

## Intellectual Property Practice Update

### *Evidence for Non-Use Revocation Proceedings in Singapore*

#### Overview

Under the Singapore Trade Marks Act (Cap 332), a registered trade mark may be revoked under various grounds, and one of which is because of “non-use” by the registered proprietor. In Singapore, the requisite period of “non-use” which would allow a third party to file for non-use revocation proceedings, would be 5 years from the date of completion of the registration procedure, or an uninterrupted period of 5 years.

The Singapore Trade Marks Registry has recently issued a new Circular on “Evidence in Trade Mark Revocations on the Ground of Non-use” (HMD Circular No. 4/2017, dated 19 April 2017) which deals with the type of evidence that a proprietor ought to be furnishing in a Statutory Declaration along with the Counter-Statement.

#### What evidence should be produced

The Statutory Declaration should set out, in the alternative:-

- (i) evidence of the use by the proprietor of the trade mark during the alleged period of non-use;
- (ii) evidence supporting proper reasons for non-use during the alleged period of non-use;
- (iii) evidence of commencement or resumption of use of the trade mark on a date which falls after the alleged period of non-use, and before the 3-month period immediately preceding the date of the application for revocation;
- (iv) evidence of:-
  - (a) commencement or resumption of use of the trade mark on a date which falls after the alleged period of non-use, and within the 3-month period immediately preceding the date of the application; and
  - (b) the fact that the proprietor was unaware that the application might be made when the preparations for the commencement or resumption of use of the trade mark began.

At the counter-statement stage, a proprietor is only required to show that he has an arguable case. More detailed evidence, if any, can be filed later in the proceedings. It has also been clarified that as a matter of best practice, a proprietor's prima facie evidence of use should

minimally comprise some material showing the mark in use (e.g. catalogues, product labels, advertisements, mark as affixed on the goods in question) and/or some indication of sales (e.g. invoices, purchase orders).

### Who should be filing evidence and what happens if you do not

An application for revocation on the ground of non-use shall be granted where no Statutory Declaration has been filed with the counter-statement or served on the applicant within the time allowed. This means that the proprietor's registered mark will be revoked.

However, it is not mandatory for the applicant for revocation to file any evidence. This is because the burden is for the proprietor to show what use has been made of it.

### Recommended steps to take

As the applicant for the revocation proceedings, it would be prudent to conduct the necessary surveillance work to ensure that the registered proprietor has not genuinely used the trade mark for the requisite period. On the other hand, as the proprietor, if the trade mark is genuinely important to you but you have yet to start using the trade mark, it would be useful to take note of the deadline of 5 years since the completion of the registration procedure, and to take steps to use the trade mark in any way possible. Putting up advertisements appropriately could be the first step forward in showing genuine use besides paving the way for your entry in the market.

*Should you have any queries as to how this update may affect your organisation or require further information, please do not hesitate to email us.*



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*This article is intended to highlight the salient points of filing evidence in a non-use trade mark revocation action in Singapore as directed and clarified in the latest Circular to-date, and it is not intended to be comprehensive nor should it be construed as legal advice.*