

Campomar SL v Nike International Ltd
[2011] SGCA 6

Case Number : Civil Appeal No 78 of 2010
Decision Date : 28 February 2011
Tribunal/Court : Court of Appeal
Coram : Chao Hick Tin JA; Andrew Phang Boon Leong JA; V K Rajah JA
Counsel Name(s) : Prithipal Singh (K.L. Tan & Associates) for the appellant; Michael Palmer and Toh Wei Yi (Harry Elias Partnership LLP) for the respondent.
Parties : Campomar SL — Nike International Ltd

Trade Marks and Trade Names

[LawNet Editorial Note: The decision from which this appeal arose is reported at [\[2010\] 3 SLR 951.](#)]

28 February 2011

Judgment reserved.

Chao Hick Tin JA (delivering the judgment of the court):

Introduction

1 This appeal raises the issue as to whether the registration of a trade mark "NIKE" ("the Mark") should have been rejected on the ground that as of the date on which the Mark took effect, there existed another identical earlier mark on the trade mark register ("the register"). The appellant, Campomar S.L. ("Campomar"), was the proprietor of that earlier mark and has appealed against the decision of the Judge below ("the Judge") who refused to overturn the decision of the Principal Assistant Registrar of Trade Marks ("the PAR") allowing the registration of the Mark notwithstanding Campomar's objection.

The background

2 The respondent, Nike International Ltd ("Nike International"), is a US company and a wholly-owned subsidiary of Nike Inc. Both Nike International and Nike Inc have, since 1972, been marketing and retailing shoes and apparel worldwide under the "NIKE" trade mark and brand name.

3 Campomar is a Spanish company and had on 2 April 1986 made an application to register the mark "NIKE" in Class 3 of the International Classification of Goods in respect of "perfumery with essential oils". Its mark ("the 1986 Mark") was duly registered on 30 December 1989 with the registration taking effect from 2 April 1986.

4 On 20 November 2001, Nike International made an application ("the Registration Application") to register the Mark in Class 3 in respect of:

bleaching preparations and other substances for laundry use; cleaning; polishing, scouring and abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; colognes; toiletries; sunscreens; cosmetics; skincare products; deodorants and antiperspirants for personal use; shaving preparations.

The specification was subsequently amended to:

bleaching preparations and other substances; cleaning; polishing, scouring and abrasive preparations; soaps; all for laundry use or for use on sports goods or sporting apparel; perfumery; essential oils; cosmetics; hair lotions; dentifrices; colognes; toiletries; shampoo; sunscreens; cosmetics; skincare products; deodorants and antiperspirants for personal use; shaving preparations.

Campomar opposed the Registration Application based on, *inter alia*, its earlier 1986 Mark.

5 Consequently, Nike International filed an application on 21 January 2002 ("the Revocation Application") to have Campomar's 1986 Mark revoked under s 22(1) of the Trade Marks Act (Cap 332, 1999 Rev Ed) ("TMA 1999") on the ground that for the period of five years immediately preceding its application to revoke, Campomar had not used its 1986 Mark. As a result, the Registration Application was held in abeyance pending the outcome of the Revocation Application.

6 At the conclusion of the hearing of the Revocation Application, Principal Assistant Registrar of Trade Marks Anne Loo ("PAR Loo") held that Campomar had failed to show that it had made use of the 1986 mark during the relevant five year period. She thus revoked the registration of the 1986 Mark. Her decision was reversed on appeal to the High Court in *Nike International Ltd and another v Campomar SL* [2005] 4 SLR(R) 76. On further appeal by Nike International to the Court of Appeal, the decision of PAR Loo was restored: the decision of this Court is reported at *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919 ("*Nike International (Appeal)*"). Thus, in accordance with s 22(8) (a) of the TMA 1999 (which has been renumbered as s 22(7)(a) of Trade Marks Act (Cap 332, 2005 Rev Ed) ("TMA 2005")), Campomar's rights to the 1986 Mark were deemed to have ceased from the date of the Revocation Application (*ie* 21 January 2002).

7 Following the revocation of the 1986 Mark, the Registration Application was accepted for registration and published on 14 June 2006 for opposition purposes. Pursuant to rule 29(1) of the Trade Marks Rules 1998 (Cap 322, R 1, 2008 Rev Ed), the period of time within which any interested party could oppose the registration of the mark was from 14 June 2006 to 14 August 2006. Campomar filed a notice of opposition on 14 August 2006. At a hearing on 16 September 2009 before the PAR, Campomar opposed the registration of the Mark on *inter alia*, the following two grounds. First, it contended that s 8(1) of the TMA 2005 prohibited registration of a later trade mark if it was identical with an "earlier trade mark" and if the goods or services for which the later trade mark was sought to be registered were identical with the good or services for which the "earlier trade mark" was protected. Campomar averred that pursuant to the definition of "earlier trade mark" under s 2(1) of the TMA 2005, the relevant time to consider if there were any earlier trademarks was the time when Nike International made the Registration Application (*ie* 20 November 2001). Since Campomar's 1986 Mark was not deemed to have ceased until 21 January 2002, the 1986 Mark fell within the definition of "earlier trade mark" under the TMA 2005. As the Mark was identical with the 1986 Mark, and the goods and services applied for were identical with those for which the 1986 Mark was protected, the Registration Application should accordingly be refused under s 8(1) of the TMA 2005. Secondly, relying on s 7(6) of the TMA 2005, Campomar alleged that Nike International had made the Registration Application in bad faith.

8 In respect of Campomar's first ground of opposition, Nike International argued that a right to oppose could only arise after the date of publication of the Mark (*ie* 14 June 2006). Since Campomar's 1986 mark had already been revoked by 14 June 2006, it could not be an "earlier trade mark" under s 2 of the TMA 2005 at the time that the right to oppose arose. Accordingly, s 8(1) of the TMA 2005 could not apply. As for Campomar's second ground of opposition, Nike International argued that they

had shown *bona fide* and prolific use of the Mark on a wide range of products all around the world and that Campomar had not adduced any credible evidence of the use of its 1986 Mark in relation to any goods in Singapore. Hence Nike International submitted that Campomar had no basis whatsoever to invoke s 7(6) of the TMA 2005 against it in relation to the Registration Application.

9 In her written grounds of decision ("the PAR's GD") dated 30 October 2009, the PAR held that Campomar failed on both grounds of opposition. In relation to the first ground, the PAR took the view that the relevant point in time to consider if there was an "earlier trade mark" under s 2(1) of the TMA 2005 was neither the date on which the Registration Application was made (*ie* 20 November 2001) as argued by Campomar, nor the date of publication of the Mark (*ie* 14 June 2006) as argued by Nike International, but an even later date, *viz*, the date on which the Registrar decides if the later mark could be registered, *ie*, the time of the hearing of the opposition, or more specifically, the point of time when the Registrar is about to enter the Mark on the register. In the present case, this date was 16 September 2009. Since the 1986 Mark was no longer a "registered mark" from 21 January 2002, there was no longer, at the time of the hearing of the Registration Application, an "earlier trade mark" for the purposes of s 2 of the TMA 2005 which could form the basis of Campomar's opposition under s 8(1) of the TMA 2005. Accordingly, the PAR held that s 8(1) of the TMA 2005 did not apply. She also rejected Campomar's contentions that the Registration Application was made in bad faith. Having disposed of the objections, she allowed the registration of the Mark.

10 Campomar appealed against this decision of the PAR to the High Court by way of Originating Summons No 1353 of 2009 ("the OS"). We should, at this juncture, point out that in its appeal to the High Court, Campomar abandoned its opposition to the registration of the Mark based on s 7(6) of the TMA 2005 (*ie*, bad faith) and confined its appeal on the sole ground that registration should have been disallowed on account of the 1986 Mark. It contended that the PAR had misdirected herself in law in determining what constituted an "earlier trade mark" for the purpose of s 8(1) of the TMA 2005. Campomar also pleaded that the PAR misdirected herself in law by stating that there is an absence of an express provision that defines "earlier trade marks" as marks that are on the register as at the date of the application.

11 The OS was heard by the Judge, who, on 14 April 2010, dismissed Campomar's appeal. His grounds of decision ("the GD") may be found at *Campomar SL v Nike International Ltd* [2010] 3 SLR 951. Campomar now appeals to this court to reverse both the Judge's as well as the PAR's decisions.

Decision below

12 The sole issue before the Judge was whether Campomar's 1986 Mark could be considered an "earlier trade mark" within the definition of s 2(1) of the TMA 2005 for the purposes of the application under s 8(1) of the same. Like the PAR, the Judge found that the 1986 Mark did not qualify as an "earlier trade mark". He agreed with the PAR that the appropriate moment to determine whether there was an "earlier trade mark" under s 8(1) of the TMA 2005 was at the hearing of the opposition. Since the 1986 Mark had already been revoked by then, it was no longer a registered trade mark, and therefore not an "earlier trade mark" for the purposes of s 2(1) and s 8(1) of the TMA 2005. Accordingly, s 8(1) would not apply as a ground for refusing registration.

13 In coming to his decision, the Judge first noted that under s 2 of the TMA 2005, an "earlier trade mark" referred to a "registered trade mark... the application for registration of which was made earlier than the trade mark in question". It does not indicate the relevant moment in time at which it should be determined whether an earlier mark existed. However, from the wording of s 2 of the TMA 2005, the Judge took the view that the application for the earlier trade mark must not only be made

before the later trade mark in question (in this case, the Mark), the earlier trade mark must still, at the relevant time, be a registered trade mark (see GD at [3]).

14 The Judge then considered the cases of *Riveria Trade Mark* [2003] RPC 50 ("*Riveria*") and *Transpay Trade Mark* [2001] RPC 10 ("*Transpay*") both decisions of the UK Trade Marks Registry. Campomar relied heavily upon the former and argued that it stood for the proposition that the appropriate time to consider if there was an "earlier trade mark" was at the time of the application to register the subsequent trademark. The Judge was, however, of the view that *Riveria* could not assist Campomar as that case concerned a determination of the question of whether the registration of a later trade mark was valid, whereas the appeal before him concerned grounds for opposing the registration of a later mark *per se*. In the former situation, the Judge was of the opinion that the question of whether a later mark was validly registered would "obviously" depend on the circumstances at the time of the registration. In the latter situation, however, he was of the view that events which occurred between the date of application for registration and the date on which the decision was to be made on the application ought to be taken into account (*ie* the position taken by the UK Trade Mark Registry in *Transpay*) as the courts ought to be aware of the realities of the situation at the date that the opposition proceeding was heard. Moreover, adopting this approach would be consistent with the approach of this Court in *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 2 SLR(R) 541 ("*Tiffany & Co*"), where this Court opined that the appropriate time to consider if the public was likely to be confused by an applicant's mark was at the time at which the opposition proceeding was heard.

Issues before this Court

15 The main issue in this appeal is similar to that which confronted the court below, *viz*, whether Campomar's 1986 Mark could be considered to be an "earlier trade mark" within the meaning of s 8(1) read with s 2(1) of the TMA 2005. However, it does not appear to us that resolution of this issue would depend solely on the question of whether the Registrar, in determining an application to register, should view the application as at the date of the application to register or the date of the hearing of the registration application itself. This is because the 1986 Mark was deemed to have been removed as of 21 January 2002 but the Mark was deemed to have been registered with effect from 20 November 2001. Thus, if both the PAR and the Judge were right to say that the court ought to deal with an application to register as at the date on which the application to register comes before the Registrar for a decision (and we think that is correct for reasons we will come to shortly), one will then face the problem of the same mark having being registered as belonging to two distinct proprietors between 20 November 2001 and 21 January 2002. As the TMA 2005 and its predecessor prohibits this phenomenon, this two-month period of overlap cannot be ignored in determining whether an "earlier trade mark" existed.

The decision of this Court

16 Section 8(1) of the TMA 2005 prohibits the registration of a later trade mark if it is identical with an "earlier trade mark" and if the goods or services for which the former is sought to be registered are identical with the good or services for which the "earlier trade mark" was protected. Section 8(1) and (2) of the TMA 2005 provide as follows:

Relative grounds for refusal of registration

8. —(1) A trade mark shall not be registered if it is identical with an **earlier trade mark** and the goods or services for which the trade mark is sought to be registered are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because —

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

[emphasis added in bold italics]

17 The definition of an earlier mark can be found in s 2(1) of the TMA 2005:

Interpretation

2. —(1) In this Act, unless the context otherwise requires —

...

"earlier trade mark" means —

(a) a **registered trade mark** or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which **an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered** ;

...

[emphasis added in italics and bold italics]

The effect of limb (a) and the concluding limb is that a mark may be considered to be an "earlier trade mark" only where it is either already registered or pending registration. Registerability of the earlier mark is critical.

18 As the Judge rightly pointed out, s 2(1) of the TMA 2005 does not provide any specific guidance or indication as to the point in time for determining if an earlier trade mark exists for the purposes of s 8(1) of the TMA 2005. Campomar has argued that a "literal interpretation" of s 2(1) would give rise to the conclusion that the relevant date was the date of the Registration Application. However, we do not see how that view can be taken when the provision merely sets out the requirements which must be met before a mark may qualify as an "earlier trade mark". For the reasons alluded to by the PAR and the Judge in the present case, the local case of *Hugo Boss AG v Reemtsma Cigarettenfabriken GMBH* [2009] SGIPOS 7 ("*Hugo Boss*"), as well as the English cases of *Kambly SA Specialities de Biscuits Suisses v Intersnack Knabber-Geback GMBH & Co KG* [2004] EWHC 943 (CH)

(“*Kambly*”) and *Transpay*, we agree that the Registrar, in considering an opposition to an application for registration of a mark, should view the matter as at the date of the hearing of the opposition instead of the date of the registration application. This approach is not only consistent with the wording of s 8(1), more importantly, it is sensible, pragmatic and realistic.

19 In *Hugo Boss*, the Registrar had to determine whether Hugo Boss AG’s expunged trade mark registrations for “BOSS” and “HUGO BOSS” in Class 34 could still be considered as “earlier registrations” for the purposes of s 23(1) of the Trade Marks Act (Cap 332, 1992 Rev Ed) (“TMA 1992”). Section 23(1) of TMA 1992 provides:

23. —(1) Except as provided by section 25, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of —

(a) the same goods;

(b) the same description of goods; or

(c) services or a description of services which are associated with those goods or goods of that description.

Reemtsma Cigarettenfabriken GmbH (“Reemtsma”) had, on 14 December 1998, applied to register the mark “BOSS” in Class 34 for use on “tobacco, tobacco products, particularly cigarettes and cigarillos, smoker’s articles, matches; all included in Class 34”. On 5 February 2002, Reemtsma filed two applications to have Hugo Boss’ trade mark registrations for “BOSS” and “HUGO BOSS” in Class 34 revoked. By a judgment of the High Court dated 10 September 2003, these two marks of Hugo Boss were revoked and the two marks were deemed revoked as from 5 February 2002 (*ie* the date of the revocation application) (see the judgment reported at [2003] 4 SLR(R) 155). On 23 July 2004, Reemtsma’s application was published for opposition purposes. On 23 November 2004, Hugo Boss AG filed its Notice of Opposition. At the hearing of Reemtsma’s application to register the BOSS mark, PAR Lee Li Choon (“PAR Lee”) noted that s 23(1) of the TMA 1992 referred to marks “belonging to a different proprietor and **already on the register**” [emphasis in original]. Such marks prevented the registration of later marks which were identical to or nearly resembled marks in relation to the same goods or goods of the same description. PAR Lee next considered the question of “what [was] the point in time for the purpose of determining what marks were “already on the register” for the purpose of section 23(1)” and concluded that the point in time at which the Registrar should consider if prior expunged marks were still “on the register” for the purposes of a s 23(1) objection was at the point in time when the Registrar decided whether the later mark could be entered onto the register. In other words, the point in time would be the point at which the opposition proceeding was heard. This was because s 23(1) of the TMA 1992 stated that “Except as provided by section 25, no trade mark **shall be registered** in respect of any goods ...” [emphasis added in bold italics]. PAR Lee was of the view that the phrase “no trade mark shall be registered” related to the act of placing a mark on the register. Further, she also noted that there was no express provision in the TMA 1992 stating that “marks already on the register” had to be marks already on the register *as at the date of the application for registration of the later mark* [emphasis added]. Additionally, PAR Lee was of the view that her interpretation was a reasonable one and was also in line with the Registrar’s implementation of the TMA 1992 by waiving citations of earlier registrations/applications which, at the point of decision, were no longer subsisting and valid (*eg* when they had lapsed due to non-renewal or abandonment). Finally, PAR Lee observed that her approach was wholly consistent with that taken by this Court in *Tiffany & Co* where the Court observed at [57]:

57 ... Whether or not to take into account facts occurring after the date of application to register the mark must of course depend on each unique set of facts that arises. The court must always be aware of the realities of the situation at the date that the opposition proceedings under s 15 [of the TMA 1999] are heard.

20 Turning next to the English cases of *Kambly* and *Transpay*, they also suggest that events which occurred between the date of application for registration and the date on which the decision on the application was made ought to be taken into account.

21 *Kambly* was a case concerning two earlier registered marks belonging to Kambly in respect of flour, confectionery, bread, cake and biscuits, and the like ("the Kambly Trade Marks"), and two later marks which Intersnack sought to register in respect of a wider category of products which also included "snack products" ("the Intersnack Trade Marks"). Intersnack also sought revocation of the Kambly Trade Marks.

22 Kambly argued that registration of the Intersnack Trade Marks was barred by s 12 of the UK Trade Marks Act 1938 (c 22) ("UK TMA 1938") because s 12 of the UK TMA 1938 prohibits the registration of marks identical to and resembling pre-existing marks on the register where registration of the later marks were sought in respect of goods identical to and nearly resembling goods for which the earlier marks were registered for, but as at the date of the applications for registration by Intersnack (respectively 23 May 1989 and 11 May 1990), the Kambly Trade Marks were still on the register (they were only deemed revoked as of 31 August 1993) and the Intersnack Trade Marks nearly resembled (if they were not identical with) the Kambly Trade Marks and were also in respect of the same goods or same description of goods. Section 12, in so far as material, reads as follows:

12 Prohibition of registration of identical and resembling trade marks

(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and **already on the register** in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

[emphasis added]

23 Lightman J rejected the argument of Kambly and held at [26] of his decision that the critical date for determining whether there was already on the register a trade mark belonging to a different proprietor was the date when the mark was to be entered on the register:

The existence of a trade mark on the register at the date of application for registration is *not under the 1938 Act* [the UK's old Trade Marks Act on which Singapore's old TMA 1992 was modelled] a bar to an application for registration of another identical or similar trade mark so long as the previously registered trade mark is *removed from the register by the date that the trade mark applied for is registered*. The language of section 12 makes plain that *the critical date is the date of the entry on the register*: see Lord Diplock in *GE Trade Mark* [1973] RPC 297 at 328 and see *In the Matter of a Trade Mark "Palmolive"* (1932) 44 RPC 269 at 276.

[emphasis added]

24 Turning next to *Transpay*, this was a case where Barclays Bank Plc ("Barclays") applied, in November 1994, to register the word TRANSPAY in Classes 16 and 36 in relation to, *inter alia*, money

orders, cheques, cheque books, plastic cards, banking and financial services. In February 1995, it applied to register another version of the device in the same classes. Both applications were accepted and published. In November 1995 and July 1996, Chequepoint Express Inc ("Chequepoint") filed notices of opposition. One ground of opposition was under s 5(2)(b) of the UK Trade Marks Act 1994 (c 26) ("UK TMA 1994") on the basis that it owned two earlier trade marks for TRANSCHEQ in the same classes. However, Chequepoint's marks had expired following non renewal on 15 February 1997 and were no longer capable of restoration to the register.

25 The UK Trade Marks Registry was thus confronted with the question as to whether Chequepoint could validly object to Barclays' registration application under s 5(2)(b) of the UK TMA 1994 on account of the fact that Chequepoint's earlier marks only lapsed after Barclays had applied for the registration of its two new marks (Chequepoint's earlier marks expired for non-renewal on 15 February 2007 but Barclays' registration application for its marks was dated 15 November 1994 and 17 February 1995 respectively). Chequepoint argued that matters had to be considered as at the date of the registration application. As the earlier marks were still on the register when Barclays made its applications, Chequepoint contended that its marks were accordingly earlier registered marks for the purposes of s 5(2)(b) and their subsequent lapse could not affect its status as at the date on which Barclay made its registration application. Barclays, on the other hand, argued that where an earlier mark had been allowed to lapse, this ought to be taken into account, even if the lapse occurred after the date of the application for registration.

26 Mr Mike Knight of the UK Trade Marks Registry dismissed Chequepoint's opposition and allowed Barclays' registration applications. He was of the view that implicit from the provisions of the UK TMA 1994 was the notion that acceptance of an application for registration of a mark was distinct and separate from the actual registration of the mark. This view was based on ss 37 and 40 of the UK TMA 1994. The former dealt with the examination of a registration application whereas the latter made provision for the actual registration of a mark. Based on these two provisions, Mr Knight concluded that the acceptance of an application was not the same as registration.

27 Having noted the distinction between acceptance of a mark for registration and the actual registration of the mark, Mr Knight then said that the UK TMA 1994 allowed the registrar to consider certain matters arising between those two events, *inter alia*, where: (a) the proprietor of an earlier mark limited the specification of the goods and services such that the cause of the conflict between the two marks was removed; (b) the earlier mark had been fully cancelled after the date of application for registration of the otherwise later conflicting mark; (c) the applicant had taken an assignment of the earlier mark; and (d) where the earlier mark had lapsed. This was to prevent unfairness from resulting. If consideration was restricted to only matters that existed at the application date, it would be impossible for part cancellation of goods or services to be taken into account that could allow the later mark to be registered. Furthermore, the effect of cancellation or assignment of a mark could also not be considered. Turning to the facts before himself, Mr Knight noted that as Chequepoint's earlier marks no longer existed as registered trademarks from February 1997 and indeed by September 1999 when the application came up for consideration, they were clearly not on the register. Thus, he held that Chequepoint could not rely on s 5(2) of the UK TMA 1994 to oppose the registration.

28 Thus, the effect of *Hugo Boss*, *Kambly* and *Transpay* is that the relevant date for determining the existence of an "earlier mark" is the date when the mark is to be entered on the register, and not the date of the registration application. However, as mentioned in [\[15\]](#) above, it seems to us that the problem which surfaced in this case is not amenable to a resolution by merely applying s 8(1) of the TMA 2005, read with the definition of an "earlier trade mark" provided for in s 2(1) of the same act. There is also the additional problem arising from a combination of the relation-back provisions in the

TMA 2005, viz, ss 22(7) and 15(2), which we have to contend with.

29 Under s 22(7) of the TMA 2005, revocation of a trade mark takes effect either from the date of the revocation application where the application is granted, or earlier if the court is satisfied that there are grounds for revocation to be effective at a date prior to the revocation application. Under s 15(2) of the same Act, that subsection provides that where an application for registration of a mark is granted, the mark is deemed to be registered as of the date of the application for registration, ie, the effective date of registration or a mark will relate back to the date of the application for registration, notwithstanding the lapse of time between the date of application for registration and the date of actual entry of the mark onto the register. The effect of s 22(7), read with s 15(2) of the TMA 2005, is that if the date of application for registration of a later mark (this is also the effective date of registration of that later mark) occurs *before* the date of application for revocation of an earlier mark (this is also the effective date of revocation of that earlier mark), on a successful registration of the later mark and revocation of the earlier mark, there would be two identical or almost similar marks on the register at the same time at some point. This would be precisely the situation in the present matter should the Mark be registered. It seems to us that one of the objects of enacting s 22(7)(a) (backdating of the revocation to a date earlier than the date of application to revoke if the circumstances justify that) must be to address this problem.

30 Although the 1986 Mark was only finally removed on 16 January 2006 following the decision of this Court in *Nike International (Appeal)*, in view of s 22(7) of the TMA 2005, the revocation of the 1986 Mark was deemed to take effect from 21 January 2002, the date on which Nike International made the Revocation Application. Similarly, although Nike International's application to register the Mark was only granted on 16 September 2009, the Mark was deemed by s 15(2) of the TMA 2005 to take effect from 20 November 2001. Thus for the period between 20 November 2001 and 21 January 2002 ("the overlap period"), if the Mark was allowed to remain on the register, then in law both the 1986 Mark and the Mark would exist concurrently on the register, albeit for a brief two-month period. Accordingly, even if the relevant date for determining whether there was an "earlier mark" was the date when the mark was to be entered on the register rather than the date of the registration application, which we agree, this position does not alter the fact that as at the date of the hearing before the PAR, the 1986 Mark remained on the register until 21 January 2002 and was only effectively removed *after* the effective registration date of the Mark (20 November 2001). To that extent, allowing the registration of the Mark would run counter to the provisions of the TMA 2005.

31 In *Hugo Boss*, it seems to us that the approach taken by PAR Lee was to simply ask whether, as at the date of the hearing to oppose Reemtsma's application to register the BOSS mark, Hugo Boss' two earlier marks were still on the register. In finding that the registration of Hugo Boss' two earlier marks did not constitute earlier registrations for the purposes of s 23(1) of the TMA 1992, she did not appear to have considered the fact that if Reemtsma's application to register its later mark was granted, registration of that mark would take effect as from 14 December 1998. However, the two earlier Hugo Boss were still on the register on 14 December 1998 and remained so until 5 February 2002, which was the date of the revocation application and hence the effective date of their revocation.

32 Similarly, the fact that there was a period of overlap between the effective date of registration of the later Intersnack Trade Marks (respectively 23 May 1989 and 11 May 1990) and the effective date of revocation of the old Kambly Trade Marks (31 August 1993) did not appear to have been addressed by Lightman J in *Kambly*. Granted, Lightman J's views were expressed in the context of the UK TMA 1938, which did not contain any equivalent of s 22(7) of Singapore's TMA 2005. A similar provision was however introduced some time later into the UK TMA 1994 (see s 46(6) of the UK TMA 1994). Yet, that provision was not considered in *Transpay* either. Like PAR Lee, Mr Knight did not

appear to have considered the fact that in allowing the registration of Barclays' later marks, Chequepoint's earlier marks and Barclays' later marks would appear alongside each other on the register between 15 November 1994/17 February 1995 and 15 February 1997. In passing, we should further add that Mr Knight also found that the two marks, TRANSPAY and TRANSCHEQ, were not confusingly similar.

33 In dealing with the problem created by the relation-back provisions in the TMA 2005, *viz*, ss 22(7) and 15(2), we find guidance from *Riveria*, which Campomar relied on. While we do not agree with Campomar's reliance on *Riveria* for the proposition that the appropriate time to consider if there was an "earlier trade mark" was at the time Nike International applied to register its subsequent mark (see [36] below), there is much to be said about the remarks of Mr Allan James (of the UK Trade Marks Registry) to the effect that an earlier mark must be revoked effective from a date which preceded the date of application for registration of a later conflicting mark before the later mark could be validly registered.

34 *Riveria* concerned an application by the proprietor of an earlier mark for a declaration that the registration of a later mark, which was similar to the earlier mark and registered for identical goods, was invalid. This case involved the earlier trade mark of "Riveria", which was held by Stella Products Limited ("Stella"), and the later mark of "Franco's Riveria Cone", which was held by Domenico Tanzarella t/a Franco's Ices ("Franco"). Stella's earlier trade mark was registered with effect from 13 June 1973 but was subsequently revoked for non-use effective from 21 May 2001. Franco applied on 22 March 2000 to register its later mark. This application was granted on 25 August 2000, a date which pre-dated Franco's application to revoke Stella's registered mark for non-use for the prescribed period (*ie* 21 May 2001). However, pursuant to the relation-back provision in the UK TMA 1994, the effective date of registration of Franco's later mark was backdated to 22 March 2000. Following the registration of Franco's mark, Stella applied on 23 April 2001 (which was even before Franco applied to revoke the Stella mark) to have Franco's registration invalidated on the ground that its mark was on the register. The decision of Mr James in *Riveria* was in relation to this application by Stella. Although Franco's application to revoke was made later than Stella's application to invalidate (the former was made on 21 May 2001 whereas the latter was made on 23 April 2001), the former was heard first and the revocation order was granted. In the light of this background and of the fact that the revocation of the Stella mark was deemed effective from the date of the revocation application (*ie* 21 May 2001), Mr James put the issue before him as follows (at [12]):

The matter in dispute is whether the subsequent revocation of Stella's registration with effect from May 21, 2001 has the effect of either retrospectively extinguishing the earlier trade mark right or else preventing or limiting the proprietor's ability to continue to rely upon it.

35 Mr James answered this query in the negative and relied on s 46(6) of the UK TMA 1994, which was the genesis of our s 22(7) of the TMA 2005. Section 46(6) of the UK TMA 1994 provides:

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.

In his view, by virtue of s 46(6) of the UK TMA 1994, the rights of the proprietor of a revoked registration would continue to exist up until the date of the application for revocation, "unless the

registrar is satisfied that the grounds for revocation existed at an earlier date" (see [14] of *Riveria*). It was, therefore, essential that the party who was seeking to revoke an earlier trade mark, whether to make way for its own application or to resist an application to have its own registration declared invalid on the basis of the earlier trade mark, request that the conflicting earlier mark be revoked with effect from a date which precedes the date of its own application for registration. Otherwise, the subsequent revocation of an earlier mark (in this case, Stella's earlier mark, with effect from 21 May 2001), after the later mark had been registered (in this case, Franco's later mark, which was deemed to be registered on 22 March 2000), would have the effect of retrospectively extinguishing the rights of the proprietor of the earlier mark during the overlapping period when *both* the later mark and earlier mark would be found on the register (*ie* between 22 March 2000 and 21 May 2001).

36 What is of relevance in *Riveria* to the present case is in relation to the existence of the overlapping period. Mr James would not allow the Franco mark to remain on the register as it would coincide with the Stella mark which was still there until 21 May 2001. As mentioned in the previous paragraph, Mr James also added that the difficulties that arose could have been taken care of by resorting to s 46(6)(b) of the UK TMA 1994 (our s 22(7)(b) of the TMA 2005) and by requesting the Registry to order that the revocation takes effect from a date earlier than the date of the application by Franco to register its mark, provided that there is sufficient evidence to warrant such a further backdating (on the facts of *Riveria*, Franco failed to do so and Mr James declined to accept Franco's "tentative invitation to speculate about what the outcome might have been if revocation had been sought from an earlier date" (see [21] of *Riveria*)). From the facts of the case and this reasoning of Mr James, it would be seen that when he was considering the application to invalidate the Franco mark, he was looking at the matter as at the date of the hearing of that application and not as at the date of the application. If he was looking at the matter as of the date of the application to invalidate the Franco mark, there was no question of any overlapping period to talk about. The incidence of an overlapping period only arose following events which occurred after the invalidation application made on 23 April 2001 (see [34] above).

37 While it is true that the proceedings here, which concern opposition to registration, are different from that in *Riveria*, which related to invalidation of a registered mark, both were based on the ground that there was an earlier similar or identical registered mark. The ground for opposing the registration of a mark under s 8(1) of the TMA 2005 can also be relied upon to invalidate a mark. This is clearly set out in s 23(3) of the TMA 2005, which reads:

(3)The registration of a trade mark may be declared invalid on the ground -

(a) That there is an earlier trade mark in relation to which-

(i) The conditions set out in section 8(1) or (2) apply;

...

Thus, whether a party should apply to oppose the registration of a mark or to invalidate the mark depends on whether, at the time of application, the mark in question has been registered. If registration of the later mark is still pending, then the party having an interest in the matter should give notice of his intention to oppose the registration of the mark. On the other hand, if the later mark has already been registered, then the proper course for an interested party to take would be to apply for the invalidation of that mark

38 In this case, the 1986 Mark has undoubtedly been revoked on 21 January 2002. But it does not mean that that mark had never been on the register. It was there until 21 January 2002. As the

effect of the registration of the Mark would be related back to the date of application, 20 November 2001, this is a consequence which the Registrar cannot disregard in considering the Registration Application. Otherwise, it would mean that during the overlapping period, an identical mark, owned by two different entities, would be on the register. The TMA 2005 could not have contemplated or sanctioned that. As stated before, the problem could have been avoided by resorting to s 22(7)(b) of the TMA 2005, which gives the Registrar the power to order the revocation of a registered trade mark to take effect even earlier than the date on which the application for revocation was made if the circumstances warrant it. The provisions in s 22(7)(b) of the TMA 2005 were only added in 1999. As stated in [29], it seems to us that one of its objects must be to address the sort of problems that could arise like the present where the application to register a later mark was made before an application to have an earlier identical or similar registered mark revoked for non-use and there is evidence to show that the non-use occurred even before the commencement of the five-year period relied on in the application for revocation.

39 In *Transpay, Kambly and Hugo Boss*, the question of the existence on the register of two similar or identical marks belonging to different parties during the overlap period was not given focus. At this juncture, we would highlight one other aspect of *Transpay*. There, the earlier mark was not revoked for non-use but lapsed due to non-renewal. We do not think this difference, as to the reason for a mark being no longer on the register, is material. Rather, the critical facts are first, whether an earlier mark was still on the register at the time the later mark was to be entered on that register and second, whether the entry of the later mark onto the register would create a situation whereby two similar or identical marks belonging to different parties could be found on the register at any point in time. In the cases of *Hugo Boss and Kambly*, the significance of a period of overlap was similarly not considered (see [31] and [32] above). Moreover, they were decided under the now superseded predecessors of the respective UK and Singapore Trade Marks Acts, where what is now s 22(7)(b) of the TMA 2005 (or s 46(6)(b) of the UK TMA 1994) had not yet been added.

40 To recapitulate, what we would underscore is that while the Registrar, in considering an application to register a mark in the face of an opposition under s 8(1), is entitled to take into account all the circumstances up to that point in time, including the revocation of an earlier identical registered mark, the Registrar should not disregard the fact, as in this case, that the registration of the later mark would give rise to there being on the register two identical marks being owned by two different parties for a period of time. As we see it, the provisions in s 22(7)(b) of the TMA 2005 must have been added to address, *inter alia*, this difficulty.

Conclusion

41 In conclusion, this court would state that it makes good and practical sense, when the Registrar determines an application for a mark to be registered, to consider it in the light of the circumstances prevailing on the day of hearing instead of viewing it as on the date of the application. Indeed, in *Riveria*, which was an invalidation proceeding, Mr James still considered the application in the light of the facts before him as at the date of the hearing. What is critically important, whether it is an opposition proceeding or an invalidation proceeding, is for the Registrar to always bear in mind the need to ensure that the entry of a later mark on the register would not result in the existence of two similar or identical marks, belonging to different parties, on the register at *any period of time*. In the present case, while the 1986 Mark was no longer on the register on 16 September 2009 (the date of the hearing of the Registration Application), the register would show that the 1986 Mark was on the register until 21 January 2002. As the registration of the Mark would take effect from 20 November 2001, which was a date well before the 1986 Mark was removed from the register, the entry of the Mark on the register would infringe s 8(1) of the TMA 2005 and would in turn cause confusion. Therefore, it should not be allowed. The remedy for a problem of this kind could be

resolved in an appropriate case by resorting to s 22(7)(b) of the TMA 2005. However, this was not done here.

42 In the result, Campomar's appeal is allowed with costs here and below and with the usual consequential orders.

Copyright © Government of Singapore.