

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2018] SGHC 81

Tribunal Appeal No 12 of 2017

In the matter of Trade Mark Registration No T0501003C for “**BIG BOX**” in
Class 35 in the name of Big Box Corporation Pte Ltd of 1 Venture Avenue,
#0707 Big Box, Singapore 608521

And

In the matter of an application for declaration of invalidity thereto by Courts
(Singapore) Pte Ltd of 50 Tampines North Drive 2, Courts Megastore,
Singapore 528766

And

In the matter of the Trade Marks Act (Cap 332, 2005 Rev Ed) and
Order 55 and Order 87 of the Rules of Court (Cap 322, R 5, 2014 Rev Ed)

Between

COURTS (SINGAPORE) PTE LTD

... Appellant

And

BIG BOX CORPORATION PTE LTD

... Respondent

JUDGMENT

[Trade Marks and Trade Names] — [Invalidity]

[Trade Marks and Trade Names] — [Registration criteria] — [Distinctiveness]

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Courts (Singapore) Pte Ltd
v
Big Box Corporation Pte Ltd

[2018] SGHC 81

High Court — Tribunal Appeal No 12 of 2017
George Wei J
9 October 2017; 23 October 2017

5 April 2018

Judgment reserved.

George Wei J:

Introduction

1 This is an appeal against the decision of the learned IP Adjudicator in *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2017] SGIPOS 5 dated 2 May 2017 refusing the appellant's application for a declaration of invalidity of the registration of Trade Mark No T0501003C for the plain word mark, BIG BOX, owned by the respondent ("the Subject Mark").¹ For clarity, I will refer to the appellant, Courts (Singapore) Pte Ltd, as "the Applicant", and the respondent, Big Box Corporation Pte Ltd, as "the Proprietor".

¹ Appellant's submissions, para 1.

Background facts

2 I begin with a summary of the basic facts, which are largely taken from the decision of the IP Adjudicator at [8]–[12]. A more detailed discussion of the facts will be set out below where necessary.

3 Sometime around April 2004, the Economic Development Board (“the EDB”) decided to launch and promote a warehouse retail scheme (“the WRS”) in Singapore. The promotion ran for three years and was aimed at encouraging the setting up of large, out-of-town retail warehouses by permitting retail activities that were previously not allowed within areas designated for warehouse or industrial use.

4 The EDB media release of 28 April 2004 announced: “New industrial land regulations to introduce fresh retail concepts like warehouse outlets and ‘big box’ retailers to Singapore”. The promotion was reasonably successful in that several retailers decided to apply for participation in the WRS. These included the Proprietor, the Applicant and the well-known IKEA and GIANT stores.

5 The Proprietor was incorporated in July 2004,² just shortly after the start of the EDB’s promotion exercise for the WRS. The Proprietor applied to register the Subject Mark on 26 January 2005 (“the Application Date”).

6 The Applicant applied to join the WRS in 2005 and thereafter sought and obtained proposals from developers, including Ascendas Real Estate Investment Trust, to develop a “Big Box Retail-Warehouse”.

² Appellants’ bundle of documents (“ABOD”), vol IV, p 228.

7 By 2008, construction for the Proprietor’s warehouse retail mall (“the Mall”) in the Jurong Gateway area was underway under the name “Big Box”. This was reported in various local newspapers largely in the context of the transformation plans for Jurong East.³

8 The Proprietor opened the Mall under the Subject Mark on 27 December 2014 and subsequently engaged in extensive advertising of the Mall in the English, Malay and Chinese newspapers. The Mall features the Subject Mark in point-of-sale and other promotional materials prominently throughout the location, including on shopping bags and trolleys, ticket machines, retail loyalty scheme materials, as well as social media platforms such as Facebook. The use of the Subject Mark consistently appears in the form of a device comprising the word “big” on top of the word “box”, in a square box with a green background.

9 In December 2012, some two years prior to the opening of the Mall, the Applicant opened a retail warehouse store in Tampines under the WRS. In December 2014, it placed advertisements for its Tampines store in *The Straits Times* under the description: “Courts Big Box Megastore”. In early 2015, the Proprietor sent a cease and desist letter to the Applicant alleging infringement of the Subject Mark by reason of the Applicant’s use of the words “big box” in its advertisements. The Applicant responded by applying for a declaration of invalidity on 12 March 2015.

Procedural history

10 As briefly alluded to at [5], on 26 January 2005, the Proprietor applied to register the Subject Mark in Class 35 of the Nice Classification, *ie*, the International Classification of Goods and Services under the Nice Agreement

³ ABOD, vol V, pp 14–18.

(on which I will go into greater detail later) for what can be broadly or loosely described as services relating to the merchandising and distribution of goods.⁴

11 On 12 March 2015, the Applicant filed an application for a declaration of invalidity pursuant to s 23(1) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”), which provides that the registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of, *inter alia*, ss 7(1)(b), (c) and (d) of the Act.⁵ The Proprietor filed its counter-statement on 11 May 2015.⁶

12 The Applicant’s evidence comprised two statutory declarations made by Kuah Mei Yin, Finance Director of the Applicant, on 14 October 2015⁷ and 11 October 2016.⁸ The Proprietor’s evidence comprised two statutory declarations made by David Black, Managing Director of Blackbox Research Pte Ltd (“Blackbox”), on 6 April 2016⁹ and by Tong Jia Pi Julia, Director of the Proprietor, on 13 April 2016.¹⁰

13 On 2 May 2017, the IP Adjudicator refused the Applicant’s application for a declaration of invalidity and issued written grounds. The Applicant has appealed.

⁴ Appellant’s submissions, para 1.

⁵ ABOD, vol I, p 11 *et seq.*

⁶ ABOD, vol I, p 14 *et seq.*

⁷ ABOD, vol I, p 21 *et seq* and vol II, p 3 *et seq.*

⁸ ABOD, vol VII, p 44 *et seq.*

⁹ ABOD, vol II, p 37 *et seq*, vol III, p 3 *et seq* and vol IV, p 3 *et seq.*

¹⁰ ABOD, vol IV, p 228 *et seq* vol V, p 3 *et seq*, vol VI, p 3 *et seq*, vol VII, p 3 *et seq.*

Preliminary points

The nature of an appeal to the High Court from the Trade Mark Office

14 Order 87 rule 4(2) of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) provides that “[a]n appeal shall be by way of rehearing and the evidence used on appeal shall be the same as that used before the Registrar and, except with the leave of the Court, no further evidence shall be given”: see *Polo/Lauren Co LP v United States Polo Association* [2016] 2 SLR 667 at [6]–[8].

15 In *Ceramiche Caesar SpA v Caesarstone Sdot-Yam Ltd* [2017] 2 SLR 308 (“*Caesarstone*”) at [15], the Court of Appeal held that the words “shall be by way of rehearing” in O 87 r 4(2) directs the appellate court to hear the matter afresh, and there is no threshold requirement of general application that a “material error of fact or law” be shown before appellate intervention is warranted in such appeals. The Court of Appeal noted at [22] the trite principle that “an appellate tribunal should not set aside a trial judge’s finding of fact, based as it is on evidence of witnesses, unless the appellant satisfies the appellate tribunal that the trial judge is plainly wrong”. The Court of Appeal explained that this reluctance to interfere stems from the recognition of the simple fact that the trial judge is in a better position to assess the veracity and credibility of witnesses giving oral evidence. Appeals to the High Court from the Registrar under the Trade Marks Act, however, do not fall into this class of cases. There is no trial and no oral evidence is taken. All of the evidence is tendered by way of statutory declaration. It is well established that where only written evidence is involved, an appellate court will be in as good a position as the trial court to make its own evaluation from the primary facts (*Caesarstone* at [23], citing *Ho Soo Fong and another v Standard Chartered Bank* [2007] 2 SLR(R) 181 at [20]).

16 It follows that the correct approach to take in this appeal is that there is no threshold requirement for a material error. The court is to hear the matter afresh.

The burden of proof

17 By s 101(c)(i) of the Act, “the registration of a person as proprietor of a registered trade mark shall be prima facie evidence of ... the validity of the original registration”. The IP Adjudicator rightly held at [7] of his decision that the burden in the present case fell on the Applicant to prove the ground of invalidity on the balance of probabilities. In the event that the Applicant satisfies that burden, in order to avoid a declaration of invalidity, the burden of proof would shift to the Proprietor under s 23(2) of the Act to show, again on the balance of probabilities, that the Subject Mark has in fact acquired distinctiveness as a result of use by the Proprietor since its registration.

The grounds of the attack

18 I note that the Applicant’s attack is not founded on s 22 of the Act, which deals with revocation on the grounds of (i) five years of non-use; (ii) inactivity or acts causing the subject mark to become the common name in trade for the product or service for which it is registered; and (iii) where the mark has become liable to mislead the public particularly as to the nature, quality or geographical origin of the goods or services. Instead of revocation, the attack is solely founded on invalidity under s 23 of the Act.

19 The second point to note is that the invalidity attack mounted by the Applicant under s 23(1) does not proceed on the basis that the Subject Mark comprises a sign which does not satisfy the definition of a trade mark under s 7(1)(a). There is no issue over whether the sign “is capable of distinguishing

goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person” as set out in the definition of “trade mark” in s 2(1).

20 Thus, the attack on validity is based solely on the following three grounds:

- (a) s 7(1)(b): trade marks which are devoid of any distinctive character;
- (b) s 7(1)(c): trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering services, or other characteristics of goods or services; and
- (c) s 7(1)(d): trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.

The scope of the attack

21 Before turning to the substantive issues, I address a question of “pleading” that has arisen, namely, whether the attack mounted by the Applicant is against all the services set out in the Proprietor’s specification under Class 35 as a whole, or whether it includes and also relates to each individual service claimed such that the Subject Mark may be found invalid for some but not all the services (partial invalidity).

22 For ease of reference, the services claimed by the Proprietor in the specification of the application under Class 35 can be broken into three main “segments”:¹¹

The bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods in retail shops, supermarkets, hypermarkets, convenience stores, wholesale outlets, factory outlets, warehouse retail outlets, retail outlets and big department stores [(“Segment 1”)]....

the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise internet web site [sic] or by means of telecommunication; compilation of mailing lists [(“Segment 2”)]....

the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; telephone and all other communication and telecommunication ordering services; direct mail advertising; business advisory and business services; advertising services; display services for merchandise; publicity services; marketing and promotional services; market analysis and research; import-export agency services; procurement and buying of goods on behalf of a business; window dressing; sales and distribution services; sales promotion for others; advisory and consultancy services relating to the aforesaid services [(“Segment 3”)].

23 The grounds of invalidation filed by the Applicant gave notice of its intention to invalidate the registration of the Subject Mark in Class 35 for all the services named and set out above. The Applicant averred, *inter alia*, that:¹²

(a) The term “big box” should be available for use in Singapore in relation to retail establishments, particularly large ones, since the term

¹¹ ABOD, vol I, pp 11–12.

¹² ABOD, vol I, pp 12–13.

belongs to the public domain and is generic and/or purely descriptive. It is a term which is customary in current language and/or constitutes a common name in the trade because of its prevalent use by third parties globally.

(b) The term “big box” generally refers to a physically large retail establishment which is usually part of a chain. Numerous references to the term “big box” as a generic term, as opposed to a mark capable of denoting trade origin, can also be found online and in various publications. Notably, this reference to “big box” as a general description for large retail stores is recognised by the major dictionaries, such as “the online Merriam-Webster dictionary” which defines “big-box” as “of relating to, or being a large chain store having a boxlike structure”. Similarly, “the online Cambridge dictionary” defines “big-box” store as a “very large shop that sells a large number of products, usually at low prices.”

(c) By reason of the foregoing, the Registered Mark is devoid of distinctive character and/or serves only in trade to designate the kind or other objective characteristic of the claimed services.

24 The Applicant’s grounds of invalidation ends with the prayer that “the protection of the Registration ought to be declared invalid with costs”.¹³ There is no express prayer for a declaration of partial invalidity in the event that the registration is found valid for some services only.

25 Section 23(9) of the Act states that “[w]here the ground of invalidity exists in respect of only some of the goods or services for which the trade mark

¹³ ABOD, vol I, pp 12–13.

is registered, the trade mark shall be declared invalid as regards those goods or services only.” Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore*, vol I (Sweet & Maxwell, 3rd ed, 2014) (“*Law of Trade Marks*”) at para 9.173 explains that:

The underlying principle for this is that the specification of goods or services covered by a trade mark registration should be reduced so far as necessary to confine it to goods or services for which the trade mark in question is registrable. A wide specification which encompasses goods or services within the scope of a well-founded objection to registration is to be narrowed by amendment so as to exclude such goods or services from the specification.

26 The Applicant submits that even though the attack is mounted against the Subject Mark in respect of *all* the services claimed under Class 35, this does not preclude the court from granting the prayer limited to certain services only.¹⁴ In short, the Applicant on appeal submits that the IP Adjudicator was bound to consider whether the Subject Mark was invalid for each and every service, and if necessary, to grant a declaration of partial invalidity even if a prayer for a declaration of partial invalidity had not been expressly claimed.

27 The Proprietor, on the other hand, argued that the Applicant did not raise s 23(9) below and that when queried by the IP Adjudicator, the Applicant stated that its case was on the basis of s 23(1) alone and not on s 23(9) in the alternative.¹⁵

28 Leaving aside the question whether the Applicant had abandoned any argument under s 23(9), it is clear the IP Adjudicator in fact did go on to

¹⁴ Appellant’s submissions, para 68.

¹⁵ Respondent’s submissions, para 11.

consider the question of partial validity. At [18] of the IP Adjudicator’s grounds of decision, he stated:

Once again, it is important to draw attention to what the Applicant is not applying for: it is not applying for a declaration of invalidity in relation to part only of the specification, as is permitted under Section 23(9) of the Act... Instead, it is contended that, as at the Application Date, the Subject Mark was devoid of distinctive character, was exclusively descriptive and was generic in relation to all the services contained in the specification. Thus, by way of example only, the Applicant is contending that use of the mark BIG BOX on a website or for a convenience store was not capable of performing the function of a trade mark, i.e. to indicate the trade origin of the services provided on or from those places, and likewise the use of the Subject Mark if used by the Proprietor in relation to general advertising, marketing and promotional services.

29 The IP Adjudicator went on, however, to state at [30] that:

Although the Applicant did not specifically request that I do so, I have considered whether the specification should be declared invalid under Section 23(9) in relation to part only of the specification of services, and particularly that relating to the provision of retail services in “hypermarkets and warehouse retail outlets”, but am satisfied that even in relation to those possible locations for the provision of the relevant service it should not be. On the basis of the evidence it has adduced, the Applicant has not satisfied me that at the relevant time the Subject Mark was descriptive (or generic or devoid of distinctive character) of services so provided.

30 Whilst I accept that s 23(9) is framed as a power enjoyed by the Registrar or the court to grant a declaration of partial validity, the Applicant (who is attacking the mark’s validity) should make clear whether his prayer includes a request for a declaration of partial invalidity and, if so, to indicate which goods or services the request of partial invalidity relates to. It is unhelpful if the application simply asserts invalidity in respect of all the goods and services claimed in the specification and to leave it to the court to decide whether the attack succeeds for all or just some items without making his

position clear. I shall return to the issue of partial invalidity later in respect of the actual facts and circumstances that have arisen before this court.

Temporal considerations

31 Section 7 of the Act sets out several grounds (many of which overlap) for refusing registration. In the present case, the attack on validity is centred on the distinctiveness requirement. Chan Seng Onn J in *Love & Co Pte Ltd v The Carat Club Pte Ltd* [2009] 1 SLR(R) 561 (“*Love & Co*”) at [29] held that the critical date for assessing distinctiveness is the date of application for registration. This is because s 7(2) states:

A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of use made of it.

32 Following Chan J in *Love & Co* at [29], [30], [32], [37] and [48], marks can be arranged into four classes for the purpose of assessing distinctiveness and registration as a trade mark:

- (a) marks which do not have any capacity at all to distinguish goods and services in the market and which therefore fall outside the definition of trade mark in s 2;
- (b) trade marks which possess inherent distinctiveness at the Application Date (s 7(1) is satisfied) and which are immediately registrable without the need to prove use;
- (c) trade marks which did not possess inherent distinctiveness but which have become distinctive by the Application Date as a result of the use made of the trade mark (*de facto* distinctiveness) (s 7(2)); and

- (d) trade marks which did not possess distinctiveness at the Application Date and which were “wrongly” registered, but which can be saved from de-registration under s 23(2) because it has acquired a *de facto* distinctive character through use of the trade mark.

33 It bears repeating that there is no claim to revoke the registration of the Subject Mark on grounds of non-use or because the mark has become the common name in the trade for the services in question. Given that the attack is confined to invalidity, it follows that certain temporal considerations are important.

34 If the Applicant succeeds in establishing that the Subject Mark was devoid of distinctive character, descriptive or generic at the Application Date of 26 January 2005, the registration is declared invalid *ab initio* under s 23(10) of the Act. It follows that the court in assessing distinctiveness, *etc*, must make an assessment of the evidence with the judicial eye sharply focused on the state of affairs at that date.

35 Publications, press releases, survey reports and other material which post-date the Application Date, whilst relevant, must be viewed with caution: to what extent do they assist in shedding light on what was the perception of the Singapore public at the Application Date? The IP Adjudicator rightly remarked at [14] of his grounds of decision that an invalidity application may be brought at any time, possibly even decades after the trade mark first appeared on the trade marks register. Even though the burden on the applicant in such a case is still the civil standard, evidence relevant to the state of affairs as it existed at the relevant date may be hard to adduce, at least as a practical matter when many years have passed by. The converse is also true for the respondent if the

applicant does satisfy this burden. The IP Adjudicator makes the point at [14] that:

... if an applicant for invalidity succeeds in adducing sufficient evidence to satisfy the burden, for example, that the challenged mark was generic or descriptive for a significant portion of the relevant public at the date it was applied for, there is logically very little, if anything, the mark's proprietor may do to prove to the contrary (although it may be able to show that the registered mark acquired distinctive character as a result of use by its owner after the registration date, under Section 23(2) of the Act).

General principles on distinctiveness: ss 7(1)(b), (c) and (d) of the Act

36 The general principles on distinctiveness are well established. Distinctiveness is the concept underlying ss 7(1)(b), (c) and (d) of the Act. That said, each ground must be assessed independently in relation to the proposed mark and the relevant goods and services and in light of the public interest underlying each ground: see Susanna H S Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) ("*Leong on IP*") at para 28.076.

37 Ultimately, the question whether a trade mark lacks distinctiveness is essentially one of degree and judgment. Some trade marks may comprise signs which are patently descriptive of the product or service in question or which bear an obvious and direct reference to the quality of the goods or services. In other cases, the descriptive content or allusion to quality, *etc*, may be nuanced, subtle or less obvious. Indeed, at the other end of the spectrum are signs which are entirely meaningless (in themselves) or whose meanings are counter-intuitive in terms of the character, quality, geographical origin or nature of the goods or services.

38 Whilst the case before me does not concern geographical terms or personal names, the issues and principles which have emerged from the cases

on names are helpful given that the core issue is the same: does the claimed trade mark meet or fulfil the distinctiveness requirement as set out in ss 7(1) and (2) of the Act? A brief overview suffices to draw out the points.

39 In some cases, the name is essentially descriptive of the nature, character, quality or geographical origin of the goods or services in question. In other cases, the name may bear little (if any) relevance to the characteristics, nature or origin of the goods, such as ANTARCTICA as a trade mark for durians: see *Law of Trade Marks* at para 7.064 which states that whether there is a current association between the name of a geographical location and the goods or services in question is to be considered from the perspective of the relevant class of persons. On the other hand, if ANTARCTICA is applied to products such as ski jackets or ice cream, the view might be taken by the relevant public that there is a nuanced reference to the character or intended use of the product even if no person would draw an inference that the ski jackets or ice cream originated from ANTARCTICA.

40 Similar problems arise with personal names (including surnames). An individual's name, first and foremost, is his/her personal badge of identity. In some cases, the individual may use his/her own name as the brand for goods or services which he/she provides in the course of trade. In other cases, the individual's name (as in the case of a celebrity) might be used, after his/her demise, as a device by which memorabilia is provided to the public, in the course of trade. Numerous different circumstances may arise where a name is used as a brand or trade mark, including cases where the name is of a fictional character.

41 In all these cases, distinctiveness is assessed bearing in mind the core objective of registered trade mark law, which is to protect “indicators of origin”

in the market. The exclusive rights conferred on a registered trade mark extend to use on the same as well as similar goods or services. It is perhaps for this reason that it has sometimes been remarked that distinctiveness can be tested by asking whether other traders in the ordinary course of business might want to use the same or similar mark in relation to their own goods or services without any improper motive: see for example Lord Parker in *Registrar v W & G Du Cros Ltd* [1913] 30 RPC 660 at 672.

42 Another approach is to ask whether the registration would impose an intolerable burden on other traders: see, for example, “*Weldmesh*” *Trade Mark* [1966] RPC 220, and *Re Colorcoat Trade Mark* [1990] RPC 511 at 517 *per* Robin Jacob QC that “the privilege of a monopoly should not be conferred where it might require honest men to look for a defence [to an infringement action]”. Indeed, I note that in *Love & Co* at [70], Chan J, citing David Kitchen *et al*, *Kerly’s Law of Trade Marks and Trade Names* (Sweet & Maxwell, 14th Ed, 2005) (“*Kerly’s*”) at para 8-080, stated that “descriptive marks are excluded from registration because they consist of signs or indications which honest traders either use or may wish to use without any improper motive”.

43 In this context of “undue burden”, an issue that has caused difficulty is the extent to which it is permissible in the context of registration to have regard to the existence of defences which might protect other traders in infringement actions, such as the “own name” defence and “descriptive use” defence. Should the possibility of such defences be taken as “reducing” the burden on other traders who are required to respect the boundaries of the registered trade mark? For example, is it relevant, when deciding the validity of the mark at registration, to ask whether a rival trader who wishes to use the term “big-box retailing” to refer to the WRS is covered by a defence?

44 Under European trade mark law, it was once thought that the European Court of Justice (“ECJ”) in *Procter & Gamble Company v OHIM (BABY DRY)* [2002] RPC 17 (“*Baby Dry*”) had moved towards the position whereby it was permissible to take into account defences (such as the “own name” defence) in determining distinctiveness. This led Jacob J (as he then was) in *Nichols Plc’s Trade Mark Application* [2003] RPC 16 (“*Nichols*”) at [15] to comment that *Baby Dry* appeared to have “shifted the balance towards trade mark owners who have the resources and foresight to use the registration system and against the public in general and weaker and less organised companies.” For this reason, Jacob J decided to refer the issue to the ECJ with the comment at [14] that the problem with saying “registration will not harm the public: if a third party wants to use the mark descriptively he has a defence” is that “in the practical world powerful traders will naturally assert their rights even in marginal cases.” In the end, the ECJ made clear at the reference that the fact that the effects of registration of the trade mark were limited by the exceptions under the applicable European Union (“EU”) law had no impact on the assessment of distinctiveness: see *Nichols Plc v Registrar of Trade Marks* [2005] RPC 12 at [34].

45 Whilst this point has not been authoritatively decided in Singapore, I note that academic commentators are supportive of the more rigorous approach which ignores defences when assessing distinctiveness: see Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) at para 21.3.38. Whilst it is not necessary to decide the point, I am of the view that this is the correct approach. The distinctiveness requirement is assessed in its own right and should not be affected by the issue of defences to infringement. Thus, in the case of names, distinctiveness of the name as a trade mark must be assessed in relation to the market and the goods or services in question. Does the name enable the public to distinguish those goods or services from those of

other traders? This is a matter that is addressed from the perspective of the average, reasonably well-informed consumer. Many factors may be relevant including whether the name is the full name or a surname, how common the name is and whether names are commonly used as trade marks in that market. The nature of the market for the product to which the name is to be applied can be very important. For example, the name of a celebrity, when used in relation to a product, might be perceived by the public as nothing more than an indication that the product is concerned with memorabilia with the name serving as the carrier of the celebrity's fame or personality. In such cases, proof that the name has acquired distinctiveness can be especially difficult: see, generally, *Leong on IP* at para 28.145.

46 The present case, of course, concerns the plain word mark BIG BOX and whether the distinctiveness requirement was satisfied at the time of application, and if not, whether distinctiveness was subsequently acquired as a result of use.

47 Following the earlier discussion, the core question is whether the mark enables the public to distinguish the goods or services of the applicant (or trade mark proprietor) from those of other traders. I note also that it is not the law that where there is some “minimal” or “slight” descriptive connotation, a mark cannot be registered without proof of use and acquired distinctiveness. It is only if the mark possesses a minimally distinctive character and is essentially descriptive of the characteristics or qualities of the goods or services that registration is dependent on proof of acquired factual distinctiveness: see *Leong on IP* at para 28.191. Chan Seng Onn J in *Love & Co* also stated at [35] that:

... The relevant question to bear in mind (assuming no prior use whatsoever by the trader) will be whether the average discerning consumer operating in that market place and environment can readily and immediately identify the trade

mark viewed as a whole to be unequivocally designating the goods or services originating from the particular trader when he first encounters the trade mark on the goods or services – or will the average discerning consumer be unclear or uncertain as to the commercial source or origin of the goods or services nevertheless?

48 Before I set out my decision, it is convenient to summarise the general comments made by the IP Adjudicator at [19]–[24] of his grounds of decision on the principles (some of which I have referred to already) that are relevant in assessing inherent distinctiveness on the facts of the case at hand:

(a) First, it is necessary to consider the Subject Mark in relation to the services in respect of which it is registered but “absent any consideration of its use, promotion or marketing by the [Proprietor] of the trade mark”: *Love & Co* at [53].

(b) Second, in the event that the Applicant satisfies the burden of proof in relation to one or more of the three claimed grounds under s 7(1) of the Act, the question is whether in consequence of the use which has been made of the Subject Mark, it has, after registration, acquired a distinctive character in relation to the goods or services for which it is registered: s 23(2) of the Act.

(c) Third, in reaching the decision it is necessary to consider whether a notional and fair use of the Subject Mark in connection with the retail and other services for which it is registered would have fallen within all or any of the three grounds as at the Application Date by reference to “the perception of the average consumer of those goods or services, who is deemed to be reasonably well informed, observant and circumspect”, as explained by the Court of Appeal in *Société des Produits Nestlé SA*

and another v Petra Foods Ltd and another [2017] 1 SLR 35 (“*Kit Kat*”) at [22(b)], citing *Kerly’s* at para 8-016.

(d) Fourth, it is necessary when considering s 7(1)(d) of the Act to take account of “the perception of the body of traders [who] may in turn be influenced and be affected by the perception of the average consumer and *vice versa* because of the close interaction between traders and consumers all the time”: *Love & Co* at [84].

(e) Fifth, a trade mark may be refused registration or removed from the Register on the grounds of invalidity, “if at least one of its possible meanings designates a characteristic of the goods or services concerned... It does not matter that there are other synonyms, other more usual signs or indications which can also serve to designate the same characteristic or other characteristics of the goods or services as s 7(1)(c) does not prescribe that the mark under examination should be the only way of designating the particular characteristic in question”: *Love & Co* at [70].

49 Finally, I note there is no evidence that the Subject Mark had been put to use by the Proprietor at the Application Date and that it is not necessary to consider s 7(2) of the Act. That said, in the event it is found that the Subject Mark lacked distinctiveness at the Application Date, it will be necessary to decide whether the Subject Mark acquired a distinctive character in consequence of the use which has been made of it.

50 I turn now to consider the particular grounds of invalidity relied on. For convenience, these will be considered in the same sequence as in the decision of the IP Adjudicator.

Invalidation under s 7(1)(c)

51 Section 7(1)(c) of the Act excludes from registration “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”.

The range of services in question

52 As noted above at [22], the services claimed by the Proprietor in the specification filed under Class 35 can be broken into three segments:

(a) Segment 1 is broadly concerned with bringing together of a variety of goods where they can be viewed and purchased by customers at a variety of “physical” places ranging from retail shops and supermarkets all the way through to warehouse outlets, big department stores and hypermarkets.

(b) Segment 2 concerns the bringing together of a variety of goods where they can be viewed and purchased by customers from a general merchandise internet website or by means of telecommunication. Whilst Segment 2 includes telecommunications and compilation of mailing lists, it is loosely concerned with what might be described as “internet shopping” or “online shopping” as limited to the bringing together of a variety of goods.

(c) Segment 3 is also concerned with the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods. Segment 3 appears to overlap (at least in part) with Segment 2 in that it includes a reference to

general merchandise catalogue by mail order or by means of telephone and all other communication and telecommunication ordering services. Segment 3 however also includes advertising, promotion and numerous other services, and its scope is notably broad. For example, it includes “window dressing” and “import-export services” without any requirement that these must be for “large” warehouse/retail stores.

53 I note the IP Adjudicator’s observation at [24] of his grounds of decision that the “Subject Mark is not registered for warehouses or other types of buildings (in Class 6, if made of metal, or Class 19, if either transportable or not made of metal), but for a range of services that may be made available in a variety of ways and from a variety of locations.” Indeed, the Subject Mark is not registered in respect of “goods” such as cardboard or for packaging material under Class 16 or for “services” such as transportation, storage and warehousing services under Class 39.

54 Given the significance of the scope of the services set out in the specification to the issue of distinctiveness, a brief overview of the statutory provisions on the classification system set up by the Act may be helpful.

55 Singapore became a member of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (15 June 1957, as amended on 28 September 1979), WIPO Lex TRT/NICE/001 (“the ICGS”) on 18 March 1999. Section 6 of the Act provides that goods and services are classified for the purposes of the registration of trade marks according to a prescribed system of classification.

56 Rule 19(1) of the Trade Mark Rules (Cap 332, R 1, 2000 Rev Ed) (“the 2000 Rules”) (in force at the date when the Subject Mark was registered in 2005)

provided a 42-class classification system for goods and services in the Third Schedule. Class 35, as set out in the Third Schedule, covered “[a]dvertising; business management; business administration; office functions.” Rule 19(4) provided that:

In the case of an application for registration in respect of all the goods or services included in a particular class, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or intends to make if and when it is registered.

57 Subsequently, r 19(1) was amended by the Trade Marks (Amendment) Rules 2015 (No S 739) so as to read:

For the purposes of the registration of a trade mark, goods and services are classified according to the Nice Classification as in force on the date of the application for registration of the trade mark.

The Third Schedule was deleted. Rule 19(4) was also amended to read:

In the case of an application for registration in respect of all the goods or services included in a particular class in the Nice Classification as in force on the date of that application, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or intends to make if and when it is registered.

58 I note that the 42-class system set out in the Third Schedule of the 2000 Rules was not expressly linked to the Nice Classification system. Nevertheless, it is clear that Class 35 as set out in the Third Schedule was in fact based on the Nice Classification system. Class 35 of the ICGS carries the key words: “Advertising; business management; business administration; office functions.”

59 The Explanatory Note to Class 35 of the Nice Classification (8th ed, 2001) states:

Class 35 includes mainly services rendered by persons or organizations principally with the object of:

- (1) help in the working or management of a commercial undertaking, or
- (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

This Class includes, in particular:

- the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods;
- services consisting of the registration, transcription, composition, compilation or systematization of written communications and registrations, and also the exploitation or compilation of mathematical or statistical data;
- services of advertising agencies and services such as the distribution of prospectuses, directly or through the post, or the distribution of samples. This Class may refer to advertising in connection with other services, such as those concerning bank loans or advertising by radio.

This Class does not include, in particular:

- the activity of an enterprise the primary function of which is the sale of goods, i.e., of a so-called commercial enterprise;
- services such as evaluations and reports of engineers which do not directly refer to the working or management of affairs in a commercial or industrial enterprise (consult the Alphabetical List of Services).

Whilst the Explanatory Note is not binding on this court, it does provide guidance on the intended scope of Class 35 against which the specification can be interpreted. I note also that the Explanatory Note set out in the current ICGS (11th ed, 2017) for Class 35 (which now applies in Singapore) is the same as that for the 8th edition in most material respects.

60 A number of general points or observations can be made in respect of the range of services claimed by the Proprietor under Class 35. First, the question as to whether the registration of marks for retail services was permitted under the Act has been controversial. One view was that such services were not the proper subject for a trade mark registration on grounds that retail services were merely ancillary to the goods or some other more readily identifiable service, or because of administrative burden. In this context, I note that in cases where the goods or services claimed in the specification under a particular class are numerous (or are set out in broad terms), an attack founded on invalidity can raise tricky issues as to how the various goods or services should be organised or grouped where the spectre of a claim for partial invalidity arises in light of an attack on distinctiveness. This has been touched on already earlier. The comments of Jacob J in *Nichols* on the problem with broad specifications bear repeating in fuller context:

10. ... Wide specifications are, I understand, permitted by [the European Union Office for Harmonisation in the Internal Market (Trade Marks and Designs)] for example. It is all very well saying that the scope of registration can be challenged for non-use after a number of years. The reality of the difficulties of such challenges, involving both cost and delay, means they are rare in practice... It is important in my view in all trade mark matters to take a realistic approach to the way the registered trade mark system actually operates and is likely to operate rather than to look at the purely theoretical position.

11. It may be said that whether or not other parties are or should be free to use a mark before it has become in fact is irrelevant. The conflict between the public interest and the interests of the applicant is an inevitable feature of a registered trade mark system [as in case of distinctiveness and statutory defences]...

...

14. The problem with saying “registration will not harm the public: if a third party wants to use the mark descriptively he has a defence” is this: that in the practical world powerful traders will naturally assert their rights even in marginal cases. By granting registration of a semi-descriptive or indeed a

nearly-but-not-quite-completely descriptive mark one is placing a powerful weapon in powerful hands. Registration will require the public to look to its defences. With such words or phrases the line between trade mark and descriptive use is not always sharp. Moreover, it must not be forgotten that the monopoly extends to confusingly similar marks ...

61 Given that a registered trade mark is a true property right, it is of course important that the proprietor and the public at large should be able to determine the boundaries of the property right with reasonable certainty, especially bearing in mind that the exclusive rights extend to use in relation to goods and services that are “similar” to those for which registration has been obtained (subject to the requirements of likelihood of confusion, *etc*).

62 That said, in the context of retail services, the ECJ in *Praktiker Bau- und Heimwerkermärkte AG v Deutsches Patent- und Markenamt* [2005] ETMR 88 confirmed the more liberal approach, namely, that retail service marks can be registered provided there is a satisfactory description of those services in the specification.

63 The IP Adjudicator noted at [16] of his grounds of decision that in Singapore, the Registry had in fact already taken the step of permitting applications for registration of marks for retail services and that the Proprietor had succeeded in registering the Subject Mark in 2005 without objection. The IP Adjudicator also pointed out that the Registry had issued a circular clarifying its position in 2006 following the ECJ judgment and that more recently, by Circular No 17 of 2014 (which replaced the earlier circulars on the issue), the Registry states that it will accept as a specification “the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods” *per se*, that is, without a need to qualify the means of bringing the goods together, for example on a website or in a convenience store. The Registry also states in this

circular that it will accept the following very general descriptions of services in Class 35: (1) retail sale services; (2) retail store services; (3) wholesale store services; (4) online retail services; (5) online wholesale services; (6) online retail store services; and (7) online wholesale store services.

64 If the comment is made that the services were set out in broad terms in the Proprietor's specification in 2005, I note that similar approaches are taken in the United Kingdom and Europe, and that Circular No 17 of 2014 makes clear that very general descriptions of retail and wholesale services are now acceptable to the Registry. Indeed, the services set out in the specification were broadly framed and extend, for example, to "display services for merchandise", "market analysis and research", "import-export agency services", "window dressing" and "advisory and consultancy services relating to the aforesaid services". No objection has been taken to the width of the services claimed and I say no more other than to note the importance of specifications setting out a satisfactory description of the services for which registration is claimed.

65 Second, I note that many of the services claimed in the specification do not involve customers viewing goods at a physical place or premises. Further, whilst some of the services set out in the specification are indeed concerned with bringing together, for the benefit of others, goods enabling customers to conveniently view and purchase (Segments 1 and 2), the ultimate beneficiary of the services is of course the retail customer or consumer. In short, whilst the Proprietor may engage with retailers, manufacturers and wholesale dealers, the goal of the services (the bringing together of goods) is to attract retail customers to that location in the hope of making sales.

66 It follows that the fact that the Subject Mark is a "service mark" does not mean that the question of distinctiveness can be resolved exclusively from

the perspective of businesses such as wholesalers and retailers. The end consumer or retail customer in the market (whether the market is physical or online) is extremely important given that the ultimate goal is retail services supplied to consumers. For this reason, I find that it is appropriate and indeed necessary to take account of the views of the average consumer in Singapore in determining distinctiveness. Support for this can be found in the Court of Appeal's decision in *Kit Kat* at [33], which states that under s 7 of the Act, "[t]he critical question to ask is whether the average consumer would appreciate the trade mark significance of the mark in question without being educated that it is used for that purpose": see also *Love & Co* at [84].

Perception of the relevant public in Singapore

67 The present application seeks to invalidate the registration of the Subject Mark across the entire range of services set out in the specification. The grounds of invalidation are focused on the assertion that "[t]he term 'BIG BOX' should be available for use in Singapore in relation to retail establishments, particularly large ones" because the term "generally refers to a physically large retail establishment, which is usually part of a chain."¹⁶ Whilst the Applicant reserved the right to provide further evidence and particulars, the core complaint remained the same in the statutory declarations it filed.

68 The IP Adjudicator's view at [26] of his grounds of decision was that at as of the Application Date, the average consumer in Singapore would indeed have appreciated the trade mark significance of the Subject Mark across the full range of services set out in specification, notwithstanding the submission that

¹⁶ ABOD, vol I, p 12

the mark was essentially descriptive of the services to be provided. The attack under s 7(1)(c) of the Act accordingly failed.

69 The IP Adjudicator considered and rejected arguments that the Subject Mark lacked distinctiveness because of dictionary definitions. The first was the Oxford online dictionary cited by the Applicant, which defined “big box” as “[a] very large store which sells goods at discount prices, especially one specializing in a particular type of merchandise”. The definition provided, however, was described as “North American informal”. The second source cited by the Applicant was the Merriam-Webster online dictionary which defined “big-box” as “of, relating to, or being a large chain store having a boxlike structure”. The entries for these definitions were accessed on 16 and 14 September 2015 respectively.¹⁷

70 I am of the view that the IP Adjudicator was correct in coming to his conclusion that the definitions did not assist or advance the Applicant’s case. The Oxford online dictionary definition makes clear that the definition provided was “North American informal”. There is nothing to suggest that the definition had entered the vernacular in Singapore by the Application Date. The Merriam-Webster online dictionary is an American source and, in any case, the date of the copy in evidence is some ten years after the Application Date.

71 The point might also be made that well before 2005, many (or some) Singaporeans would have been likely to have come across the concept of big-box retailing when travelling, working or studying overseas such as in North America. Further, it may be thought that by 2005, there would already have been a sizeable number of Singapore residents originating from Europe or North

¹⁷ ABOD, vol I, pp 51 and 53.

America and who may therefore have been acquainted with the concept (in relation to warehouse and retail establishments) said to be embodied by the term “big box”. The difficulty, however, is that there is no evidence at all before this court to support the view that by 2005, the average Singapore consumer (even bearing in mind exposure to the international community) would have been familiar with the meaning that is being advanced.

72 The fact that there might have been some individuals in Singapore who were aware of the use of the words “big box” to allude to the concept of aggregating together in one place a large number of retailers, dealers, suppliers of goods for retail to customers, does not assist the Applicant’s case. For example, the head of business development in the Singapore branch of a large multinational hyper-store chain may be familiar with the meaning that has been advanced. Indeed, it appears that there were individuals within the EDB who were familiar with concept of “big-box retailing” given that the WRS promoted in April 2004 was to encourage the development of large out-of-town retail warehouses, *etc.* Nevertheless, this does not assist the Applicant given that the key issue is whether the *average consumer* in Singapore would be familiar with the descriptive meaning being advanced.

73 In reaching his decision, the IP Adjudicator noted at [27] of his decision the following cases cited by the Applicant: *Nutricia International BV v Société des Produits Nestlé SA* [2009] SGIPOS 6 (“*Nutricia*”) at [16], *G3 Enterprises Inc v Barcardi & Company Limited* [2014] SGIPOS 6 (“*G3 Enterprises*”) at [167], *Siemens AG v Sunonwealth Electric Machinery Industry Co Ltd* [2007] SGIPOS 4 at [1], and *Love & Co* at [88]). These decisions, however, do not assist the Applicant.

74 For example, Chan J commented in *Love & Co* at [88] that a reference to any English dictionary will quickly indicate whether the word “love” had become a customary word in current language or established practices of the jewellery trade. The facts, circumstances and issue here are distinguishable. The High Court did not decide that an English dictionary was always conclusive on the meaning of words in the context of resolving an issue in Singapore as to whether the word was distinctive in the trade mark sense. Indeed, Chan J stated at [87] that he had to make a determination, on the basis of evidence on the usage of the word whether in or outside Singapore and as presented to the court, as to whether the word “love” had, on a balance of probability, crept into the jewellery trade lexicon and become customary in the current language of the jewellery trade or in the *bona fide* and established practices of the jewellery trade, as evaluated at the relevant date. Likewise, in the present case, the issue is whether the word or phrase “big box” had, on the basis of the evidence before the Court, crept into the vernacular of Singapore such that it is to be understood in the context of retail services, *etc*, in the manner set out in the cited dictionary definitions.

75 In the *Nutricia* case, the issue concerned whether the plain word mark PROTECT could be registered in Class 5 for dietetic foodstuffs and substances for medical and clinical purposes, *etc*. In opposition proceedings, the opponents submitted, *inter alia*, that dictionary evidence from *Webster’s Third New International Dictionary* showed that the word “protect” was an ordinary dictionary word, bearing the following meanings including “to cover or shield from that which would injure, destroy, or detrimentally affect: secure or preserve against attack, disintegration, encroachment or harm...” The fact that the dictionary cited and relied on by the opponents in *Nutricia* was North American does not mean that the Singapore courts should accept all North American dictionary definitions without reference to actual facts and

circumstances in Singapore. In any case, I note that the Registrar, in setting out her reasons as to why the mark lacked distinctiveness in Singapore, stated at [23] that the word “protect” had well-understood meanings, the most relevant being that of securing, shielding, guarding against harm or attack. No specific reference was made specifically to the dictionary cited by the opponents.

76 In *G3 Enterprises*, revocation and invalidity proceedings arose in respect of a composite mark comprising a “ball” device, a “bar” and the word MARTINI registered in Class 3 for a range of specified goods including alcoholic beverages. A considerable amount of evidence was put before the Registrar including definitions drawn from various dictionaries. Whilst some of the dictionaries such as the Merriam-Webster online dictionary and the *Longman Dictionary of Contemporary English* included definitions for “martini”, there were other dictionaries which did not contain any such entry at all: *G3 Enterprises* at [131], [132] and [167]. Other evidence in *G3 Enterprises* included targeted internet searches; survey of bars, clubs, restaurants in Singapore; various articles from *The Straits Times*; and material on films, popular movie culture and so on. The quantity and types of evidence before the Registrar were considerable. The focus of the inquiry by the Registrar was sharply on how the average consumer in Singapore viewed the word “martini” at the relevant date.

77 The Applicant argued on appeal that by 2004, the term “big box” would have been understood in North America as alluding to the concept of aggregating together in one place, a large number of retailers, dealers, suppliers of goods for purpose of retail services to customers. The submission essentially was that at the very least, the term would have been known to persons in the retail or warehouse trade and to some customers residing in North America. Indeed, I accept that it is likely that some retailers in Singapore in or around

2004 would have come across the use of the expression “big box” in this context. But this misses the point. What this court is concerned with is the view of the average, discerning, reasonably well-informed and reasonably observant consumer in Singapore: see *Love & Co* at [61].

78 The fact that the public in Singapore is generally well-travelled and that some may have had exposure to the term “big box” overseas is certainly relevant as a background factor against which the distinctiveness in Singapore is to be examined. Indeed, I bear in mind that the public in Singapore is not confined to Singaporeans and will include foreign citizens in Singapore. This is a point I shall return to below. Nevertheless, distinctiveness must be assessed in light of the evidence as a whole. It is not enough to establish that *some* traders and consumers in Singapore would have understood or been aware of the meaning alleged and relied on by the Applicant at the Application Date: see *Love & Co* at [91]–[92] where Chan J quoted with approval the ECJ’s statement in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ETMR 585 at [54] that “if the competent authority finds that a *significant proportion* of the relevant class of persons identify goods as originating from a particular undertaking *because of the trade mark*, it must hold the requirement for registering the mark to be satisfied” [emphasis in *Love & Co*]. Whilst this statement was made in the context of acquired distinctiveness and not inherent distinctiveness, there is no reason why the requirement of a “significant proportion” should not also apply to the inherent distinctiveness enquiry.

79 In *Matratzen Concord AG v Hukla Germany SA* [2006] ETMR 48 at [25], the ECJ held that in determining distinctiveness, it must be borne in mind that because of linguistic, cultural, social and economic differences between member states of the EU, a trade mark which is devoid of distinctive character

or is descriptive of the goods or services concerned in one member state may not be so in another member state. Whether it does will depend on whether the term borrowed from the language of another member state in which it is devoid of distinctiveness carries the same meaning to the relevant parties in the member state in which registration is sought. If this is so as between the member states of the EU (especially bearing in mind the policies and principles of free movement of goods, services and people within the EU), the same must be equally true as between Singapore and other countries such as the United States (“US”). Even though the English language is common to Singapore and the US, it does not follow that an average, reasonably well-informed customer in Singapore will necessarily be familiar with the particular usage and meaning of a word or expression that has developed in the American vernacular.

80 In the present case, as discussed earlier, the Subject Mark was registered for a wide range of services. The service which is closest to the alleged descriptive meaning is the provision of retail services in “hypermarkets and warehouse retail outlets”. The Applicant’s submission is that all the services claimed are necessary to the essential function of a “big-box” establishment, which is to retail, advertise and promote a wide variety of consumer products. The Applicant argues that the specification consists entirely of quintessential retail and related services such as advertising and marketing.¹⁸ On this basis, the Applicant submits that the Subject Mark lacks distinctiveness for all the claimed services listed in the specification.

81 In *salesforce.com, Inc v European Intellectual Property Office* (“*SOCIAL.COM*”) Case T-134/15 (28 June 2016, European Union General Court (Third Chamber)) (“*salesforce.com*”), the court rejected an appeal against

¹⁸ Applicant’s submissions at [65].

the refusal by the European Intellectual Property Office (“EUIPO”) examiner of the application to register the mark SOCIAL.COM in relation to a wide range of goods and services. The court noted at [16] that the descriptiveness of a sign may be assessed only in relation to the relevant public’s understanding of that sign and the goods or services in question. The goods and services in that case were found to have been of a specialised nature and the relevant public comprised average consumers and a professional public. The mark SOCIAL.COM taken as a whole would be understood as an “overall internet-related concept in relation to society” or an “internet-based social interaction” (at [24]). The court went on to find at [30] that “all the goods and services covered by the mark applied for and which are the subject of the present dispute are related to social media or social networks in a sufficiently direct manner and form a group of goods and services of sufficient homogeneity.” On that basis, there was no need for the EUIPO Board of Appeal to carry out an examination of the descriptive nature of the mark applied for with respect to each of the goods and services concerned.

82 The IP Adjudicator at [29] of his decision rejected the argument that the Subject Mark was comparable to that in *salesforce.com*, on the ground that the trade mark BIG BOX registered for the services contained in its specification could not sensibly be compared with the patently descriptive mark SOCIAL.COM in relation to the goods and services in respect of which registration was sought at the EUIPO.

83 In any case, the IP Adjudicator went on at [30] of his decision to consider whether the specification should be declared invalid under s 23(9) of the Act in relation to only part of the specification of services, and particularly that relating to the provision of retail services in “hypermarkets and warehouse retail outlets”. The conclusion reached was that “even in relation to those

possible locations for the provision of the relevant service it should not be”, since “the Applicant has not satisfied me that at the relevant time the Subject Mark was descriptive (or generic or devoid of distinctive character) of services so provided.”

84 In coming to his conclusion, the IP Adjudicator acknowledged the effect of granting registration of “a semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark” is to place “a powerful weapon in powerful hands”: at [31] of the IP Adjudicator’s decision, quoting *Nichols* at [14]. The IP Adjudicator’s conclusion, however, was that the case before him did not involve “a semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark” for and in relation to the services for which the mark is registered.

85 I agree with IP Adjudicator’s decision that the Subject Mark is not descriptive of any characteristic but is inherently distinctive as an indication of trade origin, *ie*, as a trade mark, at the Application Date. Taking the Applicant’s case at its strongest, namely, the use of the Subject Mark for services comprising the bringing together of a variety of goods enabling customers to conveniently view and purchase those goods in retail shops, supermarkets, hypermarkets and factory outlets, the sign BIG BOX is not descriptive of the *service* of bringing a variety of goods together.

86 The fact that the sign BIG BOX may be descriptive or semi-descriptive when used in relation to warehouse buildings or indeed cardboard boxes does not assist the Applicant. Class 35, as noted, covers a broad range of services. Class 35 does not cover goods, objects or articles.

87 Given the range of services set out, I agree that the relevant public comprises the average consumer as well as businesses concerned with the retail

market. As discussed earlier, it is not enough if some executives or management staff from large multinational traders from the US and based in Singapore may have been familiar with the usage of the term contended for. It also bears repeating that the relevant date for the assessment is 26 January 2005. There is no doubt that at that date the WRS advanced by the EDB in 2004 was new to Singapore.

88 I note that the Applicant relies on several pieces of evidence in support of its contention that the Subject Mark was descriptive at the Application Date. These can be grouped as follows:

- (a) official press releases and reports;
- (b) *The Retailer*, a publication in 2004;
- (c) news articles from 2002 to 2004;
- (d) news articles from 2005 to 2016;
- (e) overseas publications on foreign markets; and
- (f) US Trademark Registration No 47771225.

Official press releases and reports

89 The first group of evidence includes a press release dated 28 April 2004 from EDB regarding the WRS (“the EDB Press Release”), which carried the heading: “New industrial land regulations to introduce fresh retail concepts like warehouse outlets and ‘big box’ retailers to Singapore”. The EDB Press Release explained that the concept of the WRS was to house the headquarters, logistics and retail functions of a warehouse outlet in one centralised location. Retail activities were allowed for industrial or warehouse developments under the

scheme.¹⁹ A similar statement was also set out in the 2004-2005 annual report of SPRING Singapore.²⁰

90 Whilst reference was made in the EDB Press Release to the idea of “fresh” concepts such as “big box retailers”, there was nothing to suggest that the relevant public as a whole would already have understood “big box retailer” to describe the services claimed in the specification under Class 35. In any case, I note that the EDB’s concept was the bringing together of warehouse, retail, logistics and management services under one roof.

91 I note as well that a circular from the Urban Redevelopment Authority dated 3 May 2004 (“the URA Circular”) addressed to professional institutes made no reference at all to the term “big box retailer”.²¹ Instead, it merely sets out the planning parameters for interested applicants under the WRS. The URA Circular goes on to stress that the WRS was designed to facilitate new business models which genuinely required the integration of warehouse or industrial function with retail use.²²

The Retailer, a 2004 publication

92 *The Retailer* is a quarterly journal of the Singapore Retailer Association. A 2004 issue included a reference to the WRS and “fresh retail concepts” such as “big box” retailing.²³ I note that whilst this publication referred to this

¹⁹ ABOD, vol I, p 31.

²⁰ ABOD, vol VII, p 49.

²¹ ABOD, vol I, p 28.

²² ABOD, vol I, pp 28–30.

²³ ABOD, vol VII, p 49.

concept, the terms and language used in the publication simply echoed those in the EDB Press Release.

News articles from 2002 to 2004

93 The third group includes articles in publications such as *The Business Times*, *The Straits Times* and *The Edge*. Whilst I have considered all the publications provided by the Applicant, a brief comment on a selection will suffice to give the flavour of the publications and references to “big box.” For example, on 29 April 2004, *The Business Times* carried an article titled “Warehouse retail scheme set to make impact”. The article described the WRS that had just been announced and included references to the idea of “‘big box’ formats which typically occupy 100,000 sq ft to 200,000 sq ft”.²⁴ Another article referred to was published in *The Business Times* on 11 May 2004 with the title “Warming to warehouse retailing”. This article reported that “big names like Ikea, Courts and Mustafa” had expressed interest in the WRS, and set out the view of the managing director of the Applicant that “[b]ig-box retailing [was] a standard feature in Europe and now even Asia, particularly in places like Thailand.”²⁵ Another *The Business Times* article referred to was published on 20 July 2004 under the title “Want productivity? Look for competition”. This article concerned a new study by the McKinsey Global Institute on productivity, and made a reference to “big-box retailers”²⁶. Yet another article in *The Business Times* dated 25 November 2002 discussed the “big box” concept that was gaining popularity in Asian countries including Thailand, Malaysia and Singapore, and the problem of developing such a concept in land-scarce

²⁴ ABOD, vol I, p 57.

²⁵ ABOD, vol I, p 70.

²⁶ ABOD, vol I, pp 76–79.

Singapore given the need for ample car-parking spaces.²⁷ Similarly, a 30 June 2003 article in *The Edge Singapore* discussed some of the problems of developing the concept in Singapore, such as the need for a lot of physical space.²⁸

94 Whilst there are a few articles which pre-date the EDB Press Release of 28 April 2004, the majority of the articles is concerned with the WRS that had just been launched by the EDB. To be sure, it does appear that the big-box concept (at least in terms of combining warehousing and retail services under one roof) was familiar to some senior staff members of large retailers such as Ikea, Carrefour and the Applicant, and that the concept was also successful in some neighbouring countries such as Thailand. With that said, it is clear the concept was new to the average Singapore consumer. Indeed, whilst some large retailers in Singapore may have been familiar with the concept, it is by no means clear on the basis of this evidence whether the average retailer or average retail business in Singapore at the relevant date would have been acquainted with the use of the term “big box” as a shorthand to refer to combining warehouse and retailing services under one roof.

News articles from 2005 to 2016

95 The Applicant also referred the court to a number of articles or publications that post-date the Application Date. The question is whether these articles and publications enable the court to draw any inference as to what was the state of affairs at the Application Date: in particular, whether BIG BOX was already descriptive of the characteristics or quality of the services for which

²⁷ ABOD, vol VII, p 55.

²⁸ ABOD, vol VII, p 59.

registration was sought and obtained, as seen from the perspective of the relevant public in Singapore.

96 Again, a brief description of a selection of these articles or publications is sufficient to give the flavour of their contents. First, there is an article published in *The Business Times* on 11 February 2005 on the results of CapitaMall Trust, which owned five shopping centres in Singapore. A passing reference was made to the Government’s intention to release sites for retail use, as well as the “big-box” format for the suburbs under the WRS.²⁹ Similar passing references can be found in other articles published in *The Business Times* on 29 September 2005 and in *The Edge* on 24 October 2005.³⁰

97 Another article on the WRS was published in *The Business Times* on 7 November 2005, where it was reported that the scheme was expected to lead to new retail concepts like warehouse outlets and “big-box retailing”. Retailers said to be interested included the Applicant, Ikea and Giant Hypermarket.³¹ A similar point was made in a DTZ Asia property market update dated 9 December 2005.³²

98 A more recent article published on *Channel NewsAsia* on 5 April 2014 entitled “Going big: Warehouse retailing in Singapore” explains that warehouse retailing was initiated by the EDB in 2004 through the WRS. The article comments that the pilot programme was discontinued after three years but it had “allowed the likes of Ikea and Courts to set up store here”. The article, amongst

²⁹ ABOD, vol VII, pp 87–88.

³⁰ ABOD, vol VII, pp 91 and 93.

³¹ ABOD, vol VII, p 95.

³² ABOD, vol VII, p 97.

other things, states that “[r]etail development Big Box was the fourth and last to be approved under the [WRS]”.³³

99 The Applicant also exhibited several other articles from 2005 to 2016 containing passing references to “big-box retailers”, including ones from *Today*, *My Paper*, *Dow Jones International News* and *Lianhe Zaobao*.³⁴

100 Other publications cited by the Applicant include blog posts, such as one dated 21 October 2012 on a blog titled *Frenzeelo*.³⁵ The post begins with the following:

When I hear the phrase ‘big box retailers’, I will immediately think of popular retailers in the US like Target, Walmart and Best Buy. Unfortunately, they did not make their presence in Singapore so we can’t enjoy affordable furniture, clothes, electronics and groceries. Not all is lost though. Singapore does have its own set of big box retailers in the east called Tampines Retail Park which consists of a Giant Hypermarket, Ikea Furniture Store and Courts Megastore...

Whilst the blog post connects “big-box” retailing with retailers like Walmart and Giant Hypermarket, it is dated 21 October 2012 which was just before the Applicant had opened a retail warehouse store in Tampines under the WRS.

101 After reviewing the various articles and publications referred to by the Applicant, I am unable to draw any inference that the Subject Mark lacked distinctiveness on the Application Date of 26 January 2005 as being descriptive of or an allusion to the quality of the services for which registration was obtained, or that the words “big box” had become customary in the current

³³ ABOD, vol VII, p 164.

³⁴ ABOD, vol VII, pp 101, 108, 113, 118, 126.

³⁵ ABOD, vol VII, p 187 *et seq.*

language or in the *bona fide* and established practices of the trade in Singapore (see [110] below).

Overseas publications on foreign markets

102 The Applicant also submitted copies of a number of articles published on American and other foreign-based websites that refer to “big box” retailers in those countries. For example, on 24 October 2004, an article titled “Home Depot: Thinking Outside The Big Box” published on the *Bloomberg* website concerns American home improvement supplies retailer Home Depot, productivity issues and the need to embrace new technologies.³⁶ An article from *The Los Angeles Times* dated 7 April 2004 under the heading “2 Bills Target ‘Big Box’ Benefits, Impacts” touches on concerns raised against large retail stores in light of their impact on smaller businesses.³⁷ In the case of Australia and New Zealand, an article dated 18 March 2004 from *Fairfax Digital* under the headline “Discount variety retailers in big guns’ firing line” discusses competition between small format stores and “big-box formats”.³⁸ In addition, the Applicant also referred to various reports and academic papers on the North American retail and warehouse market.³⁹

103 Like the IP Adjudicator, I do not consider that these publications help in advancing the Applicant’s case to any significant extent. The point has already been made that the big-box retailing format was new to Singapore in 2004. Indeed, it appears that regulations prior to the WRS did not permit or encourage warehouse and retail operations to be co-located under one roof.

³⁶ ABOD vol I, p 106.

³⁷ ABOD vol I, p 121.

³⁸ ABOD, vol I, p 123.

³⁹ ABOD, vol I, p 123 *et seq.*

US Trademark Registration No 4771225

104 The Applicant also referred to the US Trademark Registration No 4771225 that “consists of the words ‘BIG’ and ‘BOX’ in blue separated by a blue star, with a grey shadow to the upper right positioned behind the words ‘BIG’ and ‘BOX’ and the star” registered for retail store services featuring a wide variety of goods (“the US Trade Mark”).⁴⁰ The key point was that the examiner required a disclaimer that “No claim is made to the exclusive right to use “BIG BOX” apart from the mark as shown”.

105 The filing date for the US Trade Mark is 18 December 2013 and the date of registration is 14 July 2015. The priority date claimed is 20 June 2013. Leaving aside the fact that US trade mark law and practice may not be the same as Singapore’s and the difference in the services claimed in respect of each mark, the key point is that the application for the US Trade Mark was filed in 2013 by which time (if not well before), the expression “big box” may well have become associated with warehouse retailing in the US market in the minds of the relevant US public. Again, this does not say much about the perception of the relevant public in Singapore at the Application Date.

106 Having considered all of the arguments and evidence put forth by the Applicant, I am not convinced on a balance of probabilities that the Subject Mark consists of a sign that designates the characteristics of goods or services under s 7(1)(c) of the Act.

⁴⁰ ABOD, vol VIII, pp 9–10.

Invalidation under s 7(1)(d)

107 Section 7(1)(d) of the Act excludes “trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”.

108 The Applicant’s contention below and on appeal is that the words “big box” were viewed by the body of traders at the Application Date in retail and warehouse industries as a generic description of large retail or warehouse establishments. The body of evidence said to support this contention comprises the newspaper articles, internet publications, reports, *etc*, discussed above.

109 I am unable to accept the Applicant’s contention. The relevant public in Singapore comprises not just a few large multinational retail chains, but retailers and warehouse businesses in general as well as consumers in Singapore. Retailers in Singapore will range from small provision stores to medium single-store businesses to large multi-branch retail stores, all the way through to a number of large multinational stores. Whilst the Applicant underscores the importance of not excluding retailers as members of the relevant public in Singapore, it is also important to bear in mind the average consumer in Singapore whose custom is the driver behind all types of retail businesses in Singapore whether small, medium or large and whether local or multi-national.

110 I do not accept that the evidence supports the contention that the Subject Mark was customary in current language in Singapore or in the *bona fide* and established practices of the trade at the Application Date.

Invalidation under s 7(1)(b)

111 Section 7(1)(b) of the Act provides that trade marks which are devoid of any distinctive character shall not be registered.

112 The meaning of distinctiveness has been discussed already. For the reasons set out above in relation to ss 7(1)(c) and (d), the Applicant has not established that the Subject Mark was devoid of distinctiveness at the Application Date in the Singapore market for the services in respect of which registration was sought and obtained.

General comments on the Applicant’s invalidity attack

113 The point has been made that the burden lies on the Applicant to prove the ground of invalidity on a balance of probabilities (see [17] above). A considerable time has elapsed between the Application Date and the invalidity attack. It is understandable that the Applicant may encounter practical problems in marshalling evidence as to what the state of affairs in Singapore was in January 2005 as to the relevant public’s understanding or usage of the words “big box” in the Singapore market. Nevertheless, the burden falls on the Applicant’s shoulders.

114 Hindsight knowledge or analysis must be avoided. Evidence that the words “big box” are synonymous in Singapore today with large retail/warehouse businesses does not necessarily mean that the words lacked distinctiveness, *etc*, at the Application Date. If the evidence is that the trade mark has become the common name in the trade for the product or service in respect of which it is registered due to the acts or inactivity of the proprietor, the solution would be to seek revocation of the registration under s 22(1)(c) of the Act instead. Furthermore, an argument based on the current state of affairs

which then looks back to a much earlier point in time is particular dangerous when combined with a “leading question” type of analysis which asks the court to consider a number of recent publications on “big-box” retailing and whether they indicate that BIG BOX was descriptive of and/or alluded to some characteristic of a very large retail/warehouse store at the Application Date. Instead, the proper question is whether the relevant public (retailers and consumers) in Singapore would appreciate the trade mark significance of BIG BOX on 26 January 2005 without being educated that it is being used for that purpose.

115 In coming to my decision, I also note that the words “big box” can mean different things in the context of retail services. The dictionary definitions referred to by the Applicant speak of a “very large store” or a “large chain store having a box-like structure” (see [69] above). The WRS, on the other hand, promotes the idea of bringing warehouse and retail operations under one roof. A 2004 report cited by the Applicant titled “Big Box Retail and Austin” prepared for the city of Austin, Texas (“the Austin Report”) states that “[d]efining what qualifies as a big box retail development in any particular community obviously varies” and includes discount department store, superstores, warehouse clubs and “category killers” (stores which offer a large selection of merchandise at low prices in a particular category (*eg*, toys) where store sizes are typically smaller).⁴¹ In the present case, Segment 1 of the claimed services covers retail shops, convenience stores, as well as warehouse retail outlets and big department stores. Not all retail shops are large in size or part of a large chain. Many convenience stores may well be small in size. If a distinction is to be drawn between “big” department stores or “large retail outlets” and others, the question arises as to what is meant by “big” or “large” in the

⁴¹ ABOD, vol I, p 141.

Singapore market. As the Austin Report notes, the meaning of “big box” in the retail trade varies from community to community. Indeed, it cannot be assumed that it has a particular meaning when used in the context of retail services in any given community. On the facts and evidence, I am not satisfied that the Applicant has demonstrated that the words were customary in the current language or in the *bona fide* and established practices of the trade in Singapore at the Application Date.

116 Notwithstanding the submissions of the Applicant, I find that the attack on the Subject Mark under ss 7(1)(b), (c) and (d) fails in respect of the services set out in the specification as a whole. I make clear that even if the attack is considered simply for “[t]he bringing together for the benefit of others of a variety of goods (excluding transport thereof) enabling customers to conveniently view and purchase those goods in retail shops, supermarkets, hypermarkets, convenience stores, wholesale outlets, factory outlets, warehouse retail outlets, retail outlets and big department stores” (*ie*, Segment 1), the Subject Mark possessed distinctiveness as a trade mark in Singapore on the Application Date.

Acquired distinctiveness

117 I move now to the issue of acquired distinctiveness. The IP Adjudicator rightly commented at [46] of his decision that this issue would only be relevant if the Subject Mark were found to lack distinctiveness at the Application Date. If that had been the finding, the question would then have arisen as to whether the Subject Mark has acquired distinctiveness as a result of use made of it by the proprietor since the Application Date.

118 In reaching his decision that the Proprietor had not established that the Subject Mark had become distinctive as a result of use made of the Subject Mark

post the Application Date, the IP Adjudicator, quoting *Love & Co* at [95], remarked at [59] that it is generally “an enormously difficult task to acquire or regain a *de facto* distinctive character” once an applicant has succeeded in establishing that the registered mark was generic at the date of its registration. Whilst the Proprietor had put into evidence the results of a survey conducted in 2016, the IP Adjudicator found that the survey results fell far short of the evidence sufficient to prove that the Proprietor had successfully completed that “enormously difficult task”.

119 Given my decision that the IP Adjudicator rightly concluded on the evidence before him that the Subject Mark was inherently distinctive and capable of performing its function as an indication of origin at the Application Date, it is not necessary for this court to set out a detailed discussion of the survey evidence. That said, I agree with the comments made by the IP Adjudicator at [47]–[48], following Chan J in *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 at [130], that “great care and circumspection must be taken with respect to market surveys”. The purpose or objective of the survey in the context of trade mark issues must be borne in mind, as well as the question of who has the burden of proof. Is the survey conducted for the purposes of proving or supporting a negative: *eg*, that the trade mark is not descriptive or generic or customary? Or is the survey intended to address the positive: *eg*, that the trade mark has acquired distinctiveness as a result of use, which as the IP Adjudicator rightly comments at [49] is a factual proposition? Bearing in the mind the purpose or objective (and in some cases there may be several), care is needed in framing the questions, selecting a relevant cross-section of the Singapore public and securing a statistically significant number of participants.

120 I pause here to note that the market survey was conducted by Blackbox, a well-established member of the Market Research Society of Singapore. The evidence was that Blackbox had been instructed to conduct a representative survey on the meaning or association with the term “big box” (if any) amongst Singapore citizens and permanent residents. A total of 363 survey responses were adduced in evidence. The interviews were conducted at 15 locations across Singapore. Apart from the point made by the IP Adjudicator at [57] of his decision that the survey reports were incomplete records of what was said by the interviewers and interviewees (clearly a matter of some significance), I have no comments on the locations where the interviews were conducted except to note that higher brand recognition might be expected in or nearby Jurong, where the Proprietor’s Mall is located.

121 The only other observation I make relates to the decision to limit the survey to Singapore citizens and permanent residents. Although the decision to limit the survey to Singapore citizens and permanent residents is readily understandable, the court has to bear in mind the point that the trade mark issue concerns the understanding or perception of the relevant public in the relevant market in Singapore. A proportion of Singapore’s population consists of residents who work, study and live in Singapore without permanent residence, and form part of the body of consumers in Singapore. Further, whilst an overseas visitor on vacation in Singapore or simply passing through might not be part of the relevant public in the relevant market in Singapore, if an overseas visitor who is in Singapore for a few days during which he delivers a public lecture on new avenues for business and marketing, the contents of that lecture may still be relevant in determining the state of affairs in Singapore in terms of the likely knowledge and perceptions of the members of the relevant Singapore public on matters discussed in the lecture. Much will depend on the facts and circumstances.

122 After reviewing the submissions and the survey report, I see no reason to disagree with the IP Adjudicator’s conclusion at [59] of his decision that even if the best possible light is put on the evidence, as the Proprietor did in its submissions by stating that 25.1% of those interviewed linked “big box” to the Mall, this was still insufficient to show that the Subject Mark had acquired a distinctive character for the services in respect of which it has been registered.

123 It bears repeating that whilst the Proprietor registered the Subject Mark on 26 January 2005, it was only nearly 10 years later on 27 December 2014 that the Proprietor opened the Mall which carried the Subject Mark. Before then, it appears based on the evidence before me that the Applicant opened a retail warehouse under the WRS in December 2012 and advertised it in December 2014 (see [9] above). It does not appear that anyone else opened a warehouse retail mall in Singapore under or by reference to the words “big box”. That being so, it is perhaps not surprising that some interviewees associated the Subject Mark with the Mall.

124 The fact some members of the relevant public recognise the Subject Mark in connection with the Mall does not necessarily mean that distinctiveness been acquired in the trade mark sense. Take, for example, *Merck & Co Inc v Smith Kline Beecham Plc (JERYL LYNN Trade Mark)* [1999] FSR 491. This case concerned a method for producing strains of the mumps virus that was developed in 1963. The method was generally known in the pharmaceutical industry by the name “Jeryl Lynn”, after the girl who provided the throat swab from which the mumps virus was isolated. After the patent had expired, an attempt was made by *Merck* (the patentee) to register JERYL LYNN as a trade mark for medicines and pharmaceutical preparations. *Merck* relied on the extensive use and promotional efforts of the name for its anti-mumps vaccine. Laddie J, in finding against distinctiveness, held at 497:

... Where, for whatever reason, a particular product is only obtainable from one source, identifying the product will inevitably mean that the source is indirectly identified as well. The result is that it is all too easy to assume that the name used by the source for his unique product is an indication of origin when in fact the relevant public treat it as no more than the proper name for the product.

125 The general point is evidence that some members of the public recognise the trade mark does not necessarily mean that the trade mark has acquired distinctiveness. In the present case, I have noted that the Proprietor was not the only business that had applied under the WRS, nor does it appear that the Proprietor was the first to actually launch a warehouse retail mall under the WRS. Nevertheless, I also note there were very few warehouse retail businesses in Singapore under the WRS. Whilst the Proprietor registered the Subject Mark on 26 January 2005, its warehouse retail mall only started some 10 years later together with advertisements of the same under the Subject Mark. It appears that at the time, the only other large retailer to have used “big box” in connection with warehouse/retail trade was the Applicant. It is in this context that the survey results have to be interpreted.

126 Pausing here, I note that if the mark JERYL LYNN had been registered in 1963 as a trade mark for medicines and pharmaceutical preparations, it is very likely the registration would have been valid at that date. But, assuming that all other facts remained the same, the registered trade mark would nonetheless have become susceptible to revocation once the name became the common name for mumps vaccines.

Conclusion

127 For the reasons set out above, I dismiss the appeal against the IP Adjudicator’s decision, with costs to be agreed or taxed.

128 This case highlights the difficulties which arise where a registered trade mark is attacked many years after registration on the basis of invalidity at the date of registration. This is not a case where revocation is sought on the basis of non-use or because the mark has become the common name in the trade for the product or service for which it has been registered. Just as it is very difficult to obtain independent persuasive evidence on whether the relevant public viewed the mark in question as a trade mark (*ie*, whether they appreciated the trade mark significance without being educated of that purpose) for the relevant goods or services at a date long in the past, it is also challenging for the proprietor to marshal evidence to demonstrate that, even if the trade mark lacked distinctiveness all those years ago, it has through use acquired *de facto* distinctiveness (as an indicator of trade origin) in the minds of the relevant public. Evidence, particularly survey evidence, in either case must be assessed with care.

129 The court expresses its appreciation to learned counsel for the helpful submissions.

George Wei
Judge

Pang Sze Ray Melvin and Ong Eu Jin (Amica Law LLC) for the
appellant;
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LLP) for the respondent.
