

# World Trademark Review Daily

**Court of Appeal clarifies when mark is “earlier trademark”  
Singapore - One Legal LLC**

**Examination/opposition  
Cancellation  
National procedures**

April 07 2011

*Campomar SL v Nike International Ltd* ([2011] SGCA 6, February 28 2011) stemmed from a trademark application by Nike International Ltd, a worldwide retailer of sports shoes and apparel, and an opposition by Campomar SL, a Spanish company, to the registration of the mark.

Campomar owned a registration for the mark NIKE in Class 3 of the [Nice Classification](#) for “perfumery with essential oils”, with effect from April 2 1986.

On November 20 2001 Nike applied to register the mark NIKE in Class 3 for:

*“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.”*

This 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.”*

On January 21 2002 Nike filed an application for the revocation of Campomar's mark. The application was successful and Campomar's rights in its mark were deemed to have ceased as from the filing date of the application for revocation.

Following the revocation of Campomar's mark, Nike's mark was published on June 14 2006.

On August 14 2006 Campomar filed a notice of opposition against the registration of Nike's mark. Campomar's opposition was based on Sections 7(6) and 8(1) of the [Singapore Trademarks Act](#) (Cap 322, Rev Ed 2005) on the grounds of:

- bad faith; and
- existence of an identical earlier trademark registered for identical goods or services.

Section 7(6) of the act provides that “[a] trademark shall not be registered if, or to the extent that, the application is made in bad faith”.

Section 8(1) provides as follows:

*“A trademark shall not be registered if it is identical to an earlier trademark, and the goods or services for which the trademark is sought to be registered are identical to the goods or services for which the earlier trademark is protected.”*

An 'earlier trademark' is defined in Section 2(1) as:

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

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

*and includes a trademark in respect of which an application for registration has been made and which, if registered, would be an earlier trademark by virtue of Paragraph (a) subject to its being so registered’.*

During the opposition hearing on September 16 2009, the principal assistant registrar held that Campomar

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had failed on both grounds. Specifically, in relation to Section 8(1) of the act, the principal assistant registrar took the view that Campomar's mark could not be considered an "earlier trademark" which could form the basis of an opposition under Section 8(1) - this was because, at the time of the opposition hearing, Campomar's mark had already been revoked and was no longer a registered trademark. The principal assistant registrar held that the relevant point in time to determine whether there was an earlier trademark was the date of the opposition hearing or, more specifically, the date on which the registrar was due to enter the later mark into the register.

Campomar appealed to the High Court, restricting its case to Section 8(1) of the act. The High Court upheld the principal assistant registrar's decision (for further details please see "[Appropriate time to determine whether mark is an 'earlier mark' clarified](#)"), and Campomar brought the matter before the Court of Appeal.

The single issue before the Court of Appeal was whether Campomar's mark could be considered an "earlier trademark" within the meaning of Section 8(1), read together with Section 2(1).

The Court of Appeal agreed with both the principal assistant registrar and the High Court that an opposition to the registration of a mark should be considered in light of the circumstances prevailing as at the date of the opposition hearing.

However, the Court of Appeal pointed out a common flaw in the reasoning of the principal assistant registrar and the High Court in coming to the conclusion that Campomar's mark was not an "earlier trademark" within the meaning of Section 8(1), read together with Section 2(1): they did not consider the fact that two identical marks belonging to two proprietors co-existed on the register during the period from November 20 2001 (the date on which the registration of Nike's mark would take effect) and January 21 2002 (the date on which Campomar's mark was revoked).

According to the Court of Appeal, this problem would arise in cases where the date of an application for registration of a later mark (which would be the effective date of registration of the later mark, if registered) predates the application for revocation of an earlier mark, where the effective date of revocation is the date of the application for revocation.

The Court of Appeal reviewed a number of Singaporean and English decisions, but observed that most of these decisions appeared not to have considered the problem of overlapping rights.

However, the Court of Appeal found the case of *Riveria trademark* ([2003] RPC 50) to be useful, in particular the comments of the UK Trademarks Registry to the effect that, in order for a later trademark to be/remain validly registered, the conflicting earlier trademark must be revoked with effect from a date preceding the application date of the later trademark.

Although the *Riveria* case concerned invalidation - rather than opposition - proceedings, the Court of Appeal nevertheless believed that it was relevant, as it was also based on an earlier similar or identical registered mark.

The Court of Appeal thus held that the relevant date for determining whether Campomar's mark was an "earlier trademark" under Section 8(1), read together with Section 2(1), was the date on which Nike's mark was to be entered on the register (ie, the date of the opposition hearing); however, as at the date of the opposition hearing, the register showed that Campomar's mark was a registered trademark until January 21 2002. To that extent, allowing the registration of Nike's mark (which would take effect before January 21 2002) would run counter to the provisions of the act.

According to the Court of Appeal, the problem of overlapping rights could be avoided by invoking Section 22 (7)(b) of the act, which gives the registrar/court the power to backdate the effect of a revocation to a date earlier than the application date of the later trademark, if warranted by the circumstances. However, this was not done with respect to the revocation of Campomar's mark.

Therefore, the Court of Appeal came to a conclusion opposite to that of the principal assistant registrar and the High Court - namely, that Campomar's mark was an "earlier trademark" within the meaning of Section 8 (1), read together with Section 2(1).

The application for the registration of Nike's mark was thus refused.

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