

Intellectual Property Office of Singapore Case Summary: Technopharma Limited v Unilever PLC [2021] SGIPOS 11

Source: <https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/legal-decisions>

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In this dispute, an application was made to revoke three registered trade marks on the ground of non-use. None of these marks were put to use in the exact forms in which they were registered. This decision addresses various issues surrounding the legal requirements for “genuine use” of a registered trade mark, which the registered proprietor bears the burden of proving in order to resist the revocation application.

Unilever PLC are the Registered Proprietors (“the Proprietors”) of the following trade marks (“the Subject Marks”):

Mark	Specification
	<p>Class 3</p> <p>Soaps, cosmetics, skin creams and lotions, non-medicated toilet preparations.</p> <p>[The “Logo Mark”]</p>
	<p>Class 3</p> <p>Soaps; essential oils; bath and shower preparations [non-medicated]; skin care preparations [non-medicated]; oils, creams and lotions for the skin [non-medicated]; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations [cosmetic]; cosmetics; make-up and make-up removing preparations; petroleum jelly [for cosmetic use]; lip care preparations [non-medicated]; talcum powder; cotton wool, cotton sticks [for cosmetic use]; cosmetic pads, tissues or wipes, all impregnated with non-medicated preparations for personal use; cleansing pads, tissues or wipes, pre-moistened or impregnated with cosmetic preparations; beauty masks, facial packs [cosmetic].</p> <p>[The “Series Marks”]</p>
	<p>Class 3</p> <p>Perfumery; essential oils; deodorants and antiperspirants; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; cotton wool, cotton sticks.</p> <p>[The “Word Mark”]</p>

Technopharma Limited (“the Applicants”) applied for revocation of the above registrations on the basis of non-use under Sections 22(1)(a) and 22(1)(b) of the Trade Marks Act (“the Act”), which requires that a registered mark be used within 5 years from the completion of the registration process, and that there is no consecutive 5-year period of non-use at any time. To defeat an application for revocation, the Act requires the Proprietors to show that there has been “genuine use” of the registered trade mark “by the proprietor or with his consent”.

The Proprietors’ best evidence of use of their mark(s) is as follows:



There was no evidence of any use of the Word Mark on any of the goods specified in that trade mark registration. The Proprietors also conceded that there was *no evidence of any use* of the Logo Mark or Series Marks *in the exact forms* in which they had been registered. The focus was whether the various product-packaging images tendered by the Proprietors, depicting various items from their “Fair & Lovely” range of skincare products, could be relied upon to show “genuine use” of the Subject Marks. More specifically, one of the main legal questions was whether what appeared on these product-packaging designs qualified under Section 22(2) of the Act as “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”. Some of these product-packaging images appeared on websites operated by third parties independently of the Proprietors, raising additional issues relating to the Proprietors’ claims that such third party trade mark use had occurred with their “consent”.

The IP Adjudicator construed the distinctive character of the Logo Mark and Series Marks as residing in the combinations of two components – the words “Fair & Lovely” and pictorial elements – which constitute each composite mark.

The IP Adjudicator then considered whether use of the words “Fair & Lovely” on the product-packaging images, without the dual-headed photographic pictorial element from the Series Marks, or the dual-headed line drawing pictorial element from the Logo Mark, should be regarded as “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”. He determined that what appeared in the product-packaging images made additions, alterations and adaptations to the registered forms of the Series Marks and Logo Mark which had altered their distinctive character. While the product-packaging designs exhibited visual cues that broadly corresponded to the distinctive components of the Series Marks and the Logo Mark, it also appeared as if their component elements had been disaggregated, reconfigured and reconstituted alongside additional design elements (new layouts, shapes and fonts, as well as words describing the functionality of the products) to render these designs legally non-equivalent to the registered forms of the trade marks.

The IP Adjudicator also considered, on the issue of use with consent, whether the Proprietors could be regarded as having made an unequivocal demonstration of consent to the third party’s use of their registered trade marks on its website, on the facts of this case.

On the last of these questions, the IP Adjudicator outlined a framework of principles to guide the interpretation of the meaning of “consent” in Section 22(1)(a) of the Act, identifying two broad categories of situations where third party acts of trade mark use can be regarded as instances of “genuine use” of the registered trade mark that have occurred with the registered proprietor’s “consent”. These principles define the circumstances in which the conduct of a third party using the registered trade mark may be relied upon by the registered proprietor to defeat an application to revoke that trade mark registration on grounds of non-use:

- (i) A third party’s use of a registered trade mark occurs with the “consent” of the registered proprietor where the latter has expressly consented to the third party’s trade mark usage. Express consent may be inferred from the evidence adduced by the registered proprietor and can be established through indirect evidence.
- (ii) As the purported consenting party, the registered proprietor must prove that it had actual knowledge of the third party’s acts of trade mark use that are alleged to have occurred with the registered proprietor’s “consent”.
- (iii) Apart from having actual knowledge of the third party’s conduct, the registered proprietor must also show that it has taken positive steps that objectively indicate it has authorised, assented to or approved of the third party’s use of the registered trade mark.

(iv) A third party's use of a registered trade mark takes place with the "consent" of the registered proprietor where the latter has explicitly given its consent to the former, with both parties in direct communication with each other. In addition, third party trade mark use can also take place with the "consent" of the registered proprietor even if the former has not received any direct, formal or prior authorisation from the latter. The registered proprietor can demonstrate its consent to a third party's use of the registered trade mark such that the former can rely on the actions of the latter to establish "genuine use" of the registered trade mark for the purposes of Section 22(1)(a) TMA. This requires the registered proprietor to, upon learning of the third party making use of the registered trade mark, respond with conduct of its own that publicly, objectively and unequivocally, demonstrates its assent to the third party's continued or ongoing use of the registered trade mark.

As it was eventually found that the forms of the mark that have been actually used by the Proprietors do not fall within the scope of Section 22(2) of the Act, such use cannot be relied upon as evidence of genuine use of the Subject Marks during the relevant 5-year periods. There being no other better evidence of use of the Subject Marks, these registrations are to be revoked as from 21 July 1995 (the Logo Mark), 17 October 2013 (the Series Marks) and 25 September 2017 (the Word Mark), these dates being the first day immediately following the end of the respective 5-year period from the completion of registration.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2021/technopharma-v-unilever-2021-sgipos-11.pdf>.