IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[1997] SGHC 228

OM 13/1996

Between

National Dairies Ltd

… *Applicant*

And

Xie Chun Trading Pte Ltd

… *Respondent*

GROUNDS OF DECISION

Trade Marks and Trade Names — Rectification of register; Trade Marks and Trade Names — Registration; Trade Marks and Trade Names — Registration; Words and Phrases

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National Dairies Ltd v Xie Chun Trading Pte Ltd

[1997] SGHC 228

OM 13/1996
Christopher Lau JC
01 September 1997

1 **Judgment:**

2 **CHRISTOPHER LAU JC**

3 The applicants, National Dairies Ltd, part of the National Foods Group of Companies in Australia, are producers in Australia of a wide range of dairy products, including milk, cream, butter, flavoured milk and other milk based products such as custard as well as non-dairy products such as fruit juice, mineral water and pancake batter. The applicants are the proprietors of the mark PURA in respect of these products in Australia and the expired mark PURA registered in the name of its predecessors in title Bakers Milk (Tas) Pty Ltd (Bakers Milk) in the Register of Trade Marks, Singapore (the Register) in Class 29 in respect of milk and other dairy products and desserts.

4 2.In these proceedings the applicants sought relief against the respondents in respect of the identical mark registered in the name of the respondents under registration No 1452/87 in Class 29 in the Register in respect of milk, jams, eggs, yoghurt and other dairy products, edible oils and fats.

5 3.On consideration of the affidavit evidence and following submissions by counsel, I granted the reliefs sought by the applicants and ordered that the mark PURA registered in the name of the respondents in the Register be expunged.

6 4.The matter arose in this way: on 11 June 1935 a company in Australia known as Metropolitan Dairy Products Pty Ltd (Metropolitan) registered the mark PURA in Class 29 in respect of milk and milk products in the Trade Marks Register in Australia. On 15 June 1966, the same mark PURA was registered by Bakers Milk in Class 29 in respect of milk and other dairy products and desserts in the Register. Bakers Milk, which subsequently changed its name to Tasmaid Foods Pty Ltd (Tasmaid) on 1 March 1984 was a wholly owned subsidiary of Consolidated Foods Ltd (CFL) an Australian company. Metropolitan was also a subsidiary of CFL. Metropolitan subsequently changed its name to Pura Dairy Products Pty Ltd (Pura Dairy). Between 1981 and 1985, Pura Dairy registered the mark PURA on several occasions in the Trade Marks Register in Australia in respect of milk, milk based products, cream, milk based drinks, yoghurt, jelly, fruit juice and cordials, all other drinks and beverages.

7 5.The PURA mark had accordingly been used extensively on a wide range of dairy and non-dairy products in Australia since 1935. It had also been promoted extensively in Australia. Sales in Australia had been substantial for many years. In the period 1984 to 1994 for instance, sales figures for milk alone had been more than A$50,000,000 annually.

8 6.From 1984 to about February 1987, the respondents were CFL`s sole agents for the sale and distribution of the PURA range of dairy products in Singapore and from 1984 to early April 1987 the respondents` advertising and promotion expenditure for CFL`s PURA range was shared by CFL. In early

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1987 a decision was made by CFL to cease direct exports to Singapore due to the high costs of administrative time involved in scheduling, documentation, accounting etc and the need to concentrate on CFL`s core business problems. Shipments from CFL direct ceased from Friday, 27 February 1987. CFL however continued to manufacture their milk products for export sales to Singapore supplying them instead through a company known as Bemco (Australia) Pty Ltd (Bemco) a company incorporated by Mr Richard J Baker, CFL`s former marketing manager.

9 7.Shortly thereafter, on 30 March 1987 the respondents applied to register the mark PURA in their name in the Register. The application, made under s 12(1) of the Trade Marks Act (Cap 332) (the Act), was on the basis that the respondents were the bona fide proprietors of the mark in that they had used the mark themselves since 1984. Section 12 provides:

> *Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration in Part A or Part B of the register.*

10 8.At the time of the respondents` application Bakers Milk`s registration of the same mark in Singapore had not expired (although it did subsequently expire on 15 June 1987 as no application had been made for its renewal). On 21 January 1988, the Registrar of Trade Marks wrote to the respondents` then solicitors M/s Yong & Partners objecting to the respondents` application pursuant to s 15(1) and/or s 23 of the Act by reason of the mark having been registered in the name of Bakers Milk.

11 9.On 2 September 1988, M/s Yong & Partners, in answer to the registrar`s objection, wrote on behalf of the respondents stating:

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> *to the best of our clients` knowledge, this mark has not been used by anyone other than our clients since 1984.*

12 10.Thereafter on the registrar`s request for evidence that the mark had not been used by any one other than the respondents, Chung Suan Lim (Chung), a director of the respondents, swore a statutory declaration on 13 December 1988 stating, inter alia : a. `the [respondents] started using the Trade Mark of `PURA` in relation to the goods in respect of which the mark is proposed to be registered sometime in 1984,`

13 b. `the [respondents] has been selling substantial quantities of the goods under the mark of `PURA` to local purchasers and has gradually been establishing a market for its goods under the mark of "PURA"`

14 c. `to the best of [his] knowledge, the mark `PURA` has since 1984 not been used in Singapore by anyone other than the [respondents].`

15 11.Following Chung`s statutory declaration and on the respondents` furnishing documents evidencing sales of PURA goods and the costs allegedly incurred by them in promoting the PURA mark, the registrar permitted the respondents` registration of the mark. The mark was therefore registered on 30 March 1987. It was subsequently renewed by the respondents for ten years from 30 March 1994.

16 12.In 1991, Pura Dairy and Tasmaid were acquired by the applicants. On 17 January 1994 Pura Dairy formally assigned ownership of the Australian PURA mark to the applicants. In this way the applicants became the proprietors of the mark in Australia and the expired mark in Singapore.

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17 13.When the applicants acquired Pura Dairy, a decision was made to launch PURA as a national brand for the National Dairies Group of Companies. The applicants also commenced looking at ways to expand or to restore the overseas markets for PURA products. One of the countries in which the applicants were interested to revive trade in PURA dairy products was Singapore. Around June 1994, the applicants made a search of Class 29 of the Register and found there was an identical mark in the name of the respondents. They also found the expired registration in the name of Bakers Milk. On 5 July 1994, the applicants unsuccessfully applied to register the trade mark PURA in Class 29, in respect of `milk, milk based products, milk based drinks and all dairy products in this class`.

18 14.At the hearing, which proceeded purely on affidavit evidence, Mr Yap who acted for the respondents raised a preliminary objection. The objection was to the admissibility of the following three affidavits filed by the applicants: (a). the third affidavit of David James Porter, the applicants` general manager, International Marketing and Sales, (filed on 16 September 1996);

19 (b). the third affidavit of Yee Fook Weng (filed on 2 September 1996); and

20 (c). the first affidavit of Leo Ying, an investigator (filed on 2 September 1996).

21 All three affidavits referred to events that had taken place in August 1996. The objection taken essentially was that as all three affidavits referred to events that had taken place in August 1996, they were completely irrelevant to the issues I had to decide which related to events arising well before August 1996.

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22 15.I dismissed Mr Yap`s preliminary objection and allowed the three affidavits to remain on the record. I did so for several reasons. Firstly, by an order of court dated 10 July 1996, the applicants had been given leave to file final affidavits, if necessary, or within four weeks after the service of the respondents` final affidavits. The three affidavits were filed pursuant to this order. Secondly, each of the affidavits referred to events which were, in my view, relevant to the issues between the parties: the crux of Leo Ying`s first affidavit being that a survey of eleven consumers carried out on 27 August 1996 at Cold Storage supermarket at Centrepoint Shopping Centre showed, in relation to a product known as Skinny Milk sold by the respondents, that these consumers did not know this product as `PURA` Skinny Milk, the gist of Yee Fook Weng`s third affidavit being that there is no product known as `PURA` Skinny Milk being sold by NTUC supermarkets; and the purport of David James Porter`s third affidavit being to explain why the `PURA` mark which had been registered by the applicants` predecessors had unintentionally been allowed to lapse.

23 16.The applicants` case was put in three ways. First, the applicants submitted that the original registration had been obtained by fraud as relevant information had been withheld by the respondents, at the time of the respondents` application, from the registrar; alternatively that the mark PURA was likely to deceive or cause confusion. Secondly, it was said there had been no `bona fide use` of the mark for a continuous period of five years up to one month before the date of this application, ie 6 February 1991 to 6 February 1996. Finally it was said that the mark had been registered without any bona fide intention on the part of the respondents to use the mark and that there had in fact been no bona fide use of the mark in relation to the goods by the respondents up

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to the date one month before the date of this application, that is, 6 February 1996. The application for relief was filed by the applicants on 6 March 1996.

24 17.The relevant statutory provisions were ss 48(1), 15(1), 40(1)(b) and 40(1)(a) of the Act. Section 48(1) provides for the mark to be taken as valid after the expiration of seven years from the date of its original registration unless the original registration was obtained by fraud or unless the mark offends against s 15. Section 15 makes it unlawful to register a mark if the use of the mark is likely to deceive or cause confusion. Section 40(1)(b) provides, if there has been no `bona fide use` of the mark in respect of the goods in which it is registered for a continuous five year period ending one month before the date of the application for relief, for the mark to be taken off the register. Section 40(1)(a) provides for the removal of the mark where it was registered by the respondents without any bona fide intention to use the mark and if in fact there has been no bona fide use of the mark in relation to the goods up to the date of one month before the date of the application for relief.

25 18.The principal response by the respondents to these submissions was that the applicants and their predecessors had abandoned the PURA mark and that by their conduct the applicants were now estopped from claiming any rights whatsoever in the PURA mark. The secondary response was that the validity of the mark could not be challenged since seven years had run from its original registration and there was neither fraud in the original registration nor deception or confusion, that even if there was fraud or deception or confusion, the delay in the commencement of these proceedings negated the fraud, or deception or confusion, that the respondents have been bona fide users of the mark for the period in question and that the respondents` registration was bona fide.

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26 19.The basis of the principal response essentially was first, that CFL had in reality paid nothing to promote its products since CFL`s share of the advertising and promotion costs were recoverable by CFL from the Australian Federal Government. Second, that CFL had in fact informed the respondents sometime in February 1997 that they were no longer interested in exporting all milk products with the PURA mark as the Singapore market was too small to be of any commercial benefit. Third, that at all material times CFL knew or were well aware that the respondents had plans to promote, advertise and market goods under the PURA mark. Fourth, that CFL also knew or were well aware that the respondents planned to register the PURA mark ultimately and that at all material times, CFL were not interested at all in the Singapore market commercially and for commercial reasons, had abandoned the Singapore market. Fifth, that after February 1987, the respondents were left entirely on their own to develop the PURA`s market share in Singapore and CFL in effect had no proprietary interest whatsoever in the fate of the Singapore market. Sixth, that the applicants being well aware of the usage of the PURA mark by the respondents as early as mid-1994, had substantially delayed seeking relief. Finally, that after the expiry of the original PURA mark on 15 June 1987, there were no attempts by the applicants` predecessors to renew the mark, to apply for a fresh mark, to assert ownership of it or even to challenge the respondents` registration and use of the mark in Singapore.

27 20.Whether there has or has not been abandonment is a question of fact: see **Mouson & Co v Boehm** [1884] 26 Ch D 398. The respondents` principal response rested primarily on a statutory declaration of 10 May 1996 by Richard J Baker (exh CSL-6 in Chung`s first affidavit of 18 May 1996), CFL`s former national marketing manager between 1979 to 1987 in which he asserted that CFL had made a decision to abandon the Singapore market and that it was no

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longer interested in the PURA mark in Singapore. The respondents referred also to the second paragraph of a letter dated 11 January 1987 (exhibited at DJP-8 p 10 of DJ Porter`s second affidavit of 12 July 1996) written and sent by Richard J Baker to CFL in which he said:

> *You will know that CFL currently buys milk, cream and yoghurt from Metropolitan Dairies, plus additional products from Regal Cream for export to Singapore. It has been agreed previously that this is not an operation that CFL wishes to continue because of the need to concentrate manpower on core business problems plus the high cost of administrative time involved in scheduling, documentation, accounting etc.*

28 21.This was however not the true purport of the letter. The first paragraph of the same letter crucially stated:

> *As mentioned briefly to yourself and Geoff Kleeman last Friday, I am hopeful of starting my own export business. It would assist me greatly, and also meet the requirements of Harry Chung & Co in Singapore, if Pura products could be exported through me rather than through Consolidated Foods.*

29 `Harry Chung & Co` are the respondents in these proceedings. This clearly indicated that at that point in time CFL had not decided to cease exports to Singapore altogether and it pointedly contradicted Richard J Baker`s assertion that CFL had abandoned the Singapore market and relinquished their rights to the mark in Singapore. A commercial reason not to export directly to Singapore for the reasons stated in the 11 January letter could not be said to be a decision to abandon the Singapore market altogether.

30 22.Neither did a letter from CFL to the respondents dated 23 February 1987 (exh CSL-5 in Chung`s first affidavit of 18 May 1996) on which the respondents also relied as proof of abandonment show abandonment. On the contrary, it showed CFL had no such intention. The text of that letter from CFL to the respondents was in the following terms:

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> *I reply to requests from yourself and Dick Barker. I comment on the following matters:*
>
> (1) Consolidated Foods Ltd will cease direct export shipments from Friday 27 February 1987;
>
> (2) I confirm that CFL will support your committed advertising expenditure up to early April 1987. Your telex dated 5 February 1987 indicated $29 125 committed for January to April, but you should make every effort to keep this expense, being met by CFL, to a minimum.
>
> *Please contact me if you require any further information.*

31 The first paragraph of this letter was particularly illuminating. CFL did not intend to abandon the market. They were merely redirecting their exports through Bemco. They did not intend to abandon the PURA mark in Singapore. The second paragraph further indicated that CFL shared the respondents` promotion expenses. Whether or not all of CFL`s share of these expenses was utlimately borne by the Federal Government, did not to me seem relevant. The point is that the expenditure was at least shared by CFL.

32 23.CFL`s arrangement with Bemco and its continued production for export through Bemco was hardly reflective of an `intention to abandon the mark`. The evidence was that the PURA products produced by CFL were sold in Singapore up to 1989 and sales ceased after 1989 because the products were no longer competitive in price and not because of CFL`s refusal to produce such products for sale to Singapore.

33 24.The PURA mark had lapsed in 1987 as a result, at the time, of an administrative oversight by the owner of the trademark caused by corporate changes, the lack of a central administrative body overseeing the trade mark portfolios of the Pura group of companies (of which Tasmaid was one of such companies) and a significant change of staff.

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34 25.There was no evidence that the Australian owners of the mark had relinquished their rights to the mark in Singapore or that they knew the respondents had applied to register the mark in March 1987.

35 26.For these reasons, I rejected the respondents` assertions of abandonment.

36 27.Was the registration on 30 March 1987 then obtained by fraud? The date 30 March 1987 was the date of the original registration of the PURA mark by the respondents. That is the relevant date in considering whether there had or had not been fraud: see **Farley (Aust) Pty Ltd v JR Alexander & Sons (Q) Pty Ltd** [1946] 75 CLR 487 at p 439 where Williams J in considering an application to rectify a register on similar grounds, said:

> *the crucial date is the date of the application for registration.*

37 In my judgment, on 30 March 1987, the registration was obtained by fraud. These are my reasons.

38 28.The respondents could not dispute that the applicants through their predecessors in title were the proprietors of the mark in Australia and the expired mark in Singapore, that the applicants had used and promoted extensively and at considerable cost, the mark in Australia, that the mark had been used by the applicants on a wide range of dairy and non-dairy products with sales of PURA milk in Australia being quite substantial at more than A$50,000,000 per year for many years, that between the period 1984 and 1987 the respondents were merely the sole agents for the PURA range of dairy products for CFL, that the advertising and promotion expenditure by the respondents during this period was shared by CFL and that at the time of the

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respondents` filing of their application, Bakers Milk`s mark in the Registry was still subsisting.

39 29.The evidence was also clear the respondents in obtaining registration of the mark did not disclose to the registrar that they were only the sole agents of the Australian producer or its distributor of the products during the years 1984 to 1987, that they had misrepresented to the registrar that they had used the mark themselves during the relevant period, that Chung`s statutory declaration of 13 December 1988 which was crucial to the registration contained at best half truths designed to portray the picture that the respondents were the proprietors of the mark. Chung had deliberately omitted to mention the fact that the goods with the PURA mark were packaged and produced by CFL/Pura Dairy, that they were all imported from CFL/Pura Dairy, that the sales figures cited were quantities derived from sales as sole agents of CFL and that the advertisements and brochures were all published jointly with their principals CFL/Pura Dairy with such expenses being shared, that CFL and/or Pura Dairy were responsible for coining the PURA mark and associating it with the products and that all the respondents did was to distribute the products for CFL and/or Pura Dairy in Singapore. All these ought to have been disclosed to the registrar. They were not. By omitting to do so, the respondents had represented they were the proprietors of the PURA mark when they clearly were not.

40 30.Chung`s statutory declaration was made after objection to the proposed registration was raised by the registrar. Even if the respondents were not aware of the corporate relationship between Bakers Milk and CFL/Pura Dairy as Chung later claimed, the fact that Bakers Milk was an Australian company, which fact the respondents did not dispute, and that CFL/Pura Dairy were also the Australian companies exporting the PURA products to Singapore

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should surely have put the respondents on notice of the possibility that Bakers Milk could be related in some way to CFL/Pura Dairy.

41 31.If the respondents had informed the registrar of any or all of the above or if they had accurately stated the facts in Chung`s statutory declaration, in particular that PURA goods had been and were imported by them merely as sole agent, the registrar would have required the respondents to obtain Bakers Milk`s or CFL`s or Pura Dairy`s consent to the proposed registration.

42 32.It was suggested by the respondents that I should nevertheless not order rectification since the applicants had substantially delayed seeking relief. I saw no basis for such a submission. Fraud, surely, unravels all.

43 33.These findings would have disposed of the matter. But for completeness, I would add further I accepted the applicants` submission that, on the evidence, there was also every likelihood of deception and confusion caused by the respondents` registration, satisfying the test, which I respectfully adopt, laid down by Lord Upjohn in **Bali Trade Mark** [1969] RPC 472 at pp 496 and 497 where he said in relation to an application to expunge a mark under a section of the UK Trade Marks Act 1938 identical to s 15 of the Act :

> *It is not necessary in order to find that a mark offends against s 11 to prove that there is an actual probability of deception leading to a passing-off action or (I add) an infringement action. It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt, but the court has to be satisfied not merely that there is a possibility of confusion, it must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the register. And so mutatis mutandis when it is sought to expunge a mark.*

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44 34.What were my reasons? These were first, that the evidence of use filed by the respondents in support of their application for registration of the PURA mark related solely to the PURA products sold by the respondents as a distributor. They were only sole agents, and they could have had no claim to the ownership of the mark. Secondly, the public and trade would have associated PURA products with that of the applicants. This was accomplished through the substantial sales in Australia, promotions and advertisements, appointment of the respondents as sole agents and the advertising and promotion expenditure allocated for Singapore. If there was any use of the mark by the respondents on any of its own products (of which there was no proof) there can be no doubt that it would have caused deception and confusion in the market. Third, the respondents were importing PURA products from CFL and/or Pura Dairy during the years 1984 to 1987 and thereafter from Bemco from 1987 to 1989. When the respondents filed their application for the registration of the mark on 30 March 1987, the PURA mark had been used by the applicants` predecessors in title in Singapore for more than three years through the sale of its products. Fourth, when the respondents filed their application for the registration of the mark on 30 March 1987, the only PURA products being sold by them were those imported from CFL/Pura Dairy and sold as agents of CFL/Pura Dairy. If there were in fact products produced by the respondents being sold by the respondents as at the date of application, as to which, as I have said, there was no evidence, such products would have been identical to those exported by CFL/Pura Dairy to Singapore and sold by the respondents as their agents. In such an instance there would have been a `real tangible danger of confusion` had the respondents` mark been allowed to remain on the register. It would have been impossible for the public in such an instance to determine which of the two sources the product came from.

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45 35.I was referred by Mr Yap to **Diehl Trade Mark** [1970] RPC 435 where a United Kingdom exclusive importer was held to be entitled to register the `Diehl` mark notwithstanding the undisputed evidence that the importer was a sole agent only as the respondents in these proceedings also were. But that was where the similarity in the facts ended, in my view. In these proceedings, the applicants did use its mark in Singapore. Through its predecessors, Bakers Milk, the mark had been registered in the Register and the respondents were not only selling products with the PURA mark, they were also selling products with other marks Most importantly, at the time of the respondents` registration, there was already a subsisting mark that had been registered by Bakers Milk. These facts were absent in ***Diehl Trade Mark*** .

46 36.As for the applicants` second submission, the respondents in contending in response that there had been bona fide use of the mark since 1984, produced copies of invoices for the years 1984 to 1986, copies of purchase orders from NTUC Fairprice and Yaohan, a copy of a PT Tongkat credit note and invoice, copies of advertisements of the PURA products, copies of letters from Prime Supermarket, NTUC Fairprice and Kimisawa Supermarket confirming the supply of PURA products by the respondents to them, copy of a notice of change of price to NTUC Fairprice and a statutory declaration of a Ho Yew Meng relating to the change of price of PURA Skinny Milk.

47 37. ***Kodak Trade Mark*** This evidence however, on a closer scrutiny, did not show bona fide use for the following reasons: 37.1. As the material period for consideration was 6 February 1991 to 6 February 1996, those invoices and purchase orders which were for the period prior to 6 February 1991 were irrelevant. These had been exhibited at pp 9 to 19 of exh CSL-2 to Chung`s first affidavit.

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48 37.2. Pages 20 to 27, 30 to 36 of CSL-2 were purchase orders for alleged PURA products by Yaohan Singapore and pp 28, 29, 37 to 49 of the same exhibit were purchase orders for the alleged same products by NTUC Fairprice. The products alleged to have been sold to Yaohan were `PURA Fresh Milk`, `PURA Skinny Milk`, `PURA Thickened Milk`, `PURA Reduced Fat Milk` and `PURA Thickened Cream`. The products alleged to have been sold to NTUC Fairprice were `PURA Skinny Milk` and `PURA/REV Reduced Fat Milk`.

49 37.3. However the word `PURA` in the documents in this exh CSL-2 and in the documents in exhs CSL-3, CSL-4, CSL-7 and CSL-8 merely showed that the respondents had used the word `PURA` as part of their supplier stock codes or stock names with the supermarkets concerned. In a survey carried out by one Yee Fook Weng (Yee) of the supermarkets prior to the filing of this application Yee had seen no evidence of sales of PURA dairy products. I saw no reason to doubt the veracity of Yee`s evidence. Yee was the managing director of Food Corp Pte Ltd, the applicants` present Singapore agent.

50 37.4. It was not disputed by the respondents that the name `Skinny` is a trade mark belonging to the Victorian Dairy Industry Authority (VIDA) and that the VDIA has licensed the use of the mark to Australian Milk Marketing (AMM). It was also not disputed by the respondents that the respondents had taken steps to affix `PURA` stickers onto the cartons of Skinny Milk being sold at NTUC and that this resulted in a stern letter from the general manager of Australian Milk Marketing objecting strongly to the respondents` action and demanding that the respondents cease from applying the `PURA` mark onto the product. It was a vain attempt by the respondents to show that products bearing the PURA mark were being sold by them.

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51 37.5. A survey conducted by Leo Ying on 27 August 1996 showed that all 11 purchasers of Skinny Milk at Cold Storage Centrepoint Shopping Centre stated that the brand name of the product that they had just purchased was known to them as `Skinny Milk` and that they did not associate the product with any other name, brand or mark.

52 37.6. As for the PT Tongkat credit note and invoice, these did not constitute proof that the PURA condensed milk had been produced or sold in Singapore. All these showed was that the respondents were entitled to a commission on the sale of the milk by PT Tongkat in Indonesia. No evidence had been adduced to explain the connection between PT Tongkat and the respondents nor was any explanation given as to why the respondents were entitled to a commission on the sale of PURA condensed milk by PT Tongkat.

53 37.7. At best it was evidence of an arrangement between PT Tongkat and the respondents whereby the respondents had permitted PT Tongkat to manufacture the condensed milk under the mark of PURA in Indonesia and sold by PT Tongkat to Vietnam and that the respondents were as a result entitled to a commission on such sales. Such an arrangement does not constitute `bona fide use` under s 40(1)(b) of the Act: see **Continental Liqueurs Pty Ltd v GF Heublein & Bro Inc** [1960] 103 CLR 422, where the Australian Court held that the use of the labels by another party authorised by the respondent did not constitute use by the respondent. In that case, the respondent had granted a licence to Gilbeys Limited (an English company) to use on the bottles of vodka manufactured by Gilbeys Limited and marketed in Australia by Gilbeys Ltd the respondent`s trade mark in consideration for a royalty. It was held, to amount to a `use`, it must be a use indicating or for the purpose of indicating a connection between the goods and the proprietor of the trade mark. The respondents had not shown any nexus between the product and themselves as proprietor of the

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mark. The Court of Appeal in **Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd** [1994] 1 SLR 625 adopted a similar approach in defining the phrase `bona fide use` when it decided that the primary question to be determined was `whether there has been a bona fide use in the sense of a genuine use by way of trade` by the proprietor thereof for the time being.

54 37.8. Similarly, the invoice from Delta Design relating to PURA condensed milk merely showed that the respondents had engaged the designers to design the label for the condensed milk. No evidence of any sale of PURA condensed milk in Singapore had been adduced by the respondents. The invoice from Delta Design could not be evidence that the product was sold or produced or offered for sale in Singapore.

55 37.9. The advertisements and brochures at pp 52 to 54 of the first affidavit of Chung all related to those which were placed during the period when the respondents were the sole agents of the PURA products produced by the applicants and for which expenses were paid by CFL and/or Pura Dairy. Furthermore the advertisements and brochures were all placed in 1986 and so were not within the material dates.

56 37.10. In brief, the best that could be said of the respondents` evidence was that the mark PURA had been used on the supermarkets` stock codes or stock names but this could not amount to `bona fide use` within s 40(1)(b) of the Act: see **Landcare Australia Ltd v Oehlschlager** [1993] AIPC 91-024 where it was held that the use of the mark on invoices and quotations for the services provided by the respondent did not amount to a `use of the mark in the required sense`; and **Kodak Trade Mark** [1990] FSR 49 which decided that the respondents` mark Kodak which was registered for `articles of clothing` was to be expunged for non-use even though the respondent had used the mark on

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certain articles of clothing, principally T-shirts, in the promotion sales of photographic goods. The T-shirts carried the wording: `Do it! Use Kodak films and plates.`

57 37.11. The PURA mark when used as the stock codes or names was known only to the supermarkets concerned. The public had no knowledge of such use of the product. No such product bearing the mark was available for purchase by the public. In , the mark was in fact used on the T-shirts but because of the manner in which the mark had been used, it was found not to be `bona fide use` within the meaning of the Act. A fortiori, there could be no `bona fide use` within the meaning of s 40(1)(b) of the Act where the product did not bear the trade mark nor where it was not offered for sale at all to the public: see **Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd** [1994] 1 SLR 625 where it was held by the Court of Appeal that the primary meaning of `bona fide` in s 40(1)(b) was `genuine`, as opposed to `fictitious`, `pretended` or `colourable` and that the primary question to be determined was `whether there had been a bona fide use in the sense of a genuine use by way of trade`.

58 37.12. The products alleged to have been sold by the respondents bearing the PURA trademark for the period from 6 February 1991 to 6 February 1996 was disputed by the applicants. The evidence adduced by the respondents in respect of such alleged sales had been disputed. If, as the respondents alleged, they had spent `an average of at least $10,000 per year in advertising and promoting the goods under the PURA mark`, surely it would not have been too difficult for the respondents to provide such proof of sales during the relevant period. This would have clearly shown the use of the mark on the alleged goods for that period. They did not.

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59 38.The applicants had also, in my judgment, established their case to expunge in respect of their third submission, on the evidence, because: (a). the respondents were the distributors of the PURA products up to the end of February 1987 and thereafter were importing these through Bemco when they applied for registration of the mark on 30 March 1987. These products were all imported by the respondents in the form produced by CFL and the respondents did not, nor were they authorised to, in any way vary any of the products whether in form or in substance or in its packaging;

60 (b). it was never the intention of the respondents to use the mark on any of the products registered by the respondents at the time of registration as they were engaged in importing PURA products from CFL up to 1989 albeit through Bemco;

61 (c). there was no use or bona fide use of the mark by the respondents for the reasons referred to earlier. The importation of the products from CFL through Bemco up to 1989 bearing the mark PURA could not be said to be a use of the mark by the respondents. That mark was a mark owned and imprinted onto the product by the applicants` predecessors in Australia. Such an alleged use could hardly be said a `genuine use by way of trade` as held by the Court of Appeal in **Swanfu Trading Pte Ltd v Beyer Electrical Enterprises Pte Ltd** [1994] 1 SLR 625 ;

62 (d). the use of the mark on stock codes of supermarkets similarly could not be a `genuine use by way of trade` as the products on the shelves for sale to the public did not contain such markings. Such a use could hardly be said to be in the ordinary cause of the respondents` business. It was a `fictitious` or `pretended` use.

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Christopher Lau JC

Chan Kok Chye (Chu Chan Gan & Ooi) for the applicants
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