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

Trade Mark No. T1010624H
13 April 2021

IN THE MATTER OF A TRADE MARK REGISTRATION BY

BAIDU ONLINE NETWORK TECHNOLOGY (BEIJING) CO., LTD.

AND

REVOCATION THERETO BY

BAIDU EUROPE BV

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Representation:

Mr Max Ng and Ms Loshini Shanker (**Gateway Law Corporation**) for the Registered Proprietor
Ms Christine Ess, Ms Dimple Banghar and Ms Kimberly Chong Kah Wai (**Tan Peng Chin LLC**) for the Applicant

GROUNDS OF DECISION

1 百度百態[1] or the multiple facets of Baidu.

2 In this dispute, the subject mark, T1010624H ("***Registered Mark***"):

[1] Pronounced as "Bai du bai tai".

 [2] is registered for

Class 38: Message sending; communications by computer terminals; communications by telephone; computer aided transmission of messages and images; providing access to databases; providing telecommunications connections to a global computer network; chat room services (telecommunications services); voice mail services; electronic bulletin board services (telecommunications services); electronic mail; all included in Class 38 and;

Class 42: Computer software design; maintenance of computer software; computer system design; creating and maintaining web sites for others; providing search engines for the internet; conversion of data or documents from physical to electronic media; quality control; technical project studies; rental of web servers; all included in Class 42.

3 The ***Registered Mark*** was registered with effect from 18 August 2010[3] in the name of Baidu Online Network Technology (Bejing) Co., Ltd (the "***Registered Proprietor***")[4] while the date of completion of the registration procedure[5] was 14 January 2011. On 23 October 2018, Baidu Europe B.V. (the "***Applicant***") filed an application for revocation based on non-use. The ***Registered Proprietor*** filed supporting evidence together with its counter-statement on 21 February 2019 and thereafter on 3 November 2020.[6]

Grounds of Revocation

4 The ***Applicant*** relies on sections 22(1)(a) and (b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("Act") in this action. In addition, it also pleaded section 22(6) for partial revocation.

Evidence and written submissions

5 The evidence comprises the statutory declarations of:

(i) Ms Wang Qiu Xiang, Legal Counsel of the ***Registered Proprietor*** dated 15 February 2019 ("***Registered Proprietor's 1st SD***"); and
(ii) the same Ms Wang dated 26 October 2020 ("***Registered Proprietor's 2nd SD***").

[2]The English words are the transliteration of the Chinese characters which mean "hundred times".
[3] The registration date of a mark is backdated to the date when the application for the registration is filed (see section 15(2) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("Act")).
[4] For clarity, ***Registered Proprietor*** henceforth will include the ***Registered Proprietor's*** associated entities (see [3] of the ***Registered Proprietor's*** evidence dated 15 February 2019 (defined above as ***Registered Proprietor's 1st SD***)).
[5] This refers to the date when the certificate of registration is issued and may be different from the date of registration (see section 15 of the Act above).
[6] This was the re-executed evidence. The original evidence was filed on 28 September 2020.

6 Parties submitted the following written submissions:

(i) ***Applicant's*** written submissions filed on 15 March 2021 ("***AWS***");
(ii) ***Applicant's*** reply submissions filed on 30 March 2021 ("***ARS***");
(iii) ***Registered Proprietor's*** written submissions filed on 13 March 2021 ("***RWS***"); and
(iv) ***Registered Proprietor's*** reply submissions filed on 30 March 2021 ("***RRS***").

Applicable Law and Burden of Proof

7 The applicable law is the Act, and under section 105 the burden of proving use of trade mark falls on the registered proprietor to show what use has been made of it.

Background

8 The ***Registered Proprietor*** deposed that it was established on 18 January 2000 by Mr Robin Lee and Mr Eric Xu in Beijing, China. The ***Registered Proprietor*** has been engaging in Chinese web related goods, including, a Chinese language search engine, websites, audio files and images. Baidu Inc., the ***Registered Proprietor***'s parent company, was listed on NASDAQ on 5 August 2005. The ***Registered Proprietor***, its parent company, together with Baidu (Hong Kong) Limited, Beijing Baidu Netcom Science and Technology Co., Ltd are associated companies.[7]

9 The ***Applicant*** is a company registered in the Netherlands, and described itself as an "internet services provider focusing on software consultancy, computerization and web-portal design".[8] The ***Applicant*** submitted that it "has been providing telecommunication and related information technology services worldwide including Singapore since at least 9 August 2006".[9] There is no other information provided as to the background of the ***Applicant***. In this regard, there is no obligation under the Act for the ***Applicant*** to tender any evidence.

10 The ***Registered Proprietor*** submitted an article via its reply submissions[10] to show the connection between the ***Applicant*** and Michael Gleissner.[11] However, this cannot be taken into account as it was not submitted as evidence. In any event, such information is irrelevant for the purposes of this revocation for non-use action. The rationales for a revocation action have been elaborated by the IP Adjudicator in the case of ***The Patissier LLP v Aalst Chocolate Pte Ltd*** [2019] SGIPOS 6 ("***Patissier***"):

> [21] Before identifying and analysing the legal test(s) to be applied under Section 22(2) TMA to determine whether the Proprietor has put the registered trade mark to genuine

[7] ***Registered Proprietor's 1st SD*** at [3].
[8] See [1] ***AWS***.
[9] See [1] ***AWS***.
[10] Annex B of ***RRS.***
[11] Gleissner is known to be a serial trade mark filer, who has filed thousands of trade mark applications worldwide through hundreds of different companies controlled by him, and is embroiled in disputes with various brand owners all over the world.

use, it may be helpful to set out the underlying policy rationales behind the trade mark revocation mechanism within the trade mark law framework. Non-use of a registered trade mark can result in the revocation of the trade mark registration because of:

> (i) *The inaccuracy rationale*. The accuracy of the trade marks register is jeopardised by the continued presence of the registered trade mark within the trade mark registration system. As a public record of all the statutorily created intellectual property rights protected by the TMA, the trade marks register performs an important notification function to rival traders and the public at large…Public confidence in the fidelity of the trade mark registration system will be undermined if the trade marks register is not kept up to date, where registered trade marks which have not been put to genuine use by their proprietors are not expunged from the trade marks register.
>
> (ii) *The unjustified legal monopoly rationale*. The registered proprietor no longer deserves to enjoy the proprietary rights created by the trade mark registration when the registered trade mark is not performing the origin-indicating function that justified the existence of the legal monopoly in the first place…The legal monopoly sustained by the continued registration of a trade mark is legitimate only to the extent that the registered mark continues to perform, through its usage in the marketplace, as an indication of source or origin for the goods and services of the registered proprietor.
>
> (iii) *The unfair competition rationale*. The continued grant of a legal monopoly to the registered proprietor might facilitate acts of unfair competition, which runs contrary to the objectives behind the trade mark regime. If a user of the registered trade mark system were allowed to accumulate trade mark registrations, and keep his registered trade marks on the trade marks register even though they have not been put to genuine use, then the property rights acquired through such trade mark registrations can be weaponised against other traders with legitimate interests in exploiting trade marks that are identical or similar to these registered trade marks.

The above is in contrast to an action where, for example, the registration of a trade mark is opposed on the basis that it has been applied for in bad faith under section 7(6).

MAIN DECISION

Ground of Revocation under Section 22

11 Section 22(1), (2) and (6) of the Act provides:

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

> (a) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to ***genuine use in the course of trade*** in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
>
> (b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non use…
>
> (2) For the purposes of subsection (1), use of a trade mark includes use in a form differing in elements ***which do not alter the distinctive character of the mark*** in the form in which it was registered, and use in Singapore ***includes*** applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore ***solely for export purposes***.[12]
> …
> (6) Where grounds for revocation exist in respect of only ***some of the goods or services*** for which the trade mark is registered, revocation shall relate to those goods or services only.

[Emphasis in bold and italics mine]

Decision on Section 22(1)(a)

Relevant periods

12 The first step is to identify the relevant periods. The ***Applicant*** has indicated two such periods:[13]

> [5] The [***Applicant***] submits that…..
>
> (a) In respect of section 22(1)(a) of the TMA…the correct 5-year period should be from ***15 January 2011 to 14 January 2016***.
>
> (b) In respect of section 22(1)(b) of the TMA…the correct 5-year period should be from ***23 October 2013 to 22 October 2018***.

I agree with the ***Applicant***.

[12] For clarity, I do not think that the applicability of section 22(2) is subject to it being specifically pleaded / relied on in the Counter-statement (see [28] ***ARS***).
[13] ***ARS*** at [5].

The Law

13 The law in relation to revocation has been summarised by the Principal Assistant Registrar ("***PAR***") in ***FMTM Distribution Ltd v Tan Jee Liang trading as Yong Yew Trading Company*** [2017] SGIPOS 9 ("***FMTM***"):[14] [15] [16]

> [37] The following legal principles are trite and undisputed.
>
> [38] First: In an action for non-use revocation, the ***burden of proof*** is on the proprietor to show what use has been made of the mark. (Section 105 TMA.)
>
> [39] Second: A trade mark serves to indicate the source of the goods to which it is affixed and registration facilitates and protects this function of the trade mark. There must be ***genuine use*** of the trade mark before its function is served and protection by registration ***justified***. The register serves as a ***notice to rival traders*** of trade marks that are already in use. As such, to allow a mark that is not *bona fide* in use to remain on the register would be deceptive and could permit the registered proprietor to unfairly hijack or usurp a mark and/or monopolise it to the exclusion of other legitimate users. (*Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 ("*Weir Warman*") at [99].)
>
> [40] Third: The essential question in Section 22(1)(a) TMA is whether there has been genuine, or *bona fide*, use of the mark, in the course of trade. For use to be considered genuine, the use in question ***does not have to be significant in the qualitative sense*** provided it was ***in accordance with the essential function of a trade mark***, which is to guarantee the origin of goods or services to the consumer or end user. (*Weir Warman* at [99] – [100].) Although not cited in argument, I note that this principle was further elaborated upon in *Société des Produits Nestlé SA and anor v Petra Foods Ltd and anor* [2017] 1 SLR 35, where the Court of Appeal clarified that **genuine use means *bona fide use as a trade mark*** (i.e. use of the mark to indicate the origin of the goods to which it is affixed).
>
> [41] Fourth: ***Token use*** for the sole purpose of preserving the rights conferred by the mark, or use which is just ***internal use*** by the proprietor concerned, is ***not genuine use***. (*Weir Warman* at [100] citing *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 717.)
>
> [42] Fifth: There is ***no rule that de minimis use cannot constitute genuine use***. ***No one single objective formula which applies to all situations can be laid down; much would depend on the fact situation in each individual case***. (*Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 at [44] ("*Wing Joo Loong*").)

[14] Item 10 of the ***Registered Proprietor's*** bundle of authorities (***RPBoA***) at tab J.
[15] See [37] – [43] ***FMTM.***
[16] For clarity, the ***Applicant*** relied on the case of ***Bigfoot Internet Ventures Pte Ltd v Apple Inc*** [2017] SGIPOS 4 ("***Bigfoot***") for the principles instead (see [17] ***AWS***).

> [43] Sixth: As a general rule, ***the fewer the acts of use relied upon, the more solidly the acts need to be established***. In a case where one single act is relied on, this single act ought to be established by, if not conclusive proof, overwhelmingly convincing proof. (*NODOZ Trade Mark* [1962] RPC 1 ("*NODOZ*"), followed by *Nike International Ltd v Campomar SL* [2006] 1 SLR 919 (SGCA). ("*Nike CA*") It would stand to reason that where there are a number of acts of use relied upon, the standard of proof should be the usual civil standard on a balance of probabilities.

[Emphasis in bold and italics mine]

14 To the above, I add, as submitted by the ***Applicant***:[17]

> [12] The Registered Proprietor must show "solid and objective evidence" and this was made clear by the Court of Appeal in *Wing Joo Loong Ginseng Hong (Singapore) Co Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 ("***Wing Joo Loong***") at [44] *"...genuine use of a trade mark [could not] be proved by means of probabilities or suppositions" (at [59]), but must instead be "demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned" [emphasis added] (ibid)."*
>
> [13] Further, the recent case of *Romanson Co. Ltd. v Festina Lotus, S.A.* [2015] SGIPOS 335 has confirmed that the standard for genuine use in revocation cases is **"**pegged at a higher standard[18] than that for determining goodwill" at [85].
> …
>
> [18] The Court of Appeal in [*Société des Produits Nestlé SA and another v Petra Foods Ltd and another* [2017] 1 SLR 35] stated at [122]:
>
> > *"The question of whether there has been genuine use of a registered trade mark entails a factual inquiry. In La Mer Technology Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) [2008] ETMR 9 at [57]…the CFI elaborated on how an examination of whether a trade mark had been put to genuine use should be carried out:*
> >
> > > *To examine whether … [a] trade mark has been put to genuine use,* ***an overall assessment must be carried out,*** *which takes into account all the relevant factors of the particular case.* ***That assessment entails a degree of interdependence between the factors taken into account.*** *Thus, the fact that [the] commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the… trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, [the]*

[17] [12], [13] and [18] ***AWS***.
[18] In the sense that in the context of goodwill, it is "exposure, as opposed to use" (see [53] in ***Novelty Pte Ltd v Amanresorts Ltd and another*** [2009] 3 SLR(R)).

> *production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market."*

[Emphasis in bold mine]

15 Last but certainly not least, as submitted by the ***Registered Proprietor***:[19]

> [14] In *Audi AG v Lim Ching Kwang* [2017] SGIPOS 2, the Learned PAR held that:
>
> > [24] I will not focus individually on each and every item of evidence lodged by the Registered Proprietor as it is clear to me that in considering the evidence and purposes of examining whether there is genuine use of a trade mark, ***an overall assessment*** must be carried out which takes into account all of the relevant factors in the particular case. While genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence, it cannot be ruled out that ***the totality of items of evidence*** may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts.

[Emphasis in italics and in bold mine]

16 Some possible ways of using the mark include those as enumerated in section 27(4):

> Section 27(4) For the purposes of this section and sections 28, 29 and 31, a person uses a sign if, in particular, he —
>
> > (a) applies it to goods or the packaging thereof;
> > (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
> > (c) imports or exports goods under the sign;
> > (d) uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or
> > (e) uses the sign in advertising.

17 In this regard, the ***Applicant*** argued:[20]

> [6] The Registered Proprietor submitted that it relied on section 27(4) of the TMA. The Applicant submits that this was not pleaded by the Registered Proprietor in its counter statement, and raised for the first time in the [***RWS***].

[19] [14] ***RWS***.
[20] [6] and [7] ***ARS***.

> [7] In any event, the Applicant submits that while section 27(4) of the TMA is relevant for determining if there has been use of the Trade Mark, ***it is not determinative*** since section 27(4) clearly states that it is for the purposes of sections 27, 28, 29 and 31 of the TMA.

[Emphasis in bold and italics mine]

For clarity, I agree with the ***Applicant*** that section 27(4) is not determinative in relation to this issue.[21]

Use which does not alter the distinctive character

18 For the issue of use which does not alter the distinctive character of the mark, the ***PAR*** at ***Aussino International Pte Ltd v Aussino (USA) Inc.*** [2019] SGIPOS 18 ("***Aussino***") provided:[22]

> [53] The test under Section 22(2) of the Act, is whether the form of the mark actually used by the Proprietor differs from the Subject Mark only "in elements which do not alter the distinctive character" of the Subject Mark "in the form in which it was registered". In this connection, the learned IP Adjudicator in ***The Patissier LLP v Aalst Chocolate Pte Ltd*** [2019] SGIPOS 6, articulated the following three-stage test for the application of Section 22(2) of the Act at [52]:
>
> > *Identification Stage*. Looking at the *form in which the trade mark was registered* as a whole, what should the Registrar (taking the viewpoint of the average consumer) regard as the "distinctive character" of the registered trade mark?
> >
> > *Comparison Stage*. Turning to the *form in which the trade mark was actually used*, what changes have been made to the elements of the registered trade mark (including stylisation, additions, deletions, adjustments to size or other features of appearance) which differentiate it from the registered form of the trade mark?
> >
> > *Evaluation Stage*. Looking at the differences between these two forms of the trade mark, has there been an alteration of the "distinctive character" of the registered form of the trade mark? If so, then the registered proprietor has not put the registered form of the trade mark to genuine use for the purposes of Section 22(1) of the TMA.

19 For ease of reference, the various versions of the ***Registered Mark*** as used are as follows:

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[21] This is so even though I am of the view that some types of use in the present case falls within those enumerated in section 27(4); see [8] ***ARS*** where the ***Applicant*** submitted that any purported use by the ***Registered Proprietor*** does not fall within section 27(4).
[22] See [31] and [32] ***RWS***.

Registered Mark[23]			
			
S/N	***Mark as used***	***Reference in the evidence***	***Satisfies section 22(2)?***
1		***Registered Proprietor's 2nd SD*** at Exhibit 10, pages 302 – 308; dated 26 Jul 2012	Yes
2		***Registered Proprietor's 2nd SD*** at Exhibit 12, page 320; dated 29 Nov 2012	No
3	 [24]	***Registered Proprietor's 2nd SD*** at Exhibit 5, page 219; dated 15 Jan 2011	Possible
4	 [25]	***Registered Proprietor's 2nd SD*** at Exhibit 5, page 221; dated 25 Jan 2011	
5	 [26]	***Registered Proprietor's 2nd SD*** at Exhibit 5, page 223; dated 15 Jan 2011	
6	 [27]	***Registered Proprietor's 2nd SD*** at Exhibit 5, page 227; dated 29 Jan 2011[28]	
7	 [29]	***Registered Proprietor's 2nd SD*** at Exhibit 14, page 335; 11 November 2011 (release date)[30]	No

[23] For clarity, the mark as sought to be registered is in black and white.
[24] The Chinese words are pronounced as "Tieba" and mean "post it" (see also [14] and Exhibit 5 of the ***Registered Proprietor's 2nd SD*** at page 219).
[25] The Chinese words are pronounced as "Zhidao", and mean "know" (see also [14] and Exhibit 5 of the ***Registered Proprietor's 2nd SD*** at page 221).
[26] The Chinese words are pronounced as "Baike" and mean "encyclopedia" (see also [14] and Exhibit 5 of the ***Registered Proprietor's 2nd SD*** at page 223).
[27] The Chinese words are pronounced as "Ditu" and mean "map" (see also [14] and Exhibit 5 of the ***Registered Proprietor's 2nd SD*** at page 227).
[28] See page 225 of the ***Registered Proprietor's 2nd SD.***
[29] The Chinese word is pronounced as "Tie" and means "post".
[30] See page 326 of the ***Registered Proprietor's 2nd SD.***

8	 31	***Registered Proprietor's 2nd SD*** at Exhibit 14, page 340; 12 December 2011 (release date)[32]	
9		***Registered Proprietor's 2nd SD*** at Exhibit 14, page 345; 25 October 2017 (release date)[33]	
10		***Registered Proprietor's 2nd SD*** at Exhibit 14, page 352; 31 July 2011 (release date)[34]	

20 Applying the 3 stage test above, it is clear that it is the ***Registered Mark*** as a ***composite whole***, which includes words, a device as well as Chinese characters which is distinctive.

21 Thus a distillation of the above leaves us with the following marks for consideration:

S/N	***Mark as used***	***Satisfies section 22(2)?***
1		Yes
3		Possible
4		
5		
6		

22 Critically, the issue is whether marks 3, 4, 5 and 6 are marks which do not alter the distinctive character of the ***Registered Mark***. One of the related issues is the target audience of the ***Registered Mark***, specifically, whether the target audience understands

[31] The Chinese words are pronounced as "Xinwen" and mean "News".
[32] See page 326 of the ***Registered Proprietor's 2nd SD.***
[33] See page 327 of the ***Registered Proprietor's 2nd SD.***
[34] See page 326 of the ***Registered Proprietor's 2nd SD.***

Chinese. This is because a common feature of the four marks above is  and then there is the addition of Chinese characters depending on where the mark is used.

23 The crux of the ***Applicant's*** argument is that if the target audience understands Chinese, then they would be able to understand that the Chinese characters in the marks 3,4, 5 and 6 are not 百度 (or Baidu in Chinese characters).

24 Unfortunately, both parties did not tender any authorities in relation to this issue. However, I find guidance from the case of ***Aalst Chocolate Pte Ltd v The Patissier LLP*** *[2019] SGIPOS 7* (albeit this is in the context of an invalidation):

> [23]… the parties have diametrically opposed positions on the nature of the "average consumer", for understandable reasons.
>
> [24] Counsel for the Applicant…sought to demonstrate that the Proprietor itself targets "high end" clients with "high end" products and pricing…
> …
>
> [26] Counsel for the Proprietor disagreed. She pointed out that it was very common for cakes and confectionery (claimed in the Class 30 Specification) to be purchased by people from all walks of life. The potential range of consumers, given the nature of the goods, was very broad…
> …
>
> [29] I am inclined to think that the notional specification of goods or services is in view in the phrase "*the hypothetical average consumer of the category of goods or services in question*", ***rather than*** the specific goods sold by the trade mark proprietor in connection with its marketing strategy. In a different (but relevant, in that it relates to a consideration of goods and services claimed) context under Section 8(2)(b) of the Act, the Court of Appeal in ***Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide*** [2014] 1 SLR 911 ("***Staywell***"), also made clear, at [40], that "*it is not within the scheme of the classification system to make distinctions within a specification based on whether the particular product is targeted at one or another market segment*." Thus, for example, "*Hotel services are hotel services, whether these concern a luxury hotel or a more modest one*" (***Staywell*** at [41]).
> …
>
> [32] Thus, in the present case, one should have regard to the notional specifications of goods and services in respect of which the Subject Mark is registered…***Nothing in the Class 30 Specification and the Class 35 Specification qualifies the goods and services as being pitched at the high end of the market. The goods and services covered are generic, e.g., "cakes" and not "upmarket cakes".***

[Emphasis in bold and italics mine]

25 Applying the above to the current case, "[n]othing in the [Class 38] Specification and the [Class 42] Specification qualifies the …services as being pitched at the [Chinese speaking] market. The…services covered are generic…". Thus I am of the view that the target audience is the ***general public (including the Chinese majority of the population).***

26 Following the above, marks 3, 4, 5 and 6 would not have passed the section 22(2) test and ***cannot*** be taken into account as the majority of the public who can understand Chinese will be able to tell that the Chinese characters in the marks are different (from that in the ***Registered Mark***).[35] [36] In any event, it will become apparent that ***even if*** I am wrong in relation to this, it does not affect the final result.

Use for the relevant periods

27 For ease of reference:

(i) the period ***15 January 2011 to 14 January 2016*** will be defined as the "***First Relevant Period***"); and
(ii) the period ***23 October 2013 to 22 October 2018*** will be defined as the "***Second Relevant Period***".

28 For easy reference, I replicate the table above:

Registered Mark		
		
S/N	***Mark as used***	***Satisfies section 22(2)?***
1		Yes

29 It will become evident below that the main event for consideration for the ***First Relevant Period*** is the ***Registered Proprietor's*** collaboration with the Agency for Science, Technology and Research ("***A*STAR***"), while the main events for consideration for the ***Second Relevant Period*** include this collaboration as well as the ***Registered Proprietor's*** collaboration with the Singapore Tourism Board ("***STB***"). These will be considered in turn.

[35] See also [34] ***ARS***. In any event, these marks do not help the ***Registered Proprietor*** due to the lack of an "active step" (see [19] – [22] ***AWS***).
[36] This is because while the target audience is the general public (and not any specific sector), it happens to be the case that the majority of the population in Singapore are Chinese (and thus would understand the Chinese language).

First Relevant Period

30 For ease of reference, the table above has been adapted as follows:

Registered Mark	
Class 38: Message sending; communications by computer terminals; communications by telephone; computer aided transmission of messages and images; providing access to databases; providing telecommunications connections to a global computer network; chat room services (telecommunications services); voice mail services; electronic bulletin board services (telecommunications services); electronic mail; all included in Class 38 and; ***Class 42***: Computer software design; maintenance of computer software; computer system design; creating and maintaining web sites for others; providing search engines for the internet; conversion of data or documents from physical to electronic media; quality control; technical project studies; rental of web servers; all included in Class 42.	
S/N	***Mark as used***
1	

*Collaboration with A*Star*

31 The ***Registered Proprietor*** deposed as follows:[37]

> [17] The Registered Proprietor's sister company, Baidu (Hong Kong) Limited…has also opened a joint research and development facility with A*STAR's Institute for Infocomm Research… **(*I²R*)…Baidu-I²R Research Centre…(*BIRC*)** in Singapore, to undertake research and development facilities and collaborative projects in relation to the services that [***Registered Mark***] is registered for.
>
> [18]…***BIRC*** focuses on research which relates to Southeast Asian Language Resources, Natural Language Processing, Information Retrieval and Information Extraction, Speech Information Processing and Multimedia Processing amongst others…
>
> [19] ***A*STAR I²R*** also partnered with key players in the Singapore ICT economy to establish **Research and Commercialisation Hub…(*Reach@I²R*)**, a cluster of joint laboratories designed to nurture technological innovation, which ***includes BIRC***.[38]

[37] [17] – [19] at the ***Registered Proprietor's 2nd SD.***
[38] Thus, articles in relation to ***Reach@I²R*** also refer to projects under ***BIRC.***

32 Further evidence in relation to the above are as follows:

(i) ***BIRC***

(a) A media release by ***A*STAR*** entitled *BIRC Brings First Speaker Verification Technology Into Smartphones with Built-In Voiceprint Feature* dated 30 November 2012.[39]

(b) A signed copy of the *Collaborative Joint Laboratory Agreement* dated 23 February 2012 ("***BIRC Collaboration***").[40] [41]

(c) The backdrop of the opening ceremony of ***BIRC*** dated 26 July 2012;[42] the ***Registered Mark*** was clearly featured alongside the ***A*STAR*** logo.

(d) The plaque for the opening ceremony of ***BIRC*** dated 26 July 2012;[43] again, the ***Registered Mark*** was clearly featured.

(e) The signboard at the entrance of ***BIRC*** clearly showing the ***Registered Mark***.[44]

(f) An interview with ***I²R*** Acting Executive Director, Dr Tan Geok Leng on the opening of ***BIRC*** in 2012;[45] once again, the ***Registered Mark*** was clearly featured.

(g) An article entitled *Baidu-I²R Research Centre (BIRC) officially opens in Singapore* dated 26 July 2012 in *Asia Research News magazine* ("***Asia Research News Magazine Article***");[46] the ***Registered Mark*** was clearly featured.

(h) An article entitled *Baidu, A*STAR Set Up Human Language Technology Center In Singapore* dated 26 July 2012 in *Asian Scientist Magazine* ("***Asia Scientist Magazine Article***");[47] the ***Registered Mark*** was clearly featured.

(i) Invoices issued by ***A*STAR*** to the ***Registered Proprietor*** in the amount of:[48]

I. SGD 1,080,000 (dated 3 March 2014);[49] and

II. SGD 1,332,067 (dated 4 March 2016).[50]

(ii) ***Reach@I²R***[51]

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[39] Exhibit D of the ***Registered Proprietor's 1st SD.***

[40] Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at pages 242 – 271.

[41] This was variated (see Exhibit D of the ***Registered Proprietor's 1st SD*** at pages 7 - 8 of the PDF document (the evidence is not paginated).

[42] Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at page 274.

[43] See also Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at page 276.

[44] Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at page 275.

[45] Exhibit 8 of the ***Registered Proprietor's 2nd SD.***

[46] Exhibit 10 of the ***Registered Proprietor's 2nd SD*** at pages 302 – 308.

[47] Exhibit 10 of the ***Registered Proprietor's 2nd SD*** at pages 309 - 311.

[48] The ***Applicant*** argued that the invoices were not rendered in the course of trade ([33] ***AWS***). This is dealt with below; that is, even if the payment via the invoice is for the purposes of, for example, purchase of Pre Collaboration IP, this should be included as evidence of use under section 22.

[49] Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at page 277.

[50] Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at page 278.

[51] See above as to its relationship with ***BIRC***.

(a) A picture of the directory of ***Reach@I²R***; again the ***Registered Mark*** can be seen (the ***Registered Proprietor*** occupies the unit #08-12 and the hub was officially opened on 13 March 2014).[52]

(b) An article entitled *Changing the face of Singapore's infocommunications*, dated 6 May 2014 (based on the web address, it would appear to be on the ***A*STAR*** website).[53] [54]

(c) An article entitled *A*STAR'S I²R Unveils REACH@I²R (Research And Commercialisation Hub) to Boost Deeper Integration with Industry* dated 16 Mar 2014 in *Asia Today*.[55] [56]

(d) An article entitled *A*STAR I²R launches programme for ICT collaborations* dated 25 Mar 2014 in EET Asia.[57]

33 Taking all of the above into account namely, the collaboration with ***A*STAR*** under ***BIRC*** and ***Reach@I²R,*** I am of the view that there is use of the ***Registered Mark*** in relation to Class 42[58] for the ***First Relevant Period.***

34 One of the key objections by the ***Applicant*** is that there is no "genuine use in the course of trade":[59]

> [30] The Applicant submits that the above evidence of use cited by the Registered Proprietor should be disregarded, as Section 22 of the TMA is clear that it must be "genuine use in the course of trade [emphasis added]". This is because "non-commercial use of the trade mark is certainly not genuine use sufficient to allow the trade mark to remain on the register.". The Applicant submits that there was no genuine use for the Trade Mark in all of the above instances relating to the BIRC. Even if there was use in the photograph(s) and/or the powerpoint slides for the collaboration review, they would be "use which is just internal use by the proprietor" based on the above established principles regarding genuine use.
>
> [31] The joint collaborative research agreement states in the recitals that the purpose of the BIRC is to "undertake research and development activities and collaborative projects [emphasis added]". Schedule 1 of the agreement, which details the collaboration further states that: "through BIRC in Singapore, I²R and Baidu will jointly develop technologies". Accordingly, all the photographs submitted by the Registered Proprietor should not be considered evidence of genuine use in the course of trade as they only detail non-commercial use, which in this case would be research and development…

[52] Exhibit 9 of the ***Registered Proprietor's 2nd SD*** at page 297.
[53] Exhibit 9 of the ***Registered Proprietor's 2nd SD*** at pages 287-289.
[54] The article made reference to the voice recognition software unlocking smart phones which was developed jointly with the ***Registered Proprietor***.
[55] Exhibit 9 of the ***Registered Proprietor's 2nd SD*** at pages 290 – 293.
[56] Again there was a reference to a voice recognition unlock feature for smart phones which was developed in collaboration with the ***Registered Proprietor***.
[57] Exhibit 9 of the ***Registered Proprietor's 2nd SD*** at pages 294 – 296.
[58] The issue of partial revocation is discussed below.
[59] [30] and [31] ***AWS***.

35 In relation to the allegation of internal use, I agree with the ***Registered Proprietor***[60] that the collaboration with ***I²R***,[61] which is an ***external*** party, debunks the argument that there was only internal use. The evidence pertaining to the collaboration has been enumerated above and I will not repeat them here.

36 In relation to the argument that there is only non-commercial use as the collaboration mainly entails "research and development", both parties did not make substantial submissions as to whether this amounts to "genuine use in the course of trade". However, it is to be recalled that "***[n]o one single objective formula which applies to all situations can be laid down; much would depend on the fact situation in each individual case***".[62] Further, "***genuine use can be established even if there is no evidence of actual sales being made***".[63]

37 In addition, the following principles can be culled from the Court of Appeal case of ***Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal*** [2009] 2 SLR(R) 814 ("***Wing Joo Leong***"):[64]

(i) the use in question must be in accordance with the *essential function* of a trade mark…which is "to guarantee the identity of the origin of the goods or services for which it [was] registered … in order to ***create or preserve an outlet for those goods or services***". This is in comparison to "***token use for the sole purpose of preserving the rights*** conferred by the mark" or use which was "just ***internal use*** by the [proprietor] concerned".

(ii) Regard must be had to all the facts and circumstances relevant to establishing ***whether the commercial exploitation of the mark is real***.

(iii) Provided there is ***nothing artificial about a transaction*** under a mark, ***then it will amount to 'genuine' use***. The smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was ***not*** merely 'token', or done with the ***ulterior motive of validating the registration***.

(iv) The ***absence of any purpose***, ***other than trying to sell goods*** under the mark, would lead him to the conclusion that the uses were ***genuine***.

(v) There seems [to be] no reason to make a trader who has actually made some small, but proper, use of his mark, lose it [*ie*, the registration of his mark]; only if his use is in essence ***a pretence at trade*** should he do so.

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[60] [27] and [28] ***RRS.***
[61] This would similarly apply to ***Reach@I²R*** as well.
[62] Above and also see [43] ***Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd and another and another appeal*** [2009] 2 SLR(R) 814.
[63] See [104] ***Weir Warman Ltd v Research & Development Pty Ltd*** [2007] 2 SLR(R) 1073 ("***Weir Warman***").
[64] [37] to [43] ***Wing Joo Loong***.

(vi) Where there was ***no question of a hidden motive behind the use***, the courts were prepared to regard even small quantities of sales under the mark as sufficient to constitute ***bona fide use***.

(vii) If the main or a ***principal motive was trade mark protection*** rather than simply making sales under the mark, then the use was ***not 'bona fide'***.

(viii) when it serves ***a real commercial purpose***, even minimal use can be sufficient to establish genuine use.

38 Some examples where the court held that activities other than actual sales amounted to genuine use include the following:

(a) The offer for sale of cosmetics branded "Elle" in the UK through foreign editions of the plaintiff's magazine could qualify as genuine use for the purposes of section 46 of the English Trade Marks Act 1994,[65] notwithstanding that there was no evidence of actual sales during the relevant period.[66]

(b) Three e-mail enquiries received by the defendant from Singapore companies pursuant to information on the defendant's website were assessed in the light of the requirement for an "active step" in Singapore. These were a fax written by the defendant and addressed to a Singapore company, offering the sale of various "Warman" pumps, and a report of the Hytrade (likely a dealer / agent for pumps) meeting. The High Court found that there was genuine use by the defendant of the "Warman" mark in relation to both pumps and pump parts.[67]

(c) The sale of component parts and substances for use in MINIMAX fire extinguishers, as well as the service and repair of MINIMAX equipment, even though the sale of MINIMAX fire extinguishers had ceased, amounted to genuine use of MINIMAX. The European Court of Justice held that the use of a mark in connection with goods that were no longer newly traded could nonetheless constitute genuine use provided that the proprietor makes actual use of the same mark for component parts that are ***integral*** to the make-up or structure of such goods, or for goods or services ***directly connected*** with the goods previously sold and intended to meet the needs of customers for those goods.[68]

39 Further elaboration on the matter can be found in *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* by Professor Ng-Loy Wee Loon ("***Law of Intellectual Property of Singapore***"):[69]

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[65] Our equivalent of section 22(1) of the Act.
[66] ***ELLE Trade Marks*** [1997] FSR 529 (see [104] ***Weir Warman***).
[67] See [107] – [110] ***Weir Warman.***
[68] ***Ansul BV v Ajax Brandbeveiliging BV*** [2003] IP & T 970 at [34(a)] ***Bigfoot.***
[69] ***Law of Intellectual Property of Singapore*** [25.3.18] and [25.3.19].

(i) Genuine use ***does not necessarily require communication*** of the mark ***to the end user / ultimate consumer*** of the good / services.
(ii) Use of the mark on ***promotional materials*** may amount to genuine use of the mark.
(iii) Account can be taken of ***pre-sale*** meetings and negotiations.
(iv) Importantly, the scenario where the only use of the trade mark is in relation to goods which are made in Singapore but ***destined for foreign markets*** is dealt with under section 22(2); specifically these are ***relevant use*** for the purpose of section 22.

40 Thus the key issue is whether there is ***genuine intention to engage in commercial activities*** under the relevant mark or whether the activities are simply a façade to maintain the registration of the mark. The examples provided above reflect that the commercial realities in particular cases can be complex. The Court of Appeal in ***Wing Joo Loong*** was cognisant of the ***range*** of activities which can fall within the spectrum of "use" with *actual sales at one end* (clearly "genuine use") and *activities to purely maintain a trade mark registration* on the other (clearly not "genuine use"). Thus it was reluctant to provide a definitive test and emphasised that there is ***no*** one objective formula and that ***all the relevant circumstances*** are to be taken into account.[70]

41 I am of the view that there is ***nothing artificial*** about the collaboration with ***A*STAR***. The "research and development" activities of the ***Registered Proprietor*** in Singapore constitute a ***condition precedent*** to the launch of new / enhanced products by the ***Registered Proprietor*** which are then used to further the ***Registered Proprietor's*** reach in the South East Asian region and China (more below).[71]

42 Activities of which the end goal is the ***economic enhancement***[72] of the ***Registered Proprietor*** must be within the boundaries of "genuine use in the course of trade". The fact that (i) there is no communication with the end user; and that (ii) it is destined for foreign markets[73] are non-issues.[74] Further the "research and development" activities of the ***Registered Proprietor*** in Singapore which constitute a ***condition precedent*** to the launch of new / enhanced products overseas by the ***Registered Proprietor*** are akin to pre-sales activities.[75]

[70] Above at [36].
[71] See the ***BIRC framework*** (which forms part of the ***BIRC Collaboration***), at page 260 of the ***Registered Proprietor's 2nd SD,*** under *Introduction*.
[72] The idea is to utilise *Pre-Collaboration IP* (from both sides to create a patentable invention for commercialisation / licensing (see Clause 9.2 of the ***BIRC Collaboration***, which pertains to *Pre-Collaboration IP*, at page 250 of the ***Registered Proprietor's 2nd SD***).
[73] Even though we are considering services here.
[74] See above at [39].
[75] See above at [39].

43 The idea is to utilise Pre-Collaboration Intellectual Property[76] [77]from both sides to create a patentable invention for commercialisation / licensing.[78] In this regard, under Clause 9.3.7[79] of the ***BIRC Collaboration***, the parties are free to ***commercialise and licence*** the Project IP[80] [81] subject to Clause 9.3.6 of the same.[82] As alluded to above, research activities which are a ***condition precedent to the commercialisation of IP*** (for the launch / enhancement of products) surely must fall within the ambit of activities intended to be covered by the phrase "genuine use in the course of trade".

44 In fact the ***BIRC Collaboration*** has yielded successful results, including:[83]

(i) In December 2012, BIRC enhanced and embedded I²R speaker verification technology into the Lenovo A586, the world's first *voiceprint smartphone* to enable users to unlock their devices using their voice.

(ii) In March 2013, ***BIRC's*** Thai language processing technologies facilitated the quick release of Baidu Thai-English *online translation,* which showed much better performance than similar products in the market.

(iii) In May 2013, ***BIRC*** launched the Baidu Music Search technology, "听歌识曲" – ting ge shi qu, which literally translates to "hear a tune and know the song", embedded within the Baidu Music App. It *identifies music playing over the air by its "unique music fingerprint"* made up of its audio waveform and returns the song title, the name of the artiste, and the album art within seconds.

The above successes were publicised in several articles with the ***Registered Mark*** clearly displayed,[84] akin to use of a mark on promotional materials.

45 Singapore has always sought, and continues to seek, encourage and attract research and development activities to Singapore. Pertinent to the current case, this is apparent from the establishment of:

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[76] As defined at page 245 of the ***Registered Proprietor's 2nd SD.***

[77] And thus, the Applicant's arguments at [33] ***AWS*** do not stand as the invoices rendered by ***A*STAR*** to the ***Registered Proprietor*** can be taken into account (see above at [32(i)(i)].

[78] See Clause 9 of the ***BIRC Collaboration*** in general, at pages 250 – 252 of of the ***Registered Proprietor's 2nd SD***.

[79] Pages 251 – 252 of the ***Registered Proprietor's 2nd SD.***

[80] Project IP has been defined in Clause 2 of the ***BIRC Collaboration*** (page 245 of of the ***Registered Proprietor's 2nd SD***) to mean "all IP which was discovered, developed, conceived or reduced to practice whether solely or jointly by the Parties…in the course of the Project" while Project has been defined to mean "any collaborative project undertaken pursuant to this Agreement".

[81] In the template for the ***Project Plan,*** which forms part of the ***BIRC Collaboration***, there is a specific provision for the indication of the likelihood of patentable invention and commercialisation / licensing of the same (see page 270 of the ***Registered Proprietor's 2nd SD*).**

[82] Page 251 of the ***Registered Proprietor's 2nd SD.***

[83] Exhibit 10 of the ***Registered Proprietor's 2nd SD***, which is an article entitled ***Baidu-I²R Research Centre Launches Singapore-developed Music Search Technology***, dated 9 Sep 2013 in Asia Today magazine, at pages 312 – 313 of the of the ***Registered Proprietor's 2nd SD***.

[84] See (i) ***Asia Research News Magazine Article*** and (ii) ***Asia Scientist Magazine Article,*** above.

(i) ***A*STAR***, which is "the lead agency for fostering world-class scientific research and talent for a vibrant knowledge-based and innovation-driven Singapore. ***A*STAR*** oversees 14 biomedical sciences and physical sciences and engineering research institutes, and six consortia & centres…***A*STAR*** supports Singapore's key economic clusters by providing intellectual, human and industrial capital to its partners in industry";[85] and

(ii) "I²R…a member of the…A*STAR…family... [e]stablished in 2002, [its] mission is to be the globally preferred source of innovations in `Interactive Secured Information, Content and Services Anytime Anywhere' through research by passionate people dedicated to Singapore's economic success. I²R performs R&D in information, communications and media (ICM) technologies to develop holistic solutions across the ICM value chain. [Its] research capabilities are in information technology, wireless and optical communication networks, interactive and digital media, signal processing and computing. [It] seeks to be the infocomm and media value creator that keeps Singapore ahead".[86]

To hold that genuine research and development activities do not amount to "genuine use in the course of trade" would be inimical to this objective.

46 The research and development activities discussed above fall squarely under Class 42. However, I am unable to find any evidence of use of the ***Registered Mark*** in relation to Class 38 services for the ***First Relevant Period.***

47 In this regard, the ***Registered Proprietor*** deposed:[87]

> [16] The Registered Proprietor also uses the [***Registered Mark***] in relation to its search platforms which also includes Baidu Post Bar, Baidu Knows and Baidu Encyclopedia, amongst others. These platforms have been used by the Registered Proprietor in relation to its technology services for internet users worldwide, including Singapore, ***evidencing the use of the mark on the services in Class 38*** and 42.

[Emphasis in italics and bold mine]

48 However, as far as I can tell, the services provided under Baidu Post Bar and Baidu Knows are Class 42 services. The ***Registered Proprietor*** itself described them as follows:[88]

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[85] See Exhibit 10 of the ***Registered Proprietor's 2nd SD*** at page 305 (this is part of the ***Asia Research News Magazine Article***).
[86] See footnote [85].
[87] [16] of the ***Registered Proprietor's 2nd SD.***
[88] [14] of the ***Registered Proprietor's 2nd SD.***

> [14]…a digital archive tool - Wayback Machine…provides archived versions of the webpages of the ***search engine options and services*** of the Registered Proprietor, such as:
>
> (a) Baidu core ***web search engine***…
> (b) Baidu Post Bar, the world's first and largest ***query-based searchable online community platform***…
> (c) Baidu Knows, the world's largest ***interactive knowledge-sharing platform***…
> (d) Baidu Encyclopedia, the world's largest ***user generated encyclopedia***…
> (e) Baidu Maps, ***integrated map data*** with location based services relating to locations, routes, and local merchants…

These are clearly Class 42 services. In particular they are: (i) providing search engines for the internet; and (ii) conversion of data or documents from physical to electronic media. However, these uses ***cannot*** be taken into account as they fall short of the requirement of any "active step" on the part of the ***Registered Proprietor***.[89]

Conclusion for the First Relevant Period

49 There is use of the ***Registered Mark*** in relation to Class 42 but ***not*** for Class 38 for the ***First Relevant Period.***

Second Relevant Period

50 The main events for consideration for the ***Second Relevant Period*** are:

(i) The continuation of ***BIRC*** and ***Reach@I²R***; and
(ii) the memorandum[90] for co-operation with ***STB***.

BIRC and *Reach@I²R*

51 Before I proceed any further, it is to be noted that there is an overlap between the ***First Relevant Period***[91] and the ***Second Relevant Period***,[92] specifically, the period from October 2013 – January 2016. In this regard, the ***BIRC Collaboration*** which was dated 23 February 2012, was for a period of three years (that is, until February 2015).[93] In addition, most of the evidence in relation to ***Reach@I²R*** are dated in 2014.[94]

52 In addition, the following are some of the evidence supporting the continuation of ***BIRC***:

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[89] See [19] – [22] ***AWS***.
[90] Exhibit E of the ***Registered Proprietor's 1st SD.***
[91] ***15 January 2011 to 14 January 2016.***
[92] ***23 October 2013 to 22 October 2018.***
[93] See Clause 6 of the ***BIRC Collaboration*** at page 248 of the ***Registered Proprietor's 2nd SD***.
[94] See [32(ii)] above.

(i) Exhibit 10 of the ***Registered Proprietor's 2nd SD*** contains an excerpt from the ***A*STAR*** website which clearly reflects the ***Registered Mark***:[95]

> ***2018 marks A*STAR I²R's sixth year of collaboration with BAIDU*. We *started off with Baidu's first overseas joint laboratory - BIRC in March 2012*** and have since achieved significant progress in cutting edge research on speech processing, natural language processing and robotics.
>
> - The world's first ***Voice Biometrics smart phone***, Lenovo A586 was ***launched in Nov 2012, using I²R Voice Print Technology***
> - ***Music Search technology***, "听歌识曲" - Ting Ge Shi Qu, which literally translates to "hear a tune and know the song" was ***released through Baidu Music App in 2013***.
> - ***Baidu's Online Machine Translation released Thai and English translation services in 2013 using BIRC's language resources***. ***Thai*** word segmentation and ***named entity recognition were released through Baidu NLP cloud in 2016.***
> - ***Entity Linking technology*** to automatically link related entities such as companies and people in the web pages to Baidu's Knowledge Bases has been ***used for various search applications since 2014***.
> - ***Far-field Speech Recognition technology was embedded in DuRobot in 2016***.
> - ***Sentiment analysis and entity relation extraction technologies*** have been ***used in various Baidu platforms such as Duer (AI platform), mobile search and Nuomi (O2O app) in 2016***. Se***ntiment Analysis technology*** has also been ***used in 2 operators on Sentiment Classification and Comment Opinion Extraction*** which were ***published at Baidu AI Open Platform in 2017***.
>
> In 2018, we are looking at more innovations in the above areas to enhance the experiences of Baidu's platform for its users.
>
> [Emphasis in bold and italics mine]

I accept that it is indicated that the page was updated on 14 Nov 2019.[96] However this does not detract from the fact that the content of the webpage describes the ***various projects for the period 2012 – 2017***.

(ii) The ***Registered Proprietor*** also provided evidence of the "***BIRC*** Review and Plan" for the period 2017 – 2018.[97] [98] For example:

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[95] Pages 299 – 301 of the ***Registered Proprietor's 2nd SD.***
[96] Page 301 of the ***Registered Proprietor's 2nd SD.***
[97] At [10] of the ***Registered Proprietor's 1st SD.*** Exhibit D is not paginated so the page references are to the PDF document. See Exhibit D of the ***Registered Proprietor's 1st SD*** at pages 39 – 92.
[98] Contrary to the ***Applicant's*** submissions ([32] ***AWS***), such use is ***not internal*** (dealt with above).

(a) the collaboration review for June – December 2017 as well as the collaboration plan for 2018.[99]

(b) ***BIRC Review and Plan*** dated 3 March 2018;[100] the ***Registered Mark*** clearly seen at the top right hand corner.

(c) ***BIRC 2018 January – June Review and Plan*** dated 3 March 2018;[101] again the ***Registered Mark*** clearly seen at the top right hand corner.

(iii) Invoice issued by ***A*STAR*** to the ***Registered Proprietor*** dated 18 January 2017[102] for the amount of SGD 1,332, 067.

Co-operation with STB

53 The ***Registered Proprietor*** deposed that:[103]

> [11] Since at least 2017, Baidu (Hong Kong) Limited has co-operated with [***STB***] to ***promote Singapore as one of the preferred destinations for Chinese visitors***. As part of the co-operation, Baidu (Hong Kong) Limited conducted and announced [*sic*] annual Chinese tourist insight report with the objective of ***enhancing Singapore tourism industry's competitiveness*** under and by reference to the [***Registered Mark***].

[Emphasis in italics and bold mine]

54 Specifically, "the co-operation was an initiative of the [***STB***] to use more detailed merchant information and ***data analysis*** to engage digitally savvy visitors and encourage them to share their trip experiences in Singapore" (emphasis mine).[104]

55 In support of the above, the ***Registered Proprietor*** provided an unsigned copy of a memorandum with STB dated 17 July 2017 ("***STB Memorandum***").[105] The ***Registered Proprietor*** also included what appears to be an undated copy of the "annual Chinese tourist insight report" referred to above.[106]

56 The ***Applicant*** argued that:[107]

> [34] …The memorandum of cooperation evidences such co-operation and cannot be said to be evidence of use of the [***Registered Mark***] in the course of trade and/or commerce. The "use" if any, would be (a) not in relation to the services listed in classes 38 and/or 42; (b) for internal purposes only and (c) for the benefit of Chinese

[99] Pages 39 – 56 of the ***Registered Proprietor's 1st SD,*** above.
[100] Pages 58 – 73 of the ***Registered Proprietor's 1st SD,*** above.
[101] Pages 74 – 92 of the ***Registered Proprietor's 1st SD,*** above.
[102] Exhibit 7 of the ***Registered Proprietor's 2nd SD*** at pages 281 - 282.
[103] The ***Registered Proprietor's 1st SD*** at [11].
[104] The ***Registered Proprietor's 2nd SD*** at [23].
[105] Exhibit E of ***Registered Proprietor's 1st SD.***
[106] Exhibit E of ***Registered Proprietor's 1st SD*** at pages 6 – 68 of the PDF document.
[107] [34] ***AWS***.

> consumers and not Singapore consumers. As such, any purported "use" cannot be said to be genuine use of the [***Registered Mark***] in Singapore.

57 At the hearing, the ***Applicant*** argued that there is no evidence that the collaboration with ***STB*** was successful since the copy of the memorandum was unsigned. In that regard, the ***Applicant*** emphasized that "mere intention to use" is not use.

58 While the memorandum was unsigned, it has to be looked at ***together*** with the undated report. In this regard, the fact that the report was undated ***does not detract*** from the fact that the content of the report shows that there was data analysis done in relation to the period 2013 – 2014.[108]

59 As to the areas of partnership, Clause 2.1 of the ***STB Memorandum*** provides:[109]

> 2.1 Information Sharing
>
> ***STB to provide Singapore tourism information***, including but not limited to location and description of merchants/location ***to Baidu***. ***Baidu to share the information via the Baidu map platform*** for users ***when they arrive in Singapore*** to get more accurate navigation information.
>
> 2.2 Marketing
>
> The Parties to jointly embark on destination marketing so as to actively promote Singapore as a quality travel destination to different target consumer segments. According to different needs, [***STB***] shall allow Baidu to use its logo and name, to be discussed by Parties in each case, and a series of [***STB***] approved information for the purposes of promoting [***STB***] campaigns via Baidu to Baidu uses.
>
> 2.3 Big Data
>
> The Parties to ***conduct and announce*** [sic] ***annual Chinese tourist insight report***, which elaborate the data of Baidu, its partners and [***STB***]. This report shall be free to public with the objective of enhancing Singapore tourism's industry's competitiveness.

[Emphasis in bold and italics mine]

60 Having regard to Clause 2.3 above, the report suggests that the ***co-operation did materialise*** (in that regard, the ***Registered Mark*** can be seen at pages 6, 33 and 68 of the report).[110] Unfortunately, "data analysis" is under Class 35 and thus this activity cannot be taken into account.

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[108] Exhibit E of ***Registered Proprietor's 1st SD,*** for example, at pages 12 and 22 of the PDF document.
[109] Exhibit E of ***Registered Proprietor's 1st SD,*** at pages 3 - 4 of the PDF document.
[110] Or of the of ***Registered Proprietor's 1st SD***; the exhibit is not paginated so all references are to the PDF document.

61 The above also suggests that the collaboration under Clause 2.1 above, which pertains to "conversion of data or documents from physical to electronic media" under Class 42, did materialise. I accept that there is no direct evidence that this conversion process was done under cover of the ***Registered Mark***. But I am of the view that there is a high probability that such was the case. In the event that I am wrong, this is ***not the sole activity*** relied on (more below) for the purposes of the ***Second Relevant Period***.

62 As for the argument that it is solely for internal purposes, it clearly does not stand since there is an external party (***STB***) involved. Last but not least, the data was intended to benefit Chinese consumers while ***in Singapore***.[111]

63 As alluded to above,[112] "in considering the evidence and purposes of examining whether there is genuine use of a trade mark, ***an overall assessment*** must be carried out which takes into account all of the relevant factors in the particular case" and "[w]hile genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence, it cannot be ruled out that ***the totality of items of evidence*** may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts".

64 Taking the totality of the following into consideration, that is:

(i) Collaboration under ***BIRC*** and ***Reach@I²R***; and
(ii) Collaboration with ***STB***

I am of the view that there is use of the ***Registered Mark*** in relation to Class 42 for the ***Second Relevant Period*** as well.

65 However, similar to the ***First Relevant Period***, I am unable to find any evidence of use of the ***Registered Mark*** in relation to Class 38 for the ***Second Relevant Period.***

Conclusion for the Second Relevant Period

66 I therefore conclude that there is use of the ***Registered Mark*** in relation to Class 42 but ***not*** for Class 38 for the ***Second Relevant Period.***

Partial Revocation

67 On the issue of partial revocation, the ***Applicant*** relied heavily on ***Patissier***, and advocated for an interventionist approach which entails "the registered trade mark proprietor's specifications being rewritten and replaced with a description that ***corresponds***

[111] In any event, as alluded to above, use of the trade mark is in relation to goods which are made in Singapore but ***destined for foreign markets*** is relevant (above at [39(iv)]).
[112] Above at [15].

exactly to the specific goods and services in respect of which the registered trade mark has been put to actual use" (emphasis in bold and italics mine).[113]

68 In that regard, the Applicant submitted that the ***Registered Mark*** "should be ***revoked in class 38 entirely***, and ***partially revoked in class 42*** so as to reflect the actual use of the [***Registered Mark***] by the Registered Proprietor" (emphasis in bold and italics mine).[114]

69 In relation to Class 38, as indicated above, I have concluded that there is no use for both the ***First Relevant Period as well as the Second Relevant Period*** and I will say no more about it. The only class left for discussion is Class 42. For ease of reference, the specification is as follows:

> ***Class 42***: Computer software design; maintenance of computer software; computer system design; creating and maintaining web sites for others; providing search engines for the internet; conversion of data or documents from physical to electronic media; quality control; technical project studies; rental of web servers; all included in Class 42.

70 The Applicant argued:[115]

> [21] S/N 1 to 5 and 10 of Annex A appear to be components and/or variations of the Registered Proprietor's website, "baidu.com" and/or the Registered Proprietor's mobile application. The Applicant notes that all these components are entirely in Chinese. The Applicant submits that the Registered Proprietor provided no evidence showing use in the following specifications:
> …
> Class 42: Computer software design; maintenance of computer software; computer system design; creating and maintaining web sites for others; conversion of data or documents from physical to electronic media; quality control; technical project studies; rental of web servers; all included in Class 42.
>
> [22] The Applicant submits that use of the [***Registered Mark***] on the website "baidu.com" does not satisfy the test for genuine use, and repeats its submission at [24] to [28] of the AWS. From the evidence provided by the Registered Proprietor, "baidu.com" appears to be a ***Chinese language search engine***, and the Applicant therefore submits that should the Registrar find that there has been some use of the [***Registered Mark***]***, it should be revoked in respect of the specifications listed above and/or reworded to reflect the actual use made by the Registered Proprietor.***
>
> [23] S/N 7 of Annex A is in respect of Baidu translation services. The Applicant submits that the Exhibits referred to at S/N 7 of Annex A do not show use of the [***Registered Mark***] in respect of the services in [class]…42.

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[113] [20] ***ARS***.
[114] [26] ***ARS***.
[115] [21] – [25] ***ARS***.

> [24] S/N 6 and 8 of Annex A are in respect of the BIRC signing in 2012 and subsequent media release in respect of the ***speaker verification technology***. The Applicant submits that the use of the [***Registered Mark***] for the above purposes (1) ***does not fall within*** [class]…42; and (2) does not constitute genuine use for the purposes of sections 22(1)(a) and/or 22(1)(b) of the TMA. The Applicant repeats [29] to [33] of the AWS. In the event the Registrar finds that there has been some use, the Applicant submits that the use was in 2012, and therefore falls outside of the Relevant Period for the purposes of section 22(1)(b) of the TMA.
>
> [25] S/No. 9 of Annex A is in respect of the collaboration between the Registered Proprietor and the Singapore Tourism Board. The Applicant submits that this does not show genuine use of the [***Registered Mark***] in [class]…42 in Singapore, and repeats [34] of the AWS.

[Emphasis in bold and italics mine]

71 To begin with, the IP Adjudicator in ***Patissier*** preferred a more "centrist" approach:[116]

> [68] In my view, the correct approach towards applying Section 22(6) of the TMA when the partial revocation remedy is granted should ***lie somewhere between two extremes***. ***At one extreme, there is the so-called "blue-pencil" test***, which only permits specifications to be amended by making deletions from the list of words used to describe the goods…
>
> [69] ***At the other end of the spectrum***, one might take the view that granting partial revocation can ***entail rewriting the registered trade mark proprietor's specification of goods or services entirely***. This would permit the inclusion of any additional words or qualifiers, as well as the substitution of the original language found in the trade mark registration with more precise language that ***specifically describes the products on which the registered trade mark has been actually used***.

[Emphasis in bold and italics mine]

72 The learned IP Adjudicator in ***Patissier*** continued:[117]

> [76] In my view, the ideal outcome of any partial revocation process should be to ***arrive at a "fair specification" that reflects the private and public interests*** outlined above. Achieving such an outcome means that Section 22(6) of the TMA should *not* be interpreted in such a restrictive way that *only* permits the court or Registrar of Trade Marks to amend the Specification of Goods via "blue-pencil" deletions...
>
> [77] However, just because the tribunal *can* make these sorts of adjustments to the registered trade mark proprietors' specifications does not mean that it *should* always

[116] [68] – [69] ***Patissier.***
[117] [76] – [77] and [80] – [81] ***Patissier.***

> exercise all of these powers in every case…The goal of the partial revocation exercise is ***not*** to define, with surgical precision, the exact range of goods or services in respect of which registered proprietor has actually used his mark. ***Rather, it is to achieve a "fair specification" which still gives the registered proprietor a commercially sensible zone of exclusivity*** associated with the inherent semantic nebulousness of the words used by the trade mark framework to classify the goods and services in respect of which the mark may be registered.
> …
>
> [80] Working from the premise that the objective of the partial revocation exercise under Section 22(6) of the TMA is to ***produce a "fair specification"***, I am of the view that the tribunal should replace the original specifications of the registered trade mark with an alternative description of the goods or services only after carefully weighing the following factors. ***Firstly***, the extent to which the registered trade mark proprietor's ***pre-existing and future commercial interests*** are prejudiced by these changes to the boundaries of his intellectual property rights. ***Secondly***, the corresponding strategic benefits potentially ***reaped by the applicant***, who has sought partial revocation of the registered trade mark, from narrowing the scope of the goods or services in respect of which the trade mark was originally registered. ***Thirdly***, the ramifications of the adjustments to the specifications of the registered trade mark ***on the trade or industry sectors*** in which the parties are market players. ***Fourthly***, the impact of making the contemplated changes to the trade mark specifications ***on the average consumer and the public at large***.
>
> [81] A more interventionistic approach could result in the registered trade mark proprietor's specifications being rewritten and replaced with a description that corresponds exactly to the specific goods and services in respect of which the registered trade mark has been put to actual use…On the other hand, a more business-friendly approach that recognises the legitimacy of allowing the registered trade mark proprietor to retain a "buffer zone" of goods and services, which represent future business diversification opportunities, could translate into a much lighter touch towards amending the description of goods and services found in the registered trade mark's specifications. ***Neither the Registrar of Trade Marks nor the Singapore courts have yet to articulate a clear policy preference either way***. Regardless of which direction this area of Singapore's trade mark law eventually takes, what is more important is that the principles of partial revocation are ***developed coherently in tandem with the Registry of Trade Marks' procedural framework for securing trade mark registrations***. More specifically, [it]…must be ***consistent with the legitimate expectations of users of the trade mark system*** when their trade mark registrations were secured in the first place.

[Emphasis in bold and italics mine]

73 A few principles can be gleaned from the above:

(i) The ***preferred approach lies somewhere between two extremes*** with one end being the "blue-pencil" test and the other entailing rewriting the registered trade mark proprietor's specification of goods or services and limiting it entirely to the precise goods and services for which the proprietor has actually used the mark.

(ii) The goal of the partial revocation exercise is ***not*** to define, with surgical precision, the exact range of goods or services in respect of which the registered proprietor has ***actually used*** his mark. Rather, it is to achieve a ***"fair specification"*** which still gives the registered proprietor ***a commercially sensible zone of exclusivity*** associated with the inherent semantic nebulousness of the words used by the trade mark framework to classify the goods and services in respect of which the mark may be registered.

(iii) Working from the premise that the objective of the partial revocation exercise under Section 22(6) of the Act is to produce a ***"fair specification"***, the tribunal should replace the original specifications of the registered trade mark with an alternative description of the goods or services only after carefully weighing the following factors:

(a) ***Firstly***, the extent to which the registered trade mark proprietor's pre-***existing and future commercial interests*** are prejudiced by these changes to the boundaries of his intellectual property rights.
(b) ***Secondly***, the corresponding strategic benefits potentially ***reaped by the applicant***, who has sought partial revocation of the registered trade mark, from narrowing the scope of the goods or services in respect of which the trade mark was originally registered.
(c) ***Thirdly***, the ramifications of the adjustments to the specifications of the registered trade mark ***on the trade or industry sectors*** in which the parties are market players.
(d) ***Fourthly***, the impact of making the contemplated changes to the trade mark specifications ***on the average consumer and the public at large***.

(iv) ***Neither the Registrar of Trade Marks nor the Singapore courts have yet to articulate a clear policy preference either way***. Regardless of which direction this area of Singapore's trade mark law eventually takes, what is more important is that the principles of partial revocation are developed coherently and are consistent with the legitimate expectations of users of the trade mark system when their trade mark registrations were secured in the first place.

74 Returning to the ***Applicant's*** specific submissions above, I have indicated above that some of the marks do not satisfy section 22(2) and there is no need to discuss them. Thus, what is left and relevant for the discussion for the issue of partial revocation is the use of the ***Registered Mark*** in relation to:

(i) technical project studies (S/N 6 of Annex A, ***RWS***); and

(ii) conversion of data or documents from physical to electronic media (S/N 9 of Annex A, ***RWS***).

75 Applying the above principles to the current case, I am of the view that a "***fair specification***" which still gives the registered proprietor a ***"commercially sensible zone of exclusivity***"[118] is to leave the specification as per Class 42 ***intact***. This is because:

(i) "technical project studies" necessarily include "computer software design", and "computer system design" while it is related to "maintenance of computer software", "quality control" and "rental of webservers".
(ii) "conversion of data or documents from physical to electronic media" is related to "providing search engines for the internet" and "creating and maintaining web sites for others".[119]

76 Finally, for the avoidance of doubt:

(i) In the event I am wrong in relation to use of the ***Registered Mark*** pertaining to "conversion of data or documents from physical to electronic media" under the ***STB Memorandum***, I am of the view that it would still be ***commercially sensible*** to retain the specifications under [75(ii)] having regard to the ***Registered Proprietor's*** deep involvement in search engine capabilities, audio files and images.[120] In fact, one of the successful stories of the ***BIRC Collaboration*** is a ***Music Search technology*** namely "听歌识曲" (Ting Ge Shi Qu) which literally translates to "hear a tune and know the song".[121] [122] Further, I am also of the view that it does not make commercial sense to restrict "providing search engines for the internet" to the Chinese language.[123]

(ii) The use in relation to "speaker verification technology" falls within the item "technical project studies"[124] and as discussed above there is continued collaboration with ***BIRC*** well into the ***Second Relevant Period***.

Conclusion

77 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the revocation ***succeeds in relation to Class 38 only*** for both the ***First Relevant Period and the Second Relevant Period.*** Accordingly, the ***Registered Mark is revoked only in relation to Class 38, with effect from 15 January 2016.*** The

[118] [77] ***Patissier.***
[119] See Clause 2.1 of the ***STB Memorandum***, above at [59].
[120] [3] of the ***Registered Proprietor's 1st SD***; also referred to above.
[121] See Exhibit 10 of the ***Registered Proprietor's 2nd SD,*** which contains an excerpt from the ***A*STAR*** website, at pages 299 – 301 of the ***Registered Proprietor's 2nd SD*** (above).
[122] In order words, "conversion of data or documents from physical to electronic media" is of a subset of "technical project studies".
[123] See [22] ***ARS***, above.
[124] See [24] ***ARS***, above.

Applicant is also entitled to 50% of its costs, having regard to the fact that the revocation only partially succeeded. These are to be taxed, if not agreed.

Date of Issue: 12 July 2021