Campomar SL *v* Nike International Ltd
[2010] SGHC 140

Case Number : Originating Summons No 1353 of 2009

Decision Date : 05 May 2010

Tribunal/Court : High Court

Coram : Choo Han Teck J

Counsel Name(s) : Prithipal Singh (K.L. Tan & Associates) for the appellant; Michael Palmer and Toh Wei Yi (Harry Elias Partnership) for the respondent.

Parties : Campomar SL — Nike International Ltd

Trade marks and trade names

5 May 2010

Choo Han Teck J:

1 This was an appeal by Campomar S.L. ("Campomar") against the decision of the Principal Assistant Registrar of Trade Marks ("PAR"). Campomar registered the mark "Nike" in Class 3 for "perfumery with essential oils" (application dated 2 April 1986) ("the 1986 mark"). On 20 November 2001, Nike filed an application seeking registration of the trademark "Nike" (the "application mark") in Class 3. Campomar opposed the application on the grounds that the application mark was identical to their 1986 mark. On 21 January 2002, Nike applied to have the 1986 mark revoked. In *Nike International Ltd v Campomar SL* [2006] 1 SLR(R) 919, the Court of Appeal found in favour of Nike and ordered that Campomar's rights to the 1986 mark be deemed to have ceased from the date of the application of the revocation proceedings, ie 21 January 2002. Nike's application to register the application mark, which was held in abeyance pending the outcome of the revocation proceedings, was restored and accepted. The application mark was published on 14 June 2006. Campomar filed a Notice of Opposition on 14 August 2006.

2 The relevant provisions of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") are as follows:

> **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

…

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.

…

Publication and opposition proceedings

13. — (1) When an application for registration has been accepted, the Registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the Registrar of opposition to the registration.

Before the PAR, Campomar contended that following the definition of "earlier trade mark" under s 2(1) of the Act, the relevant date to consider if there were any earlier trade marks is the date of the subject application. Hence, for the purposes of Nike's application (made on 20 November 2001), Campomar's 1986 Mark, which was applied for on 2 April 1986 and not deemed to have ceased until 21 January 2002, fell within the definition of 'earlier trade mark' under the Act. Therefore, since Nike's application mark was identical to Campomar's 1986 mark, and the goods and services for which Nike's application mark is sought to be registered was identical with the goods or services for which the 1986 mark protected, s 8(1) applied and the application mark should not be registered. Counsel for Nike argued that a right to oppose can only arise after the date of publication ie 14 June 2006. Since Campomar's 1986 mark had already been revoked, it did not qualify as an 'earlier trade mark' under s 2(*a*) of the Act at the time that the right to oppose arose. The PAR allowed Nike's application, and held that the time to consider whether there were earlier registered trademarks is the time when it was to be decided if the later application mark can be registered. The PAR therefore found that since the 1986 mark was no longer registered, it was not an "earlier trade mark" at the material time and s 8(1) of the Act did not apply. Against this ruling Campomar appealed. (Campomar had also contended before the PAR that Nike's application was made in bad faith pursuant to s 7(6) of the Act, however this was rejected by the PAR and was not a subject of this appeal.)

3 It was not disputed that the burden of proof in such an opposition fell on Campomar. The main

issue before me was whether Campomar's 1986 mark could be considered an "earlier trade mark" within the definition of s 2(1) of the Act for the purposes of the application under s 8(1). For the reasons below, I found that it was not. I agreed with the PAR that the appropriate time to determine whether there was an "earlier trade mark" was at the time of the opposition proceedings. First, contrary to Campomar's contention, I found that although s 2(*a*) provided a definition for what constitutes an "earlier trade mark", it does not indicate the relevant date for determining if the one existed. Instead, s 2(*a*) merely states that 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". From its wording, it is clear that not only must the application for the earlier trade mark be made before the trade mark in question (in this case, Nike's application mark to be registered), it must also be a registered trade mark. Therefore the question whether Campomar's trade mark was a registered one at the relevant time remained unanswered.

4 Secondly, Campomar relied heavily on *Riveria Trade Mark* [2003] RPC 50, a decision of the UK Trade Marks Registry 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. In that case, the applicant, whose trademark was registered on 13 June 1973 but revoked on 21 May 2001, applied to invalidate a subsequent trade mark, which was registered with effect from 22 March 2000 (ie before the revocation of the earlier trade mark). The Trade Marks Registry held that at the time the application to register the subsequent trade mark was made, the earlier trade mark was still valid. It remained valid when the application to invalidate the subsequent trade mark (on 23 April 2001) was made. Thus, the Trade Marks Registry held that the subsequent trade mark registered by the respondent was invalid despite that at the time of the proceedings, the trade mark had already been revoked. *Riveria Trade Mark* does not assist Campomar. In that case, the Trade Marks Registry had to decide if the subsequent trade mark was validly registered. That would obviously depend on the circumstances at the time of the registration. Here, we were concerned with whether there were grounds for opposing the registration of a subsequent trademark which has yet to be registered ie Nike's application mark. I would adopt the position taken by the PAR and in *Transpay Trade Mark* [2001] RPC 10 where the UK Trade Mark Registry held that at opposition proceedings, it was proper to take into account events that occurred between the date of application for registration and the date the final decision came to be made. In my view therefore, the more appropriate time to consider whether s 8 (1) applied was the time of the opposition proceedings. This would be consistent with the approach taken by the Court of Appeal in *Tiffany & Co v Fabriques de Tabac Reunies SA* [1999] 2 SLR(R) 541 where, in relation to the predecessor of the current Act, the Court held that the courts must be aware of the realities of the situation at the date that the opposition proceedings are heard. In that case, the Court of Appeal considered that the appropriate time to consider if the public was likely to be confused by the applicant's mark was at the time the opposition proceedings were heard.

5 Following the above, I am of the opinion that the time that determines when an application mark was an "earlier trade mark" under s 8(1) of the Act was the time of the opposition proceedings. Since the 1986 Mark had already been revoked at the time of the opposition proceedings, it was not a registered trade mark, and therefore not an "earlier trade mark". Accordingly s 8(1) as a ground for refusal of registration did not apply.

6 For the reasons above, I dismissed the appeal. I ordered costs to be taxed if not agreed.