or other characteristics of the star device did not alter his view that the registered trade mark had been put to actual use, because the distinctive character of the registered trade mark had been embodied entirely within the word device component of this composite mark. The somewhat liberal approach taken by the Singapore High Court in this case towards the interpretation and application of Section 22(2) of the TMA should, with respect, be approached cautiously for at least two reasons.

45 Firstly, there appears to be some uncertainty as to how the “distinctive character” concept, which is central to the application of Section 22(2) of the TMA, was interpreted in the judgment. The court identified the words “BLUE STAR” as the “distinctive character” of the composite mark on the basis that “the trade and public would refer to the RTM simply as ‘Blue Star’ and not ‘Blue Star with a star device’”. This appears to interpret the concept of distinctiveness in a *technical* sense, with an emphasis on how the word component of the registered trade mark functions as a badge of origin from the perspective of the average consumer. As the Singapore Court of Appeal has explained in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc* [2014] 1 SLR 911 (“*Staywell*”) at [24]:

Distinctiveness in the technical sense... stands in contradistinction to descriptiveness.... Distinctiveness can be inherent, usually where the words comprising the mark are meaningless and can say nothing about the goods or services; or acquired, where words that do have a meaning and might well say something about the good or services, yet come to acquire the capacity to act as a badge of origin through long-standing or widespread use.

46 Rather than focusing on the qualities, characteristics and details of the registered form of the trade mark that gave it its “distinctive character”, the court seemed to look at what made the trade mark “distinctive” in the eyes of the trade and the public, equating what makes the mark “distinctive” (in a *technical* sense) – that which enables the average consumer to distinguish the proprietor’s goods or services from the those offered by other traders – with the “distinctive character” of the mark. However, as Professor Ng-Loy’s treatise<sup>23</sup> has pointed out:

The ‘distinctive character’ of the registered trade mark in this context does not have the same meaning as ‘distinctive character’ as a registration criterion. The latter refers to the capacity (inherent or acquired) of the mark to function as a trade mark to denote the origin of the goods or services in question.

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<sup>22</sup> *Bluestar* at [41]-[42].

<sup>23</sup> See n16 above at [25.3.8].

47 Instead, the “distinctive character” concept in Section 22(2) of the TMA must be understood in light of the *non-technical* meaning of “distinctiveness”, where attention is paid to those aspects of the mark’s appearance which would stand out to the average consumer viewing the trade mark (in the form in which it has been represented on the trade marks register). This non-technical meaning of “distinctiveness” was clearly adopted by Lord Walker in *Budweiser UKCA* (see [28] above) when interpreting the UK equivalent of Section 22(2) of the TMA, and has been explained by the Singapore Court of Appeal in *Staywell* at [23] in the following manner:

Distinctiveness in the ordinary and non-technical sense simply refers to what is outstanding and memorable about the mark. Such components tend to draw the consumer’s attention...

48 So while “the trade and the public” may not have referred to the registered trade mark in *Bluestar* as “Blue Star with a star device” because they would have regarded the “Blue Star” word device as the principal component which gave the trade mark its ability to function as badge of origin, the pictorial star device (as it appeared *in the form in which the trade mark was registered*) could reasonably have constituted a component which “tend[s] to draw the consumer’s attention” and hence could reasonably have been regarded as part of the “distinctive character” (in a *non-technical* sense) of the registered trade mark.

49 Secondly, the court in *Bluestar*, at [32]-[33], cited Simon Thorley QC’s interpretation of the UK equivalent of Section 22(2) of the TMA from *Budweiser UKHC* (see [27] above) and acknowledged that the UK Court of Appeal “did not dissent from that part of his judgment which said that the relevant provision was of narrow scope”. Without explicitly affirming or rejecting the UK position on the breadth that should be given to Section 22(2) of the TMA, the court went on to conclude that, despite the alterations made to the size and position of the star device from the way in which the trade mark was originally represented on the trade marks register, the registered trade mark had been put to genuine use in Singapore. This conclusion was premised on the view that the “distinctive character of the [registered trade mark] was not the star device notwithstanding its size”, along with the observation that star devices were “used in many marks belonging to others”.<sup>24</sup>

50 During the oral hearing, counsel for the Proprietor recognised this internal inconsistency between the stringency of the UK approach (which counsel for the Applicant urged me to follow) and the more generous interpretation of the scope of Section 22(2) of the TMA in *Bluestar*, suggesting that I should take my cue from this local decision and find in favour of the Proprietor.<sup>25</sup> Given the doubts I have expressed above about the status of the “essential feature” approach towards interpreting the “distinctive character” concept found in Section 22(2) of the TMA, as well as my view that the Singapore courts have yet to articulate a binding legal test to be followed when applying this statutory provision, I will set out my views on how this area of trade mark law should be understood below before applying the law to the facts of this case.

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<sup>24</sup> *Bluestar* at [36].

<sup>25</sup> Bearing in mind, of course, that *Bluestar* at [36] also reminds us that “[i]t is trite law that each case must depend on its own facts.”

## A Framework for Section 22(2) of the TMA

51 In my view, the UK caselaw which deals with the UK equivalent of Section 22(2) of the TMA should be regarded as highly persuasive in deciphering the limits and contours of this statutory provision. The following legal principles may be distilled from the experience of the UK courts. Firstly, the meaning of the word “distinctive”, when used in the context of the “distinctive character of the mark in the form in which it was registered” requires “distinctiveness” to be understood in the non-technical sense of the word. Secondly, when identifying the “distinctive character” of the trade mark, the tribunal must look at all the visual, aural and conceptual qualities of the trade mark from a holistic perspective, rather than focusing on any “essential feature”. Thirdly, in light of the policy rationales underlying the revocation of registered trade marks on grounds of non-use, the breadth of Section 22(2) of the TMA must be fairly narrow in its scope. Registered trade mark proprietors cannot have free rein to ignore the registered form of their trade marks and use whatever variants they like on their goods and services, while insisting on holding on to their original trade mark registrations. The public notification function of the trade marks register would be distorted if a registered proprietor was permitted to represent his trade mark in a particular form on the register, and maintain this registration, while *only* putting *other* forms of the mark to actual use on its goods and services. The justification for continuing to grant the trade mark proprietor a legal monopoly over the trade mark, in the form in which it has been registered, fades away once it is shown that the proprietor has not used *that* trade mark on his goods and services.

52 Drawing upon Lord Walker’s judgment in *Budweiser UKCA* (see [32] above), it is my view that the correct approach towards applying Section 22(2) of the TMA can be articulated using the following three-stage test:

*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?

*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.

## Application to the Facts

53 Applying the framework set out above to the facts of the present case, the first stage requires a careful consideration of the form in which the Subject Mark was registered, as a whole, to identify its “distinctive character”. The second stage involves comparing the appearance of the Pâtissier-hat device and the Aalst house mark device (see [14] above for the strongest examples of concurrent usage of these two marks),



which the Proprietor has actually used on its products, against the appearance of the Subject Mark, to pinpoint the differences between them. The third stage involves an evaluation of the consequences of these differences between the registered and actually used forms of the trademark: have the forms in which the Proprietor has actually used its mark(s) altered the distinctive character of the Subject Mark (the registered form of the trade mark)?

54 At the first stage of the inquiry, I would regard the “distinctive character” of the Subject Mark to reside within the various distinctive (understood in a non-technical sense of the word) elements of the composite mark. I would accept the Proprietor’s submissions, made during the oral hearing, that the Pâtissier-hat device is *a* distinctive element of the Subject Mark because (i) it occupies about three-quarters of the area of the mark, (ii) it is likely to be read by the average consumer before the Aalst Chocolate word element and (iii) it has visual appeal because of the graphical element (the drawing of the chef’s toque). I would also accept Applicant’s submission that Aalst Chocolate word element is an element that the average Singapore consumer would take note of when viewing the Subject Mark because “Aalst” is “the name of a town in Belgium... that most Singaporeans may not be familiar with... [and] most Singaporean consumers will take note of the word “Aalst” as it is more uncommon than “Pâtissier” and is unusual” (AWS at [30]). There is no need for me to decide whether the Pâtissier-hat device is *more* distinctive than the Aalst Chocolate word element, or whether the Pâtissier-hat device is the “essential feature” of the Subject Mark, because I am interested in identifying the distinctive character of the Subject Mark as a whole. In my view, the distinctive character of this trade mark, in the form in which it has been registered, resides in the combination or collocation of these two distinctive components within a single composite mark or, as the Applicant has put it, “elements [that] are contained within the borders of an invisible rectangle” (AWS at [29]).

55 At the second stage of the inquiry, given that there is no evidence that the Subject Mark has been used in its entirety, or in the exact form in which the trade mark was registered, a straightforward comparison should be drawn between the Subject Mark and what the Proprietor has actually used as trade marks on its goods. From the evidence tendered by the parties, it seems clear enough that the Proprietor has applied two separate marks simultaneously to many of its products – the Pâtissier-hat device and the Aalst house mark device. As the Pâtissier-hat device bears the closest resemblance to the Subject Mark, this stage of the inquiry should focus on the differences between the Pâtissier-hat device and the Subject Mark. The outcome of this inquiry is obvious: the mark which the Proprietor has actually put to use is different from the form in which the Subject Mark was registered to the extent that the Aalst Chocolate word element is absent from the former.

56 At the final stage of the inquiry, the legal question to be answered is whether use of the Pâtissier-hat device *on its own*, without the concurrent use of the Aalst Chocolate word element below that device in the bottom right-hand corner, constitutes a “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”? The inquiry here is *not* whether the use of the Pâtissier-hat device alone would be regarded by the average consumer as the actual use of a mark that is substantially different from the Subject Mark. *Neither* is the inquiry focused on whether “the essential feature” of the Subject Mark is to be found in the Pâtissier-hat device which has been put to actual use, on its own, by the Proprietor.

Instead, the precise question to be resolved at this stage is whether the form of the mark actually used by the Proprietor differs from the Subject Mark only “in elements which do not alter the distinctive character” of the Subject Mark “in the form in which it was registered”.

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

57 The Pâtissier-hat device which the Proprietor has put to actual use differs from the Subject Mark in respect of an element – the Aalst Chocolate word element – which I believe would be regarded by the average consumer as a distinctive element (i.e. a component that will catch the eye of the average consumer looking at the Subject Mark as a whole). Professionals in the food and catering industry who purchase chocolate baking ingredients in bulk, at whom the Proprietor’s goods are primarily targeted, are probably very accustomed to scrutinising the contents of food labels. The average customer’s attention is likely to be drawn to any sign on the packaging that conveys information about the source or origin of the ingredients used by the manufacturer. Together with the reasons why “Aalst” would stand out to local consumers (see [54] above), the words “By Aalst Chocolate” in the Aalst Chocolate word element are thus likely to stand out to such customers viewing the Subject Mark, making them distinctive in a non-technical sense.

58 Thus, the excision of the Aalst Chocolate word element from the Subject Mark when the Proprietor chose to use the Pâtissier-hat device on its own means that the latter is different from the former in respect of a distinctive element. This difference between the registered form and actually used forms of the trade mark leads me to the conclusion that the variant of the Subject Mark used by the Proprietor is one that *has* altered the “distinctive character” of the Subject Mark. This conclusion I have reached is consistent with the recent observations from the Supreme Court of New Zealand, cited to me by the Applicant (AWS at [49]), concerned with statutory language found in the New Zealand Trade Marks Act 2002 that was based on the Singapore Trade Marks Act, which contrasts the impact of an addition of elements to, with the impact of a subtraction of elements from, the form in which a trade mark has been registered:

The essential question remains whether removing or adding elements has altered the distinctive character of the trade mark. We do accept, however, that whether elements are added or taken away may affect the practical application of the test.

This is because it will be harder to alter the distinctive character of a trade mark by the addition of elements. The totality of the registered trade mark will have satisfied the legal requirement of having a distinctive character. With each additional embellishment, the totality of the trade mark having the distinctive character is still present, whereas, if elements are removed, the distinctive character in that totality may be more easily eroded.<sup>26</sup>

59 As such, it follows that the forms of the mark that have been actually used by the Proprietor do not fall within the scope of Section 22(2) of the TMA and cannot be relied upon as evidence of use of the Subject Mark during the First 5-Year Period or the Second 5-Year Period. This means that the Applicant has succeeded in establishing non-use of the Subject Mark during the relevant statutory periods and its application to revoke the Subject Mark under Section 22(1) of the TMA should be granted.

### **Partial Revocation**

60 From the evidence tendered by the parties, it appears that the Proprietor has used various combinations of the Pâtissier-hat device and the Aalst house mark device on products covering the following specifications (PWS [9] and [12]):

“Chocolates; Chocolate based products; cocoa products; chocolate chips; chocolate extracts; chocolate fudge; milk chocolate; cocoa; snack foods consisting principally of chocolate; confectionery.”

61 To recapitulate, the Proprietor’s trade mark registration for the Subject Mark is in respect of the following Specification of Goods:

“Chocolates; chocolate-based products; cocoa products; chocolate chips; chocolate bars; chocolate candy; chocolate creams; chocolate extracts; chocolate-based beverages; chocolate beverages with milk; chocolate sauce; chocolate fudge; liqueur chocolates; milk chocolate; chocolate coated nuts; chocolate truffles and sweets; cocoa; coffee-based beverages; snack foods consisting principally of chocolate; chocolate base aerated beverages; cocoa-based beverages; chocolate wafers; confectionery; biscuits; cakes; coffee; tea; tea-based beverages; caramels [candy]; candy for food; cookies; prepared desserts [chocolate based]; flavorings, other than essential oils, for beverages; ice cream; pastry; pies; sugar confectionery; puddings; fondants [confectionery]; mousse confections; bread and bakery products; buns; prepared snack foods; tarts, all included in class 30.”

62 The original written submissions and oral submissions made by the parties did not address the partial revocation issue in sufficient detail, making it necessary for the parties to submit supplementary submissions in the fortnight following the oral hearing. The supplementary submissions set out the parties’ positions on the manner in which the partial revocation process ought to be carried out, including whether the Registry can insert qualifying language or reword the language used to describe the categories of goods for which the trade mark is registered. The parties also used their supplementary submissions to indicate their preferred outcomes, proposing alternative

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<sup>26</sup> *Crocodile International Pte Ltd v Lacoste* [2017] NZSC 14 at [41]-[42].

versions of the specifications for the goods found in the Proprietor’s trade mark registration might be narrowed down. Unsurprisingly, the Applicant’s Supplementary Written Submissions (“ASWS”) proposed a much narrower amended Specification of Goods than the version proposed in the Proprietor’s Supplementary Written Submissions (“PSWS”).

Applicant’s proposed amended Specification of Goods  ASWS [23]	“Chocolate in the form of blocks, bars, chips and powder; all being for use as ingredients in cooking or baking”
Proprietor’s proposed amended Specification of Goods  PSWS [3]	“Chocolates; chocolate-based products; cocoa products; chocolate chips; chocolate bars; chocolate extracts; chocolate sauce; milk chocolate; cocoa.”

63 Given my conclusion that the Proprietor’s Subject Mark should be revoked on grounds of non-use, there is no need for me to decide on the issue of partial revocation or evaluate these two amended versions of the Proprietor’s Specification of Goods. However, since the parties have made supplementary submissions on the issue, I will set out my general views on this issue in the event that my conclusions in relation to the interpretation and application of Section 22(2) of the TMA are incorrect.

### **Narrowing the Scope of the Specification of Goods: Singapore and UK Perspectives**

64 Two decisions of the Singapore High Court were cited by the parties in their supplementary written submissions to illustrate the application of Section 22(6) of the TMA where partial revocation has been addressed: the *Bluestar* case and the *Weir Warman* case.

65 In *Bluestar*, the court declined to restrict the trade mark proprietor’s specifications (where registration had been obtained for “men’s undergarments, briefs, socks, men’s sports clothing, knitwear, singlets, swimwear, all included in class 25”) to a narrower class of goods, even though the registered proprietor had only actually used the trade mark on socks, briefs, singlets, t-shirts and swimwear. Woo J held, at [60], that “it was not in the interest of the public or trade to try and narrow the description of the clothing in the... classification further to those specific categories for which the [registered trade mark] was in fact used. To do so would result in confusion and invite litigation.”

66 In *Weir Warman*, partial revocation was granted to the extent that the registered trade mark had only been actually used for “pumps and pump parts”, while the specifications in the trade mark registration covered “Pumps; milling equipment; valves; parts and fittings for the aforesaid goods in Class 7”. VK Rajah JA ordered, at [113], the partial revocation of the defendant’s registration “with respect to milling equipment and valves”, declining to insert additional words to confine the scope of the

specifications even further to “particular *types* of pump parts” on the basis that doing so would “be unnecessarily confusing and restrictive as well as not in the interest of the public or the trade.”

67 While the judges in both *Bluestar* and *Weir Warman* considered the UK approach towards partial revocation – where “it is open to the court (or Registrar) to require the specification of goods or services to be re-written in order to achieve the required degree of revocation, such that the court may “dig deeper” into certain wider specifications and insert words of limitation into the specifications” (*Weir Warman* at [112]) – neither decision explicitly affirmed that the UK approach is the correct approach to be taken when applying Section 22(6) of the TMA. While both cases recognised the line of UK cases which illustrate how partial revocation can be achieved by rewriting or qualifying the specifications found in an existing trade mark registration, it appears that neither court chose to fully embrace the possibility of a tribunal having complete freedom to rewrite or insert words into the specifications of goods or services that trade mark proprietors have claimed under their trade mark registrations. It seems that both courts took a slightly conservative stance towards partial revocation, limiting the scope of their intervention because they were mindful of the possibility of confusion and the “interests of the public or the trade.”

68 In my view, the correct approach towards applying Section 22(6) of the TMA when the partial revocation remedy is granted should lie somewhere between two extremes. At one extreme, there is the so-called “blue-pencil” test, which only permits specifications to be amended by making deletions from the list of words used to describe the goods. No word insertions or replacements are permitted under this highly conservative approach, which the UK courts have clearly moved away from. This is the approach advocated by the Proprietor in this case (PSWS at [11]), where they have removed 86 words from the original 102-word list that comprises their Specification of Goods.

69 At the other end of the spectrum, one might take the view that granting partial revocation can entail rewriting the registered trade mark proprietor’s specification of goods or services entirely. This would permit the inclusion of any additional words or qualifiers, as well as the substitution of the original language found in the trade mark registration with more precise language that specifically describes the products on which the registered trade mark has been actually used. Such an approach could circumscribe the scope of trade mark monopoly considerably, though the proprietor will continue to receive some “protection outside his specification of goods in areas where he can demonstrate a likelihood of deception in the wide sense” (See *Decon Laboratories Ltd v Fred Baker Scientific Ltd*, [2001] RPC 17 at [24] per Pumfrey J).

70 The UK approach towards partial revocation may be described as one that permits the court or Registrar to engage in selective acts of editing the language used to describe the trade mark proprietor’s specification of goods or services. The author of Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, 3<sup>rd</sup> Edition, 2014), at pages 522-523, has summarised the process undertaken by the UK courts as one aimed at arriving at a “fair specification”, where the court seeks to strike “a fair balance between the interests of the proprietor, other traders and the public having regard to the protection afforded by a registered mark”, keeping in mind “how the



average consumer would fairly describe the goods or services in relation to which the trade mark has been used” (cited in PSWS at [7]).

71 Having helpfully summarised a line of UK authorities that illustrate the “principles of relating to partial revocation by way of limitation, rewriting or qualifiers” (ASWS at [11]), the Applicant submitted that the Proprietor’s existing specifications should be substantially modified and confined to the goods actually sold by the Proprietor – “chocolate-based ingredients for the purposes of baking, sold primarily by weight or bulk...[to] customers...in the hospitality business” (ASWS at [12]). This led the Applicant to propose replacing the Proprietor’s 102-word Specification of Goods with the 20-word formulation set out above, which essentially confines the trade mark registration to chocolate products in particular forms (“blocks, bars, chips and powder”) that are used specifically “in cooking or baking” (ASWS at [23]).

72 The Applicant also took issue with use of the word “Chocolates” in the Proprietor’s Specification of Goods because it is the plural form of a countable noun (i.e. pieces of chocolate packaged in a box for retail consumption) whereas the Proprietor’s main product offering was “Chocolate”, which refers to the uncountable noun that more accurately describes the baking ingredients sold by the Proprietor (ASWS at [13]-[16]). While I appreciate that there are genuine issues relating to the grammatical precision of the Proprietor’s Specification of Goods, and that the very purpose of the partial revocation remedy is to refine the scope of the specifications, I am doubtful that it is appropriate to adopt an overly technical approach towards the language found in the specification of a trade mark registration. Drawing a rough analogy with how patent specifications are interpreted: just as how patent law does not expect the hypothetical skilled reader to interpret the word “vertical” with the linguistic precision of a mathematician, trade mark law should approach trade mark specifications through the eyes of the average trader and consumer rather than a fastidious linguist. While amending the Proprietor’s Specification of Goods, from “Chocolates” to “Chocolate”, may placate the anxieties of confectionery-conscious grammarians, I am of the view that is unlikely to serve any wider public interest.

73 This brings me to what, in my view, are the key principles underlying the operation of Section 22(6) of the TMA, a provision that should be applied after due consideration has been given to the concerns of the applicant, the legitimate expectations of the trade mark proprietor, as well as the interests of the public. The public interest includes the interest of customers and trading community for whose benefit the registered trade mark serves as a badge of origin.

### **Section 22(6) of the TMA: General Principles and Application**

74 The rationales underpinning trade mark revocation on grounds of non-use, articulated above at [21], apply equally to partial revocation situations. The only difference is that the registered proprietor’s non-use of the trade mark only relates to some (rather than all) of the specified goods or services. Thus, the partial revocation procedure should be viewed as one which updates the trade marks register to more accurately reflect the actual use that had been made of the registered trade mark, refocusing the scope of the trade mark monopoly to cover only those areas of commerce where the trade mark actually functions as a badge of origin, while freeing up those categories of goods or services in respect of which the trade mark has not been used –

making room in the trade marks register for other traders to potentially occupy with rival trade marks.

75 As a starting point, it should be recognised that the partial revocation of a trade mark registration substantially only alters the *formal* boundaries of the trade mark monopoly. How far partial revocation changes the *substantive* scope of protection enjoyed by the registered proprietor depends on the breadth of the remaining categories of goods or services, the strength of the trade mark and all the surrounding circumstances that influence the assessment of likelihood of confusion. As such, the amendments to specifications directed by the court or Registrar may or may not make it easier for other traders to use identical or similar marks on those goods or services which have been freed up from the original trade mark registration. Having said that, because the partial revocation process involves a direct interference with the pre-existing property rights of the registered trade mark proprietor, it is important that the exercise is not carried out in an arbitrary manner and should be sensitive to the legitimate expectations of users of the trade mark registration system.

76 In my view, the ideal outcome of any partial revocation process should be to arrive at a “fair specification” that reflects the private and public interests outlined above. Achieving such an outcome means that Section 22(6) of the TMA should *not* be interpreted in such a restrictive way that *only* permits the court or Registrar of Trade Marks to amend the Specification of Goods via “blue-pencil” deletions. The “blue-pencil” test has its origins in contract law and was developed in the context of judicial attempts to salvage overly broad restraint of trade clauses without rewriting the terms of the contract. The underlying concerns in that context – respecting party autonomy and freedom of contract – do not resonate within trade mark law framework. It must follow that the court or Registrar should be *capable* of doing *more* than just remove words or phrases from the Specification of Goods when granting partial revocation. The possible adjustments that may be made to the trade marks register under Section 22(6) of the TMA could also include, potentially, the insertion of additional words or qualifiers, as well as rewriting parts of the specifications where necessary to achieve a “fair specification”.

77 However, just because the tribunal *can* make these sorts of adjustments to the registered trade mark proprietors’ specifications does not mean that it *should* always exercise all of these powers in every case. When an application for trade mark registration is made, the applicant specifies products and services to be included in the specifications for his trade mark. This selection is done either generally, or from an approved list maintained by the Registrar of Trade Marks<sup>27</sup>. Either way, the selection is based on the Nice Classification system. From this selection he makes, the user of the trade mark system is then able to anticipate the scope of the trade mark monopoly he will obtain, if his registration is successful, and where the boundaries of his intellectual property rights will lie. If, in subsequent partial revocation proceedings, a tribunal had a completely free hand to amend the wording of these specifications in an unrestrained manner, the operational integrity of the trade mark registration system would almost certainly be jeopardised. The goal of the partial revocation exercise is not to define, with surgical precision, the exact range of goods or services in respect of which registered proprietor has actually used his mark. Rather, it is to achieve a “fair

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<sup>27</sup> Rule 19(2A) of the Trade Marks Rules (Cap 332, 2008 Rev Ed) allows an applicant to adopt “a specification set out in an approved list of goods or services”.

specification” which still gives the registered proprietor a commercially sensible zone of exclusivity associated with the inherent semantic nebulosity of the words used by the trade mark framework to classify the goods and services in respect of which the mark may be registered.

78 If an applicant seeking partial revocation wishes to insert additional words or qualifiers to the specifications, or if he has an alternative formulation to propose, then I think it is incumbent upon him to justify the *necessity* of making these sorts of changes. In other words, making amendments to the specifications beyond deleting categories of goods and services requires evidence of how the interests of the applicant might be prejudiced if these further refinements were not made. Alternatively, the necessity of inserting words into, or rewriting over, the specifications could be established with reference to “the interest of the public or the trade” (*Weir Warman* at [113]), bearing in mind the danger that making unnecessarily fine distinctions in the specifications may “result in confusion and invite litigation” (*Bluestar* at [60]). Adopting such a calibrated approach, in my view, probably conforms with the cautious note struck by Woo J and VK Rajah JA in the *Bluestar* and *Weir Warman* decisions.

79 Applying the general principles I have set out above to the alternative application for partial revocation under Section 22(6) of the TMA in the current proceedings, if my main decision on Section 22(2) is incorrect, I would have been more inclined towards the Proprietor’s version of the amended Specification of Goods. The much narrower version proposed by the Applicant confines the goods to particular physical forms of chocolate products (“blocks, bars, chips and powder”), while also limiting the purpose of the chocolate products (“for use as ingredients in cooking or baking”). While the Applicant did submit “that the specification should be reworded and qualified so as to make it clear that the actual goods are reflected, since the trade and the public would see them from a different perspective” (ASWS at [24]), I am not persuaded such an extensive reformulation of the Specification of Goods is *necessary* to achieve a “fair specification”. Much stronger reasons need to be given before the specifications in a trade mark registration are reconstructed in the manner proposed by the Applicant. I am unconvinced that members of the trade and the public might better off if the Specification of Goods were redrafted in the manner proposed by the Applicant, as opposed to simply removing those categories of goods (such as “chocolate wafers; confectionery; biscuits; cakes; coffee; tea; tea-based beverages; caramels [candy]; candy for food; cookies; prepared desserts [chocolate based]; flavorings, other than essential oils, for beverages; ice cream; pastry; pies; sugar confectionery; puddings; fondants [confectionery]; mousse confections; bread and bakery products; buns; prepared snack foods; tarts”) in respect of which the Proprietor has not actually used its registered trade mark.

80 Working from the premise that the objective of the partial revocation exercise under Section 22(6) of the TMA is to produce a “fair specification”, I am of the view that the tribunal should replace the original specifications of the registered trade mark with an alternative description of the goods or services only after carefully weighing the following factors. Firstly, the extent to which the registered trade mark proprietor’s pre-existing and future commercial interests are prejudiced by these changes to the boundaries of his intellectual property rights. Secondly, the corresponding strategic benefits potentially reaped by the applicant, who has sought partial revocation of the registered trade mark, from narrowing the scope of the goods or services in respect of

which the trade mark was originally registered. Thirdly, the ramifications of the adjustments to the specifications of the registered trade mark on the trade or industry sectors in which the parties are market players. Fourthly, the impact of making the contemplated changes to the trade mark specifications on the average consumer and the public at large.

81 A more interventionistic approach could result in the registered trade mark proprietor's specifications being rewritten and replaced with a description that corresponds exactly to the specific goods and services in respect of which the registered trade mark has been put to actual use. Such an approach would be undergirded by a policy preference in favour of limiting the scope of the registered proprietor's trade mark monopoly to the precise extent to which he has actually made use of his trade mark. On the other hand, a more business-friendly approach that recognises the legitimacy of allowing the registered trade mark proprietor to retain a "buffer zone" of goods and services, which represent future business diversification opportunities, could translate into a much lighter touch towards amending the description of goods and services found in the registered trade mark's specifications. Neither the Registrar of Trade Marks nor the Singapore courts have yet to articulate a clear policy preference either way. Regardless of which direction this area of Singapore's trade mark law eventually takes, what is more important is that the principles of partial revocation are developed coherently in tandem with the Registry of Trade Marks' procedural framework for securing trade mark registrations. More specifically, the manner and extent to which trade mark specifications can be changed during partial revocation proceedings must be consistent with the legitimate expectations of users of the trade mark system when their trade mark registrations were secured in the first place. It is important that registered trade mark proprietors understand, from the outset, the full extent to which the legal boundaries of their intellectual property rights may be subsequently narrowed during partial revocation proceedings on grounds of non-use when the language found in their trade mark specifications is amended, adjusted, altered or augmented by a competent tribunal.

## **Conclusion**

82 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). The Subject Mark is revoked as from 25 July 2013 (being the first day immediately following the end of the First 5-Year Period). The Applicant is also entitled to costs to be taxed, if not agreed.

83 Registered trade marks that have not been put to genuine use are like unsold or unconsumed chocolates long past the end of their shelf life. There are good reasons for getting rid of them. Such trade marks are vulnerable to revocation on grounds of non-use because their continued presence on the trade marks register is no longer justifiable. While these consequences may seem harsh for the registered proprietor, whose intellectual property rights are extinguished by the revocation, they arise because the trade mark system must also cater to the wider public interest, which includes the interest of consumers and other members of the trading community.

84 When trade marks are revoked on grounds of non-use, registered proprietors who have not made *any* genuine use of their trade mark on their goods or services face the

same consequences as registered proprietors who have *only* made use of variants of the registered forms of their trade marks (where the forms in which their marks have been used alter the distinctive character of the registered forms of these marks). Registered proprietors in the latter category have *not*, in the eyes of trade mark law, made use of *that* trade mark represented in the trade marks register. The continued subsistence of the trade mark monopoly for *that* registered trade mark is no longer justifiable. Keeping *that* trade mark registration alive distorts the operation of the trade marks system. Other traders who consult the register when developing their own trade marks, while seeking to avoid infringing upon the pre-existing rights of other trade mark owners, have legitimate expectations regarding the accuracy of its entries. Discrepancies between the form in which an earlier trade mark has been registered and the form in which it has been put into use its owner would impair any efforts made by other traders to differentiate their own trade marks from what is found on the trade marks register. Thus, an application for revocation of *that* registered trade mark ought to be granted.

Date of Issue: 8 April 2019