

Did you know...?

‘A Stitch in Time ends up saving your Precious Trademarks and Time’

Today, we discuss a unique legal encounter that went beyond the right to a particular trade mark. Legal summons and notices often require immediate attention on the part of a company, and when this does not happen, it amounts to action. The request to file a counter-statement in a trade mark application by ‘Metrojaya BHD and Metrojaya Sendirian Berhad’ and the objection thereto by ‘The East India Company Holdings Pte Ltd’ is the core of our discussion today, highlighting the various arguments made.

The East India Company Holdings Pte Ltd (the ‘Applicants’) applied to register the trademarks "The East India Company Guinea" and "The East India Company" in various classes in Singapore.

As their application passed through various stages of registration, at one stage they encountered objection from IPOS as these marks were not surprisingly similar to the "East India Company & logo" trademarks owned by Metrojaya BHD and Metrojaya Sendirian Berhad (the ‘Registered Proprietors’).

The Applicants filed a revocation action against each of the Registered Proprietors’ trade marks on 24th November, 2014 based on Section 22 (1)(a) and (b) of the Singapore Trade Marks Act. On 25th November, 2014, the Registrar of the Trade Marks issued a standard letter to the Registered Proprietors, asking them to file their counter statement, or evidence of no use, or request an extension of time to file these documents. The Registered Proprietors did not file a reply by the deadline, thus prompting the Applicants to issue a letter requesting the Registrar’s confirmation that the subject registrations are to be deemed withdrawn.

On April 1st, 2015, a letter was received from the Registered Proprietors, stating that they were “instructed to apply for an extension of time for their clients to file a counter statement’. While paragraph 4 dealt with the reasons for non-use of the trade marks in the last 5 years in Singapore, the 5th paragraph specified the circumstances which led to the delay in the Registered Proprietors filing a reply by the deadline. The circumstances for the inaction was apparently the resignation of Administrative Manager and Human Resource Executive along with office relocation.

The Applicants subsequently wrote to the Registrar requesting the Registrar to confirm that the Registered Proprietors’ Marks were be ‘deemed revoked’. This is because the Registrar no longer held discretion under Rule 58(5) to allow for the extension of time, as the 4-month deadline expired on 24th March, 2015. After considering applications from both parties, the Registrar was inclined to decline the Registered Proprietors’ request for extension in time. An interlocutory hearing was requested by Registered Proprietors, without any application for the extension of time, and thus a notice for an interlocutory hearing was sent out to both the parties on 15th June, 2015. However, the interlocutory hearing was postponed to 23rd July, as the Registered Proprietors missed the initial letter from the Registrar.



Did you know...?

At the hearing, it was found that the Registered Proprietors had renewed the trade mark in 2007 as they were looking to re-launch the East India Company ('EIC') brand name in Singapore. However, their aspirations were cut short by the 2008 Financial Crisis. The Applicant highlighted the issue of non-use but the Registered Proprietors argued that the lack of use was justified by the financial crash.

In this case, a few other factors weighed against the Registered Proprietors, namely, there was long period of delay before the extension time was sought, the reasons given for the delay (purely administrative) did not constitute "exceptional circumstances", and there was no communication from the Registered Proprietors, giving Applicants the impression that the former was not interested to defend themselves.

Having weighed all the relevant factors, the Registrar decided against the Registered Proprietors and granted the Applicant's request to revoke Trade Mark Nos. T9706153E, T9706155A, T9706154C, T9706156Z, T9002227E, T9002228C.

This case raises two important points to take note of in revocation actions. Firstly, we learn that non-use due to financial crashes does not qualify a proper reason for non-use because these kinds of risks constitute a normal part of running a business. Secondly, administrative reasons such as departure of employees and office relocation do not fall within the purview of "exceptional circumstances" warranting the Registrar accept the Applicant's unjustified delay in filing a counter statement or extension of time. There was a careless attitude on the part of Registered Proprietors who did not file for an extension on time, thus letting the verdict favour of the Applicants.