

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

[2022] SGIPOS 2

Trade Mark No. T1212409Z

**IN THE MATTER OF A TRADE MARK REGISTRATION BY
COMFORT LAB INC**

... Registered Proprietor

AND APPLICATION FOR REVOCATION THEREOF BY

CHOI SUN MI

... Applicant

GROUND OF DECISION

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Choi Sun Mi
v
Comfort Lab Inc

[2022] SGIPOS 2

Trade Mark No. T1212409Z
Assistant Registrar Chee Sze Yin
1 December 2021

1 March 2022

Assistant Registrar Chee Sze Yin:

Introduction

1 This is a revocation action on the grounds of non-use against the following trade mark:

COMFORTLAB

(“the Subject Mark”), registered in Singapore for “Coats; sweaters; shirts; underwear (underclothing); nightwear; socks and stockings; T-shirts; headgear for wear; shoes and boots; all included in Class 25.”

Background facts

2 Comfort Lab Inc., also known as Kabushiki Kaisha Comfort Lab, operates from Osaka, Japan, and is the Registered Proprietor (“the Proprietor”).

3 Choi Sun Mi (“the Applicant”) is the CEO of Comfortlab Co., Ltd., which operates from Seoul, South Korea.

Procedural history

4 On 4 May 2020, the Applicant filed an application for revocation of the Subject Mark on the grounds of non-use. The Proprietor filed its counter-statement and evidence in support on 27 August 2020. The Applicant filed evidence in support of the application on 27 January 2021. The Proprietor filed further evidence in support of maintaining the registration on 23 April 2021. It was not mandatory for the Applicant to file evidence in reply and it did not do so. A Pre-Hearing Review was held on 10 August 2021. The matter was set down for a full hearing on 1 December 2021.

5 Parties elected to only file written submissions without appearing at the hearing to make oral submissions. After written submissions were filed by the Proprietor on 29 October 2021 and by the Applicant on 1 November 2021, written submissions in reply were filed by the Applicant on 30 November 2021 and by the Proprietor on 1 December 2021.

Grounds of revocation

6 The Applicant relies on Section 22(1)(a) and (b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”) in this revocation.

Applicant’s evidence

7 The Applicant’s evidence comprises a Statutory Declaration made by the Applicant on 22 January 2021 in Seoul, Republic of Korea.

Proprietor’s evidence

8 The Proprietor’s evidence comprises the following:

- (a) a re-executed Statutory Declaration made by Mitsuru Mukumoto, President of the Proprietor on 30 September 2020 in Osaka, Japan (“the Proprietor’s 1st SD”); and
- (b) a Statutory Declaration made by the same Mitsuru Mukumoto on 21 April 2021 in Osaka, Japan (“the Proprietor’s 2nd SD”).

Burden of proof

9 Under Section 105 of the Act, the Proprietor has the burden of showing the use made of the Subject Mark in Singapore.

Ground of revocation under Section 22(1)(a) and (b)

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

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

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

...

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

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

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

Relevant dates

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

(a) **Section 22(1)(a)**: The registration procedure was completed on 18 January 2013. The 5-year period immediately following the completion of registration ended on 18 January 2018. Thus, the period of use (or non-use) in issue is 19 January 2013 to 18 January 2018 (the “First 5-Year Period”).

(b) **Section 22(1)(b)**: The Applicant stated at [5] of the statement of grounds the following periods of use (or non-use) in issue:

- (i) 20 January 2013 to 19 January 2018;
- (ii) 5 May 2015 to 4 May 2020; and/or
- (iii) Such other successive 5-year periods between the periods (i) and (ii) above.

Analytical framework

12 The decision in *Technopharma Limited v Unilever PLC* [2021] SGIPOS 11 (“Technopharma”) succinctly summarises the analytical framework in a revocation application as follows:

24 The analytical framework for determining if the criteria for revocation on grounds of non-use have been satisfied can be found in the approach set out in *Lisbeth Enterprises Limited*

v Proctor & Gamble International Operations SA [2015] SGIPOS 6 (“***Lisbeth Enterprises***”), where the Principal Assistant Registrar of Trade Marks framed the legal elements of Sections 22(1)(a) and 22(1)(b) TMA as revolving around five “W” Issues – “Where”, “When”, “Which”, “Who” and “What”. To defeat the application to revoke trade mark registration, the registered proprietor must show: (i) that the trade marks in question have been *used in Singapore* (the “Where” Issue); (ii) that those marks have been *used during* those relevant time periods defined by the statute (the “When” Issue); (iii) that those marks have been *used in relation to the goods for which the marks have been registered* (the “Which” Issue); (iv) that those marks have been *used by the proprietor or with his consent* (the “Who” Issue); and (v) that there has been *use of the mark*, either in the form in which it has been registered or in forms which does not alter the distinctive character of its registered form (the “What” Issue).

25 These five “W”s are cumulative requirements and if the Proprietors are unable to demonstrate a single instance where all the criteria are satisfied, then they would have failed to show “genuine use” of the Series Mark or Logo Mark and the applications for revocation of the registered trade marks should be granted...

[emphasis in the original]

13 Without the need to delve into each of the “Where”, “When”, “Which”, “Who” and “What” issues in turn and at length, I will consider the “Which” issue first, the finding on which is dispositive of this revocation application.

No evidence of use in relation to goods for which the Subject Mark is registered

14 The Proprietor’s President deposed that it has used the Subject Mark in relation to “shoes and insoles”.¹ However, its evidence showed purported use on “insoles” only.²

¹ [4] of the Proprietor’s 1st SD

² Exhibits A, B and D of the Proprietor’s 1st SD and Exhibit J of the Proprietor’s 2nd SD

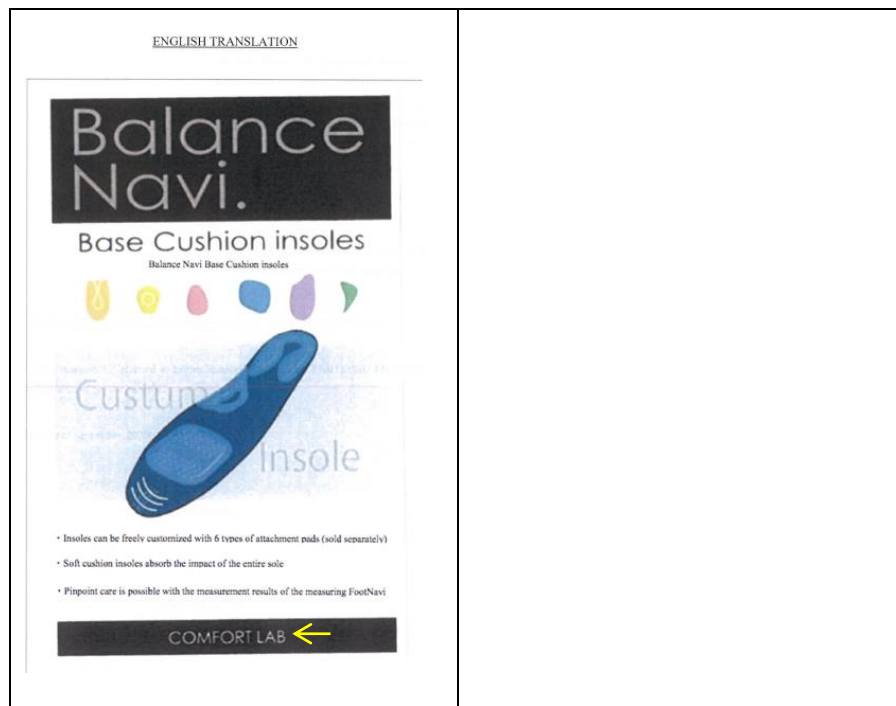


ENGLISH TRANSLATION

Balance Navi. Balance your body. Highly functional insoles that fit you perfectly.

Balance Navi. heel pad 004	Balance Navi. heel cushion 005	Balance Navi. heel wedge 006
Balance Navi. forefoot cushion 001	Balance Navi. metatarsal pad 002	Balance Navi. arch medial pad 003

BODIPAX
COMFORT LAB ←



15 The Subject Mark is not registered in respect of “insoles”. The closest goods for which the Subject Mark is registered are “shoes”. The Proprietor attempted to conflate “shoes” and “insoles” by referring to them as “shoes and insole products” in the evidence and written submissions. The Applicant submitted that the Oxford Advanced American Dictionary defines “insole” as “a piece of material shaped like your foot that is placed inside a shoe to make it more comfortable” [emphasis in the original], therefore “insoles” and “shoes” are two different types of goods.³ I agree. These distinct goods may be complementary, but it cannot be said that use of the Subject Mark on “insoles” is the same as use on “shoes” to sufficiently defend a revocation action for non-use.

³ [26] of the Applicant’s written submissions

16 Aside from the above, the Proprietor has also not adduced any purported evidence of use of the remaining goods in its specification (set out at [1]), namely: coats; sweaters; shirts; underwear (underclothing); nightwear; socks and stockings; T-shirts; headgear for wear; boots.

Conclusion on revocation under Section 22(1)(a) and (b)

17 Since all the elements in the analytical framework at [12] above are critical in establishing “genuine use” of a registered mark, the failure of the Proprietor to establish that the Subject Mark has been used on goods for which it is registered means that the revocation application must be granted.

Comments in passing

18 The Applicant has also made detailed submissions on why the Proprietor’s evidence does not support a finding that there has been relevant use in Singapore according to the analytical framework at [12] above. A copy of its summary table is annexed. There is no necessity for me to make a determination on each submission, but the summary table suffices to give a flavour of the challenges the Applicant has mounted against the purported and limited evidence of use.

Overall conclusion

19 Having considered all the pleadings and evidence filed and the submissions made in writing, I find that the application for revocation succeeds on Section 22(1)(a) and (b). The Subject Mark is revoked as from 19 January 2018, which is the date immediately following the end of the First 5-Year Period. The Applicant is also entitled to costs to be taxed, if not agreed.

Chee Sze Yin
Assistant Registrar

Ms Gooi Chi Duan (Donaldson & Burkinshaw LLP) for the
Registered Proprietor;
Mr Mok Ho Fai (Bird & Bird ATMD LLP) for the Applicant.

Annex 1: Applicant’s summary of key gaps in Proprietor’s evidence of use

NB: If the Proprietor is unable to demonstrate a *single* instance where all the criteria are satisfied, then they would have failed to show “genuine use” of the Subject Mark and the Application should be granted: Technopharma at [25]

Reference to square brackets below are reference to the Applicant’s written submissions.

Exhibit Number (Reference to 1 st and 2 nd Statutory Declarations of Mitsuru Mukumoto)	Summary Of Evidence	What	Where	Who	Which	When
	These descriptions are based on the Proprietor’s SD and are adopted for ease of reference but strictly without admission as to the accuracy of these descriptions.	That there has been use of the Subject Mark, either in the form in which it has been registered or in forms which does not alter the distinctive character of its registered form.	That the Subject Mark has been used in Singapore;	That the Subject Mark has been used by the proprietor or with his consent	That the Subject Mark has been used in relation to the goods for which the marks have been registered	That the Subject Mark has been used during those relevant time periods defined by the Statute
A	Photograph showing a shelf of products in Tokyu Hands Westgate store in Singapore around December 2013.	Use of Subject Mark is obscured and without context: [36].	Proprietor has exhibited evidence that the Tokyu Hands Westgate store was not open in December 2013: [37].	No evidence that this was used by the Proprietor or with its consent: [32].	There has been no use of the Subject Mark in relation to the Registered Goods: [21]-[30]	If this exhibit was from December 2013, this is outside the relevant time period for a revocation action premised on s 22(1)(b) of the Act: [38].

B	Leaflet bearing the Proprietor's Mark that was enclosed in product packages of shoes and insoles ordered around 2018, and which were handed out to customers at Tokyu Hands outlets in Singapore around the same time.		No evidence that this Exhibit was used in Singapore: [42].	No evidence that this was used by the Proprietor or with its consent: [40]	See "A" above.	Exhibit itself is undated: [40].
C / I	Email thread between Ms Marie Kusumoto of the Overseas Business Division of Tokyu Hands and the Proprietor's President dated 11 August 2014, where they requested the Proprietor to provide photos of its products to be used in	No evidence that, if the photo provided was indeed published, that it was published in the form in Exhibit D: [47].	Tokyu Hands had warned that the photographs may not be used and there is no evidence that the photos were actually displayed in Singapore: [45]-47].		See "A" above.	

	advertisements in Singapore.					
D	Picture provided to Tokyu Hands in response to the request set out in Exhibit C.		See “C/I” above.		See “A” above.	
E	Post from 14 December 2016 on the Proprietor’s Facebook page titled “Comfortlab Inc.” showing the Proprietor’s various insole products and the story behind the Registered Mark.		No “active steps” taken to target Singapore.: [55]-[56]	No evidence why the Proprietor has two Facebook pages, and if the Proprietor is responsible for content of either page: [54]	See “A” above. See also [57]	
F / J	Post on the Proprietor’s Japanese Facebook page dated 15 December 2017 sharing a picture promoting the Proprietor’s	Use of the Japanese translation “コンフォートラボ” is not use of the Subject Mark. Furthermore, any use of Subject Mark in product photos was too small to be	See “E” above.	See “E” above.	See “A” above.	

	insole products under its sub-brand Balance Navi.	viewed by a reasonable user.: [60]				
G	Screenshot showing that Exhibit F was part of an ad campaign whereby Singapore was one of the target countries.	See “G” above.	See “E” above. No evidence that any users actually accessed, viewed, or clicked on the ad.	See “E” above.	See “A” above.	
H	Purchase orders and delivery notes from Tokyu Hands to the Proprietor which describe the Proprietor’s goods that have been ordered from the Registrant for the Tokyu Hands “Orchard Central” store in Singapore.	Products appear to be sold under the name “BODIPAX” and no evidence that there has been use of the Subject Mark: [49].			See “A” above.	