

# The Limits of Implied Consent to Use in Non-Use Trade Mark Revocations

## *Technopharma Limited v Unilever PLC [2021] SGIPOS 11*

### Background

Technopharma Limited (“**Technopharma**”) applied to revoke three registered trade marks owned by Unilever PLC (“**Unilever**”) on the ground of non-use pursuant to sections 22(1)(a) and 22(1)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**TMA**”).

A registered trade mark will be revoked if, during the relevant time period, it has not been put to genuine use in the course of trade in Singapore, either by the proprietor or with his consent, in relation to the goods or services for which it is registered. To defeat Technopharma’s revocation application, Unilever sought to rely on evidence of use comprising photos of trade mark-bearing product packaging uploaded to third party websites. This raised the issue of what exactly “consent” to use a registered trade mark by a third party should entail.

### The Requirement of “Unequivocal Demonstration of Consent”

The Assistant Registrar considered the case of *Romanson Co. Ltd v Festina Lotus, S.A.* [2015] SGIPOS 3 (“**Festina**”), which set out the requirement that there must be an “unequivocal demonstration of consent” to satisfy the consent element in sections 22(1)(a) and 22(1)(b) of the TMA. It was also observed in *Festina* that “consent” may be implied, for instance, where a proprietor has actual or constructive knowledge of an unrelated third party that is selling goods bearing his trade mark, and he acquiesces to the use of the trade mark and the sales of these goods.

The Assistant Registrar sought to qualify the principles set out in *Festina* as he found that including implied consent in the interpretation of the consent element in sections 22(1)(a) and 22(1)(b) of the TMA would lead to uncertainty.

The Assistant Registrar identified two broad categories of trade mark use by third parties where “consent” may be established:

- (1) a third party’s use of a registered trade mark may take 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; and
- (2) third party trade mark use may 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. In this regard, the proprietor must show that (i) it had actual knowledge of the third party’s trade mark use and (ii) upon learning of the third party making use of the registered trade mark, it had responded 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. Merely tolerating or acquiescing to the third party’s use of the trade mark is not enough.

The Assistant Registrar also provided some examples as to how registered proprietors may indirectly demonstrate “consent” to the use of their marks by third parties, including engaging with the latter’s customers through social media, promotional campaigns, and providing repair or other after-sales services to purchasers of parallel imported products.

## Decision

Out of the numerous third party websites relied upon by Unilever, the Assistant Registrar found that only one third party website showed third party trade mark use with the consent of Unilever. The website was operated by an entity to which large quantities of Unilever’s goods were sold. The Assistant Registrar therefore inferred that Unilever had actual knowledge that the entity was operating a store that featured the goods supplied by the proprietors. In addition, it found that Unilever’s repeated supplies of products to this business customer should be regarded as some sort of authorised distributorship arrangement, from which express consent could be inferred.

Regardless, Unilever failed to defeat Technopharma’s revocation application, as the registered marks were not used in the exact forms in which they had been registered, and the forms of the mark that were actually used could not be relied upon as evidence of genuine use.

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