

# ONLINE TRADE MARK USE - SINGAPORE

**1. Is availability of goods over the internet considered use of the trade mark?**

Yes, provided that there is some other "active step" that goes beyond the passive offering of goods at a website, as discussed by the Singapore court in the case of *Weir Warman Ltd v. Research & Development Pty Ltd* [2007] 2 SLR 1073; [2007] SGHC 59 ("**Weir Warman Case**"), where the issue had to be considered in the context of a revocation action for non-use of a registered trade mark. In that case, the registered proprietor's separate fax communication offering goods bearing the registered trade mark to a prospective customer and the occurrence of a meeting where the trade mark was communicated to a third party as a badge of origin, were held to be sufficient to constitute such "active step" as to establish genuine use of the mark.

**2. Must goods available over the internet be purchased in the country?**

No. The purchase of goods is not mandatory for genuine use of a trade mark to be established. As stated in the Weir Warman Case, "it now seems fairly settled that genuine use can be established even if there is no evidence of actual sales being made".

**3. Must goods available over the internet be directed towards consumers in the country?**

Bearing in mind that genuine use of a trade mark must be that "in the course of trade *in Singapore*", the requisite "active step" (see question 1 above) is determined on the basis of all available evidence of use.

To this extent, where the offer of goods over the internet is directed towards consumers in the country, it would aid in meeting the requirements for genuine use of the mark, but would not be necessarily critical where other evidence of use constituting the required "active step" is available.

**4. Is it necessary to lead evidence of actual purchase of goods available over the internet?**

See question 2 above.

**5. Does mere advertising of a trade mark over the internet without presence of goods or services in your country constitute use of trade mark?**

As discussed at question 2 above, the actual supply of goods (and hence of services as well) is not itself necessary to establish genuine use of a trade mark. The court in the Weir Warman Case made it clear that once the mark was communicated to a third party in such a way as can be said to be "consistent with the essential function of a trade mark" (*ie* as a badge of origin), that would be "genuine use" of the trade mark.

**6. Must the advertising of goods over the internet be directed towards consumers in the country?**

See question 3 above.

**7. Does having a website constitute advertising (as opposed to only paid advertising)?**

Yes, to the extent that the website contains material advertising goods or services under a trade mark, it can constitute relevant evidence of use of the trade mark. In that sense, it is no different from paid advertising, depending on the contents and circumstances in question.

However, advertising goods and services under a trade mark at one's own website would not be measurable in terms of the advertising dollar expended, in the way that paid advertising can be measured in dollar value terms as an indication of the extent of use and the investments made in the promotion of the trade mark.

**8. Is it possible to initiate an action for passing off / unfair competition purely on the basis of internet use?**

In the case of *Amanresorts Limited and Another v. Novelty Pte Ltd* [2008] 2 SLR 32; [2007] SGHC 201 ("**Amanresorts Case**"), the Singapore court held in favour of the plaintiff in an action for passing off of its trade mark "AMANUSA" in relation to resorts, although the plaintiff did not have any resorts in Singapore. In doing so, the court relied on the extensive goodwill and reputation in the trade mark in Singapore, as established by the plaintiff through, *inter alia*, promotional materials to travel agents, collaboration with airlines and credit card companies in targeting high-net-worth individuals, its newsletters to customers in Singapore, the numerous accolades and features it earned in international and regional magazines and newspapers in Singapore and elsewhere as well as its **Internet websites**, in respect of which the plaintiff held more than 20 domain names.

Although the plaintiff's internet use was relevant in the court's finding of the requisite goodwill and reputation to support the passing off action in the Amanresorts Case, it clearly was not pivotal.

To-date, there has been no reported case in which the Singapore courts have addressed a passing off action in which goodwill or reputation is claimed purely on the basis of internet use, although it is imagined that it would be conceivable to do so, provided such use is qualitatively sufficient for purposes of establishing the requisite goodwill and reputation in the trade mark in question, to support a passing off action.

**9. Can internet use establish initial use to entitle registration (relevant for countries like the US where use is required for registration)?**

Proof of initial use is not required for registration of a trade mark in Singapore since it is possible to obtain registration on the alternative basis of a genuine intention to use the trade mark (as opposed to actual use).

Where a trade mark is not considered to be inherently distinctive, and registration for such mark is sought on the basis of its having acquired *de facto* distinctiveness or secondary meaning by virtue of long and extensive use of the mark, evidence of such use may include internet use. However, it remains a factual determination in each case whether the internet use *per se* would be sufficient to prove the requisite long and extensive use.

**10. Can internet use form a basis of protecting a registration from non-use?**

The Weir Warman Case (see question 1 above) dealt squarely with the revocation of a registered mark on the ground of non-use, in respect of which the court clarified that internet use by way of a passive offering of goods at a website would not be sufficient to establish genuine use in the absence of some "active step".

Hence, while internet use can form a basis for protecting a trade mark registration from non-use, the "active step" of the nature discussed in the Weir Warman Case would be additionally necessary.

**11. Can internet use be sufficient to claim secondary meaning of a trade mark and entitle it to registration?**

See second paragraph to question 9 above.